Will Professor Nimmer's Change of Heart on File Sharing Matter?

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ABSTRACT

In a significant reversal, the leading copyright treatise, Nimmer on Copyright*, has changed its position on the controversial subject of whether merely making a copyrighted work available for distribution violates the distribution right—an issue most significant in the context of peer-to-peer file sharing.* Nimmer on Copyright *had previously concluded that the distribution right did not extend so far. It now embraces whole-heartedly the "making available" theory of copyright infringement. Courts and practitioners should not follow suit. First, the treatise relies heavily on legislative materials that predate the actual passage of the current Copyright Act. Second, it argues that the current distribution right encompasses the old publication right of the predecessor Copyright Act, and that the old publication right included offers for sale. It fails, however, to acknowledge that "publication" had two very different meanings under the predecessor Act, and it makes the mistake of conflating those two meanings. In the end, the question of the "making available" right is intractable and requires congressional action to set straight.*

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Nimmer on Copyright is, without a doubt, the most important and influential treatise on copyright law.[1] Originally written by Melville Nimmer in 1963, it has been revised and maintained by his son, David, since 1986.[2] On controversial subjects—and there are many in copyright law—their opinion has been known not only to sway courts but also to make courts see the error of their ways.[3] One such controversial subject, on which David Nimmer apparently wielded considerable influence, was the impenetrable question of

1. *See, e.g.*, Kabehie v. Zoland, 125 Cal. Rptr. 2d 721, 737 (Ct. App. 2002) (Mosk, J., concurring); *see also* Devlin Hartline, *Nimmer Changes His Tune: 'Making Available' Is Distribution*, COPYHYPE (Oct. 2, 2012), http://www.copyhype.com/2012/10/nimmer-changes-his-tune-making-available-is-distribution (conducting an informal search on a well-known legal database and turning up twice as many references for Nimmer than for the second-most-cited copyright treatise).

2. *See* 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, "In Memoriam" (2012). References to "Nimmer" in this Article are to David Nimmer, except where indicated.

3. Schrock v. Learning Curve Int'l, Inc., 586 F.3d 514, 520 & n.4 (7th Cir. 2009) (citing Nimmer's criticism of Gracen v. Bradford Exch., 698 F.2d 300 (7th Cir. 1983), in reassessing the holding of that decision).

whether making an unauthorized copy available for sale or download constituted a violation of the public-distribution right—one of the exclusive rights held by copyright owners.[4] In those cases, Nimmer opposed the "making available" theory urged by the copyright owners.[5] Nimmer specifically advocated the view that only actual dissemination of copies violated the distribution right.[6]

Last year, however, Nimmer did an about-face on the issue. He now contends that actual dissemination of copies is not a requirement for infringement of the distribution right and that merely making a copyrighted computer file available on a publicly accessible network is sufficient to constitute a violation of that right.[7] His new view is based on a careful and fascinating reading of legislative history from the 1960s and early 1970s of bills that would ultimately be enacted as the Copyright Act of 1976 (1976 Act).[8] Nimmer found evidence in those materials that Congress was adopting an expansive view of the old publication right, simply renaming it the "distribution" right and further expanding it.[9] Might this be a watershed moment? With Nimmer's influence, will courts inevitably follow suit?[10]

As argued below, courts and commentators should not follow Nimmer blindly into the "making available" theory of copyright infringement. Not only does Nimmer's change of heart come very late in the game, well after significant contrary legal authority has developed (ironically, perhaps, with Nimmer's assistance), but Nimmer's new analysis contains significant flaws. The most significant flaw is the assumption that it is appropriate to rely on the old legislative materials—none of which were even generated by members of Congress. Nimmer cites no authority for this reliance, and the available legal authorities on the subject suggest that only materials generated by the Congress that actually passed the 1976 Act should be considered, if any.[11] Additionally, it is far from clear that Congress was consciously adopting and incorporating an expansive view of the publication right. The legal authorities Nimmer cited for this proposition were actually using "publication" in a very

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4. Atl. Recording Corp. v. Howell, 554 F. Supp. 2d 976, 981 (D. Ariz. 2008); Capitol Records Inc. v. Thomas, 579 F. Supp. 2d 1210, 1223 (D. Minn. 2008). It is impossible to say whether, but for Nimmer's influence, the court would have reached a different conclusion.

5. *See* cases cited *supra* note 3.

6. *See* cases cited *supra* note 3.

7. *See* 2 NIMMER & NIMMER, *supra* note 2, § 8.11.

8. *See id.*

9. *See id.*

10. *See* Moses Avalon, *Copyright Guru Changes Mind: Costs Lawyers Millions*, MOSESAVALON.COM BLOG (Oct. 2012), http://www.mosesavalon.com/copyright-guru-costs-lawyers-millions; Hartline, *supra* note 1.

11. *See infra* Part II.

different sense, and their pronouncements on the subject are all arguably dicta.[12]

I. FILE SHARING AND THE NEED FOR THE "MAKING AVAILABLE" THEORY OF PUBLIC DISTRIBUTION

File-sharing lawsuits are a bit passé these days.[13] From 2003 through 2008, the Recording Industry Association of America (RIAA) sued tens of thousands of alleged file sharers and settled before litigation with an unknown additional number.[14] Its goal was to educate the public by making public examples of ordinary people who used peer-to-peer file-sharing services to trade copyrighted song files.[15] In 2008, however, after spending tens of millions of dollars in legal fees,[16] the RIAA abandoned the initiative and stopped filing new

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12. *See infra* Part III.

13. *Real* file-sharing lawsuits, that is. There are a large number of lawsuits involving the BitTorrent protocol and copyrighted works of pornography, but these do not seem designed to survive past the pleadings stage. *See* David Kravets, *How Mass BitTorrent Lawsuits Turn Low-Budget Movies into Big Bucks*, WIRED (Mar. 31, 2011, 2:36 PM), http://www.wired.com/threatlevel/2011/03/bittorrent (estimating that as of March 2011, about 130,000 persons have been sued in such lawsuits). As one district court explained:

> This course of conduct indicates that the plaintiffs have used the offices of the Court as an inexpensive means to gain the Doe defendants' personal information and coerce payment from them. The plaintiffs seemingly have no interest in actually litigating the cases, but rather simply have used the Court and its subpoena powers to obtain sufficient information to shake down the John Does.

K–Beech, Inc. v. Does 1–85, No. 3:11cv469–JAG, 2011 WL 9879174, at *3 (E.D. Va. Oct. 5, 2011); *see also* Malibu Media, LLC v. Does 1–10, No. 2:12–cv–3623–ODW, 2012 U.S. Dist. LEXIS 89286, at *8–9 (C.D. Cal. June 27, 2012) ("The Court will not idly watch what is essentially an extortion scheme, for a case that plaintiff has no intention of bringing to trial.").

14. Sarah McBride & Ethan Smith, *Music Industry to Abandon Mass Suits*, WALL ST. J. (Dec. 19, 2008), http://online.wsj.com/article/SB122966038836021137.html (noting that the RIAA had brought approximately 35,000 legal proceedings since 2003); *see also* John Borland, *Record Industry Warns of New Lawsuits*, CNET (Oct. 17, 2003), http://news.cnet.com/Record-industry-warns-of-new-lawsuits/2100-1027_3-5093078.html.

15. *See* Press Release, RIAA, Recording Industry Begins Suing P2P File Sharers Who Illegally Offer Copyrighted Music Online (Sept. 8, 2003), http://www.riaa.org/newsitem.php?id=85183A9C-28F4-19CE-BDE6-F48E206CE8A1 ("We want to send a strong message that the illegal distribution of copyrighted works has consequences."); *see also* McBride & Smith, *supra* note 14 (explaining RIAA's decision to "drop its legal assault" after its decision to sue tens of thousands of individuals "created a public-relations disaster for the industry").

16. According to Ray Beckerman, who represented several defendants in these cases, the RIAA spent about $16 million in legal fees in 2008 alone, about $21 million in 2007, and about $19 million in 2006. Ray Beckerman, *Ha Ha Ha Ha Ha. RIAA Paid Its Lawyers More Than $16,000,000 in 2008 to Recover Only $391,000!!!*, RECORDING INDUSTRY VS THE PEOPLE BLOG (July 13, 2010, 11:26 AM), http://recordingindustryvspeople.blogspot.com/2010/07/ha-ha-ha-ha-ha-riaa-paid-its-lawyers.html. Although Beckerman has a rooting interest on this issue (which is apparent from the title of his blog post), these figures are based on publicly available Forms 990, to which Beckerman links in his blog. *See id.*

lawsuits.[17] This year, the final two such lawsuits—the *Thomas-Rasset* case in Minnesota[18] and the *Tenenbaum* case in Massachusetts[19]—are in their death throes.

Central to the RIAA's legal strategy was the "making available" theory of distribution.[20] Copyright law does not make illegal everything that might be done with or to a copyrighted work, only violations of certain limited (if broadly defined) "exclusive rights"—most notably, reproducing, adapting, publicly distributing, publicly performing, or publicly displaying a copyrighted work.[21] Not only must one avoid infringing these rights (unless there is a defense), one must avoid knowingly assisting or inducing others to infringe these rights.[22]

The Copyright Act defines the distribution right as the "distribut[ion of] copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease or lending."[23] "Copies or phonorecords" are just physical embodiments of the copyrighted work.[24] The distribution right thus covers not only sales to the public, but also gratuitous distributions and lease-like transactions.[25] The statutory definition left unclear whether merely offering to sell (or otherwise distribute) a copy constitutes an infringement of the distribution right in the same way offers for sale constitute infringements under the Patent Act.[26] Until the rise of file-sharing systems, this was a purely academic question because those who offered to distribute copyrighted goods nearly always succeeded in doing so, and an offer to distribute would almost

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17. *See* McBride & Smith, *supra* note 14.

18. Capitol Records, Inc. v. Thomas-Rasset, 799 F. Supp. 2d 999 (D. Minn. 2011), *vacated*, 692 F.3d 899 (8th Cir. 2012), *cert. denied*, 2013 WL 1091785 (U.S. Mar. 18, 2013) (No. 12-715).

19. Sony BMG Music Entm't v. Tenenbaum, 660 F.3d 487 (1st Cir. 2011), *cert. denied*, 132 S. Ct. 2431 (2012).

20. David Kravets, *RIAA 'Making Available' Argument: File Sharers 'Freeload'*, WIRED (June 30, 2008, 1:08 PM), http://www.wired.com/threatlevel/2008/06/riaa-making-ava.

21. 17 U.S.C. § 106(a) (2006).

22. *E.g.*, Fonovisa, Inc. v. Cherry Auction, Inc., 76 F.3d 259, 264 (9th Cir. 1996) (discussing contributory copyright infringement).

23. 17 U.S.C. § 106(3).

24. *Id.* § 101 (defining "copy" and "phonorecord"). It is generally agreed that an electronic transfer across a network of a copyrighted computer file constitutes a distribution even though nothing physical is exchanged and all that typically happens is the recipient's hard drive is altered. *See, e.g.*, London-Sire Records, Inc. v. Doe 1, 542 F. Supp. 2d 153, 172–73 (D. Mass. 2008) ("An electronic file transfer is plainly within the sort of transaction that § 106(3) was intended to reach.").

25. 17 U.S.C. § 106(3).

26. 35 U.S.C. § 271(a).

certainly be enough for an injunction against the actual distribution of the goods.[27]

File-sharing systems, especially peer-to-peer filing-sharing systems, radically changed this calculation because it became much easier to prove offers to distribute than to prove actual distributions.[28] Peer-to-peer file-sharing systems, like many Internet-based innovations, harness the Internet's "network effect" by inviting users into a kind of social contract: users obtain access to a wide range of content, and in exchange, subscribers make their content available to the system.[29] Greatly simplified, peer-to-peer file sharing works by connecting a subscriber who wants a particular item of content (e.g., a particular song or movie) with a subscriber who has that content.[30] The larger the file-sharing network, the more valuable it is for its users because the likelihood of finding a desired item of content increases with the addition of new users to the system.[31]

For this to work, users must purposely place content into "public folders" on their computers (i.e., a "walled-off" part of the computer's directory that any member of the public may access).[32] If a public folder were full of copyrighted song files, that user would be infringing copyright in two ways[33]: by (1) helping the downloading user to make a copy of the file (thus contributorily infringing the reproduction right) and (2) distributing a copy of the file to the

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27. 2 NIMMER & NIMMER, *supra* note 2, § 8.11[C].

28. *Id.*

29. *See* Stephanie Watson, *How Kazaa Works*, HOWSTUFFWORKS.COM, http://computer.howstuffworks.com/kazaa1.htm (last visited Mar. 4, 2013).

30. London-Sire Records, Inc. v. Doe 1, 542 F. Supp. 2d 153, 159 (D. Mass. 2008) (explaining peer-to-peer file sharing); Watson, *supra* note 29.

31. *See* Watson, *supra* note 29.

32. The part of the file-sharing process where one subscriber accesses another's "public folder" and downloads one or more files is nothing new—it is as old as the Internet. *See* Watson, *supra* note 29. The innovation of peer-to-peer file sharing was the creation of means of connecting supply and demand. *See id.* One file-sharing method, most famously employed by Napster, used a centralized database. *See* Marshall Brain, *How Gnutella Works*, HowStuffWorks.com, http://computer.howstuffworks.com/file-sharing.htm (last visited Mar. 4, 2013). This system was vulnerable to the failure or shutdown of the central server that maintained the database. *See id.* ("[T]he original Napster's key weakness lay in its architecture . . . ."). More recent systems that use the FastTrack protocol use a decentralized system in which subscribers' computers constantly update their content offerings to other computers on the network. *See* Watson, *supra* note 29.

33. At least one district court judge intimated a willingness to accept that file sharing could be fair use. *See* Sony BMG Music Entm't v. Tenenbaum, 672 F. Supp. 2d 217, 238 (D. Mass. 2009) ("A defendant who shared files online during this interregnum, sampling the new technology and its possibilities, but later shifted to paid outlets once the law became clear and authorized sources available, would present a strong case for fair use."). Despite an extraordinary opportunity to make this case, the plaintiff fumbled the argument by failing to satisfy basic rules of civil procedure. *Id.* at 221 ("[Plaintiff] did not meet [his] burden; in truth, he did not come close.").

downloading user (thus directly infringing the distribution right).[34] The RIAA thus had at least two straightforward legal theories of copyright infringement against a subscriber who was "hosting" the file in a particular transaction.

These legal theories were not sufficient for the RIAA's purposes, however. It was very difficult to detect actual downloads of files from a user's "public" folder, except by having agents initiate the downloads themselves.[35] In a peer-to-peer file-sharing network, it is extremely difficult, if not impossible, to directly observe an act of downloading.[36] Even where download logs can be obtained, they are only circumstantial evidence of what copyrighted work was actually accessed and downloaded.[37] While it is possible to prove an actual distribution of the files with circumstantial evidence, it requires more effort and expense because circumstantial evidence usually requires a jury trial.[38] Contributory liability's knowledge requirement would also be expensive to prove.[39] With tens of thousands of lawsuits to prosecute, even the RIAA lacked the necessary resources.[40] The RIAA needed a legal theory that was easy and cheap to establish and was sufficiently watertight to force early settlements and adjudications.

The RIAA thus argued that merely making copyrighted files available on a file-sharing network, without more, constituted infringement of the distribution right.[41] Establishing that files were available in the targeted subscriber's public folder was simple and irrefutable.[42] All the RIAA had to do was examine the subscriber's home computer. At that point, a subscriber was doomed: even if the subscriber destroyed the public folder so completely that forensics could not reconstruct it, such destruction would almost certainly draw an adverse inference that the subscriber had made illegal content

34. *See* 17 U.S.C. § 106(3) (2006); Fonovisa, Inc. v. Cherry Auction, Inc., 76 F.3d 259, 264–65 (9th Cir. 1996).

35. *See* Capitol Records Inc. v. Thomas, 579 F. Supp. 2d 1210, 1214–15 (D. Minn. 2008).

36. *See* 2 NIMMER & NIMMER, *supra* note 2, § 8.11[C][5][b].

37. *Id.*

38. *See* Atl. Recording Corp. v. Howell, 554 F. Supp. 2d 976, 979 (D. Ariz. 2008) (denying summary judgment to rights holder because defendant admitted to setting up peer-to-peer file-sharing account containing infringing files but swore he did not place those files onto the account, thereby creating a question of fact).

39. *Fonovisa*, 76 F.3d at 265. Unless the defendant admits to having the requisite knowledge, the plaintiff must prove the defendant's state of mind with circumstantial evidence. *See* Arista Records LLC v. Usenet.com, Inc., 633 F. Supp. 2d 124, 125 (S.D.N.Y. 2009).

40. *See supra* notes 3–4 and accompanying text.

41. *See* Kravets, *supra* note 20.

42. *See* 2 NIMMER & NIMMER, *supra* note 2, § 8.11[C][5][b].

publicly available.[43] Furthermore, this "making available" theory greatly increased the subscriber's liability because, under the statutory damages permitted by the Copyright Act, the size of an award was dependent on the number of works infringed.[44] The RIAA could therefore go from proving infringement of a handful of works to proving infringement of hundreds or even thousands of works.[45] The challenge for the RIAA was convincing the courts to accept its "making available" theory of the distribution right—an endeavor that met with only modest success.[46] Courts have generally rejected the theory.[47]

First, there is no definition of "distribute," which suggests Congress meant to limit the term to an ordinary and plain meaning. Furthermore, the distribution right sets forth several examples of distributions—sales, rentals, leases and lendings—all of which are consummated acts, more than mere offers.[48]

Second, there is a definition of "publication" that incorporates word for word the distribution right and adds the following sentence: "[T]he offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance or

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43. FED. R. CIV. P. 37(b)(2)(A)(i); *see generally* Rimkus Consulting Grp., Inc. v. Cammarata, 688 F. Supp. 2d 598 (S.D. Tex. 2010) (analyzing at length the circumstances that would support an adverse inference).

44. 17 U.S.C. § 504(c) (2006).

45. *See* Capitol Records, Inc. v. Thomas-Rasset, 692 F.3d 899, 902 (8th Cir. 2012) (concluding that recording companies are entitled to damages of $222,000 and "a broadened injunction that forbids Thomas-Rasset to make available sound recordings for distribution," but that "they are not entitled to an opinion on an issue of law that is unnecessary for the remedies sought or to a freestanding decision on whether Thomas-Rasset violated the law by making recordings available"), *cert. denied*, 2013 WL 1091785 (U.S. Mar. 18, 2013) (No. 12-715).

46. *See* UMG Recordings, Inc. v. Alburger, No. 07-3705, 2009 U.S. Dist. LEXIS 91585, at *10 (E.D. Pa. Sept. 29, 2009) ("[S]ources indicate that an individual violates the exclusive-distribution right by 'making available' that illegally downloaded work to other internet users." (citing Motown Record Co. v. DePietro, 2007 U.S. Dist. LEXIS 11626, at *12–13 (E.D. Pa. Feb. 16, 2007))); *DePietro*, 2007 U.S. Dist. LEXIS 11626, at *12 (adopting a "making available" theory); Universal City Studios Prods. LLLP v. Bigwood, 441 F. Supp. 2d 185, 190–91 (D. Me. 2006) (adopting a "making available" theory); *see also* Warner Bros. Records, Inc. v. Payne, No. W-06-CA-051, 2006 U.S. Dist. LEXIS 65765, at *11 (W.D. Tex. July 17, 2006) (refusing to reject the "making available" theory at the pleadings stage); Arista Records LLC v. Greubel, 453 F. Supp. 2d 961, 971–72 (N.D. Tex. 2006) (refusing to reject the "making available" theory at the pleadings stage). Of the three decisions that adopted the "making available" theory, two (*Bigwood* and *DePietro*) were against pro se defendants. *See DePietro*, 2007 U.S. Dist. LEXIS 11626, at *1; *Bigwood*, 441 F. Supp. 2d at 186. The other (*Alburger*) was something less than a ringing endorsement of the theory, especially since the theory was not necessary to the holding (the defendant admitted to reproducing the files), and the court did not use the theory in calculating damages. *See Alburger*, 2009 U.S. Dist. LEXIS 91585, at *11–16.

47. *See* Atl. Recording Corp. v. Howell, 554 F. Supp. 2d 976, 981 (D. Ariz. 2008) (collecting cases).

48. *See id.* at 985; Capitol Records Inc. v. Thomas, 579 F. Supp. 2d 1210, 1216–17 (D. Minn. 2008).

public display [constitutes publication.]"[49] If the distribution right included offers to distribute, this additional language would be superfluous.[50]

Third, legislative history sheds little light on the issue. The House Report comments that the distribution right "establishes the right of publication."[51] As this Article discusses, this *might* mean Congress was equating the distribution right with an older (not superseded) publication right that *might* include offers to sell. The rest of the House Report, however, undercuts this viewpoint by describing the distribution right in terms of actual, consummated acts.[52]

Consistent with the court opinions, the three major copyright treatises—*Nimmer on Copyright*, *Patry on Copyright*, and *Goldstein on Copyright*—were unanimous in concluding that there was no "making available" theory of copyright infringement and that infringement of the distribution right required an actual, consummated act of distribution.[53]

II. NIMMER'S CHANGE OF HEART

The copyright treatises *were* unanimous until recently. In early 2012, *Nimmer on Copyright* reversed itself on this issue and now confidently asserts that, properly understood, the distribution right must include offers to distribute.[54] The genesis of this about-face[55] came in Fall 2011, when Nimmer's long-time collaborator, Professor Peter S. Menell, published a lengthy article[56] arguing that, for years, courts have been misunderstanding the true scope of the distribution right because they have not looked at all of the legislative history.[57] When this veritable "trove" of legislative materials is read in the proper context, it makes clear that Congress intended to expand an

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49. *In re* Napster, Inc. Copyright Litig., 377 F. Supp. 2d 796, 803–04 (N.D. Cal. 2005) (citing 17 U.S.C. § 101).

50. *See id.*

51. *Thomas*, 579 F. Supp. 2d at 1219 ("The Committee Reports identified the 'Rights of Reproduction, Adaptation, and Publication' as '[t]he first three clauses of Section 106.'" (citing Elektra Entm't Grp., Inc. v. Barker, 551 F. Supp. 2d 234, 241 (S.D.N.Y. 2008))).

52. *See id.*

53. *See Atl. Recording*, 554 F. Supp. at 981 (citing 2 NIMMER & NIMMER, *supra* note 2, § 8.11[A] (2007); 4 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 13:9 (2007); 2 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 7.5.1, at 7:125–7:126 (3d ed. 2005)).

54. 2 NIMMER & NIMMER, *supra* note 2, § 8.11[D][4][c].

55. *See generally id.* § 8.11[D] (examining the division among courts on the scope of the distribution right and drawing a conclusion about the correct scope).

56. *See generally* Peter S. Menell, *In Search of Copyright's Lost Ark: Interpreting the Right to Distribute in the Internet Age*, 59 J. COPYRIGHT SOC'Y U.S.A. 1 (2011).

57. *See id.* at 5–6.

old right that Menell argued had always included the right to offer to sell.[58] Menell's argument persuaded David Nimmer, who invited Menell to rewrite the section of *Nimmer on Copyright* dealing with the distribution right.[59] The newly revised section reads more like a law review article than a treatise. Although Menell penned the revised section, Nimmer has adopted Menell's positions and arguments on the matter.

A. Publication's Double-Duty under the 1909 Act

To understand Nimmer's new reasoning, it is instructive to examine the predecessor to the 1976 Act, the Copyright Act of 1909 (1909 Act). There was no distribution right under the 1909 Act.[60] Instead, there was a right to "publish" and a right to "vend."[61] At the time, the term "vend" had a specific and a general meaning. Specifically, it meant, "to dispose of by sale."[62] But more generally, it meant to be in the business of selling.[63] The phrase, "I vend dry goods," expresses both that "I regularly sell dry goods" and "I am in the business of selling dry goods," which necessarily includes offering dry goods for sale.[64] Is a vending machine a "vending" machine because it regularly sells small snacks or because it offers small snacks for sale? In ordinary parlance, does it make a difference?

The term "publish" was more subtly ambiguous. It originally meant to make publicly known—usually (but not always) through writing—or more specifically "to make generally accessible or available for acceptance or use; to place before or offer to the public."[65] But in a more specific business context, it could mean "to issue . . . for sale to the public (copies of a book, writing, engraving, piece of music, or the like); said of an author, editor or, spec., of a professional publisher."[66] This latter definition seems to combine creation (of the copies, not the work) and sending forth ("issue") with a commercial purpose ("for sale to the public").

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58. *See id.* at 6.

59. *See id.* at 20 n.90.

60. *See* Act of Mar. 4, 1909, Pub. L. No. 60-349, 35 Stat. 1075–76 (codified as amended by Copyright Act of 1976, 17 U.S.C. § 101); Menell, *supra* note 56, at 37.

61. *See* Act of March 4, 1909, Pub. L. No. 60-349, 35 Stat. 1075; Menell, *supra* note 56, at 37.

62. V OXFORD ENGLISH DICTIONARY 90 [hereinafter OED] (sense 1).

63. *Id.* (sense 2) (defining the transitive use of "vend" as "To sell; to dispose of by sale; to trade in as a seller").

64. *Id.* (sense 2).

65. P OED 1563–4 (senses 1 and 4b).

66. *Id.* at 1564 (sense 4a).

Unfortunately, the term "publish" did double-duty under the 1909 Act.[67] It not only defined one of the exclusive rights of copyright, but it was also a requirement for federal copyright protection—or the destruction of copyright protection. Under the 1909 Act, to copyright a work, one had to publish the work with statutorily defined "notice."[68] Before it was published, state- or common-law copyright governed.[69] Common-law copyright was perpetual, but the work remained unavailable to the public.[70] In exchange for making the book publicly available, the author received a kind of monopoly on the right to exploit the book limited to twenty-eight or fifty-six years from publication.[71] In this way, Congress hoped to encourage the public dissemination of knowledge and creativity.[72]

If an author published a work without notice, the work passed immediately into the public domain—a harsh result indeed.[73] The 1909 Act provided some guidance regarding when to fix the first "publication" of a work for these purposes. The Act defined "the date of publication" as, "in the case of a work of which copies are reproduced for sale or distribution [shall] be held to be the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed by the proprietor of the copyright or under his authority."[74]

A fairly common defense to a claim of copyright infringement under the 1909 Act (and before)[75] was that the work in question was

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67. 1 NIMMER & NIMMER, *supra* note 2, § 4.01[D].

68. *See* Act of Mar. 4, 1909, Pub. L. No. 60-349, 35 Stat. 1077, 1079; Menell, *supra* note 56, at 37 (citing Act of Mar. 4, 1909, Pub. L. No. 60-349, 35 Stat. 1078–79).

69. *See* Act of Mar. 4, 1909, Pub. L. No. 60-349, 35 Stat. 1076; Societe Civile Guino v. Renoir, 549 F.3d 1182, 1185–86 (9th Cir. 2008).

70. Estate of Martin Luther King v. CBS, Inc., 194 F.3d 1211, 1214 (11th Cir. 1999) (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 4.01[B] (1998)).

71. *See* Act of Mar. 4, 1909, Pub. L. No. 60-349, 35 Stat. 1080 (repealed 1976); 1 NIMMER & NIMMER, *supra* note 2, § 4.04.

72. The Nimmer treatise states:

> Some answer that it is contrary to the public interest for any form of property to remain entirely private from generation to generation without limit . . . . Others maintain that society's interest in, and need for free access to, literary property qualitatively differs from its interest in other forms of private property . . . .

1 NIMMER & NIMMER, *supra* note 2, § 4.04. Additionally, it points out that, "In any event, even before the current Act, Congress and the courts, by invoking the doctrine of publication as an act of divestment, implemented the constitutional policy of limited ownership in literary property." *Id*.

73. *See* Act of Mar. 4, 1909, Pub. L. No. 60-349, 35 Stat. 1078–79 (repealed 1976); *Societe Civile*, 549 F.3d at 1185–86 (citing La Cienega Music Co. v. ZZ Top, 53 F.3d 950, 953 (9th Cir. 1995)); Menell, *supra* note 56, at 37.

74. Act of Mar. 4, 1909, Pub. L. No. 60-349, 35 Stat. 1087–88 (repealed 1976).

75. Jewelers' Mercantile Agency v. Jewelers' Weekly Publ'g Co., 155 N.Y. 241, 249–53 (Ct. App. 1898).

"published" without notice and was therefore not protected under copyright—or there was some other formal defect related to publication.[76] Litigants sometimes called upon courts to determine when a work was "published."[77] Despite their extreme reluctance, in essence, to work a forfeiture, courts sometimes held that merely offering a book for sale constituted a "publication."[78] Given the definition of "date of publication," this seems to be the correct—if unhappy—result.

With "publish" performing two different functions in the 1909 Act, the possibility arises that "publish" might mean two different things in the 1909 Act depending on the function.[79] On the one hand, it is neater for a given cohesive act, such as the 1909 Act, to contain only one meaning for key terms.[80] On the other hand, even this presumption will yield when statutory context demands.[81] In the 1909 Act, "publish" fulfills very different functions. Congress might well have intended to make securing (or accidentally destroying) copyright easier than violating the publication right. After all, publication with notice was the only way to secure copyright, but there were multiple ways to infringe copyright. Arguably, "publication" in the former sense should be broader than it is in the latter sense, since it has more work to do.

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76. Advisers, Inc. v. Wiesen-Hart, Inc., 238 F.2d 706, 707–08 (6th Cir. 1956) (per curiam) (finding forfeit of copyright where actual date of publication was earlier than stated on the registration).

77. *See id*.

78. *See* Menell, *supra* note 56, at 36–37.

79. *See* 1 NIMMER & NIMMER, *supra* note 2, § 4.01[D] (referring to the use of "publication" in connection with eligibility for federal copyright protection as an "event," and the other use as an "event," and that these usages were "[e]ntirely separate" and "distinct" from each other). Subsection 4.01[D] was also apparently coauthored by Menell. *See id*. n.* ("This subsection, co-authored by Peter S. Menell, draws heavily on his article, *In Search of Copyright's Lost Ark: Interpreting the Right to Distribute in the Internet Age* (2010) . . . ."). Nimmer does state that the right of publication "cannot be understood absent historical development of the concept of publication," but does not say why. *See id*. § 4.01[D].

80. Gustafson v. Alloyd Co., 513 U.S. 561, 568 (1995) (5-4 decision) ("[W]e adopt the premise that the term should be construed, if possible, to give it a consistent meaning throughout the Act."); Ratzlaf v. United States, 510 U.S. 135, 143 (1994) ("A term appearing in several places in a statutory text is generally read the same way each time it appears." (citing Estate of Cowart v. Nicklos Drilling Co., 505 U.S. 469, 479 (1992))).

81. The Supreme Court explained:

> Undoubtedly, there is a natural presumption that identical words used in different parts of the same act are intended to have the same meaning. But the presumption is not rigid and readily yields whenever there is such variation in the connection in which the words are used as reasonably to warrant the conclusion that they were employed in different parts of the act with different intent.

Atl. Cleaners & Dyers, Inc. v. United States, 286 U.S. 427, 433 (1932) (citations omitted); *see also Gustafson*, 513 U.S. at 588 (Thomas, J., dissenting) ("But this presumption [that a given term bears the same meaning throughout a statute] is overcome when Congress indicates otherwise.").

Courts never attempted to reconcile the meaning of "publish" in these two contexts. Instead, they further complicated the issue by treating "publication," as used in the context of securing (or accidentally destroying) federal copyright, in two very different ways depending upon external factors. The meaning of "publish" depended on whether the author was trying to avoid forfeiture of protection, in which case courts construed the term narrowly, or to secure federal copyright, in which case courts construed the term broadly.[82] Either way, such courts interpreted the term in the author's favor.[83] Additionally, *Nimmer on Copyright*, among other sources, heavily criticized this double meaning of "publication" in the same statutory context.[84]

Alas, there appears to be no legal authority on the issue that actually matters here (i.e., whether "publish" as applied to the exclusive right under the 1909 Act required actual distributions of copies). There simply appears to be no decision construing "publish" in that statutory context under the 1909 Act. All of the treatments of "publish" are instead related to securing (or accidentally destroying) federal copyright. Certainly, Nimmer does not provide any such authorities but simply assumes the term means exactly the same thing in both statutory contexts.[85]

B. Congress Reforms Copyright Law and the Concept of Publication

In the 1950s, Congress began the long process of reforming copyright law.[86] It did not, as Congress often does, reform it piecemeal with amendments that fixed whatever problems the law had.[87] It was

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82. *See* Roy Export Co. Establishment of Vaduz, Liechtenstein v. Columbia Broad. Sys., Inc., 672 F.2d 1095, 1101–02 (2d Cir. 1982) (tracing the history of these "divestive" and "investive" meanings of "publication"); Hirshon v. United Artists Corp., 243 F.2d 640, 645 (D.C. Cir. 1957) ("[I]t takes more publication to destroy a common-law copyright than to perfect a statutory copyright.").

83. *See supra* note 82.

84. *See* Zachary v. W. Publ'g Co., 143 Cal. Rptr. 34, 41 (Ct. App. 1977); *see also* Cont'l Cas. Co. v. Beardsley, 151 F. Supp. 28, 40 (S.D.N.Y. 1957) (referring to the definitions as a "double standard"). Indeed, this "double standard" was criticized by the concurring judge in the very decision that appears to have given rise to it. *See* Am. Visuals Corp. v. Holland, 239 F.2d 740, 745 (2d Cir. 1956) (Medina, J., concurring).

85. 2 NIMMER & NIMMER, *supra* note 2, § 8.11[B][4][d]. Menell also apparently found no such authority. *See* Menell, *supra* note 56, at 37–38 & n.160.

86. 1 PATRY, *supra* note 53, at 74–89 (summarizing the history the 1976 Copyright Act). The impetus for reforming copyright law dates to 1955, after the United States joined the Universal Copyright Convention and needed to update its laws to conform, but the first formal report was made by the Register of Copyrights at Congress's instruction in 1961. *See id*. at 74–76.

87. *See id*. at 74–89.

generally agreed that copyright law needed a complete and fundamental overhaul; a series of amendments would not do. Copyright law needed to be uprooted and replanted,[88] a process that took several decades.[89] During that time, Congress worked closely with the Register of Copyrights, academics, and representatives of the various stakeholders.[90]

Each Congress progressed slightly in drafting a new copyright act, with one Congress hashing out a series of disputed issues and leaving the rest to the next Congress, and so forth.[91]

On the issue of "publication," there was little question that it had almost no place in the reformed act.[92] The publication requirement's main reason for existence was no longer valid because it would be inconsistent with international treaties the drafters expected the United States to join eventually.[93] Instead of a publication-with-notice requirement, which opened the possibility of unintended forfeiture, copyright would instead arise as soon as the work was fixed in a tangible medium, such that unintended forfeiture would be impossible.[94]

Congress also generally agreed that the "publication" right should be replaced with something less confusing.[95] The rights to publish and to vend were thus combined into the current right to distribute.[96] "Publication" as a concept was nearly wiped out—but not so much that it did not merit a definition.[97] In 1965, the Register of Copyrights wrote in the *Second Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*

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88. *See id.*

89. *See id.*

90. *See id.*

91. *See id.*

92. *See* 2 NIMMER & NIMMER, *supra* note 2, § 8.01[B]. Publication continues to have a number of limited functions in the current copyright act. *See* 1 NIMMER & NIMMER, *supra* note 2, § 4.01[A] (setting forth fifteen contexts in which publication may be significant).

93. H.R. REP. NO. 94-1476, at 144–45 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5760–61. In fact, the United States did not join the Berne Convention until 1989. *See* Berne Convention Implementation Act of 1988, Pub. L. 100-568, 102 Stat. 2853–61.

94. *Id.*

95. 2 NIMMER & NIMMER, *supra* note 2, § 8.11[B][1]. Actually, Congress was never explicit about this frustration. *Id.* Professor Nimmer's only evidence is a statement by Edward Sargoy, who was involved in the negotiations related to copyright reform in 1965, but who was representing the American Bar Association at the time. *Id.* He was not representing any member of Congress at the time, and he cannot be said to be a spokesman for legislative intent. Nevertheless, Professor Nimmer's description of this frustration makes intuitive sense. Surely, it is the best explanation for why Congress abandoned the exclusive right of publication. Whether the "best explanation" constitutes actual legislative history is more doubtful, however.

96. *See id.*

97. 17 U.S.C. § 101 (2006).

(Second Supplementary Report) that the language of the new distribution right "is virtually identical with that of the definition of 'publication' . . . , but for the sake of clarity we have restated the concept here."[98] The Register did not elaborate on what she thought the definition of "publication" was. Thus, in 1965, the congressional committee in charge of drafting the reformed copyright act had settled upon the distribution right.[99] That draft provision would remain unchanged when Congress finally passed the 1976 Act.[100]

Looking at this trove of legislative history and historical context, Nimmer now concludes that the distribution right includes offers for sale based on the following syllogism: (1) the distribution right is synonymous with the old publication right; (2) the old term "publication" used to include offers for sale; therefore, (3) the new distribution right must also include offers for sale.[101] Nimmer's logic is flawed because it hand-waves two critical assumptions: (1) that it is appropriate to look at the legislative history from the 1965 Congress, or indeed any Congress, in interpreting the distribution right; and (2) that the right to publish under the 1909 Act actually included the right to offer to sell.

III. IS NIMMER'S TROVE OF LEGISLATIVE HISTORY EVIDENCE OF CONGRESSIONAL INTENT?

David Nimmer appears to assume that it is always appropriate to look at legislative materials to help interpret statutes, but he cites no support for this proposition.[102] Resorting to legislative materials to help interpret statutes is, in fact, not always appropriate. To the contrary, courts may make recourse to legislative history only if the statutory provision in question is ambiguous based on its plain meaning and statutory context.[103] Furthermore, a court may not use

98. 2 NIMMER & NIMMER, *supra* note 2, § 8.11[B][4][d] (quoting OFFICE OF THE REGISTER OF COPYRIGHTS, SUPPLEMENTARY REGISTER'S REPORT ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 19 (1965)). For the entire report, see Supplementary Register's Report on the General Revision of the U.S. Copyright Law (1965), 9 NIMMER & NIMMER, *supra* note 2, App. 15.

99. 2 NIMMER & NIMMER, *supra* note 2, § 8.11[B].

100. *Id.*

101. *Id.* § 8.11[D][4][c].

102. *Id.* § 8.11[B].

103. Koons Buick Pontiac GMC, Inc. v. Nigh, 543 U.S. 50, 60 (2004) ("Statutory construction is a 'holistic endeavor.' 'A provision that may seem ambiguous in isolation is often clarified by the remainder of the statutory scheme . . . .'" (citations omitted) (quoting United Sav. Ass'n of Tex. v. Timbers of Inwood Forest Assocs., Ltd., 484 U.S. 365, 371 (1988))); *accord* Robinson v. Shell Oil Co., 519 U.S. 337, 340–42 (1997); Conn. Nat'l Bank v. Germain, 503 U.S. 249, 253–54 (1992) ("[C]ourts must presume that a legislature says in a statute what it means and means in a statute what it says there.").

legislative materials to create an ambiguity.[104] The ambiguity must be in the statute itself.[105] The mere fact that a statute is controversial or that an interest group would very much wish the statute were written differently does not make a statute ambiguous. To be ambiguous, the statute must permit more than one reasonable interpretation when read in context.[106]

A. Is the Distribution Right Ambiguous in Context?

Is the Copyright Act's description of the scope of the distribution right really so ambiguous as to require recourse to legislative history? If one were to approach the statutory description of the distribution right neutrally, there is little reason to even ask whether offers for sale are included; the right allows an author "to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending . . . ."[107]

The legislative history from the 1960s might indicate that the distribution right was meant to encompass the publication right, which *might* mean it encompasses the right to offer to sell, but that is irrelevant. One may not use the legislative history to create the ambiguity; it must be present in the statutory language.[108] It is at least highly questionable whether this statutory language is ambiguous.

Dictionary definitions hardly create sufficient ambiguity to require resort to legislative history. One well-known dictionary defines "distribute" as follows:

> 1 : to divide among several or many: apportion <*distribute expenses*>
>
> 2 a : to spread out so as to cover something: scatter
>
> 2 b : to give out or deliver especially to members of a group <*distribute newspapers*> <*distribute leaflets*>
>
> 2 c : to place or position so as to be properly apportioned over or throughout an area <200 pounds *distributed* on a 6-foot frame>
>
> 2 d : to use (a term) so as to convey information about every member of the class named <the proposition "all men are mortal" *distributes* "man" but not "mortal">
>
> 3 a : to divide or separate especially into kinds

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104. *See* Comm'r v. Ewing, 439 F.3d 1009, 1013 (9th Cir. 2006); United States v. Wildes, 120 F.3d 468, 470 (4th Cir. 1997) (citing United States v. Gonzales, 520 U.S. 1, 4–6 (1997)).

105. *See Wildes*, 120 F.3d at 471.

106. *See*, *e.g.*, Carrieri v. Jobs.com Inc., 393 F.3d 508, 518–19 (5th Cir. 2004); John v. United States, 247 F.3d 1032, 1040–41 (9th Cir. 2001).

107. 17 U.S.C. § 106(3) (2006).

108. *See supra* notes 80–81.

3 b : to return the units of (as typeset matter) to storage

4 : to use in or as an operation so as to be mathematically distributive.[109]

Again, approaching these definitions neutrally, which definition is most appropriate for copyright law? Of the above, surely, it is 2(b). The examples provided in the definitions even involve copyrighted material.[110] Yet, that definition clearly contemplates a consummated delivery of something.[111] Under this definition, if a pamphleteer offered leaflets without success to several passersby, one would not say she distributed those leaflets but would say instead that she failed to do so. One would think her untruthful if she later reported that she distributed the very leaflets that she still had in her hands.

Further, it is not as though Congress was unaware of the possibility of offers to distribute. Indeed, in the definition of "publication,"[112] Congress specifically included "offering to distribute copies." If "distribution" included "offers to distribute," this additional sentence would be completely unnecessary. Nimmer dismisses this additional sentence in the definition of "publication" as an artifact of a 1971 amendment necessary to comply with new treaty obligations—an artifact that Congress evidently failed to clean up in 1976.[113] Any ambiguity Nimmer thereby seeks to introduce arises not from the statutory language and statutory context, but from the legislative history. As discussed above, that sort of ambiguity is irrelevant.[114]

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109. *Distribute*, MERRIAM-WEBSTER DICTIONARY, http://www.merriam-webster.com/dictionary/distribute (last visited Mar. 6, 2013).

110. Nimmer also looks at a dictionary to determine whether "distribute" is ambiguous. His dictionary lacks the final definition given above and includes in its place "to market (a commodity) under a franchise in a particular area, esp. wholesale." Menell, *supra* note 56, at 49 (quoting WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 660 (1961)). He regards this new final definition as being equally likely as definition 2(b). 2 NIMMER & NIMMER, *supra* note 2, § 8.11[D][4]. It is submitted that Nimmer is overthinking the problem. No reasonable speaker of English would prefer "to market (a commodity) under a franchise in a particular area," which seems a very specific and specialized meaning, over "to give out, deliver," which seems a much more ordinary use of the word.

111. Menell thinks his version of definition 2(b) is itself ambiguous as to whether it contemplates an actual delivery of something. The sum of his explanation is as follows: "To spread out or scatter seems to involve some physical act by the distributor, but could plausibly be accomplished through placing a work into a file-share folder that is searchable and accessible to a network of 'subscribers.'" Menell, *supra* note 56, at 50. This reasoning does nothing more than restate the very proposition he is trying to prove.

112. 17 U.S.C. § 101.

113. 2 NIMMER & NIMMER, *supra* note 2, § 8.11[B][2][a].

114. *See supra* notes 80–82 and accompanying text.

B. Is It Appropriate to Use Legislative Materials Generated by Previous Congresses that Debated, but Did Not Enact, Copyright Reform Bills?

Even if one were to resort to legislative history, it still might not be appropriate to look at the legislative history from 1965 (or even 1971) which is so crucial to Nimmer's argument.[115] The purpose of legislative history is to divine Congress's intentions in enacting a statute.[116] But "Congress" changes every two years.[117] One Congress may have very different intentions and goals than its predecessor, even if its membership does not change significantly.[118] If a bill was drafted by one Congress, shelved, then passed by a later Congress, that later Congress's intentions in adopting the old bill's language may have been very different from the previous Congress's intentions in drafting it. In short, if one looks at the legislative history at all, we may look only at the materials generated by the 1976 Congress—the one that passed the 1976 Act.[119]

Nimmer cites no authority to support using the intent of previous Congresses as an aid in statutory interpretation.[120] Even Menell does not cite to any such authority in his article.[121] In a footnote he argues, "Statutory history as well as bill history can also be important."[122] But looking to statutory history—the history of a statute as it is amended and revised over time—is not the same thing as looking to the legislative history of previous Congresses to determine the congressional intent of a later Congress, and none of Menell's cited authorities suggests otherwise.[123]

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115. *See* 2 NIMMER & NIMMER, *supra* note 2, § 8.11[B][1].

116. *See* Cantor v. Detroit Edison Co., 428 U.S. 579, 618 (1976) (Stewart, J., dissenting).

117. U.S. CONST. art. I, § 2, cl. 1.

118. To take a hypothetical example, imagine that Congress was contemplating in 1988 a bill that would criminalize the unauthorized accessing of computer networks because it was reacting to a series of physical break-ins at buildings hosting central computers. The legislative material stresses the physical access to the actual computers. The bill is not passed by that Congress. In 1990, there were no significant changes in Congress, and Congress takes up the same bill, but in the meantime, there had been a series of remote "hacks" across computer networks, prominently mentioned in the legislative materials. This time the bill passes. If there were ambiguity in the act as to whether it applied to remote "hacks," it might be fair to consider the 1990 materials as evidence that Congress intended to include such "hacks," even though one might have reached the opposite conclusion if the same bill had passed in 1988.

119. *See* Lyons v. Ga.-Pac. Corp. Salaried Emps. Ret. Plan, 221 F.3d 1235, 1247 (11th Cir. 2000) (rejecting an argument based on earlier legislative history because "we are concerned with [the statute] as amended by the 1986 legislation, not as it existed before").

120. *See* 2 NIMMER & NIMMER, *supra* note 2.

121. *See* Menell, *supra* note 56, 52–53 nn.222–26 (failing to cite legislative intent of prior Congresses).

122. *See id*. at 52 n.225.

123. *See supra* text accompanying notes 96–100.

Menell might have usefully cited to *Mizrahi v. Gonzales*,[124] in which the Second Circuit did look far back in time to examine older legislative materials for an old statute that had been amended on numerous occasions.[125] But even in *Mizrahi*, the court limited its examination of the older legislative materials to those materials generated by the Congresses that actually enacted amendments relevant to the court's inquiry.[126] By contrast, the materials Nimmer relies on were generated by Congresses that did not, in fact, enact the 1976 Act.[127]

Further, the legislative materials on which Nimmer relies did not necessarily reflect the views of Congress. They represent the views of (1) the Register of Copyright, (2) the General Counsel of the Copyright Office, and (3) the American Bar Association.[128] Those entities are highly influential; it is a safe assumption that their words carried a great deal of weight with Congress. Those groups and individuals were present because of their great expertise and the fact that the Copyright Office, and the General Counsel in particular, played a central role in drafting the text of what would become the 1976 Act.[129] But they were not, in fact, members of Congress. And it is Congress's intent that matters.[130] At best, Nimmer's legislative materials constitute indirect evidence of legislative intent.

The 1976 Act arguably should be treated differently because its legislative history is so unusual. The debate, analysis, and thinking that went into the 1976 Act spanned more than a decade.[131] The 1976 Act was enormously complex and intended to satisfy several interest groups.[132] It is perhaps expecting too much of the 1976 Congress to distill all of this into a single set of legislative materials. Where the enactors were silent, perhaps it is appropriate to look at what the drafters were thinking, even if those thoughts were already more than ten years old. In the right hands, this argument might be compelling, but it is not an argument that either Nimmer or Menell makes.

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124. 492 F.3d 156 (2d Cir. 2007).
125. *See id.* at 167–73.
126. *See id.*
127. *See* 2 NIMMER & NIMMER, *supra* note 2, § 8.11[B][1].
128. *See id.*
129. *See id.*
130. *See* Cantor v. Detroit Edison Co., 428 U.S. 579, 618 (1976) (Stewart, J., dissenting).
131. *See* 2 NIMMER & NIMMER, *supra* note 2, § 8.11[B].
132. *See id.*

IV. DID CONGRESS ADOPT AND INCORPORATE AN EXPANDED VIEW OF THE OLD PUBLICATION RIGHT INTO THE NEW DISTRIBUTION RIGHT?

The other flaw in Nimmer's syllogism is the assumption that the publication *right* (as opposed to the publication *requirement*) encompassed the right to offer to sell under the 1909 Act. Nimmer confidently asserts that by the 1950s the "right to 'publish' was understood to encompass the offering of copyrighted work to the public," and that "[m]id-twentieth century cases were in accord, as were later characterizations of prior law."[133] Nimmer cites a number of legal authorities for these assertions;[134] unfortunately, none of them is actually about the exclusive right to publish.[135] They each deal with the 1909 Act's other use of "publish"—the means by which a work is copyrighted (if published with notice) or falls immediately into the public domain (if published without notice).[136]

A. Does "Publish" Mean the Same Thing Throughout the 1909 Act?

As recounted above, the term "publish" did double duty under the 1909 Act: it defined both an essential requirement for copyright and one of its exclusive rights.[137] As argued above, in light of the very different purposes for which the 1909 Act used "publish," the term probably meant different things in the two different contexts. In one context, its purpose was to force authors out of the perpetual but private monopoly afforded by common-law copyright and into the limited but public (and hopefully more lucrative) monopoly afforded by federal copyright law.[138] In the other context, its purpose was to set the boundaries of that monopoly.[139]

There is also the language of the 1909 Act itself. The provision that governs initiation of copyright by publishing with notice, § 9, implies that offers for sale are *not* "publications." It has two

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133. *Id.* § 8.11[B][4][d] (footnotes omitted).

134. *See id.* § 8.11[B][4][d] nn.86–92.

135. *See id.* (citing, in order, Jeweler's Mercantile Agency v. Jewelers' Weekly Publ'g Co., 155 N.Y. 241, 254 (Ct. App. 1898); William A. Meier Glass Co. v. Anchor Hocking Glass Corp., 95 F. Supp. 264, 267 (W.D. Pa. 1951); Advisers, Inc. v. Wiesen-Hart, Inc., 238 F.2d 706 (6th Cir. 1956); Data Cash Sys., Inc. v. JS&A Grp., Inc., 628 F.2d 1038, 1042 (7th Cir. 1980); Roy Export Co. Establishment v. Columbia Broad. Sys., Inc., 672 F.2d 1095, 1102 n.14 (2d Cir. 1982); Bobbs-Merrill Co. v. Straus, 147 F. 15, 19 (2d Cir. 1906); Patterson v. Century Prods., Inc., 93 F.2d 489, 492 (2d Cir. 1937); 17 U.S.C. § 26 (1909) (repealed 1976)).

136. *See id.*

137. *See supra* Part II.A.

138. *See* 1 NIMMER & NIMMER, *supra* note 2, § 4.04. This section was not coauthored by Menell. *See id.*

139. *See* 2 NIMMER & NIMMER, *supra* note 2, § 8.01. This section was not coauthored by Menell. *See id.*

requirements. First, the author must publish with notice.[140] Second, each "such notice shall be affixed to each copy thereof published or offered for sale . . . ."[141] If "publications" included offers for sale, there would be no need to include "or offered for sale" here.

This is not to say with any confidence that "publish" does not or cannot mean the same thing in both of these contexts, nor does it mean that Congress did not or could not have assumed "publish" encompasses the right to offer to sell. It is only to say that these are unexamined assumptions. More importantly, they are assumptions about which reasonable minds can differ, and thus they are insufficient to sustain the certainty with which Nimmer in his treatise presents his conclusions.

B. Is the Use of "Publish" in the 1909 Act Truly Expansive?

In addition, Nimmer's authorities are not as on point as he thinks. True, they are consistent in stating that placing a work on sale or making it generally available to the public constitutes a "publication."[142] In none of those cases, however, is this broad pronouncement necessary to the holding. In *Jewelers' Mercantile*, the book in question was physically lent to subscribers.[143] *William A. Meier Glass* is probably better analyzed as a trade-secret case.[144] In *Advisers v. Wiesen-Hart*, the items of jewelry were considered published when they were physically delivered to retailers (as opposed to when they were physically delivered to customers), but that was in

140. Act of Mar. 4, 1909, Pub. L. No. 60-349, 35 Stat. 1078 (repealed 1976).

141. *Id.*

142. *See* 1 NIMMER & NIMMER, *supra* note 2, § 8.11[B][1].

143. 155 N.Y. 241, 254 (Ct. App. 1898). Thus, the court's rule that a book is published if it was "put within reach of the general public" was unnecessarily broad and could be considered dicta. *Id.* The court seemed to be at a loss how to analyze a lending of a book, and, instead of focusing on the physical dissemination of the book, it tried to shoehorn the transaction in terms of sale. *See id.* at 250–52.

144. 95 F. Supp. 264 (W.D. Pa. 1951). In *William A. Meier*, the plaintiff was attempting to enforce a "loop design" in its glassware under "a common property right" (which is never referred to as "common-law copyright"). *Id.* at 266. The plaintiff had not attempted to secure either copyright or a design patent in the "loop design." *Id.* at 267. It showed the glassware in question to defendant under an agreement of secrecy, but it then later displayed and offered for sale the glassware at a public trade show. *Id.* at 268. The opinion was silent as to whether any sales actually occurred, the court apparently believing the issue irrelevant. *See id.* Once the glassware was publicly displayed and offered for sale, the defendant was free to copy the "loop design." *Id.* Although the court described the plaintiff's right as "an exclusive property right [under common law] in designs for works of ornament or utility until publication," it then analyzed the issue under trade-secret principles: "In the absence of a statutory copyright or patent, no person has the monopoly in any idea, device or process, *which has not been effectively kept a secret*." *Id.* at 267–68 (emphasis added). Obviously, placing an item up for sale is not consistent with keeping it a secret.

the context of determining the date of publication from which the copyright term commences, not for determining whether a general publication had taken place.[145] In *Data Cash Systems*, the plaintiff had actually sold twenty-five hundred units of the electronic game that contained the copyrighted material.[146] When the plaintiff argued that there was no evidence that any of those customers actually played the game, the court dismissed this argument as "a proposition akin to the epistemological query after whether a falling tree makes a sound when there is no one to hear it."[147] The footnote of *Roy Export*, to which Nimmer cites, is unnecessary dicta.[148]

C. Is Greenbie v. Noble *Truly an Outlier?*

Only one legal authority discusses the exclusive right of publication under the 1909 Act. That legal authority, *Greenbie v. Noble*,[149] is contrary to Nimmer's thesis, and, while Nimmer offers no other cases to contradict *Greenbie*, he does all he can to devalue it.[150]

In *Greenbie*, the plaintiff, a writer, sued a book publisher and a book club for "publishing" a book that infringed the copyright in her book.[151] Although the defendants admitted to publishing and vending the books (but not to infringing the plaintiff's copyright), it became necessary for the court to establish precisely when and where the book club "published" and "vended" the book.[152] The court rejected on two grounds an argument that the book club had "vended" the book in each state where it offered its book for sale: (1) that mere offers for sale, without more, did not constitute "vending" (or, presumably,

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145. 238 F.2d 706, 707 (6th Cir. 1956). At least one court believed that the date of publication was a separate concept from whether a general publication occurred. *See* Patterson v. Century Prods., Inc., 93 F.2d 489, 492 (2d Cir. 1937). Confusingly, Nimmer cites to this case as though it held the opposite. *See* 2 NIMMER & NIMMER, *supra* note 2, § 8.11 n.91.

146. 628 F.2d 1038, 1042 (7th Cir. 1980).

147. *Id.*

148. 672 F.2d 1095, 1102 n.14 (2d Cir. 1982). The question in *Roy Export* was whether a single, restricted broadcast of a compilation of clips from different motion pictures constituted a publication that divested the compilation of its common-law copyright. *Id.* at 1100–04.

149. 151 F. Supp. 45 (S.D.N.Y. 1957).

150. 2 NIMMER & NIMMER, *supra* note 2, § 8.11 n.86.

151. *Greenbie*, 151 F. Supp. at 49.

152. *See id.* at 49, 62–63. The defendants had asserted the statute of limitations as a defense. *Id.* Under the 1909 Act (and contrary to current law), the statute of limitations was determined by the law of the state in which the action was brought, which was New York. *Id.* at 62. Unfortunately, as to the out-of-state book club, New York state law directed the court to use the statute of limitations of the state in which the cause of action arose. *Id.* at 63. To the court, this meant determining where the book club violated any of the plaintiff's exclusive rights. *See id.* Since the two relevant exclusive rights were the rights to publish and to vend, the court focused its attention on determining where the book club caused the publication and vending of the allegedly infringing books. *See id.* at 63–64.

publication); and (2) the offers, in any event, "emanated from" and "consummated in" the book club's home state.[153] As authority for the former, the court cited an 1834 English patent opinion—a peculiar choice.[154]

Nimmer calls *Greenbie* an outlier,[155] but it is the only opinion directly on point because it is the only one to address the scope of the publication and vending rights.[156] Nimmer criticizes the court for relying on such peculiar authority.[157] Admittedly, *Greenbie* is only one opinion—a trial-level one at that—and its reasoning is open to question.[158] But it is just as true that, the one time a court addressed whether offers to sell infringed copyright under the 1909 Act, that court answered in the negative.[159] That is one more legal authority than Nimmer has to support his assumption that the publication and vending rights include offers to sell.

V. CONCLUSION

This Article does not criticize Nimmer's view because it is wrong. He is not obviously or necessarily wrong, but he is not obviously or necessarily right either, and this is problematic. If his opinion were expressed in a law review article, that would be appropriate. Indeed, Menell's article, on which the revised section 8.11 is based, was a stimulating shot across the bow of those who had grown comfortable with the notion that the difficult proof of actual distribution was necessary to bring file sharing to heel. But *Nimmer on Copyright* is a treatise. Practitioners spend considerable sums of money[160] on treatises not to be treated to law review–like normative arguments, but rather to be told, with confidence, *what the law is*. As Melville Nimmer, the original author of *Nimmer on Copyright*, said in explaining what "impelled" him to draft the treatise in the first place:

> It is not just that I believed there to be *a need for a study in both depth and breadth of the manifold problems which confront lawyers and judges in copyright matters*. More than that, the inordinate number of "open questions" which pervade the law of copyright

153. *Id.* at 63–64.

154. *Id.* at 64 (citing Minter v. Williams, 111 Eng. Rep. 781 (K.B. 1835)).

155. 2 NIMMER & NIMMER, *supra* note 2, § 8.11 n.86.

156. *See supra* notes 121, 123–24.

157. 2 NIMMER & NIMMER, *supra* note 2, § 8.11 n.86.

158. *Id.*

159. *Greenbie*, 151 F. Supp. at 63–64.

160. The Author's firm pays about $200 a month for the privilege of having electronic access to *Nimmer on Copyright*. That is a tidy sum of money. The Author's criticism notwithstanding, it is still money very well spent.

> offer both a challenge and a charm to this area of the law which is almost, if not entirely, unique.[161]

The revised section 8.11 of *Nimmer on Copyright* no longer says what the law is. If it did, it would present Menell's revelations as merely one piece of a difficult puzzle. It would acknowledge the considerable body of case law that had already developed on the subject, rather than brushing them aside as sub-"optimal."[162] It would not pretend that there are no other reasonable points of view. Instead, it describes a clearly unsettled area of the law as settled. In its rush to settle what is unsettled, section 8.11 overleaps at least two crucial issues.[163] It would be of much more value to a judge or practitioner, when confronted with the thorny question of the scope of the distribution right, to learn the hard truth that the law is indeed unsettled, and to learn what the competing views are.[164] Where the author of the treatise has developed an opinion on an open question of law based on many years of wrestling with the problem, the author should by no means hide that opinion. Rather, he should state the opinion persuasively, but clearly marked as such.[165]

It may be that the revision to section 8.11 will become a kind of self-fulfilling authority. In the past, *Nimmer on Copyright* has been instrumental in correcting courts' misconceptions about points of copyright law.[166] Based on this reputation, it may be so authoritative that courts will not question its conclusions. It will be incumbent on practitioners faced with an uncritical presentation of section 8.11 to persuade a court to look behind the treatise to see that its foundations are not as solid as they appear. Courts are often perfectly willing to ignore Nimmer where his conclusions are not supported by the

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161. *Preface to the Original Edition* of 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, (1963) (emphasis added).

162. 2 NIMMER & NIMMER, *supra* note 2, § 8.11[C].

163. There are potentially others. For example, although the Second Supplementary Report is clear about the desire to combine the old rights to publish and to vend, Nimmer provides no evidence that any member of Congress agreed with the Register on this point or was even aware of the issue in 1965. *See* 2 NIMMER & NIMMER, *supra* note 2, § 8.11[B][2][c]. Experts and special interests may help draft bills, but it is Congress's intent that matters.

164. A good example is 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 24:67–134 (4th ed. 2012), where McCarthy takes up the difficult and unsettled subject of trademark dilution, which had been made even more difficult and unsettled by a recent revision of the controlling statute. McCarthy gives all legal authority and commentators their due in a neutral way before explaining his own opinion in sections conspicuously labeled "Author's Comment." *E.g., id.* §§ 24:67–68. Of course, Nimmer himself often does this. *See, e.g.*, 3 NIMMER & NIMMER, *supra* note 2, § 9.05[E].

165. 2 NIMMER & NIMMER, *supra* note 2, § 8.11[C].

166. Schrock v. Learning Curve Int'l, Inc., 586 F.3d 514, 520 n.4 (7th Cir. 2009) (citing Nimmer's criticism of Gracen v. Bradford Exchange, 698 F.2d 300 (7th Cir. 1983)).

controlling legal authority.[167] Hopefully this is an isolated incident that will be corrected by revising section 8.11 of *Nimmer on Copyright* to state what the law is. If this proves to be a trend, practitioners (and judges) will have to turn away from *Nimmer on Copyright*, and all would be poorer for it.

This is not a matter of taking sides. To the contrary, the scope of the distribution right in the Internet age is impenetrable and cries for congressional action, for neither "solution" to the problem is entirely satisfactory. One solution provides cover for what is clearly illegal activity, but the other solution ratchets up liability to unconscionable levels. One reasonable starting point might be for Congress to create a separate exclusive right to make the copyrighted work available for digital download,[168] but then to subject infringements of that right to significantly milder damages.[169] It stands to reason that merely offering a work for distribution is not nearly as damaging to the copyright owner as actually distributing it, but neither is it harmless. Therefore, under this approach, those who have merely made copyrighted digital content available to a network should be punished much less, but enough to deter such conduct in the future.

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167. *See* Broad. Music, Inc. v. Roger Miller Music, Inc., 396 F.3d 762, 777–78 (6th Cir. 2005) (rejecting Nimmer's conclusions because it was based on a faulty legal premise); Aurora World, Inc. v. TY Inc., 719 F. Supp. 2d 1115, 1131 n.38 (C.D. Cal. 2009) ("Although potentially authoritative in other jurisdictions, Nimmer does not appear to state the law of this circuit."); Specific Software Solutions, LLC v. Inst. of Workcomp Advisors, LLC, 615 F. Supp. 2d 708, 715 (M.D. Tenn. 2009) (rejecting Nimmer's view on a controversial subject); Order to Show Cause Re: Subject Matter Jurisdiction at 3, Kandy Kiss of Cal., Inc. v. Tex-Ellent, Inc., No. CV-10-9215 GAF (C.D. Cal. Jan. 24, 2011), ECF 17 (rejecting Nimmer in favor of out-of-circuit authority), *vacated on other grounds*, Order Vacating Order to Show Cause Re: Subject Matter Jurisdiction, Kandy Kiss of Cal., Inc. v. Tex-Ellent, Inc., No. CV-10-9215 GAF (C.D. Cal. Feb. 14, 2011), ECF 26.

168. This concept is hinted at elsewhere in the 1976 Act. *See* 17 U.S.C. § 115.

169. Arguably, the entire copyright damages regime requires recalibration in light of *Feltner v. Columbia Pictures Television, Inc.,* which gave juries the exclusive power to set statutory damage awards. *See* 523 U.S. 340 (1998).