



UNC
SCHOOL OF LAW

NORTH CAROLINA LAW REVIEW

Volume 85 | Number 3

Article 5

3-1-2007

Using the Implied License to Inject Common Sense into Digital Copyright

John S. Sieman

Follow this and additional works at: <http://scholarship.law.unc.edu/nclr>



Part of the [Law Commons](#)

Recommended Citation

John S. Sieman, *Using the Implied License to Inject Common Sense into Digital Copyright*, 85 N.C. L. REV. 885 (2007).
Available at: <http://scholarship.law.unc.edu/nclr/vol85/iss3/5>

This Comments is brought to you for free and open access by Carolina Law Scholarship Repository. It has been accepted for inclusion in North Carolina Law Review by an authorized administrator of Carolina Law Scholarship Repository. For more information, please contact law_repository@unc.edu.

Using the Implied License To Inject Common Sense into Digital Copyright

INTRODUCTION	885
I. OPT-IN AND OPT-OUT SYSTEMS.....	887
A. <i>Opt-in Systems Defined and Explained</i>	887
B. <i>Control of Copyrighted Works Is an Opt-in System</i>	887
C. <i>Opt-out Systems Defined and Explained</i>	888
D. <i>The Internet Is an Opt-out System</i>	889
E. <i>The Conflict</i>	891
II. DEVELOPMENT OF COPYRIGHT LAW	893
A. <i>Defining “Copy” in the Digital Environment</i>	893
B. <i>Removal of Statutory Formalities</i>	896
III. DEVELOPMENT OF THE IMPLIED LICENSE DOCTRINE	898
A. <i>Traditional Implied License Cases</i>	898
B. <i>Lexmark</i>	900
C. <i>State Contract Law, Meeting of the Minds, and Federal Preemption</i>	901
IV. <i>FIELD V. GOOGLE</i>	906
A. <i>Facts and Background</i>	906
B. <i>The Outcome</i>	909
1. <i>Knowledge and Use</i>	913
2. <i>Encouragement</i>	914
C. <i>A Broader Reading of Field</i>	915
V. WHY IMPLIED LICENSE INSTEAD OF FAIR USE?.....	916
A. <i>What’s Wrong with Fair Use?</i>	916
B. <i>How Does Implied License Avoid the Problems Plaguing Fair Use?</i>	921
C. <i>Application to New Technologies</i>	923
VI. THE IMPLIED LICENSE DOCTRINE AS A GAP-FILLER	925
A. <i>Browsing by Individuals</i>	925
B. <i>Indexing by Google</i>	927
C. <i>Translating by Google</i>	928
D. <i>Other Projects</i>	929
CONCLUSION	930

INTRODUCTION

Existing copyright law is not well-suited to handle the transmission of copyrighted works over the Internet. Generally

speaking, copyright law grants exclusive rights to copyright owners that others cannot exercise without authorization.¹ One of these exclusive rights is the right of reproduction, which revolves around the concept of a “copy.”² Thus, under copyright law, unauthorized copying of a copyrighted work creates a prima facie case for copyright infringement.³ At the same time, copying is a core function of computers and networks of computers.⁴ Neither individual computers nor the Internet can function without the ability to copy data within a computer or between networked computers, respectively.⁵ Because so much copying is required, and because asking for permission each time a copy is made would be terribly impractical, the only realistic way the Internet can work is the way it does: almost all copying is done without explicit permission. Even when copyright owners place their works online with the intent that others make use of those works, copyright law does not have a well-developed mechanism for facilitating such use.

When there is a fundamental conflict between the law and the workings of the online world, one of two things is bound to happen: either the law will change to meet the demands of the digital world, or the digital world will change to comply with the law. At present, neither of these changes has occurred to resolve the fundamental conflict between copyright law and the technology developed to make the Internet useful and powerful. Eventually, a catalyst will bring this problem into the spotlight. When that time comes, courts are likely to seek a way to resolve the conflict without destroying the utility of the Internet. Largely through the use of Google as a case study, this Comment analyzes how this gap between law and reality might be resolved by extending the implied license doctrine.

Part I defines both opt-in and opt-out systems, describes how copyright use is an opt-in system and the Internet is largely an opt-out system, and explains why there is a major conflict between these two systems. Part II reviews the development of copyright law’s definition of a “copy” in digital environments. Part III discusses the development of the implied license doctrine. Part IV analyzes *Field v. Google, Inc.*, a recent federal court case that applied the implied

1. See 17 U.S.C. § 106 (2000).

2. See *id.* “Copies” are defined in § 101.

3. See *id.* § 501(a).

4. In order for any computer, networked or not, to use data, it must have a working copy of the data in its main memory, or RAM. See, e.g., *RAM*, in *DICTIONARY OF COMPUTING* 406 (Valerie Illingworth & Ian Pyle eds., 4th ed. 1996).

5. *Id.*

license doctrine to the Internet context. Part V contrasts implied license with another existing copyright law doctrine, fair use, and explains why implied license works better. Part VI provides some examples of how a recent application of the implied license doctrine may be used to bridge the gaps between copyright law and current practices on the Internet.

I. OPT-IN AND OPT-OUT SYSTEMS

A. *Opt-in Systems Defined and Explained*

An opt-in system is one where an individual must choose to participate in the system.⁶ By default, an individual is not a part of the system and remains outside the system until choosing to become a part of it.⁷ An example of an opt-in system in the real world may help to illustrate the idea. Supermarket loyalty programs are opt-in systems because customers must sign up for the program and then display or scan their loyalty cards when they check out.

Opt-in systems have several important benefits. First, an opt-in system preserves personal autonomy—the individual is not included unless he wants to be. This allows him the freedom to balance the costs and benefits of joining the system and make the choice of whether to join on his own. Second, opt-in systems place the burden on the system itself to gain individual participation. This is valuable where the automatic inclusion of individuals would be intrusive or unfair, or where the system itself is valuable enough to make it worthwhile for people to take the time to opt in. In the supermarket loyalty cards example, an individual can choose for herself whether the savings in grocery costs outweigh her lost privacy if the store maintains a list of her purchases.

B. *Control of Copyrighted Works Is an Opt-in System*

The Copyright Act⁸ operates by first granting specific exclusive rights to copyright owners and then by enumerating a set of exceptions to those exclusive rights. Section 106 of the Copyright Act states that “the owner of copyright under this title has the exclusive rights to [exercise] and to authorize” others to exercise any of the enumerated rights, including the rights of reproduction, preparation

6. See, e.g., KIM MACPHERSON, PERMISSION BASED E-MAIL MARKETING THAT WORKS! 11 (2001) (defining opt-in in the context of e-mail marketing).

7. *Id.*

8. 17 U.S.C. §§ 101–1332.

of derivative works, distribution, public performance, and public display.⁹ Sections 107 through 122 limit the scope of the copyright owner's exclusive rights, many of which are the complex result of negotiation between commercial interests.¹⁰ If one acts without the permission of a copyright owner in violation of any of the exclusive rights, the copyright owner has a strong case for infringement.¹¹ This statute is what makes the system an opt-in system: without the copyright owner choosing (opting in) to allow others to exercise the exclusive rights granted under the statute, anyone exercising those rights is infringing the owner's copyright. In short, nobody can legally exercise the owner's exclusive rights without the owner's permission or a statutory exception,¹² making the use of copyrighted works an opt-in system.¹³

C. *Opt-out Systems Defined and Explained*

An opt-out system is one in which an individual must choose to be removed from participation in the system. By default, the individual is a part of the system and remains in the system until choosing to be removed. A well-known example of an opt-out system is the popular do-not-call registry.¹⁴ In this example, the default state is that telemarketers may call residential phone numbers, but the owners of those numbers may choose to be put on a list from which telemarketers cannot call. By placing themselves on this do-not-call registry, these people are opting out of the system which permits telemarketers to call them.

Like opt-in systems, opt-out systems also have important benefits. First, an opt-out system has the potential to be more valuable to the operator of the system than an opt-in system because it will include more people by default. Second, an opt-out system allows for the existence of systems that would otherwise be impracticable or prohibitively expensive. An opt-out system

9. *Id.* § 106.

10. *See id.* §§ 107–122; JESSICA LITMAN, DIGITAL COPYRIGHT 35–63 (2001) (explaining how copyright laws have been developed in the United States).

11. 17 U.S.C. § 501(a).

12. *See id.* § 106.

13. In a recent case, *Kahle v. Gonzales*, 474 F.3d 665 (9th Cir. 2007), the Ninth Circuit discusses copyright law historically as an opt-in regime that has been changed to an opt-out regime. *See id.* at 666–67. To distinguish, *Kahle's* argument is about whether copyright protection applies at all. This Comment addresses whether uses of works already protected by copyright are permitted. *See* Lessig Blog, *Kahle v. Ashcroft*, <http://www.lessig.org/blog/archives/003602.shtml> (Nov. 13, 2006, 14:43 PST).

14. *See* 47 U.S.C. § 227(c)(3).

accomplishes this by placing the burden on individuals to remove themselves from the system. This burden shift is also enormously valuable when individuals would not have enough incentive to join on their own. The next section details why the Internet can exist only as an opt-out system for these very reasons.

D. The Internet Is an Opt-out System

The Internet was designed to be an open system¹⁵ in the sense that any computer, using a set of standard communication protocols,¹⁶ can communicate with other networked computers without explicit permission. In practice, much of the Internet operates as an opt-out system. It is extraordinarily common for people to view a website without explicit permission from the website's owner. Google and other commercial search engines copy and index entire websites without anyone's permission.

Classifying opt-out systems based on their enforcement mechanism separates those systems into several categories. Some opt-out systems are enforced by technology, others are enforced by law, and still others are enforced only by community social norms.¹⁷ Each of these is examined in turn below.

Basic website accessibility on the World Wide Web is an example of an opt-out system enforced by technology. When someone creates a website, by default, others can access it.¹⁸ If a website owner wants to restrict access, she must take affirmative steps to block access; in other words, she must opt out. She might opt out and block unwanted access by Internet Protocol ("IP") address¹⁹ or by requiring a user account and/or password. In these opt-out systems, the

15. See, e.g., JACK GOLDSMITH & TIM WU, WHO CONTROLS THE INTERNET? 23 (2006).

16. This set of protocols is called TCP/IP. See *id.*; TCP/IP Reference Page, <http://www.protocols.com/pbook/tcpip1.htm> (last visited Feb. 17, 2007).

17. See LAWRENCE LESSIG, CODE AND OTHER LAWS OF CYBERSPACE 89 (2000) (explaining how these various forms of enforcement work in cyberspace).

18. After a person creates a website, anyone who knows the location of the site can go to it. The most common location information for a website is its uniform resource locator ("URL"). See, e.g., *URL*, in *DICTIONARY OF COMPUTING*, *supra* note 4, at 522.

19. An IP address is a set of four numbers used to represent a computer's location on the Internet. NetDictionary, <http://www.netdictionary.com/i.html> (last visited Feb. 17, 2007). A server can be programmed to exclude users with specific IP addresses or from within certain ranges of IP addresses. A useful analogy is the telephone system. If somebody has a phone number, then by default, you can call it. No permission is required. Someone might opt out of this by having the phone company block certain unwanted callers.

technology electronically enforces the decision to opt out.²⁰ For example, if a person does not know the password to a password-protected site, he cannot access it because the technology does not permit access.

A second type of opt-out system is one enforced by law. For example, the do-not-call registry is based on a specific statute's provision allowing individuals to opt out of receiving certain phone calls. Each person's decision to opt out can be enforced by a state attorney general or by private action.²¹ This system is not enforced by technology because telemarketers can still physically make calls to those on the list; they just do so at their own (legal) risk.

Google's decision whether to include individual web pages in its index and search results is based on a third type of opt-out system—one enforced only by community norms. Although it has stopped publishing an exact number, Google had indexed²² over eight billion web pages as of September 2005.²³ It did not ask permission to index any of these web pages. If a website is online and discoverable,²⁴ Google's robot²⁵ will make a copy of the page and add the page to its searchable index. If a website owner decides that she does not want Google to index her site, she must take an affirmative step to tell Google not to do so. She has several options. She can always make use of the opt-out system enforced by technology and block access to her site in other ways, but this is not a good solution if she wants her site to remain available to others. Instead, she can take advantage of Google's own opt-out system. She can leave instructions²⁶ on her

20. See LESSIG, *supra* note 17, at 20 (describing regulation of behavior in cyberspace through technology).

21. 47 U.S.C. § 227(c)(5), (f) (2000).

22. Indexing is the term used to describe how search engines collect data. Search engines have automated programs called "robots" (or "spiders") that visit as many websites as they can discover. For each one, the robot copies the page onto a computer owned by the search engine and creates an index of all of the data on the page. All of this data is then ordered so that when users search for the data, the search engine can find it efficiently. See *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828, 832 (2006).

23. See John Markoff, *How Many Pages in Google? Take a Guess*, N.Y. TIMES, Sept. 27, 2005, at C8.

24. A website is "discoverable" when there is chain of links leading to it, starting from a site that the search engine already knows about. See CHRIS SHERMAN & GARY PRICE, *THE INVISIBLE WEB: UNCOVERING INFORMATION SOURCES SEARCH ENGINES CAN'T SEE* 33 (2001).

25. Google's robot is appropriately named "Googlebot." See *How Google Crawls My Site*, <http://www.google.com/support/webmasters/bin/topic.py?topic=8843> (last visited Feb. 17, 2007).

26. These instructions must be given either using a file called robots.txt or using meta-tags. Both techniques are discussed later in this Comment. See *infra* notes 143–51 and accompanying text.

website telling the Google robot (“Googlebot”) not to index it.²⁷ Google tells its users that it will not index websites that opt out by using these measures, but this promise is not expressed in any contract or agreement and is not enforceable by technology.²⁸ The instructions serve merely to notify Google of the website owner’s preferences, not as a technological lock preventing Google from indexing the site. Accordingly, this system is not really enforced by anything other than Google’s self-restraint and compliance with the norms of the search industry.

The very value of the Internet is based on this kind of opt-out system. Compare the Google example with the supermarket loyalty card program. Unlike the supermarket loyalty card system, in which customers have a strong enough incentive to opt in and join the system, Google has no mechanism to create incentives for website owners to opt in to inclusion in Google’s search index. The transaction costs that Google would incur to secure permission to index every website would be overwhelming. The same is true for individual Internet users. The transaction costs in getting permission before viewing every website would be so high that people would be likely to stop visiting websites. An opt-in Internet would be virtually unusable.

E. *The Conflict*

As described above, copyright law is an opt-in system and the Internet operates on an opt-out basis. These differing systems overlap frequently, causing a great amount of conflict. Almost everything on the web is subject to copyright law,²⁹ and, at the same time, it is impossible to use the web without making copies. A user’s web browser will make at least two copies, one in RAM³⁰ and another on the hard disk in a cache folder.³¹ In addition, a search engine cannot index a page without making a copy. These electronic copies

27. See Removing My Content from the Google Index, <http://www.google.com/webmasters/remove.html> (last visited Feb. 17, 2007); Remove Part of Your Website, <http://www.google.com/support/webmasters/bin/answer.py?answer=35303> (last visited Feb. 17, 2007).

28. Remove Part of Your Website, *supra* note 27.

29. See *infra* Part II.A.

30. RAM stands for random access memory and is the main memory of a typical computer. See *RAM*, *supra* note 4; *Wells Fargo & Co. v. WhenU.com, Inc.*, 293 F. Supp. 2d 734, 748 (E.D. Mich. 2003).

31. Cached files are retained for efficiency purposes by web browsers. See *How and Why To Clear Your Cache*, <http://www.microsoft.com/windows/ie/ie6/using/howto/customizing/clearcache.mspx> (last visited Feb. 18, 2007) (explaining the role of the Internet Explorer browser’s cache).

are certainly copies in the everyday sense of the word, but the Copyright Act has a more specific definition of “copy,” which is explained in Part II.A. The extent of the conflict between the opt-in copyright system and the opt-out Internet depends on the extent that technological “copies” fall within the legal definition of “copy,” because the opt-out Internet does not require permission from copyright owners before a user can browse any of the copyrighted work the owner put online. If Google indexes the entire web at least once every month³²—which, according to a recent court case, it does—it may be committing copyright infringement over eight billion times a month.³³ Because a single instance of copyright infringement can result in up to \$150,000 in statutory damages without proof of any actual damages,³⁴ the potential damages in any particular month for Google’s infringements could easily exceed \$1,200 trillion, more than 100 times the U.S. national debt.³⁵

A natural response to the description of this conflict is disbelief that the entire population of Internet users might be acting in a potentially illegal manner. If this were such a huge problem one might expect that it would have been the central issue in a few significant cases by now. A major reason that it has not been litigated is the lack of incentive to sue and a lack of actual harm. However, with Google’s rapid growth and expanding pocketbook, many copyright owners are becoming irked that Google is profiting from unauthorized and uncompensated use of their works. As Google’s revenue continues to grow, inevitably more copyright owners will seek what they believe to be their “cut.” This change is already beginning to result in litigation against search engines.³⁶

As the issue is brought into focus through litigation, courts will probably avoid ruling in a way that would effectively cripple the Internet and send shock waves across the world. Instead, courts will probably seek to allow copyright owners to retain control over their

32. See *Field v. Google, Inc.*, 412 F. Supp. 2d 1106, 1124 (D. Nev. 2006) (stating that Google’s cache is kept for approximately fourteen to twenty days, implying that Google’s index is refreshed at least that often).

33. See Markoff, *supra* note 23.

34. See 17 U.S.C. § 504(c)(2) (2000).

35. See U.S. National Debt Clock, http://www.brillig.com/debt_clock (last visited Feb. 17, 2007) (stating that the debt is \$8.74 trillion as of February 17, 2007).

36. Google has been involved in several cases that were decided in early 2006. See, e.g., *Field*, 412 F. Supp. 2d at 1109 (accusing Google of infringing the plaintiff’s copyright by making cached copies of his copyrighted works available to Internet users); *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828, 831 (C.D. Cal. 2006) (accusing Google of infringing the plaintiff’s copyright by hosting thumbnail copies of its copyrighted images for use in Google Image Search).

exclusive rights without significantly damaging the utility of the web. There are two legal solutions that are most appealing: fair use³⁷ and implied license. Although fair use might work to some degree, it is a less effective solution than implied license.³⁸ The implied license is also a more natural fit to the problem. Common sense suggests that many copyright owners who put their work online are not ignorant of the nature of the Internet, and certain uses of their work should be expected.

While it is one thing to suggest that the sole act of putting copyrighted work online automatically grants an implied license to make certain uses of the work, it is a far more difficult problem to define the scope of that license. This Comment attempts to address this problem by answering two questions. Can the implied license doctrine allow certain uses of copyrighted works on the Internet? And if so, how?

II. DEVELOPMENT OF COPYRIGHT LAW

Two aspects of copyright law are important to understanding the scope of the problem described in Part I. The first has to do with how the Copyright Act and the cases interpreting it define “copy” in the digital environment. The second has to do with the broadening of works covered by copyright law, due largely to the removal of two statutory copyright formalities, registration and notice.

A. *Defining “Copy” in the Digital Environment*

The definition of “copy” is important because the term is used in the definition of two exclusive rights held by the copyright owner. The copyright owner is given the exclusive right “to reproduce the copyrighted work in copies or phonorecords”³⁹ and “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.”⁴⁰

Copies are defined in the Copyright Act as “material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”⁴¹ Thus, to be a copy, a work must be

37. *See infra* Part V.A.

38. *See infra* Part V.B.

39. 17 U.S.C. § 106.

40. *Id.*

41. *Id.* § 101.

“fixed.” The Act further provides that a “work is ‘fixed’ in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”⁴² Fixation is therefore a requirement for infringement of the copyright owner’s rights of reproduction and distribution.

Making copies (in the nonlegal sense of the word) is a crucial part of the digital environment. Neither individual computers nor the Internet can function without making copies. A simple example will help make this clear. Suppose a computer user seeks to view a website. The user types in a URL,⁴³ and his computer looks up the location of the server where the website is stored.⁴⁴ The user’s request is forwarded across the Internet, and the data is split into packets and sent back across the Internet to the user.⁴⁵ There is no single wire between the user and the server—a series of routers⁴⁶ transmit the data across the network, each one making an electronic copy of the data to send to the next destination. The Copyright Act specifically excludes these copies from copyright infringement lawsuits.⁴⁷ When the packets arrive and are assembled at the user’s computer, the computer will usually make at least two copies, one in RAM⁴⁸ for immediate use and another in a cache⁴⁹ folder on the hard disk for possible later use. All of this copying is fully automatic, and users need not be aware of it.

The crucial question as to whether computer-made electronic copies are “copies” as defined by the Copyright Act was not decided until 1993, in *MAI Systems Corp. v. Peak Computer*,⁵⁰ where the Ninth Circuit held that “the loading of software into the RAM creates a copy under the Copyright Act.”⁵¹ In *MAI*, the alleged infringing

42. *Id.*

43. See *URL*, *supra* note 18, at 522. URL, or uniform resource locator, consists of a string of characters specifying a protocol to use and the server to contact. For example, the URL for the University of North Carolina’s web page is <http://www.unc.edu>.

44. The domain name server (“DNS”) facilitates this lookup system. See, e.g., *Domain Name Server*, in *DICTIONARY OF COMPUTING*, *supra* note 4, at 163.

45. See, e.g., *Packet Switching*, in *DICTIONARY OF COMPUTING*, *supra* note 4, at 378.

46. See, e.g., *Router*, in *DICTIONARY OF COMPUTING*, *supra* note 4, at 457–58.

47. 17 U.S.C. § 512(a). Some routers also make cached copies so that the distribution of widely-requested files is more efficient. These copies are also immune from copyright infringement lawsuits. *Id.* § 512(b).

48. See *supra* note 30.

49. See *supra* note 31.

50. 991 F.2d 511 (9th Cir. 1993).

51. *Id.* at 519.

party merely turned on a computer to repair it.⁵² By turning on the computer, the copyrighted operating system software was loaded from the hard disk into RAM.⁵³ Since Peak was not a licensed user of the operating system, the copying constituted infringement.⁵⁴ The court noted that the fixation requirement was met when Peak “load[ed] the software into RAM and [was] then able to view the system error log and diagnose the problem with the computer.”⁵⁵

MAI was followed by a series of cases agreeing that a copy made from another medium into RAM constitutes copying for copyright infringement purposes.⁵⁶ In 1998, Congress intervened by enacting the Computer Maintenance Competition Assurance Act,⁵⁷ which permits individual computer owners to have their computers repaired by third parties using copyrighted software.⁵⁸ By softening the result in *MAI* with a specific exception for *MAI*-type facts, Congress reinforced the underlying principle that RAM copies are sufficiently fixed to constitute a “copy” under the Copyright Act.

While this interpretation of fixation has been fairly entrenched in the law with respect to end users, one circuit recently chose to carve out an exception to the general principle as applied to Internet Service Providers (“ISPs”).⁵⁹ In *CoStar Group, Inc. v. LoopNet, Inc.*,⁶⁰ the Fourth Circuit held that temporary electronic copies made by ISPs in the process of passively and indifferently transmitting data to customers were not “fixed” in the sense of existing for more than transitory duration, and as a result, the ISP could not be liable under the Copyright Act for direct infringement.⁶¹ The court reasoned that although data was downloaded (and, therefore, copied) to the owner’s computer in the process of transmitting the data, the

52. *See id.* at 518.

53. *See id.*

54. *See id.* (“In the absence of ownership of the copyright or express permission by license, [copying] constitute[s] copyright infringement.”).

55. *Id.*

56. *See, e.g., In re Indep. Serv. Orgs. Antitrust Litig.*, 910 F. Supp. 1537, 1541 (D. Kan. 1995) (listing four cases that match the holding in *MAI*).

57. Digital Millennium Copyright Act, Pub. L. No. 105-304, §§ 301–02, 112 Stat. 2860, 2886–87 (1998) (codified at 17 U.S.C. § 117(c) (2000)).

58. *See* 2 MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8.08[D][1] (2006).

59. Examples of ISPs are businesses like cable companies providing cable modem service, other companies providing DSL service, or universities providing network access to their students. *See, e.g., ISP*, in *DICTIONARY OF COMPUTING*, *supra* note 4, at 276–77 (“ISPs are usually commercial companies. They often provide e-mail and other information services as part of the service contract.”).

60. 373 F.3d 544 (4th Cir. 2004).

61. *Id.* at 551.

downloading was “a temporary, automatic response to the user’s request, and the entire system function[ed] solely to transmit the user’s data to the Internet.”⁶² Though this may at first glance appear to soften the *MAI* holding with respect to fixation in a computer’s RAM, the court carefully distinguished the situation for ISPs from the situation for individual users. The court warned, “We do not hold that a computer owner who downloads copyrighted software onto a computer cannot infringe the software’s copyright.”⁶³ By focusing on the fact that an ISP is indifferent to the data that it passes along to users, the court shifted responsibility onto those who are interested in what the data is—the users who requested it.

Once an individual computer owner receives the data she requested, the data serves the purpose the individual computer owner intended, making the copying more than merely transitory.⁶⁴ The court then defines “transitory duration” (which negates fixation) in both quantitative and qualitative terms: “It is quantitative insofar as it describes the period during which the function occurs, and it is qualitative in the sense that it describes the status of transition.”⁶⁵

Because the user’s desired use for any data copied into RAM, or any other device, is far different from the ISP’s, a user’s copy is far less likely to be “transitory” under the qualitative standard, even if the ISP and the end user store a copy for the same quantitative time period. Therefore, even for technologically similar copying, an end user might be making a “copy” for infringement purposes while the ISP does not. *CoStar* does not soften *MAI* for end users at all. Instead, it strengthens the *MAI* holding by shifting responsibility to those with a qualitatively greater interest in the data transmitted.

B. Removal of Statutory Formalities

Copyright protection in this country began as a voluntary system.⁶⁶ In order to obtain copyright protection, authors of creative works were required to take certain steps, often referred to as “formalities.”⁶⁷ For instance, authors needed to put a copyright notice on any published work, or publication would result in

62. *Id.*

63. *Id.*

64. *Id.*

65. *Id.*

66. See *Kahle v. Ashcroft*, No. C-04-1127 MMC, 2004 U.S. Dist. LEXIS 24090, at *9–10 (N.D. Cal. Nov. 19, 2004).

67. *Id.*

forfeiture of the work to the public domain.⁶⁸ In addition, authors had to register their work with the United States Copyright Office.⁶⁹ After registering their works under the old system, owners of copyrights received an automatic initial term of protection after registration, followed by a renewal term if requested by the author.⁷⁰

Under the current laws, these formalities have all been removed. In 1989, Congress did away with the notice requirement in compliance with the Berne Convention Act,⁷¹ which eliminated the need for formalities.⁷² The registration requirement is no longer a prerequisite to copyright protection.⁷³ Finally, renewal terms became automatic instead of optional in 1992 with the passage of the Copyright Renewal Act.⁷⁴ Today, the United States has a copyright system where any work containing a certain minimal amount of creativity⁷⁵ automatically receives copyright protection from the moment it is fixed,⁷⁶ extending through an automatic term of at least seventy years.⁷⁷ An author cannot decline copyright protection, and it is not clear if an author can put a work in the public domain should he wish to do so.⁷⁸ The closest he might be able to get a copyrighted work to public domain status is to grant everyone in the world a nonexclusive irrevocable license.⁷⁹

Looking both at the broad definition of “copy” and at the removal of copyright formalities, the scope of the problem becomes clearer. The number of works subject to copyright is enormous and

68. Act of Mar. 4, 1909, ch. 320, 35 Stat. 1077 (codified as amended at 17 U.S.C. § 9 (1982)) (repealed 1988).

69. See CRAIG JOYCE ET AL., COPYRIGHT LAW 411 (7th ed. 2006).

70. See *id.* at 323.

71. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (codified as amended in scattered sections of 17 U.S.C.).

72. See 17 U.S.C. § 401(a) (2000) (stating that “a notice of copyright . . . may” be used, but is not required).

73. See *id.* § 408(a) (stating that “registration is not a condition of copyright protection”).

74. See *id.* § 304(a) (listing certain older works in which renewal terms vest automatically); *id.* § 302 (creating one single term for works created after 1977).

75. See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 346 (1991).

76. Works are protected from the moment they are fixed in “any tangible medium of expression.” 17 U.S.C. § 102(a).

77. See Lolly Gasaway, When U.S. Works Pass into the Public Domain, <http://www.unc.edu/~unclng/public-d.htm> (last visited Mar. 2, 2007).

78. See, e.g., LAWRENCE LESSIG, FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY 135 (2004).

79. Even an “irrevocable” license may be subject to termination under 17 U.S.C. § 203(a)(5). Also, a public domain (“PD”) donation as a contract would be without consideration.

growing rapidly. Much of this work is put on the Internet, where it is literally impossible for end users to view or otherwise utilize it without making a “copy.” With so many people accessing (and therefore copying) so much copyrighted work online, there needs to be a legal mechanism that explains how and when this is permitted.

III. DEVELOPMENT OF THE IMPLIED LICENSE DOCTRINE

Copyright owners are free to assign or license their rights to others. Section 204 of the Copyright Act imposes a writing requirement for transfers of copyright ownership.⁸⁰ A “transfer of copyright ownership” is defined as including “assignment” and “exclusive license,” but “not . . . a nonexclusive license.”⁸¹ Nonexclusive licenses do not have to be in writing; they “may therefore be granted orally, or may even be implied from conduct.”⁸² The application of the applied license doctrine is discussed in the next section.

A. *Traditional Implied License Cases*

Often, parties simply do not think about copyright before entering into agreements. The leading case for implied copyright licenses is a good example. In *Effects Associates, Inc. v. Cohen*,⁸³ one party orally agreed to create special effects for a movie.⁸⁴ The special effects were made and included in the movie, and after a monetary dispute, the party who created the copyrighted special effects sued the requesting party for copyright infringement.⁸⁵ The creating party owned the copyright and only turned over particular copies of the special effects shots for the movie; it did not give the requesting party the right to copy and distribute the work.⁸⁶ The implied license doctrine was used here as it is traditionally used: to insert some common sense into the dispute. The work was obviously created for the specific purpose for which it was actually used (creation and distribution of a movie) and copyright law should not undermine the clearly manifested intent of both parties. By allowing the law to imply that the requesting party is licensed to use the work as

80. 17 U.S.C. § 204(a).

81. *Id.* § 101.

82. 3 NIMMER & NIMMER, *supra* note 58, § 10.03[A][7].

83. 908 F.2d 555 (9th Cir. 1990).

84. *Id.* at 555.

85. *Id.*

86. *Id.*

intended, the implied license doctrine functioned to eliminate the gap between the law and the reality of the situation.

Courts have treated *Effects Associates* as creating a three-part test to determine when a nonexclusive license might be implied. As restated in a later case,

Under the *Effects Associates* test, an “implied nonexclusive license” for use of an otherwise copyright protected work is created “when (1) a person (the licensee) requests the creation of a work, (2) the creator (the licensor) makes that particular work and delivers it to the licensee who requested it, and (3) the licensor intends that the licensee copy and distribute his work.”⁸⁷

Other circuits have followed the Ninth Circuit’s *Effects Associates* rule,⁸⁸ some with a particular focus on intent.⁸⁹ The rule can be summarized as requiring (1) a request that a work be made; (2) creation and delivery of that work; and (3) intent that the work be copied and distributed.

This formulation of the implied license test seems particularly well suited for situations in which the parties could have structured a deal under the work-for-hire doctrine,⁹⁰ but for some reason did not. In other words, when one party requests that another create copyrighted work, either the requesting party or the creating party could own the copyright. If the work-for-hire doctrine applies, the requesting party owns the copyright.⁹¹ If it does not, the requesting party owns only the particular material object in which a copy is embodied, and the creator retains the copyright. Therefore, without

87. *Nelson-Salabes, Inc. v. Morningside Dev.*, 284 F.3d 505, 514 (4th Cir. 2002) (describing the test from *Effects Associates*).

88. *See, e.g., Atkins v. Fischer*, 331 F.3d 988, 990–92 (D.C. Cir. 2003); *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 776 (7th Cir. 1996).

89. *See, e.g., John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 322 F.3d 26, 40 (1st Cir. 2003) (“The touchstone for finding an implied license . . . is intent.”); *Nelson-Salabes, Inc.*, 284 F.3d at 515 (calling intent “the determinative question”); *Johnson v. Jones*, 149 F.3d 494, 502 (6th Cir. 1998) (“Without intent, there can be no implied license.”).

90. For any “work made for hire” as defined in 17 U.S.C. § 101, “the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.” 17 U.S.C. § 201 (2000). Thus, when the work-for-hire doctrine applies, copyright of a work belongs to the hiring party.

91. *Id.* § 201.

the implied license doctrine, the recipient of the work cannot copy or distribute it⁹² because she does not own the copyright.⁹³

B. Lexmark

Conduct that can imply a copyright license has, until recently,⁹⁴ been limited to cases in which there is direct dealing between just a few parties, as in *Effects Associates*. A recent Sixth Circuit case indicated, however, that the doctrine might apply to very large classes of people as well. In *Lexmark International, Inc. v. Static Control Components, Inc.*,⁹⁵ printer and ink manufacturer Lexmark sued Static Control Components (“SCC”) under the Digital Millennium Copyright Act for selling chips that allowed third-party ink cartridge remanufacturers to refill Lexmark “Prebate” cartridges for use in Lexmark printers.⁹⁶ The majority found in SCC’s favor, but Judge Feikens, dissenting in part, reasoned that the implied license doctrine would *not* have given printer owners an implied license covering the use of Lexmark’s copyrighted Toner Loading Program (“TLP”) after refilling the “Prebate” ink cartridge because the shrinkwrap license explicitly stated that customers must return those cartridges after the first use.⁹⁷ He then revisited the idea of the implied license and stated that even though the majority did not use the words “implied license,” he believed that the idea of an implied license was implicit in its opinion.⁹⁸ He argued that each purchaser of a Lexmark printer is given “an implied license to use the [software that controls the printer] for the life of that printer.”⁹⁹

Although Judge Feikens’s statements were not in the majority opinion, because he did not explain the elements of an implied license or cite any case that used one, his analysis might be instructive as to how judges might apply the implied license doctrine in cases involving nontraditional circumstances. He would have limited the scope of any implied license for use of the TLP based on an express license

92. *See id.* § 106(3).

93. *See id.* § 202 (“Transfer of ownership of any material object, including the copy or phonorecord in which the work is first fixed, does not of itself convey any rights in the copyrighted work embodied in the object; nor, in the absence of an agreement, does transfer of ownership of a copyright or of any exclusive rights under a copyright convey property rights in any material object.”).

94. *See infra* Part IV.

95. 387 F.3d 522 (6th Cir. 2004).

96. *Id.* at 522, 529.

97. *Id.* at 563 (Feikens, J., concurring in part and dissenting in part).

98. *Id.*

99. *Id.* at 564.

(the shrinkwrap license), while allowing the license for the software controlling the printer to last for the life of the printer.¹⁰⁰ Thus, Judge Feikens's focus on the terms of the express shrinkwrap license, combined with the common sense idea that people should be expected to be able to use the printers they buy, appears to create a focus on the intent of the parties as evidenced by their contractual dealings and marketplace norms.

Judge Feikens's version of the implied license differs significantly in structure and effect from the three-part test in *Effects Associates*. It seems that he would essentially ignore the first prong, the request that the work be created, and the second prong, fulfillment and delivery of the requested work. While there was still delivery of a printer to a customer, it was not requested in advance by the customer. Only the third prong would be clearly relevant in his application, reinforcing the argument that the third is the most important prong. This third prong of *Effects Associates*, whether the licensor intends that the work be copied and distributed, is really what aligns the implied license doctrine with common sense. By looking at the intent of the licensor, courts can prevent the situation where one party uses copyright law to block a transaction that was clearly intended by the parties, which is especially important when the parties do not know anything about copyright when they enter into the transaction.

The application suggested by Judge Feikens's opinion in *Lexmark* would have been a small step toward modifying the *Effects Associates* test to allow it to apply to parties whose dealings are not as direct and personal as those contemplated in *Effects Associates*. By removing the first two prongs and focusing on intent of the licensor, the implied license doctrine might function better in situations in which the parties are not involved in direct person-to-person transactions. For instance, this third-prong-only version would permit Lexmark's many customers to receive an implied license from Lexmark, even though none of them requested that Lexmark make anything at all.

C. *State Contract Law, Meeting of the Minds, and Federal Preemption*

A summary of current law involving the implied license doctrine would be incomplete without a look at the relation between state contract law and federal copyright law, and a discussion of which law

100. *Id.*

applies to implied copyright licenses. For example, the precedential value of a Ninth Circuit implied license case in the Second Circuit depends largely on whether the circuit courts are applying federal law or state law. If a Ninth Circuit decision relies heavily on California state law, for instance, a district court in New York would give the decision less weight. On the other hand, if a Ninth Circuit decision relies on federal copyright law, a district court in New York could give the decision more consideration.

The implied license doctrine arises by implication from the copyright statute,¹⁰¹ making federal copyright law appear to be a reasonable choice of law. However, the implied license acts in a similar manner to an implied contract, suggesting a role for state law. This exact question was raised in *Foad Consulting Group, Inc. v. Musil Govan Azzalino*,¹⁰² in which the Ninth Circuit began its opinion: "In this copyright case, we must decide an issue unaddressed by our prior decisions: Which law, state or federal, governs the creation of an implied, nonexclusive copyright license?"¹⁰³ *Foad* was the first case to address this question. Unfortunately, it did little to clarify the situation. The majority held that for the question of whether an implied license can be granted at all, federal law provides the answer, but for determining whether an implied license has actually been granted, state law applies.¹⁰⁴

In *Foad*, the preliminary issue decided was whether the court should apply California's parol evidence rule or federal common law.¹⁰⁵ In deciding to apply state law, the majority first stated the following general rule: "Where the Copyright Act does not address an issue, we turn to state law to resolve the matter, so long as state law does not otherwise conflict with the Copyright Act."¹⁰⁶ Applying this principle, the court considered whether the state parol evidence rules in California conflict with copyright law or policy at the federal level, and concluded that there was no conflict.¹⁰⁷ The court's reasoning was that implied licenses do not require a writing at all, so there is no reason to think that federal law would look only within the four corners of the contract document to find an implied license.¹⁰⁸ Accordingly, the use of state law for determining whether to admit

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

102. 270 F.3d 821 (9th Cir. 2001).

103. *Id.* at 823–24.

104. *Id.* at 824.

105. *Id.* at 826.

106. *Id.* at 827.

107. *Id.* at 828.

108. *Id.*

parol evidence to aid in interpretation of a contract that one party says grants an implied license does not present any conflict with federal copyright law or the underlying policy.¹⁰⁹

The problems with the majority opinion were made clear by Judge Kozinski (who wrote the *Effects Associates* opinion) in his concurrence in *Foad*. After admonishing the majority for deciding “a difficult question that bears some analysis” without the benefit of briefing or even argument in the court below, he stated that he would have liked to have seen an explanation of the majority’s conclusion that state law should apply.¹¹⁰ Kozinski explained his confusion as follows:

As best I can tell, the majority assumes that anything that is called a contract—including an implied contract—must be governed by state law. But not every implied contract is, in fact, a contract. Certainly, *some* implied contracts are governed by state law. Those contracts really *are* contracts; they are actual agreements between parties, albeit imperfectly articulated. The cases on which the majority relies all involve this type of contract.

But there is another type of implied contract, one that is “created otherwise than by assent and without any words or conduct that are interpreted as promissory.” Such an implied contract is not a contract at all; it is a legal obligation the law imposes between certain parties where there is no actual agreement between them. If the implied contract that gives rise to the nonexclusive license discussed in *Effects Associates* is this kind of contract, then it has nothing at all to do with contract law. Rather, it is an incident of the copyright and is therefore governed by federal law.¹¹¹

Because Judge Kozinski viewed the decision he wrote in *Effects Associates* as clearly implying the creation of federal law, he would have applied federal law in *Foad* instead.¹¹² In addition, he pointed out numerous flaws¹¹³ in the majority’s application of state law, an

109. *Id.*

110. *Id.* at 832 (Kozinski, J., concurring).

111. *Id.* (citation omitted).

112. *Id.* at 833.

113. First, claiming it was applying state law, the majority inferred an implied license from the “absence of a contrary agreement” in the terms of the contract without citing any state law authority for that type of inference. *Id.* Second, “the majority’s conclusion that an indemnification clause creates a presumption that the indemnified-for act is authorized is almost certainly inconsistent with state law.” *Id.* Third, it does not make sense to

application that he argued “makes about as much sense as calculating how high is up.”¹¹⁴ After poking holes in the majority’s analysis, Kozinski stated that in other cases in which the choice of parol evidence rules might be relevant (which he said in this case it is not), the preemption analysis needs to provide “certainty and predictability” in the law governing copyright transfers in accordance with the policy underlying federal copyright law.¹¹⁵ Kozinski concluded by warning that he “can only hope that future courts will not give undue deference to the majority’s answer to a question that was neither posed by the parties nor presented by the facts of the case before us.”¹¹⁶

The effect of *Foad* remains to be seen. A handful of cases have cited *Foad* for the proposition that state law applies in determining whether or not an implied license exists.¹¹⁷ One case citing *Foad* noted the conflict between the majority opinion and Judge Kozinski’s concurrence, and decided not to address it.¹¹⁸ The analysis of cases that deal with the use of state contract law in implied contract situations without the guidance of *Foad* is even more confusing. Sometimes courts seem to apply state law for procedural convenience only. For example, one case applied state law only because the district court below also did—at no point did the parties contest the application of state law.¹¹⁹

Amongst the other cases that appear to apply state contract-like principles, two cases are often cited. First, in *Allen-Myland, Inc. v. International Business Machines Corp.*,¹²⁰ the court stated that implied licenses can result only from the parties’ objective conduct, from which a reasonable person would understand that the parties have reached an agreement, and never from one party’s “unilateral

consider whether a supposed already-existing implied license under the contract terms would be defeated by parol evidence; instead, extrinsic evidence is relevant only to determine whether there is an implied license to begin with. *See id.* at 834. Fourth, the majority does not cite the Copyright Act’s preemption provision, which at best makes the preemption analysis “incomplete.” *See id.*

114. *Id.* at 833.

115. *Id.* at 834.

116. *Id.*

117. *See, e.g.,* Scholastic Entm’t, Inc. v. Fox Entm’t Group, Inc., 336 F.3d 982, 988 (9th Cir. 2003); Warren v. Fox Family Worldwide, Inc., 328 F.3d 1136, 1142 (9th Cir. 2003); Tim Vining Real Estate Appraiser and Consultants, Inc. v. Clark Jennings & Assocs., No. CV-04-3110-RHW, 2005 U.S. Dist. LEXIS 20832, at *7–8 (E.D. Wash. June 23, 2005).

118. *See* John G. Danielson, Inc. v. Winchester-Conant Props., Inc., 322 F.3d 26, 41 n.6 (1st Cir. 2003).

119. Carson v. Dynegy, Inc., 344 F.3d 446, 452 (5th Cir. 2003).

120. 746 F. Supp. 520 (E.D. Pa. 1990).

expectations,” unless those unilateral expectations were purposely induced by “unscrupulous conduct of the other party.”¹²¹ This principle has its roots in *De Forest Radio Telephone Co. v. United States*,¹²² a 1927 patent case in which the Court held that an implied license may exist where “[a]ny language used by the owner of the patent, or any conduct on his part exhibited to another from which that other may properly infer that the owner consents to his use”¹²³ Second, in *N.A.D.A. Services Corp. v. Business Data of Virginia, Inc.*,¹²⁴ a district court held that “[t]he creation of an implied license, as in the creation of any implied contract, requires a meeting of the minds,” without explaining why, without citing a single case, and without stating whether it was applying state law or not.¹²⁵

Modern courts that use state contract-like language, as is used in *Allen-Myland* and in *N.A.D.A.*, cite these two cases and others that followed them.¹²⁶ When cases involving the applicability of implied licenses do not even mention if they are applying state or federal law, and the cases they cite are all federal cases which themselves do not clearly apply state or federal law, it becomes very difficult to determine what the court is doing. The court could either be applying its own state law without saying so, or creating federal common law. Unfortunately, the only analysis of this issue currently comes from *Foad*, which, as Judge Kozinski wrote, is riddled with problems.¹²⁷

In the future, courts may follow *Foad* and find a role for state law, or they may follow Judge Kozinski’s view of his own opinion in *Effects Associates* as indicated in his *Foad* concurrence. In writing the *Effects Associates* opinion, Judge Kozinski relied heavily on another case¹²⁸ that seemed to deal with implied licenses as a doctrine stemming from copyright law without discussing the role of state law

121. *Id.* at 549 (quoting *Medeco Sec. Locks, Inc. v. Lock Tech. Corp.*, 199 U.S.P.Q. (BNA) 519, 524 (S.D.N.Y. 1976)).

122. 273 U.S. 236 (1927).

123. *Id.* at 241.

124. 651 F. Supp. 44 (E.D. Va. 1986).

125. *Id.* at 49.

126. *See, e.g.*, *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 317–18 (S.D.N.Y. 2000). In 2004, the same court, following *SHL Imaging*, refused to find an implied license where there was no meeting of the minds. *Ulloa v. Universal Music & Video Distrib. Corp.*, 303 F. Supp. 2d 409, 416–17 (S.D.N.Y. 2004). One year later, the same court again stated that in order to find that an implied license exists, the proponent of the license must show a meeting of the minds “as determined by contract law.” *Pavlica v. Behr*, 397 F. Supp. 2d 519, 526 (S.D.N.Y. 2005).

127. *Foad Consulting Group, Inc. v. Musil Govan Azzalino*, 270 F.3d 821, 833–34 (9th Cir. 2001) (Kozinski, J., concurring).

128. The case was *Oddo v. Ries*, 743 F.2d 630 (9th Cir. 1984). *See Foad*, 270 F.3d at 838 (Kozinski, J., concurring).

in implied licenses at all.¹²⁹ The broad appeal of *Effects Associates* and the reliance by other circuits on that case may be due to its departure from earlier cases that seemed grounded in state contract law principles.¹³⁰

At least one thing is clear about this federal preemption problem: it is not resolved. If a court takes up the difficult task of trying to provide clear answers, it should carefully consider how its decision will affect the applicability of the implied license doctrine and the ability of copyright law “to protect copyright holders in a comprehensive and uniform way.”¹³¹ With the ability of the Internet to make state borders invisible and seemingly meaningless, it will be hard to maintain uniformity without a federal standard.¹³² In addition, the ability of the implied license to operate in situations where parties deal with each other only indirectly through the Internet would be greatly hindered if a “meeting of the minds”-type requirement were imposed in those situations, as described in the next Part.

IV. *FIELD V. GOOGLE*

In order to take the implied license from its traditional interpretation in *Effects Associates* and apply it to an Internet context, even more stretching is needed than what Judge Feikens would have allowed in *Lexmark*. In January 2006, a federal district court in Nevada did just this in *Field v. Google, Inc.*,¹³³ and applied what appears to be an entirely new rule for determining whether an implied license exists.¹³⁴ This case raises a host of fascinating issues and new viewpoints relevant to this Comment.

A. *Facts and Background*

Among other services, Google provides a very popular Internet search engine that allows users to find information efficiently.¹³⁵ In order to make the vast number of web pages searchable, Google uses

129. Boryana Zeitz, Comment, “How High Is Up”: *Interstitial Dilemmas in Nonexclusive Copyright Licensing Cases in the Ninth Circuit*, 11 UCLA ENT. L. REV. 429, 442 (2004).

130. *Id.* at 442–43.

131. *Foley v. Luster*, 249 F.3d 1281, 1287 (11th Cir. 2001).

132. Zeitz, *supra* note 129, at 447–49 (considering thoroughly the development of a federal common law test).

133. 412 F. Supp. 2d 1106 (D. Nev. 2006).

134. *See infra* note 177 and accompanying text.

135. *Field*, 412 F. Supp. 2d at 1110.

its robot, called Googlebot, to index¹³⁶ pages automatically.¹³⁷ As Googlebot analyzes each web page to add it to Google's index, it makes a copy of that page and stores it as a cached copy of the page.¹³⁸ When a Google user performs a web search and the results of the search return a particular page, those search results also often include a link to the cached copy of the page that Google has stored.¹³⁹ A Google user can then click on the link to the cached page and Google will automatically send the cached copy to the user's browser.¹⁴⁰ Because Google's cached copy is a "copy" for copyright purposes,¹⁴¹ by traditional copyright analysis, Google is committing rampant copyright infringement through its caching program unless there is an exception, such as fair use, that applies. Until *Field*, however, Google had never been sued for this practice.¹⁴²

Perhaps in recognition of this conflict, Google attempts to respect the rights of copyright owners by providing an opt-out system¹⁴³ through which all website owners, regardless of the copyright status of the work on their site, can instruct Google not to search and cache their websites. Google even provides instructions on how to opt out on its website.¹⁴⁴ There are several ways that website owners can communicate to Google their desire to opt out of Google's index. First, using the Robot Exclusion Protocol, site owners can create a file called "robots.txt" that instructs search engines on what parts of the site to index.¹⁴⁵ This file can single out specific search engines by giving individualized instructions to that engine's robot (e.g., Google's Googlebot), and can single out specific directories and even specific file types on the site to be treated differently.¹⁴⁶ The robots.txt file can only instruct search engines

136. Indexing is the process of scanning through all of the data on a page and adding it to Google's index. The concept is similar to combing through the text of a normal book and compiling an index to include in the back of the book. See *supra* note 22.

137. *Field*, 412 F. Supp. 2d at 1110.

138. *Id.*

139. *Id.* at 1111.

140. *Id.*

141. See *supra* Part II.A.

142. *Field*, 412 F. Supp. 2d at 1111.

143. An opt-in system where Google contacts every website owner is not possible because the Internet is too big. *Id.* at 1112.

144. *Id.* These instructions are available from Google at <http://www.google.com/remove.html> (last visited Feb. 17, 2007) and also from The Web Robots Pages at <http://www.robotstxt.org/wc/exclusion.html> (last visited Feb. 17, 2007).

145. This protocol has been "widely recognized . . . as a standard for controlling automated access to Web pages since 1994." *Field*, 412 F. Supp. 2d at 1113.

146. See, e.g., Webmaster Help Center, [http://www.google.com/support/webmasters/bin/answer/py?answer=35301&topic=8459](http://www.google.com/support/webmasters/bin/answer.py?answer=35301&topic=8459) (last visited Feb. 17, 2007) (providing

whether or not to index the site; the robots.txt file cannot instruct robots on whether or not to cache the site. However, pages that are not in Google's index will not be accessible through cached links because they will never be included in search results; thus, the robots.txt file can effectively prevent caching by opting out of Google's index.

Second, using meta-tags,¹⁴⁷ site owners can include instructions on each individual page describing what uses Google and other search engines may make of the page.¹⁴⁸ Unlike the robots.txt approach, the use of meta-tags allows the owner of each page to specify separately whether the page should be indexed¹⁴⁹ and/or cached.¹⁵⁰ Meta-tags are embedded in each individual page, whereas robots.txt files must be stored on the root folder of the server on which the pages reside. Because website owners do not always have permission to write to this root folder, meta-tags are the better option for some individuals.¹⁵¹

Third, requests can be made directly to Google to remove pages from Google's index or cache.¹⁵² It is important to note that all three of these approaches—robots.txt, meta-tags, and direct requests—are *voluntary* on Google's part. There is no technological mechanism that prevents search engines like Google from indexing or caching sites, even if they are explicitly instructed not to do so.¹⁵³ Google chooses to be a "polite" search engine that respects the wishes of website owners. All three approaches are best characterized as putting Google on notice as to what the website owner intends

instructions for singling out specific directories and files for different treatment by Google's search engine).

147. As used here, meta-tags are segments of HTML code designed to be used by computers, not humans, and are not even shown to human users when the HTML is displayed in an ordinary browser. See, e.g., HTML Meta Element, http://www.w3schools.com/html/html_meta.asp (last visited Oct. 17, 2006).

148. *Field*, 412 F. Supp. 2d at 1112.

149. *Id.* A meta-tag preventing indexing by Googlebot only would look like this: `<META NAME="GOOGLEBOT" CONTENT="NOINDEX, NOFOLLOW">`.

150. *Id.* at 1112–13. A meta-tag preventing caching by Google only would look like this: `<META NAME="GOOGLEBOT" CONTENT="NOARCHIVE">`.

151. See, e.g., The Web Robots FAQ, <http://www.robotstxt.org/wc/faq.html#noindex> (last visited Mar. 2, 2007) ("Sometimes you cannot make a /robots.txt file, because you don't administer the entire server.").

152. *Field*, 412 F. Supp. 2d at 1113 n.5. Google also has an automatic removal system, located at <http://www.google.com/webmasters/remove.html> (last visited Feb. 17, 2007).

153. An analogy can make this clearer: suppose trick-or-treating children on Halloween come upon a box full of candy on someone's front porch that is accompanied by a sign that says, "Please take one piece only." The sign does not prevent a child from taking more, just like the robots.txt file does not prevent a search engine from downloading and indexing a website.

Google to do when it crawls the website. Whether this notice to Google has any legal force at all is extremely unclear and not previously litigated.

Blake Field, a Nevada attorney¹⁵⁴ and regular Google user,¹⁵⁵ noticed that this practice by Google might be a legal problem and “decided to manufacture” a copyright infringement claim against Google to try to make some money from Google’s caching practice.¹⁵⁶ He created fifty-one works,¹⁵⁷ registered copyrights in those works,¹⁵⁸ and put the works on a website that he created. He did not use any meta-tags, but he did include a robots.txt file that instructed all robots to crawl and index his entire site.¹⁵⁹ He waited for Google to automatically index his page, and once Google’s search results included a link to a cached copy of the page stored on Google’s server,¹⁶⁰ Field sued Google for copyright infringement. His amended claim sought over \$2.5 million in damages.¹⁶¹

B. *The Outcome*

The district court in Nevada rejected Field’s claim, finding that Google did not directly infringe Field’s copyright.¹⁶² Further, it held that even if Google had infringed, it could succeed on an implied

154. *Field*, 412 F. Supp. 2d at 1110.

155. *Id.* at 1113.

156. *Id.*

157. *Id.* at 1114.

158. *Id.* Registration is not a requirement for copyright protection, but it is a prerequisite for certain copyright infringement lawsuits. See 17 U.S.C. § 411 (2000).

159. *Field*, 412 F. Supp. 2d at 1114. Field did this because he wanted his site to be indexed by search engines and included in search results. *Id.* This is a puzzling choice by Field because Google will also crawl pages without any robots.txt file at all.

160. *Id.*

161. *Id.* at 1110.

162. *Id.* at 1115. Because Field did not allege any indirect (contributory or vicarious) infringement by Google, the court only had to decide if Google directly infringed Field’s copyright. *Id.* at 1114 n.8. The only infringement that Field alleged was the copy that was made when third-party Google users clicked on the “Cached” link from Google’s search results and the cached copy of Field’s work was sent to those users. *Id.* at 1115. The court specifically notes that “Field [did] *not* allege that Google committed infringement when its Googlebot, like an ordinary Internet user, made the initial copies of the Web pages containing his copyrighted works and store[d] those copies in the Google cache.” *Id.*

Copyright law requires “volitional conduct” by the defendant to reach a finding of direct infringement. *Id.* Because “it is the user, not Google, who creates and downloads a copy of the cached Web page,” and because Google acts in a “passive” manner only, “[t]he automated, non-volitional conduct by Google in response to a user’s request” is not direct copyright infringement. *Id.* The court does not suggest one way or another what the result would have been if Field had also alleged that Googlebot’s original copying during indexing was infringing. See *id.*

license defense or three other affirmative defenses:¹⁶³ estoppel,¹⁶⁴ fair use,¹⁶⁵ and § 512(b) safe harbor.¹⁶⁶ Although the implied license defense received less treatment in the opinion than any of the other four defenses, it may be the most important in terms of precedential value, as it is a step toward moving the implied license doctrine in a new direction.

Until this point, the mainstream implied license doctrine was still represented by the three-prong test from *Effects Associates*.¹⁶⁷ The greatest deviation so far from the *Effects Associates* test seems to be a dissenting opinion in *Lexmark* that would have effectively dropped the first two prongs from the *Effects Associates* test, leaving only the third prong, focused on the licensor's intent.¹⁶⁸ The district court in *Field* took a completely new approach from the one found in *Effects Associates*, effectively creating a new application for the implied license doctrine. The *Field* court cited *Effects Associates* only for the

163. *See id.* at 1115–23.

164. Google succeeded on the estoppel defense because: (1) Field knew that Google was offering the cached copies; (2) Google had a right to believe that Field intended Google to rely on his conduct; (3) Google did not know Field's true desire not to have his works cached; and (4) Google relied to its detriment on Field's failure to opt out. *Id.* at 1123; *see also* 4 NIMMER & NIMMER, *supra* note 58, § 13.07 (“Principles of estoppel applicable elsewhere in the law are equally applicable in copyright infringement actions.”).

165. Google succeeded on the fair use defense because the first and fourth fair use factors favored Google heavily, along with Google's good faith compared to Field's lack of good faith. *Field*, 412 F. Supp. 2d at 1123; *see also infra* notes 202–08 and accompanying text (explaining the concept of fair use). The court's comprehensive fair use analysis in this case deserves its own scholarly paper.

166. Google succeeded on the § 512(b) safe harbor defense for system caching because (1) Google's storage of cached pages for fourteen to twenty days qualifies as “intermediate and temporary storage of that material”; (2) the material that Field made available was transmitted to Google at Google's request; and (3) Google's caching of web pages is “an automat[ed] technical process . . . for the purpose of making the material available to users . . . who . . . request access to the material from” Google. *Field*, 412 F. Supp. 2d at 1124 (quoting 17 U.S.C. § 512(b)(1) (2000)); *see also* 3 NIMMER & NIMMER, *supra* note 58, § 12B.03[A] (“For [this provision] to apply, the material must be made available on an originating site, transmitted at the direction of another person through the system or network operated by or for the service provider to a different person, and stored through an automatic technical process so that users of the system or network who subsequently request access to the material from the originating site may obtain access to the material from the system or network.” (quoting the legislative history)).

The court's finding that fourteen to twenty days is “intermediate and temporary” is an interesting characterization. Google's cache of a website that remains unchanged indefinitely will also contain the exact same data indefinitely, and it does not make sense that the mere fact that Google rechecks every twenty days to see if anything has changed makes the cached copy anything less than permanent.

167. *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555 (9th Cir. 1990).

168. *See supra* Part III.B.

proposition that a license is a defense to copyright infringement.¹⁶⁹ Even though *Effects Associates* is considered the leading case for the definition of implied copyright licenses, the *Field* court failed to mention *Effects Associates* at all after this, and instead cited one of the leading implied license cases from the field of patent law, a 1927 Supreme Court case, for the definition of an implied license.¹⁷⁰ *Effects Associates* was decided by the Ninth Circuit, and is therefore binding on the district court in Nevada that decided *Field*. Nevertheless, the *Field* court seems to have chosen its citations carefully to reach its final result.

The court decided it needed a new starting point for defining the implied license test to better fit this situation. Citing *De Forest*,¹⁷¹ the *Field* court stated that a court may find an implied license exists where the copyright owner's conduct permits the other party to "properly infer" that the copyright owner has consented to the other party's use.¹⁷² The court continued to cite a pair of copyright cases from district courts in other circuits¹⁷³ for the proposition that a copyright owner's consent does not need to be manifested verbally, and can be inferred even in silence if the copyright owner knows of the use and encourages it.¹⁷⁴ Curiously, instead of citing any case from its own Ninth Circuit, the *Field* court chose to cite cases that had remarkably little to say about the implied license doctrine and did not even explicitly state what is required to raise a successful implied license defense.¹⁷⁵

169. *Field*, 412 F. Supp. 2d at 1115.

170. *See id.* at 1116 (citing *De Forest Radio Tel. Co. v. United States*, 273 U.S. 236 (1927)). The *De Forest* case was also discussed in this Comment's section on state law and federal preemption. *See supra* Part III.C.

171. *Field*, 412 F. Supp. 2d at 1116.

172. *Id.* (citing *De Forest*, 273 U.S. at 241).

173. The *Field* court cited both a New York district court case, *Keane Dealer Servs., Inc. v. Harts*, 968 F. Supp. 944 (S.D.N.Y. 1997), and a Michigan district court case, *Quinn v. City of Detroit*, 23 F. Supp. 2d 741 (E.D. Mich. 1998).

174. *Field*, 412 F. Supp. 2d at 1116.

175. *Keane* includes one eight-sentence paragraph on deciding whether or not there is an implied license, *Keane*, 968 F. Supp. at 947, and *Quinn* devotes a single seven-sentence paragraph to implied license. *Quinn*, 23 F. Supp. 2d at 749. Stranger still is that the proposition for which *Keane* is cited by *Field* is obtained by *Keane* from a Seventh Circuit case, *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 774-75 (7th Cir. 1996). In *Shaver*, the court discusses implied license in significantly more depth than in *Keane*, including an explanation of the *Effects Associates* test. *See Shaver*, 74 F.3d at 774-76. *Keane* cites only a brief part of the *Shaver* opinion, which does not include the *Effects Associates* test. *See Keane*, 968 F. Supp. at 947 (citing *Shaver*, 74 F.3d at 775).

Though seven or eight sentences can certainly be informative and descriptive of any legal doctrine, it is unusual that these cases were cited when there is much more written on implied licenses, especially from more authoritative courts. It almost appears

The *Field* court developed its implied license doctrine, in part, based on the language from *Keane Dealer Services, Inc. v. Harts*, which stated that consent given by “lack of objection” can create an implied license.¹⁷⁶ *Field* crafted this into a new two-part test for implied license. Under this test, an implied license is found when the copyright owner (1) “knows of the use” and (2) “encourages it.”¹⁷⁷ Although it is immediately clear that this test is different from and much broader than the traditional *Effects Associates* test,¹⁷⁸ the *Field* court further stretched the implied license doctrine by its fairly broad interpretations of both “knowledge” and “encouragement.”

Applying this new test to the facts before it, the court first noted that *Field* admitted he was aware of the mechanisms, which are well-known and highly publicized industry standards, of using “no-archive” meta-tags to communicate his preferences to Google; *Field* also knew that use of such a meta-tag would have conveyed his wishes to Google concerning the use of cached links to his pages.¹⁷⁹ With full knowledge of the ability to opt out of Google’s caching program, *Field* decided not to use this mechanism, leading Google to the conclusion that he had consented to allow access to his pages via Google’s “cached” links.¹⁸⁰ He chose not to opt out specifically because he believed, as a copyright owner, that it was not his burden to opt out of Google’s caching program; instead, he probably (and reasonably) thought that the opt-in nature of copyright law¹⁸¹ put the burden on Google to secure his permission. He thought Google was acting illegally in offering the cached copy of his work to its users. *Field*’s knowledge that Google would interpret his failure to opt out of the caching program as permission was the precise problem that his suit raised. *Field* probably asked himself: *why should I have to specifically tell Google not to violate my rights?*

If widely followed by other courts in the future, the *Field* court’s conclusion with regard to implied license may rival the importance of

that the *Field* court did some serious searching for implied license cases that did not mention the *Effects Associates* test. If this is the case, it might explain the odd selection of the non-Ninth Circuit court cases it cited.

176. *Keane*, 968 F. Supp. at 947 (citing *Shaver*, 74 F.3d at 775).

177. *Field*, 412 F. Supp. 2d at 1116.

178. Under this test, none of the *Effects Associates* prongs remain. Under the new *Field* test, not even the third prong related to the intent of the licensor, which the dissenting judge in *Lexmark* would have retained, remains. The new test, with the two prongs of knowledge and encouragement, is much better suited to the context of interactions where parties do not engage in direct, personal interactions.

179. *Field*, 412 F. Supp. 2d at 1116.

180. *Id.* at 1117.

181. See *supra* Part I.B.

the 1984 case, *Sony Corp. of America v. Universal City Studios, Inc.*,¹⁸² which established the legality of the sale of VCR-style recording devices.¹⁸³ First, it may rival *Sony* as one of the most important developments in the history of copyright law, in terms of its role in reconciling the nature of copyright law with the realities that technology imposes on it. Second, it may rival *Sony* in the amount of opposition the doctrine gains as it is applied to new technologies that do not yet exist. The *Field* court briefly summarized its findings and stated its conclusion:

Thus, with knowledge of how Google would use the copyrighted works he placed on those pages, and with knowledge that he could prevent such use, Field instead made a conscious decision to permit it. His conduct is reasonably interpreted as the grant of a license to Google for that use.¹⁸⁴

The significance of this holding is that for the first time a court has validated an opt-out system with respect to copyright by allowing failure to use a known opt-out system to result in an implied license. Unfortunately, the court's analysis explaining why it actually found an implied license is not clearly separated into the two prongs of knowledge of the use and encouragement of the use, making it difficult to determine how each prong was satisfied.

1. Knowledge and Use

According to the *Field* court, the first element of creating an implied license is that the copyright holder "knows of the use" of the copyrighted material.¹⁸⁵ The court found that Field knew (by his own admission) about the opt-out mechanism and that Google would copy his work if he failed to opt out, interpreting this as permission to copy the work.¹⁸⁶ This finding is noteworthy for a few reasons. First, because Field had no personal interaction with anyone at Google, it

182. 464 U.S. 417 (1984).

183. *Id.* at 442 (holding that "the sale of copying equipment . . . does not constitute contributory infringement if the product is . . . capable of substantial noninfringing uses").

184. *Field*, 412 F. Supp. 2d at 1116. This conclusion is supported by citing *Keane* again, this time for the proposition that a "copyright owner's knowledge of defendant's use coupled with owner's silence constituted an implied license." *Id.* (citing *Keane Dealer Servs. v. Harts*, 968 F. Supp. 944, 947 (S.D.N.Y. 1997)). Note, however, the difference in personal distance between the parties. In *Keane*, the parties actually worked together for the same employer creating the copyrighted software that was the subject of the copyright claim. *Keane*, 968 F. Supp. at 946. In *Field*, the parties did not know each other or directly interact at all until after Field filed his complaint. *Field*, 412 F. Supp. 2d at 1114.

185. *Field*, 412 F. Supp. 2d at 1116.

186. *Id.*

would have been extremely hard for him to know for sure how Google would interpret his failure to opt out. At the time Googlebot crawled Field's website, Google had no way of knowing what level of technical expertise Field possessed, and whether or not he knew the slightest thing about meta-tags. In addition, Field may not have known whether Google would interpret his failure to opt out as "permission" because Google may not believe it even *needs* permission, as suggested by its success on fair use and safe harbor defenses in this case.¹⁸⁷ In spite of these observations, it is a fair characterization to say that under the court's analysis, Field satisfied the knowledge requirement by knowing of Google's use of the opt-out system to determine what to cache and what not to cache.¹⁸⁸

2. Encouragement

The part of the opinion discussing the encouragement prong stated that because Field knew how to opt out and failed to do so, he "made a conscious decision to permit" Google to cache his web page.¹⁸⁹ This is a serious stretch of the word "encouragement" because Google had no idea what Field's state of mind was until his complaint was filed. To outside observers, Field did *absolutely nothing*. Google had no way of knowing whether Field specifically chose not to opt out or simply failed to for some other reason. All Google would have been able to know at the time was *whether* Field used meta-tags to opt out. Here, he did not, and Google would have had no idea *why* not. He might have forgotten; he might have tried to but used incorrect syntax; he might not have known how; he might have decided against it; or, as was the case here, he might have been trying to manufacture a lawsuit against Google. The point is that "encouragement" will be inferred from a copyright owner's actions. Despite the court's use of the phrase "conscious decision to permit" in defining "encouragement," a party does not need actual knowledge of a copyright owner's state of mind to satisfy the encouragement prong of the *Field* test.

Summing up, the two-part knowledge and encouragement test that *Field* purports to apply boils down to the following: where a copyright owner (like Field) knows about an opt-out system (like Google's cache) and purposely fails to opt out, an implied license is created. The burden to opt out is on the copyright owner—if he does

187. *See supra* notes 165–66.

188. *Field*, 412 F. Supp. 2d at 1116.

189. *Id.*

not, the use will be allowed by an implied license. To those who adhere to the traditional notion that copyright law should remain only an opt-in system, this approach would seem inherently wrong.

C. *A Broader Reading of Field*

How broad is this new implied license doctrine from *Field*? A major factor in how widely applicable *Field* may become is how courts will interpret the knowledge requirement. Here, *Field* knew of the opt-out system, but this was revealed only after the matter came before the court and *Field* admitted he knew about it. Perhaps recognizing that bad facts sometimes make bad law, and that crafting a new implied license test around a manufactured claim such as *Field*'s might result in a test that is limited in applicability, the *Field* court worked some possible wiggle room into the knowledge requirement. The court mentioned that the opt-out system was a widely known industry standard several times in the opinion, including once immediately before stating that *Field* knew about it.¹⁹⁰ In the court's application of its new implied license test, the knowledge requirement was clearly met because *Field* admitted to knowing about the system.

Why would it matter how well known the opt-out system was if *Field* knew about it? With the inclusion of this factor, the court lays the foundation for a new implied license test with extraordinary promise. The court's recognition that the opt-out mechanism is widely known could serve several related functions. First, the court might have wanted to leave open the possibility that constructive knowledge may satisfy the knowledge requirement.¹⁹¹ Second, the court may have been trying to show that the burden this new test

190. *See id.* at 1112 (“The Internet industry has developed a set of widely recognized and well-publicized industry standard protocols.”); *id.* at 1113 (“The ‘no-archive’ meta-tag has been a widely recognized industry standard for years.”); *id.* at 1116 (stating that “site publishers typically communicate their permissions to Internet search engines . . . using ‘meta-tags,’” and that “the ‘no-archive’ meta-tag is a highly publicized and well-known industry standard”).

191. A court might find that the opt-out system is so well known and easy to learn that anyone who puts copyrighted work online is deemed to have constructive knowledge of that system. If courts do not favor such a broad interpretation of the knowledge requirement for implied license, they might instead need to determine precisely when copyright or website owners can be considered to have constructive knowledge. Courts may differentiate between different types of website owners. For example, larger institutions could be assumed to know more. Courts could also consider what other meta-data the website contains (other uses of meta-tags providing instructions to robots could indicate knowledge), whether there is a robots.txt page (suggesting some technical knowledge of robot behavior in general), whether any express terms of use suggest knowledge of robot activity, or a number of other factors.

imposes on the copyright owner is a light one. That is, when the opt-out system is widely known, the burden on the copyright owner might appear to be light because opting out is not an obscure process that requires the copyright owner to engage in undue research to learn how to opt out. Finally, the court may have decided that industry standards and customs are important factors in deciding whether to find an implied license in any given situation. As in the related field of contract law, customs and standards are important factors in discerning intent and in deciding what actions and behaviors are reasonable.¹⁹²

This broad reading of the *Field* court's "knowledge" requirement would go a long way to resolve the conflict between the opt-out Internet and the opt-in copyright system. By taking widely known industry customs and standards into account, the implied license doctrine can serve as the mechanism to harmonize copyright with many of the seemingly incongruent systems that make the Internet so valuable. Because any shift of a burden to opt out to the copyright owner is a departure from any copyright scheme currently in effect, courts may seek a mechanism within the framework of existing copyright law, such as fair use. Under current law, implied license and fair use are the primary copyright doctrines that could realistically reconcile the opt-out Internet with the opt-in copyright regime.¹⁹³ Due to reasons discussed in the next Part, implied license is a much better solution for this problem than fair use.

V. WHY IMPLIED LICENSE INSTEAD OF FAIR USE?

A. *What's Wrong with Fair Use?*

Implied license and fair use are similar in that they are both affirmative defenses to copyright infringement. Both were used successfully by Google in *Field*, and each independently provided Google with an affirmative defense.¹⁹⁴ The court's order, however, has about seven times more text dedicated to the fair use defense

192. See 5 ARTHUR LINTON CORBIN, CORBIN ON CONTRACTS § 24.14 (1998).

193. Fair use became important as an affirmative defense for new technologies that enable new types of use, especially after *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984), which upheld the district court's decision that private time-shifting of television programs using the Sony Betamax, a device similar to a VCR, is a fair use. See *id.* at 442.

194. *Field*, 412 F. Supp. 2d at 1115-16, 1117-23.

than to implied license.¹⁹⁵ This disparity hints at one of the reasons the implied license doctrine is a better solution: fair use is extremely complicated. Despite codification in its own section in the Copyright Act,¹⁹⁶ holding a central role in at least three United States Supreme Court opinions,¹⁹⁷ and appearing in hundreds of cases¹⁹⁸ and thousands of law review articles,¹⁹⁹ the fair use doctrine is one of the most difficult to predict, hardest to apply, and most misunderstood legal doctrines in copyright law.²⁰⁰ As technology develops, expanding the number of uses that are possible, deciding when each of those uses qualifies as fair use will become even more complex.²⁰¹

Section 107 of the Copyright Act provides that a copyright owner's exclusive rights are limited so that "the fair use of a copyrighted work" is "not an infringement of copyright."²⁰² The statute provides a nonexclusive, illustrative list of uses that qualify as fair use, including "criticism, comment, news reporting . . . teaching, scholarship, [and] research."²⁰³ The statute continues to list four factors that must be considered in every fair use determination.²⁰⁴

195. See *id.* at 1115–16 (devoting about one page to implied license); *id.* at 1117–23 (devoting about seven pages to fair use).

196. 17 U.S.C. § 107 (2000).

197. See *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 594 (1994) (holding the lower court committed error by ruling that 2 Live Crew's parody of "Oh, Pretty Woman" was not fair use solely because it was a commercial use); *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 569 (1985) (holding that *The Nation* magazine's use of exact quotes from former President Ford's autobiography before its publication was not fair use); *Sony*, 464 U.S. at 442.

198. A LexisNexis search on January 12, 2006, of all cases, with the search query: "atleast2(fair use) and atleast2(copyright)" returned 777 cases.

199. The same search query in "US law reviews and journals, combined" on the same day returned more than 3,000 results.

200. One case calls the doctrine of fair use "the most troublesome in the whole law of copyright." 4 NIMMER & NIMMER, *supra* note 58, § 13.05 (citing *Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661 (2d Cir. 1939) (per curiam)). Another notes that the "doctrine is entirely equitable and is so flexible as virtually to defy definition." *Id.* (citing *Time, Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130 (S.D.N.Y. 1968)). *Campbell, Harper & Row*, and *Sony* "were overturned at each level of review, two of them by split opinions at the Supreme Court level." *Id.*

201. As a result of the utter lack of predictability in interpreting the statute and case law, as well as the enormous statutory damages looming as a potential punishment for crossing too far over the fair use line, certain sectors of the public that rely on the fair use doctrine in day-to-day operations have negotiated fair use guidelines that establish certain uses to be "fair use" as agreed upon by the interested parties. See, e.g., Guidelines For Classroom Copying of Books and Periodicals, <http://www.utsystem.edu/OGC/INTELLECTUALPROPERTY/clasguid.htm> (last visited Feb. 18, 2007) (providing classroom fair use guidelines).

202. 17 U.S.C. § 107 (2000).

203. *Id.*

204. *Id.*

The first factor is the purpose and character of the use, including whether the use is for commercial or educational purposes.²⁰⁵ The second factor is the nature of the copyrighted work.²⁰⁶ The third factor is the amount of the protected work that is used by the allegedly infringing work.²⁰⁷ The fourth factor is the effect of the new use on any potential market for the copyrighted work or the work's value.²⁰⁸

The central relevant difference between the doctrines of fair use and implied license is the role of the copyright owner's intent. Fair use permits partial and sometimes total copying of copyrighted works without the owner's permission.²⁰⁹ Fair use does not take the intent of the copyright owner into consideration—in fact, fair use is a successful defense even if the copyright holder vehemently opposes the use. Sometimes, courts have made this characteristic somewhat unclear. For example, in *Harper & Row, Publishers, Inc. v. Nation Enterprises*,²¹⁰ the Supreme Court stated that “[f]air use was traditionally defined as ‘a privilege in others than the owner of the copyright to use the copyrighted material in a reasonable manner without his consent.’”²¹¹ Almost immediately after stating that the use is without the consent of the author, however, the Court added that an “author’s consent to a reasonable use of his copyrighted works [had] always been implied by the courts as a necessary incident of the constitutional policy of promoting the progress of science and the useful arts”²¹² and that “the fair use doctrine was predicated on the author’s implied consent to ‘reasonable and customary’ use when he released his work for public consumption.”²¹³ Note the contradiction: at the same time, fair use can be made without the copyright owner’s consent, and the copyright owner’s consent is implied for that use. One cannot simultaneously do something with *and* without the consent of another. Accordingly, this historic view of fair use as “predicated on the implied or tacit consent of the author

205. *Id.*

206. *Id.*

207. *Id.*

208. *Id.*

209. William F. Patry & Richard A. Posner, *Fair Use and Statutory Reform in the Wake of Eldred*, 92 CAL. L. REV. 1639, 1643 (2004).

210. 471 U.S. 539 (1985).

211. *Id.* at 549 (citation omitted).

212. *Id.*

213. *Id.* at 550 (citations omitted).

... is manifestly a fiction.”²¹⁴ Some of the fair uses explicitly mentioned in the preamble of § 107, such as criticism and parody, would often be entirely blocked if every author’s permission was necessary.

Why was the *Harper & Row* Court discussing author consent if fair use does not respect it? Because *Harper & Row* dealt with an unpublished work,²¹⁵ the Court was looking at the circumstances surrounding publication.²¹⁶ Note how the language above hinges on the condition that the author “released his work for public consumption.”²¹⁷ Back when copyright was not automatically attached at fixation and instead attached only at publication with notice of copyright,²¹⁸ it made sense to think of the system as a tradeoff. Once the author published a work and secured the copyright, the work was no longer privately held by the author, and the author could no longer control the use of the work.²¹⁹ The author could be said to assent to whatever uses were “reasonable and customary” because the author made the decision to publish the work with knowledge of the uses people would make of the work after it was published. The quid pro quo was that in exchange for the copyright protection obtained by publication, an author accepted the reality of reasonable and customary uses, *fully aware that there was nothing she could do to stop such uses*. In this sense, fair use cannot be described as an opt-in or opt-out system. Rather, the copyright owner is treated as opting in, without the ability to opt out.

Through its discussion of author consent, the *Harper & Row* opinion illuminates the reason the implied license doctrine is a better defense than fair use in many cases. The Court merely stated that when an author decides to publish something, people are going to use it in certain “reasonable and customary” ways.²²⁰ In a context similar to the *Field* case, both the fair use and the implied license defenses can be used to implement the common sense idea that when a website goes up on the Internet, users will make reasonable and customary use of the website. However, especially in new industries based on new technologies, what is reasonable and customary is far from clear.

214. 4 NIMMER & NIMMER, *supra* note 58, § 13.05. Professor Nimmer explains, “A restrictive legend on a work prohibiting copying in whole or in part gives no greater protection than the copyright notice standing alone.” *Id.*

215. *Harper & Row*, 471 U.S. at 542.

216. *See id.* at 542–44.

217. *Id.* at 550.

218. 1 NIMMER & NIMMER, *supra* note 58, at OV-3 (Overview).

219. *Harper & Row*, 471 U.S. at 549–51.

220. *See id.*

Even if a new technology enables a new use that is reasonable, it cannot immediately become “customary” because not enough time has passed for customs to develop. Thus, for uses that are not reasonable and customary, another mechanism is needed, because there is no tacit consent in the *Harper & Row* tradeoff sense described above.²²¹ Where more deference to the copyright owner’s permission is needed, the implied license doctrine as used in *Field* has the ability to respect the wishes of the copyright owner through the adoption of an opt-out system.

Unlike fair use, implied license retains an important and central role for intent of the copyright holder. Even if implied licenses are granted based on a broad interpretation of the *Field* test’s knowledge prong, so that the copyright holder’s permission might be assumed unless she opts out, the act of opting out remains as a simple way for the copyright owner to immediately prevent the grant of an implied license. Where fair use provides an “automatically in” system, implied license provides an option to opt out, allowing for greater respect of the copyright owner’s rights.²²²

Because fair use fits more naturally where the copyright owner’s intent is not important, it maintains a crucial role in a different set of situations dealing with the widespread copying and distribution of copyrighted works on the Internet. Whenever a copyrighted work is made available online by someone other than the copyright owner without permission of the owner, the implied license doctrine cannot be used as a defense, as third parties cannot grant rights they do not even have to others.²²³ For instance, under the *Field* test, the second prong involving encouragement by the copyright owner could never be satisfied by the actions of an unauthorized third party who has no rights in the first place. In these cases, fair use is a much more appropriate defense.²²⁴

221. See *supra* notes 210–14 and accompanying text.

222. In *Field*, the role of the ability to opt out was minor in the fair use analysis. See *Field v. Google, Inc.*, 412 F. Supp. 2d 1106, 1119 (D. Nev. 2006). The ability of site owners to “disable the cache functionality . . . in a matter of seconds” weighs in the first factor toward Google since it makes the use less of a substitute. *Id.* Because the first fair use factor weighed heavily in Google’s favor, see *id.* at 1118–20, and only the second factor weighed against Google (and only slightly so), *id.* at 1120, the court probably would have found fair use even without the opt-out procedure. If this is the case, then the implied license defense is far less useful here; if fair use makes caching legal without the owner’s consent, it is a waste of time even to consider the intent of the owner with the implied license defense.

223. See 17 U.S.C. § 106 (2000).

224. See, e.g., *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828, 831 (C.D. Cal. 2006). In *Perfect 10*, the court applied a fair use analysis to Google’s “creation and display of

The ability to respect the wishes of the copyright owner is only one reason that implied license is a better solution than fair use. Another reason is that a system based on implied licenses has the potential to supply a clear, simple, bright-line rule that fair use is inherently incapable of providing.²²⁵ Fair use analysis requires the balancing of at least four factors and perhaps also the comparative good faith of the parties,²²⁶ while trying to find “equity” in the process. While the Supreme Court appropriately downplays the possibility of a bright-line approach because it would create an inflexible fair use doctrine, the value of a clearer standard cannot be overstated. Individuals and businesses simply cannot make educated decisions about their behavior under the fair use regime because it is too unpredictable.²²⁷

B. How Does Implied License Avoid the Problems Plaguing Fair Use?

To review, the more flexible version of the *Field* implied license doctrine discussed in this Comment generally is as follows: where a copyright owner can prevent a use through a well-known opt-out mechanism and does not, the law may allow the use by creating an implied license.²²⁸ The critical reader may wonder where the limits are on such an implied license system. The very factors that make fair use so unpredictable at least provide some limits to its application. Thus, *Field*'s implied license test would need some limits to prevent some absurd consequences.

The fact that a system of use allows the copyright owner to opt out will not always justify the grant of an implied license if the owner fails to opt out. As an extreme example, suppose a company, Pegleg,

thumbnails” based on images hosted on third-party websites that themselves infringed Perfect 10’s copyrights. *Id.* at 845. In this case, it would not make sense to look at whether Perfect 10 granted Google an implied license to create and display the thumbnail images because Perfect 10 never made the images freely available. Rather, Perfect 10 chose to opt out of free availability by password protecting their site so only paying customers could view their works. *See id.* at 832 n.3.

225. *See Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 448 n.31 (“ ‘Although the courts have considered and ruled upon the fair use doctrine over and over again, no real definition of the concept has ever emerged. Indeed, since the doctrine is an equitable rule of reason, no generally applicable definition is possible, and each case raising the question must be decided on its own facts ’ ” (quoting H.R. REP. NO. 94-1476, at 65 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5679)). The Court also noted that “[t]he Senate Committee similarly eschewed a rigid, bright-line approach to fair use.” *Id.*

226. *See Field*, 412 F. Supp. 2d at 1122.

227. *See supra* notes 200–01 and accompanying text.

228. *See supra* Parts IV.B–C.

decided to base its business model on pirating music recordings, where it would purchase single copies of music CDs, copy them onto blank discs, and sell thousands of the “burned” copies online and on the streets at less than retail cost. Clearly, this is an infringement of copyright and could land Pegleg’s employees and owners in federal prison.²²⁹ It would be ludicrous to convert this business model from criminal to legitimate merely because Pegleg provides an opt-out mechanism widely known in the music industry.

What, then, are the relevant differences between the opt-out caching system that Google operates and Pegleg’s opt-out piracy business that make the former acceptable and the latter unacceptable? The difference relates to the reasonableness of finding the copyright owner’s consent. The *Field* implied license cannot operate without the copyright owner’s consent. While the owner’s consent can be implied, it cannot be implied in a manifestly *unreasonable* manner. Thus, the assumption that a copyright owner impliedly consents to piracy is completely unreasonable, but implied consent to Google’s caching program was reasonable, as the *Field* court found.²³⁰

This reasonableness determination does not have to rely on the same type of factors utilized when determining whether a use is a fair use. Instead, the reasonableness standard can consider common practices based on current industry customs and standards and widely held practices. In *Field*, the court stated that there was no direct infringement at all and that even if there had been direct infringement, the fair use defense and the statutory safe harbor would apply as well.²³¹ Therefore, two defenses establish that in a general sense, Google’s caching practice is not illegal. Even if the legal status of Google’s caching was unclear before *Field*, it was never an unquestionably infringing use. It was a widely used practice that no cases had found to be infringing activity, and no statute specifically prohibited.²³² For these reasons, implied consent is reasonable to assume. In stark contrast to *Field* is Pegleg, whose piracy is not reasonably regarded as legal under any current interpretation of the

229. Copyright infringement is usually a civil matter, but there are also criminal provisions of the Copyright Act, and extreme cases are prosecuted criminally. See 17 U.S.C. § 506 (2000).

230. *Field*, 412 F. Supp. 2d at 1116 (finding that *Field*’s “conduct is reasonably interpreted as the grant of a license to Google”).

231. See *supra* notes 165–66.

232. See *Field*, 412 F. Supp. 2d at 1111 n.2, 1116 (noting that caching is a common practice among search engines). The *Field* court did not cite any authority that treated caching as an infringing action.

law and is not a common practice in any legitimate industry. Thus, to prevent the absurd conclusion that the *Field* decision could legitimize otherwise obviously illegal uses, all that is needed is to recognize that those uses are indisputably illegal, and any implied consent to those uses is therefore unreasonable.

C. *Application to New Technologies*

Of course, the legal status of new technological uses of copyrighted works will almost always be undetermined at the inception of such use, especially when a change in technology raises new questions of law, policy, and practice. In these cases, whether the new use is clearly unreasonable, as is the Pegleg business model, may be in the eye of the beholder. When the new use first arises, it is *not* a good time for an opt-out policy to allow grants of implied licenses. At its inception, the new use is simply too tentative to be firmly established as an Internet custom or an industry standard practice. If Internet users find the new service helpful, and it becomes popular, then other similar uses will arise. In *Field*, the court noted that Google is not the only search engine that provides links to cached pages. Yahoo! and MSN have programs identical to Google's.²³³ The passage of time without incident also contributes to the establishment of such a system as reasonably accepted by the industry and users. For example, Google's caching practice is widely known and had never been challenged in court even after several years of practice. As the number of services based on the new use increase, and as these uses become part of the menu of services available to online users who have no reason to think the new use is problematic, the public reliance on those services also grows. At the point when services based on the new use are widely available and accepted as *the way things are*, the new use will have matured into the type of use for which implied licenses become possible. Search engine caching is exactly this type of practice: it is widely done and accepted, and the public relies on it.

An example of a relatively new use that could not be characterized as an accepted new use is the unauthorized copying of music over peer-to-peer ("P2P") networks.²³⁴ Even if it is still widely

233. *Id.* at 1111 n.2.

234. P2P networks offer a distributed, rather than centralized, mode of distribution. They are often called file-sharing networks because they efficiently permit large numbers of users to share files without overburdening any particular computer. *MGM Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913, 918 (2005).

practiced,²³⁵ it is by no means widely accepted. There have been lawsuits from the beginning, both against the P2P services²³⁶ and their users.²³⁷ The affected interest groups have again and again voiced their dissatisfaction with these services.²³⁸ Even before the first P2P lawsuits were decided and the potential of a fair use defense for these services was not yet eliminated,²³⁹ it was clear that P2P music sharing raised serious copyright issues to which the answers were unclear at best. For these reasons, P2P systems, like the old version of Napster, could not have avoided liability simply by offering copyright owners the chance to opt out.²⁴⁰

The limitation preventing the *Field* test from applying to cases like that of Pegleg is crucial to enclose the *Field* test within reasonable boundaries of use, even though it was included only implicitly in *Field* itself.²⁴¹ As a result, for the remainder of this paper, this limitation is treated as an additional factor to consider in the *Field* test. With this third factor, the implied license test from *Field* should not be a thorn in the side of copyright owners who have to take yet another step to protect their works. Instead, it will be an instrument to provide certainty where industry and the public at large have justifiably come to rely on certain uses as acceptable. Part VI briefly surveys a number of possible applications of the implied license doctrine to other technologies, including a few of Google's other projects.

235. See, e.g., John Boudreau, *Illegal File Sharing Showing No Letup*, SEATTLE TIMES, July 3, 2006, at E3, available at 2006 WLNR 11507396.

236. See, e.g., *MGM Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005) (concerning the Grokster and Morpheus P2P services); *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004 (9th Cir. 2001) (concerning the Napster peer-to-peer service).

237. See Press Release, Recording Industry Association of America, RIAA Announces New Round of Music Theft Lawsuits (Feb. 28, 2006), http://www.riaa.com/news/newsletter/022806_2.asp.

238. See, e.g., Recording Industry Association of America, Online Piracy and Electronic Theft, <http://www.riaa.com/issues/piracy/online.asp> (last visited Feb. 18, 2007); Motion Picture Association of America, Internet Piracy, http://www.mpaa.org/piracy_internet.asp (last visited Feb. 18, 2007).

239. See *Napster*, 239 F.3d at 1017.

240. In fact, the court's initial order before shutting down Napster was essentially an opt-out system. The court ordered Napster to remove access to certain works. *Napster*, 239 F.3d at 1011 (citing *A&M Records, Inc. v. Napster*, 114 F. Supp. 2d 896, 927 (N.D. Cal. 2000)). This system did not work, but if it had, there would have been an interesting implied license issue in old Napster's future. If it became common practice for copyright owners to request exclusion from Napster, and this became the accepted industry model for P2P music sharing, then failure of a copyright owner to opt out may have implied a license under the *Field* analysis. This, however, never occurred.

241. See *supra* text accompanying notes 230–33.

VI. THE IMPLIED LICENSE DOCTRINE AS A GAP-FILLER

In order to illustrate how useful the *Field* implied license doctrine may be, and also to illustrate its limitations, this Part describes three different uses for copyrighted works: browsing, indexing, and translating. Each is analyzed with respect to the flexible implied license doctrine from *Field*. A common practice that is very well suited for an application of the implied license doctrine is ordinary web browsing, which is considered first. The second practice, indexing the web, is likewise a fairly strong case for implied license. The third practice, automated language translation, presents a harder case for implied license.

A. *Browsing by Individuals*

Individuals, in the course of ordinary web browsing activity, normally make copies of the websites they visit both in RAM and in a cache folder on a disk drive.²⁴² These qualify as copies under the *MAI* definition,²⁴³ and therefore are potentially infringing copies when the websites contain copyrighted work. This is the problem raised in the beginning of this Comment.²⁴⁴ Surely, a court would strive to find a way to avoid making every Internet user in the country a copyright infringer due to browsing activity alone. Although this may appear to be only an academic concern, it needs to be addressed. If the gap between the law and technology is ignored without considering the ways in which the gap can be bridged, the gap may grow, creating an even larger problem that must be dealt with in the future. The possibility of infringement by browsing and the natural fit of the implied license as a solution has been mentioned by some commentators,²⁴⁵ though the prior analysis is somewhat clumsy compared to what is now possible given the *Field* result.

Applying *Field*, the implied license seems to fit the situation. First, browsing is a broadly used practice from which website owners may opt out in well-known ways, such as through password protection. Second, website owners encourage use by making the site available without opting out. Finally, browsing is a common practice by millions of people, which has never been seriously called into

242. See *supra* Part I.E.

243. See *supra* notes 50–51 and accompanying text.

244. See *supra* Part I.E.

245. See, e.g., Comm. on Computer Law, *Caching on the Internet and the Proxy Caching Notice Project: Avoiding an Internet Copyright Dilemma*, 52 REC. ASS'N B. CITY N.Y. 968, 975–77 (1997); Allen R. Grogan, *Implied Licensing Issues in the Online World*, COMPUTER LAW., Aug. 1997, at 1, 2.

question in a legal sense, and there is an enormous public reliance on the noninfringing status of browsing.

Therefore, under *Field*, individual users would not be liable for infringement because of browsing activity in situations where copyright owners make their works available on the Internet. This analysis is premised on the idea that making a work available online makes it freely available to all users. This is true in a technological sense. If a work is placed in a directory on a web server without access control, it can be downloaded by any person who knows the location of that work on the web server. In essence, one only needs to know where to look. To those who know where to look, the work in that location is freely available. The *Field* court made this observation several times.²⁴⁶ The implied license defense is an ideal mechanism for explaining why most users browsing the web are not committing copyright infringement. As evidenced by the decision to put something online, a copyright owner usually expects that users will make use of the work using widely available browsers that operate in ordinary ways, which involves making copies.²⁴⁷

246. See *Field v. Google, Inc.*, 412 F. Supp. 2d 1106, 1114 (D. Nev. 2006) (stating that Field created his website and “published his works on pages where they were accessible, for free, to the world”). Since he used a permissive robots.txt file, the court concluded that he “sought to make his works available to the widest possible audience for free.” *Id.* at 1120. Then, the court stated that Field made his “works available to the public for free in their entirety.” *Id.* at 1121. It is unclear how much of the court’s determination that anything on the Internet is “available for free” relied on Field’s permissive robots.txt file.

247. In another recent case, *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828 (C.D. Cal. 2006), the court included a footnote stating that when Google automatically distributes thumbnail images which are then locally cached by a browser, this distribution by Google probably constitutes fair use. *Id.* at 845 n.11. The court did not mention whether this is likely fair use at the user’s end, but similar reasoning may apply. While fair use may also provide a defense to infringement based on locally cached copies, this defense is better suited to cases where there is some indication that the copyright owner did not want users to make any copies at all, including local cache copies. These situations are typically the oddball cases where a copyright owner has put works on a site with the notice similar to “you have no permission to make any copies of this work” or where a copyright owner places something online and does not expect that anyone else will discover it. A fair use defense could handle these situations if a court is unwilling or unable to find an implied license.

Because the expectation in this oddball example may sound like an unreasonable one, a different example might help clarify this situation. If I had a folder in my university webspace to temporarily store my work (located hypothetically at <http://www.unc.edu/~jsieman/myprintfolder>), including drafts of this Comment, I could conveniently print my work from any campus computer lab by pointing my browser to the web folder. There is no “web page”; instead, there is only a directory listing of my files. Technologically, these files might be freely available to anyone who knows where to look, but realistically, because no other person or search engine knows about this folder, no one is likely to ever find my work because it would require someone else to guess that I have a folder called “myprintfolder” on my personal webspace.

B. Indexing by Google

In *Field*, the court carefully defined the activity Field alleged was infringing by explaining that “Field [did] not allege that Google committed infringement when its ‘Googlebot,’ like an ordinary Internet user, made the initial copies of the Web pages containing his copyrighted work and store[d] those copies in the Google cache.”²⁴⁸ The court did not say what the result would have been had Field alleged that Google’s activity was infringing. However, based on the holding in the case, it is fairly clear that the implied license defense would apply here, too. First, website operators can easily opt out of having their pages crawled and indexed using either robots.txt or meta-tags, both of which are widely known and were actually known by Field.²⁴⁹ Second, Field did not opt out using any of these mechanisms.²⁵⁰ Third, using “web spider” programs to crawl and make copies is a common and crucial practice in the search industry. Any successful litigation over automated spider activity has been limited to trespassing due to excessive spider activity.²⁵¹ One court even found copies made via spider activity to be fair use.²⁵² With no other legal controversy hovering over copies made by spiders, and with the enormous degree of public reliance on search engines, spider-based copying is the type of activity for which the implied license would provide a successful defense.

If the copying that occurs during indexing of web pages by electronic spiders is noninfringing due to the implied license defense, an immediate extension of this reasoning might suggest that the same defense might apply to indexing of print works. Google recently began an extraordinarily ambitious program where it will scan the printed collections of some of the world’s largest libraries in an attempt to make the wealth of information available in book form as easily searchable as works available online.²⁵³ The public benefit of

248. *Field*, 412 F. Supp. 2d at 1115.

249. *Id.* at 1113–14.

250. *Id.* at 1114. In fact, Field not only failed to opt out, he voluntarily opted in with a permissive robots.txt file. *Id.*

251. See *Register.com, Inc. v. Verio, Inc.*, 356 F.3d 393, 404 (2d Cir. 2004) (agreeing with the district court’s finding that Verio’s “performing multiple automated successive queries[] consumed a significant portion of the capacity of Register’s computer systems”); *Ebay, Inc. v. Bidder’s Edge, Inc.*, 100 F. Supp. 2d 1058, 1069–72 (N.D. Cal. 2000) (dealing with the accusation that a spider was trespassing, not infringing copyright).

252. See *Ticketmaster Corp. v. Tickets.com, Inc.*, No. CV99-7654-HLH (VBKx), 2003 U.S. Dist. LEXIS 6483, at *15 (C.D. Cal. Mar. 6, 2003).

253. See *Google Book Search Library Partners*, <http://print.google.com/googlebooks/partners.html> (last visited Feb. 18, 2007); *Google Books Search Library Project*, <http://books.google.com/googlebooks/library.html> (last visited Feb. 18, 2007).

this program would be incalculable. Although Google decided to offer copyright owners an easy way to opt out of this program,²⁵⁴ the Author's Guild quickly filed a lawsuit against Google based on this project,²⁵⁵ followed by another suit by the Association of American Publishers.²⁵⁶

Implied license is likely not the best defense for Google in this situation. While an opt-out mechanism is available, this is not the type of use where a license can be reasonably implied, due to the bias against new technology described above.²⁵⁷ An endeavor such as Google Book Search Library Project has never been attempted before, and the legal issues are far from clear. Similar to P2P music sharing, the legality of the project has been challenged from the very beginning.²⁵⁸ Neither the search industry nor the public has built up any reliance on the legality of this project. A fair use argument may protect Google,²⁵⁹ but implied license is not an appropriate defense in this situation.

C. *Translating by Google*

The Copyright Act provides that a copyright owner's exclusive rights include the right to create derivative works based on the protected work.²⁶⁰ The term "derivative work" is defined to include "translation."²⁶¹ Google provides a service that offers to translate foreign language websites on the fly,²⁶² and also operates a website where an individual can have any particular site translated from one

254. See Google Book Search Publisher Questions, http://print.google.com/googleprint/publisher_library.html#options3 (last visited Feb. 18, 2007).

255. See Class Action Complaint at 2, *Author's Guild v. Google, Inc.*, No. 05CV8136 (S.D.N.Y. Sept. 20, 2005), available at http://eff.org/legal/cases/authorsguild_v_google/complaint.pdf.

256. See Complaint at 2, *McGraw-Hill Cos. v. Google, Inc.*, No. 05CV8881 (S.D.N.Y. Oct. 19, 2005), available at <http://publishers.org/press/pdf/40%20McGraw-Hill%20v.%20Google.pdf>.

257. See *supra* Part IV.C.

258. See *supra* notes 236-40 and accompanying text.

259. See, e.g., JONATHAN BAND, *THE GOOGLE PRINT LIBRARY PROJECT: A COPYRIGHT ANALYSIS* 5, <http://www.policybandwidth.com/doc/googleprint.pdf> (last visited Feb. 18, 2007). This is one legal analysis to which Google links as representative of its legal position. See Google Book Search: News & Views, <http://books.google.com/googlebooks/newsviews/legal.html> (last visited Feb. 18, 2007).

260. 17 U.S.C. § 106 (2000).

261. *Id.* § 101.

262. Although these automated translations are often far from perfect, § 101 of the Copyright Act does not limit a copyright owner's exclusive rights to only accurate translations. See *id.*

language to another.²⁶³ Permission is rarely explicitly granted for translation of a web page into other languages, so the copyright question considered here is whether this is an infringing use, or whether Google can take advantage of an implied license defense.

The immediate problem for an implied license for translation is that there is no clear opt-out mechanism.²⁶⁴ There is nothing a copyright owner can do to prevent Google from translating an otherwise freely available website if a third party requests that Google translate the work, just as there is nothing that can stop a human from translating a page of a book onto a sheet of paper. Because the first prong fails, the other prongs need not be considered, and the *Field* test fails. Although the *Field* implied license defense will not protect Google in its translation program, Google may still have a fair use defense against claims of infringement.

D. Other Projects

The implied license may have applicability in a wide range of other projects, including variants of search engine activity like Google News,²⁶⁵ Google Image Search,²⁶⁶ news syndication uses like RSS²⁶⁷ feed readers,²⁶⁸ ordinary forwarding of e-mails,²⁶⁹ and archiving by the Internet Archive.²⁷⁰

263. See Google Language Tools, http://www.google.com/language_tools (last visited Feb. 18, 2007).

264. In theory, the Internet industry could develop a custom to respect a hypothetical “no-translate” meta-tag, but nothing like this is in common use today.

265. Google News, <http://news.google.com> (last visited Feb. 18, 2007). Google takes news from the websites of different news organizations, categorizes them, and reproduces headlines, text snippets, and thumbnail images from those stories on its own news page. See About Google News, http://news.google.com/intl/en_us/about_google_news.html (last visited Feb. 18, 2007).

266. Google indexes images available on the web and makes them searchable to Google users. It reproduces and hosts small, thumbnail-sized images to make searching through images easier. See Google Image Search, <http://images.google.com> (last visited Feb. 18, 2007).

267. RSS stands for “Really Simple Syndication.” When a website offers an RSS feed, users can receive headlines from that site using a wide variety of software. Whether a website’s offering of RSS feeds grants a copyright license to potential RSS users is unclear. See RSS Specifications, <http://www.rss-specifications.com/the-copyright-debate.htm> (last visited Feb. 18, 2007).

268. Google does not allow website owners to remove their feeds from Google users’ feedreaders. See Google Webmaster Help Center, Remove a RSS or Atom Feed, <http://www.google.com/support/webmasters/bin/answer.py?answer=35311> (last visited Feb. 18, 2007).

269. For e-mail forwarding, the practice has become so common that corporate e-mail servers often append notice to outgoing e-mail messages that forwarding is not permitted. Perhaps this could be seen as the ability to opt out. See, e.g., Thomas G. Field, Jr., *Copyright in E-mail*, J. ELECTRONIC PUBLISHING, Sept. 1999, <http://www.press.umich>.

CONCLUSION

The promise of the flexible implied license doctrine for the Internet as presented in *Field* lies in its ability to make room within copyright law for broad opt-out systems of use that cannot efficiently operate in any other way. The reduction in transaction costs can be enormous, and parties can act with greater certainty when they can count on their behavior being considered legal based on implied licenses. When the only reason to think that a use is infringing is the inherent incompatibility of the opt-in Copyright Act with the opt-out Internet, and everything else suggests the use is compatible with the wishes of the copyright owner, including industry customs and widespread public reliance, the implied license doctrine can play the role of simple common sense.

JOHN S. SIEMAN

edu/jep/05-01/field.html (last visited Feb. 18, 2007) (“Writers who post messages to public e-mail lists should contemplate, for example, both forwarding and archiving. It is reasonable to assume that they have given permission unless it is explicitly denied.”).

270. See Internet Archive, <http://www.archive.org> (last visited Feb. 10, 2007).