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Jane C. Ginsburg  
*Columbia Law School*, [jane.ginsburg@law.columbia.edu](mailto:jane.ginsburg@law.columbia.edu)

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# COPYRIGHT WITHOUT BORDERS? CHOICE OF FORUM AND CHOICE OF LAW FOR COPYRIGHT INFRINGEMENT IN CYBERSPACE

JANE C. GINSBURG\*

## I. INTRODUCTION

I stress the question mark in the title of this paper. Here is the problem: claims of copyright infringement are arising out of the communication of works over digital networks such as the Internet. These networks are indifferent to national borders. But copyright owners today pursue infringement claims before courts and under legal rules whose competencies are territorial. How does one reconcile the ubiquity of the infringement with the boundaries of adjudication?

To illustrate the problem, let me begin with a true story. Former French President François Mitterrand died in January 1996. Within a few days of his death, his former personal physician published a memoir, titled *Le Grand Secret (The Big Secret)*. The doctor disclosed that the cancer that ultimately killed Mitterrand had already metastasized when Mitterrand first assumed the presidency. Indeed, the doctor claimed, toward the end of his second seven-year term, Mitterrand was no longer able to exercise the functions of his office. The book's publication drew Mitterrand's family's ire; the family invoked the late President's post-mortem right of privacy under French law to obtain a court order against the book's dissemination. Within days of its publication, the book was withdrawn from circulation.

Before every copy disappeared from bookstore shelves, however, the entrepreneur of a "cyberspace cafe" in a provincial French city acquired a copy, scanned all 190 pages, and posted the image files to an Internet site. Patrons of his cafe could log onto the site, as could remote users elsewhere in France who enjoyed Internet access. The event proved to be the best publicity the In-

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\* Morton L. Janklow Professor of Literary and Artistic Property Law, Columbia University School of Law. This Article expands on the Herbert Tenzer Distinguished Lecture in Intellectual Property Law, given at the Benjamin N. Cardozo School of Law, October 15, 1996.

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ternet could have received in France. More than 30,000 people simultaneously tried to access the site, provoking a "crash" of telephone service in eastern France. Faced with threats from Mitterand's family, the entrepreneur declared that if pursued, he would simply delete the material from the French server, and send his files to a website in the United States.<sup>1</sup>

So far, this story lacks a role for the copyright owner. In real life, the author and the publisher were caught in the middle. The entrepreneur's actions clearly violated their rights under French copyright law, notwithstanding his self-serving declarations that his acts fell within a juridical void. The author's and publisher's difficulty was not with the copyright law, it was with the politics of the situation. They, after all, were contesting the withdrawal of the book. While the entrepreneur had treated the copyright cavalierly, he had also eluded the censorship that the late President's family had so far succeeded in imposing.

But suppose that the entrepreneur had uploaded his files to a U.S. website, and that the French copyright owners had sought to prevent dissemination of the work in the United States? Or that the entrepreneur uploaded the files to a United Kingdom website, and the copyright owners sought to prevent the dissemination from the United Kingdom? (*Le Grand Secret* was in fact found on websites in the United States, Canada, and the United Kingdom.) Whom would the copyright owner pursue? In what forum (fora)? And what law(s) would apply?

The implications of this scenario contest a central commonplace of international copyright law. Traditionally copyright protection has been territorial. That is, national law will apply to acts of infringement committed in a particular country, regardless of the national origin of the work infringed. The principal multilateral copyright conventions aim to promote international exchange of works of authorship by mandating the nondiscrimination rule of "national treatment." While promoting the permeability of national boundaries by copyrighted works, this rule also preserves national sovereignty by confining any country's copyright regime to local borders. But the concept of territoriality becomes elusive when the alleged infringements are accomplished by means of digital communications originating offshore. Traditional international copyright rules seem to presume that international

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<sup>1</sup> See Michel Alberganti & Hervé Morin, *Internet contourne la censure du livre du docteur Gubler*, LE MONDE, Jan. 25, 1996; Paul-André Tavoillot, *Le droit de l'Internet existe personne ne l'a rencontré*, LA TRIBUNE, Jan. 25, 1996, at 6; David Dufresne, *Besançon, site sismique*, LE CAHIER MULTIMEDIA DE LIBÉRATION, Jan. 26, 1996, at I-II.

infringements will occur sequentially and slowly; but digital networks make possible multinational infringements that are simultaneous and pervasive. As a result, it may be time to rethink this basic rule of international copyright.

The disjunction between territorial treatment of copyright claims and the ubiquity of cyberspace has led some commentators to urge abandonment of landlocked notions of judicial and legislative competence. Since digital communications resist grounding in particular fora, or governance by individual national laws, these writers contend it would be best to devise a cyberian legal system that would supply cyber-specific substantive copyright law, and/or virtual dispute settlers whose competence—and whose determinations—would transcend national borders.<sup>2</sup>

My analysis will be more earthbound. This is not to belittle the important ongoing efforts to achieve international harmony of substantive copyright rules.<sup>3</sup> Nor is it in any way to disparage the virtual magistrate concept, under which parties (especially copyright holders and on-line service providers) would remit their disputes to on-line arbitrators.<sup>4</sup> Rather, as a practical matter, I doubt that either of these approaches will immediately displace national disparities in copyright rules or adjudication in national courts. As a result, I will consider how courts may apply existing principles of judicial and legislative competence to resolve as fully as possible in a single forum a claim of multinational copyright infringement occurring through cyberspace. To keep an admittedly complex inquiry relatively simple, I will limit the focus of the analysis to U.S. legal concepts of judicial and legislative competence. I acknowledge, however, that U.S. concepts may sometimes differ significantly from those applied in other common law or civil law countries.<sup>5</sup>

## II. CHOICE OF FORUM

Recall our story of the posting of *Le Grand Secret* to websites in

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<sup>2</sup> See, e.g., David R. Johnson & David Post, *Law and Borders—The Rise of Law in Cyberspace*, 48 STAN. L. REV. 1367 (1996); Henry H. Perritt, Jr., *Jurisdiction in Cyberspace*, 41 VILL. L. REV. 1 (1996); see also Paul Edward Geller, *New Dynamics in International Copyright*, 16 COLUM.-VLA J.L. & ARTS 461 (1992).

<sup>3</sup> See, e.g., WIPO Copyright Treaty, Dec. 20, 1996. A “special agreement” to “introduce new international rules and clarify the interpretation of certain existing rules in order to provide adequate solutions to the questions raised by new economic, social, cultural and technological developments.” *Id.* preamble.

<sup>4</sup> See, e.g., Johnson & Post, *supra* note 2 (advocating a separate legal system for cyberspace, developed and regulated by users and service providers).

<sup>5</sup> See W.R. Cornish, *Intellectual Property Infringement and Private International Law: Challenging the Common Law Approach*, 4 GRUR INT'L 285 (1996).

the United States and the United Kingdom. The copyright owner's goal in pursuing an infringement action is to bring as many parties and claims as possible before a single forum. Can the French publishers obtain personal jurisdiction in a U.S. court over the French national that originated the communication? Over the operator of the U.S. website? Over the operator of the U.K. site? Over the commercial on-line service (if any) that carries the website? (The question whether, on the merits, the website operator or on-line service would be liable for direct or secondary copyright infringement is a different matter. For present purposes, we are concerned with whether that entity can be haled before a U.S. court.)

A. *Jurisdiction Based on Defendant's Domicile or the Place or Origin of the Harm*

To address this question, it may be helpful to recall some general principles of judicial competence in the United States. First, although jurisdiction over the subject matter of copyright claims is exclusively federal,<sup>6</sup> federal courts look initially to the law of the forum state to supply the rules of jurisdiction over the parties.<sup>7</sup> As a general matter, a defendant may be sued at its domicile or principal place of business, regardless of whether or not the claim arose there.<sup>8</sup> Thus, for example, were the French publishers to initiate their copyright action against CompuServe in Ohio, or against America Online ("AOL") in Virginia, the Ohio or Virginia federal court would have jurisdiction over those parties. Moreover, because the court would be asserting general jurisdiction over those parties, it would have power to hear not only claims arising out of the U.S. distribution of the copyrighted work, but also claims arising out of the distribution of the work in other countries. (What law applies to extra-U.S. distribution is a matter I will take up in a later section of this Article.) But what about the website operators

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<sup>6</sup> 28 U.S.C. § 1338 (1994).

<sup>7</sup> See FED. R. CIV. P. 4. Although it has yet to do so, Congress could enact national rules of judicial competence. However, when the claim arises under federal law, and minimum contacts with any one state are lacking, a federal court will have jurisdiction over a defendant whose aggregate contacts with the United States meet constitutional standards for assertion of personal jurisdiction. See *id.* 4(k)(2), discussed *infra* text accompanying notes 22-24.

<sup>8</sup> See 4 CHARLES ALAN WRIGHT & ARTHUR R. MILLER, FEDERAL PRACTICE AND PROCEDURE §§ 1065-67 (2d ed. 1987). This basis of judicial competence is generally recognized outside of the United States as well. See also *Judicial Enforcement of Judgments in Civil and Commercial Matters*, sec. 2, art. 5.2, 1978 O.J. 1978 (L 304) 77; RUDOLF B. SCHLESINGER, *COMPARATIVE LAW: CASES, TEXTS, MATERIALS* 383 (1988); European Communities Convention on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters, Sept. 27, 1968, 8 I.L.M. 229, arts. 2, 5.3 [hereinafter Brussels Convention] (judicial competence within the European Union).

(if those entities are different from an on-line service and are not residents of Ohio or Virginia) and the French national?

A second basis of judicial competence focuses on the place of the harm. The place of harm can be understood as either the place of generation of the harm or the locations of its impact. Under the former characterization, the non-resident defendants could be subject to suit at the point of origin of the communication.<sup>9</sup> This raises the problem of localizing the origin of the communication. Under one view, the communication of *Le Grand Secret* originated in Besançon, France, whence the cybercafe entrepreneur sent it to the U.S. and U.K. websites. Economically, however, this point of origin seems rather fortuitous: the communication does not become accessible (and thus economically threatening) until it has been received at the website. The alleged harm is caused by the public availability of the work for access and downloading from the website, not from the home or cafe computer of the French national (who, in any event, deleted it from his server).<sup>10</sup> From the perspective of the members of the public seeking to obtain *Le Grand Secret*, the website is the distribution center for the work.<sup>11</sup> Thus, jurisdiction in a U.S. court over the website operator and over the foreign national who deliberately sent the work to that site would be proper at the U.S. location of the server. The territorial scope of the claim would cover not only distributions of the work to U.S. users, but distributions to foreign users who access and download from the U.S. website. (Again, choice of law is another matter.)

### B. Long-Arm Jurisdiction

This brings us to the final basis of judicial competence: the forum as the place of impact of the harm. In our hypothetical, the party over whom the copyright owner would be asserting this basis of personal jurisdiction in a U.S. court would be the U.K. website

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<sup>9</sup> The prevailing view in the United States and abroad is that plaintiff can sue in tort either where the harm originated or where it impacted. See, e.g., WRIGHT & MILLER, *supra* note 8, § 1069; SCHLESINGER, *supra* note 8, at 391; DOMINIQUE HOLLEAUX, JACQUES FOYER, GÉRAUD DE GEOUFFRE DE LA PRADELLE, DROIT INTERNATIONAL PRIVÉ §§ 713-26 (1987); Brussels Convention, *supra* note 8, art. 5.3; Case 68/93, Shevill v. Presse Alliance, SA, 1995 E.C.R. 289 (Mar. 7), ¶ 20.

<sup>10</sup> Cf. *Summers v. The Washington Times*, 21 Med. L. Rep. 2127 (D.D.C. 1993), quoted in *Givens v. Quinn*, 877 F. Supp. 485, 491 (W.D. Mo. 1994) (in libel action, "publication" held to occur not when newspaper's source sent allegedly defamatory statements to the newspaper, but when alleged defamation became "available to the general public").

<sup>11</sup> Cf. *CompuServe, Inc. v. Patterson*, 89 F.3d 1257 (6th Cir. 1996) (personal jurisdiction in Ohio over non-resident declaratory judgment defendant justified because, *inter alia*, defendant regularly sent software to CompuServe for distribution over its shareware network).

operator. Here, unlike the case of the U.S. website operator, there is no U.S. "distribution center." But there could be receipt in the United States, assuming U.S. users contacted the U.K. site, rather than the U.S. site, in order to obtain the work. In any event, once a work is on the web, it is available all over the world, whatever the physical location of the server. Is this availability of material sufficient to justify exercise of personal jurisdiction over the non-U.S. site operator?

### 1. Jurisdiction over the parties

The answer depends first on constitutional limitations on judicial competence. The constitutional limits are generous: it suffices for assertion of specific jurisdiction that defendant have "certain minimum contacts with [the forum] such that the maintenance of the suit does not offend 'traditional notions of fair play and substantial justice.'"<sup>12</sup> There will be "minimum contacts" with the forum if there is "some act by which the defendant purposefully avails itself of the privilege of conducting activities within the forum State, thus invoking the benefits and protections of its laws."<sup>13</sup>

For constitutional purposes, then, the question would be whether making copyrighted works available to users in the forum for viewing and downloading is tantamount to purposefully availing oneself of the privilege of conducting activities in the forum. If we were talking about traditional distribution of infringing hard copies or traditional broadcasting to the forum, the answer, I believe, would clearly be "yes."<sup>14</sup> For distributions through cyberspace that do not specifically target the forum, the defendant's relationship to the forum may be similar to that of a foreign defendant who merely injects a product into the "stream of commerce." That act alone may not suffice.<sup>15</sup> On the other hand, even if the defendant has not specifically targeted the forum, the defendant knows that "[b]y simply setting up, and posting informa-

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<sup>12</sup> *International Shoe Co. v. Washington*, 326 U.S. 310, 316 (1945).

<sup>13</sup> *Hanson v. Denckla*, 357 U.S. 235, 253 (1958).

<sup>14</sup> See generally Martin Schwimmer, *World Wide Web—Nationwide Jurisdiction?*, 65 COPY-RIGHT WORLD 15, 16-17 (1996) (discussing mail-order catalog cases).

<sup>15</sup> See, e.g., *Worldwide Volkswagen Corp. v. Woodson*, 444 U.S. 286 (1980); *Asahi Metal Indus. v. Superior Ct.*, 480 U.S. 102 (1987). In international stream of commerce cases, courts must

consider the procedural and substantive interests of other nations whose interests are affected by the assertion of jurisdiction . . . . In every case, however, those interests . . . will be best served by a careful inquiry into the reasonableness of the assertion of jurisdiction in the particular case, and an unwillingness to find the serious burdens on an alien defendant outweighed by minimal interests on the part of the plaintiff or the forum State.

*Asahi Metal Indus.*, 480 U.S. at 115-16.

tion at [ ] a website in the form of an advertisement or solicitation, one has done everything necessary to reach the global [I]nternet audience,"<sup>16</sup> and thus has "purposefully availed" oneself of the benefits of each forum from which one hopes to attract customers.

A recent trademark infringement case in the Southern District of New York affords an example of the "mere injection" approach to Internet postings. The case involved a Missouri website that advertised a local jazz club called the Blue Note. The website was accessible in New York, where the better-known plaintiff Blue Note jazz club is located. The judge held that "[c]reating a site, like placing a product into the stream of commerce, may be felt nationwide—or even worldwide—but, without more, is not an act purposefully directed toward the forum state."<sup>17</sup> In that case, the court stressed that Internet users could not purchase tickets to shows at the Missouri Blue Note through the website. To buy tickets or see a show, New Yorkers would have to travel to Missouri (although they could order tickets from New York via the defendant's 800 number). Thus, the court concluded, the website advertised to New Yorkers (and to anyone else with Internet access), but did not initiate a transaction via the web with these users.

By contrast, in another recent Internet-related trademark infringement case, a federal district court in Connecticut held that the minimum contacts standard was met when an out of state software producer's website was accessible to Connecticut residents, and invited them to call an 800 number to place orders.<sup>18</sup> The Connecticut court did not inquire whether any 800 number transactions had taken place, or even if Connecticut residents with Internet access had in fact logged onto defendant's site. The potential for access to and transactions from the forum apparently sufficed.

In the same vein, while a Missouri court faced with another Internet trademark infringement controversy took evidence on the number of "hits" the defendant's site had received from Missouri, the court's disposition rested more on the potential of the Internet as a marketing tool to the forum, than on the quantifiable in-state

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<sup>16</sup> *Maritz, Inc. v. Cybergold, Inc.*, 947 F. Supp. 1328, 1332 (E.D. Mo. 1996).

<sup>17</sup> *Bensusan Restaurant Corp. v. King*, 937 F. Supp. 295, 301 (S.D.N.Y. 1996).

<sup>18</sup> *See Inset Sys., Inc. v. Instruction Set, Inc.*, 937 F. Supp. 161 (D. Conn. 1996). *But see* Richard S. Zembek, Comment, *Jurisdiction and the Internet: Fundamental Fairness in the Networked World of Cyberspace*, 6 ALB. L.J. SCI. & TECH. 339, 367-75 (1996) (drawing analogies to cases involving interstate advertising and 1-800 numbers, which held that neither the advertisement, nor the toll-free number, standing alone, sufficed to satisfy the minimum contacts standard); *see also* Dan L. Burk, *Federalism in Cyberspace*, 28 CONN. L. REV. 1095, 1111 n.70 (1996) (criticizing *Inset* on the ground that it could lead to assertion of personal jurisdiction over remote users who access websites located in other states).



impact of the website. The court stressed that “the nature and quality of contacts provided by the maintenance of a website on the [I]nternet are clearly of a different nature and quality than other means of contact with a forum such as the mass mailing of solicitations into a forum.”<sup>19</sup> Or, as another district court recently concluded, a commercial website operator “should not be permitted to take advantage of modern technology through an Internet Web page and [CompuServe] forum and simultaneously escape traditional notions of jurisdiction.”<sup>20</sup>

Another federal district court has assessed and attempted to rationalize these decisions by distinguishing “passive Website[s]” such as the Missouri Blue Note’s from interactive sites either “involving the knowing and repeated transmission of computer files over the Internet,” or at least permitting a user to “exchange information with the host computer.”<sup>21</sup> Applying this analysis to our hypothetical, the out of state website that offers *Le Grand Secret* is “interactive”: it does not simply inform users that they can buy the book elsewhere (or through other media); it enables them to acquire it directly from the site.

If interactivity is the key to minimum contacts, must in-state residents have in fact interacted with the website, or does the potential for in-state viewing and storage suffice? Courts that have found the minimum contacts standard satisfied by the in-state accessibility of an out-of-state webpage appear to emphasize potential access by in-state computer users, rather than actual in-state access measured by the number of “hits” to the website. Where in-state users have viewed or downloaded *Le Grand Secret* from the foreign site, it should be clear that the out of state website operator has initiated infringing transactions within the forum. Where the site is accessible in-state but no evidence is submitted as to actual hits, the “potential access” view of minimum contacts would hold that, by inviting residents to view or acquire infringing copies directly from the website, the out-of-state operator avails itself of the benefits of conducting activities within the state.

On the other hand, were the evaluation of minimum contacts limited to actual hits, it is conceivable that no single state would

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<sup>19</sup> *Maritz*, 947 F. Supp. at 1333; accord *Minnesota v. Granite Gate Resorts* (Minn. 2d Dist. 1996) (visited Feb. 17, 1997) <[www.leepfrog.com/E-law/Cases/Minn\\_v\\_Granite\\_Gate.html](http://www.leepfrog.com/E-law/Cases/Minn_v_Granite_Gate.html)> (offshore on-line gambling service based in Belize held to have established minimum contacts with Minnesota because its webpage solicitation was “a direct marketing campaign to the State of Minnesota”).

<sup>20</sup> *EDIAS Software Int’l v. BASIS Int’l Ltd.*, 947 F. Supp. 413, 420 (D. Ariz. 1996).

<sup>21</sup> *Zippo Mfg. Co. v. Zippo Dot Com*, 1997 U.S. Dist. LEXIS 1701 \*12-13 (W.D. Pa. 1997).

have sufficient contacts with the offshore website operator. But this need not mean that no U.S. court will be competent to hear a copyright infringement claim against the foreign defendant. Because the claim arises under federal copyright law, Federal Rule of Civil Procedure 4(k)(2) affords a special basis of personal jurisdiction in exactly this kind of situation. The Rule provides:

If the exercise of jurisdiction is consistent with the Constitution and laws of the United States, serving a summons or filing a waiver of service is also effective, with respect to claims arising under federal law, to establish personal jurisdiction over the person of any defendant who is not subject to the jurisdiction of the courts of general jurisdiction of any state.<sup>22</sup>

Thus, so long as there are a sufficient number of *nationwide* hits to satisfy minimum contacts standards, a federal district court will have personal jurisdiction over the foreign website operator. In applying Rule 4(k)(2) to foreign (non-U.S.) corporations, federal courts have held that "personal jurisdiction may be asserted by courts where a foreign corporation, through an act performed elsewhere, causes an effect in the United States."<sup>23</sup> Similarly,

where American residents have been intentionally solicited or targeted by the allegedly tortious conduct and there are sufficient contacts overall with the United States, a court may find that the exercise of personal jurisdiction would not offend the minimum contacts requirement of due process even where the conduct that proximately causes the injury occurs outside this country's borders.<sup>24</sup>

A U.S. federal court could determine that the invitation from the operator of U.K. website to U.S. users to download *Le Grand Secret* is an act causing an effect (creation of infringing copies) in the United States.

Rule 4(k)(2) only applies, however, in the event that all state courts would lack judicial competence. In many, if not most, instances it is likely that a state's doctrine on personal jurisdiction would reach the foreign website operator, particularly if the state's

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<sup>22</sup> FED. R. CIV. P. 4(k)(2).

<sup>23</sup> *Eskofot A/S v. E.I. Du Pont De Nemours & Co.*, 872 F. Supp. 81, 87 (S.D.N.Y. 1995) (antitrust claim by Danish corporation against U.K. corporation alleging anticompetitive acts in Europe that barred plaintiff's entry into U.S. market); *accord* *United States v. Int'l Bhd. of Teamsters*, 945 F. Supp. 609 (S.D.N.Y. 1996) (RICO claim against Canadian corporation).

<sup>24</sup> *Aerogroup Int'l Inc. v. Marlboro Footworks, Ltd.*, No. 96 CIV. 2717 (DLC), 1996 U.S. Dist. LEXIS 19051, \*41 (S.D.N.Y. Dec. 24, 1996) (applying Rule 4(k)(2) in a trademark infringement action and finding insufficient nation-wide contacts).

long-arm statute is coextensive with constitutional standards. But in some states constitutional norms may not supply the only limits on the court's competence; the long-arm statute in force in the state in which the federal court sits may decline to exercise the state's power over foreign defendants to the full extent allowed by the federal Constitution.<sup>25</sup> Take, for example, the New York long-arm statute. Section 302 of New York Civil Practice Law and Rules offers two relevant bases for asserting personal jurisdiction over the U.K. defendant. One is based on "commit[ting] a tortious act within the state," when the claim arises from that act.<sup>26</sup> Another basis is more circumscribed. It recognizes jurisdiction based on tortious acts committed outside the state that cause injury within the state, but also requires that defendant reasonably should have expected its acts to have in-state consequences, and that the defendant "derive[d] substantial revenue from interstate or international commerce."<sup>27</sup>

When in-state users access and download allegedly infringing copies from the foreign website, has a tort been committed in the state, thus triggering the first basis for personal jurisdiction? Or does the tort (unauthorized copying or distribution) originate out-of-state, with only an impact (the copies) occurring in-state, thus triggering the potentially more restrictive second basis for judicial competence?

The prevailing view (at least in the United States and the European Union) on communication of works over digital networks holds that copies are made when the work is received, even temporarily, in the memory of a computer.<sup>28</sup> As a result, when the in-

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<sup>25</sup> Compare R.I. GEN. LAWS § 9-5-33 (1956), CAL. CIV. CODE § 410.10 (West 1973), N.J. STAT. ANN. § 4:4-4 (West 1996), TEX. REV. CIV. STAT. ANN. art. 2031b (West 1996), and TENN. CODE ANN. § 20-2-214 (1994) (state long-arms going to full extent permitted by constitution) with MD. CODE ANN., CTS. & JUD. PROC. §§ 6-102 to -103 (1995), FLA. STAT. ANN. § 48.193(1)(g) (West 1997), and GA. CODE ANN. § 9-10-91 (1996) (state long-arms of more limited reach).

<sup>26</sup> N.Y. C.P.L.R. § 302(a)(2) (McKinney 1996).

<sup>27</sup> *Id.* § 302(a)(3)(ii).

<sup>28</sup> Electronic distribution entails the making of "copies" within the meaning of the 1976 Copyright Act, 17 U.S.C. § 101 (1994), at least as amended in 1980, when Congress adopted the recommendations of the Commission on New Technological Uses ("CONTU"). Under the CONTU approach, a "copy" is made when a computer program (or by extension, any work expressed digitally) is received into the computer's temporary memory. See FINAL REPORT OF THE NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS (1978), cited in ROBERT A. GORMAN & JANE C. GINSBURG, COPYRIGHT FOR THE NINETIES 692 & n.164 (4th ed. 1993). This approach is the premise for section 117 of the U.S. Copyright Act, and has been followed in the European Union. See Council Directive 91/250, art. 4(a), 1991 O.J. (L 122) 42. American courts have also applied this principle. See, e.g., MAI Sys. Corp. v. Peak Computer, Inc., 991 F.2d 511, 517 (9th Cir. 1993); Advanced Computer Servs. v. MAI Sys. Corp., 845 F. Supp. 356, 362 (E.D. Va. 1994) (unauthorized loading of a program into computer's temporary memory held to create an

state receiver accesses or downloads *Le Grand Secret* at her home computer, she has created an unauthorized copy; a tortious act has thus been committed in the state. But by whom? The offshore website operator has not engaged in-state copying, it has simply made it possible for in-state actors to copy. Under this reasoning, the operator could be seen as a contributory infringer.<sup>29</sup>

But one might also characterize the offshore defendant's activities as directly effecting a distribution in the state. In a recent Southern District of New York decision, Judge Scheindlin held that an Italian defendant who operated an Italian website from which U.S. users could access and download images from *Playmen* magazine—in violation of the trademark rights of *Playboy* magazine—was not only distributing the images, but was engaging in distribution within the United States. This distribution violated a 1980 order enjoining the defendant from distributing *Playmen* (then extant only in print format) in the U.S. The foreign website operator had contended that it was “merely posting pictorial images on a computer server in Italy [where distribution of *Playmen* was lawful],<sup>30</sup> rather than distributing those images to anyone within the United States.”<sup>31</sup> In effect, argued the defendant, U.S. users are taking a virtual voyage to Italy, acquiring *Playmen* there, and returning to the United States with their copies. The court rejected this argument, stressing “[t]hat the local user ‘pulls’ these images from [defendant’s] computer in Italy, as opposed to [defendant]

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infringing copy); *Telerate Sys. Inc. v. Caro*, 689 F. Supp. 221, 231 (S.D.N.Y. 1988) (unauthorized remote access to database: receipt of data in unauthorized user's computer held to create a copy). Thus, to receive an electronic distribution is to make a copy, even if no further, more permanent, copy follows. See generally INFORMATION INFRASTRUCTURE TASK FORCE, INTELLECTUAL PROPERTY AND THE NATIONAL INFORMATION INFRASTRUCTURE: THE REPORT OF THE WORKING GROUP ON INTELLECTUAL PROPERTY RIGHTS 64 & n.66 (1995).

However, several commentators have questioned or even strongly criticized the proposition that receipt in a computer's random access memory entails making a “copy.” See, e.g., David Post, *New Wine, Old Bottles: The Evanescent Copy*, AM. LAW., May, 1995, at 103 (questioning); Jessica Litman, *The Exclusive Right to Read*, 13 CARDOZO ARTS & ENT. L.J. 29, 40 & n.43 (1994) (criticizing); Pamela Samuelson, *Legally Speaking: The NII Intellectual Property Report*, COMM. ACM, Dec. 1994, at 21, 22 (criticizing). But cf. Ira L. Brandriss, *Writing in Frost on a Window Pane: E-mail and Chatting on RAM and Copyright Fixation*, 43 J. COPYRIGHT SOC'Y 237 (1996) (distinguishing infringing copying—which may be accomplished by transitory perceptible access—from fixation in creating a work of authorship, which should require a more stable format).

<sup>29</sup> See, e.g., *Fonovisa, Inc. v. Cherry Auction, Inc.*, 76 F.3d 259 (9th Cir. 1996); *Gershwin Publ'g Corp. v. Columbia Artists Management, Inc.*, 443 F.2d 1159 (2d Cir. 1971); *Polygram Int'l Publ'g, Inc. v. Nevada/TIG, Inc.*, 855 F. Supp. 1314 (D. Mass. 1994).

<sup>30</sup> See *Playboy Enters., Inc. v. Chuckleberry Publ'g, Inc.*, 486 F. Supp. 414, 423 & nn. 11-12 (S.D.N.Y. 1980) (noting that PEI “succeeded in preventing dilution of the mark by *Playmen* everywhere but Italy, where a standard inconsistent with our law was applied to deny *Playboy* any protection”).

<sup>31</sup> *Playboy Enters. v. Chuckleberry Publ'g, Inc.*, 939 F. Supp. 1032, 1039 (S.D.N.Y. 1996) (granting motion for a finding of contempt).

'sending' them to this country, is irrelevant. By inviting United States users to download these images, [defendant] is causing and contributing to their distribution in the United States."<sup>32</sup>

By contrast, in an earlier ruling on the motion for a finding of contempt, the court had found that a distribution in the United States had occurred when U.S. users, upon viewing the *Playmen* teaser screens ("Playmen Lite"), requested a password to view more ("Playmen Pro"). In this opinion, Judge Scheindlin was less clear as to whether simply viewing the "Playmen Lite" images in the United States (without the additional e-mail or fax transaction to obtain the password to "Playmen Pro") constituted a distribution in the United States.<sup>33</sup> There was a distribution, but its localization at first seemed uncertain.

In the *Le Grand Secret* hypothetical, the difference between distributing in the United States and distributing in some unspecified location correlates to the two long-arm bases cited earlier: tortious act committed in the state and tortious act committed out of state, with impact in state (and additional conditions). If the U.K. website operator were making *Le Grand Secret* available to U.S. users without requiring additional transactions (such as the purchase of a password), under the reasoning of Judge Scheindlin's second opinion in *Playboy Enters.* there would still be a U.S. distribution because U.S. users would be receiving copies on their screens that they could also printout or download to permanent memory. Under her first opinion in *Playboy Enters.*, by contrast, the place of distribution being uncertain, perhaps the only basis of personal jurisdiction (in a federal court sitting in a state with a long-arm statute like New York's) would be the latter one. In that case, the copyright owner would need to show that the U.K. website operator should have foreseen U.S. downloads, and that the U.K. defendant derived substantial revenue from interstate or international commerce.

With respect to the defendant's source of revenue, one might expect that the copyright owner would not attempt to secure jurisdiction in the U.S. courts over the U.K. website operator if the operator lacked assets in the United States against which a judgment could be enforced. But that may be too swift an assumption. Suppose that the plaintiff was seeking an injunction to block access by U.S. users to the U.K. website.<sup>34</sup> (Plaintiff could, of course, go

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<sup>32</sup> *Id.* at 1044 (denying motion for reconsideration).

<sup>33</sup> *See id.* at 1039.

<sup>34</sup> U.S. courts may enter injunctions "sufficiently broad to include actions taken outside

against the U.K. actor in the United Kingdom, but it would prefer to get as much coverage as possible in a single action.<sup>35</sup>) In that case, the “substantial revenue” limitation could bar asserting the claim against the offshore actor.

As for foreseeability, it should be clear that once a document is posted on a website, it is foreseeable that it can be accessed anywhere in the world (assuming that the operator has not specifically limited access).

## 2. Scope of the claim

Assuming that the contacts between the offshore website operator and the U.S. forum are not too tenuous to justify assertion of personal jurisdiction over our hypothetical U.K. operator, the next question is: what is the territorial scope of the claim? If the claim is based on the intra-U.S. impact of an infringement originating outside the United States, then the non-resident alleged infringer would normally be obliged to defend against only those acts that can be localized in the United States.<sup>36</sup> The plaintiff would not be able to bootstrap extraterritorial acts, such as the distribution of copies in the United Kingdom or elsewhere in the world, to its U.S. claim. Otherwise, as a practical matter, there would be no difference between the “specific” jurisdiction exercised against a non-resident defendant under a long-arm statute and the “general” jurisdiction to which a resident defendant would be subject.

Now, that makes some sense if one is thinking only in terms of the normally appropriate power of the court to hale a foreign defendant before it. If one is thinking of the plaintiff who is facing a worldwide infringement, this reasoning means that the plaintiff may have to litigate its infringement claims around the world, in each country of receipt/access. Of course, plaintiff could go to the source country of the infringement, or the domicile of the in-

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the United States which have a significant impact on U.S. commerce.” *Nintendo of America, Inc. v. Aeropower Co.*, 34 F.3d 246, 249 (4th Cir. 1994).

<sup>35</sup> Moreover, under U.K. jurisdictional approaches, the plaintiff may not be able to try in a U.K. court those aspects of the claim that involve infringements taking place outside the United Kingdom. See *Cornish*, *supra* note 5, at 286, 287 n.7.

<sup>36</sup> *Accord Shevill*, 1995 E.C.R. 289, ¶ 33. In a libel action, Brussels Convention, *supra* note 8, art. 5.3, authorizes a victim to

bring an action for damages against the publisher either before the courts of the contracting state of the place where the publisher of the defamatory publication is established, which have jurisdiction to award damages for all the harm caused by the defamation, or before the courts of each contracting state in which the publication was distributed and where the victim claims to have suffered injury to his reputation, which have jurisdiction to rule solely in respect of the harm caused in the state of the court seised.

*Id.*

fringer, but this alternative presents at least two problems. First, as illustrated by the entrepreneurial copier of *Le Grand Secret* who uploaded the book to sites in the United States, the United Kingdom, and Canada, there may be more than one source country. Second, even assuming a single source, a rule that limits trial of the entire action to the source country or to defendant's domicile may well spawn opportunistic relocation of servers and corporate domiciles to the copyright equivalent of the Cayman Islands.

Is there an alternative to litigating either everywhere, or, as a practical matter, nowhere? Libel and defamation law may supply a helpful analogy. The "single publication rule" responds to a similar problem. When a defamatory statement has been published, broadcast, or transmitted to many jurisdictions, one could imagine that receipt of the libel in each jurisdiction constitutes a distinct tort,<sup>37</sup> thus obliging the plaintiff to sue in many fora, and putting defendant at risk of inconsistent outcomes. Instead, the "single publication rule" (judge-made in some states, legislated in others) deems an "aggregate communication," such as an edition of a newspaper or a radio broadcast, a "single publication"; while plaintiff may still select among potentially competent fora, she may only choose one.<sup>38</sup> Moreover, "recovery in any action shall include all damages for any such tort suffered by the plaintiff in all jurisdictions."<sup>39</sup> The purpose of the rule is "avoiding multiplicity of suits, as well as harassment of defendants and possible hardship upon the plaintiff himself."<sup>40</sup> In effect, the single publication rule makes compulsory the joinder of claims that the plaintiff could have brought against the defendant in other fora.

Does the territorial scope of the damages claim asserted under the single publication rule transcend U.S. borders? While I am not aware of any U.S. defamation decisions awarding damages for extraterritorial publications,<sup>41</sup> the *Restatement (Second) of Torts* is clear that a plaintiff may so recover:

In [plaintiff's] single action he may recover damages for the publication to all persons whom the communication has reached or may be expected to reach . . . . This is true even though the publication has crossed state lines and has been read, heard or seen in every state and in foreign countries; and

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<sup>37</sup> See *Keeton v. Hustler Magazine*, 465 U.S. 770, 777 (1984) ("The tort of libel is generally held to occur wherever the offending material is circulated.").

<sup>38</sup> See RESTATEMENT (SECOND) OF TORTS § 577A (1977).

<sup>39</sup> UNIF. SINGLE PUBLICATION ACT § 1, 14 U.L.A. 377 (1990).

<sup>40</sup> RESTATEMENT, *supra* note 38, § 577A, cmt. d.

<sup>41</sup> *Cf. Watt v. Longsdon*, 1 K.B. 130 (1930) (calculating damages to include distribution of English publication in Morocco).

all damages sustained in all jurisdictions may be recovered in the one action.<sup>42</sup>

Were courts to adapt the single publication rule to copyright infringement in cyberspace, a U.S. court with personal jurisdiction over our hypothetical U.K. website operator would be able to award damages not only for U.S. downloads, but for all downloads, wherever localized (assuming it were possible to calculate or estimate their extent).<sup>43</sup> The rule thus could usefully simplify the plaintiff's claim, as well as the defendant's exposure to subsequent litigation. The rule's actual effectiveness would depend on whether the U.K. defendant has sufficient U.S. assets to satisfy the judgment, or if not, whether a U.K. court would recognize such a judgment.<sup>44</sup>

Now, if a single publication rule for international copyright infringement claims is such a good idea, why haven't U.S. courts already adopted it? After all, multinational infringements are not new with cyberspace, although cyberspace certainly aggravates the problem. One reason may be that, with respect to multinational infringements that did not involve distribution or public performance of works in the United States, there may have been no basis for personal jurisdiction over a foreign infringer. In cyberspace, by contrast, even far away infringements can come to the United States, and thus potentially subject the offshore defendant to the jurisdiction of our courts. A more significant reason may be that, in the United States, copyright is exclusive federal subject matter. Courts and litigants did not *need* a single publication rule for copyright, because one copyright action already covered the whole na-

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<sup>42</sup> RESTATEMENT, *supra* note 38, § 577A, cmt. e; *see id.* illus. 8:

A publishes in a magazine of national circulation an article in which he states that B beats his wife. The magazine is read by a million readers in all states of the United States and in foreign countries. B brings an action against A for a defamation. In this action B may recover damages based on the communication to all of these readers.

<sup>43</sup> There may be some question as to whether there has been a "single publication" when the work is "distributed" not by communication to users who receive the copies or the performance at the same time, but rather by means of the users themselves, whose access to the work will be intermittent and disjoined in time. Nonetheless, since each user is presumably receiving the same communication from the same website, the "single" quality of the publication should persist. *See id.* § 577A, cmt. d.

<sup>44</sup> It is not clear whether a U.K. court would recognize the judgment. The single publication rule appears inconsistent with the European Court of Justice's determination in *Shevill*, 1995 E.C.R. 289. *See supra* note 36.

Outside the European Union, a British Columbian court, in a libel action where the libel was published in British Columbia, Alberta, and Saskatchewan, awarded damages for harm caused by the publication in all three jurisdictions; this was permissible because the libel was wrongful under the law of all the jurisdictions and there were no significant differences in the libel laws of the jurisdictions. *See Hubert v. DeCamillis* [1963] 41 D.L.R. (2d) 495. Thus, it seems that other jurisdictions could apply the single publication rule.



tional territory.<sup>45</sup> On the other hand, even U.S.-originated infringements can impact abroad, notably in Canada. As to these claims, however, litigants in the past appear to have concentrated on whether U.S. copyright law could apply to extraterritorial acts or impacts, not on whether plaintiff could be compelled to add the foreign claim to the U.S. action. As a U.S. court has emphasized, “[t]he single publication rule is not a choice-of-law rule. Instead, the single publication rule determines how many causes of action a plaintiff might have . . . .”<sup>46</sup> And with this distinction between the single publication rule and choice of law, it is now appropriate to turn to the latter issue.

### III. CHOICE OF LAW

First, if my proposal to adopt a single publication rule for multinational infringements in cyberspace were adopted, would the choice of law analysis be simplified as well? Not necessarily. While in single publication rule cases the forum applies its own law to determine the applicable statute of limitations,<sup>47</sup> it is unclear what law applies to the substance of the defamation claim. Indeed, it is not even clear if the forum should apply one law,<sup>48</sup> or as many laws as there are jurisdictions to which the libel was communicated.<sup>49</sup> Ultimately, the appropriateness of the forum applying its own law (and only its own law) may depend on the facts of the alleged infringement.

#### A. *The U.S. Forum is Defendant’s Domicile—or is the Point of Origin of the Infringement*

Let us return to the comparatively straightforward situation in which the allegedly infringing communication originates from a U.S. website. Clearly, U.S. copyright law would apply to all U.S. access of the work, and the court should be able to enjoin the oper-

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<sup>45</sup> Cf. *Ettore v. Philco Television Broad. Corp.*, 229 F.2d 481 (3d Cir. 1956) (adjudicating right of publicity claims by Pennsylvania resident arising out of unauthorized television broadcast received in Pennsylvania, Delaware, New Jersey, and New York; right of publicity claims, albeit a form of intellectual property, are state rather than federal claims).

<sup>46</sup> *Givens*, 877 F. Supp. at 488.

<sup>47</sup> See *Sun Oil v. Wortman*, 486 U.S. 717 (1988). This is true even if the forum ends up applying another state’s statute of limitations; it would have done so under its own “borrowing statute,” which directs the forum to look to the statute of limitations in force in the state of first publication. See *Givens*, 877 F. Supp. at 487.

<sup>48</sup> See David S. Welkowitz, *Preemption, Extraterritoriality, and the Problem of State Antidilution Laws*, 67 TUL. L. REV. 1, 21 (1992) (“There is scant precedent as to what law should apply, although the logic of the single publication rule and judicial economy considerations suggest that a single state law should apply to the entire transaction.”).

<sup>49</sup> See *Ettore*, 229 F.2d at 481 (distributive application of the law of each state where unauthorized broadcast of prizefight was received).

ation of the U.S. site altogether. But what law applies to copies made outside the United States, when offshore users logged onto the U.S. site? Still U.S. law, or the laws of the countries of end use? Our ever-present desire to keep things simple would counsel application of U.S. law, even to infringements that culminate offshore. The case law, however, is conflicted. There appears to be a split between the Ninth Circuit and other courts, most notably the Second Circuit.

In a series of decisions dating back to 1939, the Second Circuit has upheld the application of U.S. law to distribution of copies abroad, when the foreign copies were further reproductions of an initial infringing reproduction committed in the United States.<sup>50</sup> Other courts have also applied this master copy approach to the extraterritorial extension of U.S. copyright law.<sup>51</sup> The Second Circuit has, however, distinguished the master copy cases when plaintiff sought recovery for offshore live *performances* of copyrighted works. When an unauthorized performance takes place abroad, the material connection to the United States provided by an initial unauthorized reproduction is considered lacking.<sup>52</sup>

The Ninth Circuit appears more reluctant to apply U.S. copyright law to extraterritorial acts. In a recent decision concerning videocassette rights to the Beatles' film *Yellow Submarine*, the court declined to apply U.S. law to a claim that the U.S. defendant had "authorized" offshore actors to make and distribute videocassettes of the film, in violation of plaintiff's alleged rights.<sup>53</sup> None of the allegedly infringing videocassettes were manufactured or sold in the United States.

Although the U.S. Copyright Act confers on authors the exclu-

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<sup>50</sup> See, e.g., *Sheldon v. Metro-Goldwyn Pictures, Corp.*, 106 F.2d 45 (2d Cir. 1939), *aff'd*, 309 U.S. 390 (1940) (distribution in Canada of motion picture held to infringe plaintiff's play); *Update Art Inc. v. Modiin Publ'g Ltd.*, 843 F.2d 67 (2d Cir. 1988) (publication in Israel of photograph of poster; initial copy of photograph allegedly made in United States and sent to Israel for further copying and distribution); *Famous Music Corp. v. Seeco Records, Inc.*, 201 F. Supp. 560 (S.D.N.Y. 1961) (pirate records sold in Europe allegedly made from illicit U.S. master tape); see also *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, No. 96 CIV. 1103 (MBM), 1996 U.S. Dist. LEXIS 18653, at \*19 (S.D.N.Y. Dec. 16, 1996) (dismissing copyright infringement claim because plaintiff "failed to allege an infringement within the United States that led to extraterritorial infringement").

<sup>51</sup> See *P & D Int'l v. Halsey Publ'g Co.*, 672 F. Supp. 1429 (S.D. Fla. 1987) (unauthorized exhibition on cruise ship of film print made without authorization in Miami).

<sup>52</sup> See *Robert Stigwood Group Ltd. v. O'Reilly*, 530 F.2d 1096, 1100 (2d Cir. 1976) (distinguishing *Sheldon*, 106 F.2d 45, on the ground that case involved a U.S. reproduction further reproduced in Canada, while case at bar concerned live performances in Canada); *Gasté v. Kaiserman*, 683 F. Supp. 63, 65 (S.D.N.Y.), *aff'd*, 863 F.2d 1061 (2d Cir. 1988) (no recovery for infringing performances abroad, unless plaintiff can show that these performances "resulted from the reproduction of recordings originally made in the United States").

<sup>53</sup> *Subafilms, Ltd. v. MGM-Pathe Communications Co.*, 24 F.3d 1088 (9th Cir. 1994).

sive rights "to do and to authorize" certain acts, including reproduction, distribution, and public performance,<sup>54</sup> the Ninth Circuit held that "authorization" alone is insufficient to justify the application of U.S. law.<sup>55</sup> Invoking the national treatment principle of the Berne Convention,<sup>56</sup> the Ninth Circuit stressed that copyright is territorial, and that courts should therefore apply the law of the countries where the infringing distribution takes place.<sup>57</sup>

*Subafilms* was not necessarily inconsistent with the Second Circuit decisions, since no infringing master copy was alleged to have been made in California, and the Second Circuit cases did not involve "mere authorization." A later Ninth Circuit decision, however, seems more in tension. In a controversy concerning the diversion of the Showtime cable signal to Canadian viewers, the Ninth Circuit held that it made no difference whether the U.S. defendant had authorized Canadians to appropriate the signal, or had instead itself broadcast the signal from the United States to Canada. "In either case, the potential infringement was only completed in Canada once the signal was received and viewed."<sup>58</sup>

The Ninth Circuit's approach has provoked criticism from commentators<sup>59</sup> and, to date, one district court, in Tennessee.<sup>60</sup> For that court, the Ninth Circuit's analysis was artificial and out of touch. "[P]iracy has changed since the Barbary days," the *Curb* court emphasized.<sup>61</sup>

Today, the raider need not grab the bounty with his own hands; he need only transmit his go-ahead by wire or telefax to start the presses in a distant land. *Subafilms* ignores this economic reality . . . . Under [the Ninth Circuit's] view, a phone call to Nebraska [from the United States] results in liability; the same phone call to France results in riches. In a global marketplace, it is literally a distinction without a difference.<sup>62</sup>

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<sup>54</sup> 17 U.S.C. § 106 (1994).

<sup>55</sup> *Subafilms*, 24 F.3d 1088.

<sup>56</sup> Berne Convention for the Protection of Literary and Artistic Works, *as last amended* Oct. 2, 1979, 828 U.N.T.S. 221 [hereinafter Berne Convention].

<sup>57</sup> "Extraterritorial application of American law would be contrary to the spirit of the Berne Convention, and might offend other member nations by effectively displacing their law in circumstances in which previously it was assumed to govern." *Subafilms*, 24 F.3d at 1097.

<sup>58</sup> *Allarcom Pay TV Ltd. v. General Instrument Corp.*, 69 F.3d 381, 387 (9th Cir. 1995).

<sup>59</sup> *See, e.g.*, Michael W. Ballance, *Third-Party Innocence: Domestic Authorization of Foreign Copyright Infringement and Subafilms, Ltd. v. MGM-Pathé Communications Co.*, 20 N.C.J. INT'L L. & COM. REG. 435 (1995); Jason S. Hartley, *Subafilms, Ltd. v. MGM-Pathé Communications Co.: The Ninth Circuit Allows Direct Copyright Infringers to Escape Liability*, 4 TUL. J. INT'L & COMP. L. 345 (1996).

<sup>60</sup> *Curb v. MCA Records, Inc.*, 898 F. Supp. 586 (M.D. Tenn. 1995).

<sup>61</sup> *Id.* at 595.

<sup>62</sup> *Id.* The court may have overstated its proposition, given that the same act that vio-

What is the relationship of this debate to our hypothetical U.S. website? When foreign users log onto the U.S. site and download copies to their computers outside the United States, these acts could be characterized as further reproductions made from the illicit master copy on the U.S. website, and thus within the scope of U.S. law, as the Second Circuit has articulated the law's reach. Alternatively, applying the Ninth Circuit's approach, one might view the website as an invitation ("authorization") to all Internet users to access the document and produce copies. U.S. downloads would be governed by U.S. law (that would be true were the server located in the United Kingdom as well), but foreign downloads, since they "culminate" off shore, would be subject to the law of the place of receipt.

One begins to appreciate the Tennessee court's frustration with insistence on the dual conditions of territoriality and materiality. Perhaps courts should be less materialistic about identifying infringement, and recognize that intellectual acts of planning unauthorized acts of copying, public performance, or distribution can be localized here in the United States.<sup>63</sup> In the networked world of dematerialized copies, the U.S. originator of an infringing communication can attempt to elude the application of her own law by ensuring that copies are initially "sent" from a server outside the United States to destinations outside the United States. This illustrates the problem with confining legislative competence over the alleged infringement to the place where copies are made.<sup>64</sup> It may make more sense to identify the place where the plan to engage in unauthorized dissemination was devised, and then to consider the application of that place's law. I would argue that if it is possible to localize in the United States the point from which the unauthorized communication becomes available to the public (wherever that public be located), then U.S. law should apply to all unauthorized copies, wherever communicated. Similarly, where the United States is the nerve center for foreign distributions, the domestic

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lates U.S. law might well violate French copyright law, so riches might not ultimately result there, either. On the other hand, the defendant could achieve a substantial practical advantage if a U.S. court, persuaded that U.S. law does not apply, and that the laws of the countries where the physical copying occurred did apply, then dismissed the claim on *forum non conveniens* grounds, remitting the plaintiff to suing in each of the countries where copying occurred. See discussion *infra*, section III.B.

<sup>63</sup> Cf. *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 101 A.D.2d 753 (N.Y. Sup. Ct. 1984) (retaining jurisdiction to apply New York unfair competition law to New York headquartered defendant who allegedly conceived and directed from New York a scheme to infringe plaintiff's trademark rights in many foreign countries).

<sup>64</sup> See *Burk*, *supra* note 18, at 1111-15 (discussing the difficulty of discerning physical locations of Internet users).

acts of planning and intellectually implementing the offshore acts should suffice to justify the application of U.S. law to the foreign communications.

Is this recommendation consistent with the conflicts rule of the Berne Convention, which directs application of the law of the country “where protection is claimed” to govern infringement claims?<sup>65</sup> One can read that text to require distributive application of the laws of all of the countries in which infringing copies appear.<sup>66</sup> Or one could contend that the “country where protection is claimed” is the forum country when that is the country from which the infringement originated, and which is best placed to accord an effective international remedy.<sup>67</sup>

Similarly, if the basis of judicial competence is the U.S. domicile of the defendant, rather than the U.S. point of origin of the communication, I would argue that U.S. law should still apply to the entirety of the infringing acts. Indeed, to some extent, the “point of origin” approach and the defendant’s domicile may converge: the defendant’s domicile is likely to be the same as the place from which defendant planned a series of unauthorized acts, many of them culminating abroad.<sup>68</sup> Moreover, the law of headquarters (especially when that is the place from which defendant devised and executed its program of international infringement) has a close relationship to all the alleged illicit acts; that law will produce the same result, whatever the destination of the pirated copies. In addition, under U.S. conflict of laws principles, the forum has a strong interest in regulating the activities of its domiciliaries.<sup>69</sup>

This analysis has focused on application by a U.S. court of its own law when that law is the law of the point of origin of the allegedly infringing digital communication, or of defendant’s domicile. The “domicile” and “origin of the communication” points of attachment are not fully generalizable: to make these the choice of law rules in all cases would again spur manipulation of these criteria in order to localize them in the “Cayman Islands of copyright.”

<sup>65</sup> Berne Convention, *supra* note 56, art. 5.2.

<sup>66</sup> See, e.g., Pierre-Yves Gautier, *Du droit applicable dans le <<village planétaire>>, au titre de l’usage immatériel des œuvres*, D.S. Jur. 131 (1996).

<sup>67</sup> Cf. Paul Edward Geller, *Conflict of Laws in Cyberspace: Rethinking International Copyright in a Digitally Networked World*, 20 COLUM.-VLA J.L. & ARTS 571, 597 (1996) (making a similar argument, in the context of infringements for which a point of origin cannot easily be identified); Michel Vivant, *Cybermonde: Droit et droits des réseaux*, JCP [1996] I [3969], para. 6.

<sup>68</sup> Cf. *Shevill*, 1995 E.C.R. 289, ¶ 24 (reconciling judicial competence under Brussels Convention, *supra* note 8, art. 2—defendant’s habitual residence—and art. 5.3—point of origin of a multinational tort—on the ground that these will often be the same).

<sup>69</sup> See, e.g., *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 508-09 (1947).

Thus, any generalization of these criteria would require that a court ascertain whether the law designated by these points of attachment meets minimum standards of copyright protection, such as those set forth in the Berne Convention and the Agreement on Trade Related aspects of Intellectual Property ("TRIPS").<sup>70</sup>

B. *The Infringement Originated Outside the U.S. Forum, and Defendant Is a Non-Domiciliary*

Finally, let us return to the U.K. website operator, who is before the U.S. courts on a long-arm basis. The single publication rule (if adapted to international copyright cases) would subject the foreign defendant to suit in the United States for non-U.S. distributions as well, but we have yet to resolve which law(s) apply to those distributions. While the simplest solution would be to apply U.S. copyright law to all downloads, the relationship of the U.S. to foreign downloads from a foreign website seems too attenuated (assuming the operator is also non-U.S.) to justify such extensive application of U.S. law. Rather, the court should either apply the law of the place of the server or of the defendant's domicile. However, if these places are copyright havens, then the court should revert to the traditional territorial approach and apply the law of each country of receipt. Copyright is a "transitory cause of action": so long as the court has personal jurisdiction over the foreign defendant, it can apply a foreign copyright law.<sup>71</sup>

Moreover, the court *should* apply foreign law, especially when the claim presents many points of attachment with the forum, and no other forum is likely to be able to adjudicate the entirety of the action. U.S. courts too often dismiss on grounds of *forum non conveniens* when called upon to apply foreign law.<sup>72</sup> For example, in a

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<sup>70</sup> See generally Agreement on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, LEGAL INSTRUMENT—RESULTS OF THE URUGUAY ROUND vol. 31, 33 I.L.M. 81 (1994); cf. Comment 10 to proposed section 2B-106 of the Uniform Commercial Code (draft 1996) (protective rule if the foreign law otherwise applicable confers too low a level of protection) (visited Feb. 18, 1997) <www.law.uh.edu/ucc2b/>.

<sup>71</sup> See, e.g., *London Film Prods. Ltd. v. Intercontinental Communications, Inc.*, 580 F. Supp. 47 (S.D.N.Y. 1984); III PAUL GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW & PRACTICE § 16.2 (2d ed. 1996).

<sup>72</sup> See *Timberlane Lumber Co. v. Bank of Am. Nat'l Trust & Sav. Ass'n*, 549 F.2d 597, 616 (9th Cir. 1976) (dismissing antitrust claim on *forum non conveniens* grounds because, *inter alia*, Honduran law applied); see also *Gulf Oil Corp.*, 330 U.S. at 509 (stating that it is appropriate to try a diversity case "in a forum that is at home with the state law that must govern the case, rather than having a court in some other forum untangle problems in conflict of laws, and in law foreign to itself."). But see *London Film Prods.*, 580 F. Supp. at 49 (retaining exercise of federal diversity jurisdiction over foreign law claim by U.K. plaintiff against U.S. defendant alleged to have licensed plaintiff's films for exhibition in South

recent decision involving worldwide videocassette rights to Stravinsky's *Rite of Spring*, recorded on the soundtrack to Disney's *Fantasia*, the Southern District of New York dismissed the action, remitting the plaintiff music publisher to trying its copyright infringement claims in each of the eighteen foreign countries where videocassettes of *Fantasia* were distributed.<sup>73</sup> Because the U.S. copyright in the work had never been secured, there was no U.S. copyright claim. There were nonetheless substantial U.S. contacts to the litigation: defendant was a U.S. corporation; the contract in which Stravinsky granted rights to record *Rite of Spring* onto the film soundtrack was signed in New York and governed by New York law. The court justified its *forum non conveniens* dismissal on the grounds that the substantive copyright issues would best be tried in the countries whose domestic copyright laws would be called into play.

This is a weak basis for dismissal when the United States probably was the only forum in which all eighteen copyright claims could have been adjudicated. Nor would the copyright issues necessarily have been better resolved in eighteen different proceedings. The substantive issue in the case was whether a 1939 contract authorizing recording of the music onto the film's soundtrack for exhibition of the film in theaters should be interpreted to authorize reproduction and public distribution of videocassettes of the film. The Southern District of New York could have heard proof on the resolution of the old license/new media issue under the laws of the eighteen countries at issue. While other countries may resolve that issue differently, the issue under foreign law is no more elusive than it is under U.S. law.

Assuming that the court should apply foreign copyright law to the non-U.S. based claims, must the plaintiff plead and prove the laws of all 100 or more other countries where the work could have been received, and for which the plaintiff seeks damages? Perhaps resorting to a presumption that foreign copyright law resembles U.S. copyright law would help. U.S. courts have occasionally applied such a presumption, leaving it to the defendant to demonstrate that, in certain jurisdictions, the law is different.<sup>74</sup> The

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America, without plaintiff's authorization, and in violation of plaintiff's rights in the South American countries at issue).

<sup>73</sup> *Boosey & Hawkes Music Publishers, Ltd. v. Walt Disney Co.*, 934 F. Supp. 119 (S.D.N.Y. 1996).

<sup>74</sup> *See, e.g.*, *Louknitsky v. Louknitsky*, 266 P.2d 910 (1954); *Leary v. Gledhill*, 84 A.2d 725 (1951). *But cf.* *Phillips Petroleum Co. v. Shutts*, 472 U.S. 797 (1985) (declining to apply Kansas law when that law conflicted with that of other jurisdictions, and Kansas had little connection to either the class action plaintiffs or the suit's subject matter); *Castano v. American Tobacco Co.*, 84 F.3d 734, 740-44 (5th Cir. 1996) (decertifying multistate class

presumption may be particularly appropriate in the copyright area, where over 100 countries are members of the Berne Convention, a multilateral treaty that imposes substantive minimum standards of copyright protection.<sup>75</sup>

#### IV. CONCLUSION

To conclude, let us return to the site—physical as well as digital—at which our story began. Back in eastern France, our cyber-cafe entrepreneur was enjoying considerable notoriety as a result of his Internet exploits. All the major papers carried the story of his scanning and uploading *Le Grand Secret*. But his fifteen minutes of fame ultimately did him in. The authorities did pursue him, although not for copyright infringement, nor for post-mortem privacy violations. Rather, the national press coverage awakened local officials in another part of France to a trail that had run cold: our entrepreneur went to jail for “family abandonment” and failure to pay child support.<sup>76</sup>

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action because the district court failed adequately to analyze possible variations in state law).

<sup>75</sup> Cf. *In re “Agent Orange” Prod. Liab. Litig.*, 580 F. Supp. 690, 708-13 (1984) (not necessary to apply presumption regarding the content of foreign law, since the court instead determined that the states whose laws were at issue would all apply a “national consensus” law to the mass tort claim at issue). *But see In re Rhone-Poulenc Rorer, Inc.*, 51 F.3d 1293, 1300-02 (7th Cir. 1995) (district court exceeded discretion in proposing to apply an amalgamated common law standard to determine negligence in a 50-state class action suit).

<sup>76</sup> See *Besançon: Pascal Barbaud écroué*, LE FIGARO, Jan. 27, 1996, at p. B9, col. 8.



