

**SPEAK NO EVIL: *MGM v. GROKSTER*'S POTENTIAL FREE
SPEECH IMPLICATIONS IN THE WAKE OF THE INDUCEMENT
STANDARD AND SECONDARY LIABILITY FOR EXPRESSION**

*Scott J. Sholder**

INTRODUCTION

After the downfall of the infamous file-sharing program Napster and its progeny, such as Aimster, a new breed of peer-to-peer (“P2P”) digital file-sharing programs took over the illicit downloading marketplace.¹ This next generation of software sought to replace its fallen comrades and hoped to reel in an already-existing user base which was salivating for a new way to amass free media files,² while the recording and movie industries continued their lawsuit campaign as they had against the predecessor software.³ Recently, the Supreme Court of the United States, in *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.* (“MGM”),⁴ decided that the creators of software that invited illegal downloading could be held secondarily liable for their users’ infringements; such liability would attach if the creators encouraged the infringement in violation of a version of the “induce-

* J.D. Candidate, May 2007, Seton Hall University School of Law; B.A., 2004, American University. I would like to send a sincere thanks to my advisor Professor Frank Pasquale for all of his invaluable advice, guidance, and support in creating this Comment.

¹ *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 125 S. Ct. 2764, 2770 (2005). The Court explains the nuances of the Grokster and Streamcast technology. *Id.* Essentially, the programs differ from their older counterparts in that the manufacturers’ software allows computer users to share and transfer files “directly with each other, not through central servers.” *Id.* This eliminates expensive storage space, allows for faster transfers and communications, and decreases the risk of security breaches or harmful glitches. *Id.*

² *Id.* at 2772–73.

³ Benny Evangelista, *Music File-Sharing Case Before High Court; Ruling Could Have Major Effect on Future of Entertainment Industry*, *Consumer Rights*, S.F. CHRON., Mar. 28, 2005, at A1 (To date, the Recording Industry Association of America (“RIAA”) has sued 9900 people individually for downloading music; the RIAA began filing individual suits in September, 2003.).

⁴ *MGM*, 125 S. Ct. at 2770.

ment” rule often utilized in patent infringement cases.⁵ This decision was seen as a huge victory for the recording industry,⁶ although some commentators question whether this opinion was, indeed, harmful to makers of software, or whether the programmers will simply bounce back with another tide of new technology.⁷

It is a well-established notion that technology and copyright protection butt heads like rams vying for common territory.⁸ As a result, the *MGM* Court hinders innovation and, simultaneously, threatens to constrain First Amendment free speech rights⁹ of software producers, marketers, and advertisers, by favoring copyright over technological innovation.¹⁰

⁵ *Id.*

⁶ Matthew Ingram, *Entertainment Industry Victory May Be Hollow*, N.Z. HERALD, July 5, 2005 (noting that “the entertainment industry got what it clearly felt was a victory in its fight against illegal downloading of music and movies”); see also Recording Industry Association of America, *RIAA Statement on MGM v. Grokster Supreme Court Ruling*, June 27, 2005, <http://www.riaa.com/news/newsletter/062705.asp> (“This decision lays the groundwork for the dawn of a new day—an opportunity that will bring the entertainment and technology communities even closer together, with music fans reaping the rewards.”).

⁷ Stephen Kiehl, Abigail Tucker & Sam Sessa, *Is Ruling End of File-Sharing? Industry Hopes So, But Users Say Free Music Will Never Die*, BALTIMORE SUN, June 29, 2005, at A1 (“As quickly as authorities find ways to curtail the free downloading of music, consumers find ways around them.”). Websites and programs exist that authorities do not know about yet and new technology is developing constantly. *Id.*; see also Jon Pareles, *The Court Ruled, So Enter The Geeks*, N.Y. TIMES, June 29, 2005, at E1. Software writers simply established

independent, ad-free networks or, like Bittorrent, facilitated multiple individual connections. The court’s decision may torpedo the parasitical, ad-pumping services like Grokster, Kazaa and Morpheus, but no one’s going to miss them much. There are plenty of geek alternatives that were devised not as business startups, but for the programmers’ satisfaction and the users’ sense of connection.

Id.

⁸ Professor Lawrence Lessig of Stanford University Law School describes this conflict:

It is the duty of policy makers . . . to assure that the changes they create, in response to the request of those hurt by changing technology, are changes that preserve the incentives and opportunities for innovation and change. In the context of laws regulating speech—which include, obviously, copyright law—that duty is even stronger. When the industry complaining about changing technologies is asking Congress to respond in a way that burdens speech and creativity, policy makers should be especially wary of the request. It is always a bad deal for the government to get into the business of regulating speech markets.

LAWRENCE LESSIG, *FREE CULTURE* 128 (2004), available at <http://www.freeculture.cc/freeculture.pdf>.

⁹ U.S. CONST. amend. I (“Congress shall make no law . . . abridging the freedom of speech . . .”).

¹⁰ See *infra* Part III.

Copyright law also often comes into conflict with the First Amendment.¹¹ The *MGM* Court has ruled in favor of copyright and has adopted the inducement rule as its flimsy plywood barrier to protect free speech from the onslaught of the copyright doctrine. Now, due to new concerns for free speech created by *MGM*, courts must take First Amendment values into careful consideration before blindly applying the *MGM* Court's inducement rule. This Comment suggests that courts consider a more speech-protective interpretation of the inducement rule in light of the concrete wall of protection afforded to speech via the incitement standard.¹² This solution arises from an analysis comparing the *MGM* decision and its potential free speech limitations to media incitement cases that took a more established route through a similar free speech labyrinth.¹³

This Comment, however, is about more than just the *MGM* decision. It scrutinizes secondary liability for expression using *MGM* as a vehicle for analysis. This Comment does not suggest that the solution to the impending free speech problem is to wholly replace the *MGM* Court's inducement standard or to rewrite or abandon the Court's opinion. It does suggest, however, that courts faced with similar disputes in the future should use a stricter, more speech-sensitive interpretation of the inducement standard that, for guidance, hearkens more to the expression-protective incitement test than the patent inducement rule.¹⁴ Courts should shift toward a more incitement-like interpretation of inducement because of the First Amendment rights currently endangered by the *MGM* Court's importation of a secondary liability standard that properly applies to cases about *things* (i.e., patented inventions) but not to cases about *expression* (i.e., copyrighted materials, advertisements, etc.). Using incitement as a base will establish a firmer groundwork for secondary liability in the expression context.

Part I of this Comment provides a general overview of the situation at hand, with Part I.A explaining the *MGM* case, its holding, and

¹¹ Michael D. Birnhack, *Copyright Law and Free Speech After Eldred v. Ashcroft*, 76 S. CAL. L. REV. 1275, 1280–81 (2003) (criticizing judicial rejection of the conflict between the First Amendment and copyright, and reiterating the presence of such a conflict and its ramifications).

¹² The incitement test states that “the constitutional guarantees of free speech and free press do not permit a State to forbid or proscribe advocacy of the use of force or of law violation except where such advocacy is directed to inciting or producing imminent lawless action and is likely to incite or produce such action.” *Brandenburg v. Ohio*, 395 U.S. 444, 447 (1969).

¹³ See *infra* Part II.B.

¹⁴ See *infra* Part II.B.

its version of the inducement rule. Part I.B lays out the bizarre landscape of secondary liability as well as the highly ambiguous conduct of the *MGM* manufacturers and downloaders. This section suggests that the inducement rule is unworkable and should be clarified and refined because it provides so little guidance. Part I.B.1 explains the inducement rule's lack of clarity in the context of disclaimers and analyzes problems that inducement would create when applied to such speech. Part I.B.2 further analyzes the inducement test's ambiguity based on the diversity of concurrences found in the *MGM* decision, itself. Part II asks how courts can elucidate the murky inducement standard, with Part II.A dismissing the patent context as a means of clarification. Part II.B, however, determines that media incitement cases clarify the standard because these cases involve secondary liability based on expression, just like *MGM*. This section will summarize the results of several landmark cases involving incitement suits against the media for violent action on the part of its consumers, thus establishing a basis of comparison to *MGM* in the context of secondary liability for expression. This section ultimately concludes that the manufacturers' speech in *MGM* would not pass incitement-level scrutiny and would thus be deemed protected speech. Part III notes that copyright law must acknowledge the First Amendment, and thus provides a discussion regarding the differences between inducement and incitement and their suitability to different types of intellectual property. It concludes that since the speech at issue in *MGM* is more closely related to the copyrightable expression seen in the "violent media" cases, a test akin to incitement is more appropriate because, unlike the patent inducement test, it inherently accounts for speech-specific contingencies.

This Comment ultimately finds that file-sharing secondary liability cases should be interpreted in light of the incitement standard, as incitement is merely a version of inducement that is more speech-protective and more appropriately aimed at expression. The goal is to preserve First Amendment free speech rights in the ever-burgeoning P2P software industry. The solution is not to rewrite the *MGM* decision, but to clarify the standard with guidance from the incitement test, the conflict between copyright and free speech, and the various policy issues at stake. The aim of this Comment is neither to express an opinion on the propriety of illegal downloading nor to take either the downloaders' or industries' sides on that main issue. The focus is on free speech concerns and the analytical problems involved in the Court's adoption of a particular rule.

I. AN OVERVIEW: SETTING THE TONE

A. *The MGM Decision and the Inducement Standard: A Case and Its Rule*

In *MGM*, the Supreme Court of the United States decided that P2P software manufacturers (“manufacturers”) could be held secondarily liable for their users’ infringement if they actively induced or “encouraged” the infringement through “clear expression or other affirmative steps taken to foster infringement.”¹⁵ The manufacturers of the Grokster and Streamcast software distributed free programs which allowed users to share digital media files through P2P networks (which communicate computer-to-computer, unlike older programs, such as Napster, which linked up to a central server).¹⁶ Although some of the material traded and downloaded on the manufacturers’ software were in the public domain (such as plays by Shakespeare) or were available through consent of the copyright owners, the Court noted that the vast majority of the downloads were of copyrighted materials posted without the consent of the owners, thus constituting copyright infringement by the users.¹⁷ The manufacturers did not contest their awareness that their users utilized the programs “primarily to download copyrighted files”; they knew about these in-

¹⁵ Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd., 125 S. Ct. 2764, 2770 (2005) (“We hold that one who distributes a device with the object of promoting its use to infringe copyright, as shown by clear expression or other affirmative steps taken to foster infringement, is liable for the resulting acts of infringement by third parties.”). The case against Grokster appears to have been settled. Kevin Allison, *The Battle for Grokster Leaves a War to Be Won DIGITAL MUSIC: With the File-Sharing Company Out of Action, Some in the Record Business Are Upbeat. But, Writes Kevin Allison, There is Trouble Ahead*, FIN. TIMES (London), Dec. 20, 2005, at 12 (“In November, the music industry won a big scalp after Grokster, the peer-to-peer file-sharing service, agreed to shut down as part of a legal settlement.”).

¹⁶ *MGM*, 125 S. Ct. at 2770.

¹⁷ *Id.* at 2772. This proposition is disputed in the manufacturers’ amicus brief. Brief of Amici Curiae Law Professors in Support of Respondents at 4, Metro-Goldwyn-Mayer Studios, Inc., v. Grokster, Ltd., 125 S. Ct. 2764 (2005) (No. 04-480), available at <http://www.copyright.gov/docs/mgm/lunney-law-profs.pdf> [hereinafter “Lunney Amicus Brief”] (“Applying the equitable rule of reason approach to fair use that this Court established for private copying in *Sony Corp.*, the undersigned Amici would respectfully suggest that much of the unauthorized sharing of copyrighted works through P2P networks constitute a fair and hence noninfringing use.”). Lunney notes that unauthorized P2P file sharing replaced legitimate market purchases in “less than ten percent of the P2P file sharing at issue. As for the remaining ninety percent, the petitioners have altogether failed to prove that this type of P2P file sharing substitutes for authorized access or is otherwise unfair.” *Id.* at 24.

fringements from user e-mails asking for guidance regarding the playing of copyrighted material.¹⁸

From their inception, the Court noted, Grokster and Streamcast were intended to be used to download copyrighted works, and their creators made this intent known and encouraged infringement.¹⁹ The manufacturers marketed their programs directly to former Napster users, promoting their products as Napster alternatives in order to recapture a horde of technophiles wandering aimlessly in a desert devoid of free downloads.²⁰ Grokster even sent a newsletter to users which touted “its ability to provide particular, popular copyrighted materials.”²¹ The Court noted that both manufacturers’ business models indicated their objective to encourage copyright infringement: since the software was free, income would come from selling advertising space which was worth much more as the user base increased, suggesting that “volume is a function of free access to copyrighted work.”²² Also, neither service blocked infringers nor “filter[ed] copyrighted material,” and both turned away companies that solicited monitoring services to try to catch infringers.²³

The United States District Court for the Central District of California granted the manufacturers’ summary judgment motions and held that Grokster and Streamcast were not secondarily liable be-

¹⁸ *MGM*, 125 S. Ct. at 2772.

¹⁹ *Id.*

Grokster and StreamCast are not, however, merely passive recipients of information about infringing use. The record is replete with evidence that from the moment Grokster and StreamCast began to distribute their free software, each one clearly voiced the objective that recipients use it to download copyrighted works, and each took active steps to encourage infringement.

Id.

²⁰ *Id.* at 2772–73. The Court looked to internal company documents and press kits sent to potential advertisers that indicated Streamcast was “similar to what Napster was” and would be “positioned to capture the flood of their 32 million users that will be actively looking for an alternative.” *Id.* at 2773. Streamcast also created promotional marketing materials to market itself as a Napster alternative (which may or may not have been publicly released—a factor the Court disregarded due to the materials’ reflection of Streamcast’s intent). *Id.* The materials contained statements such as “Napster Inc. has announced that it will soon begin charging you a fee. That’s if the courts don’t order it to shut down first. What will you do to get around it?” and “when the lights went off at Napster . . . where did the users go?” *MGM*, 125 S. Ct. at 2773. Grokster’s name was an apparent Napster spin-off, and its makers used digital codes to direct search engine inquiries on “free filesharing” to Grokster’s website. *Id.*

²¹ *Id.* at 2774.

²² *Id.*

²³ *Id.*

cause use of their software “did not provide the distributors with actual knowledge of specific acts of infringement.”²⁴ The United States Court of Appeals for the Ninth Circuit affirmed, citing *Sony Corp. of America v. Universal City Studios, Inc.*²⁵ in holding that “distribution of a commercial product capable of substantial noninfringing uses could not give rise to contributory liability for infringement unless the distributor had actual knowledge of specific instances of infringement and failed to act on that knowledge.”²⁶ The Ninth Circuit essentially held that there was no liability because the manufacturers’ software used no central server and the makers did not engage in any other affirmative activities aside from providing the software.²⁷

The Supreme Court of the United States, however, disagreed with the Ninth Circuit and held that the appellate court had misapplied the *Sony* rule.²⁸ The Ninth Circuit’s actual knowledge standard was excessively broad, thus extending *Sony* too far because *Sony* did not “displace other theories of secondary liability.”²⁹ Therefore, the Court declined to further analyze *Sony* and the copyright owners’ knowledge theory because “nothing in *Sony* requires courts to ignore evidence of intent if there is such evidence, and the case was never meant to foreclose rules of fault-based liability derived from the common law.”³⁰ The Court noted that “where evidence goes beyond

²⁴ *Id.*

²⁵ 464 U.S. 417, 456 (1984) (holding that VCRs were “capable of substantial non-infringing uses” and therefore the manufacturer could not be held secondarily liable based solely on its distribution). The *MGM* Court notes that this standard is borrowed from patent law’s “staple article of commerce” doctrine which states that “distribution of a component of a patented device will not violate the patent if it is suitable for use in other ways.” *MGM*, 125 S. Ct. at 2777 (citing 35 U.S.C. § 271(c) (2000) and *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 485 (1964)). The author is aware that the *Sony* Court integrated a patent standard into copyright law and that this decision has stood the test of time. That said, this Comment later distinguishes patent and copyright law for the purpose of criticizing the patent inducement rule as applied in a copyright context. See *infra* Part III. This Comment distinguishes the *Sony* scenario and does not question the adoption of a patent doctrine in that case. Such an integration as seen in *Sony* did not raise any noteworthy First Amendment issues because commercial speech (i.e. advertisements and marketing plans) was not affected by the Court’s holding. Unlike in *MGM*, the copyright holders in *Sony* claimed liability solely due to the *distribution of a product*, not due to the underlying *speech* that facilitated the distribution. See *Sony*, 464 U.S. at 419. Thus, the two scenarios are fundamentally different, and the author does not suggest that the *Sony* rule is misguided merely because it also hearkens to patent law.

²⁶ *MGM*, 125 S. Ct. at 2775.

²⁷ *Id.* at 2774–75.

²⁸ *Id.* at 2778.

²⁹ *Id.*

³⁰ *Id.* at 2779.

a product's characteristics or the knowledge that it may be put to infringing uses, and shows statements or actions directed to promoting infringement, *Sony's* staple-article rule will not preclude liability."³¹

Rather than relying solely on *Sony*, the Court complemented the staple-article rule by adopting its own interpretation of the inducement standard³² from patent law: "one who distributes a device with the object of promoting its use to infringe copyright, as shown by clear expression or other affirmative steps taken to foster infringement, is liable for the resulting acts of infringement by third parties."³³ In adopting this standard, the Court noted that the inducement rule "premises liability on purposeful, culpable expression and conduct," rather than mere knowledge of the product's potential to infringe, actual infringing uses, or steps taken in the normal course of business or product distribution, such as technical support.³⁴ Thus, the Court opined that the inducement test "does nothing to compromise legitimate commerce or discourage innovation having a lawful promise."³⁵

The Court found the required unlawful objective fairly easily, looking to the following elements to reach its conclusion:

- The manufacturers' advertisements to former Napster users;
- Offerings of Napster-like software with similar names and similar functions;
- Grokster's newsletter touting its ability to download copyrighted music;
- Grokster's diversion of P2P file-sharing search engine queries to its own website;
- Streamcast's (as yet unpublished) advertising campaigns aimed at former Napster users;
- Both companies' technical assistance to users in finding copyrighted material; and
- Both companies' refusal to filter shared copyrighted material.³⁶

The "unlawful objective [was] unmistakable" in light of concrete evidence of mass copyright infringement by users, and the Court ulti-

³¹ *Id.*

³² See *infra* Part II.A and note 109 for a full explanation of the rule and its nuances.

³³ *MGM*, 125 S. Ct. at 2780.

³⁴ *Id.*

³⁵ *Id.*

³⁶ *Id.* at 2780–81.

mately found that the Ninth Circuit's grant of summary judgment was erroneous.³⁷

The central focus of the *MGM* decision and of this Comment is, of course, the inducement standard and its possible ramifications. Logically, the rule itself requires a bit more clarification than what was stated above. The inducement rule, in the context of patent law, has been codified, and states that "whoever actively induces infringement of a patent shall be liable as an infringer."³⁸ The inducement standard, as articulated by the Court in *MGM*, is as follows:

Evidence of "active steps . . . taken to encourage direct infringement," such as advertising an infringing use or instructing how to engage in an infringing use, show an affirmative intent that the product be used to infringe, and a showing that infringement was encouraged overcomes the law's reluctance to find liability when a defendant merely sells a commercial product suitable for some lawful use.³⁹

Inducement, in terms of patent infringement, will be explained more below.⁴⁰

B. The Secondary Liability Landscape and Inducement's Road to Nowhere

This Comment is not simply about the *MGM* case. It encompasses the more general idea that secondary and contributory liability, as concepts, are a bit strange, especially because they seem to apply in differing degrees to issues as life-threatening as gun control or as comparatively miniscule as copyright protection.⁴¹ It seems odd that copyright holders so badly want to hold technological innovators—whose creations are capable of copyright infringement—secondarily liable for users' infringements when, analogously, those injured by firearms are rarely ever able to hold gun manufacturers liable for personal injuries suffered as the result of a gunshot.⁴² Apparently the unbearable loss of human life and the life-shattering re-

³⁷ *Id.* at 2782.

³⁸ 35 U.S.C. § 271(b) (2000).

³⁹ *MGM*, 125 S. Ct. at 2779 (internal citations omitted).

⁴⁰ *See infra* Part II.A.

⁴¹ See Alfred C. Yen, A Personal Injury Law Perspective on Copyright in an Internet Age, 52 *Hastings L.J.* 929, 931 (2001) ("[I]f [measures desired by copyright holders] seem more drastic than those we are willing to accept when guarding against serious physical injury or death [in personal injury or gun control law], then perhaps recent efforts to expand copyright protection have gone too far.")

⁴² *Id.* at 934 (noting that "plaintiffs injured by misuse of guns or alcohol have practically no chance of recovering from gun or alcohol manufacturers").

sults of serious physical injury are not reasons enough to push courts and legislatures to ban possession of guns. So how can copyright holders justify secondary liability for copyright infringement when the infringement “inflicts intangible economic injuries, and not the physical personal injuries that justify the use of enterprise liability in tort law”?⁴³ Indeed, “the use of enterprise liability to protect copyrights seems even stranger” when we compare real, physical injuries with mere economic harm.⁴⁴

In tort law, “doctrines of defect, proximate cause, and assumption of risk . . . limit the reach of enterprise liability,” making it nearly impossible for injured plaintiffs to recover from gun manufacturers.⁴⁵ It seems logical, then, that fair use,⁴⁶ the free speech safety valve analogue in copyright law, would lead to the same conclusion—the inability to impute secondary liability for copyright infringement to manufacturers like Grokster or Streamcast. The Supreme Court of the United States has even emphasized that fair use acts as a safety valve when copyright and the First Amendment clash.⁴⁷ Fair use in the *MGM* context would likely involve the downloading of public domain works, the downloading of copyrighted works with the consent of the owners,⁴⁸ non-commercial uses of the works, or commercial uses lacking a significant effect on the market for a particular copyrighted work.⁴⁹

⁴³ *Id.*

⁴⁴ *Id.*

⁴⁵ *Id.* at 933.

⁴⁶ Analysis of four non-exclusive factors determines whether a use is fair: “(1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the substantiality of the portion used in relation to the copyrighted work as a whole; (4) the effect on the potential market for or value of the copyrighted work.” *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560–61 (1985).

⁴⁷ Recent case law supports this proposition:

[T]he “fair use” defense allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances. Codified at 17 U.S.C. § 107, the defense provides: “The fair use of a copyrighted work, including such use by reproduction in copies . . . , for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.” The fair use defense affords considerable “latitude for scholarship and comment,” . . . and even for parody

Eldred v. Ashcroft, 537 U.S. 186, 219–20 (2003) (internal citations omitted).

⁴⁸ *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 125 S. Ct. 2764, 2772 (2005).

⁴⁹ *See supra* notes 46–47.

As seen in *MGM*, however, the scope of fair use and the nature of the downloaded works were highly contested.⁵⁰ The conduct at issue was extremely ambiguous; there was no way for experts, much less the Court, to determine whether each individual download was fair or infringing;⁵¹ this confusion muddied the waters even further as to the appropriateness of secondary liability for expression on the part of the manufacturers. Despite a lack of definitive evidence showing that the users' downloads were *not* fair,⁵² and despite the presence of evidence suggesting that a majority of the uses *were* fair,⁵³ the Court still found that the software manufacturers could be secondarily liable via inducement—despite the fair use safety valve—based on the quantity of files downloaded and the intent and actions of the manufacturers.⁵⁴

As strange as the concept of secondary liability may be in the expression context, especially in *MGM*, it is not altogether invalid. There are situations where the rule could be legitimately applied in order to protect the public from *physical* harm. As seen in *Rice v. Paladin Enterprises, Inc.*,⁵⁵ expression can sometimes, though *very rarely*, lose its First Amendment protection when it incites violence on the part of its recipient.⁵⁶ Eugene Volokh, a law professor at UCLA Law School, addresses other limited situations where secondary liability for expression may be proper, such as when a publication teaches readers how to make nuclear bombs.⁵⁷ Volokh qualifies these circumstances with the idea that such liability should only be imputed

⁵⁰ *MGM*, 125 S. Ct. at 2772 (“MGM commissioned a statistician to conduct a systematic search, and his study showed that nearly 90% of the [available] files . . . were copyrighted works. [Manufacturers] dispute this figure . . . arguing that free copying even of copyrighted works may be authorized . . . [and] potential noninfringing uses of their software are significant in kind . . .”).

⁵¹ *Id.* (“[T]he parties’ anecdotal and statistical evidence entered thus far to show the content available on the FastTrack and Gnutella networks does not say much about which files are actually downloaded by users, and no one can say how often the software is used to obtain copies of unprotected material.”).

⁵² *Id.* at 2788–89 (Breyer, J., concurring). Justice Breyer observes that the ten percent of potentially noninfringing files offered on Grokster and Streamcast was approximately the same percentage found to be fair in the *Sony* case. *Id.* He also noted that MGM “has offered no evidence sufficient to survive summary judgment that could plausibly demonstrate a significant quantitative difference” to counter the fair use argument. *Id.* at 2789 (Breyer, J., concurring).

⁵³ Lunney Amicus Brief, *supra* note 17, at 22–26.

⁵⁴ *MGM*, 125 S. Ct. at 2772.

⁵⁵ 128 F.3d 233 (4th Cir. 1997) (instruction manual on contract killing lost its First Amendment protection because it incited and aided and abetted a grisly triple homicide).

⁵⁶ *Id.* at 250; *see infra* Part II.B and notes 185–87.

⁵⁷ Eugene Volokh, *Crime-Facilitating Speech*, 57 STAN. L. REV. 1095, 1097 (2005).

based on a suggested rule that would narrow the circumstances in which expression would lose its First Amendment protection.⁵⁸

The ultimate question, then, is: why extend secondary liability to manufacturers like Grokster and Streamcast? Copyright infringement is not a matter of life or death, and as seen above (and as will be seen below), expression rarely loses its protection even when situations *do* involve life or death. This question begs courts to clarify the inducement rule adopted by the *MGM* Court in order to align secondary liability jurisprudence with the current trend in analogous areas of the law, and to afford more First Amendment protection to speakers in situations similar to *MGM*. In order to decide how to refine and clarify the rule, however, we must first analyze *why* it is unworkable, and therefore leads future courts on a winding dirt road to nowhere.

1. The Disclaimer Dilemma: A Paradox

One problem courts will encounter in strictly applying the *MGM* inducement standard is how to treat disclaimers. Can a speaker circumvent the inducement rule simply by placing a disclaimer on a product, advertisement, or marketing scheme? It seems that there are two potential outcomes in the disclaimer situation, both of which expose the inducement standard as an imprecise choice as the governing rule in these situations.

Outcome One: What if the makers of Grokster and Streamcast had inserted a warning stating “Do not use this product to infringe copyrighted material” or “Warning, this product has the potential to infringe copyrighted material. Grokster/Streamcast does not sanction this type of use and encourages its customers to use the software only in a legal capacity”? This type of warning may look good on its face. Potentially, these speakers could avoid liability under the inducement rule because they did the *opposite* of what the rule prohibits—actively *encouraging* infringement. Such disclaimers would be used to *discourage* illegal use. This first outcome allows speakers to avoid the inducement rule rather easily just by adding a few words to

⁵⁸ Volokh notes that crime-facilitating speech ought to be constitutionally protected unless (1) it's said to a person or a small group of people when the speaker knows these few listeners are likely to use the information for criminal purposes, (2) it's within one of the few classes of speech that has almost no noncriminal value, or (3) it can cause extraordinarily serious harm (on the order of a nuclear attack or a plague) even when it's also valuable for lawful purposes.

Id. at 1106.

their advertisements or on the packaging their products. Under these circumstances, the inducement standard will be seen as extremely weak and easy to avoid altogether. There would not be much left of the *MGM* decision in the universe of this outcome.

Volokh addresses this issue in his article about speech that facilitates criminal activities.⁵⁹ The author notes first that restrictions on advertisements that promote “improper uses of a work burden lawful uses only slightly, because the same material could be distributed if it weren’t billed as promoting illegal uses,” and such restrictions could even decrease illegal use.⁶⁰ Volokh notes, however, that if courts focus on the advertising or marketing of speech that has potential illegal uses, the speakers could “just slightly change their speech so that it doesn’t look like an overt appeal to illegal users” and the message “could still be communicated if it’s not presented in a way that stresses the illegal uses.”⁶¹

Outcome Two: Could such a disclaimer as mentioned above constitute inducement in and of itself? It is possible that the mere mention of the potential for illegal use, especially a tempting use that leads to free music and movies, could be considered an inducement to infringe copyright. This second outcome would lead to an inducement standard stretched far beyond its reasonable boundaries. The expansiveness of the rule in this outcome would mean that no precautions the speaker took could prevent inducement liability because the speaker’s acts of prevention would themselves be inducements even if the speaker honestly is trying to prevent and discourage illegal use of its product. In this universe, the inducement rule would not only infringe upon free speech rights in advertisements, but it would reach so far as to infringe upon free speech rights in *disclaimers* in advertisements. This outcome allows too much leeway in an already broad standard, and allows the inducement rule to spill over its levees.

Donald S. Chisum, in his treatise on patent law, has even addressed this dilemma.⁶² His treatise notes that “[e]ven an express warning to customers against infringing use will not preclude liability if under the circumstances the warning invites such use.”⁶³ This

⁵⁹ *Id.* at 1200.

⁶⁰ *Id.*

⁶¹ *Id.* at 1201. Volokh’s examples of this phenomenon include “term-paper Web sites” which “already present themselves as offering mere ‘example essays,’ and say things like ‘the papers contained within our web site are for research purposes only!’” *Id.*

⁶² DONALD S. CHISUM, CHISUM ON PATENTS § 17.04(4)(f) (2005).

⁶³ *Id.*

quandary could potentially plague inducement standard jurisprudence, especially as applied to such amorphous concepts as creative and expressive speech, whether artistic, political, or commercial.

To put this paradox in a context close to that of *MGM*, it is useful to look at the “Hear Your Music Anywhere” Project (“Hymn”).⁶⁴ Hymn is a software provider that allows Apple iTunes users to “free” their purchased music downloads “from their DRM restrictions *with no loss of sound quality*.”⁶⁵ By converting these music files away from their current file format, users would be able to play the songs outside of the iTunes software, which is where the DRM file format restricts them.⁶⁶ The program is used to decrypt songs so they can be played through other software, on other operating systems, and on more computers.⁶⁷ It is also used to “make archival backups of your music” to use on a portable MP3 player other than an iPod.⁶⁸

The website states that another purpose of the software is to “demonstrate your belief in the principles of fair-use under copyright law.”⁶⁹ Software such as Hymn’s could be viewed as similar to that of *Grokster* and *Streamcast* in that it may have potential noninfringing uses such as creating archival backups,⁷⁰ but could still be used for secondary copyright infringement that is arguably encouraged by the maker.⁷¹ Were Hymn to place a disclaimer on its website or in the software license agreement that read “This software is for fair use only,” would they be out of harm’s way? Based on the present interpretation of the inducement standard, copyright owners likely would

⁶⁴ Hear Your Music Anywhere, <http://www.hymn-project.org> (last visited Apr. 5, 2007).

⁶⁵ *Id.* (“DRM” refers to the file format in which downloaded iTunes songs are delivered).

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *Id.*

⁶⁹ *Id.*

⁷⁰ June M. Besek, *Anti-Circumvention Laws and Copyright: A Report from the Kernochan Center for Law, Media and the Arts*, 27 COLUM. J.L. & ARTS 385, 471–72 (2004) (“Some consumptive use copying is privileged, such as in-home copying of free broadcast television for later viewing, copying [certain] sound recordings . . . and making backup copies of computer programs.”). Besek also notes that the “Audio Home Recording Act (“AHRA”) contains a privilege to make analog and certain digital copies of musical recordings” in some circumstances. *Id.* at 472.

⁷¹ Copyright owners would claim violations of their exclusive rights under the copyright statute, 17 U.S.C. § 106 (2000). They would most likely sue for contributory infringement of their right of reproduction under § 106(1) or digital performance rights under § 106(6). They could also argue that “due to its narrow definitions, works copied by means of computers do not qualify for the AHRA privilege.” Besek, *supra* note 70, at 472.

argue for an expansive reading of the inducement rule, making this disclaimer an inducement in and of itself. Alternatively, if a court decided that this disclaimer was enough to satisfy *MGM*, there would not be much left of the rule, as this disclaimer “exemption” would swallow the *MGM* rule whole.

Incitement, however, does not present this disclaimer problem, nor does it cause confusion on the part of the speaker as to whether the disclaimer will save them or damn them in the end. In several of the “violent media” incitement cases,⁷² disclaimers have been taken into the analysis as a significant factor weighing against incitement liability on the part of a media speaker.⁷³ In other cases, the absence of a disclaimer has been deemed inconsequential, as the expression still failed the incitement standard, and such a warning was not even required.⁷⁴

In *Herceg v. Hustler Magazine, Inc.*,⁷⁵ for example, Hustler Magazine placed an explicit and noticeable disclaimer before its article on dangerous sexual practices that stated that the magazine “emphasizes the often-fatal dangers of the practice of ‘auto-erotic asphyxia,’ and recommends that readers seeking unique forms of sexual release DO NOT ATTEMPT this method. The facts are presented here solely for an educational purpose.”⁷⁶ The article also graphically depicted the deadly outcomes of some unfortunate experiments in the sexual practice detailed therein.⁷⁷ The United States Court of Appeals for the Fifth Circuit found that Hustler magazine’s article had not incited a young man’s accidental suicide after reading the article, and gave significant weight to the disclaimer and the graphic warnings of possible accidents.⁷⁸

The plaintiff in *Yakubowicz v. Paramount Pictures Corp.*⁷⁹ was the father of a murder victim who was killed by members of a gang after a showing of the movie *The Warriors*, a fictional portrayal of gang violence in New York City.⁸⁰ The plaintiff alleged that the defendant movie theater and production companies failed to “warn the exhibitors of the film and those responsible for the safety of the public” and

⁷² See *infra* Part II.B.

⁷³ See *infra* notes 75–78.

⁷⁴ See *infra* notes 79–88.

⁷⁵ 814 F.2d 1017 (5th Cir. 1987).

⁷⁶ *Id.* at 1018.

⁷⁷ *Id.* at 1018–19.

⁷⁸ *Id.* at 1023.

⁷⁹ 536 N.E.2d 1067 (Mass. 1989).

⁸⁰ *Id.* at 1068.

“to take reasonable steps to protect [people] at or near the theater” showing the movie.⁸¹ Essentially, the plaintiff complained that Paramount and the theater should be liable for the movie’s supposed incitement to violence because they *failed* to place a disclaimer before the movie or to warn those responsible for exhibiting the movie and keeping the peace.⁸² This count was dismissed on summary judgment.⁸³ The Supreme Judicial Court of Massachusetts noted that a “fatal assault occurring miles from the theater as a matter of law could not be attributed to a failure to” protect those near the theater or a failure on the part of Paramount or the theater owners to warn anyone.⁸⁴

Similarly, in *Olivia N. v. National Broadcasting Co.*,⁸⁵ a failure to warn claim did not hold water with a California appellate court when the parents of a young rape victim alleged that a television movie depicting a violent rape scene incited a group of youths to attack their daughter.⁸⁶ The parents claimed the film was “particularly likely to cause imitation and that NBC televised the film without proper warning in an effort to obtain the largest possible viewing audience.”⁸⁷ The movie ultimately failed the incitement test despite the absence of a disclaimer before the movie.⁸⁸

Were future courts to interpret the inducement test for contributory copyright infringement in light of incitement, they would be able to avoid the messy issue of disclaimers altogether, and possibly avoid future circuit splits. Inducement leaves the door wide open for a flood of litigation solely on the issue of the inducing (or non-inducing) nature of disclaimers. By utilizing a stricter interpretation of the rule and reflecting on and citing to the “violent media” cases, future courts can avoid this potential disclaimer disarray. Disclaimers are practically a non-issue in the “violent media” cases, as they are either helpful to the speaker or are unnecessary. This simplification will make *MGM*-type jurisprudence much tidier. If the inducement standard is perpetuated as it stands, litigation would increase, and cases would become very convoluted.

⁸¹ *Id.* at 1072 (alteration in original).

⁸² *Id.* at 1068.

⁸³ *Id.* at 1072.

⁸⁴ *Id.*

⁸⁵ 178 Cal. Rptr. 888 (Cal. Ct. App. 1981).

⁸⁶ *Id.* at 890–91.

⁸⁷ *Id.* at 891.

⁸⁸ *Id.* at 892.

Furthermore, either outcome of the continued use of the present inducement rule mentioned in the context of the two situations at the beginning of this section would constitute a legal mockery when it comes to disclaimers. If inducement could be circumvented simply by using a disclaimer, *MGM* would be rendered meaningless. Still, if disclaimers themselves were found to be inducing, speakers would be at a loss for simple methods of self-preservation. Innovation, as well as speech, would most certainly be chilled to the bone. Because the present interpretation of the inducement standard poses a lose-lose situation in the *MGM* context, courts should adopt a test that hearkens to incitement for guidance.

2. Diversity of Concurrences in *MGM*: Leaning Toward Justice Breyer's Opinion

Justice Breyer and Justice Ginsburg wrote the concurring opinions in *MGM*. Each justice took a different view on the case, and their disagreement is yet another indication that the inducement standard is blurry to the point of uselessness. Despite *MGM* being a unanimous decision, a diversity of concurrences is suggestive of an unclear rule.

Justice Breyer's⁸⁹ concurring opinion in *MGM* calls for an unchanged view of the *Sony* rule, which would better protect technology and, in turn, would better protect the speakers behind the technology.⁹⁰ Although Justice Breyer agreed with the Court's conclusion and adoption of the inducement standard, he believed that Grokster and Streamcast had proved to the Ninth Circuit that their software was "capable of substantial noninfringing uses."⁹¹ Therefore, Justice Breyer concluded that the stricter version of the *Sony* test suggested by Justice Ginsburg's concurrence⁹² was unnecessary.⁹³ Justice Ginsburg urged that the evidence proffered by Grokster and Streamcast was insufficient to satisfy the *Sony* rule regarding substantial nonin-

⁸⁹ Justice Breyer has significant experience in copyright and is presumably the resident expert on the Supreme Court in these matters. See Frank Pasquale, *Breaking the Vicious Circularity: Sony's Contribution to the Fair Use Doctrine*, 55 CASE W. RES. L. REV. 777, 810 (2005) ("Although Justice Breyer has done much to try to rationalize copyright law in his scholarship and opinions in copyright disputes, his work in administrative law most directly inspires my work on the topic.").

⁹⁰ *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 125 S. Ct. 2764, 2796 (2005) (Breyer, J., concurring).

⁹¹ *Id.* at 2787–88 (Breyer, J., concurring).

⁹² *Id.* at 2783–86 (Ginsburg, J., concurring).

⁹³ *Id.* at 2792 (Breyer, J., concurring).

fringing uses.⁹⁴ She would require a stricter reading of the *Sony* rule—one that requires more evidence and more concrete examples of noninfringing uses before deciding whether a product is capable of *substantial* noninfringing uses.⁹⁵

Justice Breyer noted, however, that in *Sony*, nine percent of uses of the VCR were found to be noninfringing and therefore substantial; the manufacturers in *MGM* had shown that approximately ten percent of the uses of their software were noninfringing.⁹⁶ Justice Breyer concluded that manufacturers' evidence of consenting artists, free electronic books, public domain material, and "licensed music videos and movie segments" provided sufficient proof of substantial noninfringing use in light of the *Sony* holding.⁹⁷ He also emphasized that the *Sony* Court's use of the word "capable" in its rule on noninfringing uses inferred a forward-looking perspective; thus it would be possible to foresee many future noninfringing uses that either were up-and-coming or had not even come to life yet.⁹⁸

For three reasons, Justice Breyer ultimately concluded that a stricter reading of *Sony* was unnecessary.⁹⁹ First, he noted that the *Sony* rule is technology-protecting in that it is clear as to what manufacturers can and cannot do; it is a deliberately difficult standard and is "forward looking" because it anticipates technological evolution and allows leeway for such innovation.¹⁰⁰

Second, the Justice noted that a stricter interpretation, asking for a heavier evidentiary burden on the part of a defendant, would "undercut the protection that *Sony* now offers" by forcing innovators to provide extensive information on noninfringing uses—yet innovators would still face "legal uncertainty" as to whether their new technology would be protected.¹⁰¹ The uncertainty would cause unpredictable results in courts employing this extremely fact-sensitive analysis, and could result in less ambition to create, thus chilling innovation in general.¹⁰²

⁹⁴ *Id.* at 2785–86 (Ginsburg, J. concurring).

⁹⁵ *Id.* at 2786 (Ginsburg, J., concurring).

⁹⁶ *MGM*, 125 S. Ct. at 2788–89 (Breyer, J., concurring).

⁹⁷ *Id.* at 2789 (Breyer, J., concurring).

⁹⁸ *Id.* at 2789–91 (Breyer, J., concurring) (noting that up-and-coming uses include research, historical recordings, digital photo swapping, shareware swapping, licensed media file sharing, news broadcasts, and independently-created media file sharing); see *supra* note 25 for an explanation of the *Sony* rule.

⁹⁹ *MGM*, 125 S. Ct. at 2791 (Breyer, J., concurring).

¹⁰⁰ *Id.* at 2791–92 (Breyer, J., concurring).

¹⁰¹ *Id.* at 2792–93 (Breyer, J., concurring).

¹⁰² *Id.* (Breyer, J., concurring).

Third, Justice Breyer noted that although a stricter *Sony* rule would benefit copyright owners, it was not clear that this benefit would outweigh possible chills on technology.¹⁰³ The Justice concluded that a stricter rule may be unnecessary and dangerous because, presently, any evidence of extreme harm to copyright owners is uncertain.¹⁰⁴ Justice Breyer pointed out that the statistics regarding P2P software's diminution of creative works were sparse, and proof of loss of entertainment industry revenue was unclear.¹⁰⁵ Furthermore, owners of copyrights have viable alternatives: they can sue for direct infringement, institute new technological innovations to further protect their works, turn a profit via legal downloading services, or turn to the legislature for a change in the law.¹⁰⁶

Justice Breyer's concurrence is the most reasonable interpretation of both *Sony* and *MGM* in light of the free speech issues mentioned in this Comment. His position is technology-friendly and innovation-protective and calls for no change in the *Sony* rule, while still allowing for liability via inducement.¹⁰⁷ Justice Breyer's technology-protective view analogizes perfectly to speech in the context of this Comment. Were future courts to adopt Justice Ginsburg's stricter application of the *Sony* rule, not only would P2P software be inhib-

¹⁰³ *Id.* at 2793 (Breyer, J., concurring).

¹⁰⁴ *Id.* (Breyer, J., concurring).

¹⁰⁵ *MGM*, 125 S. Ct. at 2793–94 (Breyer, J., concurring). “Unauthorized copying likely diminishes industry revenue, though it is not clear by how much.” *Id.* at 2794 (Breyer, J., concurring). Justice Breyer compares the results of studies on industry revenue. Compare Stan Liebowitz, *Will MP3 Downloads Annihilate the Recording Industry? The Evidence So Far*, June 2003, at 2, <http://www.utdallas.edu/~liebowit/intprop/records.pdf> (“My conclusions, in a nutshell, are that MP3 downloading does appear to be causing harm. No other explanations that have been put forward seem to be able to explain the decline in sales that have occurred since 1999.”), with Felix Oberholzer & Koleman Strumpf, *The Effect of File Sharing on Record Sales: An Empirical Analysis*, Mar. 2004, at 24, http://www.unc.edu/~cigar/papers/FileSharing_March2004.pdf (“We find that file sharing has no statistically significant effect on purchases of the average album in our sample.”). Justice Breyer also notes that the “extent to which related production has actually and resultingly declined remains uncertain, though there is good reason to believe that the decline, if any, is not substantial.” *MGM*, 125 S. Ct. at 2794 (Breyer, J., concurring). To support this proposition he cites Yochai Benkler, *Sharing Nicely: On Shaveable Goods and the Emergence of Sharing as a Modality of Economic Production*, 114 *YALE L.J.* 273, 351–52 (2004), which explains that “[m]uch of the actual flow of revenue to artists—from performances and other sources—is stable even assuming a complete displacement of the CD market by [P2P] distribution . . . it would be silly to think that music . . . will cease to be in our world [because of illegal file swapping].” *MGM*, 125 S. Ct. at 2794 (Breyer, J., concurring).

¹⁰⁶ *Id.* at 2794–96 (Breyer, J., concurring).

¹⁰⁷ *Id.* at 2794 (Breyer, J., concurring).

ited, but the accompanying speech in advertisements and marketing schemes would be similarly stymied.

If courts were to interpret *Sony* more strictly, they would inherently have to view inducement more broadly. Logically, if a court is going to require *more* proof to show that a product is capable of substantial noninfringing uses, it will likely require *less* proof to show that the speech advocating those uses was *unprotected* under the First Amendment. Under Justice Breyer's approach, however, the *Sony* rule would remain the same—difficult to satisfy yet broad and protective of innovation. Courts could accordingly tighten inducement in light of the incitement cases mentioned below¹⁰⁸ in order to grant the speech accompanying the technology as much deference and protection as *Sony* grants to the innovation itself.

II. HOW DO WE CLARIFY THE INDUCEMENT STANDARD?

A. *The Patent Cases: No Help Here*

The *MGM* Court's imported inducement rule was taken from many cases involving secondary infringement of patents, each of which placed its own spin on the rule.¹⁰⁹ However, an analysis of the rule in the patent law context does nothing to clarify the standard for purposes of applying it in cases involving secondary liability for expression.

Chisum explains that "a person infringes by actively and knowingly aiding and abetting another's direct infringement of the patent."¹¹⁰ Chisum notes that in *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*,¹¹¹ the United States Court of Appeals for the Federal Circuit held

¹⁰⁸ See *infra* Part II.B.

¹⁰⁹ See generally *MEMC Elec. Materials, Inc. v. Mitsubishi Materials Silicon Corp.*, No. 04-1396, 2005 U.S. App. LEXIS 17956, at *21, *25-27 (Fed. Cir. Aug. 22, 2005) (technical support presentations and technical support through e-mail about patented material could be inducement); *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1365 (Fed. Cir. 2004) (published articles about patented material could be inducing); *Minn. Mining & Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1305 (Fed. Cir. 2002) (possible inducement by supplying customers with the patented product and instructions on how to use it); *Water Tech. Corp. v. Calco, Ltd.*, 850 F.2d 660, 668 (Fed. Cir. 1988) (inducement liability where one "actively and knowingly aid[s] and abet[s] another's direct infringement"); *Fromberg, Inc. v. Thornhill*, 315 F.2d 407, 412-13 (5th Cir. 1963) (inducement when sales staff demonstrated infringing uses); *R.W. Sims v. Mack Trucks, Inc.*, 459 F. Supp. 1198, 1217 (E.D. Pa. 1978), *rev'd and vacated*, 608 F.2d 87 (3d Cir. 1979) (inducement in promotional films and brochures depicting use of patented device).

¹¹⁰ CHISUM, *supra* note 62, § 17.04.

¹¹¹ 909 F.2d 1464 (Fed. Cir. 1990).

that “proof of actual intent to cause the acts which constitute the infringement is a necessary prerequisite to finding active inducement.”¹¹² Chisum, however, observes that a Virginia district court in *Hauni Werke Koerber & Co. v. Molins, Ltd.*,¹¹³ held just the opposite, finding that specific intent was unnecessary to find active inducement.¹¹⁴ Chisum concludes that commentators have generally agreed that the mens rea requirement for inducement is unclear, at best, and that case law varies to a great degree.¹¹⁵ Based on its “affirmative intent that the product be used to infringe” language, the *MGM* Court’s take on mens rea seems to be one of an intent requirement.¹¹⁶ This language should not be taken as gospel, however, considering the *MGM* Court adopted the inducement rule in the wake of the diversity of mens rea requirements noted in the previous patent cases mentioned above.

According to Chisum, actions that can constitute inducement in a patent context include licensing, indemnification, repair and maintenance, design, purchase of product, instruction, and advertising, and publication.¹¹⁷ Of most concern here, of course, is “instruction and advertising,” which has the most obvious First Amendment connotations, especially in the *MGM* context.¹¹⁸ Chisum explains that “instruction and advertising” can induce infringement “where a defendant selling products capable of either innocent or infringing use provides through labels, advertising or other sales methods instructions and directions as to the infringing use.”¹¹⁹ The treatise explains this phenomenon primarily in the context of complex medical technology cases that are beyond the scope of this Comment.¹²⁰

This broad articulation of the inducement standard, combined with the *MGM* Court’s statement of the rule, and the diverse patent inducement cases, show how heterogeneous and unclear the inducement rule is. As an overall proposition, the broad “active steps” to “encourage direct infringement” language used by the *MGM* Court regarding advertising and instructions, Chisum’s observation that the mens rea of inducement is unclear, and the wide variety of rules pro-

¹¹² CHISUM, *supra* note 62, § 17.04(2).

¹¹³ No. 73-404-R, 1974 U.S. Dist. LEXIS 8152 (E.D. Va. June 11, 1974).

¹¹⁴ CHISUM, *supra* note 62, § 17.04(2).

¹¹⁵ *Id.*

¹¹⁶ *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 125 S. Ct. 2764, 2779 (2005).

¹¹⁷ CHISUM, *supra* note 62, §§ 17.04(4)(a)–(g).

¹¹⁸ See *supra* note 20; see *infra* Part III.

¹¹⁹ CHISUM, *supra* note 62, §17.04(4)(f).

¹²⁰ *Id.*

posed by the patent law inducement cases, together suggest that inducement is a broad, easy-to-apply, yet extremely unclear rule.¹²¹ Analysis of patent doctrine does nothing to clarify it.

B. *The Incitement Standard and the “Violent Media” Cases: Likely Heroes*

Falling closer to the entertainment industry that spawned *MGM*, the incitement rule is overwhelmingly the standard used in what may be referred to broadly as the “violent media” line of cases.¹²² The incitement standard is the best tool with which to clarify the inducement rule because the “violent media” incitement cases, like *MGM*, involve secondary liability related to expression. In these cases, a media entity (such as a musician or a movie producer) disseminates his or her entertainment product, a consumer of that product (a listener of the music or a viewer of the movie) subsequently inflicts harm upon herself or harms a third party, and the media entity is blamed for such conduct.¹²³ These cases provide an intriguing overview of the application of the incitement test to speakers whose primary purpose in speech is creative, often copyrightable, expression.¹²⁴ Despite divergences in jurisdictions, these cases overwhelmingly conclude in the protection of the arts and the speakers who disseminate these expressive products.¹²⁵

The incitement test, itself, stands in stark contrast to the loose requirements of the inducement rule. As set forth in *Brandenburg v. Ohio*,¹²⁶ the incitement standard says that

the constitutional guarantees of free speech and free press do not permit a State to forbid or proscribe advocacy of the use of force or of law violation *except where such advocacy is directed to inciting or producing imminent lawless action and is likely to incite or produce such action.*¹²⁷

The Supreme Court of the United States, in *Brandenburg*, emphasized that statutes violate First Amendment rights by proscribing “the mere abstract teaching . . . of the moral propriety or even moral

¹²¹ *MGM*, 125 S. Ct. 2764, 2779–80. For an overview of the nuances of the patent inducement rule, see *supra* note 109.

¹²² As discussed below, the label “violent media cases” comes from the common presence in these cases of a media consumer committing a violent act upon himself or others allegedly at the behest of the media speaker.

¹²³ See generally *infra* note 188.

¹²⁴ See generally *infra* note 188.

¹²⁵ But see *infra* note 185.

¹²⁶ 395 U.S. 444 (1969).

¹²⁷ *Id.* at 447 (emphasis added).

necessity for a resort to force and violence.”¹²⁸ The incitement standard is a test that requires a higher level of scrutiny and arguably provides a greater level of protection to speakers, as it requires *both* imminence of lawless action *and* likelihood that the speech will cause such action.¹²⁹

In *Brandenburg*, a Ku Klux Klan leader held a rally on his farm and invited a television reporter to tape the action.¹³⁰ He was consequently convicted under the Ohio Criminal Syndicalism statute for his advocacy of “the duty, necessity, or propriety of crime, sabotage, violence, or unlawful methods of terrorism as a means of accomplishing industrial or political reform” and for assembling “with any society, group, or assemblage of persons formed to teach or advocate the doctrines of criminal syndicalism.”¹³¹ The cameras caught images of hooded figures carrying firearms gathered around a burning cross, spouting racial epithets, and giving inflammatory speeches about their hatred of minorities and taking “revengeance” on the government for oppressing whites.¹³² The *Brandenburg* Court adopted and applied the above test and held that the Ohio statute was invalid, as it proscribed mere advocacy of violence and not “incitement to imminent lawless action.”¹³³ As stated above, this is the bedrock test applied in the following media/expression-related cases.

In *Byers v. Edmonson*¹³⁴ the plaintiff, Byers, was shot and rendered paralyzed during a convenience store robbery.¹³⁵ The shooter, Sarah Edmondson, and her boyfriend Benjamin Darrus, had left their home in Oklahoma to go to a concert, but instead engaged in a multi-state shooting spree ending in one murder and Byers’s paralysis.¹³⁶ Upon their apprehension, Edmonson explained that the couple had watched the movie *Natural Born Killers* the night before their trip.¹³⁷ She noted that they had watched the movie several times recently and that they had taken LSD.¹³⁸ Edmonson claimed they would not have taken a gun on their trip but for watching the movie, and that the movie had a “numbing influence” on them which

¹²⁸ *Id.* at 448 (quoting *Noto v. United States*, 367 U.S. 290, 297–98 (1961)).

¹²⁹ *Id.* at 447.

¹³⁰ *Id.* at 445–47.

¹³¹ *Id.* at 444–45.

¹³² *Brandenburg*, 395 U.S. at 445–47.

¹³³ *Id.* at 448–49.

¹³⁴ 826 So. 2d 551 (La. Ct. App. 2002).

¹³⁵ *Id.* at 553.

¹³⁶ *Id.*

¹³⁷ *Id.*

¹³⁸ *Id.* at 553 n.2.

sparked a desire to feel “the power of violence.”¹³⁹ Byers consequently filed a lawsuit against the couple, as well as Time Warner, the production company behind *Natural Born Killers*, and Oliver Stone, the film’s director.¹⁴⁰ Byers’s theory was that the murderous couple was inspired and incited by the movie, and that the movie’s content had caused their violent behavior.¹⁴¹

The Louisiana appellate court held that, despite the abundance of violent imagery in the movie, it did not constitute incitement because nothing in the movie necessarily “exhorts, urges, entreats, solicits, or overtly advocates or encourages unlawful or violent activity on the part of viewers.”¹⁴² The movie did not “purport to order or command anyone to perform any concrete action immediately or at any specific time,” nor did it ever direct nor urge viewers “to commit any type of imminent lawless activity.”¹⁴³

The *Byers* court viewed the film and decided that this was a “copycat scenario” that did not remove the film from First Amendment protection simply because it had “a tendency to lead to violence.”¹⁴⁴ Although the shooters may have imitated the characters in the movie out of inspiration to feel the power they felt while watching the characters’ violent crime spree, the court decided, as a matter of law, that *Natural Born Killers* was not inciteful because it did not “direct or encourage them to take such actions.”¹⁴⁵

The *Byers* court focused much of its analysis on the artistic elements of the movie.¹⁴⁶ The movie was not inciteful because it was not mainly about violence or murder, but portrayed the life and lifestyle of the main characters, their relationship, their incidental killing sprees, and “how their exploits are glorified by the media to the point where they become cultural icons.”¹⁴⁷ A main point of analysis was the film’s imagery, such as its frequent colorization changes, cartoon clips, “facial distortions,” “sitcom laugh tracks,” and use of slow motion and bizarre camera angles, all of which “place[d] [the] film in the realm of fantasy.”¹⁴⁸ This analysis, like in the other cases to follow, seemed to focus on the expressive elements of the film protected by

¹³⁹ *Id.*

¹⁴⁰ *Byers*, 826 So. 2d at 554.

¹⁴¹ *Id.* at 553–54.

¹⁴² *Id.* at 556.

¹⁴³ *Id.*

¹⁴⁴ *Id.* at 557 (quoting *Hess v. Indiana*, 414 U.S. 105, 109 (1973)).

¹⁴⁵ *Id.*

¹⁴⁶ *Byers*, 862 So. 2d at 556.

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

the First Amendment, coupled with its failure of the *Brandenburg* test.¹⁴⁹

A similar case, *Yakubowicz v. Paramount Pictures Corp.*,¹⁵⁰ involved the murder of a young man during a remote incident of gang violence shortly after a public theater showed the movie *The Warriors*.¹⁵¹ The decedent's father sued Paramount (the producer and distributor of the movie), alleging that the movie, a fictional story about gang violence in New York City, incited his son's killer to stab him to death.¹⁵²

The Supreme Judicial Court of Massachusetts viewed the film and decided that nothing in it constituted incitement despite its many violent scenes, because at no time did the film "exhort, urge, entreat, solicit, or overtly advocate or encourage unlawful or violent activity on the part of viewers."¹⁵³ The film did not create a likelihood of imminent lawless action and it did not command viewers to immediately commit violent acts.¹⁵⁴ The court held that this work of fiction, this creative story, did not constitute unprotected incitement, and the defendant movie companies were not unreasonable in creating the work and disseminating it to the public.¹⁵⁵

Cases involving music follow essentially the same trend and analysis, yet focus more on lyrics as poetic device and metaphor which lack a direct command to action.¹⁵⁶ In *Davidson v. Time Warner, Inc.*,¹⁵⁷ gang member Ronald Howard shot and killed Texas State Trooper Bill Davidson after the officer stopped Howard (who was driving a stolen car) for a routine traffic violation.¹⁵⁸ At the time he shot Officer Davidson, Howard was listening to *2Pacaplyse Now*, a Tupac Shakur rap record.¹⁵⁹ The murdered officer's family sued Shakur and the defendant record labels, claiming, *inter alia*, that the record incited the killing.¹⁶⁰

A Texas district court held that the plaintiffs could not prove Howard's violent action was a likely, imminent result of listening to

¹⁴⁹ *Id.* at 556–57.

¹⁵⁰ 536 N.E.2d 1067 (Mass. 1989).

¹⁵¹ *Id.* at 1068.

¹⁵² *Id.*

¹⁵³ *Id.* at 1071.

¹⁵⁴ *Id.*

¹⁵⁵ *Id.* at 1072.

¹⁵⁶ See *infra* notes 157–84 and accompanying text.

¹⁵⁷ No. V-94-006, 1997 U.S. Dist. LEXIS 21559 (S.D. Tex. Mar. 31, 1997).

¹⁵⁸ *Id.* at *4.

¹⁵⁹ *Id.*

¹⁶⁰ *Id.* at *6.

2Pacalypse Now even though Shakur's intent may have been to produce such action.¹⁶¹ "At worst," the court noted, "Shakur's intent was to cause violence some time after the listener considered Shakur's message. The First Amendment protects such advocacy."¹⁶² Although the music and lyrics were insulting and derogatory (or, as Shakur called them, "revolutionary"), the plaintiffs failed to show that Shakur intended to incite imminent violence, and even if he did, such violence was not a likely result of listening to the record.¹⁶³

The court also explained that rational listeners could not possibly believe that "musical lyrics and poetry" were the equivalent of "literal commands or directives to immediate action" aimed specifically at the individual listener.¹⁶⁴ Such a belief would not be in accordance with First Amendment protection of expressive speech, such as song lyrics.¹⁶⁵ Simply because "weak-willed individuals may be influenced by Shakur's work" does not mean that the courts will remove the work's First Amendment protection.¹⁶⁶

The *Davidson* court cites to *McCullum v. CBS, Inc.*,¹⁶⁷ another landmark music case from several years earlier, involving heavy metal icon Ozzy Osbourne.¹⁶⁸ In *McCullum*, a teenager shot himself while listening to Osbourne's record.¹⁶⁹ Despite the teenager's substance abuse problems and emotional turmoil, his parents sued Osbourne and the accompanying record labels for proximately causing their son's suicide.¹⁷⁰ One of their theories was incitement to imminent lawless action via a song called *Suicide Solution*.¹⁷¹

As in the previous cases, a California appellate court in *McCullum* could find no incitement.¹⁷² Intent and likelihood of violence were

¹⁶¹ *Id.* at *63.

¹⁶² *Id.*

¹⁶³ *Davidson*, 1997 U.S. Dist. LEXIS 21559, at *66. The court noted that the record had been released three years prior and had sold over 400,000 copies; that being said, the Davidsons were the first parties to bring an incitement suit against Shakur and the record labels, making it unlikely that the album caused Howard's violent behavior. *Id.* Howard was also a gang member driving a stolen car, most likely fearing arrest, which suggests even a lesser likelihood that the murder was triggered by the music. *Id.*

¹⁶⁴ *Id.* at *67–*68 (citing *McCullum v. CBS*, 249 Cal. Rptr. 187, 194 (Cal. Ct. App. 1988)).

¹⁶⁵ *Id.* at *68.

¹⁶⁶ *Id.* at *70.

¹⁶⁷ 249 Cal. Rptr. 187 (Cal. Ct. App. 1988).

¹⁶⁸ *Id.* at 188.

¹⁶⁹ *Id.* at 189.

¹⁷⁰ *Id.*

¹⁷¹ *Id.* at 190–91.

¹⁷² *Id.* at 194–95.

absent, as the decedent was not even listening to *Suicide Solution* at the time of his death; imminency was lacking because nothing in Osbourne's songs "could be characterized as a command to an immediate suicidal act."¹⁷³ Taking the lyrics literally, the court still could not find that they constituted a command to commit suicide, and if they had, such action was not demanded at a specific, immediate time.¹⁷⁴

The *McCollum* court noted that when judges act as censors, the lyrics of a song can be seriously misconstrued, especially when they were meant to be "a play on words, to convey meanings entirely contrary to those asserted by plaintiff."¹⁷⁵

Ultimately, the court held that creative expression such as song lyrics and poetry could not be "construed to contain the requisite 'call to action'" and that a reasonable listener would interpret the lyrics as poetic device, symbolism, or metaphor.¹⁷⁶ Rational persons could not mistake lyrical expression for specific, personal, immediate commands to take imminent violent action, and the First Amendment does not permit any contrary assumption.¹⁷⁷ The court noted that art which causes a depressive mood does not automatically constitute incitement, and the philosophical ideas regarding suicide as a plausible alternative to life can be freely advocated and constitute protected expression no matter how bizarre or controversial they may be.¹⁷⁸

A few years after *McCollum*, Osbourne ran into the same problem regarding his music in a case called *Waller v. Osbourne*.¹⁷⁹ Another young man took his own life supposedly while listening to an Osbourne record, and his parents sued the artist for disseminating music that purportedly incited their son to kill himself.¹⁸⁰ A Georgia district court found a lack of incitement because Osbourne's music was not "directed toward any particular person or group of persons" and there was no evidence that the music "was intended to produce acts of suicide and likely to cause *imminent* acts of suicide; nor could one rationally infer such a meaning from the lyrics."¹⁸¹ The plaintiffs had

¹⁷³ *McCollum*, 249 Cal. Rptr. at 193.

¹⁷⁴ *Id.*

¹⁷⁵ *Id.*

¹⁷⁶ *Id.* at 194.

¹⁷⁷ *Id.*

¹⁷⁸ *Id.*

¹⁷⁹ 763 F. Supp. 1144 (M.D. Ga. 1991).

¹⁸⁰ *Id.* at 1145.

¹⁸¹ *Id.* at 1151.

not even proved that the decedent had listened to the song right before he shot himself.¹⁸²

The court's analysis of *Suicide Solution* mirrored the *McCullum* court's analysis by emphasizing that philosophical assertions about suicide constituting "abstract discussion" are not equivalent to an imminent urge or encouragement that someone should take such action.¹⁸³ This artistic expression did not rise to the level of incitement to imminent lawless action and was therefore shielded by First Amendment protections.¹⁸⁴

At this point in the analysis it is important to note that incitement is a valid test—not a neutered one—despite the vast majority of media incitement cases concluding in the same manner. The test is not merely mechanically applied with the blind expectation that every case will turn out the same; incitement is valid because there are exceptions to the general rule—where the media have been found liable for incitement—as seen in *Rice v. Paladin Enterprises, Inc.*¹⁸⁵ In this case, the publishers of a book called *Hit Man: A Technical Manual for Independent Contractors* were found liable when a hired contract killer precisely followed the detailed instructions in the guidebook for murder to aid him in committing a triple homicide.¹⁸⁶ The book and its publisher lost their First Amendment protection because the book went beyond mere advocacy and constituted incitement, and the United States Court of Appeals for the Fourth Circuit found that the publisher had aided and abetted the murders via the guidebook.¹⁸⁷

¹⁸² *Id.* at 1151 n.15.

¹⁸³ *Id.*

¹⁸⁴ The *Waller* court also engaged in a lengthy discussion about the plaintiff's allegations that Osbourne's songs contained subliminal messages. *Id.* at 1146–48. The court ultimately decided that such messages did not exist; however, this is not determinative for incitement purposes. *Waller*, 763 F. Supp. at 1148–50.

¹⁸⁵ 128 F.3d 233, 250 (4th Cir. 1997) (noting that the district court had "erred . . . [when it misunderstood] . . . *Brandenburg* to protect not just abstract advocacy of lawlessness and the open criticism of government and its institutions, but also the teaching of the technical methods of criminal activity—in this case, the technical methods of murder").

¹⁸⁶ *Id.* at 239.

¹⁸⁷ *Id.* at 250, 255.

The violent media cases do follow a clear trend, however.¹⁸⁸ Expressive, often copyrightable, creations such as movies, music, and song lyrics have almost never been found to have incited imminent lawless action. Such expression generally finds solid protection under the First Amendment behind the shield of the *Brandenburg* incitement test. The speech at issue in *MGM* would likely fall in step with the majority of these incitement cases, as opposed to the exception, *Rice*; this issue is addressed in more detail in the following section. The speech at issue in *MGM*—advertisements, marketing schemes, and internal communications—do not come anywhere close to a detailed hitman manual, and as copyrightable commercial material, would fall much closer to the side of the fence where the creative expression seen in the violent media cases fell. The only exception may be Grokster’s newsletter to users,¹⁸⁹ mentioned above, which may or may not find solace under even a stricter inducement test. Therefore, were inducement interpreted in a stricter, more pro-speech, incitement-esque light, the majority of the commercial speech at issue in *MGM* would be shielded by the First Amendment, and the speakers would be immune from secondary liability.¹⁹⁰

III. INDUCEMENT AND INCITEMENT AS DISTINCT: SECONDARY LIABILITY FOR EXPRESSION AND THE NECESSITY FOR COPYRIGHT TO ACKNOWLEDGE THE FIRST AMENDMENT

By placing inducement and incitement side by side, the reader can see that the two standards are very different. Incitement, generally, is an extremely difficult standard to meet—especially in the context of creative, often copyrightable, expression such as music, movies, and song lyrics—as it requires both imminent illegal action *and* a likelihood that the illegal action will occur.¹⁹¹ Inducement, on the other hand, is a more expansive and ambiguous test that is not altogether clear, and is easily satisfied in the patent infringement cases

¹⁸⁸ See also *James v. Meow Media, Inc.*, 300 F.3d 683, 697–99 (6th Cir. 2002) (video games, movies, and internet pornography did not incite school shooter’s killing spree); *Herceg v. Hustler Magazine, Inc.*, 814 F.2d 1017, 1022–23 (5th Cir. 1987) (Hustler magazine did not incite boy’s accidental suicide by hanging after he read an article about autoerotic asphyxia, a dangerous sexual practice); *Olivia N. v. Nat’l Broad. Co.*, 178 Cal. Rptr. 888, 892 (Cal. Ct. App. 1981) (rape scene in a television movie did not incite copycat rape of a young girl); *Pahler v. Slayer*, No. CV 79356, 2001 WL 1736476, at *4 (Cal. Super. Oct. 29, 2001) (death metal band, Slayer, did not incite rape and murder of a young girl through song lyrics).

¹⁸⁹ See *supra* notes 20 and 21 and accompanying text.

¹⁹⁰ See *infra* Part III.

¹⁹¹ *Brandenburg v. Ohio*, 395 U.S. 444, 447 (1969); see *supra* Part II.B.

mentioned above.¹⁹² As a general proposition, incitement is a more speech-protective doctrine because it is harder to satisfy the test. Logically, the harder the test is to satisfy, the more speech will retain its First Amendment protection. More often than not, political¹⁹³ and creative speech¹⁹⁴ will escape incitement liability. Inducement, however, has historically been used in a strictly patent context and its application has often been successful.¹⁹⁵

The speech at issue in *MGM*—advertisements, marketing plans, press releases, and internal communications regarding such plans—are granted First Amendment protection as commercial speech.¹⁹⁶ The commercial speech in *MGM* is more akin to the copyrightable creative and expressive speech protected by the incitement standard in the violent media cases,¹⁹⁷ as opposed to the inventions and processes which are afforded strict patent protection to which the inducement standard applies.¹⁹⁸ Courts should interpret the *MGM* inducement rule in light of the incitement standard and thus make inducement a more speech-protective test that preserves First Amendment rights of software designers and advertisers.¹⁹⁹ As noted

¹⁹² For an overview of the nuances of the patent inducement rule, see *supra* note 109.

¹⁹³ See *Brandenburg*, 395 U.S. at 448–49.

¹⁹⁴ See *supra* Part II.B.

¹⁹⁵ For an overview of the nuances of the patent inducement rule, see *supra* note 109.

¹⁹⁶ See *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 564 (1980) (Commercial speech is protected, generally, if it constitutes speech, it is lawful, and it is not misleading.). Although it could be argued that the speech at issue here is not legal (and therefore not protected commercial speech) because it “induces” copyright infringement, this circular assertion simply begs the issue. If the test to be used were stricter, like incitement, the speech would not be found illegal because it would lack immanency. See *supra* Part II.B. To argue that the speech at issue in *MGM* falls outside commercial speech protection goes beyond the scope of this Comment and creates a circular argument that defeats the purpose of determining the proper test to use in circumstances similar to *MGM*.

¹⁹⁷ Joel Timmer, *When a Commercial is Not a Commercial: Advertising of Violent Entertainment and the First Amendment*, 7 COMM. L. & POL'Y 157, 186 (2002) (“Because advertising of media products often embodies ideas or opinions in the underlying works, courts will likely accord such advertising the same level of First Amendment protection given the artistic expression in the works themselves.”).

¹⁹⁸ For an overview of the nuances of the patent inducement rule, see *supra* note 109.

¹⁹⁹ It is inconsequential that the violent media cases do not touch on the issue of copyrightability. The analogy here is that the expression in the violent media cases fell under one test (incitement), and would be the subject of copyright protection, whereas the intellectual property in the inducement cases fell under another test (inducement), and would be the subject of patent protection. The key is that the speech in *MGM* falls more on the side of the violent media cases than the patent inducement cases. Therefore, it should fall under an interpretation of inducement

above, incitement is the best way to clarify the already-hazy inducement standard,²⁰⁰ and by interpreting inducement in this way, the speech at issue in *MGM* would not pass muster based on the analysis of the violent media cases, and would therefore be protected under the First Amendment.²⁰¹

This proposition of a paradigmatic shift in the interpretation of the inducement standard is born out of the notion that copyright and patent protect very different types of intellectual property. The copyright statute states that copyright protection applies to “original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated.”²⁰² Copyright protection specifically does *not* apply to “any idea, procedure, process, system, method of operation, concept, principle, or discovery” despite the form in which it appears.²⁰³ Patent protection, however, extends to inventions or discoveries of “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.”²⁰⁴ Patent protection will imbue if a product or process is useful, novel, and non-obvious.²⁰⁵ Patent protection is more a form of idea protection than copyright even though the inventor must have documentation of his invention in the form of a patent application (including an oath, drawings, models or specimens, and specific claims of protection) to get protection.²⁰⁶ The inventor generally need not even work the invention to maintain this security because the inventor has protected the idea by reduction to practice or constructive reduction to practice.²⁰⁷

more akin to the incitement test instead of the more generous patent inducement test, because the speech in *MGM* is a closer analogue to copyrightable speech than to patentable inventions.

²⁰⁰ See *supra* Part II.B.

²⁰¹ See *supra* Part II.B. The advertisements to former users, offerings of software, diversion of search queries, technical assistance, and refusal to filter content would likely fail a stricter interpretation of the inducement rule, and therefore be protected under the First Amendment. Grokster’s newsletter promoting its ability to find copyrighted material may be the only questionable element in light of *Rice v. Paladin Enters., Inc.*, 128 F.3d 233 (4th Cir. 1997).

²⁰² 17 U.S.C. § 102(a) (2000).

²⁰³ *Id.* § 102(b).

²⁰⁴ 35 U.S.C. § 100 (2000).

²⁰⁵ *Id.* §§ 101–03.

²⁰⁶ *Id.* §§ 111–15.

²⁰⁷ See PAUL GOLDSTEIN, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES 439–40 (rev. 5th ed. 2004).

Copyright protection is much more narrowly drawn in protecting only *expression* of ideas and not ideas themselves, or inventions embodying ideas. Nevertheless, copyright is a more mercurial concept than patent, which, although more idea-protective than copyright, is more tangible in its protection of concrete products and inventions. What may constitute *expression* of an idea is vaguer.²⁰⁸ Inducement seems more appropriate for patent cases because it is a looser, broader standard that can apply easily in cases where a tangible, valuable product or idea is infringed, even based on advertising or marketing. The stricter standard of incitement, on the other hand, applies more appropriately to expressive speech, which is more likely to be the subject of copyright, simply because of its elusive nature. Perhaps because free expression is a broad concept and a valued activity, courts and legislatures have accepted a stricter test in order to give more First Amendment protection to what they view as a valuable constitutional right.²⁰⁹ Because the commercial speech at issue in *MGM* is a closer cousin to the expressive copyrightable speech found privileged in the “violent media” incitement cases, an incitement-influenced reading of inducement should apply to the advertisements and marketing plans at use in *MGM*, which may themselves be considered expressive and creative, and therefore copyrightable.²¹⁰

In *MGM*, copyright law essentially trumps free speech in advertisements and marketing schemes. The Supreme Court of the United

²⁰⁸ See *Baker v. Selden*, 101 U.S. 99, 101–02, 107 (1879) (early Supreme Court case identifying the confusion inherent in the idea/expression dichotomy).

²⁰⁹ See Susan W. Brenner, *Complicit Publication: When Should the Dissemination of Ideas and Data Be Criminalized?*, 13 ALB. L.J. SCI. & TECH. 273, 302–03 (2003) (“*Brandenburg* is . . . more protective of speech than Holmes’ [clear and present danger] standard because it demands a closer connection between speech and unlawful action ‘[R]are will be the speech that not only advocates lawless action, but is likely to accomplish that result imminently.’”) (internal citations omitted); William Li, *Unbaking the Adolescent Cake: The Constitutional Implications of Imposing Tort Liability on Publishers of Violent Video Games*, 45 ARIZ. L. REV. 467 (2003):

[*Brandenburg*] operates as a higher standard of causation[;] . . . application of the usual standard of proximate cause has the potential to expose the media to tort liability for just about any creative work that somehow inspires a child or mentally ill individual to commit an act of violence. Therefore, *Brandenburg* requires “incitement” as a higher standard of causation than mere “influence” or “inspiration” . . . [and] constitutes a viable compromise between a plaintiff’s interests in compensation and a defendant’s free speech interests.

Id. at 493–94 (internal citations omitted).

²¹⁰ See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903) (finding that lithograph advertisements were sufficiently expressive to be considered copyrightable expression; advertisements were not exempt from copyright protection simply because they served a commercial purpose).

States, however, has applied a patent test in a copyright situation. Future courts should recognize this disparity and realize that the speech at issue is more akin to the copyrightable speech in the “violent media” incitement cases as opposed to the patented products protected in the inducement cases. Because the Court in *MGM* favors copyright protection over free speech, it should employ a more copyright-applicable test as opposed to a broad patent test. In arguing this proposition, it is important to reiterate the conflict between free speech and copyright and explain the goals of each doctrine.

Copyright protection and free speech conflict in that the First Amendment instructs the government “not to abridge speech on the one hand, and the Copyright (and Patent) Clause . . . permits Congress to limit speech, on the other.”²¹¹ That being said, the long-term goal of copyright protection and the short-term goal of free speech often clash.²¹² Generally speaking, the long-term goal of copyright “is the enhancement of learning, the advancement of knowledge and the progress of science” through a limited monopoly on certain qualified forms of expression, whereas the goal of the First Amendment is immediate freedom from government interference with speech.²¹³ The long-term goal of copyright protection restricts free speech for the short-term “and has the practical effect of strengthening the property rights during that period.”²¹⁴

Recent cases, such as *Eldred v. Ashcroft*,²¹⁵ have extended this property right even further, resulting in even more limitation on free speech in the short-run in favor of copyright protection in the long-run.²¹⁶ The plaintiff in *Eldred* ran an online service allowing free downloads of public domain books; he challenged the constitutionality of the Sonny Bono Copyright Term Extension Act of 1998 (“CTEA”) arguing, *inter alia*, violation of his First Amendment rights to make speech accessible to those who visit his website.²¹⁷ The Supreme Court of the United States ultimately found that the CTEA (which added an extra twenty years of copyright protection to new and existing works) was constitutional, and rejected the plaintiff’s claims of conflict with the First Amendment.²¹⁸

²¹¹ Birnhack, *supra* note 11, at 1304.

²¹² Michael Birnhack, *The Copyright Law and Free Speech Affair: Making-Up and Breaking-Up*, 43 IDEA 233, 293 (2003).

²¹³ *Id.*

²¹⁴ *Id.*

²¹⁵ 537 U.S. 186 (2003).

²¹⁶ *Id.* at 218–21.

²¹⁷ *Id.* at 192–94.

²¹⁸ *Id.* at 218–21.

In the *MGM* context, the short-term result in applying the inducement test would be to restrict speech by advertisers and software manufacturers by favoring the long-term goal of copyright protection of authors whose materials may (or may not) be infringed. Essentially, the *MGM* Court is validating this existing “copyright exception to the First Amendment,” which was recently bolstered and upgraded by *Eldred*.²¹⁹

Volokh suggests that *Eldred* created an important boundary to this “copyright exception”: “The copyright exception immunizes only laws that protect creative expression rather than facts or ideas” and the allowance of free communication of *facts* balances the free speech/copyright scales, thus making copyright law constitutional based on its built-in “idea/expression dichotomy.”²²⁰ As mentioned above, this protection is different from the protection afforded by patent law, which generally allows for the protection of ideas.²²¹

Volokh also points out, however, that despite the idea/expression dichotomy and the seemingly universal protection on the expression of factual information, copyright law may indeed restrict publication of facts in some circumstances: when a newspaper publishes “a story about a store that sells some infringing material” and the story “mentions the store’s name and address” or when a website provides the name and URL of another web site that distributes infringing material.²²² In Volokh’s hypotheticals, the speakers’ publication of *facts* could constitute contributory infringement of the copyrights at issue.²²³

In the *MGM* context, such publication of facts could constitute inducement on the part of the newspaper publisher, writer, webmaster, or website designer. Because the broad-based inducement rule adopted in *MGM* is a patent standard, it does not take into account the inherent effects the rule could have on otherwise freely expressible *factual* assertions because there simply are no free speech issues in the patent context. Were future courts to interpret the inducement rule in light of incitement, a more copyright-friendly and speech-friendly doctrine, the conflict seen in the *MGM* context would dissolve. Arguably, the advertisements and marketing schemes at issue

²¹⁹ Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred*, 44 *Liquormart*, and *Bartnicki*, 40 *HOUS. L. REV.* 697, 713 (2003).

²²⁰ *Id.* at 713–14.

²²¹ See GOLDSTEIN, *supra* note 207, at 439–40.

²²² Volokh, *supra* note 219, at 715.

²²³ *Id.*

in *MGM* were inherently factual,²²⁴ which would afford them protection under an altered, stricter interpretation of the inducement rule, despite the fact that traditional copyright law (as expressed by Volokh's examples) may still bar the speech under a contributory infringement theory.²²⁵

CONCLUSION

Courts facing future cases analogous to *MGM* should utilize an incitement-tinged interpretation of the inducement rule as opposed to strictly interpreting the test in a broad patent sense. The inducement rule, as it stands, is murky and unworkable, and would lead to courts perpetuating secondary liability for expression on a convoluted path toward a state of confusion. Clarification of inducement in light of incitement and the "violent media" cases, as well as differentiating between the types of intellectual property protected by each test, will afford more First Amendment protection to advertisers and marketers of P2P software, and will ensure that both their advertisements and disclaimers will receive the protection they constitutionally deserve. The goal of affording this protection is, of course, to prevent a chilling effect on speech and innovation, alike. This proposed interpretation of the test, however, is not without teeth, and could still bar speech in some factual circumstances.²²⁶

To say that illicit downloading and the proliferation of P2P software in the last several years is a contentious issue would be an understatement. Amidst the melee and mudslinging, the defiance of downloaders and the counter-defiance of the copyright owners, as well as the staggering number of lawsuits, the issue of free speech seems to have been lost, hiding under a rock in hopes of avoiding the crossfire. Nevertheless, free speech implications are unavoidable when dealing with the marketing and advertising of P2P software or any technology. If courts are going to deal with the conflict between copyright and technological innovation, they will also have to deal with the First Amendment's potential conflicts with inducement. When these issues inevitably arise, courts should employ an interpretation of the *MGM* inducement rule in light of the "violent media" incitement cases to ensure as much First Amendment protection to advertisements and marketing schemes as courts should analogously

²²⁴ For a description of these materials, see *supra* note 20.

²²⁵ Volokh, *supra* note 219, at 715–16.

²²⁶ As mentioned in *supra* note 201, Grokster's newsletter promoting its ability to find copyrighted material may be the only questionable element in light of *Rice v. Paladin Enters., Inc.*, 128 F.3d 233 (4th Cir. 1997).

afford to the technological innovations that act as the impetus for such commercial speech.