

Spring 1985

## Contributory Infringement by Providing the Means: The Staple Article of Commerce Doctrine and an Alternative Analysis for Copyright Law, 18 J. Marshall L. Rev. 703 (1985)

Michael J. McCambridge

Follow this and additional works at: <https://repository.law.uic.edu/lawreview>



Part of the [Intellectual Property Law Commons](#)

---

### Recommended Citation

Michael J. McCambridge, *Contributory Infringement by Providing the Means: The Staple Article of Commerce Doctrine and an Alternative Analysis for Copyright Law*, 18 J. Marshall L. Rev. 703 (1985)

<https://repository.law.uic.edu/lawreview/vol18/iss3/6>

This Comments is brought to you for free and open access by UIC Law Open Access Repository. It has been accepted for inclusion in UIC Law Review by an authorized administrator of UIC Law Open Access Repository. For more information, please contact [repository@jmls.edu](mailto:repository@jmls.edu).

CONTRIBUTORY INFRINGEMENT BY  
PROVIDING THE MEANS: THE STAPLE  
ARTICLE OF COMMERCE  
DOCTRINE AND AN  
ALTERNATIVE ANALYSIS FOR COPYRIGHT  
LAW\*

[C]ontributory infringement . . . is grounded on the recognition that adequate protection of a monopoly may require [that] the courts look beyond . . . [direct infringement] to the products or activities that make such duplication possible. The staple article of commerce doctrine must strike a balance between a copyright holder's demand for effective—not merely symbolic—protection of the statutory monopoly, and the rights of others freely to engage in substantially unrelated areas of commerce.\*\*

The Copyright Act does not expressly render a third-party liable for facilitating an act of copyright infringement.<sup>1</sup> The case law, however, includes many instances in which the courts have imposed such liability on third parties.<sup>2</sup> The courts have found this liability under the judicially-created doctrine of contributory infringement.<sup>3</sup> This doctrine, which is extremely flexible, has allowed the courts to apply it to a broad variety of factual situations.<sup>4</sup> It is flexible be-

---

\* The author intends to enter this article in the 1985 Nathan Burkan Memorial competition sponsored by the American Society of Composers, Authors and Publishers.

\*\* *Sony Corp. of Am. v. Universal City Studios, Inc.*, 104 S. Ct. 774, 789 (1984) (a recent pronouncement of contributory infringement for providing the means).

1. The copyright statute proscribes direct infringement and the authorization of such infringement but does not impose third-party liability on those who merely facilitate another's act of direct infringement. See 17 U.S.C. § 106, 501 (1982). See also *infra* notes 19-22 and accompanying text.

2. A third party is a person other than the party who actually completes or performs the act of direct infringement. See BLACK'S LAW DICTIONARY 1327 (5th ed. 1979) (defining a third party as one who is not party to a transaction, but who has rights arising from the transaction; in the case of contributory infringement, this would be liability arising from the act of infringement).

3. See *infra* notes 24-26 and accompanying text.

4. Such liability has arisen from such diverse circumstances as where any further contribution by the defendants would have constituted taking part in the final act, *Kalem Co., v. Harper Bros.*, 222 U.S. 55, 63 (1911) (the defendant produced and promoted a movie version of a popular book whose exhibition was the direct infringement), to where a retailer was liable for the infringing acts of an independent concessionaire operating within its store. *Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304 (2d Cir. 1963) (sales of infringing sound recordings). See *infra* notes 33, 37-40, 46-64, 70-78 & 84-99 and accompanying text.

cause the courts have melded its dual sources of origin<sup>5</sup> into a somewhat indistinguishable whole.<sup>6</sup> Recently, courts have introduced another, novel basis of liability for contributory copyright infringement: the staple article of commerce doctrine.<sup>7</sup> Its origin, however, lies in patent law.<sup>8</sup>

This comment discusses the propriety of applying the staple article of commerce doctrine to copyright law. It examines the current scope of statutory copyright protection and the doctrine of contributory infringement in both copyright and patent law. This analysis determines that the courts should not incorporate the staple article of commerce doctrine into copyright law in its present condition, even though it embodies a principle useful to copyright law.<sup>9</sup> This comment proposes an alternative means of employing this principle in cases where the defendant provides the means of infringement.<sup>10</sup>

#### STATUTORY COPYRIGHT PROTECTION

The Constitution authorizes Congress to grant authors and inventors exclusive rights in their works.<sup>11</sup> These rights were

5. These independent bases are the agency doctrine of *respondeat superior*, and the tort doctrine of joint and several liability. See *infra* notes 27 & 28 and accompanying text.

6. See *infra* note 29 and accompanying text.

7. The staple article of commerce doctrine examines the quantity and quality of non-infringing uses for an article which the defendant sold to the direct infringer for use in an act of infringement and imposes or denies liability on this basis. See *infra* notes 133-37 and accompanying text. For a discussion of the adoption of the staple article of commerce doctrine into copyright law, see *infra* notes 70-78 and accompanying text. For a definition of a "staple article" in the patent context see *infra* note 120.

8. See 35 U.S.C. § 271(c) (1982). Contributory patent infringement existed as a judicially-created doctrine prior to the current patent act, but the staple article of commerce doctrine did not exist in its present form until the current patent statute. *Dawson Chem. Co. v. Rohm & Haas Co.*, 448 U.S. 176, 180, 184 (1980) (discussing the history of contributory infringement as a judicial doctrine, but holding that 35 U.S.C. §§ 271(c) & (d) constitute a new balance for contributory infringement); Oddi, *Contributory Infringement/Patent Misuse: Metaphysics and Metamorphosis*, 44 U. PITT. L. REV. 73, 75-81, 83-87 (1982) (discussing the developmental history of contributory patent infringement and the staple article of commerce doctrine). See also 35 U.S.C. §§ 271(c) & (d) (1982); *infra* note 107 and accompanying text.

9. See *infra* notes 125-29 & 132-38 and accompanying text.

10. The courts have applied the staple article of commerce test to copyright cases where liability was contingent upon the defendant providing some device which was the means of infringement. In these cases, the courts deviated from the more traditional contributory infringement analysis. See *infra* notes 70-78 & 91-101 and accompanying text.

11. Article I, sec. 8 of the Constitution provides:

[t]he Congress shall have Power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

U.S. CONST. art. I, § 8, cl. 8.

designed to increase the public availability of information and ideas.<sup>12</sup> Copyright law, therefore, involves a balance between the private interest and the public interest.<sup>13</sup> On balance, the private interest is subordinate to the public interest.<sup>14</sup> The private interest of the author must remain protected from invasion, however, so that it may continue to serve its public purpose.<sup>15</sup> Congress has ex-

---

12. See, e.g., *Sony Corp. of Am. v. Universal City Studios, Inc.*, 104 S. Ct. 774, 782 (1984) (the purpose of copyright is to promote access to the fruit of individual creative effort); *Twentieth Cent. Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) ("Creative work is to be encouraged and rewarded, but private motivation must ultimately . . . [promote the] broad public availability of literature, music, and other arts."); *Meeropol v. Nizer*, 560 F.2d 1061, 1068 (2d Cir. 1977) (noting the public interest in dissemination of information in areas of broad concern); *Rosemont Ent. Inc. v. Random House, Inc.*, 366 F.2d 303, 307 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967); see also *Allied Artists Pictures Corp. v. Rhodes*, 496 F. Supp. 408, 446 (S.D. Ohio) (the fundamental purpose is to advance the arts and sciences), *modified*, 679 F.2d 656 (6th Cir. 1980). Courts have recognized that the private incentive of a limited monopoly encourages the creative effort in order to increase the availability of information and works of art. See, e.g., *Goldstein v. California*, 412 U.S. 546, 555 (1973) (the objective is to encourage the progress of science and the arts by granting a productive incentive); *Mazer v. Stein*, 347 U.S. 201, 219 (1954) ("encouragement of individual effort advances the public welfare"); *Gilliam v. American Broadcasting Co.*, 538 F.2d 14, 23 (2d Cir. 1976) (by acting as a reward, the copyright grant recognizes the role of the artist in society and the need to encourage production and dissemination of his works); *Gero v. Seven-Up Co.*, 535 F. Supp. 212, 216 (E.D.N.Y.) ("Copyright protection was [intended] to encourage the dissemination of ideas by protecting the embodiment or expression of an idea in a creative work, and reserving rights in it to that creator."), *aff'd*, 714 F.2d 113 (2d Cir. 1982).

13. See, e.g., *Sony Corp. of Am. v. Universal City Studios, Inc.*, 104 S. Ct. 774, 872-83 (1984) (observing that the constant shift in the balance has induced numerous statutory revisions by Congress who is in the best position to strike the proper balance); *Twentieth Cent. Music Corp. v. Aiken*, 422 U.S. 151, 157 (1975) (the limited scope and duration of the copyright grant reflect the balance); *Shapiro, Bernstein & Co. v. Goody*, 248 F.2d 260, 268 (2d Cir. 1957) (holding that it is for Congress to decide the balance of interests in copyright law). For this reason, the courts must recognize that the copyright statute must be interpreted in light of its basic purpose. *Sony*, *supra*, at 783-84; *Twentieth Cent. Music Corp.*, *supra*, at 156; *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 346 (1908).

14. *Twentieth Cent. Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (the private incentive of the copyright grant must ultimately serve its public purpose); see *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932) ("The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of the author.").

15. *Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304, 309 (2d Cir. 1963) (the purposes for copyright protection are better served by imposing liability on the contributory infringer than by allowing the copyright owner to bear the loss resulting from the infringement); *De Acosta v. Brown*, 146 F.2d 408, 413 (2d Cir. 1944) (observing the danger to authors if there is no liability for "innocent" infringement); *Atari, Inc. v. JS&A Group, Inc.*, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,613 (N.D. Ill. Dec. 6, 1983) (observing that the non-protection of the copyrights involved would result in a disincentive for others' production of such works); *Encyclopaedia Britannica Educ. Corp. v. Crooks*, 542 F. Supp. 1156, 1174 (W.D.N.Y. 1982) (without protection, the fruit of the productive effort is lost); *Elektra Records Co. v. Gem Electronic Dist., Inc.*, 360 F. Supp. 821, 825 (E.D.N.Y. 1973) (granted preliminary injunction against a contributory infringer because non-protection of the exclusive rights would defeat the purpose

exercised its constitutional authority several times to maintain the proper balance between these interests.<sup>16</sup>

The current copyright statute confers upon the copyright owner, *inter alia*, the exclusive right to reproduce and to sell copies<sup>17</sup> of his works.<sup>18</sup> It defines infringement as the invasion of these

of the statute); *Williams & Wilkins Co. v. United States*, 487 F.2d 1345, 1385-86 (Ct. Cl. 1973), (observing that the alternative of not protecting exclusive rights would be massive public support of the arts), *aff'd*, 420 U.S. 376 (1975).

16. Act of May 31, 1790, ch. 15, 1 Stat. 124 (1790) (providing for the protection of maps, charts, and books); Act of Feb. 3, 1831, ch. 16, 4 Stat. 436 (1831) (adding musical compositions); Act of July 8, 1870, ch. 230, 16 Stat. 198 (1870) (adding dramatic compositions, engravings, cuts, prints, photographs and negatives, paintings, drawings, chromes, statues, and models or designs for works of art); Copyright Act of 1909, ch. 320, 35 Stat. 1075 (1909) (formerly codified as 17 U.S.C. §§ 1-810 (1976)) (protecting "all the writings of an author"); Act of Aug. 24, 1912, ch. 356, 37 Stat. 488 (1912) (formerly codified as 17 U.S.C. §§ 1-810 (1976)) (adding motion pictures); Sound Recording Amendment of 1971, Pub. L. No. 92-140, 85 Stat. 391 (1971) (formerly codified as 17 U.S.C. §§ 1-810 (1976)) (adding sound recordings); Copyright Revision Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified as 17 U.S.C. §§ 101-810 (1982)) (revising the statute by adding pantomimes, choreographic works, and audiovisual works, and by defining protected works as "original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device").

17. The statute provides:

Subject to . . . [certain statutory exclusions], the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; and
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.

17 U.S.C. § 106 (1982).

The statute defines "copies" as "material objects . . . in which a work is fixed by any method now known or later developed, and from which the work can be perceived . . . or otherwise communicated, either directly or with the aid of a machine or device." 17 U.S.C. § 101 (1982).

18. Protected works are described by the statute as follows:

(a) Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression, now or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;

rights<sup>19</sup> and prescribes a potent array of remedies to compensate for copyright infringement.<sup>20</sup> Despite this broad protection against direct infringement,<sup>21</sup> the copyright statute does not expressly render a third party liable for merely facilitating an act of direct infringement.<sup>22</sup> Such an indirect participant is a contributory infringer.<sup>23</sup>

---

(6) motion pictures and other audiovisual works; and

(7) sound recordings.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, or embodied in such work.

17 U.S.C. § 102 (1982).

19. "Anyone who violates any of the exclusive rights of the copyright owner . . . is an infringer of the copyright." 17 U.S.C. § 501(a) (1982); *see, e.g.,* *Fortnightly Corp. v. United Artists T.V., Inc.*, 392 U.S. 390, 394-95 (1968) (no copyright infringement absent performance); *cf. Mazer v. Stein*, 347 U.S. 201, 218 (1954) ("Absent copying there can be no infringement of copyright."); *White-Smith Music Pub. Co. v. Apollo Co.*, 209 U.S. 1, 11 (1908) (copyright protects only the tangible result from copying).

Copyright infringement is characterized as a strict liability tort. Intent to infringe is therefore not a prerequisite to liability for infringement. *See, e.g.,* *F.W. Woolworth Co. v. Contemporary Arts, Inc.*, 344 U.S. 228, 229 (1952) (Court imposing liability, despite the defendant's ignorance of the infringing nature of the statues which it sold); *Buck v. Jewell-LaSalle Realty Co.*, 283 U.S. 191, 198 (1931) (holding that the intent to infringe is unnecessary); *Shapiro, Bernstein & Co. v. Goody*, 248 F.2d 260, 264-65 (2d Cir. 1957) (holding that a strict construction of the copyright statute required finding an unknowing infringer liable); *De Acosta v. Brown*, 146 F.2d 408, 410-11 (2d Cir. 1944) (observing that the statute does not absolve the innocent infringer, but permits a mitigation of damages for such an infringer); *Columbia Broadcasting Sys., Inc. v. Scorpio Music Dist., Inc.*, 569 F. Supp. 47, 48-49 (E.D. Pa. 1983) (holding that intent is not a necessary element of infringement); *see also* 17 U.S.C. § 504(c)(2) (1982) (statutory provision for damages permitting diminution, but not elimination, of damages for an infringer who believed in good faith that his actions were non-infringing).

Strict liability also applies to contributory infringement evolved from the agency doctrine of *respondeat superior*. *See Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304, 307-08 (2d Cir. 1963). For a discussion of the current scope of *respondeat superior* in copyright law *see infra* notes 32-40 and accompanying text. *But see infra* note 34 and accompanying text (indicating apparent departure from such strict liability).

20. The copyright statute makes a copyright infringer subject to injunction, 17 U.S.C. § 502 (1982), to impoundment of any infringing articles in his possession, 17 U.S.C. § 503 (1982), to liability for any actual profits earned through his infringing activity, and actual or statutory damages. 17 U.S.C. § 504 (1982).

21. "Direct infringement" refers to an act which directly violates the terms of the copyright statute. *See supra* notes 17 & 19 and accompanying text. A "direct infringer" is therefore a party whose actions actually violate the express terms of the statute. *But see infra* note 25 and accompanying text (defining contributory infringement).

22. *See supra* note 19 (citing the statutory provision defining infringement). Some commentators have observed that the statutory phrase "to authorize," 17 U.S.C. § 106 (1982), establishes liability for third-party defendants, N. BOORSTYN, *COPYRIGHT LAW* § 10:8 (1981) (citing H.R. REP. NO. 1476, 94th Cong., 2d Sess. 61, 159, *reprinted in* 1976 U.S. CODE CONG. & AD. NEWS 5674, 5775-76); 3 M. NIMMER ON COPYRIGHT § 12.04(A) (rel. 15 June, 1983), but the statute, strictly construed, does not expressly provide for the liability of such parties. The House Report states that Congress intended this phrase to avoid the issue

## CONTRIBUTORY COPYRIGHT INFRINGEMENT

The judicially-created doctrine of contributory copyright infringement renders third parties liable for their indirect participation in acts of copyright infringement.<sup>24</sup> A party who authorizes, facilitates, participates in, or benefits from an act of infringement may be a contributory copyright infringer.<sup>25</sup> Courts have applied this doctrine to a variety of different factual settings.<sup>26</sup> The flexibility of contributory infringement is attributable to its dual sources of origin.

Contributory copyright infringement arose from two distinct legal theories: *respondeat superior*<sup>27</sup> and "joint and several liabil-

---

of contributory infringement. Its example of the meaning of the phrase indicates that Congress may have intended a strict construction for it. See H.R. REP. NO. 1476, 94th Cong., 2d Sess. 61, reprinted in 1976 U.S. CODE CONG. & AD. NEWS 5674; see also H.R. REP. NO. 1476, at 159 (indicating that Congress intended to leave the current law regarding contributory infringement unchanged).

23. Compare *infra* note 25 and accompanying text (discussing contributory infringement) with *supra* note 21 (discussing direct infringement).

24. The doctrine of contributory infringement does not exist on a statutory foundation, rather, it exists based on judicial precedent. See *infra* notes 32-40, 46-69 & 79-98 and accompanying text.

The earliest American case to find a party liable for copyright infringement for merely contributing to copyright infringement, but not for technically violating the provisions of the copyright statute, was *Harper v. Shoppell*, 28 F. 613, 615 (S.D.N.Y. 1886). The *Harper* defendant made and sold a printing plate for a copyrighted newspaper knowing that it would be used to make infringing copies of the paper. The court held that the defendant "sanctioned the appropriation of the plaintiff's copyrighted matter, and occupie[d] the position of a party acting in concert with the . . . [direct infringer] and is responsible with him as a joint tort-feasor." *Id.* It is interesting to observe that the *Harper* court cited a leading contributory patent infringement case as authority for its holding. *Id.* at 615, citing *Wallace v. Holmes*, 29 F. Cas. 74 (D. Conn. 1871) (No. 17,100); see *infra* notes 112-13 and accompanying text. The first reported use of the phrase "contributory infringement" in copyright law was by the Supreme Court in *Scribner v. Straus*, 210 U.S. 352, 355 (1908) (defendant not liable because the evidence was insufficient to establish that he had induced the direct infringement).

25. N. BOORSTYN, COPYRIGHT LAW § 10:8 (1981); see also *Universal City Studios, Inc. v. Sony Corp. of Am.*, 659 F.2d 963 (9th Cir. 1981), *rev'd on other grounds*, 104 S. Ct. 774 (1984) (a party who knowingly "induces, causes, or materially contributes to" an act of infringement is a contributory infringer). See *infra* note 44 and accompanying text (discussing joint and several liability). A party who has a direct financial interest in an infringing activity and is in a position to supervise or control the activity may also be liable as a contributory copyright infringer. See *infra* note 38 and accompanying text (discussing contributory infringement based on the doctrine of *respondeat superior*).

26. See *supra* note 4; see also *infra* notes 33, 37-40, 46-64, 70-77 & 84-99 and accompanying text for examples of the various factual situations in which courts have applied the doctrine.

27. The agency doctrine of *respondeat superior* applies most generally to the master-servant or employer-employee relationship. See E. KITNER & J. LAHR, AN INTELLECTUAL PROPERTY LAW PRIMER 430 (2d ed. 1982). This doctrine imputes the servant's liability to the master if the liability arises from acts performed within the scope of the master-servant relationship. Technically, it

ity."<sup>28</sup> The courts' application of these independent foundations has rendered them nearly indistinguishable.<sup>29</sup> Recently, the courts have spawned a third theory for contributory liability: the staple article of commerce doctrine.<sup>30</sup>

*Contributory Infringement and the Doctrine of Respondeat Superior*

Liability for contributory copyright infringement is often based on the agency doctrine of *respondeat superior*.<sup>31</sup> The central focus of inquiry in this type of case is the relationship between the alleged contributory infringer and the direct infringer and any direct financial interest that the defendant had in the act of infringement.<sup>32</sup> Based on this relationship, courts will find corporate officers and controlling shareholders liable as contributory infringers for corporate acts of infringement.<sup>33</sup> At the very least, a contributory in-

---

applies only within the limits of the master-servant relationship so that a master is not responsible for the acts of the servant which were performed outside the scope of this relationship. See BLACK'S LAW DICTIONARY 1179 (5th ed. 1979). In the copyright setting, however, courts have not so technically restricted this agency doctrine. See *infra* notes 34 & 36-40 and accompanying text.

28. Joint and several liability is a tort doctrine which renders a third party liable for knowingly acting in concert with the prime tortfeasor or by knowingly giving substantial assistance to the tortious activity of the other. See RESTATEMENT (SECOND) OF TORTS § 876 (1977). This doctrine applies to copyright infringement because such infringement is a tort, *Stabilisierungsfonds Fur Wein v. Kaiser Stuhl Wine Dist. Party, Ltd.*, 647 F.2d 200, 207 (D.C. Cir. 1981), and all who knowingly participate in or further tortious activity are jointly and severally liable together with the prime tortfeasor. See, e.g., *Screen Gems-Columbia Music, Inc. v. Mark-Fi Records, Inc.*, 256 F. Supp. 399, 403 (S.D.N.Y. 1966); see also *Gershwin Pub. Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971); *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, 365 n.9 (9th Cir. 1947); *Columbia Broadcasting Sys., Inc. v. Scorpio Music Dist., Inc.*, 569 F. Supp. 47, 48 (E.D. Pa. 1983); *infra* note 44 and accompanying text.

29. The expansion of *respondeat superior* and the failure of many courts to expressly acknowledge doctrinal distinctions between *respondeat superior* and joint and several liability when finding liability for contributory infringement, may be why the distinctions between these separate theories are now obscured. See, e.g., *Universal City Studios, Inc. v. Sony Corp. of Am.*, 480 F. Supp. 429, 457-58 (C.D. Cal. 1979), *rev'd* 659 F.2d 963 (9th Cir. 1981), *rev'd* 104 S. Ct. 774 (1984) (the lines between contributory infringement and vicarious liability are not clearly drawn).

30. See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 104 S. Ct. 774, 787-89 (1984); *Atari, Inc. v. JS&A Group, Inc.*, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,613 (N.D. Ill. Dec. 6, 1983); *Midway Mfg. Co. v. Arctic Int'l, Inc.*, 211 U.S.P.Q. 1152 (N.D. Ill. 1981).

31. See *supra* note 27.

32. See *infra* note 38 and accompanying text.

33. See, e.g., *Bally Midway Mfg. Co. v. American Postage Mach., Inc.*, 1983 COPYRIGHT L. REP. (CCH) ¶ 25,601 (E.D.N.Y. Aug. 25, 1983) (corporate officer and shareholder liable for corporate infringements, despite non-participation); *Milene Music, Inc. v. Gotauco*, 551 F. Supp. 1288, 1295 (D.R.I. 1982) (corporate officers liable despite ignorance of infringements); *Rodgers v. Quests, Inc.*, 213



fringer is liable where he was active in the infringement, aware of it at the time it occurred, or derived direct financial benefit from it.<sup>34</sup> Although, liability for contributory infringement sometimes arises from facts more supportive of traditional *respondeat superior* principles,<sup>35</sup> courts have not strictly limited liability to the technical limits of this agency doctrine.<sup>36</sup>

The "dance hall" cases reshaped *respondeat superior* into its current form in the law of contributory copyright infringement.<sup>37</sup>

---

U.S.P.Q. 212 (N.D. Ohio 1981) (non-participating shareholder liable for radio station's infringements); *Boz Scaggs Music v. KND Corp.*, 491 F. Supp. 908 (D. Conn. 1980) (radio station manager personally liable for station's infringements); *F.E.L. Pub., Ltd. v. National Conf. of Cath. Bishops*, 466 F. Supp. 1034 (N.D. Ill. 1978) (holding church leaders contributorily liable for infringements by local parishes); *Lottie Joplin Thomas Trust v. Crown Pub., Inc.*, 456 F. Supp. 531 (S.D.N.Y.), *aff'd*, 592 F.2d 651 (1977); *Davis v. E.I. DuPont de Nemours & Co.*, 240 F. Supp. 612 (S.D.N.Y. 1965) (holding television program sponsors contributorily liable for ability to supervise and control program content).

34. Two courts observed that a corporate officer may be liable as a contributory infringer if he personally participated in or directly derived financial benefit from the corporation's infringement, if he used the corporation to accomplish the infringement, and/or he was a dominant influence in the corporation. *Varon v. The Santa Fe Reporter, Inc.*, 218 U.S.P.Q. 716, 718 (D.N.M. 1982); *Famous Music Corp. v. Bay State Harness Horse Racing & Breeding Ass'n*, 423 F. Supp. 341, 344 (D. Mass. 1976), *aff'd*, 554 F.2d 1213 (1st Cir. 1977).

Other courts have apparently limited contributory infringement to those situations in which the corporate officer took more than a mere passive role in the infringing activity. *See, e.g., United Feature Synd., Inc. v. Sunrise Mold Co.*, 569 F. Supp. 147, 148 (S.D. Fla. 1983) (corporate officers liable for having "caused and materially contributed to" the corporate infringements); *Lauratex Textile Corp. v. Allton Knitting Mills Inc.*, 519 F. Supp. 730, 733 (S.D.N.Y. 1981) (corporate officer "directly cause[d]" the corporate infringements); *Milene Music, Inc. v. Gotauco*, 551 F. Supp. 1288, 1295 (D.R.I. 1982) (stockholders and officers liable for contributory infringement had knowledge of the infringements); *Samet & Wells, Inc. v. Shalom Toy Co., Inc.*, 429 F. Supp. 895, 903-04 (E.D.N.Y. 1977) (corporate president authorized and supervised infringing activity).

35. *See supra* notes 27 & 33 and accompanying text.

36. *Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304, 307 (2d Cir. 1963); *Varon v. The Santa Fe Reporter, Inc.*, 218 U.S.P.Q. 716, 718 (D.N.M. 1982); *M. Witmark & Sons v. Calloway*, 22 F.2d 412, 414 (E.D. Tenn. 1927); N. BOORSTYN, COPYRIGHT LAW § 10:8 (1981); E. KITNER & J. LAHR, AN INTELLECTUAL PROPERTY LAW PRIMER 430-31 (2d ed. 1982).

37. These cases were so named because the defendants were proprietors of establishments who provided live music for the entertainment of their guests. The performances infringed musical copyrights. *See, e.g., Famous Music Corp. v. Bay State Harness Horse Racing and Breeding Ass'n*, 554 F.2d 1213 (1st Cir. 1977) (horseracing track retained a band which infringed copyrights); *Gershwin Pub. Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159 (2d Cir. 1971) (concert promoter who did not participate in selecting programs); *Dreamland Ball Room, Inc. v. Shapiro, Bernstein & Co.*, 36 F.2d 354 (7th Cir. 1929) (owners of dance halls were liable for infringements by orchestras they hired); *Chess Music, Inc., v. Sipe*, 442 F. Supp. 1184 (D. Minn. 1977) (restaurant owner who hired band explicitly instructing them not to infringe copyrights); *KECA Music, Inc. v. Dingus McGee's Co.*, 432 F. Supp. 72, 74 (W.D. Mo. 1977) (restaurant owner hired a band who infringed copyrights despite explicit instructions by the owners that they should play only "original works"); *MCA, Inc. v. Wilson*, 425 F.

These cases established that where the defendant had the "right or ability to supervise" the infringing activity combined with a "direct financial interest" in the activity, he was a contributory infringer.<sup>38</sup> Liability arises, therefore, despite the fact that the direct infringer was an independent contractor<sup>39</sup> or was acting against the express conditions of his employment.<sup>40</sup>

The reshaping of *respondeat superior* has been compounded by the contemporaneous existence of liability based on joint and several liability. Indeed, some courts have begun discussions of contributory infringement based on *respondeat superior* only to conclude with rhetoric more typical of joint and several liability.<sup>41</sup> This group of cases indicates a cross-semination of the two separate legal doctrines.

### *Contributory Infringement and Joint and Several Liability*

The tort doctrine of joint and several liability is distinct from *respondeat superior* as a foundation for contributory copyright infringement.<sup>42</sup> It focuses on the intentional actions of the defendant

---

Supp. 443 (S.D.N.Y.) (owner of cabaret in which infringement occurred), *aff'd* 677 F.2d 180 (2d Cir. 1976); *M. Witmark & Sons v. Tremont Social & Athletic Club*, 188 F. Supp. 787 (D. Mass. 1960) (bar which retained a band as an independent contractor); *Shapiro, Bernstein & Co. v. Veltin*, 47 F. Supp. 648 (W.D. La. 1942) (club hired a band who infringed despite a signed agreement that they would not do so).

38. *Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304, 307 (2d Cir. 1963); *Fourth Floor Music, Inc. v. Der Place, Inc.*, 572 F. Supp. 41, 43-44 (D. Neb. 1983); see *Gershwin Pub. Corp. v. Columbia Artists Mgmt., Inc.* 443 F.2d 1159, 1162 (2d Cir. 1971); *Rodgers v. Quests, Inc.*, 213 U.S.P.Q. 212, 214 (N.D. Ohio 1981); *Chess Music, Inc. v. Sipe*, 442 F. Supp. 1184, 1185 (D. Minn. 1977) ("Those who profit from copyrighted music are obliged to pay not only the piper but the author."); but see *F.E.L. Pub., Ltd. v. National Conf. of Cath. Bishops*, 466 F. Supp. 1034, 1040 (N.D. Ill. 1978) (holding the defendants liable based on *respondeat superior* despite the lack of a "direct financial interest" in the acts of infringement).

39. See, e.g., *Gershwin Pub. Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971); *Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304, 307 (2d Cir. 1963); *Dreamland Ball Room, Inc. v. Shapiro, Bernstein & Co.*, 36 F.2d 354, 355 (7th Cir. 1929); *M. Witmark & Sons v. Tremont Social & Athletic Club*, 188 F. Supp. 787 (D. Mass. 1960).

40. See, e.g., *Gershwin Pub. Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159 (2d Cir. 1971); *Chess Music, Inc. v. Sipe*, 442 F. Supp. 1184, 1185 (D. Minn. 1977); *KECA Music, Inc. v. Dingus McGee's Co.*, 432 F. Supp. 72, 74 (W.D. Mo. 1977); *Shapiro, Bernstein & Co. v. Veltin*, 47 F. Supp. 648 (W.D. La. 1942).

41. See, e.g., *Gershwin Pub. Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971); *F.E.L. Pub., Ltd. v. National Conf. of Cath. Bishops*, 466 F. Supp. 1034, 1040 (N.D. Ill. 1978); see also, e.g., *Bally Midway Mfg. Co. v. American Postage Mach., Inc.*, 1983 COPYRIGHT L. REP. (CCH) ¶ 25,601 (E.D.N.Y. Aug. 25, 1983) (discussing joint and several liability with respect to an ability to supervise the infringing activity).

42. See *Universal City Studios, Inc. v. American Invsc0 Mgmt., Inc.*, 217 U.S.P.Q. 1076, 1077 (N.D. Ill. 1981) (observing three distinct bases for infringement liability: direct infringement, liability for contribution to the infringe-

which facilitated an act of direct infringement.<sup>43</sup> Under joint and several liability, a third party who knowingly facilitated, caused, authorized, or materially contributed to an act of infringement is a contributory infringer.<sup>44</sup> Unlike a contributory infringer liable under *respondeat superior*, a third party jointly and severally liable must knowingly participate and further the act of direct infringement.<sup>45</sup>

A few contributory copyright infringement cases predicated on joint and several liability illustrate the requirement of knowing participation. The defendant's acts in *Kalem Co. v. Harper Brothers*<sup>46</sup> demonstrate the extreme of knowing participation. The *Kalem* contributory infringers produced a film version of a copy-

ment, and liability arising from a relationship with the direct infringer). Compare *supra* notes 27 & 38-40 and accompanying text (discussing the doctrine of *respondeat superior*) with *supra* note 28 and *infra* notes 44-45 and accompanying text (discussing joint and several liability).

43. See *supra* note 28 and accompanying text; *infra* note 44 and accompanying text.

44. E.g., *Gershwin Pub. Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971) (concert promoter induced infringements at concerts); *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, 365 (9th Cir. 1947) (screen writer contributed to infringing exhibitions of a movie by incorporating infringing material into them); *Encyclopaedia Britannica Educ. Corp. v. Crooks*, 558 F. Supp. 1247, 1256 (W.D.N.Y. 1983) (school board "caused and materially contributed to" school's infringing exhibition of audiovisual works by taping them off the air and distributing them to schools for exhibition); *MCA, Inc. v. Wilson*, 425 F. Supp. 443, 455-56 (S.D.N.Y. 1977) (song writer liable for contributing copyrighted music for an infringing song); *Johnson v. Salomon*, 197 U.S.P.Q. 801, 829-30 (D. Minn. 1977) (salesman liable for causing infringing publication of infringing games and for promoting sales of those games); *Screen Gems-Columbia Music, Inc. v. Mark-Fi Records, Inc.*, 256 F. Supp. 399, 403 (S.D.N.Y. 1966) (agency which advertised and agency who packaged and shipped infringing record albums were potentially liable for participating in or furthering their sale).

45. See *Schuchart & Assoc. v. Solo Serve Corp.*, 1983 COPYRIGHT L. REP. (CCH) ¶ 25,593 (W.D. Tex. June 28, 1983); *Encyclopaedia Britannica Educ. Corp. v. Crooks*, 558 F. Supp. 1247, 1256 (W.D.N.Y. 1983); *Aiken, Hazen Hoffman, Miller, P.C. v. Empire Const. Co.*, 542 F. Supp. 252, 261-62 (D. Neb. 1982); *Universal City Studios, Inc. v. American Invscos Mgmt., Inc.*, 217 U.S.P.Q. 1076, 1077-78 (N.D. Ill. 1981); *Universal City Studios, Inc. v. Sony Corp. of Am.*, 480 F. Supp. 429, 459-60 (C.D. Cal. 1979), *rev'd*, 659 F.2d 963 (9th Cir. 1981), *rev'd*, 104 S. Ct. 774 (1984); *Johnson v. Salomon*, 197 U.S.P.Q. 801, 829 (D. Minn. 1977); *cf.* *Gershwin Pub. Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971) (observing that a party may be held jointly and severally liable based on "vicarious liability," originally derived from *respondeat superior*, despite his lack of knowledge, but later observing that one who knowingly "induces, causes, or materially contributes to" an act of infringement is a "contributory infringer"); *Screen Gems-Columbia Music Corp. v. Mark-Fi Records, Inc.*, 256 F. Supp. 399, 403 (S.D.N.Y. 1966) (similarly observing no necessity for knowledge to establish liability, but stating later that *knowing* participation establishes joint and several liability).

46. 222 U.S. 55 (1911).

righted book and promoted its exhibition.<sup>47</sup> The *Kalem* Court observed that any further participation would necessarily have been direct infringement.<sup>48</sup> The element of knowing and deliberate participation also existed in *Universal Pictures Co. v. Harold Lloyd Corp.*<sup>49</sup> In *Universal Pictures*, a writer knowingly induced the infringing production and exhibition of a film when he deliberately chose material knowing that it was copyrighted.<sup>50</sup> In *Encyclopaedia Britannica Educational Corp. v. Crooks*,<sup>51</sup> a school board and its members taped copyrighted televised works and distributed the copies for infringing classroom exhibition.<sup>52</sup> Similarly, in *Johnson v. Salomon*,<sup>53</sup> the defendant intentionally induced the production and sale of infringing copies of a game and its rule book. The defendant in *Johnson* also misrepresented certain facts to the direct infringers so that the infringing activities would continue.<sup>54</sup> Each of these cases illustrates defendant's deliberate activities which were clearly intended to "facilitate, cause, authorize, or materially contribute to"<sup>55</sup> acts of direct infringement.<sup>56</sup> Not all "knowing" participation, however, is so active and deliberate.

Other cases demonstrate that a contributory infringer need not have specifically intended for his actions to further the infringement. The defendant who knew or should have known of the infringing nature of the activity will be liable as a contributory

---

47. *Id.* at 60. Producing the movie version of the book was not direct infringement because it did not violate the express terms of the copyright statute. Exhibition of the movie, however, was an act of infringement. *Id.* at 61.

48. "If the defendant did not contribute to the infringement, it is impossible to do so except by taking part in the final act. It is liable on principles recognized in every part of the law." *Id.* at 63. The Court found that the defendant "not only expected but invoked" the direct infringement. *Id.* This case is of particular interest because of the Court's observations regarding contributory infringement by providing the means. See *infra* notes 79-83 and accompanying text.

49. 162 F.2d 354 (9th Cir. 1947).

50. *Id.* at 365. The court observed that the writer acted on his own; he was not directed by his employer to appropriate the infringing material. *Id.* at 366 (emphasizing the deliberateness of the defendant writer's actions).

51. 558 F. Supp. 1247 (W.D.N.Y. 1983).

52. *Id.* at 1256.

53. 197 U.S.P.Q. 801 (D. Minn. 1977).

54. The defendant led the direct infringers to believe that a license to produce the games and rules books was still valid. *Id.* at 815, 829-30.

55. See *supra* note 44 and accompanying text.

56. In *Electra Records Co. v. Gem Electronic Dist., Inc.*, 360 F. Supp. 821 (E.D.N.Y. 1973), the court considered similar facts when granting the plaintiff's prayer for a preliminary injunction. The *Electra Records* defendants operated a record store at which they sold blank cassette tapes, loaned original copies of copyrighted recordings, and maintained a machine upon which customers could make infringing copies for a small fee. *Id.* at 822-23. This court observed that the defendants' activities were commercial exploitation prohibited by the copyright statute. *Id.* This court did not otherwise engage in the traditional contributory infringement analysis.

infringer.<sup>57</sup> The contributions of the defendants in *Screen Gems-Columbia Music, Inc. v. Mark-Fi Records, Inc.*<sup>58</sup> were not so clearly deliberate. The defendant advertising agency promoted sales and the defendant mail order agency filled orders for infringing sound recordings.<sup>59</sup> Despite the defendants' lack of actual knowledge of infringing nature of these recordings, the court imputed knowledge of the direct infringements to the defendants.<sup>60</sup> The infringer in *Gershwin Publishing Corp. v. Columbia Artists Management, Inc.*<sup>61</sup> promoted concerts at which infringing material was played.<sup>62</sup> The court imputed knowledge based on the defendants' preparation of the concert programs prior to the performances.<sup>63</sup> Therefore, a party who facilitates copyright infringement is a contributory infringer where a reasonable basis exists for imputing knowledge of the direct infringement.<sup>64</sup>

A defendant who does not know and has no reasonable basis to know that his actions facilitate acts of infringement, on the other hand, is not a contributory infringer. In *Schuchart & Associates v.*

---

57. See, e.g., *Screen Gems-Columbia Music, Inc. v. Mark-Fi Records, Inc.*, 256 F. Supp. 399, 403 (S.D.N.Y. 1966) ("each defendant was aware or should have been aware"); *Gershwin Pub. Corp. v. Columbia Artists Mgmt., Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971) (citing *Screen Gems* with approval). That the defendant "knew or should have known" is a prerequisite to joint and several liability. See RESTATEMENT (SECOND) OF TORTS § 877 (1977). Observe that this is different from strict liability which would not examine evidence of knowledge or a reasonable basis for knowledge. See *supra* note 19. This element of knowledge is also important to the patent law staple article of commerce doctrine. See *infra* note 119 and accompanying text.

58. 256 F. Supp. 399 (S.D.N.Y. 1966).

59. *Id.* at 401-02.

60. The court held that each of these defendants knew or should have known of the infringing nature of the record sales by mail order. *Id.* at 403. The court observed that the advertising agency had sufficient business expertise in the music industry to have realized that the records sold were infringing copies. They sold for an unusually low price, and the "smallness, lack of permanent location, and financial unreliability" of the direct infringer should have alerted this defendant. *Id.* at 404. The court denied the defendants' motion for summary judgement. *Id.* at 405 (also denying the motion of the mail order shipping agent because it found that a similar issue of fact remained as to the knowledge of that defendant).

61. 443 F.2d 1159 (2d Cir. 1971). A part of this court's analysis considered contributory infringement based on *respondeat superior*, but it based its holding at least in part on joint and several liability. See *Id.* at 1162-63.

62. *Id.* at 1162. Another division of the defendant managed and booked the bands for the performances at which the infringements occurred. *Id.* at 1160. The court found that separate division vicariously liable. *Id.* at 1162-63. Despite the separate analysis given to the issue of contributory liability for this separate division and the fact that liability lay on a separate basis, it is impossible to determine whether the outcomes of the two issues were wholly independent.

63. *Id.* at 1161.

64. The Supreme Court recently held that constructive knowledge is insufficient to establish liability for contributory infringement. See *infra* notes 70-72 and accompanying text. This holding conflicts with prior case law. See *supra* note 57 and accompanying text.

*Solo Serve Corp.*,<sup>65</sup> the court noted that a defendant who provides a copyrighted work to another who makes infringing copies of it is not a contributory infringer if he does so innocent of any knowledge of the other parties' intended illegitimate use.<sup>66</sup> In *Aiken, Hazen, Hoffman, Miller, P.C. v. Empire Construction Co.*,<sup>67</sup> the court also observed that the defendants' ignorance of the infringing act would have precluded liability for contributory infringement.<sup>68</sup> The defendants in these cases had no reason to believe their contributions would result in copyright infringement.<sup>69</sup> Liability for contributory copyright infringement, therefore, requires at least some reasonable basis from which the court might impute knowledge to the defendant of his facilitation of copyright infringement.

In a recent case, *Sony Corp. of America v. Universal City Studios, Inc.*,<sup>70</sup> the United States Supreme Court held that "constructive knowledge"<sup>71</sup> was insufficient to hold a defendant liable for contributory copyright infringement.<sup>72</sup> The *Sony* Court observed

---

65. 1983 COPYRIGHT L. REP. (CCH) ¶ 25,593 (W.D. Tex. June 28, 1983).

66. *Id.* (citing 1 M. NIMMER ON COPYRIGHT § 12.11(A) (1983) with approval). The *Schuchart* defendants had no knowledge of the copyright infringements until the copyright owner filed the action alleging contributory infringement. *Id.* They provided original copies of copyrighted designs and specifications to an architectural firm which copied them. They legitimately transferred the originals to act as a "guideset" for a building project. *Id.*

67. 542 F. Supp. 252 (D. Neb. 1982).

68. *Id.* at 262. The defendant provided infringing copies of copyrighted architects' drawings and specifications to a professional engineer for certification. The court held that this activity had nothing to do with subsequent infringement of those drawings. *Id.* Nevertheless, the court fully analyzed the contributory infringement issue. *Id.* at 261-62 (separately considering "contributory infringement"—*i.e.*, joint and several liability—and "vicarious liability"—*i.e.*, liability derived from *respondet superior*).

69. See *Schuchart*, 1983 COPYRIGHT L. REP. at ¶ 25,593; *Aiken*, 542 F. Supp. at 262.

70. 104 S. Ct. 774 (1984).

71. Where the defendant could have known a fact by the exercise of reasonable diligence, he is deemed to have known it as a matter of law. BLACK'S LAW DICTIONARY 284 (5th ed. 1979).

72. *Sony*, 104 S. Ct. at 787. It is difficult to determine what constitutes the type of reasonable basis for knowledge for which the *Sony* Court would impose liability. It is possible that the prospective lawful uses for the *Sony* video cassette recorder were so significant in relation to any foreseeable infringing uses that such illegitimate use, although probable, would not have been intended by the defendants. See *Sony*, 104 S. Ct. at 786 (observing that the video recorder involved in *Sony* was capable of lawful uses, whereas the movie in *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911), was capable only of infringing use). Note, however, the foreseeability of infringing use of the recorder constitutes a reasonable basis for imputing knowledge to the defendant of such infringing use. See *supra* notes 57-64 and accompanying text. A lack of intent to facilitate copyright infringement does not constitute a lack of knowledge, constructive or actual, that purchasers of a copying device will likely use it to infringe copyrighted works. A lack of intent is immaterial in determining culpability for contributory copyright infringement, see *supra* note 19, but a lack of any basis for imputed knowledge is decisive. See *supra* notes 65-69 and accompanying text.

that the closest analogy to contributory liability based on constructive knowledge was contributory patent infringement.<sup>73</sup> It observed that contributory patent infringement includes the staple article of commerce doctrine<sup>74</sup> which precludes liability where the article sold was "suitable for substantial noninfringing use."<sup>75</sup> The *Sony* Court held that the staple article of commerce doctrine must "balance the interests," of the copyright owner in his works against those of the defendant in the sale of goods and, impliedly, against those of the public at large.<sup>76</sup> In so holding, the *Sony* Court transcended the traditional analysis for contributory copyright infringement,<sup>77</sup> and incorporated the staple article of commerce doctrine. This incorporation has begun to have an impact on the law of contributory copyright infringement.<sup>78</sup>

### *Contributory Infringement By Providing The Means*

In *Kalem Co. v. Harper Brothers*,<sup>79</sup> the defendant distributed a film based on a copyrighted novel.<sup>80</sup> Liability rested on the defendant's knowing, intentional acts which brought about copyright infringement.<sup>81</sup> The Court also considered the nature of the article

---

73. *Sony*, 104 S. Ct. at 788. *But see infra* notes 109, 119 & 134-37 and accompanying text (discussing contributory patent infringement and the requirement of "knowledge").

74. *See supra* note 7; *infra* notes 135-37.

75. *Sony*, 104 S. Ct. at 788.

76. *Id.* at 789.

77. Such traditional analysis was twofold. The court could determine that the defendant had the right or ability to control or supervise the infringing activity combined with a direct financial interest in it. *See supra* note 38 and accompanying text (discussing liability derived from *respondeat superior*). The central focus of this inquiry is the relationship of the defendant with the direct infringer and with the unlawful profit from the infringement. *See supra* note 32 and accompanying text. The court could otherwise determine that the defendant had knowingly caused, induced, authorized, or otherwise materially contributed to the direct infringement. *See supra* notes 44 & 45 and accompanying text (discussing liability based on joint and several liability). The emphasis of this approach is the knowledge and actions of the defendant which contributed to the direct infringement. *See supra* note 43 and accompanying text. The staple article of commerce doctrine focuses on the nature of the means of infringement provided by the defendant. *See infra* notes 120 & 133-37 and accompanying text.

78. *See RCA Records, Inc. v. All-Fast Systems, Inc.*, No. 84 Civ. 631-CSH (S.D.N.Y. Sept. 10, 1984) (distinguishing *Sony*) (slip opinion).

79. 222 U.S. 55 (1911).

80. *See supra* notes 46-48 and accompanying text (discussion of the *Kalem* case).

81. *See supra* notes 47 & 48 and accompanying text. This is the traditional basis for contributory infringement evolved from joint and several liability. *See supra* notes 43 & 44 and accompanying text. The focus and tenor of the Court's analysis exhibits this, despite dicta regarding "ordinary articles of commerce." *See infra* note 82. The *Kalem* Court further illustrated that the intent of the sale was the material factor involved. It observed that constructive knowledge, *see supra* note 71, that a buyer may use the commodity for illegal purposes was

sold important only to the extent that it could imply the intent of its sale.<sup>82</sup> Therefore, it was not solely on the basis of the nature of the article sold that the Court held the defendant liable.<sup>83</sup>

Other courts have also considered the nature of the article sold as a factor in determining the defendant's intent. The *Midway Manufacturing Co. v. Strohon*<sup>84</sup> court held that the seller of a video game modification kit was not a contributory infringer. This court concluded that mere anticipation that purchasers would use it to infringe copyrights was insufficient to demonstrate intent.<sup>85</sup> Such misuse was not the "most conspicuous use" for the kit or the use "intended, expected, encouraged, and . . . the source of the product's consumer appeal."<sup>86</sup> The court did not hold the seller responsible for the misuse of the kit without such actual knowledge of the purchaser's infringing use.<sup>87</sup>

Similarly, the court in *Original Appalachian Artworks, Inc. v. Cradle Creations, Inc.*,<sup>88</sup> compared the defendant's intent with the nature of the article sold. The *Original Appalachian Artworks* defendants sold a pattern book for making copies of a copyrighted doll. The court granted a preliminary injunction against the sale of the book because its nature made the defendants aware that purchasers would use it to infringe copyrights.<sup>89</sup> The focus of the *Original Appalachian Artworks*, *Kalem*, and the *Midway Manufacturing* courts remained on the intent or knowledge of the

---

insufficient to make the seller liable. *See supra* note 72. It further noted, however, that sale with the intent that the buyer use it illegally would make the seller liable. *Kalem*, 222 U.S. at 62 [citations omitted] (using the illustration of illegal liquor sales).

82. The Court found that the "most conspicuous purpose" for the sale of the *Kalem* film was infringing exhibition. *Kalem*, 222 U.S. at 62-63. It further observed, however, that "where an ordinary article of commerce is sold nice questions arise as to the point at which the seller becomes an accomplice in subsequent illegal use by the buyer." *Id.* at 62. Such an examination of the nature of the articles sold is not unusual where courts choose to draw an inference of culpable intent from its sale. *See generally* *Direct Sales Co. v. United States*, 319 U.S. 703, 710-12 (1943) (sale of narcotics by a drug distributor); *infra* note 120 (discussing the original focus of the staple article inquiry in patent law).

83. The primary focus of this analysis was that for determining joint and several liability. *See supra* notes 43-45 and accompanying text (discussing joint and several liability). The focus which considers the nature of the article sold by the defendant is the staple article of commerce doctrine. *See supra* notes 7 & 73-75 and accompanying text; *infra* notes 91-101 and accompanying text (discussing the staple article of commerce doctrine in copyright law).

84. 564 F. Supp. 741 (N.D. Ill. 1983).

85. *Id.* at 748. The court observed the dearth of evidence to indicate what purchasers would do with the modification kit when they bought it. *Id.*

86. *Id.* (quoting *Universal City Studios, Inc. v. Sony Corp. of Am.*, 659 F.2d 963, 975 (9th Cir. 1981), *rev'd*, 104 S. Ct. 774 (1984)).

87. *Id.* [citation omitted].

88. 1982 COPYRIGHT L. REP. (CCH) ¶ 25,387 (N.D. Ga. Jan. 27, 1982).

89. *Id.*



defendants. This is consistent with the traditional contributory infringement analysis.<sup>90</sup> The case law, however, includes limited examples of a departure from the traditional analysis.

Two pre-*Sony* cases focused on the nature of the article sold as a primary means of determining liability for contributory infringement, but departed from the traditional analysis. In *Midway Manufacturing Co. v. Arctic International, Inc.*,<sup>91</sup> the court held that copyright law would not permit the defendant to "reap the benefits of plaintiff's artistic endeavor"<sup>92</sup> by selling a video game conversion kit. The court found that the defendant would effectively misappropriate some value from the plaintiff's copyrights if the device's value was exclusively derived from the plaintiff's games. The court also held, however, that if the device was useful on all video games, then the modification kit would have its own inherent independent value and its sale would be permissible.<sup>93</sup> Had the *Arctic International* court employed this reasoning, it would not have based a final decision on the intent or knowledge of the defendant; rather, it would have extended or denied liability solely on the basis of the nature of the article provided.<sup>94</sup> This approach is inconsistent with the traditional contributory copyright infringement analysis.<sup>95</sup>

In another case, the *Atari, Inc. v. JS&A Group, Inc.*,<sup>96</sup> defendants sold a device for copying video game cartridges. The court found that while the device was capable of some uses that did not involve the copying of the plaintiff's games these uses were minor. In granting a preliminary injunction against its sale,<sup>97</sup> the court held that the defendant's device for copying video game cartridges

---

90. See *supra* notes 31-40 & 42-69 and accompanying text (discussing contributory copyright infringement evolved from *respondeat superior* and joint and several liability, respectively).

91. 211 U.S.P.Q. 1152 (N.D. Ill. 1981).

92. *Id.* at 1159-60. This court was protecting the copyright owner's exclusive right to capitalize on his works. See *supra* notes 11-19 and accompanying text (discussing the copyright owner's interest in his works).

93. *Arctic Int'l*, 211 U.S.P.Q. at 1159-60. This inquiry was similar to the staple article of commerce inquiry—examining whether significant noninfringing uses exist for the article. See *supra* notes 70-76 and accompanying text (discussing the *Sony* decision); *infra* notes 96-98 and accompanying text (discussing the *Atari* decision); *infra* notes 132-38 and accompanying text (discussing the staple article of commerce doctrine as codified in patent law).

94. The court's emphasis on the potential appropriation of the value of the defendant's copyrights indicates that the court would have balanced the interests of the plaintiff, the defendant, and the public in reaching a final decision. See *supra* note 76; *infra* notes 183-90 and accompanying text. Whether the modification device was useable on other games or not would have had no effect on its impact to the value of the plaintiff's copyrights. Use on other games would have meant appropriation of their value also; it would not necessarily have rendered the device a "staple article." See *supra* note 120.

95. See *supra* note 77 and accompanying text.

96. 1984 COPYRIGHT L. REP. (CCH) ¶ 25,613 (N.D. Ill. Dec. 6, 1983).

97. *Id.*

must be capable of "substantial noninfringing use" to preclude injunctive relief against its sale.<sup>98</sup> As it did in the *Arctic International* case,<sup>99</sup> the court in *Atari* abandoned the traditional contributory infringement analysis.

The common factor in *Atari*, *Arctic International*, and *Sony* was the recognition of a potential public interest in noninfringing use of the means of infringement provided by the defendants.<sup>100</sup> The courts focused primarily on the nature of the article sold rather than on any relationship between the defendants and an act of direct infringement.<sup>101</sup> This analysis is analogous to that employed in patent law under similar circumstances. It also includes the staple article of commerce doctrine which precludes liability where the defendant sold an article capable of significant noninfringing uses.<sup>102</sup>

---

98. *Id.* This inquiry is central to the staple article of commerce doctrine as employed in patent law. See *infra* notes 134-37. This is the approach subsequently adopted by the Supreme Court in *Sony Corp. of Am. v. Universal City Studios, Inc.*, 104 S. Ct. 774 (1984). See *supra* notes 70-76 and accompanying text.

99. See *supra* notes 91-94 and accompanying text.

100. See *Sony*, 104 S. Ct. at 788-89; *Atari*, 1984 COPYRIGHT L. REP. at ¶ 25,613 (finding that customers would not buy the article for its lawful uses, the court found that the public interest is best served by restraining its sale); *Arctic Int'l*, 211 U.S.P.Q. at 1160 (the article may be capable of use in connection with a number of video games). See *infra* notes 127-30 & 132-38 and accompanying text (discussing the public interest involved in patent law and the staple article of commerce doctrine, respectively).

101. The *Sony* Court first concluded that the defendants were not contributory infringers under the traditional analysis in that they lacked the requisite knowledge or ability to control the infringing activity, and then observed that the only way the defendants could be liable for contributory infringement would be under that doctrine as employed in patent law. See *Sony*, 104 S. Ct. at 788. The *Atari* court considered the nature of the article sold, despite the conceded nature of its sale. See *Atari*, 1984 COPYRIGHT L. REP. at ¶ 25,613. The *Arctic Int'l* court would have examined the nature of the article to determine whether the defendants primarily intended it for copying the plaintiff's copyrighted games. See *Arctic Int'l*, 211 U.S.P.Q. at 1159-60. The difference between the use of the staple article of commerce doctrine in *Sony* and its use in the other two cases is subtle, but important. The *Sony* Court's finding that liability could not arise under the traditional analysis should have ended its inquiry. The Court, however, considered the significance of any noninfringing uses for the video recorder involved. See *supra* note 71-76 and accompanying text. The *Sony* Court would therefore have extended liability beyond the traditional bounds of contributory copyright infringement if it had found the article involved incapable of substantial noninfringing uses. The *Arctic Int'l* and *Atari* courts would have limited liability for contributory infringement by using the staple article test. See *supra* notes 91-94 & 96-98 and accompanying text (discussing the *Arctic Int'l* and *Atari* decisions, respectively). The latter approach is more typical of the staple article of commerce doctrine of patent law. See *infra* notes 134-38 and accompanying text (discussing the staple article of commerce doctrine in patent law).

102. See *infra* notes 120 & 136 and accompanying text.

CONTRIBUTORY PATENT INFRINGEMENT AND THE STAPLE ARTICLE  
OF COMMERCE DOCTRINE

Patent law<sup>103</sup> and copyright law<sup>104</sup> both exist on the same constitutional basis.<sup>105</sup> Violation of the patent owner's exclusive rights<sup>106</sup> constitutes a patent infringement.<sup>107</sup> The prohibition against contributory patent infringement, unlike contributory copyright infringement,<sup>108</sup> is found in the patent statute.<sup>109</sup> Contributory patent infringement also includes considerations alien to copyright law;<sup>110</sup> however, it was once a judicially-created doctrine

103. 35 U.S.C. §§ 100-376 (1982).

104. 17 U.S.C. §§ 101-810 (1982).

105. See *supra* note 11 (U.S. CONST. art. I, § 8, cl. 8).

See, e.g., *Sony Corp. of Am. v. Universal City Studios, Inc.*, 104 U.S. 774, 787 (1984) (close kinship); *Fox Film Corp. v. Doyal*, 286 U.S. 123, 131 (1932); *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 656-57 (1834) (common origin). The Supreme Court, however, has noted significant differences between the two and stated that precedent in one area does not necessarily apply to the other. See, e.g., *Mazer v. Stein*, 347 U.S. 201, 217-18 (1954); *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 345-46 (1908).

106. "Every patent shall . . . grant to the patentee . . . the right to exclude others from making, using, or selling the invention throughout the United States . . ." 35 U.S.C. § 154 (1982).

107. The patent statute provides:

(a) [W]hoever without authority makes, uses or sells any patented invention . . . infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and *not a staple article or commodity of commerce suitable for substantial noninfringing use*, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed misuse or illegal extension of the patent right by . . . [exercising or enforcing exclusive rights over a nonstaple, nonpatented article described in subsection (c) above].

35 U.S.C. § 271 (1982) [emphasis added].

108. See *supra* notes 1, 22, 24 & 25 (discussing contributory copyright infringement).

109. 35 U.S.C. § 271(c) (1982).

110. Patent protection can exist in an article, in an assemblage of non-patented articles, or in a method for using non-patented articles. See 35 U.S.C. § 271(a) (1982). Contributory patent infringement includes the sale of non-patented articles where such use infringes the patent which comprises them. See 35 U.S.C. § 271(c) (1982); see also *infra* note 120 (discussing the staple-nonstaple article distinction). The doctrine of patent misuse counterbalances contributory patent infringement. The staple article of commerce doctrine is the statutory center of balance. See 35 U.S.C. § 271(c) & (d) (1982).

Contributory copyright infringement does not involve the provision of component articles of the copyright; it involves facilitation of infringement in other ways. The issue of copyright misuse has only arisen in the context of tying the licensing of copyrighted works to the licensing of other works. See *United*

similar to contributory copyright infringement.<sup>111</sup>

In an early contributory patent infringement case, the court in *Wallace v. Holmes*,<sup>112</sup> recognized that effective enforcement of patent rights required relief against a person who merely facilitated another's act of infringement.<sup>113</sup> Where the case involves a combination patent<sup>114</sup> or a process patent,<sup>115</sup> the only practicable remedy available to protect the interests of the patent owner is an action against the seller of the nonpatented material components of his invention.<sup>116</sup> Contributory patent infringement evolved from such situations where the defendant sold a material part of a combina-

---

States v. Loew's, Inc., 371 U.S. 38, 45-48 (1962) (anti-trust case); *United States v. Paramount Pictures, Inc.*, 334 U.S. 131 (1948) (anti-trust case). The issue of misuse has possibly not arisen in the same way in copyright law because copyright owners do not have the same power as patentees to include non-protected articles within the scope of their exclusive rights. Where the issue is contributory copyright infringement for providing the means, however, it is possible that a copyright owner could extend his exclusive rights so far as to control the availability of an article not included in the copyright grant. See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 104 S. Ct. 774, 778-89 (1984). Nevertheless, in the patent setting, the article over which the patent owner has effective control constitutes at least an essential component of the patented invention. See 35 U.S.C. § 271(c) (1982). This is impossible for copyrights which do not include the physical object embodying the concept, but only include its particular form of expression. See *Mazer v. Stein*, 347 U.S. 201, 217-18 (1954).

111. See *infra* notes 113-19 and accompanying text.

112. 29 F. Cas. 74 (C.C. Conn. 1871) (No. 17,100); see Oddi, *Contributory Infringement/Patent Misuse: Metaphysics and Metamorphosis*, 44 U. PITT. L. REV. 73, 76 (1982).

113. *Wallace*, 29 F. Cas. at 80 (the patent owner would otherwise be "driven to the task of searching out the individual purchasers"—*i.e.*, they would be "helpless and remediless"); see *infra* note 116 and accompanying text. The *Wallace* defendant owned the patent for an oil burning lamp assembly—none of the parts of which were patented. The defendant sold the innovative base which purchasers could combine with a readily available glass chimney to complete an infringing lantern. *Wallace*, 29 F. Cas. at 79-80.

114. A combination patent is an assemblage of non-patented components which, taken as a whole, is protected under patent law. See, *e.g.*, *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 521 (1972) (none of the components of a shrimp deveining machine were patentable individually); *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 344 (1961) (patented convertible top protected as a whole, but not its cloth component); *Bliss & Laughlin Ind., Inc. v. Bil-Jax, Inc.*, 356 F. Supp. 577, 580 (N.D. Ohio 1972) (components of scaffolding not protected, but assembled whole was); *Watsco, Inc. v. Henry Valve Co.*, 232 F. Supp. 38, 43 (S.D.N.Y. 1964) (self-tapping valve not protected without removable tool).

115. See, *e.g.*, *Dawson Chem. Co. v. Rohm & Haas Co.*, 448 U.S. 176, 181-82 (1980) (non-patented chemical for use in a patented process as a pesticide); *B.B. Chem. Co. v. Ellis*, 314 U.S. 495, 496-97 (1942) (non-patented compound for use in a patented cold bonding process).

116. *E.g.*, *Dawson Chem. Co. v. Rohm & Haas Co.*, 448 U.S. 176, 197-98 (1980); *Wallace*, 29 F. Cas. at 80; See, *e.g.*, *Mercoide Corp. v. Mid-Continent Investment Co.*, 320 U.S. 661, 666-67 (1944) (denial of protection against the sale of a non-patented, nonstaple article for use in a patented combination—at the zenith of the doctrine of patent misuse); see also *infra* notes 125-31 and accompanying text (discussing the doctrine of patent misuse).

tion or process patent for infringing completion by the purchaser.<sup>117</sup> Contributory patent infringement was similar to contributory copyright infringement;<sup>118</sup> it was the knowing facilitation of an act of direct infringement.<sup>119</sup>

The scope of contributory patent infringement increased, however, until it precluded the sale of staple articles<sup>120</sup> to patent licensees in *Henry Co. v. A.B. Dick Co.*<sup>121</sup> This decision gave birth to widespread efforts by patentees to control the markets for non-pat-

117. See, e.g., *Thomson-Houston Elec. Co. v. Ohio Brass Co.*, 80 F. 712, 720 (6th Cir. 1897) (sale of unpatented, nonstaple switch and trolley for use in a patented electric streetcar); *Wallace*, 29 F. Cas. at 79-80 (sale of non-patented, non-staple burner for assembly into a patented combination lantern); Roberts, *Contributory Infringement of Patent Rights*, 12 HARV. L. REV. 35, 38-40 (1898).

118. See *supra* notes 43-45 and accompanying text.

119. This has remained the basic definition of contributory patent infringement. See, e.g., *Aro Mfg. Co. v. Convertible Top Replacements Co.*, 377 U.S. 476, 488 (1964) (requires sale of article knowing that it is especially for use in conjunction with a patented combination); *Fuller Co. v. Metal Arts Co.*, 276 F. Supp. 605, 610 (S.D. Tex. 1966) (defendant had actual knowledge of patent and of infringements); *Freedman v. Friedman*, 142 F. Supp. 426, 429 (D. Md. 1956); ("knowing" means actual knowledge, not constructive knowledge); 35 U.S.C. § 271(c) (1982); but see *supra* note 71 (defining constructive knowledge). This is similar to contributory copyright infringement based on joint and several liability. See *supra* notes 43-45 and accompanying text. Observe, however, that the staple article of commerce doctrine operates to exclude some forms of knowing facilitation from contributory infringement. See *infra* notes 134-37 and accompanying text.

120. A staple article is a non-patented article for use in conjunction with a patented machine, process, or combination which is not an integral part of the machine, process, or combination. See *Heaton-Peninsular Button Fastner Co. v. Eureka Speciality Co.*, 77 F. 288, 289 (6th Cir. 1896). The staple-nonstaple distinction focuses on the potential range of uses for an object. The traditional staple article of commerce inquiry in patent law begins by determining the knowledge or intent of the defendant. It then examines the nature of the article sold to determine two qualities of the article. The first determination is whether the article is incapable of non-infringing use. The second is whether the article embodies the essence of the patented invention's advance over prior art. See Oddi, *Contributory Infringement/Patent Misuse: Metaphysics and Metamorphosis*, 44 U. PITT. L. REV. 73, 84-88 (1982). The original purpose for judicial examination of the staple-nonstaple character of an article was to determine whether the seller had notice of the fact that it would be used to infringe a patent. *Id.* at 88-89; see, e.g., *Wallace v. Holmes*, 29 F. Cas. 74, 79-80 (C.C. Conn. 1871) (No. 17,100). This is similar to the focus of contributory copyright infringement derived from joint and several liability. See *supra* notes 43, 44 & 79-90 and accompanying text.

121. 224 U.S. 1 (1912). The *A.B. Dick* patentee licensed the use of its patented mimeograph machine to use only in conjunction with supplies which it sold. The defendant sold ink not included in the patent grant to one of the licensees for use with the machine. *Id.* at 11-12. The Court reasoned that the patentee has the right to either license the use of the patent or to withhold its use from all. *Id.* at 17-18. It therefore concluded that the patentee had the right to expressly limit the use to whatever scope it desired because ownership of the machine and the right to use it were severable. *Id.* at 19, 24-25. The Court held that the sale of supplies to an owner of a patented device subject to an express license limitation, in violation of that license, constituted contributory patent infringement. *Id.* at 31-35.

ented, staple articles by restrictively licensing their patented inventions.<sup>122</sup> Because patent rights, unlike copyrights, include the exclusive right to use the invention,<sup>123</sup> contributory patent infringement included supplying staple articles to patent licensees for use in conjunction with patented inventions.<sup>124</sup>

The patent owners' abusive use of restrictive licenses<sup>125</sup> gave rise to the contravening doctrine of "patent misuse."<sup>126</sup> This doctrine limited contributory infringement and was predicated on an aversion to an expanded patent monopoly.<sup>127</sup> It began when the Supreme Court limited the practice of restrictive licensing by patentees and, consequently, the doctrine of contributory infringement, through its decision in *Motion Picture Patents Co. v. Universal Film Mfg. Co.*<sup>128</sup> This decision excluded the unlicensed

122. *Dawson Chem. Co. v. Rohm & Haas Co.*, 448 U.S. 176, 191 (1980) (observing the impact of the *A.B. Dick* decision); Oddi, *Contributory Infringement/Patent Misuse: Metaphysics and Metamorphosis*, 44 U. PITT. L. REV. 73, 77 (1982); see, e.g., *Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co.*, 77 F. 288, 296-97 (6th Cir. 1896) (the monopoly over the non-patented staple is an incident of the patent grant and anyone inducing a breach of the patent license by sale of such articles is a contributory infringer); but see *Cortelyou v. Charles Eneu Johnson & Co.*, 207 U.S. 196, 199-201 (1907) (facts similar to those of *A.B. Dick*, but without actual knowledge that sale of ink violated a patent license—no liability).

123. Compare 35 U.S.C. § 154 (1982) with 17 U.S.C. § 106 (1982).

124. See *Henry v. A.B. Dick Co.*, 224 U.S. 1, 11-12 (1912) (sale of non-patented, staple ink to licensee of patented mimeograph machine, knowing that the licensee would breach the restrictive license and thereby infringe the patent); *Cortelyou v. Charles Eneu Johnson & Co.*, 207 U.S. 196, 199-200 (1907) (sale of ink); *Rupp & Wittgenfeld Co. v. Elliott*, 131 F. 730 (6th Cir. 1904) (sale of non-patented, nonstaple wire for use in violation of restrictive license); Oddi, *Contributory Infringement/Patent Misuse: Metaphysics and Metamorphosis*, 44 U. PITT. L. REV. 73, 77 (1982).

125. Under a restrictive covenant, the patent owner would sell its patented machine with the express condition that the buyer could use it only with supplies provided by the patentee. The patent owner would attempt to profit from the sale of those supplies in this way. See, e.g., *Carbice Corp. v. American Patents Dev. Corp.*, 283 U.S. 27, 29-30 (1931) (manufacturer of dry ice who owned the patent to a cold-pack container did not license or manufacturer container, but attempted to restrict its use to its own non-patented, staple dry ice); *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 506 (1917) (owner of patent for motion picture projector attempted to restrict its use to use only with its own non-patented films).

126. Oddi, *Contributory Infringement/Patent Misuse: Metaphysics and Metamorphosis*, 44 U. PITT. L. REV. 73, 77-79 (1982). The Supreme Court named this doctrine patent misuse in *Morton Salt Co. v. G.S. Suppiger Co.*, 314 U.S. 488, 493 (1942), and pronounced its equitable nature. *Id.* at 491-92.

127. See *Morton Salt Co. v. G.S. Suppiger Co.*, 314 U.S. 488, 492 (1942); *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 505, 514-17 (1917).

128. 243 U.S. 502 (1917). The *Motion Picture Patents* plaintiff manufactured and sold a motion picture projector under an express license for use only in conjunction with non-patented films which the plaintiff-licensor sold. *Id.* at 506-07. The defendant sold films to owners of the machine. *Id.* at 507-08. The Court reasoned that patent law protects the patentee's exclusive rights solely for the public benefit—not to provide for private fortunes. *Id.* at 510-11. The Court held that if the patent owner has any right to restrict the use of its pat-

provision of staple articles to patent licensees from the doctrine of contributory infringement.<sup>129</sup>

Subsequent to the *Motion Picture Patents* decision, the doctrine of patent misuse expanded, further limiting the doctrine of contributory patent infringement, until the "*Mercoïd*" cases.<sup>130</sup> In those cases, the Supreme Court held that the patent owner could not limit the availability of non-patented, nonstaple articles which had no other use than to infringe his patent rights.<sup>131</sup>

As a result of the demise of contributory infringement, Congress codified a test to balance patent misuse and contributory infringement.<sup>132</sup> The patent statute balances both to define the limits of each.<sup>133</sup> Under the statute, contributory patent infringement re-

---

ent, then it derives from the general law and not from patent law. *Id.* at 513. It found the patent owner's attempt to control non-patented, staple articles through the patent license oppressive and unlawful. *Id.* at 517-18 (observing that Congress had acted since the *A.B. Dick* decision to make attempts to lessen competition unlawful); see Clayton Act § 3, ch. 323, 38 Stat. 731 (1914) (codified as amended at 15 U.S.C. § 14 (1982)). The *Motion Pictures Patents* Court expressly overruled its earlier *A.B. Dick* decision. *Motion Pictures Patents*, 243 U.S. at 518.

129. *Motion Pictures Patents*, 243 U.S. at 512-14. The *Motion Picture Patents* decision prohibited the extension of the patent grant to supplies for use in conjunction with the patent which were not part of the patent. *Id.* at 516.

130. *Mercoïd Corp. v. Mid-Continent Investment Co.*, 320 U.S. (1944) (*Mercoïd I*); *Mercoïd Corp. v. Minneapolis-Honeywell Regulator Co.*, 320 U.S. 680 (1944) (*Mercoïd II*).

Prior to the *Mercoïd* cases, the doctrine of patent misuse gradually expanded from its beginning in the *Motion Picture Patents* decision. The Supreme Court first prohibited a patentee from profiting indirectly from its patent by tying sales of a nonstaple article that was essential to the operation of the patent. *Carbice Corp. of Am. v. American Pat. Dev. Corp.*, 283 U.S. 27, 33 (1931) (prohibition of tying not dependent on nature of article or its use—staple dry ice for use in patented refrigerated shipping container); *J.C. Ferguson Mfg. Works, Inc. v. American Lecithin Co.*, 94 F.2d 729, 731 (1st Cir. 1938) (relying on *Carbice*—staple lecithin for use in patented recipe). The Court subsequently extended the doctrine to nonstaple articles in *B.B. Chem. Co. v. Ellis*, 314 U.S. 495 (1942) (relying on *Carbice*—extending the doctrine to non-patented, nonstaple latex emulsion for use in a patented cold bonding process).

131. The *Mercoïd* cases involved combination patents. See *supra* note 114. The defendants sold nonstaple components which were the "heart" of the patent. These articles were not capable of non-infringing use. *Mercoïd I*, 320 U.S. at 666-67; *Mercoïd II*, 320 U.S. at 684. The Court denied recovery because the doctrine of patent misuse precluded inclusion of any non-patented articles into the patent monopoly. *Mercoïd I*, 320 U.S. at 665-66; *Mercoïd II*, 320 U.S. at 684. The articles must have been within the patent grant itself to be afforded protection—i.e., there was no such thing as contributory infringement to protect the patentee against indirect invasion of his exclusive rights.

132. Patent Act of 1952, ch. 950, 66 Stat. 797 (1952) (codified as amended at 35 U.S.C. § 271(c) & (d) (1982)); see *supra* note 107.

133. To save the doctrine of contributory infringement from oblivion, Congress cut back the doctrine of patent misuse. *Dawson Chem. Co. v. Rohm. & Haas Co.*, 448 U.S. 176, 184-85 (1980). By defining in the negative what is not contributory infringement, 35 U.S.C. § 271(c) (1982), and what is not patent misuse, 35 U.S.C. § 271(d) (1982), the statute embodies a balance between the two.

quires the knowing sale<sup>134</sup> of a nonstaple article especially suited for patent infringement.<sup>135</sup> The staple article of commerce doctrine specifically excludes from the doctrine of contributory infringement those articles capable of "substantial noninfringing use,"<sup>136</sup> even where the defendant intended to facilitate acts of patent infringement.<sup>137</sup> Therefore, the statutory staple article of commerce doctrine severely limits the scope of contributory patent infringement.<sup>138</sup> So severe a limitation to contributory infringement is inappropriate to copyright law.<sup>139</sup> The principle embodied in the staple article of commerce doctrine as employed by the Supreme Court in *Sony Corp. of America v. Universal City Studios, Inc.*,<sup>140</sup> however, should prove a useful addition to the law of contributory copyright infringement.

#### AN ALTERNATIVE ANALYSIS FOR CASES INVOLVING CONTRIBUTORY INFRINGEMENT BY PROVIDING THE MEANS

Contributory copyright infringement arose from contributory patent infringement,<sup>141</sup> but its developmental history has diverged

---

It is not necessary to mitigate the impact of either doctrine because the staple article of commerce doctrine encompasses both. See *Dawson*, 448 U.S. at 200-01.

134. See *supra* note 119.

135. See *supra* note 120 and accompanying text.

136. 35 U.S.C. § 271(c) (1982). See *supra* note 107.

137. 35 U.S.C. § 271(c) (1982). See, e.g., *Dawson Chem. Co. v. Rohm & Haas Co.* 448 U.S. 176, 185, 200-01 (1980); *Aro Mfg. Co. v. Convertible Top Replacement, Co.*, 377 U.S. 476, 487-88 (1964); Oddi, *Contributory Infringement/Patent Misuse: Metaphysics and Metamorphosis*, 44 U. PITT. L. REV. 73, 82-85 (1982).

138. The knowing facilitation of an act of patent infringement now further requires that the article provided has no significant noninfringing uses. See *supra* notes 134-136 and accompanying text. This scope is more restrictive than that of traditional contributory copyright infringement derived from joint and several liability. See *supra* note 44 and accompanying text.

139. The doctrine of contributory copyright infringement derived from joint and several liability makes a third party liable for his knowing facilitation of an act of infringement. See *supra* note 44 and accompanying text. There is no reason to deny liability for such knowing facilitation in all cases merely because the means of infringement were capable of significant noninfringing uses. To do so would cause the absurd result that a third party knowingly providing a photocopying machine, a tape recorder, or other such implement for infringing use would always escape liability for his actions. This could create a grave injustice, and defeat the purposes of copyright protection. See *supra* notes 11-15 and accompanying text.

140. 104 S. Ct. 774 (1984). The *Sony* decision signifies that a court should consider all of the facts of a case before imposing liability for contributory copyright infringement. The court considering these facts should consider the interest of the alleged infringer to engage in substantially unrelated areas of commerce, the public interest in the legitimate use of the means of copyright infringement provided by the defendant, and the interest of the copyright owner in effective protection of his works. See *supra* note 76 and accompanying text.

141. See *supra* note 24.



from that of contributory patent infringement.<sup>142</sup> Contributory copyright infringement remains a judicially-created doctrine,<sup>143</sup> whereas Congress codified contributory patent infringement.<sup>144</sup> The staple article of commerce doctrine of patent law prevents the patentee's misuse of the patent grant.<sup>145</sup> The staple article of commerce doctrine adopted into copyright law should prevent such overextension of the copyright grant, but it should also act to prevent damage to this grant where liability for contributory infringement would not otherwise lie.<sup>146</sup>

Contributory copyright infringement serves the same purpose in copyright law that contributory patent infringement does in patent law.<sup>147</sup> It renders a third party liable for facilitating an act of infringement performed by another.<sup>148</sup> Contributory copyright infringement provides a means for the courts to go beyond the express provisions of the copyright statute and to prevent impairment of the exclusive rights of a copyright owner.<sup>149</sup> In this way, it advances the purpose for copyright protection.<sup>150</sup>

The traditional focus of contributory copyright infringement is either on the defendant's actions which facilitated the infringement<sup>151</sup> or on his relationship to the direct infringers.<sup>152</sup> This simple, direct analysis has afforded protection to copyrights for a long time and in a variety of factual situations.<sup>153</sup> It falls short of considering all interests involved, however, where the defendant provided

---

142. Contributory copyright infringement evolved from both joint and several liability and *respondeat superior*. See *supra* notes 27-29 and accompanying text. Contributory patent infringement applies more specifically to situations where the defendant provided a material component of the actual patented invention and the only practicable means available for enforcing the patent rights lies in an action against the contributory infringer. See *supra* notes 116 & 117 and accompanying text.

143. See *supra* notes 19 & 21-23 and accompanying text.

144. See *supra* note 107 and accompanying text.

145. See *supra* notes 125-29 & 132-38.

146. See *supra* note 101.

147. Compare *supra* note 116 and accompanying text with *infra* notes 149 & 150 and accompanying text.

148. See *supra* notes 38 & 44 and accompanying text.

149. The copyright statute does not expressly proscribe contributory infringement, but it protects the copyrights involved from infringement by making a third party liable for his facilitation of the infringement. See *supra* notes 38 & 44 and accompanying text. This presents greater flexibility to the copyright owner to remedy infringement of his rights.

150. See *supra* notes 11-15 and accompanying text.

151. This is the focus of contributory infringement derived from joint several liability. See *supra* note 44 and accompanying text.

152. This is the focus of contributory infringement derived from the agency doctrine of *respondeat superior*. See *supra* note 38 and accompanying text.

153. See generally *supra* notes 33-40 & 46-90.

the means for copyright infringement.<sup>154</sup>

Where the defendant provides the means for infringement, a court holding that the defendant is a contributory infringer would necessarily limit access to and/or use of his device.<sup>155</sup> Such a holding would deprive the defendant of the fruit of his creative enterprise or industry.<sup>156</sup> If this device is capable of legitimate and beneficial use apart from its use for copyright infringement,<sup>157</sup> the court would effectively deprive society of its potential benefits.<sup>158</sup> This result under a traditional contributory infringement analysis is distasteful to all but the copyright owner, who could obtain a windfall through such a holding.<sup>159</sup>

If, for example, the *Sony*<sup>160</sup> Court had found that the defendants possessed actual knowledge of a significant likelihood<sup>161</sup> that users of its video cassette recorder would use it to make copies of copyrighted works off the air,<sup>162</sup> the Court would have limited the availability of this useful device.<sup>163</sup> This would have contravened a basic social policy favoring expanded access to broadcast works<sup>164</sup> and denied the defendants any profit from developing their advance

---

154. Where the defendant provided the means for copyright infringement, his interest in providing the means of infringement for legitimate purposes and the public interest in access to the means of infringement for noninfringing use become involved in the balance. See *supra* note 76 and accompanying text. Access to the means of infringement is not a consideration under the traditional analysis. See *supra* notes 38 & 44 and accompanying text.

155. See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 104 S. Ct. 774, 788 (1984) (observing an aversion in patent law to holding the device within the control of the patent grant unless it is "unsuited for any commercial noninfringing use") [citation omitted].

156. Two possible deprivations are the outright prohibition of the provision of the article, or the imposition of a compulsory license on the defendant to permit him to continue his activities. See Note, *Every Home Should Have One: The Betamax as a Staple Article of Commerce in Universal City Studios, Inc. v. Sony Corp. of America*, 16 U.C.D. L. REV. 209, 225-29 (1982); see also *Universal City Studios, Inc. v. Sony Corp. of Am.*, 480 F. Supp. 429, 463 (C.D. Cal. 1979), *rev'd*, 659 F.2d 963 (9th Cir. 1981), *rev'd*, 104 S. Ct. 774 (1984).

157. This inquiry is one of degree. An article may have only minor noninfringing uses or uses of significant public value. See, e.g., *Sony Corp. of Am. v. Universal City Studios, Inc.*, 104 S. Ct. 774, 788-91 (1984).

158. See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 104 S. Ct. 774, 795 (1984) (observing a public interest in the increased availability of televised programs made possible through a video cassette recorder used to infringe copyrighted works).

159. The copyright owners would effectively control the market for the means of infringement. See *supra* notes 155 & 156 and accompanying text.

160. See *supra* notes 70-76 and accompanying text.

161. Actual knowledge does not include the "constructive knowledge" that the *Sony* Court held was insufficient to establish liability for contributory infringement. See *supra* notes 71 & 72 and accompanying text.

162. This determination would establish contributory infringement based on joint and several liability. See *supra* notes 44 & 45 and accompanying text.

163. See *supra* notes 156 & 159 and accompanying text.

164. See *supra* note 158.

in technology.<sup>165</sup> This would have been an undesirable result. If, on the other hand, the Court had found that use of the recorder would significantly diminish the value of televised audiovisual works,<sup>166</sup> then to allow its continued availability would have denied the very purposes for copyright protection.<sup>167</sup> This is an equally undesirable result.<sup>168</sup>

A court, therefore, cannot permit the continued provision of the means for infringement simply because it is capable of noninfringing use or because it is not specially suited to infringing use.<sup>169</sup> The staple article of commerce doctrine in patent law would mandate such a result.<sup>170</sup> Such would have been the result in *Atari*<sup>171</sup> and *Arctic International*<sup>172</sup> if the court had looked no further into the facts than to find that the articles involved were equally capable of noninfringing use.<sup>173</sup> The courts in *Sony*, *Atari*, and *Arctic International* weighed the "significance" of prospective noninfringing uses for the means of infringement.<sup>174</sup> This weighing, although not

165. The video cassette recorder involved was the first such recorder suitable for home use. See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 104 S. Ct. 774, 778-79 (1984). The plaintiffs sought money damages, an accounting of profits, and an injunction against the continued sale of the recorder. *Id.* at 777.

166. This would occur in cases where the unlawful copying reduces the volume of legitimate sales of copies of the copyrighted work or otherwise diminishes the return to the copyright owner. See, e.g., *id.* at 793 (discussing the element of "harm" in the "fair use" setting).

167. See *supra* notes 12 & 13 and accompanying text.

168. The "significance" of the noninfringing uses, which was the determining factor in the *Sony* case, cannot always protect against damage to the value of the copyrights involved. Potential loss in value to the plaintiff's copyrights is, therefore, a separate factor for judicial consideration. See, e.g., *Atari, Inc. v. JS&A Group, Inc.*, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,613 (N.D. Ill. Dec. 6, 1983); *Midway Mfg. Co. v. Arctic Int'l, Inc.*, 211 U.S.P.Q. 1152 (N.D. Ill. 1981). This means that cases could arise in which the article provided is capable of "significant" noninfringing uses, but the loss to the value of copyrighted works so severe that the court should not permit its continued availability.

169. This is the description of a non-staple article under the patent statute. See *supra* note 107 and text accompanying note 135.

170. In patent law, under the staple article of commerce doctrine, the provision of an article specially suited for patent infringement renders the seller liable as a contributory infringer. See 35 U.S.C. § 271(c) (1982).

171. *Atari, Inc. v. JS&A Group, Inc.*, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,613 (N.D. Ill. Dec. 6, 1983).

172. *Midway Mfg. Co. v. Arctic Int'l, Inc.*, 211 U.S.P.Q. 1152 (N.D. Ill. 1981).

173. See *supra* notes 91-98 and accompanying text.

174. The determination that the article provided was capable of noninfringing uses did not end the courts' inquiries. The courts further considered the relative "significance" of any noninfringing use for the articles involved in each case. In *Arctic Int'l*, the court considered the potential uses of the article on works similar to the plaintiff's copyrighted works in order to determine whether it had its own intrinsic value apart from that of the plaintiff's copyrights. See *supra* note 93 and accompanying text. The court would only have considered the potential for infringing use against that for permissibly copying the defendant's own works in *Atari*. See *supra* note 97 and accompanying text. The *Sony* Court balanced the public interest in continued use of the defendants'

expressly reduced to clear factors by the courts,<sup>175</sup> did include six basic considerations in a balancing which sought to cause the least aggregated harm to the three interests involved.<sup>176</sup>

The first two considerations derived from the traditional contributory infringement inquiries. After the *Sony* Court considered whether copyright infringement had occurred,<sup>177</sup> it inquired into whether the defendant knowingly acted to facilitate direct infringement.<sup>178</sup> A court may direct this inquiry at the acts of the defendant, which would indicate knowledge that users of its device would infringe copyrights, or at the nature of the article sold, from which the court might infer such knowledge.<sup>179</sup> The second inquiry was whether the defendant was in a position to supervise and control the direct infringements involved and possessed a direct financial interest in them.<sup>180</sup> An affirmative answer to either inquiry would mandate holding the defendant liable as a contributory infringer under the traditional analysis.<sup>181</sup> Where the defendant provided the means for infringement, however, these first two considerations should only constitute a *prima facie* showing of contributory infringement.<sup>182</sup>

*Sony, Atari, and Arctic International* demonstrate that where the defendant provided the means for copyright infringement,<sup>183</sup>

---

device against that in copyright protection. See *supra* notes 76 & 158 and accompanying text.

175. The courts each considered similar, but separate, factors. The *Arctic Int'l* court considered the potential for misappropriation of value from the plaintiff's works and, on the other hand, the potential for independent intrinsic value in the defendant's device. See *supra* note 93 and accompanying text. In *Atari*, the court considered the potential for infringing use against the potential for legitimate use of the defendant's device. See *supra* note 97 and accompanying text. The *Sony* Court balanced public policies. See *supra* notes 76 & 158 and accompanying text.

176. The six considerations are as follows: 1) whether the defendants had the right or ability to supervise and a direct financial interest in the infringing activity; 2) whether the defendants had knowingly facilitated an act of direct infringement; 3) whether the defendant's article would damage the value of the plaintiff's copyrights; 4) whether the defendant's device had any inherent value independent of the copyrights which its users infringe; 5) whether the availability of the defendant's device produces a public benefit; and 6) whether the public policy is best served by denying the availability of the device.

177. The *Sony* Court avoided deciding the contributory infringement issue on the traditional basis by holding that significant noninfringing uses existed for the defendants' video cassette recorder. In this way, the Court also avoided deciding the issue of direct infringement. See *Sony*, 104 S. Ct. at 789.

178. See *supra* note 44 and accompanying text.

179. See *Sony*, 104 S. Ct. at 785-88. See also *supra* notes 82 & 89 and accompanying text.

180. *Sony*, 104 S. Ct. at 786-87. See *supra* note 38 and accompanying text.

181. See *supra* notes 38 & 44 and accompanying text.

182. See *supra* notes 163-68 and accompanying text.

183. See *supra* notes 70-101.

other interests make additional inquiry necessary.<sup>184</sup> Each of these courts exhibited a dual consideration of the public interest: an interest which lay on both sides of the issue of contributory infringement. On one side lay the public interest in effective protection of the plaintiff's works;<sup>185</sup> on the other side lay an interest in continued access to the means for infringement.<sup>186</sup> Public interests are the preeminent interests involved in copyright law.<sup>187</sup> Another consideration is the interest of the copyright owner whose works have been infringed.<sup>188</sup> A final, secondary consideration was for the interest of the defendant in the device he provided.<sup>189</sup> The interests of the copyright owner and the alleged contributory infringer, however, should remain subordinate to the public interests involved.<sup>190</sup> The consideration of these several factors, therefore, gives rise to an alternative analysis which goes beyond the traditional contributory infringement analysis.

This alternative analysis, which emerges from the staple article of commerce doctrine, first determines whether the plaintiff has made a *prima facie* showing of contributory copyright infringement.<sup>191</sup> Unlike the staple article of commerce doctrine as employed in patent law,<sup>192</sup> this analysis permits a judicial balancing of four factors, based on the particular facts of the case. These factors are the public interest in the device used as a means for infringement, the probable damage that continued infringement would cause to the public interest in access to the copyrighted works, the copyright owner's interest in continued reward for his creative endeavor, and the similar interest of the alleged contributory infringer in legitimately profiting from the means for infringement which he provided.<sup>193</sup>

When the balancing of these four considerations weigh in favor of the denial of access to the means for infringement, the court should hold the defendant liable as a contributory infringer.<sup>194</sup> On

---

184. See *supra* notes 155-58 and accompanying text.

185. See *supra* notes 12 & 13 and accompanying text.

186. See *supra* note 158 and accompanying text.

187. See *supra* note 14 and accompanying text.

188. This interest is in continued compensation for the product of his creative effort. See *supra* notes 13 & 76 and accompanying text.

189. This interest is similar to that of the copyright owner in his works; the defendant has an interest in deriving compensation for making his advice publicly available. See *supra* note 76 and accompanying text.

190. See *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) [citations omitted].

191. This *prima facie* determination is based on the traditional contributory infringement analysis. See *supra* notes 38 & 44 and accompanying text.

192. See *supra* notes 134-37 and accompanying text.

193. See *supra* note 165.

194. In this type of case, the balancing of these four factors either supports a *prima facie* presumption of liability based on the traditional analysis or extends

the other hand, where these considerations balance more favorably towards the continued free access to the defendant's device, even where a *prima facie* case of contributory infringement is established, the court should hold in favor of the defendant.<sup>195</sup> Consequently, this alternative analysis permits a party to create a presumption of contributory infringement or non-contributory infringement, which the opposing party has the obligation to rebut by a preponderance of the evidence. This analysis affords greater flexibility to the courts in considering all factors involved in a particular case.

### CONCLUSION

Copyright law involves a balancing between competing interests, and any activity which impacts on these interests may upset this balance. The existence of the judicially-created doctrine of contributory infringement constitutes recognition that the courts will act to maintain the proper balance of interests even where the copyright statute is silent. In some cases, the court may encounter factors not involved in the traditional setting; additional considerations may enter into the balance. The courts should not be restrained from considering the new factors entering into the balance in these instances. The courts should make a full determination of each case, based on its merits and its particular facts. If they are restrained from doing so, their decisions will not best serve the purpose of copyright protection or the intent of the copyright statute.

The copyright statute exists to "promote the useful arts and sciences."<sup>196</sup> Where the defendant provided the means for copyright infringement, additional factors arise for judicial consideration.

---

liability beyond this basis. This latter extension would occur where the damage caused to the value of the plaintiff's works greatly outweighs the benefits of continued access to the means of infringement. *See, e.g. Atari, Inc. v. JS&A Group, Inc.*, 1984 COPYRIGHT L. REP. (CCH) ¶ 25,613 (N.D. Ill. Dec. 6, 1983); *Midway Mfg. Co. v. Arctic Int'l, Inc.*, 211 U.S.P.Q. 1152 (N.D. Ill. 1981).

195. This avoids a cure that, although beneficial to the copyright owner, is actually more deleterious to the public interest. *See, e.g., Sony Corp. of Am. v. Universal City Studios, Inc.*, 104 S. Ct. 774 (1984).

This proposed analysis is similar to the "fair use" doctrine of copyright law. The fair use doctrine balances the harmful impact of a particular infringing use against the public interest in permitting it. It permits the courts to weigh four factors in cases involving direct infringement and hold that it constitutes a permissible fair use of the plaintiff's copyrights. These factors are the purpose and character of the use, the nature of the copyrighted work, the effect of the copying on the potential value of the work, and the "amount and substantiality" of the portion copied in relation to the work as a whole. 17 U.S.C. § 107 (1982). *See Sony Corp. of Am. v. Universal City Studios, Inc.*, 104 S. Ct. 774, 791-93 (1984) (calling fair use an "equitable rule of reason"); *Williams & Wilkins Co. v. United States*, 487 F.2d 1345, 1377-78 (Ct. Cl. 1983).

196. U.S. CONST. art. I, § 8, cl. 8; *see supra* notes 11-15 and accompanying text.

These include both public and private interests, the relative value of which depend upon the facts of the particular case. A mechanical means for determining the outcome of these cases would likely defeat the purpose of copyright protection. Courts should employ the traditional contributory infringement analysis to make a *prima facie* determination of contributory infringement or non-contributory infringement. The additional consideration of the nature of the means for infringement provided should then serve to either rebut or support this presumption. This alternative analysis recognizes the fact that the conclusion of the judicial analysis should depend on more than mere consideration of the defendant's position and activities or the nature of the article that he provided for the infringing use of others.

*Michael J. McCambridge*