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Withdrawal of the Reference: Rights, Rules, and Remedies for Unwelcomed Web-Linking

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WITHDRAWAL OF THE REFERENCE: RIGHTS, RULES, AND REMEDIES FOR UNWELCOMED WEB-LINKING

WALTER A. EFFROSS*

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* All rights reserved. Associate Professor, Washington College of Law, American University; Chair, American Bar Association's Subcommittee on Electronic Commerce. The author appreciates the research grants provided by the Washington College of Law and the research assistance of Melody Rosenberry. The information in this article is not offered as legal advice.

Perhaps the most important feature of the information network known as the World Wide Web¹ is not the ability of individuals and organizations to create their own web sites containing hyperlinked pages of information, but the opportunity to connect these pages to the pages of other sites.² In fact, as will be discussed in this article, it has been argued that every owner of a site in this famously participatory and interactive medium has implicitly granted to every other site owner the ability to link to the owner's site.

However, despite the technological ease with which links can be created, their use is precipitating a complex controversy in the law and culture of the Web: on what legal grounds can the owner of the target site attack an unwanted link from a linking site? Although few courts and commentators have addressed this issue, its resolution undoubtedly will involve the extension of traditional concepts of intellectual property to the new environment of cyberspace. Central to the discussion are models for and characterizations of the Web's new modes of contextualization. For instance, is a link merely the digital equivalent of a footnote in a written work, or does it somehow involve a greater connection with, and perhaps an infringement of the rights of, the creators of the target site?

Part I of this Article discusses the technical aspects of web-linking. Part II examines the issues raised in four web-linking situations that led to court proceedings. Parts III, IV, and V address, respectively, the copyright, trademark, and privacy models for attacking unauthorized web-linking. Part VI offers a practical and inexpensive solution, both cultural and legal, to some of these concerns.

I. THE TECHNOLOGY OF WEB-LINKING

A web site consists of a number of interconnected pages, each of which consists of a separate computer display of textual information, graphic information, or both. Because the computer allows viewers to "scroll through" a long document or image

1. The Internet is a system created by the federal government in 1969 to link "computers and computer networks owned by military, defense contractors, and university laboratories conducting defense-related research." *ACLU v. Reno*, 929 F. Supp. 824, 831 (E.D. Pa. 1996), *aff'd*, 117 S. Ct. 2329 (1997).

The World Wide Web has been defined as "a collection of protocols and standards for accessing information on the Internet, . . . [which is] the physical medium used to transport the data." NET.GENESIS & DEVRA HALL, BUILD A WEBSITE 5 (1995). It consists of "a series of documents stored in different computers all over the Internet" whose interlinking has made it "currently the most advanced information system developed on the Internet." *Reno*, 929 F. Supp. at 836. For an examination of the structure of web sites and its legal implications, see Walter A. Effross, *The Legal Architecture of Virtual Stores: World Wide Web Sites and the Uniform Commercial Code*, 34 SAN DIEGO L. REV. (forthcoming 1998) (discussing contract, warranty and jurisdictional issues arising from sales of goods over the Internet).

2. See *Reno*, 929 F. Supp. at 836-37 (observing that "[t]hese links from one computer to another, from one document to another across the Internet, are what unify the Web into a single body of knowledge, and what makes the Web unique").

that extends beyond the border of the screen, a single web page can contain much more than one screenful of information. The home page of a site corresponds to the front door of a house or the front window of a store. Many visitors start their explorations at the home page, proceeding to internal pages connected to the home page through one link or a series of links.

Web pages are commonly created using HyperText Markup Language, often abbreviated as HTML.³ Each page, whether a home page or an internal page, has an address or "Uniform Resource Locator" (URL) that identifies its Web location to users. They can type this URL string of letters and numbers into their web browsers, such as Netscape Navigator or Internet Explorer, to reach that page.⁴

Whether one web page is linking to another page in its own site or to a page on a different web site, the HTML programming for the hypertext link is fairly straightforward: the site owner inserts a line of code containing the phrase " [text to be marked as the link inserted here] ".⁵ As one handbook explains,

[t]he element marking a hypertext link is called an A, or anchor, element, and the marked text is referred to as a hypertext anchor. The area between the beginning <A> and ending tags becomes a hot part of the text. . . . [T]his section of text is displayed with an underline and usually in a different color (often blue). . . . Placing the mouse over this region and clicking the mouse button . . . causes the client to access the indicated document or other Internet resource.⁶

3. See, e.g., IAN S. GRAHAM, *THE HTML SOURCEBOOK* ix (1995) (defining HTML as "the markup language with which World Wide Web hypertext documents are written [and what] allows you to create hypertext links, fill-in forms, and clickable images"). This Article does not address the operation of the myriad new programs available through Internet service providers such as America On-Line or through software retailers that allow even an inexperienced user to build a web site without actually directly programming in of HTML code. See Effross, *supra* note 1 (examining the commercial implications of this development); see also Steve Glaser & Elizabeth Lewis, *Things to Know, Do & Avoid Before Building a Web Page*, 5 PC NOVICE GUIDE TO BUILDING WEB SITES 13, 13-15 (1997) [hereinafter PC NOVICE's GUIDE] ("It used to be that the only way to create a Web site was to write the HTML code. Today there are a number of programs that allow you to simply drag and drop elements together. . . . These Web editors, as they are called, handle the creation of HTML code in the background where you needn't worry about it.").

4. Generally, the home page of a commercial entity is of the form "http://www.[company's name].com" such as "http://www.barnesandnoble.com" or "http://www.kraftfoods.com." The internal pages usually add characters at the end of the designation for the site's home page, for example, "http://www.[company's name]/html/main/legal.html."

5. See, e.g., ADAM BLUM, *BUILDING BUSINESS WEB SITES* 87-88 (1996) (explaining how to build hypertext links); DAVID COOK & DEBORAH SELLERS, *LAUNCHING A BUSINESS ON THE WEB* 566-67 (2d ed. 1996) (explaining the use of link programming). Links can also take a visitor from one area in a page to another. For example, the bottom of a long page which a visitor has scrolled through might contain a helpful link back to the top of that document.

6. GRAHAM, *supra* note 3, at 21.

By only a slightly more complicated procedure, the site owner can designate a graphic image or icon as the link to be selected. That is, after the user clicks on the icon, the user's "browser reads the code, goes out to the Internet and tracks down the web page that matches the address, and makes a request for a copy of that web page. The computer running the linked web page sends the copy back to the user's browser, and the browser reads the code and assembles the page on the user's computer screen."⁷ This process usually happens very quickly, unless a large amount of textual or graphic material is involved. Unless users check their browsers' URL display for the page that they are not viewing, the process is also "transparent" to the users; they generally cannot determine whether or not the link has transferred them from one web site to another.

How can the owners of a site determine which sites are linking to theirs? One easy way to track this information (although it offers no guarantees of being current or complete) is through the web site presenting the HotBot⁸ search engine, which can present a list of pages that link to any other given page on the Web. For example, on February 12, 1998, this facility revealed 23,559 links to the home page of bookseller Amazon.com, 15,638 links to the home page of the *Playboy* magazine web site, and 6,556 links to the American Civil Liberties Union home page.⁹

This Article assumes for purposes of simplicity that an unauthorized link is made from a page of the linking site to a page of the target site, and not to a page of another site that contains material concerning the owner of the target site. That is, the situations considered are those that involve A's complaint against B for B's constructing a link on a page or pages of B's site to a page or pages of A's site, rather than linking B's site to a page or pages of C's site that somehow concern A.

7. See Rebecca Quick, *How a Link Works*, WALL ST. J., July 2, 1997, at B6 (summarizing how a link works and indicating that a visitor to a web page can examine that page's coding by "go[ing] to the 'View' button on your browser and then click[ing] on the 'Document Source' or 'Source' command") An additional wrinkle is that the information may be supplied by a "cached" copy. See *American Libraries Ass'n v. Pataki*, 969 F. Supp. 160 (S.D.N.Y. 1997) (concerning a constitutional challenge to a state statute prohibiting dissemination of obscene material to minors over the Internet). In *American Libraries* the court explained "caching" as "the Internet practice of storing partial or complete duplicates of materials from frequently accessed sites to avoid repeatedly requesting copies from the original server. The recipient has no means of distinguishing between the cached materials and the original." *Id.* at 171. For a detailed discussion of caching techniques and the World Wide Web, see Richard S. Vermut, *File Caching on the Internet: Technical Infringement or Safeguard for Efficient Network Operation?*, 4 J. INTELL. PROP. L. 273 (1997).

8. *Hotbot: The Wired Search Center* (visited Mar. 16, 1998) <<http://www.hotbot.com>>. The home page of this site offers a pull-down menu of items to "look for," one of which is "links to this URL." *Id.* By selecting this option and typing into the HotBot search engine the URL of the target site, the visitor can find a list of, and links to, many sites linking to that page.

9. Because several links to the same target page may originate from different pages in one linking site, or even from different pages of the target site itself, these numbers provide only a raw indication of the total number of separate web sites linking to the target page.
<https://scholarcommons.sc.edu/sclr/vol49/iss4/3>

II. WEB-LINKING LITIGATION

As of February 1998, the issue of unwelcomed linking had been litigated before four courts, the first of them outside the United States. Each of these controversies involved a different aspect of unwelcomed linking.

A. *Direct Linking I: The Shetland Times Case*¹⁰

In October 1995, the Shetland News (News), a newspaper whose printed version addressed concerns in the Scottish Islands, added to its web site links that reproduced verbatim the headlines of articles available on the rival Shetland Times (Times) newspaper's web site.¹¹ Visitors who followed these links from the News site would find themselves viewing the corresponding articles on the Times site, but they would then be directed back to the News site through another link without passing through the Times' home page or viewing any advertisements placed on the Times' web site by the Times' advertisers.¹² Especially galling to the editors of the Times was that visitors who reached the Times reports through the News site might have been given the erroneous impression that the two newspapers were affiliated. Although the Times articles still carried a Times logo, the News had removed the Times "frame" (the surrounding visual material) and had not advised the News visitors that the link to these stories was transferring them to the Times site.¹³

At a preliminary or "interim interdict" stage of the case on October 24, 1996, Lord Hamilton of the Court of Sessions (Outer House) agreed that the Times had "a prima facie case that the incorporation by [the News] in their Web site of the headlines provided at [the Times'] web site constitutes an infringement of [a statute prohibiting] the inclusion in a cable programme service of protected cable programmes."¹⁴ The court rejected the News' argument that it had been the News and not the Times that had sent the information from the Times' web site by noting

10. *Shetland Times, Ltd. v. Wills*, F.S.R. 604, 1997 S.L.T. 669 (Outer House Oct. 24, 1996), available in LEXIS, Scot Library, Cases File. These allegations appear on the web page that the *Shetland Times* set up to demonstrate the operation of the Shetland News site. See *The Shetland Times Online* (visited Mar. 6, 1998) <<http://www.shetland-times.co.uk/st/internet/legal.htm>>.

11. *Shetland Times*, at *3.

12. *Id.* at *4.

13. See Charles R. Merrill & Robert J. Burger, *Keeping the Chain Unbroken*, INTELL. PROP. MAG. (Feb. 1997) (visited Mar. 16, 1998) <<http://www.ipmag.com/merrill.html>> (discussing *Shetland Times*).

14. *Shetland Times*, at *5. The Times established that its web site qualified as a "cable programme service" that "consists wholly or mainly in sending visual images, sounds or other information by means of a telecommunications system, otherwise than by wireless telegraphy" to multiple recipients or to the public at large. *Id.* The court found inapplicable the exception from this definition for services which had the "essential feature" of feedback by the recipients: "While the facility to comment or make suggestions via the Internet exists, this does not appear to me to be an essential element in the service, the primary function of which is to distribute news and other items." *Id.*

[i]f the information is being sent, it prima facie is being sent by the [Times] on whose web site it has been established. The fact that the information is provided to the caller by his accessing it through the [News'] web site does not, in my view, result in the [News'] being the person sending the information.¹⁵

Notably, the court concluded that

[i]t was fundamental to the setting up by the [Times] of their web site that access to their material should be gained only by accessing their web directly. While there has been no loss to date, there is a clear prospect of loss of potential advertising revenue in the foreseeable future. . . . There was, in the circumstances, no substance, in my view, in the suggestion that [the Times was] gaining an advantage by their newspaper items being made available more readily through [the News'] web site.¹⁶

Under the terms of the settlement of the case,¹⁷ the News was not barred from linking. However, it agreed that it would qualify its linking through headlines on its site to stories on the Times' web site as follows:

- a. each link to any individual story shall be acknowledged by the legend "A Shetland Times Story" appearing underneath each headline and of the same or similar size as the headline;
- b. adjacent to any such headline or headlines there shall appear a button showing legibly the Shetland Times masthead logo; and
- c. the legend and the button shall each be hypertext links to the Shetland Times online headline page.¹⁸

*B. Direct Linking II: Ticketmaster Corp. v. Microsoft Corp.*¹⁹

Although less invasive than the conduct of Shetland News, Microsoft's unauthorized linking to an unaltered internal page of the Ticketmaster web site was no less welcomed.²⁰ On April 28, 1997, the online ticket-seller Ticketmaster filed suit against Microsoft in the District Court for the Central District of California, alleging that after "[n]egotiations with Microsoft for an agreement allowing Microsoft to profit from linkage to and association with Ticketmaster's name, marks

15. *Id.*

16. *Id.* at *6.

17. *The Shetland Times, Publisher's Statement, Internet Dispute Settled* (last modified Nov. 11, 1997) <<http://www.shetland-times.co.uk/st/internet.htm>>.

18. *Id.*

19. No. 97-3055 DDP (C.D. Cal. 1997).

20. Microsoft's unauthorized linking initiated litigation that was continuing as of early 1998. <https://scholarcommons.sc.edu/sclr/vol49/iss4/3>

and web site [had] failed, . . . Microsoft is making use of such linkage and association as a freerider and in express contravention of Ticketmaster's request."²¹

The exhibits to the Complaint indicate that this linkage involved Microsoft's including on its "Seattle Sidewalk" city guide site²² links to Ticketmaster's site.²³ Visitors who inserted the term "Ticketmaster" into the search engine on the Seattle Sidewalk site obtained search result pages listing the physical locations of Ticketmaster outlets with a link to a separate page for each of those locations.²⁴ Each of the linked pages offered the identical short article on the virtues of Ticketmaster, the disputed link to Ticketmaster's external web site, and, along its right border, a series of advertisements placed by Microsoft containing links to various other attractions in the Seattle area.²⁵

Ticketmaster alleged that by linking to the Ticketmaster web site, Microsoft had "utilized . . . the name and marks of Ticketmaster and Ticketmaster's web site notwithstanding Ticketmaster's protestation against such use and Microsoft's implicit recognition that, absent an agreement with the owner for use of a web site, web sites are for personal non-commercial use"²⁶ and that Microsoft had thereby "enhanced the value of Microsoft's web site and business and diluted and diminished the value of Ticketmaster's web site and business. . . . [by] depriving Ticketmaster of favorable advertising business and opportunities."²⁷ That is, as in *Shetland Times*, Microsoft's direct link to Ticketmaster's site allowed visitors to bypass Ticketmaster's other pages, and thus to skip the advertising on those pages. Ticketmaster thus sought relief under the Lanham Trade-Mark Act,²⁸ the California Business and Professions Code,²⁹ and the California common law of unfair competition and unfair business practices.³⁰

In its Answer, Microsoft asserted as an affirmative defense that "[a]ny business, such as Ticketmaster, participating in the Internet and the World Wide Web invites

21. Ticketmaster's First Amended Complaint para. 16, *Ticketmaster Corp. v. Microsoft Corp.*, No. 97-3055 DDP (C.D. Cal. 1997).

22. See *id.* app. C; *Seattle.Sidewalk* (visited Mar. 6, 1998) <<http://www.seattle.sidewalk.com/>>.

23. Ticketmaster's First Amended Complaint para. 16, *Ticketmaster* (No. 97-3055 DDP).

24. See *Seattle.Sidewalk*, *supra* note 22; *Sidewalk Entries Containing "Ticketmaster": Seattle Sidewalk* (visited Mar. 6, 1998)

<<http://seattle.sidewalk.com/directory?FID=185ID=11878FTS=ticketmaster>>.

25. See Ticketmaster's Amended Complaint para. 16, *Ticketmaster* (No. 97-3055 DDP); *Ticketmaster at Blockbuster Music—Bellevue* (visited Mar. 6, 1998)

<<http://seattle.sidewalk.com/detail/10877>>. Currently, if one selects the link from Seattle Sidewalk to Ticketmaster.com, the Ticketmaster logo appears, but Ticketmaster has blocked access by labeling this page as an unauthorized link and a dead-end page. See *Dead End Page* (visited Mar. 6, 1998)

<<http://ticketing.ticketmaster.com/restricted/index.html>>.

26. Ticketmaster's First Amended Complaint para. 18, *Ticketmaster* (No. 97-3055 DDP).

27. *Id.* para. 19.

28. 15 U.S.C. § 1125(a), (c) (1994 & Supp. I 1995).

29. CAL. BUS. & PROF. CODE §§ 17200, 17500 (West 1997).

30. See Ticketmaster's First Amended Complaint paras. 20-28, *Ticketmaster* (No. 97-3055 DDP) (setting forth the alleged grounds for relief).

other participants to use the business' Internet addresses and URLs to contact it."³¹ Indeed, it continued,

Microsoft does not use Ticketmaster's Web Site. Microsoft does not access, incorporate or redistribute Ticketmaster Web Page documents. All Microsoft does is provide viewers of its own Web Pages with the URLs for other Web Pages on the Internet, including some operated by Ticketmaster, that the viewer may find of interest. Whether or not the viewer accesses a Ticketmaster Web Page document is up to the viewer. Whether or not Ticketmaster displays the Web Page document to the viewer is up to Ticketmaster. Microsoft is not a party to the communication between the viewer and Ticketmaster.³²

. . . Moreover, at any time it chose, Ticketmaster had the power to refuse access to any of its Web pages. Ticketmaster voluntarily and knowingly chose not to refuse access. Ticketmaster has publicly acknowledged that it possesses the capability to refuse access and that it voluntarily elected not to do so.³³

Among Microsoft's numbered affirmative defenses were Ticketmaster's assumption of the risk of such linkage; estoppel of Ticketmaster from making a claim based on the conduct; fair use, nominative fair use, noncommercial use, and news reporting under the Lanham Act; and the protection of the First Amendment for the commercial speech of providing "basic information and commentary"³⁴ about Ticketmaster.³⁵

Ticketmaster's Reply insisted that "Ticketmaster's Web Site on the World Wide Web was provided pursuant to certain restrictions and understandings, including the limitation that it was to be used for personal, non-commercial use only, and was not provided for the competing, commercial use of Microsoft" and that following Microsoft's continued use of Ticketmaster name, mark, and web site in express contravention of Ticketmaster's request to discontinue such use, "Ticketmaster was required to expend its own resources to block Microsoft's direct access to Ticketmaster's Web Site, subject to such further contravention of Ticketmaster's request as Microsoft may be able to accomplish."³⁶

At a status hearing held on February 2, 1998, a trial of this matter was scheduled for the fall of 1998.

31. Microsoft's Answer para. 43, *Ticketmaster* (No. 97-3055 DDP).

32. *Id.* para. 45.

33. *Id.* para. 46.

34. *Id.* para. 74.

35. *Id.* paras. 51-75.

36. Ticketmaster's Reply to Microsoft's Counterclaim para. 46, *Ticketmaster* (No. 97-3055 DDP); see also *supra* note 25 (detailing the results of Ticketmaster's technological blockage of Microsoft's link).

C. *Framing*: Washington Post Co. v. Total News, Inc.³⁷

If the *Shetland Times* and *Ticketmaster* litigations involved unauthorized links to the “de-framed” and the unaltered pages of the target site, respectively, *Total News* concerned a clearly more intrusive practice: the defendant’s linking site “framed” the pages of the target site, so that a visitor to the linked target site would see those pages surrounded by material created by the linking site.³⁸

On February 20, 1997, the Washington Post filed suit against Total News, alleging “blatant acts of misappropriation, trademark dilution and infringement, willful copyright violations, and other related tortious acts . . . in connection with th[e] operation of a parasitic site know as ‘totalnews.com’ on that portion of the Internet known as the World Wide Web.”³⁹ At the core of the “parasitism” alleged was the defendant’s practice of “‘framing’ that causes Plaintiffs’ websites to appear not in the form that Plaintiffs intended, but in an altered form designed by Defendants for their own economic advantage.”⁴⁰ That is, when a visitor to totalnews.com clicked on a hyperlink bearing the name of one of the plaintiff’s publications, the Washington Post site

does not then fill the screen as it would had the user accessed Plaintiff’s site either directly or by means of a hyperlink from a website that does not “frame” linked sites. Nor does Plaintiff’s URL appear at the top of the screen as it normally would. Instead, part of Plaintiff’s site is inserted in a window designed by Defendants to occupy only a portion of the screen. Masking part of Plaintiff’s site is the totalnews.com “frame,” including, *inter alia*, the “Total News” logo, totalnews.com URL, and advertisements that others have purchased from Defendants.⁴¹

In this fashion, “by juxtaposing advertising sold by Defendants against advertising sold by Plaintiffs on their own sites, and by obscuring the advertising on Plaintiff’s sites, Defendants directly compete against Plaintiffs and interfere with Plaintiff’s contractual relationships with their advertisers.”⁴² Not only were the plaintiffs’ various sites unable to escape completely the framing effects of Total News, but they could find “no assurance that in the fast-changing world of the Internet . . . any technological steps they take to avoid framing will succeed in ensuring that Plaintiff’s sites remain consistently visible in the way they intended.”⁴³ Accordingly, the plaintiffs alleged the following causes of action:

37. No. 97 Civ. 1190 (PKL) (S.D.N.Y. 1997).

38. Washington Post’s Complaint para. 30, *Washington Post Co.* (No. 97 Civ. 1190 (PKL)).

39. *Id.* para. 1.

40. *Id.* para. 30.

41. *Id.*

42. *Id.* para. 36.

43. *Id.* para. 37.

misappropriation; federal trademark dilution and infringement; false designations of origin, false representations, and false advertising in violation of the Lanham Trade-Mark Act; trademark infringement and unfair competition, dilution, and deceptive acts and practices under New York state law; copyright infringement; and tortious interference.⁴⁴

The suit was settled on June 5, 1997.⁴⁵ The settlement specifically called for the defendants not to “frame” any of the plaintiff’s web sites⁴⁶ or to “link to any page of any website in any way that purposefully or overtly encourages users, once at a non-Plaintiff’s site, to link to any Plaintiff’s website”⁴⁷ Notably, the settlement also provided:

Plaintiffs agree that Defendants may link from the Totalnews.com website or any other website to any Plaintiff’s website, provided that:

- (a) Defendants may link to Plaintiffs’ websites only via hyperlinks consisting of the names of the linked sites in plain text, which may be highlighted;
- (b) Defendants may not use on any website, as hyperlinks or in any other way, any of Plaintiff’s proprietary logos or other distinctive graphics, video or audio material, nor may Defendants otherwise link in any manner reasonably likely to: (i) imply affiliation with, endorsement or sponsorship by any Plaintiff; (ii) cause confusion, mistake or deception; (iii) dilute Plaintiff’s marks; or (iv) otherwise violate state or federal law.⁴⁸

*D. Implying Authorization to Use Protected Symbols: ACLU v. Miller*⁴⁹

Although issues of unauthorized linking are only beginning to reach the courts, one state’s legislative attempt to resolve them has already been struck down as overbroad.

In September 1996, a coalition of plaintiffs—including The American Civil Liberties Union of Georgia, The AIDS Survival Project, and the Electronic Frontier

44. Washington Post’s Complaint paras. 38-76, *Washington Post* (No. 97 Civ. 1190 (PKL)).

45. *Law of the Internet* (visited Mar. 7, 1998) <<http://www.ljx.com/internet.totalse.htm>> (containing a copy of the Stipulation and Order of Settlement and Dismissal, No. 97 Civ. 1190 (PKL)).

46. *Id.* para. 3.

47. *Id.* para. 6. Under the terms of the settlement, this provision would be violated if the defendants “state[d] on their website that a Plaintiff’s website could be reached with two clicks—the first click taking the user to a third-party website, and the second click taking the user, via a hyperlink supplied by the third party, to a Plaintiff’s website that would then be seen through Defendants’ frame.” *Id.* However, it would be permissible for the defendants to “simply provid[e] a hypertext link, using frames technology, to a website page other than a Plaintiff’s website, from which the user on her own is able to, and does, link to a Plaintiff’s website in a manner permitted by law.” *Id.*

48. *Id.* para. 4.

49. No. 1:96-CV-2475-MHS (N.D. Ga. 1996).

Foundation—filed a constitutional challenge in the district court for the Northern District of Georgia⁵⁰ against a Georgia state criminal statute providing that it is unlawful to knowingly:

transmit any data through a computer network . . . for the purpose of setting up, maintaining, operating, or exchanging data with an electronic mailbox, home page, or any other electronic information storage bank or point of access to electronic information if such data uses any individual name, trade name, registered trademark, logo, legal or official seal, or copyrighted symbol . . . which would falsely state or imply that such person . . . has permission or is legally authorized to use such trade name, registered trademark, logo, legal or official seal, or copyrighted symbol for such purpose when such permission or authorization has not been obtained⁵¹

Emphasizing that “[t]he critical linking feature is the defining characteristic of the Web,”⁵² the plaintiffs raised the following objections to the statute: it did not define the phrase “uses” or “to use”;⁵³ nor did it require, as did other federal and Georgia trademark and trade name statutes, “that the prohibited ‘use’ create any likelihood of confusion as to the identity of the user, nor that the use in any way dilute the value of a famous and distinctive mark, nor that the ‘use’ be in the context of a commercial transaction for the sale of goods and services”; and it did not require “that the user have any intent to deceive the public by this ‘use.’”⁵⁴

More specifically, the plaintiffs asserted that the statute provided no method to determine “whether a web page that provides a link to a page containing a registered trade name or logo is a prohibited ‘use’ of the logo under the Act.”⁵⁵ Nor did it define the phrase “falsely implies” to indicate “whether any particular ‘use’ of a trade name or logo in a web page would ‘falsely imply’ that the user had

50. ACLU’s Complaint, *ACLU* (No. 1:96-CV-2475-MHS). For ACLU filings and related court materials, see *Cyber-Liberties: Online Censorship Page* (visited Mar. 7, 1998) <<http://www.aclu.org/issues/cyber/censor.html>>. For Georgia’s filings and related court materials, see *Georgia’s Defense of Its Internet Fraud Statute* (visited Mar. 6, 1998) <<http://www.inteliview.com/fraudlaw.htm>>.

51. GA. CODE ANN. § 16-9-93.1(a) (1996). This Article does not examine the Complaint’s allegations against the statute’s restrictions on anonymous or pseudonymous online communication through barring the adoption of “any individual name, trade name, registered trademark, logo, legal or official seal, or copyrighted symbol to falsely identify the person, organization, or representative transmitting such data.” *Id.* In its Brief in Opposition to Plaintiffs’ Motion for Preliminary Injunction, the State asserted that “the present Georgia statute does not prohibit anonymity on the Internet.” Brief in Opposition to Plaintiffs’ Motion for Preliminary Injunction, Part I.B n.1, *ACLU v. Miller* (N.D. Ga. 1997) (No. 1:96-CV-2475-MHS).

52. ACLU’s Complaint at 8, *ACLU* (No. 1:96-CV-2475-MHS).

53. *Id.* at 12.

54. *Id.*

55. *Id.*

obtained prior permission to link to the owner's web page or to use the trade name or logo in some other way."⁵⁶ Such indeterminacy would clearly pose a challenge to many of the plaintiffs.⁵⁷ They argued that the statute violated their state constitutional rights to free expression, association, access to information, and privacy; was unconstitutionally overbroad and impermissibly vague; and imposed a burden on interstate commerce in violation of the United States Constitution.⁵⁸

To prevent the enforcement of the statute, the plaintiffs emphasized that its restriction on the use of trade names, logos, and affiliated marks

is *not* confined to commercial use of trade names[,] logos, etc., nor does the Act require intent to deceive or any actual deception

The Act's language is so broad, therefore, that it appears to prohibit even clearly noncommercial use of names and logos to provide links in web pages in the absence of express permission from the corporations, organizations, or agencies to whom the links lead. Many of the plaintiffs use trade names or logos in this manner to create links for noncommercial purposes, and in many cases their use of these trade names or logos occurs in the context of political speech, religious speech, news and commentary, and other public interest and educational expression. It would be practically impossible for plaintiffs and other web publishers to obtain permission for all the links in their web sites, and eliminating links would destroy the most useful and acclaimed feature of the World Wide Web.⁵⁹

In response, the State asserted that

[d]uring the legislative process, the sponsor of the Bill consistently explained that the Bill did not address, and was not intended to address, the links between web sites or the addresses that are set up on home pages or electronic mailboxes, but only to prevent people from misidentifying themselves or misrepresenting that their home page is the home page of

56. *Id.*

57. For example, "[t]he ACLU of Georgia's site provides a collection of links to other related Internet sites. . . . The ACLU did not obtain permission before linking to these sites, and it would be practically impossible to obtain such permission for each link." *Id.* at 13. Similarly, the complaint noted:

As a result of the Act's prohibition against using trade names, trademarks, logos, or legal or official seals without permission, the AIDS survival project [sic] feels its web page, composed of links to other organizations' web pages, may be in conflict with the law. Thus, the Act has caused the AIDS Survival Project to curtail its efforts to create its web page.

Id. at 14.

58. ACLU's Complaint at 25, *ACLU* (No. 1:96-CV-2475-MHS).

59. Brief in Support of Motion for Preliminary Injunction at 9 (citations omitted), *ACLU* (No. 1:96-CV-2475-MHS).

another person or organization when it is not.⁶⁰

The statute's legislative history indicated an intent only to prevent the owner of a web site from falsely identifying himself or his affiliations on his own site.⁶¹ The State claimed that it "was specifically explained by the sponsor and the proponents of the Bill during the floor debates that the Bill did not apply to mere hypertext links on the Internet."⁶² The State also attempted to clarify that the Act prohibits sites "which misidentify the person by . . . falsely stating or implying that the person has permission or is authorized to use the trade names and logos . . . when the person has no such permission or authorization"⁶³ but that

[t]he hypertext links commonly used on the World Wide Web are, without the injection of fraud or misrepresentation, merely references to the computer site and computer address of another person or entity on the Internet or Web. Without the injection of the knowing and intentional misappropriation of another's identity or identifying mark into such [a] situation, the statute poses no obstacle to innocent links.⁶⁴

60. Brief in Opposition to Plaintiff's Motion for Preliminary Injunction at 3, *ACLU* (No. 1:96-CV-2475-MHS).

61. *Id.* at 4.

62. *Id.* at 5. The state argues that: as thus construed, the Act was constitutional because false and misleading speech is not protected by the First Amendment; the Act applied only to nonexpressive, and thus unprotected, conduct; even if the Act did apply to protected speech, it is a constitutional time, place, or manner restriction; and it was narrowly tailored to effect the State's interest. *Id.* at 8-12.

63. *Id.* at 19.

64. *Id.* at 20. A number of affidavits were introduced by the State to support its limited interpretation of the Act's scope. For access to and a listing of all affidavits, see *Georgia's Defense of Its Internet Fraud Statute*, *supra* note 50. See Affidavit of Robert E. Keller para. 4, *ACLU* (No. 1:96-CV-2475-MHS) (District Attorney of Clayton Judicial Circuit) (stating that

As a Georgia criminal prosecutor, I do not see how any Georgia criminal prosecutor could reasonably read [the Act] to apply to . . . mere links between one person's computer page to that of another person, when there is no knowing false identification of oneself as another or misappropriation of another's identifying mark or symbol without permission or authority.);

Affidavit of Roy H. Watson, Jr. para. 5, *ACLU* (No. 1:96-CV-2475-MHS) (Representative to Georgia House of Representatives) (stating that in drafting and enacting the Act "[t]here was . . . no intent to prohibit mere links between different addresses on the Internet"); Affidavit of Robert Ray para. 5, *ACLU* (No. 1:96-CV-2475-MHS) (Representative to Georgia House of Representatives) (indicating that "during the Legislature's consideration of House Bill 1630, I understood the Bill only to seek to prevent fraudulent misidentification or misrepresentation on the Internet, and not to prevent pseudonyms or anonymous communications or links on a home page to other sites on the Internet"); Affidavit of Don Parsons para. 15, *ACLU* (No. 1:96-CV-2475-MHS) (Representative to Georgia House of Representatives) (recalling that

[d]uring the debate on the floor of the House of Representatives, and throughout the legislative process, I explicitly and consistently explained that House Bill 1630 . . . had nothing to do with links between web sites on the Internet, but only with someone misrepresenting that their home page is the home page of another person or organization when it was not);

Yet the plaintiffs seized on precisely this inconsistency in reiterating that the statute was unconstitutionally vague: “[n]either of these statements resolves the question of whether maintenance of a site on the World Wide Web that uses a trade name or logo to create a link to another site would be a violation of the Act because it ‘falsely implies’ permission to create the link or because it ‘misappropriat[es] another’s . . . identifying mark.’”⁶⁵

On June 20, 1997, the court granted a preliminary injunction enjoining the enforcement of the Act.⁶⁶ Agreeing with the plaintiffs that the statute as written was unconstitutionally overbroad and vague and that the State’s efforts to rehabilitate it were tangled, the court found that

even if the statute could constitutionally be used to prosecute persons who intentionally “falsely identify” themselves in order to deceive or defraud the public, or to persons whose commercial use of trade names and logos creates a substantial likelihood of confusion or the dilution of a famous mark, the statute is nevertheless overbroad because it operates unconstitutionally for a substantial category of the speakers it covers.⁶⁷

Furthermore, the court acknowledged that the State had offered divergent interpretations of the web-linking provision and noted that

[a] fair reading of the clause, as written, is that it prohibits the current use of web page links. The linking function requires publishers of web pages to include symbols designating other web pages which may be of interest to a user. This means that an entity or person’s seal may appear on hundreds or thousands of other web pages, just for the purpose of enabling the linking system. The appearance of the seal, although completely innocuous, would definitely “imply” to many users that permission for use had been obtained. Defendants have articulated no compelling state interest

Affidavit of James M. Skipper, Jr. para. 7, *ACLU* (No. 1:96-CV-2475-MHS), (Representative to Georgia House of Representatives) (indicating that “during the Legislature’s consideration of House Bill 1630, I understood the Bill only to seek to prevent fraudulent misidentification or misrepresentation on the Internet, and not to prevent pseudonyms or anonymous communications or links on a home page to other sites on the Internet”); Affidavit of Thomas E. Lawrence para. 6, *ACLU* (No. 1:96-CV-2475-MHS) (Representative to Georgia House of Representatives) (indicating that “[i]t was not, and is not, my understanding, that House Bill 1630 (Act 1029) prohibits . . . mere links between different addresses on the Internet, where there is no intentional misrepresentation of one’s self as someone else”).

65. Reply in Support of Motion for Preliminary Injunction at 9, *ACLU* (No. 1:96-CV-2475-MHS) (quoting the statute).

66. Order, *ACLU* (No. 1:96-CV-2475-MHS).

67. *Id.* at 4.

that would be furthered by restricting the linking function in this way.⁶⁸

On August 7, 1997, the court entered an order permanently enjoining the State from enforcing the Act.

Because the *Shetland Times* decision was handed down by a foreign court, the *Washington Post* litigation was settled, and the *Ticketmaster* case is currently pending (and might be settled), there is no direct precedent yet available to support an action by the owner of a site to which an unwelcomed link has been made. Moreover, the *Miller* decision suggests that legislation to protect site-owners from such links must be carefully drafted and will almost certainly be challenged as unconstitutional.

Parts III, IV, and V of this Article examine the ways in which a site-owner may ground an action against the linker in established precedent from the areas of copyright, trademark, and tort law, respectively.

III. THE COPYRIGHT MODEL

Under the United States Copyright Act⁶⁹ the owner of a copyrighted work has the following exclusive rights: to reproduce, and authorize reproductions of, the work;⁷⁰ prepare derivative works based upon the original work;⁷¹ distribute copies of the work to the public by sale or other transfer of ownership, or by rental, lease, or lending;⁷² and, "in the case of literary, musical, dramatic, and choreographic works," to perform or display the copyrighted work publicly.⁷³ A person who violates any of these exclusive rights has infringed the copyright⁷⁴ and is subject to legal action by the holder of the copyright⁷⁵ for direct or contributory⁷⁶

68. *Id.* at 4 n.5.

69. 17 U.S.C. §§ 101-1101 (1994).

70. *Id.* § 106(1).

71. *Id.* § 106(2). The Copyright Act defines a "derivative work" as a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work."

Id. § 101.

72. *Id.* § 106(3).

73. *Id.* § 106(4), (5).

74. *Id.* § 501(a).

75. 17 U.S.C. § 501(b) (1994).

76. *See Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 435 (1984) (indicating that

[t]he absence of such express language in the copyright statute does not preclude the imposition of liability for copyright infringement on certain parties who have not themselves engaged in the infringing activity. For vicarious liability is imposed in all areas of the law and the concept of contributory infringement is

infringement.

The plaintiff in a copyright infringement action must prove that the copied material is copyrightable, that he secured the copyright (for example, by producing a federal copyright registration certificate⁷⁷), and that the defendant has copied it.⁷⁸ Significantly, proving the defendant's knowledge or intent forms no part of the plaintiff's action for direct copyright infringement.⁷⁹

The "fair use" exception to copyright infringement allows the reproduction, distribution, and display of copyrighted material "for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research"⁸⁰ The test for fair use is fact-specific, but the Copyright Act directs courts to consider at least the following four factors in their evaluation:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.⁸¹

A. Infringement by Unauthorized Reproduction

Whether the defendant has in fact produced a copy of the plaintiff's work constitutes a central element in copyright infringement suits concerning digitized information such as software. Although the photocopying of written materials and duplication of audio or video recordings clearly satisfy this requirement, whether the reproduction of their digital equivalents does so is less clear.

The Copyright Act 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, reproduced, or otherwise communicated, either directly or with the

merely a species of the broader problem of identifying the circumstances in which it is just to hold one individual accountable for the actions of another.);

Gershwin Publ'g Corp. v. Columbia Artists Mgmt., Inc., 443 F.2d 1159, 1162 (2d Cir. 1971) (predicating contributory copyright liability on a finding that a party "with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another . . .") (footnote omitted); *Sega Enters. v. Maphia*, 948 F. Supp. 923, 932 (N.D. Cal. 1996) (observing that "[a]lthough the Copyright Act does not expressly impose liability on anyone other than direct infringers, courts have long recognized that in certain circumstances, liability for contributory infringement will be imposed. . . . Contributory copyright infringement stems from the notion that one who directly contributes to another's infringement should be held liable") (citation omitted).

77. See 17 U.S.C. § 410 (1994) (setting forth the registration and certification process).

78. See, e.g., *Norma Ribbon & Trimming, Inc. v. Little*, 51 F.3d 45, 47 (5th Cir. 1995) (stating the elements of infringement).

79. See 17 U.S.C. § 504 (1994).

80. *Id.* § 107.

81. *Id.*

aid of a machine or device.”⁸² For these purposes,

[a] work is “fixed” in a tangible medium of expression when its embodiment in a copy . . . is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is “fixed” for purposes of this title if a fixation of the work is being made simultaneously with its transmission.⁸³

There is no question that copyright law applies to the unauthorized reproduction through the Internet of material that originally appeared in another medium. An early decision in this area, *Religious Technology Center v. Lerma*,⁸⁴ found the defendant liable for copyright infringement for posting various portions of the copyrighted spiritual writings of higher levels of the Scientology practice on the Internet.⁸⁵ The court stated:

The law of copyright has evolved with technological change, with each new technological advancement creating complicated questions of copyright interpretation and application. Nevertheless, the new technologies—from television, to video cassette recorders, to digitized transmissions—have been made to fit within the overall scheme of copyright law and to serve the ends which copyright was intended to promote. The Internet is no exception, and postings on it must be judged in reference to the already flexible considerations which fair use affords.⁸⁶

Moreover, the Ninth Circuit has held that “a ‘copying’ for purposes of copyright law occurs when a computer program is transferred from a permanent storage device to a computer’s RAM”⁸⁷ (Random Access Memory), even though such memory is “fixed” only temporarily and vanishes when the computer’s power is turned off.⁸⁸ Thus, the court found that copyright infringement occurred when

82. *Id.* § 101.

83. *Id.*

84. No. 95-1107-A, 1996 WL 633131 (E.D. Va. 1996).

85. *Id.* at *15.

86. *Id.* at *4 (citations omitted). However, this decision did not address the specifics of the infringement, such as the form of dissemination. Lerma apparently did not put the material on his own web site but instead supplied it to various public news groups on the Internet. *Id.* at *10. In addition, although Lerma’s Internet service provider was originally named as a defendant on grounds of copyright infringement, the plaintiff voluntarily dismissed its claim against that entity. *Id.* at *2.

87. *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 518 (9th Cir. 1993); see also *In re Indep. Serv. Org. Antitrust Litig.*, 910 F. Supp. 1537, 1541 (D. Kan. 1995) (agreeing with the court’s holding in *MAI Sys. Corp.*); *Advanced Computer Serv. of Michigan, Inc. v. MAI Sys. Corp.*, 845 F. Supp. 356, 363-64 (E.D. Va. 1994) (following the decision in *MAI Sys. Corp.*).

88. *MAI Sys. Corp.*, 991 F.2d at 519 (“RAM can be simply defined as a computer component in which data and computer programs can be temporarily recorded. . . . It is a property of RAM that when

service technicians, who were not authorized to use MAI's diagnostic software products, caused those programs to be transferred into the RAM of their customers' computers by the simple process of turning on those computers.⁸⁹

Does the linking of one site to another similarly produce a copy that would give rise to a copyright action against an unauthorized linker for creating an unauthorized copy or reproduction of material on the target site? In this context, two sets of copyright decisions are instructive: those concerning copyright infringement actions brought against the owners of computerized "bulletin boards" and those brought against the owners of web sites.

1. *Infringement Through Bulletin Boards*

The first wave of copyright cases concerning the Internet involved bulletin board services (BBS)⁹⁰ that enabled their users to obtain pirated digital copies of video games or erotic images.⁹¹ Beyond reinforcing the general applicability of copyright law to the Internet, the following decisions focus on the operator's control over his BBS and the applicability of its contents to web-linking. In particular, site owners should note the absence of any scienter requirement for a finding of direct infringement.

In *Playboy Enterprises, Inc. v. Frena*,⁹² Frena, the defendant operator of a BBS, made his computer available to paying subscribers who electronically connected their computers to his through a modem to "upload" (store) and "download" (retrieve) digitized information.⁹³ Exact or near-exact copies of various photographic images whose copyright was held by Playboy had been posted on the service. Frena denied furnishing these materials and attributed their presence to his subscribers.⁹⁴ The court found, nonetheless, that the defendant had infringed

the computer is turned off, the copy of the program recorded in RAM is lost." (quoting *Apple Computer Inc. v. Formula Int'l, Inc.*, 594 F. Supp. 617, 622 (C.D. Cal. 1984))).

89. *MAI Sys. Corp.*, 991 F.2d at 518; see also *Advanced Computer Serv.*, 845 F. Supp. at 360 (observing that "[l]oading" or "booting" the software entails a transfer of the software program from a storage device such as a hard disk or floppy disk into the random access memory ("RAM") of the computer").

90. See Niva Elkin-Koren, *Copyright Law and Social Dialogue on the Information Superhighway: The Case Against Copyright Liability of Bulletin Board Operators*, 13 CARDOZO ARTS & ENT. L.J. 345, 347 n.5 (1995) (defining "bulletin board system" as "an on-line service that allows users to exchange messages, texts, computer programs, photographs, music, and other forms of information by uploading materials from the user's computer to the system and by downloading materials from the BBS to his own computer").

91. *Id.* at 347.

92. 839 F.Supp. 1552 (M.D. Fla. 1993).

93. *Id.* at 1554.

94. *Id.* Nonetheless, many of the files were identified with the registered trademarks "Playboy" and "Playmate," and their contents marked with Frena's name and telephone number of his BBS. See *infra* note 189 and accompanying text.

Playboy's exclusive right to display and distribute these images.⁹⁵

There is irrefutable evidence of direct copyright infringement in this case. It does not matter that Defendant Frena may have been unaware of the copyright infringement. Intent to infringe is not needed to find copyright infringement. Intent or knowledge is not an element of infringement, and thus even an innocent infringer is liable for infringement; rather, innocence is significant to a trial court when it fixes statutory damages, which is a remedy equitable in nature.⁹⁶

Frena could not avail himself of the fair use exception to infringement because he had made the material on the bulletin board available for a commercial purpose; the images were deemed works of "fiction and fantasy" and thus less susceptible to the fair use exception than those of fact; the images were an essential part of the published version of *Playboy* magazine; and their online distribution would affect the market for Playboy's printed version.⁹⁷

Nor did defendants' greater involvement in *Playboy Enterprises, Inc. v. Russ Hardenburgh, Inc.*⁹⁸ insulate them from liability. The operators of this board awarded increased downloading privileges to subscribers who uploaded electronic information, and also had employees review these "new files to ascertain whether they were 'acceptable,' meaning, not pornographic, and not blatantly protected by copyright."⁹⁹ The court found that

[t]hese two facts transform Defendants from passive providers of a space in which infringing activities happened to occur to active participants in the process of copyright infringement. . . . It is inconsistent [for them] to argue that one may actively encourage and control the uploading and dissemination of adult files, but cannot [be] held liable for copyright violations because it is too difficult to determine which files infringe upon someone else's copyrights.¹⁰⁰

95. *Id.* at 1556-57. Not only was Frena's direct responsibility for making the copies irrelevant to the question of whether or not he had infringed Playboy's copyright by distributing the images, but the court's examination of the Copyright Act's legislative history revealed that "[t]he display right precludes unauthorized transmission of the display from one place to another, for example, by a computer system." *Id.* at 1557. Frena was also found to have infringed Playboy's right to reproduce these images: "There is no dispute that Defendant Frena supplied a product containing unauthorized copies of a copyrighted work. It does not matter that Defendant Frena claims he did not make the copies himself [*sic*]." *Id.* at 1556.

96. *Id.* at 1559.

97. *Id.* at 1557-58.

98. 982 F. Supp. 503 (N.D. Ohio 1997).

99. *Id.* at 506.

100. *Id.* at 513.

The defendants' encouragement of uploading, and their "constructive knowledge that infringing activity was likely to be occurring on their BBS," served as the basis for their liability for contributory infringement.¹⁰¹

In *Sega Enterprises, Ltd. v. Maphia*¹⁰² subscribers to defendants' BBS could download unauthorized copies of Sega's video games.¹⁰³ While the court acknowledged that the defendants' participation initially appeared insubstantial because he did not upload or download the files, or directly cause such uploading or downloading to occur,¹⁰⁴ the court concluded: "[the defendant's] role in copying, including providing facilities, direction, knowledge, encouragement, and seeking profit, amounts to a *prima facie* case of contributory copyright infringement."¹⁰⁵ As in *Frena*, the scope, purpose, and effects of the unauthorized copying precluded a fair use argument by the defendants: they had intended to allow others to make copies rather than buy authorized ones, and thereby to deprive Sega of a profit.¹⁰⁶ Moreover, the video game programs were "for entertainment uses and involve fiction and fantasy," thereby tilting the scale against the success of a fair use defense.¹⁰⁷ Finally, the BBS allowed the copying of entire programs.¹⁰⁸

The result might be different if the operator of the BBS does not encourage the uploading and downloading of copyrighted material by subscribers, or review or edit such material. For example, in *Religious Technology Center v. Netcom Online Communication Services, Inc.*¹⁰⁹ a group holding copyrights in various material related to the spiritual teachings of Scientology sued the operator of a BBS and the Internet service provider of the BBS for allowing a BBS subscriber to upload some of these works.¹¹⁰ The court acknowledged that

101. *Id.* at 514.

102. 948 F. Supp. 923 (N.D. Cal. 1994).

103. *Id.* at 927.

104. *Id.* at 932.

105. *Id.* at 933.

106. *Id.* at 934.

107. *Id.*

108. *Maphia*, 948 F. Supp. at 935.

109. 907 F. Supp. 1361 (N.D. Cal. 1995).

110. *Id.* at 1365-66. Specifically, the court found that

Erlich [the subscriber] connects to Klemesrud's BBS using a telephone and a modem. Erlich then transmits his messages to Klemesrud's computer, where they are automatically briefly stored. According to a prearranged pattern established by Netcom's software, Erlich's initial act of posting a message to the Usenet results in the automatic copying of Erlich's message from Klemesrud's computer onto Netcom's computer and onto other computers on the Usenet. In order to ease transmission and for the convenience of Usenet users, Usenet servers maintain postings from news groups for a short period of time—eleven days for Netcom's system and three days for Klemesrud's system. Once on Netcom's computers, messages are available to Netcom's customers and Usenet neighbors, who may then download the messages to their own computers. Netcom's local server makes available its postings to a group of Usenet servers, which do the same for other servers until all Usenet sites worldwide have obtained access to the postings,

there is no question after *MAI* that “copies” were created, as [the subscriber’s] act of sending a message to [the BBS] caused reproductions of portions of plaintiffs’ works on both [the BBS operator’s] and [the Internet service provider’s] storage devices. Even though the messages remained on their systems for at most eleven days, they were sufficiently “fixed” to constitute recognizable copies under the Copyright Act.¹¹¹

Yet the court found that the Internet service provider had not caused the copying because neither the Internet service provider nor the BBS operation had initiated the copying, but instead both had been configured to make temporary copies of any information contributed by a user.¹¹² Thus, the court held that “the storage on a defendant’s system of infringing copies and retransmission to other servers is not a direct infringement by the BBS operator of the exclusive right to *reproduce* the work where such copies are uploaded by an infringing user.”¹¹³

To the extent that these decisions address the liability of a BBS operator for direct or contributory copyright infringement, they appear less relevant to owners of web sites who generally maintain control over the site’s content and links. However, one could argue that a site owner is the equivalent of a BBS operator in circumstances where the site links to an infringing site or perhaps even to a site that itself is linked to an infringing site. Just as the BBS operator can be charged with a contributory copyright violation by making available material that the operator did not personally investigate, so could the site owner be held liable.

2. *Infringement Through Web Sites*

As of February 1, 1997, only two reported decisions had dealt with copyright infringement by a web site owner.¹¹⁴ Although both courts looked to the BBS cases for guidance, neither of the decisions directly addressed infringement caused by an unauthorized link. Yet they provide initial clarification of two related issues: whether a web site operator infringes copyrights by posting material on a site; and

which takes a matter of hours.

Id. at 1367-68.

111. *Id.* at 1368.

112. *Id.* (footnote omitted).

The court believes that [the Internet provider’s] act of designing or implementing a system that automatically and uniformly creates temporary copies of all data sent through it is not unlike that of the owner of a copying machine who lets the public make copies with it. Although some of the people using the machine may directly infringe copyrights, courts analyze the machine owner’s liability under the rubric of contributory infringement, not direct infringement.

Id. at 1369.

113. *Id.* at 1371.

114. *Marobie-FL, Inc. v. Nat’l Ass’n of Fire Equip. Distribs.*, 983 F. Supp. 1167 (N.D. Ill. 1997); *Playboy Enters., Inc. v. Webbworld, Inc.*, 968 F. Supp. 1171 (N.D. Tex. 1997).

whether the technology underlying web-linking results in the transmission of a "copy" of digital material.

a. Infringement Through Web-Site Posting

In *Playboy Enterprises, Inc. v. Webbworld, Inc.*,¹¹⁵ a blend of the *Frena* and *Religious Technology Center* decisions, Playboy sued for copyright infringement the operator of a web site that allowed subscribers to view adult images for a monthly subscription fee.¹¹⁶ As in *Frena*, the images were undisputed copies of those found in Playboy's magazines.¹¹⁷ However, the court distinguished the function of the web site owner from that of the Internet service provider in *Religious Technology Center* who was paid to provide Internet access.¹¹⁸ The site owner in this case was not a mere conduit for information but instead the selector and provider of adult images. The court stated:

[The site owner] surely has control over the images it chooses to sell on the Neptics' website. Even the absence of the ability to exercise such control, however, is no defense to liability. If a business cannot be operated within the bounds of the Copyright Act, then perhaps the question of its legitimate existence needs to be addressed.¹¹⁹

Accordingly, the court granted partial summary judgment for the plaintiffs.¹²⁰

b. Web-Linking Involves Copying

In *Marobie-FL, Inc. v. National Association of Fire Equipment Distributors*,¹²¹ Marobie alleged that the National Association of Fire Equipment Distributors (NAFED) had made available through its web site files of copyrighted and digitized "clip art" developed by Marobie for use by people in the fire service industry.¹²² In

115. 968 F. Supp. 1171 (N.D. Tex. 1997).

116. *Id.* at 1173.

117. *Id.*

118. *Id.* at 1175.

119. *Id.*

120. *Id.* at 1177.

121. 983 F. Supp. 1167 (N.D. Ill. 1997). Marobie also sued Northwest Nexus, Inc., NAFED's Web service provider. The court observed that:

Pursuant to a contract between NAFED and Northwest, Northwest provided a host computer for NAFED's Web Page and the access link or connection of NAFED's Web Page to Web users. Earl E. Robisheaux ("Robisheaux"), the administrator of NAFED's Web Page, placed certain files on the Northwest computer for NAFED's Web page. Once placed on Northwest's computer for NAFED's Web page, the files were available to be downloaded by Web users.

Id. at 1171.

122. *Id.*

support of its direct infringement claim against NAFED, Marobie alleged that one of NAFED's agents had obtained a copy of the clip art and had transferred that material first to his hard drive and then, through the Internet, to Northwest's hard drive to become part of NAFED's web site.¹²³

Citing *Frena* and *Maphia*, the court found that these actions by NAFED directly infringed Marobie's exclusive right to reproduce the material¹²⁴ as well as its right to publicly distribute it.¹²⁵ The court, in weighing the relevant factors, rejected NAFED's claim of fair use for the following reasons: NAFED derived commercial benefit (through promoting itself and attracting advertising revenue) rather than critical or scholarly benefit from this infringement; the clip art was a creative rather than a factual work; NAFED had copied in their entirety three of five separate clip art volumes available; and the duplication would have an adverse effect on the market for such clip art.¹²⁶

In suing Northwest for direct and contributory copyright infringement, Marobie insisted that Northwest had itself made copies of the clip art and had allowed users to do the same:

When an Internet user requests a file that is posted on NAFED's Web Page, Northwest's computer sends the information in the requested file to the user's local computer or Internet address. This process is known as "downloading" a file. The files on NAFED's Web Page are stored in the hard drive of Northwest's computer. According to Northwest, when the information in a requested file is sent to an Internet user, the information passes in electronic form through the Random Access Memory (RAM) of [Northwest's] computer. Plaintiff claims that Northwest directly infringed its copyrights each time an Internet user downloaded one or more of the files containing plaintiff's clip art because, each time, Northwest's computer "copied" the files from its hard drive to its RAM.¹²⁷

As the court observed, Northwest acknowledged that its computer automatically copies the desired file when requested by an Internet user. This copy, located in the RAM of Northwest's computer, is transmitted to the Internet user.¹²⁸ However, Northwest argued that because the RAM copy was not "fixed" it did not constitute a copy for purposes of the Copyright Act.¹²⁹

123. *Id.* at 1173.

124. *Id.*

125. *Id.*

126. *Id.* at 1175-76.

127. *Marobie-FL*, 983 F. Supp. at 1172.

128. *Id.* at 1177

129. *Id.* "Northwest argues that [the copy] is not 'fixed' because the information is transmitted 'through' RAM and over the Internet at high speed in the electronic form of bytes. According to Northwest, this process of duplication and transmission happens so quickly that 'typically only a portion of a file is in RAM at any one time.'" *Id.*

Citing the *Religious Technology Center* decision, the court found that the copy of the clip art files in Northwest's RAM constituted "copying" for purposes of the Copyright Act.¹³⁰ For these purposes, whether the information in this file was transmitted in pieces that were assembled at the requester's Internet address or whether, as in *Religious Technology Center* and *MAI*, all of the information remained in the defendant's RAM at one time was immaterial. "The fact that a copy is transmitted after it is created, or even as it is created, does not change the fact that once an Internet user receives a copy, it is capable of being perceived and thus 'fixed.'"¹³¹ Yet the court determined that, like the Internet service provider in *Religious Technology Center*, Northwest had

only provided the means to copy, distribute or display plaintiff's works, much like the owner of a public copying machine used by a third party to copy protected material. Like a copying machine owner, Northwest did not actually engage in any of these activities itself. Accordingly, Northwest may not be held liable for direct infringement.¹³²

Nor would the court grant Marobie summary judgment against Northwest for contributory infringement because it was unclear whether and when Northwest was aware that NAFED was infringing copyrighted material.¹³³

Like the *Webbworld* decision, *Marobie* offers little comfort to site owners who knowingly deposit infringing material onto their sites. More significantly, though, *Marobie*'s discussion of transmission of materials accessible through a web site's link raises the following question: If, by clicking on a link on the *linking* site, a visitor to that site triggers the transmission of information *directly from the target site's computer* to the visitor, can the target site claim the *linking* site itself created an infringing copy of the target site's information?

The owners of the linking site could argue that in this situation they are less subject to liability than the Internet service providers in the *Religious Technology Center* and *Marobie* decisions. If those intermediate parties could be compared to the blameless operators of photocopying machines, the owner of a linking site can be characterized as merely directing people to information that other people had made available for photocopying by any interested person. This argument rests on the premise that the owner of a web site grants the entire world an implied license¹³⁴ to link to it (or, in the copy-shop metaphor, to those who would like to photocopy it). If successful, this argument would appear to clear linkers from any liability for

130. *Id.* at 1178.

131. *Id.*

132. *Id.*

133. *Marobie-FL*, 983 F. Supp. at 1178-79.

134. Few would argue that the material placed on a web site is, by virtue of its being in this medium, automatically thereby deemed in the "public domain" and thereby subject to no copyright protection.

infringement of the target site owner's copyrights to "distribute" and to "publicly perform" the material on the target site.

3. *The Implied License Defense*

Does the owner of a web site grant an implied license to link?

One commentator has characterized the concept of an implied license as "rather amorphous under copyright law. At its heart, an implied license is an estoppel doctrine, arising because the infringing party detrimentally and justifiably relied on the intellectual property owner's actions."¹³⁵ But in one of the leading cases on implied licenses, *Effects Associates, Inc. v. Cohen*,¹³⁶ the Ninth Circuit disagreed, finding that a party had "cite[d] no authority for the proposition that an implied license is equitable in nature; it seems to us to be a creature of law, much like any other implied-in-fact contract."¹³⁷

The "implied-in-fact" contract would generally not seem to arise between strangers. In the handful of reported cases on implied licenses, the parties asserting an implied license each had been directly involved in commercial transactions with the plaintiffs. To this extent, a site owner's assertion of an implied license to link to any other site on the World Wide Web conceivably is a claim of a "drive-by implied license" and thus even more tenuous.

For instance, in *Effects Associates* the court observed that although the Copyright Act generally requires a "transfer of copyright ownership" to be in writing,¹³⁸ nonexclusive licenses are specifically exempted from the definition of such transfers.¹³⁹ The court also noted an authoritative treatise's recognition that "nonexclusive licenses may . . . be granted orally, or may even be implied from conduct."¹⁴⁰ Thus, the court held that a special effects company that delivered specially commissioned footage to a film maker without also supplying a written license or assignment had granted an implied nonexclusive license to the film maker to use the footage. To hold otherwise would have implied that the company's "contribution to the film was 'of minimal value,' a conclusion that can't be squared with the fact that [the film maker] paid [the defendant] almost \$56,000 for this footage."¹⁴¹

135. See Eric Schlachter, *The Intellectual Property Renaissance in Cyberspace: Why Copyright Law Could Be Unimportant on the Internet*, 12 BERKELEY TECH. L.J. 15, 46 n.104 (1997).

136. 908 F.2d 555 (9th Cir. 1990).

137. *Id.* at 559 n.7.

138. *Id.* at 556 (citing 17 U.S.C. § 204(a) (1988)).

139. See 17 U.S.C. § 101 (1994).

140. *Effects Assocs.*, 908 F.2d at 558 (quoting 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 10.03[A], at 10-36 (1989)).

141. *Id.* at 559. The court held that its ruling was controlled by *Oddo v. Ries*, 743 F.2d 630 (9th Cir. 1984). *Effects Assocs.*, 908 F.2d at 558. In *Oddo* the court held that by preparing and handing over to Oddo's business partner, Ries, a manuscript intended for publication that, if published, would infringe on Oddo's copyright in the material, Oddo "impliedly gave the partnership a license to use . . .

The *Effects Associates* court, emphasizing the simplicity of the writing required to transfer copyright,¹⁴² rejected the film maker's argument that his industry should not be bound by this requirement, an assertion that Judge Kozinski "summarized, tongue in cheek, as: Moviemakers do lunch, not contracts."¹⁴³ A similar reception might well be afforded to the owner of a web site who claims that such formalities could be dispensed with in the freewheeling culture of the Internet. A court faced with a defense of implied license to a copyright infringement claim would likely look to the following "several objective factors" identified by the Ninth Circuit to determine such a license's existence and extent: "the language of the copyright registration certificate; the letter agreement [between the parties], and deposition testimony; and the delivery of the copyrighted material without warning that its further use would constitute copyright infringement."¹⁴⁴

In this regard, an implied license "arises out of the objective conduct of the parties, which a reasonable man would regard as indicating that an agreement has been reached."¹⁴⁵ Or, in the words of another court, "[t]he creation of an implied license, as in the creation of any implied contract, requires a meeting of the minds."¹⁴⁶ One commentator, though, has suggested that "an author's decision to

the manuscript, for without such a license, Oddo's contribution to the partnership venture would have been of minimal value." *Oddo*, 743 F.2d at 634.

142. *Effects Assocs.*, 908 F.2d at 557 (indicating that "Section 204's writing requirement is not unduly burdensome; it necessitates neither protracted negotiations nor substantial expense. . . . [The writing] doesn't have to be the Magna Charta; a one-line pro forma statement will do").

143. *Id.* at 556.

144. *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 776 (7th Cir. 1996) (emphasis added); see, e.g., *MacLean Assocs., Inc. v. Wm. M. Mercer-Meidinger-Hansen, Inc.*, 952 F.2d 769, 779 (3d Cir. 1991) (inferring from circumstances not only the existence but the scope of a license: "The record does not anywhere indicate that Mr. MacLean gave Mercer the type of broad, nonexclusive license that Mercer would have needed to protect, against Mr. MacLean's copyright infringement claims, its act of incorporating [his software program] into [their own competing] program"); *Gracen v. Bradford Exch.*, 698 F.2d 300, 303 (7th Cir. 1983) (finding a genuine issue of material fact concerning whether a movie studio's invitation to an artist to enter a competition for the best painting, modeled on the studio's photographs, of Judy Garland's Dorothy in *The Wizard of Oz* constituted the grant of an implied license to the artist to create and exhibit a derivative work); *Irwin v. American Interactive Media, Inc.*, 31 U.S.P.Q.2d 1366, 1369 (C.D. Cal. 1994) (finding that, under the *Effects* criteria, plaintiff's creation for and delivery to defendant of an "underscore" soundtrack for defendant's promotional video created an implied nonexclusive license to use the underscore in the video); *Key Maps, Inc. v. Pruitt*, 470 F. Supp. 33, 39 (S.D. Tex. 1978) (concluding from the circumstances that a map maker gave a county fire marshal an implied license to reproduce a copyrighted map of the county for the limited purpose of making a Fire Zone Map).

145. *Allen-Myland v. IBM Corp.*, 746 F. Supp. 520, 549 (E.D. Pa. 1990) (quoting *Medeco Sec. Locks, Inc. v. Lock Tech. Corp.*, 199 U.S.P.Q. 519, 524 (S.D.N.Y. 1976)); see, e.g., *Johnson v. Jones*, 921 F. Supp. 1573, 1584 (E.D. Mich. 1996) (indicating that "a determination of whether the parties' conduct created an implied license requires an examination of the intent of the parties" and determining that the language of the contracts at issue clearly established no such intent).

146. *N.A.D.A. Servs. Corp. v. Business Data of Va., Inc.*, 651 F. Supp. 44, 49 (E.D. Va. 1986); see e.g., *Foreign Car Parts, Inc. v. Auto World, Inc.*, 366 F. Supp. 977, 980 (M.D. Pa. 1973) (rejecting implied license defense where "the conduct of the Plaintiff in this case indicates that it specifically withheld from Defendant permission to use [Plaintiff's copyrighted] brochures").

make a work of authorship available on a Web site likely would be an influential factor in evaluating whether some implied licenses were thereby granted to users accessing the work via the World Wide Web.”¹⁴⁷ Nonetheless, the commentator acknowledges that “it may be more difficult to determine whether, based on all of the facts and circumstances, a broader license should be implied, such as a license permitting . . . copies to be . . . distributed to third parties.”¹⁴⁸

Indeed, the following three factors militate against an implied license for links: (1) the target site owner’s not preparing the site’s material specifically for the owner of the linking site; (2) the absence of a “meeting of the minds” between the owners of the linking and target sites; and (3) the absence of payment offered to the target site’s owner by the owner of the linking site. In fact, by creating a link to a specific page or pages of the target site, the linking site may actually, as in the cases discussed in Part II, be *depriving* the target site of revenue from advertisements on the target site that visitors from the linking site can now bypass.

Although a number of sites have attempted to negate any implied license by inserting explicit language into the “Terms of Use” pages of their sites, the relative inconspicuousness of many of these disclaimers may render them unenforceable.¹⁴⁹ Moreover, given the relatively short attention span of web surfers, from a marketing standpoint site designers may be reluctant to implement “Web-wrap” agreements, which force the viewer to view screens containing various legal terms and to agree to such terms by clicking the mouse or typing “I agree” before proceeding further into the site.¹⁵⁰ A more efficient means of attempting to negate an implied license is offered in Part VI of this Article.

B. Infringement by Unauthorized Creation of Derivative Works and the Fair Use Defense

Could the owner of the target site argue that by linking to his site the owner of the linking site had created an infringing derivative work?¹⁵¹ In a number of recent decisions, courts have diverged on the standard for identifying a derivative work,

147. Allen R. Grogan, *Implied Licensing Issues in the Online World*, THE COMPUTER LAW., Aug. 1997, at 6, available in LEXIS, Computer/Communication News Library, Current File.

148. *Id.*

149. See generally *id.* at 7 (querying “[t]o be effective, should such legends appear prominently at the top of the Web page, rather than (as is often the case) at the bottom of the Web page, ‘below the fold,’ so that a user has to scroll down through the entire page before encountering such a legend, which often appears in a tiny type size?”). For a detailed examination of the implications of the inconspicuousness of legal terms even on such relatively sophisticated commercial web sites as those of Fortune 500 companies, see Effross, *supra* note 1.

150. Grogan, *supra* note 147, at 8; see also Effross, *supra* note 1 (exploring the competing considerations of retaining site visitors and enforcing legal terms).

151. See *Wojnarowicz v. American Family Ass’n*, 745 F. Supp. 130, 142 (S.D.N.Y. 1990) (holding that “[b]y editing or cropping plaintiff’s artworks and presenting the unauthorized modified version, defendants have . . . violated plaintiff’s exclusive right to prepare derivative works”).

especially with regard to the definition of such a work as taking “any other form in which [the original] work may be recast, transformed or adapted.”¹⁵²

These decisions concern whether derivative (and thereby infringing) works are created by a party that has incorporated another’s copyrighted work into a different physical framework. The Ninth Circuit, determining that “the language ‘recast, transformed, or adapted’ seems to encompass other alternatives besides simple art reproduction,”¹⁵³ held that “[by] borrowing and mounting [on a tile the plaintiff’s] preexisting, copyrighted individual art images without the consent of the copyright proprietors . . . appellant has prepared a derivative work and infringed the subject copyrights.”¹⁵⁴

In similar circumstances, two district courts in the Ninth Circuit followed this approach.¹⁵⁵ The first court emphasized that

[p]lacing a print or painting in a frame and covering it with glass does not recast or transform the work of art. It is commonly understood that this amounts to only a method of display. Moreover, it is a relatively simple matter to remove the print or painting and display it differently if the owner chooses to do so. Neither of these things is true of the art work affixed to a ceramic tile.¹⁵⁶

Nonetheless, the second district court found that a derivative work had been created even when the defendants had only matted and framed the plaintiff’s art prints.¹⁵⁷

In resolving another case involving the same defendant’s practice of mounting copyrighted works on tiles, the Seventh Circuit rejected the Ninth Circuit’s

152. 17 U.S.C. § 101 (1994).

153. *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341, 1344 (9th Cir. 1988).

154. *Id.* at 1343. The appellant bought artwork prints or books and glued individual pages or images onto a mat of black plastic to provide a backing and a narrow margin. Then, the appellant glued the black sheet onto a rectangular white ceramic tile, applied a transparent film over the print, black sheet, and ceramic tile surface, and sold the finished product in the retail market. *Id.* at 1342.

155. *Greenwich Workshop, Inc. v. Timber Creations, Inc.*, 932 F. Supp. 1210, 1215 (C.D. Cal. 1996) (holding that “defendants’ matted and framed bookplates do infringe plaintiff’s copyrights in both the artwork [featured in plaintiff’s book] and the book [itself]”); *Munoz v. Albuquerque A.R.T. Co.*, 829 F. Supp. 309, 314 (D. Alaska 1993), *aff’d*, 38 F.3d 1218 (9th Cir. 1994) (observing that in a situation involving defendant’s placing plaintiff’s copyrighted notecards on ceramic tiles and covering them with a transparent layer of acrylic or epoxy, under *Mirage Editions* the defendant’s “process of transferring art images to tiles does constitute the creation of a derivative work of art in violation of the copyright laws”).

156. *Munoz*, 829 F. Supp. at 314. In its affirmance, the Ninth Circuit stated that “A.R.T.’s position ignores the distinction drawn in this circuit between conventional framing and A.R.T.’s ceramic tiling process which the district court properly held to constitute a derivative work.” *Munoz*, No. 93-35743, 1994 WL 574156, at *2 (9th Cir. Oct. 19, 1994).

157. *Greenwich Workshop*, 932 F. Supp. at 1215 (observing that “[d]efendants’ infringement is particularly evident in the context of the copyrighted book, which defendants have clearly ‘recast’ and ‘transformed’ by physically removing the pages and adapting them into works of art to hang on the wall”).

approach in *Lee v. A.R.T. Co.*¹⁵⁸ Writing for the court, Judge Easterbrook affirmed the district court's conclusion that the defendant's mounting of the plaintiff's artworks on tile did not constitute an "original work of authorship" but instead was comparable to placing a frame on a painting or putting a medallion in a velvet case.¹⁵⁹ If framing or casing does not create a derivative work, then neither should mounting, much less using epoxy resin in binding the original work to its mounting.¹⁶⁰ To the Seventh Circuit, the Ninth Circuit's test implies that "any alternation of a work, however slight, requires the author's permission" and thereby establishes "through the back door an extraordinarily broad version of authors' moral rights."¹⁶¹

If one site provides links to a page or pages of another without any framing, such as that found in *Shetland Times*, a strong argument can be made that the target site's information has not been recast, transformed, or adapted and thus that the linked site has not created an infringing derivative work.¹⁶² However, if framing is involved, the argument for infringement under this standard grows much stronger because the linking site has transplanted information from the framing site into the context of the linking site. Distinguishing digital from nondigital framing is the fact that a framed page from the target site is not only surrounded on the visitor's computer screen with information supplied by the linking site but also is figuratively surrounded, from the navigational point of view of a web surfer, by the remainder of the linking site as well as by any other material to which the frame or the rest of

158. 125 F.3d 580 (7th Cir. 1997).

159. *Id.* at 581.

160. *Id.* (noting that "[o]ur district judge thought this a distinction without a difference, and we agree" and that "the ninth circuit erred in assuming that normal means of mounting and displaying art are easily reversible"); see *Lee v. Deck the Walls, Inc.*, 925 F. Supp. 576, 579-80 (N.D. Ill. 1996) (finding the *Munoz* court's "proffered distinctions between framed art and 'tiled art' unconvincing and without support [because b]oth framing and tiling utilize the same works purchased from the copyright holder and do not involve 'copying' as defined by the Copyright Act"). In *Deck the Walls*, as support for its position the district court cited one of the leading treatises on copyright, which attacked the *Mirage* court's decision by noting that "choosing ceramic rather than cardboard as the backing material should scarcely be construed as a 'meaningful' variation in the eyes of the Copyright Act" and the *Munoz* court's opinion by observing that even if framing were only a matter of display and very simple to accomplish, "the question remains unanswered how tile-mounting creates a meaningful variation that itself could support copyright protection." *Deck the Walls*, 925 F. Supp. at 579-80 n.2 (quoting 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 3.03, at 3-13 (1997)); see also *Precious Moments, Inc. v. La Infantil, Inc.*, 971 F. Supp. 66, 69 (D.P.R. 1997) (following the *Deck the Walls* court's rejection of "*Mirage* and the subsequent cases [as reading] the originality requirement out of the definition of 'derivative work' and open[ing] the door for the most trivial of modifications to generate an infringing derivative work").

161. *Lee*, 125 F.3d. at 582.

162. *E.g.*, *Paramount Pictures Corp. v. Video Broad. Sys., Inc.*, 724 F. Supp. 808, 821 (D. Kan. 1989) (rejecting a copyright infringement claim of a motion picture producer against a company which placed advertisements at the beginning of videotapes rented by consumers, and concluding that "[w]hile defendants' advertisement is an original work, the court does not recognize the addition of it to a videocassette in any way recasting, transforming, or adapting the motion picture. The result is not a new version of the motion picture").

the linking site is linked. Even if the linking site is found to have created an infringing derivative work by framing or otherwise incorporating material from the target site, it may be able to raise a "fair use" defense under § 107 of the Copyright Act.¹⁶³

Litigation in this area will undoubtedly raise analogies to the controversy over "digital sampling," a method by which recording artists use specialized equipment and computer programs to record sounds in digitized form, alter them, and mix them with sounds from other sources.¹⁶⁴ Although this procedure can be applied in relatively benign ways—for example, to "polish" the sounds of participants in a recording—three reported decisions and numerous law review articles have addressed its application to the more controversial practice of incorporating into new songs sound clips, riffs, or "hooks" from established hit recordings.¹⁶⁵

When compared to sampling cases, though, the extent of the alleged infringement through web-linking would probably be easier to determine. The links themselves would indicate the source of the copyright infringement claim, and would make it fairly easy to derive a measurement for the third fair use factor: "the amount and substantiality of the portion [of the plaintiff's copyrighted work] used

163. See 17 U.S.C. § 107 (1994); e.g., *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429, 1434 (6th Cir. 1992) (indicating that § 107 of the Copyright Act "takes from a copyright owner the exclusive rights to his work insofar as a derivative, or allegedly infringing work, is a 'fair use' of the copyrighted work").

164. See generally Robert M. Szymanski, *Audio Pastiche: Digital Sampling, Intermediate Copying, Fair Use*, 3 UCLA ENT. L. REV. 271, 276 (1996) (observing:

[a]lthough digital sampling is functionally similar to magnetic tape recording in so far as it captures and stores sounds that may be later retrieved, it provides far more control over the captured sound than does traditional analog recording methods. Modern sampling technology enables artists to isolate and record specific aspects, and even particular instruments, within an existing musical recording);

Randy S. Kravis, *Does a Song by Any Other Name Still Sound as Sweet?: Digital Sampling and Its Copyright Implications*, 43 AM. U.L. REV. 231, 237-38 (1993) (indicating that

[i]n the digital recording stage, analog sound waves from sound recordings are converted into digital codes that are intelligible to a digital computer. Once in this form, the sounds can then be altered and manipulated by rearranging the codes. Finally, those sounds are played back and mixed with other songs with the touch of a keyboard).

165. See *Acuff-Rose Music*, 929 F.2d at 1439 (concluding, in the case of a rap music group's sampling elements of the 1964 Roy Orbison classic, "Oh, Pretty Woman," that "[i]t is the blatantly commercial purpose of the derivative work that prevents this parody from being a fair use"); *Jarvis v. A & M Records*, 827 F. Supp. 282, 292 (D.N.J. 1993) (stating that "[t]here is no question that the combined phrase 'ooh ooh ooh ooh . . . move . . . free your body' is an expression of an idea that [is] copyrightable," and denying defendant sampler's motion for summary judgment on plaintiff's musical composition copyright infringement claim because the extent of similarity of defendant's and plaintiff's songs was an issue of fact for the jury); *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, (S.D.N.Y. 1991) (citing, in granting plaintiff's application for preliminary injunction against defendants, plaintiff's copyright and testimony and defendant samplers' vain attempt to obtain license for use of copyrighted material).

in relation to the copyrighted work as a whole”¹⁶⁶ In different situations, the work at issue could be a single page, a few pages, or the plaintiff’s entire site.

In the case of a commercial link by the defendant, both the first and fourth fair-use factors weigh against a finding of fair use. The first factor concerns “the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes,”¹⁶⁷ while the fourth factor concerns “the effect of the use upon the potential market for or value of the copyrighted work.”¹⁶⁸ In the commercial-link context, the phrase “potential market for” might be extended to include the plaintiff’s ability to obtain paid advertising on its site, an ability that can be dramatically undercut by a defendant’s linking to, and possibly framing, the plaintiff’s pages. Conversely, the second factor, “the nature of the copyrighted work,”¹⁶⁹ might help a defendant who links to factual works rather than to creative or fictional works.

C. *Violation of Authors’ Rights*

Along with the copyright rights provided in § 107, the Visual Artists Rights Act grants the author¹⁷⁰ of a work of visual art the rights “to claim authorship of that work,”¹⁷¹ “to prevent the use of his or her name as the author of any work of visual art which he or she did not create,”¹⁷² “to prevent the use of his or her name as the author of the work or visual art in the event of a distortion, mutilation, or other modification of the work which would be prejudicial to his or her honor or reputation,”¹⁷³ and “to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation”¹⁷⁴

Web site owners would likely wish to use these rights to challenge unauthorized linking. However, the Copyright Act defines a “work of visual art” to include only paintings, drawings, prints, sculptures, or photos that exist in physical forms that have a limited number of physical copies.¹⁷⁵ Specifically excluded from this

166. 17 U.S.C. § 107(3) (1994).

167. *Id.* § 107 (1).

168. *Id.* § 107 (4).

169. *Id.* § 107 (2).

170. *See* 17 U.S.C. § 106A(b) (1994) (providing that “[o]nly the author of a work of visual art has the[se] rights . . . in th[e] work, whether or not the author is the copyright owner”).

171. *Id.* § 106A(a)(1)(A).

172. *Id.* § 106A(a)(1)(B).

173. *Id.* § 106A(a)(2)(A).

174. *Id.* § 106A(a)(3)(A).

175. The Copyright Act defines a “work of visual art” as

(1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or

category are "electronic publication, or similar publication . . ." and "any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container . . ." ¹⁷⁶ For this reason, the owners of target sites probably would not find authors' rights helpful unless they were involved in the production or sale of such works.

IV. THE TRADEMARK MODEL

Under § 1114 of the Lanham Act, ¹⁷⁷ the registrant of a trademark may obtain injunctive relief ¹⁷⁸ against any person who uses for commercial purposes a reproduction or imitation of a registered trademark, whether or not it appears on product wrappers, containers, or signs, "in connection with the sale of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . ." ¹⁷⁹ The registrant of the trademark generally is not "entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive." ¹⁸⁰

A separate but overlapping ¹⁸¹ cause of action for civil damages resulting from unfair competition lies under § 1125 against

[a]ny person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or

(2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

17 U.S.C. § 101 (1994). In a nationally publicized application of the protections of the Visual Artists Rights Act, the sculptor Frederick Hart, the creator of *Ex Nihilo*, a base-relief sculpture prominently displayed in the Washington National Cathedral, recently won a settlement from the movie studio that produced *Devil's Advocate*, in which his work appeared in an erotic and demonic context. "Warner Brothers agreed to attach stickers to the videocassette packages of *Devil's Advocate* specifically disclaiming any relationship to or endorsement by Hart or Washington National Cathedral. The studio also agreed to 'make changes to certain portions of the film to eliminate any perceived confusion in future distribution of the movie.'" Sylvia Moreno, *Studio Settles Suit Brought by Va. Sculptor*, WASH. POST, Feb. 14, 1998, at C8 (quoting Warner Brothers spokeswoman Barbara Brogliatti).

176. 17 U.S.C. § 101 (1994).

177. 15 U.S.C. §§ 1051-1128 (1994).

178. *Id.* § 1114(2)(A).

179. *Id.* § 1114(1)(a).

180. *Id.* § 1114(1)(b).

181. See *Playboy Enters., Inc. v. Frena*, 839 F. Supp. 1552, 1562 (M.D. Fla. 1993).

15 U.S.C. § 1125(a) is designed to protect against a broader range of deceptive or unfair trade practices than 15 U.S.C. § 1114. In addition, both sections require the same test to determine whether the particular actions complained of are violative of their terms. Thus, as a general rule, the same set of facts which support an action for trademark infringement also support an action for unfair competition.

Id. (citations omitted).

device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person¹⁸²

Also, the Lanham Act provides that “subject to the principles of equity and upon such terms as the court deems reasonable,”¹⁸³ the owner of a “famous mark”¹⁸⁴ can obtain an injunction against another person’s using the mark or trade name commercially “if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark”¹⁸⁵ If the plaintiff proves that the other person willfully intended to trade on the name or cause dilution of the mark, the plaintiff is entitled to damages, any profits made by the defendant, and legal costs,¹⁸⁶ as well as the destruction of the defendant’s infringing documents, advertisements, and molds for the infringing item’s manufacture.¹⁸⁷ Exceptions exist for “[f]air use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark, . . . [n]oncommercial use of a mark . . . [and] [a]ll forms of news reporting and news commentary.”¹⁸⁸

Both *Frena* and *Maphia* involved trademark infringement and unfair competition in addition to copyright infringement. In *Frena*, Playboy’s registered trademarks “Playboy” and “Playmate” had been used to identify many of the defendant bulletin board service’s (BBS) computer files containing adult images;

182. 15 U.S.C. § 1125(a)(1)(A) (1994) (emphasis added).

183. *Id.* § 1125(c)(1) (Supp. I 1995).

184. In determining whether a mark qualifies as “famous,” a court may consider factors such as, but not limited to—

- (A) the degree of inherent or acquired distinctiveness of the mark;
- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (C) the duration and extent of advertising and publicity of the mark;
- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services for which the mark is used;
- (F) the degree of recognition of the mark in the trading areas and channels of trade used by the mark’s owner and the person against whom the injunction is sought;
- (G) the nature and extent of use of the same or similar marks by third parties; and
- (H) whether the mark was registered [as a trademark].

Id. § 1125(c)(1)(A)-(H) (Supp. I 1995).

185. *Id.* § 1125(c)(1).

186. *Id.* § 1125(c)(2) (Supp. I 1995); *Id.* § 1117(a).

187. *Id.* §§ 1125(c)(2); *Id.* § 1118 (1994).

188. 15 U.S.C. § 1125(C)(4)(A)-(C) (Supp. I 1995).

Playboy's text had been removed from these images, which now bore Frena's name and the name and telephone number of the BBS.¹⁸⁹ The court held that Frena had infringed Playboy's trademarks under § 1114 of the Lanham Act for the following reasons: the trademarks were "well[-]known marks" that "have acquired great distinctiveness among consumers . . .,"¹⁹⁰ the BBS used the identical marks,¹⁹¹ and "the services both parties provided [*i.e.*, the provision of images of nude women] were virtually identical."¹⁹² Additionally, by "deleting [Playboy's] text from the photographs, adding his own text to some of the photographs and appropriating [Playboy's] photographs without attribution to the copyright owner," Frena had engaged in unfair competition under § 1125.¹⁹³

In *Maphia* the court granted a preliminary injunction and found that Sega would likely prevail on the merits in a trademark infringement action.¹⁹⁴ The court stated: "[w]hen a game copied from Defendants' bulletin board is played, that game begins with a screen showing the federally registered SEGA trademark and the Sega logo. Confusion, if not on the part of bulletin board users, is inevitable on the part of third parties who may see the copied games after they enter the stream of commerce."¹⁹⁵ Sega also established a *prima facie* case of unfair competition and false designation of origin under § 1125.¹⁹⁶

However, in *Russ Hardenburgh, Inc.* the court denied Playboy's motion for summary judgment against the bulletin board operators.¹⁹⁷ The court decided Playboy had not shown

that the deceptive or misleading portions of the copied photographs were material, that is, likely to influence the purchasing decision of BBS subscribers. [Playboy] has not shown that subscribers to [the defendants' BBS] were drawn to that system because they believed that the adult photographs contained therein were created by Defendants. Plaintiff has not shown that Defendants made any attempt, or had any incentive, to pass off [Playboy] photographs as if they were created by [defendants], other than to avoid copyright liability. Plaintiff will need to produce further evidence at trial to prevail on its Lanham Act claim that Defendants misled consumers about the source of the images.¹⁹⁸

Apart from any issue of trademark infringement that would arise from the mere

189. *Playboy Enters., Inc v. Frena*, 839 F. Supp. 1552, 1559 (M.D. Fla. 1993).

190. *Id.* at 1560.

191. *Id.*

192. *Id.*

193. *Id.* at 1562.

194. *Maphia*, 857 F. Supp. at 689.

195. *Id.* at 688.

196. *Id.*

197. *Playboy Enters., Inc v. Russ Hardenburgh, Inc.*, 982 F. Supp. 503, 515 (N.D. Ohio 1997).

198. *Id.* at 515.

presence of a company's marks on another company's site, it would appear that a site employing the mark itself as a link—for instance, by asking visitors to click on another entity's trademarked logo or word in order to gain access to the site of the owner of that mark—would raise trademark infringement concerns if those seeing the link, whether they followed it or not, were wrongly led to believe that the linker was somehow affiliated with the owner of the mark. A trademark infringement action might also be brought if the link in which the trademarked material were embedded led without warning to a site directly competitive with that of the trademark's owner.

V. THE PRIVACY MODELS

In a 1960 law review article¹⁹⁹ and in a subsequent edition of his treatise,²⁰⁰ William Prosser, the dean of torts scholars, enumerated four separate causes of action for a breach of privacy which were ultimately incorporated by the Second Restatement of Torts²⁰¹ and, in some form, by the statutes and common law of different states.²⁰² This Part analyzes in the context of web-linking two of Prosser's four privacy torts, "[p]ublicity which places the plaintiff in a false light in the public eye" and "[a]ppropriation, for the defendant's advantage, of the plaintiff's name or likeness."²⁰³

A. *The False Light Model*

An action might lie against unwelcome linkers under the privacy tort of false light when the linkage—for example, from a web site devoted to obscene or objectionable material—places the owner of the target site "before the public in a false light" that is "highly offensive to a reasonable person" and is created with "reckless disregard as to the falsity of the publicized matter and the false light in which the other would be placed."²⁰⁴ However, because target sites necessarily offer

199. William L. Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960).

200. WILLIAM L. PROSSER, HANDBOOK OF THE LAW OF TORTS § 112 (3d ed. 1964).

201. HANDBOOK OF THE RESTATEMENT (SECOND) OF TORTS § 652A (2) (a)-(d) (1977) (providing that the right of privacy is invaded by unreasonable intrusion, appropriation of another's name or likeness, unreasonable publicity of another's private life, and publicity which places another in a false light).

202. However, not every state recognizes all of the privacy rights. *See, e.g.,* Geary v. Goldstein, 831 F. Supp. 269, 277 (S.D.N.Y. 1993) (noting that "New York does not recognize an independent cause of action for the common law 'false light' tort").

203. Prosser, *supra* note 199, at 389. The two remaining torts, unreasonable intrusion and unreasonable publication of another's private life, are not implicated by web-linking because one can argue that anything which a plaintiff displays on his web site is not private. However, if the owner of the linking site had breached the electronic protections, such as password requirements, that surround an individual's private site or corporation's internal "intranet," and thereby had allowed outsiders access to the sites, these causes of action might be relevant.

204. RESTATEMENT (SECOND) OF TORTS § 652E (1977); *see also* Berkos v. NBC, Inc., 515

material to the public at large, a linking site that clearly identifies the source of the material to which it links should escape false light liability.

In his law review article, Prosser noted that false light situations “frequently [arise from] the use of the plaintiff’s picture to illustrate a book or an article with which he has no reasonable connection.”²⁰⁵ Indeed, much judicial attention has recently been devoted to false light allegations based on plaintiffs’ claims that revealing photographs of them appeared in erotic magazines without their permission.²⁰⁶ In one of the leading false light cases, *Douglass v. Hustler Magazine, Inc.*,²⁰⁷ Judge Posner of the Seventh Circuit observed that “this little niche of the law of privacy is dominated by Larry Flynt’s publications.”²⁰⁸

In *Douglass* the plaintiff, an actress and model, had posed for pictorials that were represented to her as intended for publication in *Playboy* magazine. She had signed releases authorizing the magazine to use the photos for any purpose that it saw fit, including assigning or licensing the magazine’s rights to the images.²⁰⁹ Although some of the photographs did appear in *Playboy*, the photographer subsequently gained employment with *Hustler* and published additional photographs in that magazine, apparently without authorization from *Playboy* or *Douglass*.²¹⁰ The plaintiff, in the interim, posed several more times for *Playboy* and appeared in television commercials and programs, as well as in motion pictures—notably, *Breaking Away*.²¹¹ She sued for a false light invasion of privacy, asserting that *Hustler*’s publication of her photographs, some of which pictured her “engaged in erotic play with the other woman in the pictorial,”²¹² falsely implied

N.E.2d 668, 680 (Ill. App. Ct. 1987) (finding that a judge’s complaint against a television network for implying his connection with a judicial corruption scandal satisfied the Restatement of Tort’s false light standard); Prosser, *supra* note 199, at 400 (indicating that “[t]he false light need not necessarily be a defamatory one, although it very often is. . . . It seems clear, however, that it must be something that would be objectionable to the ordinary reasonable man under the circumstances The interest protected is clearly that of reputation, with the same overtones of mental distress as in defamation”).

205. See Prosser, *supra* note 199, at 399.

206. E.g., Rebecca Quick, *Can’t Get There From Here May Be Web’s New Motto*, WALL. ST. J., July 2, 1997, at B6 (quoting intellectual property and computer law lawyer as saying that “[a] lot of our clients get upset with pornography sites linking to them—they don’t want that kind of connection”).

The act of accepting a paid product placement diametrically opposes the conduct that gives rise to a false light claim. See, e.g., William Benjamin Lackey, Comment, *Can Lois Lane Smoke Marlboros?: An Examination of the Constitutionality of Regulating Product Placement in Movies*, 1993 U. CHI. LEGAL F. 275, 276 (1993) (characterizing product placement as “a classic case of one hand washing the other: filmmakers defray production costs while manufacturers gain access to a massive advertising market”); Steven L. Snyder, Note, *Movies and Product Placement: Is Hollywood Turning Films into Commercial Speech?*, 1992 U. ILL. L. REV. 301, 305-308 (1992) (enumerating instances of product placement in movies, television shows, and novels).

207. 769 F.2d 1128 (7th Cir. 1985).

208. *Id.* at 1137.

209. *Id.* at 1131.

210. *Id.* at 1131-32.

211. *Id.* at 1131.

212. *Id.* at 1134.

both that she was a lesbian and that “she is the kind of person willing to be shown naked in *Hustler*.”²¹³

As the court noted, “[t]he false-light tort, to the extent distinct from the tort of defamation (but there is indeed considerable overlap), rests on an awareness that people who are made to seem pathetic or ridiculous may be shunned, and not just people who are thought to be dishonest or incompetent or immoral.”²¹⁴ After reviewing the photographs and noting the “palpable” differences between *Playboy* and *Hustler*,²¹⁵ the Court concluded that Douglass did have a cause of action against *Hustler* for false light invasion of privacy: “We cannot say that it would be irrational for a jury to find that in the highly permissive moral and cultural climate prevailing in late twentieth-century America, posing nude for *Playboy* is consistent with respectability for a model and actress but that posing nude for *Hustler* is not (not yet, anyway)”²¹⁶

What of the fact that Douglass had given *Playboy* a general release for the photographs, presumably anticipating that the photographs might end up in *Hustler* or in publications perhaps even more objectionable? The Court found that “the risk she took and the risk that materialized were not the same. She took what may have seemed a trivial risk that *Playboy* would resell her photographs to a competitor, not the risk that the competitor would steal them.”²¹⁷

Significantly for owners of linking sites, the photographs in *Douglass* had not been previously published. The Seventh Circuit observed that “[i]f a photograph has been published previously the implied representation that its present publication is with the consent of the subject is weakened; the first publication may have put the photograph in the public domain.”²¹⁸ In fact, a subsequent Fifth Circuit case found

213. *Douglass*, 769 F.2d at 1135.

214. *Id.* at 1134. The court, though pointing to the obviously posed nature of the pictorials, indicated that a reasonable jury might falsely infer from the photographs that Douglass was a lesbian. *Id.* at 1135.

215. *Id.* at 1137 (observing that “*Playboy*, like *Hustler*, contains nude pictorials, but the erotic theme is generally muted And unlike *Hustler*, *Playboy* does not carry sexual advertisements, does not ridicule racial or religious groups, and avoids repulsive photographs . . .”).

216. *Id.*

217. *Id.* at 1138. In this situation, *Hustler* was bound by its photographer’s knowledge that Douglass had not signed the requisite releases. *Id.* at 1139-1140. However, the magazine’s false light liability could also be grounded in its failure to implement proper systems for securing the subjects’ permission. In *Wood v. Hustler Magazine, Inc.*, 736 F.2d 1084 (5th Cir. 1984), the magazine was found liable in a false light action brought by a plaintiff whose nude photos, taken by her husband, had been stolen, submitted to, and published in a *Hustler* column that printed photographs voluntarily supplied to the magazine by its readers. The court noted: “the record prominently shows that *Hustler* carelessly administered a slipshod procedure . . .” even though “[t]he wanton and debauched sexual fantasies and the intimate photos of nude models [displayed in the column] were of such a nature that great care was required in verifying a model’s consent.” *Id.* at 1092.

218. *Douglass*, 769 F.2d at 1136. *Cf.* *Kyser-Smith v. Upscale Communications, Inc.*, 873 F. Supp. 1519, 1527 (M.D. Ala. 1995) (determining that a jury could find that an advertisement featuring the plaintiff as “an attractive young woman in a red sequin, low-cut dress advertising a product with the name ‘HOT SIX OIL’ in large capital letters strewn across the top to be highly offensive” and that,

that *Hustler's* reprinting of nude photographs from a book that the magazine was reviewing did not give rise to a false light cause of action against the magazine.²¹⁹ Because any web site or page has already been published by the owner of that site, any web site linking to this material should not be vulnerable to a false light claim. In fact, the linking site is arguably not even reprinting the target's material, but only allowing visitors to the linking site the opportunity to have the target itself print for them a copy of its own material.

In this context, clear identification of the prior publication may insulate a reprinter from false light liability. For example, the First Circuit Court of Appeals found that *Penthouse Magazine*, which had reprinted a local newspaper's article and photograph about one school's segregation of young boys and girls at recess, had not thereby implied "either consent or endorsement" of the girls who appeared in the photograph.²²⁰ Not only had these items appeared in a column that was "clearly described as 'a compendium' of items 'culled from the nation's press'" but "the narrative . . . was clearly labeled as having been taken from a newspaper and submitted by an Oregon reader"²²¹ Also, the *Penthouse* column's editor "[n]ot only . . . place[d] his comment after the story and its attribution, and in a different typeface, but he expressly attributed the comment to himself."²²² This decision implies that linking sites should take care to indicate, perhaps next to the relevant links themselves, the source of the material to which the visitor who follows the links will be led. For example, a web site could state the following: "Click here for a view of the home page of [company name]," or provide a highlighted link bearing the name of the other page indicating that the page was not produced by the linking site. This concern is particularly important with respect to frames, which should clearly identify the source of any framed material that was not created by the framer.

Finally, as in libel and defamation²²³ cases, the defendant may be able to raise a defense that the plaintiff is a "public figure," and thus damages are inappropriate unless the defendant published an untrue statement—or created an embarrassing

because the plaintiff had not signed a release form for the use of the photograph, the advertiser had recklessly used the plaintiff's photograph in the advertisement).

219. *Faloon v. Hustler Magazine, Inc.*, 799 F.2d 1000, 1007 (5th Cir. 1986) (holding that "no reasonable person could consider the photographs as indicating plaintiffs' approval of *Hustler*, or that they were willing to pose nude for *Hustler*. It is obvious that the photographs were reproductions from the books being reviewed or excerpted. No tie to *Hustler* is claimed or suggested").

220. *Fudge v. Penthouse Int'l, Ltd.*, 840 F.2d 1012, 1019 (1st Cir. 1988).

221. *Id.*

222. *Id.* (concluding that "there was absolutely no room for the implication that *Penthouse* had in any way dealt with plaintiffs [the pictured schoolgirls and their parents], or they with *Penthouse*"); see also *Grimsley v. Guccione*, 703 F. Supp. 903, 910-911 (M.D. Ala. 1988) (similarly rejecting a false light claim based on a newspaper clipping reproduced in the same *Penthouse* column).

223. *E.g., Wood*, 736 F.2d at 1091 (concluding that "a Texas court would apply no different standard of care to a false light claim than it would to a defamation action"); *Braun v. Flynt*, 726 F.2d 245, 250 (5th Cir. 1984) (indicating that "[i]t has become obvious, with the expansion of privacy law, that a 'false light' invasion of privacy action will often arise from the same circumstances which yield a cause of action for defamation").

link—with “actual malice.”²²⁴ Of particular relevance to the Web is the concept of a “limited public figure,” or a person who “has: (1) successfully invited public attention to his views in an effort to influence others prior to the incident that is the subject of litigation; (2) voluntarily injected himself into a public controversy related to the subject of the litigation; (3) assumed a position of prominence in the public controversy; and (4) maintained regular and continuing access to the media.”²²⁵ For example, in finding for the defendant, the Second Circuit determined that the author, Jackie Collins Lerman, was a limited public figure with respect to her complaint against a magazine that falsely identified her as the actress who appeared topless and in an orgy scene in still photographs reprinted by the magazine from a film written by the plaintiff and her husband.²²⁶

Because the creator of any web site has arguably made himself into a limited public figure with regard to the issues with which the site deals, it would appear difficult to create a link to that site with actual malice, unless the link involved a misrepresentation of the content of the target site or of the views of its creator, or connects the site to an issue or topic that the site does not address. For example, the linking site might create a spurious set of links to web pages of individuals whom it falsely portrayed as users of a pharmaceutical drug that reversed impotence, or visitors to a particular web site.

224. See, e.g., *New York Times Co. v. Sullivan*, 376 U.S. 254, 279-80 (1964) (holding that a “public official” cannot recover damages from the state for a defamatory falsehood with respect to his official conduct unless the official can prove “that the statement was made with ‘actual malice,’—that is, with knowledge that it was false or with reckless disregard of whether it was false or not”); cf. *Braun*, 726 F.2d at 257 (holding that in the context of a private figure, a finding of malice was supported by testimony that an adult magazine’s employees “acted with entire disregard for the falsity of their portrayal . . .” of the plaintiff in publishing her photograph, and especially by testimony that they “misrepresented the nature of the magazine to [the plaintiff’s employer, a family entertainment park] in order to obtain transparencies of the picture for publication”); *Dresbach v. Doubleday & Co.*, 518 F. Supp. 1285, 1292 (D.C. 1981) (holding that, just as in defamation actions, “[a]s plaintiff is not a public figure . . . , a negligence standard applies to the accuracy of the statements in his false light claim”).

225. *Lerman v. Flynt Distrib. Co.*, 745 F.2d 123, 136-37 (2nd Cir. 1984); see also *Fitzgerald v. Penthouse Int’l Ltd.*, 525 F. Supp. 585, 603 (D. Md. 1981) (holding that

[g]iven the close theoretical relationship between a claim for defamation and a ‘false light’ suit for invasion of privacy, . . . when a plaintiff, who is a limited public figure with regard to a defamation claim, also sues under a false light theory that has as its factual basis the same allegedly false material, that plaintiff must prove actual malice in order to recover on the “false light” claim).

226. *Lerman*, 745 F.2d at 137 (concluding that

[b]y voluntarily devoting herself to the public’s interest in sexual mores, through extensive writing on this topic, reaping profits and wide notoriety for herself in the process, Ms. Lerman must be deemed to have purposefully surrendered part of what would otherwise have been her protectable privacy rights, at least those related in some way to her involvement in writing her books and screenplays).

Also, the court noted that “as a controversial, outspoken authoress and screenwriter advocating equal nudity [for men in films, Ms. Lerman was] a willing participant in this public controversy.” *Id.* at 138.

B. The "Right of Publicity" or "Commercial Appropriation" Model

Unauthorized linkers might possibly find themselves liable on another privacy ground, that of "right of publicity" or "commercial appropriation," defined by Prosser as "the appropriation, for the defendant's benefit or advantage, of the plaintiff's name or likeness."²²⁷

In *Zacchini v. Scripps-Howard Broad. Co.* the Supreme Court acknowledged that this cause of action "is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors and having little to do with protecting feelings or reputation."²²⁸ Right of publicity actions also differ from false light actions "in the degree to which they intrude on dissemination of information to the public. In 'false light' cases the only way to protect the interests involved is to attempt to minimize publication of the damaging matter, while in 'right of publicity' cases the only question is who gets to do the publishing."²²⁹ As in false light cases involving public figures, an article must be published or a link must be made in right of publicity situations "with knowledge or in reckless disregard of its falsity."²³⁰

227. See Prosser, *supra* note 199, at 401. This definition is echoed by the Second Restatement of Torts, which provides that "[o]ne who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of his privacy." RESTATEMENT (SECOND) OF TORTS § 652C (1977). An early decision indicated the Second Circuit's view that "in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture This right might be called a 'right of publicity.'" *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2nd Cir. 1953) (concerning a baseball player's right to grant to a baseball card company the exclusive privilege of publishing his picture).

Although under this phrasing misappropriation for commercial purpose is not required, that is most often the situation; hence, the common equation of right to publicity with commercial misappropriation. In fact, Comment b to section 652C of the Restatement indicates that "[t]he common form of invasion of privacy under the rule here stated is the appropriation and use of the plaintiff's name or likeness to advertise the defendant's business or product, or for some similar commercial purpose. Apart from statute, however, the rule stated is not limited to commercial appropriation." RESTATEMENT (SECOND) OF TORTS § 652C cmt. 6 (1977). See also Lerman, 754 F.2d at 133-134 (noting that "the right to publicity is essentially identical to the right to be free from commercial appropriation Because the plaintiff must generally have developed a property interest with financial value in order to prove that he suffered damages, the right is most frequently invoked by public figures or celebrities.").

228. 433 U.S. 562, 573 (1977). See also Prosser, *supra* note 199, at 406 (stating that "appropriation is quite a different matter from [other privacy-related causes of action]. The interest protected is not so much a mental as a proprietary one, in the exclusive use of the plaintiff's name and likeness as an aspect of his identity.").

229. *Zacchini*, 433 U.S. at 573. See also *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 350 (Cal. Ct. App. 1983) (indicating that "[o]rdinarily, only two branches of the law of privacy, namely, public disclosure and false light, create tension with the First Amendment, because of their intrusion on the dissemination of information to the public").

230. *Eastwood*, 198 Cal. Rptr. at 352 (finding deficient in this regard movie star Clint Eastwood's right of publicity action against a tabloid newspaper, but observing that "such defect is capable of being cured by amendment"); *Davis v. High Society Magazine, Inc.*, 457 N.Y.S.2d 308, 315 (N.Y. App. Div. 1982), <https://scholarcommons.sc.edu/sclr/vol49/iss4/3>

Zacchini involved the plaintiff's suit against a television station for televising the entirety of his fifteen-second "human cannonball" act, which featured his flight from the barrel of a cannon to a net two hundred feet away. The Supreme Court reversed Ohio's highest court's holding that the First and Fourteenth Amendments protected this telecast: "The Constitution no more prevents a State from requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner" ²³¹

For this reason, the Seventh Circuit found that the plaintiff in *Douglass*, who was both an actress and professional model who had licensed nude photographs of herself, had successfully presented not only a false light claim against *Hustler* magazine but also a claim "under the commercial-appropriation branch of the right of privacy—what is sometimes called the 'right of publicity.'" ²³² However, the district court in *Faloona* determined that the magazine's reproduction of nude photographs of the plaintiffs which appeared in a book that the magazine was reviewing did not support a claim for commercial misappropriation. The court stated that "the defendant must have capitalized upon the likeness of that person in order to sell more magazines or newspapers" and *Hustler* had not so exploited the photograph's subjects. ²³³

Even if a web site, perhaps owned by a human cannonball or nude model, offers its material—possibly including still or moving images—to the public rather than to an exclusive group, the site's owner might claim that a link has created commercial misappropriation. First, as in the case discussed in Part II, the argument could be made that the linking site was interfering with the target site's ability to generate income because it was diverting visitors from advertisements which they would otherwise encounter by browsing through the target site. Clearly, this argument depends on the linking site's leading visitors directly to an internal page of the target site, framing the target's pages, or otherwise presenting the target site's pages without allowing the range of navigation and vision offered to visitors proceeding directly to the target site.

1982) (construing state law to require such proof "where a use is associated with an item that would generally be considered newsworthy or of public interest and concerns a public official or figure . . .").

231. *Zacchini*, 433 U.S. at 575.

232. *Douglass v. Hustler Magazine, Inc.*, 769 F.2d 1128, 1138 (7th Cir. 1985) (finding that "the jury did not exceed the bounds of reason" in reaching this conclusion, because "[t]he unauthorized publication did impair the commercial exploitation of Douglass's talents . . . [and] an important aspect of the 'right of publicity' is being able to control the place as well as time and number of one's public appearances").

233. *Faloona v. Hustler Magazine, Inc.*, 607 F. Supp. 1341, 1360 (N.D. Tex. 1985), *aff'd*, 799 F.2d 1000 (5th Cir. 1986) (noting that *Hustler* did not identify the subjects of the photographs and "did not exploit the photographs in a publicity campaign designed to sell more magazines."); *cf.* *Grimsley v. Guccione*, 703 F. Supp. 903, 911 (M.D. Ala. 1988) (finding that *Penthouse Magazine* had not appropriated plaintiff's name, story, or photograph for some commercial advantage because it "clearly had not used the [plaintiff's] story to advertise the contents of its magazine or to increase sales").

Can a target successfully bring a right to publicity action against a site that links to the target's home page when it merely deposits visitors at the target's doorstep and allows them unframed access to the entirety of the target site? The target's owner might still argue that the presence of this link increases the value of the linker's site and decreases the value of the sites to which the target's owner grants a license to link.²³⁴ Such an action would not be successful if the target's mere presence on the web were taken to imply such a license. However, the implied-license argument might not apply if, for instance, the linking site bypassed a password protection, registration form, or "adult verification service" that acted as an intermediary between the casual visitor and the contents of the target site.²³⁵

VI. A WAY OUT?

Although the owners of some web sites are mounting sophisticated technological defenses to unwelcomed web-linking,²³⁶ and owners of other sites are including links to "terms and conditions" pages that disclaim responsibility for or endorsements of sites linking to others, a simple web-wide solution to resolve several of the problems associated with unwelcomed web-linking would be to create a new icon, perhaps that of a traffic light to be placed on the home page, selected pages, or all pages of a target site. If the lamp lit on the depicted traffic light were red, the indication would be that the owner of the web page had not granted permission to link to or frame that page. A yellow light would indicate that the owner had granted some sites permission to link to or frame the page. Also, clicking on the yellow-lighted icon could produce a list of those sites, perhaps in the form of reciprocal links. A green light would show that the page's owner has granted everyone on the Web a license to link to or frame that page.

If widely adopted, this concept, similar to the icon for an intact/broken key that symbolizes a secure/insecure web connection for purposes of electronic commerce, would fulfill several goals. First, it would remind all visitors that the owners of sites generally have little technological control over which sites link to theirs. Second,

234. This argument is akin to those launched by individuals who object to companies' selling their names, addresses, and other personal information to mailing lists.

235. See Effross, *supra* note 1 (discussing operation of adult verification services).

236. *E.g.*, Quick, *supra* note 206, at B6 (observing that in recent weeks Ticketmaster has escalated [its battle against Microsoft] by using computer coding to block users from linking to its site from the Sidewalk site. Users who click on Sidewalk's link to Ticketmaster arrive at a Web page that reads, 'This is an unauthorized link and a dead end for Sidewalk.' The page tells users the correct address for Ticketmaster, which must be manually typed into the browser);

Todd Woody, *Media Embroiled in Hyperlinking Dispute*, 147 N.J.L.J. 1261 (March 17, 1997) (noting that the cable network "CNN has inserted a poison pill of sorts in its Web sites that dissolves TotalNEWS's frame. If a viewer goes to the *Los Angeles Times* site through TotalNEWS, the frames disappear if the viewer ventures beyond the *Times*' home page").
<https://scholarcommons.sc.edu/sclr/vol49/iss4/3>

the presence of the icon (which might ultimately become a default feature in some software packages devoted to web page construction) would eliminate any argument that the creator of a site had granted an implied license to link. Rather, all such licenses would have to be explicit, by the inclusion of the linking site's name in the list that appeared when the visitor clicked on the icon. Third, the simplicity of the icon and its use would enable a site owner to convey its message in a relatively unobtrusive way, without annoying or deflecting visitors to the site.²³⁷

Thus, owners of web sites might find an alternative (or addition) to constructing technological moats, drawbridges, and walls around their digital domains—and thereby inviting even more determined efforts to scale or breach these ramparts. By installing a virtual signpost that not only identifies interlopers but enhances the owner's ability to counterattack, site-owners might more efficiently protect their reputations and intellectual property in a still-shifting legal landscape.

237. See Effross, *supra* note 1 (indicating that in the design of commercial web sites, marketing considerations such as an avoidance of "click-wrap" agreements often triumph over considerations of legal protection for the site owner); Grogan, *supra* note 147, at 8 (observing that "[b]ecause [click-wrap] procedures are uncommon . . . and are likely to discourage some users from using the site, the imposition of such obstacles may well be contrary to the web site host's business goals").

