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I. INTRODUCTION

Online technologies have created a new litigation locus for the owners of copyrights, patents, and trademarks. Once content to prosecute only actual infringers, intellectual property rights holders now focus their attention on intermediaries that provide the means for massive simultaneous infringement by thousands of separate Internet users.[1] Like an elite police force that has elected to target kingpins and ignore petty criminals, rights holders have begun to eschew the direct infringers, instead setting their sights on bigger game.[2]

This unprecedented litigation strategy has put sudden pressure on courts to evaluate the liability of indirect infringers. But the current state of contributory infringement doctrine offers inadequate guidance, resulting in inconsistent adjudications. The recent

* Associate Professor of Law, University at Buffalo Law School, The State University of New York. The author would like to thank Cathleen Kaveney, Salil Mehra, and Eugene Volokh as well as the participants in the Eighth Annual Intellectual Property Scholars Conference at Stanford Law School and the 2008-2009 Faculty Workshop Series at the University at Buffalo Law School for their helpful suggestions. Lindsay Bernstein and Doug Smith provided valuable research assistance.

1. Mark A. Lemley & R. Anthony Reese, *Reducing Digital Copyright Infringement Without Restricting Innovation*, 56 STAN. L. REV. 1345, 1353–54 (2004) (referring to new strategy of copyright holders to enforce their rights against indirect infringers as a "seismic shift" in copyright enforcement); *see also* 5 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 21:55 (2008) (describing sharp upturn in contributory infringement cases matching the increasing popularity of the World Wide Web); Keith E. Witek, *Software Patent Infringement on the Internet and on Modern Computer Systems—Who is Liable for Damages?*, 14 SANTA CLARA COMPUTER & HIGH TECH. L.J. 303, 304–33 (1998) (describing potential for "mass patent infringement over the Internet" and concomitant pressure on secondary liability doctrine).

2. The Recording Industry Association of America recently announced that it would discontinue lawsuits against individuals for illegally downloading music files, instead focusing its efforts on pressuring internet service providers to take the initiative to prevent inappropriate use of file sharing technology. Bureau of Nat'l Affairs, *Recording Industry to Discontinue Litigation Program, Cites Changing Marketplace*, 77 U.S. L. WK. 2392 (2009).

jurisprudence of the Ninth Circuit provides a perfect example. In less than two months the court flip-flopped, finding that the contributory liability standard was satisfied in the case of a search engine that led Internet users to infringing websites but not in the case of credit card companies that processed the payments that made the same infringing websites financially viable.[3] The court offered little to explain the difference in the two outcomes, simply stating that "location services" were somehow different than "payment services."[4]

Without a developed body of intellectual property case law on which to base their opinions, federal courts have resorted to importing secondary liability principles from other bodies of law to justify their decisions. In shaping the modern rules of contributory infringement, judges are relying on indirect liability doctrines from common law tort and criminal law. The Supreme Court has instructed the lower courts to mine tort law precedent to solve contributory infringement questions.[5] Meanwhile, in the context of an increasing criminalization of intellectual property law, analogies to criminal prosecution of accomplices have taken root in contributory infringement jurisprudence. For example, in the case of the credit card companies mentioned above, Ninth Circuit judge Alex Kozinski posited that the companies' provision of financial services for infringing websites was akin to the help provided by the person who drives the getaway car from an armed robbery or fronts the cash necessary to purchase narcotics.[6] For Kozinksi, criminal common law provides a suitable source of content for civil infringement law. These doctrinal moves elicit little controversy. If anything, courts only face criticism from the legal academy when they supposedly stray too far from common law principles in deciding infringement cases.[7]

3. *See* Perfect 10, Inc. v. Amazon.com, Inc., 487 F.3d 701, 729 (9th Cir. 2007); Perfect 10, Inc. v. Visa Int'l Serv. Ass'n, 494 F.3d 788, 824–25 (9th Cir. 2007).

4. *Visa*, 494 F.3d at 797 n.8. Six months later, the Ninth Circuit amended its opinion in *Amazon.com*, but did not alter its analysis of contributory liability. Perfect 10, Inc. v. Amazon.com, Inc., 508 F.3d 1146 (9th Cir. 2007).

5. *See* MGM Studios, Inc. v. Grokster, Ltd., 545 U.S. 913, 934–36 (2005); *see also* BUC Int'l. Corp. v. Int'l Yacht Council Ltd., 489 F.3d 1129, 1138 n.19 (11th Cir. 2007).

6. *Visa*, 494 F.3d at 815.

7. *See, e.g.*, Peter S. Menell & David Nimmer, *Unwinding* Sony, 95 CAL. L. REV. 941, 1022 (2007) (faulting the *Sony* decision for failing to apply tort principles of secondary liability); Peter S. Menell & David Nimmer, *Legal Realism in Action: Indirect Copyright*

There is often a mismatch, however, between the guiding justifications for criminal law and tort law and the very different rationales for intellectual property protection. In short, the contributory liability doctrine for the former bodies of law is a poor fit for the latter. In a companion article, I contend that much more analysis needs to be done before judges assessing contributory infringement liability can learn anything useful from tort law's contributory liability doctrine.[8] In this Article, I maintain that it does not make sense for contributory infringement law to depend on the same principles that determine the culpability of criminal accomplices. Contributory infringement law and its criminal law counterpart, known as "accomplice liability," have evolved in different directions because they are animated by different principles. Infringement law's explicitly nonretributive justification clashes with the moral basis for criminal punishment of aiders and abettors of crimes.

Nevertheless, a study of criminal contributory liability offers insights into the current functioning and normative goals of contributory infringement law.[9] One way to find out more about the nature of something is to juxtapose it against a related entity.[10] Even though contributory infringement doctrine should not be altered to resemble its criminal law counterpart, scrutiny of accomplice liability suggests some new ways of thinking about the liability of indirect infringers. Close comparison of the secondary liability regimes of criminal law and intellectual property law provides an explanation of where contributory infringement law is and where it should go.

Part II of this Article introduces the doctrine of contributory liability in intellectual property and details the controversies in this

Liability's Continuing Tort Framework and Sony*'s De Facto Demise*, 55 UCLA L. REV. 143, 149 (2007) ("[T]he tort principles that have guided copyright law since its inception should continue to guide copyright's further evolution."); Alfred C. Yen, Sony, *Tort Doctrines, and the Puzzle of Peer-to-Peer*, 55 CASE W. RES. L. REV. 815, 852 (2005) ("[C]ourts have borrowed too little from tort law in the existing construction of third party copyright liability."); Jason Kessler, Note, *Correcting the Standard for Contributory Trademark Liability Over the Internet*, 39 COLUM. J.L. & SOC. PROBS. 375, 411 (2006) (calling for "preserving traditional standards" of contributory liability in dealing with the new context of trademark infringement via the Internet).

8. Mark Bartholomew & Patrick F. McArdle, *Causing Infringement* (forthcoming 2010).

9. *Cf.* Jerome Hall, *Interrelations of Criminal Law and Torts: I*, 43 COLUM. L. REV. 753, 755 (1943).

10. *Id.*

area of jurisprudence. A contributory infringer must be shown to have "knowledge" of infringement and to "materially contribute" to the infringement. The content of these two requirements is open to question, particularly in the area of material contribution.

Part III examines the doctrine of accomplice liability. For conviction of an accomplice, the prosecution must demonstrate that the accomplice intended for the criminal action to occur. The accomplice must also perform some sort of act in an effort to further the crime, but may be liable even if the act was minimal and had no effect on the crime or its perpetrator. Because accomplice liability differs greatly from current application of intellectual property contributory liability doctrine, the contours of intellectual property law would be dramatically altered if the courts accepted analogies like Judge Kozinski's.

Part IV maintains that remaking indirect infringement law in criminal law's image would be unwise. The analogy between accomplice liability and contributory infringement fails given careful consideration of the reasons behind imposing criminal sanctions on indirect actors. Accountability for accomplices requires a tight nexus between the mental state of the defendant and the ultimate criminal act committed by another. This paradigm cannot be used, however, to structure contributory infringement law given the different theoretical bases for the two secondary liability regimes and the particular evidentiary issues accompanying infringement.

Instead, another organizing principle for contributory infringement, outside of criminal law, must be found. In Part V, I suggest that causal principles can be used to provide much needed content for contributory infringement doctrine. Causation inherently appeals to our own sense of responsibility. Although causation has little impact on accomplice liability decisions, its familiarity to the legal community in other contexts makes it an attractive source of legal rules. Part V begins to sketch out what a doctrine of causation for contributory infringement should look like.

II. CONTRIBUTORY LIABILITY RULES IN COPYRIGHT, TRADEMARK, AND PATENT LAW

All three of the main intellectual property regimes, which include copyright, trademark, and patent law, recognize some form of secondary liability—the idea that one party may be held liable for infringement even if it did not itself directly infringe on the

intellectual property right at issue. Secondary liability can be broken down into two distinct subcategories: contributory liability and vicarious liability. Often a claim for contributory infringement is coupled with a separate claim for vicarious liability. Nevertheless, the two doctrines are different. Contributory liability and vicarious liability have separate historical origins and theoretical justifications.[11] The main difference between the two subcategories is that vicarious liability is based exclusively on the relationship between the defendant and the direct infringer, while contributory liability is based on the actions of the defendant as well as the defendant's state of mind in relation to the underlying infringement.[12] A party can be held vicariously liable without any knowledge or participation in the infringement.[13] An in-depth discussion of vicarious liability for infringement and a comparison of that doctrine to vicarious liability doctrines in criminal law are beyond the scope of this Article.[14] Instead, this Article focuses on contributory infringement doctrine and the evaluation of a defendant's contribution to another's infringement—an evaluation that has given courts a great deal of trouble.

There are two types of contributory infringement: knowing facilitation and inducement.[15] For each type of infringement, the

11. *See* 5 PATRY, *supra* note 1, § 21:41 ("Vicarious liability and contributory infringement are discrete doctrines with different elements, and thus it is important to analyze a claim under the proper doctrine."). Although there have been many suggested answers for why an employer or other supervisor should be responsible for the tortious conduct of its employees, the most frequent suggestion is that vicarious liability is justified by the need to distribute losses to solvent parties when direct tortfeasors lack the means to compensate victims for their injuries. P.S. ATIYAH, VICARIOUS LIABILITY IN THE LAW OF TORTS 22 (1967). In contrast, contributory liability involves complicated questions of blameworthiness and causation that are the exclusive subject of this Article.

12. Sanford H. Kadish, *Complicity, Cause and Blame: A Study in the Interpretation of Doctrine*, 73 CAL. L. REV. 323, 337 (1985). To be held vicariously liable for either trademark or copyright infringement, the defendant must have the right and ability to control the direct infringer and the infringement must translate into a financial benefit for the defendant. Perfect 10, Inc. v. Amazon.com, Inc., 487 F.3d 701, 729–30 (9th Cir. 2007).

13. *See* John Gardner, *Complicity and Causality*, 1 CRIM. L. & PHIL. 127, 130 n.2 (2007) (distinguishing vicarious responsibility and contributory responsibility by noting that being vicariously responsible means responsibility for another's wrongs "irrespective of one's own participation in them").

14. Principles of vicarious liability for the torts of another date back at least to the seventeenth century. THOMAS BATY, VICARIOUS LIABILITY 19 (1916). On the other hand, criminal law rarely imposes liability vicariously. Michael S. Moore, *Causing, Aiding, and the Superfluity of Accomplice Liability*, 156 U. PA. L. REV. 395, 398–99 (2008).

15. PharmaStem Therapeutics, Inc. v. ViaCell, Inc., 491 F.3d 1342, 1358 (Fed. Cir.

defendant must possess a particular mental state with regard to the infringing act. In addition, for each type of infringement the defendant must take some action that contributes to the underlying infringement. The content of the mental state and contribution requirements vary depending on the type of contributory infringement at issue. As described in more detail below, a defendant must know of the infringing activity to be liable for knowing facilitation, but proof of intent to cause the infringement is not necessary. Knowing facilitation also requires the defendant to commit some act in furtherance of the directly infringing conduct. Even when there is proof of such an act and knowledge of the infringing activity, defendants that supply technologies capable of substantial noninfringing uses are exempt from knowing facilitation liability. In contrast, a defendant must specifically intend for the infringement to occur to be liable for inducement. Moreover, no safe harbor exists for such a defendant, even if that defendant supplies a technology that can be used for noninfringing purposes.

A. Knowing Facilitation Infringement[16]

1. Contours of the knowledge requirement

Copyright, trademark, and patent law set out two main conditions for a finding of knowing facilitation. First, defendants must have actual or constructive knowledge that their actions are likely to facilitate infringement by another. Second, defendants' actions must materially contribute to the infringement.[17]

All three intellectual property regimes prohibit aiding or encouraging a direct infringer when the defendant can be expected to have some knowledge of the infringing activity. Although knowledge that the direct infringer's acts constitute infringement is required for knowing facilitation infringement, proof of intent to cause the infringement is not.[18] Thus, a defendant that is indifferent

2007).

16. Courts refer to the non-inducement variety of contributory infringement in a variety of ways. Some merely refer to it as "contributory infringement." *E.g.*, *id.* I have chosen the term "knowing facilitation" to make clear that it is a subset of contributory infringement.

17. *See* Gershwin Publ'g Corp. v. Columbia Artists Mgmt., Inc., 443 F.2d 1159, 1162 (2d Cir. 1971); Mark Bartholomew & John Tehranian, *The Secret Life of Legal Doctrine: The Divergent Evolution of Secondary Liability in Trademark and Copyright Law*, 21 BERKELEY TECH. L.J. 1363, 1378 (2006).

18. Charles W. Adams, *Indirect Infringement from a Tort Law Perspective*, 42 U. RICH.

to the presence or absence of infringement may be found contributorily liable for patent infringement if it knew that the component it was selling could be used to infringe.[19] Similarly, the owner of a flea market was found contributorily liable for a t-shirt vendor's trademark infringement even though the owner arguably had no specific intent that the infringement take place.[20]

When actual knowledge is not present, courts investigate whether a reasonably prudent person in the defendant's position should have expected infringement.[21] Mere suspicion that a purchaser of the defendant's product will use that product to infringe is not enough to satisfy the knowledge standard.[22] Thus, the Supreme Court held that a generic drug manufacturer did not meet the knowledge standard for contributory liability merely because it suspected that some unknown pharmacists would use its product to infringe on comparable trademarked drugs.[23] But courts are free to use circumstantial evidence to impute knowledge to a defendant. For example, the Federal Circuit inferred knowledge of patent infringement when the defendant was a manufacturer of component parts and the evidence showed that there was no available market for those components except in the infringing system.[24] In *A&M Records v. Napster*,[25] the distributor of peer-to-peer file sharing software was found liable for knowing facilitation of infringement.[26] In that case, the trial court inferred knowledge of copyright infringement based on the Napster executives' own illegal

L. REV. 635, 657 (2007); Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469 (Fed. Cir. 1990).

19. W.R. Grace & Co.-Conn. v. Intercat, Inc., 7 F. Supp. 2d 425, 455 (D. Del. 1997) ("Actual intent to cause or contribute to infringement is not necessary to establish contributory infringement.").

20. Hard Rock Café Licensing Corp. v. Concession Servs., Inc., 955 F.2d 1143, 1149 (7th Cir. 1992).

21. Cable/Home Commc'n Corp. v. Network Prods., Inc., 902 F.2d 829, 845–46 (11th Cir. 1990).

22. *E.g.*, 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25:18 (2008) ("[T]he supplier's duty does not go so far as to require him to refuse to sell to dealers who merely might pass off its goods.").

23. Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 861 (1982) (White, J., concurring).

24. Preemption Devices, Inc. v. Minn. Mining & Mfg. Co., 803 F.2d 1170, 1174 (Fed. Cir. 1986).

25. A&M Records, Inc. v. Napster, Inc., 239 F.3d 1004 (9th Cir. 2001).

26. *Id.* at 1021–22.

downloading of copyrighted works and their experience with intellectual property rights and the recording industry.[27]

For two of the three main categories of intellectual property, a safe harbor exists for defendants accused of supplying items that facilitate infringement but can also be used for noninfringing purposes. The immunity from contributory liability exists even when the defendant is aware of the infringing activity. Section 271(c) of the Patent Act exempts the supplier of "a staple article or commodity of commerce" from liability even when the article is subsequently used, with the supplier's knowledge, for infringement of a patent.[28] Similarly, in copyright law, manufacturers of technologies having "substantial noninfringing uses" are exempt from liability even if they are aware of the infringing activity.[29] No such safe harbor exists for accused secondary trademark infringers, although the Lanham Act does provide certain limitations on the type of relief granted against publishers and printers.[30]

2. Material contribution

Even with actual or constructive knowledge of the direct infringer's behavior, liability for knowing facilitation will not attach to a secondary defendant unless the defendant "materially" contributed to the infringement.[31] All three intellectual property regimes require some act by the defendant that contributed to the ultimate act of infringement before the defendant can be held contributorily liable. For trademark law, this material contribution can take the form of manufacturing or distributing the infringing product or directly controlling and monitoring the instrumentality

27. *Id.* at 1020 n.5.The type of intellectual property at issue has some impact on the knowledge requirement. Courts tend to view the knowledge requirement more generously when the right at issue is a copyright. *E.g.*, Chappell & Co. v. Frankel, 285 F. Supp. 798, 801 (S.D.N.Y. 1968). On the other hand, in trademark law, the knowledge requirement for contributory liability is a high standard for a plaintiff to meet; mere awareness of a potential for infringement is not enough. *E.g.*, Monsanto Co. v. Campuzano, 206 F. Supp. 2d 1271, 1278–79 (S.D. Fla. 2002) (holding that a distributor's awareness of a similar scheme involving someone other than the direct infringer is not enough to satisfy knowledge standard for contributory liability).

28. 35 U.S.C. § 271(c) (2000).

29. Sony Corp. v. Universal City Studios, Inc. 464 U.S. 417, 442 (1984).

30. 15 U.S.C. § 1114(2) (2005).

31. Bridgeport Music, Inc. v. Rhyme Syndicate Music, 376 F.3d 615, 621 (6th Cir. 2004); Hyman v. Nationwide Mut. Fire Ins. Co., 304 F.3d 1179, 1191–92 (11th Cir. 2002).

used by the direct actor to infringe.[32] Copyright law's material contribution standard is similar,[33] although some would argue that the direct control and monitoring prong is read more flexibly in the copyright context.[34] Patent law imposes liability on sellers of components or materials used to infringe.[35]

The actions listed above are not an exclusive list. The law remains frustratingly unclear as to what makes a defendant's contribution material.[36] Recently, the imprecise content of the material contribution requirement sparked a heated debate among the judges of the Ninth Circuit. In two separate Ninth Circuit cases, *Perfect 10 v. Amazon.com* and *Perfect 10 v. Visa*, website operator Perfect 10 charged online intermediaries with contributory infringement.[37] Perfect 10 holds the copyrights to images of nude models[38] and rights to the trademark "Perfect 10."[39] It operates a website that allows subscribers to access the images for a monthly fee.[40] It maintained that Google and Visa facilitated copyright infringement by rival websites that published Perfect 10's images without authorization.[41] According to Perfect 10, the Google search engine promoted infringement by helping directly infringing websites distribute their infringing content, and Visa encouraged infringement by processing credit card payments made by consumers to the infringing websites.[42] In assessing both cases of contributory

32. Perfect 10, Inc. v. Visa Int'l. Serv. Ass'n., 494 F.3d 788, 807 (9th Cir. 2007); Lockheed Martin Corp. v. Network Solutions, Inc., 194 F.3d 980, 984 (9th Cir. 1999).

33. *Visa*, 494 F.3d at 796.

34. Bartholomew & Tehranian, *supra* note 17, at 1391–94.

35. 35 U.S.C. § 271(c).

36. The boundaries of contributory liability are even more uncertain when legal regimes outside the United States are considered. *See* Lynda J. Oswald, *International Issues in Secondary Liability for Intellectual Property Rights Infringement*, 45 AM. BUS. L.J. 247, 248 (2008).

37. Perfect 10, Inc. v. Amazon.com, Inc., 487 F.3d 701 (9th Cir. 2007); *Visa*, 494 F.3d 788. In a third case, Perfect 10 sued another intermediary, an Internet service provider, for providing Internet connectivity to the unauthorized websites that posted Perfect 10's copyrighted images. Perfect 10, Inc. v. CCBill LLC, 488 F.3d 1102, 1108 (9th Cir. 2007). The Ninth Circuit concluded that section 512 of the Digital Millennium Copyright Act immunized the Internet service provider from liability, pending the district court's determination of certain threshold factual issues. *Id*. at 1118.

38. *Amazon.com*, 487 F.3d at 713.

39. *Visa*, 494 F.3d at 793.

40. *Amazon.com*, 487 F.3d at 713.

41. *Id*. at 726; *Visa*, 494 F. 3d. at 796.

42. Perfect 10 also contended that Amazon.com promoted infringement by linking to

liability, the Ninth Circuit claimed that it applied "the same basic test" to examine whether the defendant "materially contribute[d]" to that infringement.[43] Yet application of that test produced dramatically different results.

In *Amazon.com*, the Ninth Circuit remanded on the issue of knowledge, but held that the search engine materially contributed to the infringing conduct by helping the rogue websites find an audience.[44] It suggested that for contributory infringement disputes "in the context of cyberspace," courts must be sensitive to the nature of the Internet, which by "facilitat[ing] access to websites throughout the world can significantly magnify the effects of otherwise immaterial infringing activities."[45] In other words, in the Ninth Circuit's view, contributory liability becomes more likely when the defendant transacts business online.

Less than two months later, the court did an about-face. A majority of a three-judge panel held that Visa's processing of online credit payments could not materially contribute to the infringement committed by a website that illegally distributed copyrighted images and used the plaintiff's trademark without permission.[46] The majority contended that Visa's inability to directly control the content of the infringing websites meant that it could not satisfy the material contribution standard for either contributory copyright or trademark infringement.[47] It attempted to distinguish the *Amazon.com* decision by arguing that "location services" are more "material" to infringement than "payment services."[48] Yet nothing in the opinion explained why a service that helps consumers find infringing content is somehow more central to infringement than a service that makes it possible for consumers to pay the direct infringer for that infringing content. The majority rejected older contributory infringement precedents, contending that tests "developed for a brick- and-mortar world" were irrelevant.[49]

In a vigorous dissent, Judge Kozinksi took a more generous view

Google search engine results. *Id.* at 712.

43. *Visa*, 494 F.3d at 795.

44. *Amazon.com*, 487 F.3d at 729.

45. *Id.* at 728.

46. *Visa*, 494 F.3d at 796–800.

47. *Id.* at 805, 807.

48. *Id.* at 797 n.8.

49. *Id.*

of the materiality requirement. He contended that the older precedents demonstrated that Visa's actions did satisfy the material contribution standard.[50] Judge Kozinski maintained that Visa's actions had to be material because there are no adequate payment substitutes for credit cards on the Internet,[51] and even if substitutes existed, the ability to receive credit card payments makes infringement possible on a mass scale.[52] The different outcomes of the two *Perfect 10* cases and the split between Judge Kozinski and the *Visa* majority over the definition of material contribution testify to the ambiguity surrounding knowing facilitation doctrine.

Nevertheless, despite the uncertainty over the material contribution standard, some tentative principles can be gleaned from the case law. One established principle provides that some action by the defendant is definitely required. Showing that the defendant benefited from the infringement is not enough. Nor is it enough to demonstrate an action is only obliquely related to the act of infringement. For example, a realtor was absolved from contributory liability for a client's copying of copyrighted architectural plans even though the realtor allegedly knew of the planned infringing activity and received an above-average fee for arranging the sale of an unimproved lot where the client built its infringing architectural design.[53] Despite the evidence of knowledge and benefit, the court denied liability because the realtor's role was too "attenuated" and "only tangentially involved in the infringement."[54]

Another principle evident in some of the cases is that materiality can be determined by the nature of the relationship between the defendant and the direct infringer. The leading treatise on copyright law states that the defendant's action must directly contribute to the infringement for there to be liability.[55] Similarly, contributory trademark infringement also requires "a special, narrowly defined relationship between the defendant and [an act of] infringement."[56]

50. *Id*. at 825 (Kozinski, J., dissenting).

51. *Id*. at 814.

52. *Id*.

53. Demetriades v. Kaufmann, 690 F. Supp. 289, 291, 294 (S.D.N.Y. 1988).

54. *Id*. at 294.

55. 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 12.04, at 12-85 (2008) ("[I]n order to be deemed a contributory infringer, the authorization or assistance must bear some direct relationship to the infringing acts . . . .").

56. Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 812 (2004).

Often the material contribution standard is evaluated through the concept of "control." If the defendant lacks control over the direct infringer or the instrumentality used to infringe, courts tend to conclude that the material contribution requirement has not been satisfied.[57] Some cases suggest that a material contribution can be found when the defendant provides the site and facilities for the infringement to take place, presumably because ownership of such facilities creates a relationship of control over the direct infringer.[58]

B. Inducement Infringement

In addition to the knowing facilitation variety of infringement, all of the intellectual property regimes recognize some form of "inducement" liability where a party will be held responsible if they encouraged the direct infringer with the specific intent to cause the direct infringer to infringe.[59] For example, inducement liability for copyright infringement occurs when the defendant distributes a technology "with the object of promoting its use to infringe copyright."[60] Although there has been some disagreement over the type of intent required for inducement liability under patent law, the Federal Circuit has recently confirmed that specific intent to infringe must be proven.[61] Likewise, trademark infringement plaintiffs proceeding under an inducement theory must also prove an intent to facilitate infringement on the part of the contributory defendant.[62]

57. Lockheed Martin Corp. v. Network Solutions, Inc., 194 F.3d 980, 984 (9th Cir. 1999); Fare Deals, Ltd., v. World Choice Travel.com, Inc., 180 F. Supp. 2d 678, 689 (D. Md. 2001); *see also* Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 437 (1984) (stating that a contributory copyright infringer must be "in a position to control the use of copyrighted works by others").

58. *E.g.*, A&M Records, Inc. v. Napster, Inc., 239 F.3d 1004, 1022 (9th Cir. 2001); Habeeba's Dance of the Arts, Ltd. v. Knoblauch, 430 F. Supp. 2d 709, 714–15 (S.D. Ohio 2006); *Demetriades*, 690 F. Supp. at 293.

59. Adams, *supra* note 18, at 636.

60. MGM Studios, Inc. v. Grokster, Ltd., 545 U.S. 913, 919 (2005).

61. DSU Medical Corp. v. JMS Co., 471 F.3d 1293, 1305–06 (Fed. Cir. 2007); *see also* Tal Kedem, Note, *Secondary Liability for Actively Inducing Patent Infringement: Which Intentions Pave the Road?*, 48 WM. & MARY L. REV. 1465, 1488–94 (2007) (arguing for the recognition of the specific intent standard).

62. Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 853–54 (1982) (holding that secondary trademark liability may be imposed "if a manufacturer or distributor intentionally induces another to infringe a trademark"); *see also* Perfect 10, Inc. v. Visa Int'l Serv. Ass'n, 494 F.3d 788, 807 (9th Cir. 2007) (evaluating Visa's intentional inducement trademark liability under same standard as inducement of copyright infringement); Andrew Beckerman-Rodau, MGM v. Grokster*: Judicial Activism or Good Decision?*, 74 UMKC L. REV. 921, 942 (2006)

The key difference between knowing facilitation liability and inducement liability is that inducement liability requires that the defendant intend for the direct actor to infringe. Intent is not necessary to find the defendant liable for knowing facilitation, which only requires that the defendant know or should know of the infringement.[63]

Just like the material contribution standard for knowing facilitation infringement, many uncertainties surround the inducement doctrine. First, the mental state requirement for inducement is vague. The Supreme Court has offered minimal guidance on how to draw the line between actions demonstrating culpable intent and actions that fall short.[64] The Court also left unanswered the question of whether a subjective belief that the direct actor's conduct is not infringing insulates the defendant from inducement liability. Indeed, courts have not answered whether a defendant could be liable for encouraging another person to copy a copyrighted work based on the erroneous belief that the other person had a fair use right to the work.[65] Similarly, the courts have not addressed whether inducement liability will apply when a defendant facilitates patent or trademark infringement believing that the plaintiff's patent or trademark is invalid.[66]

Second, the courts have not determined what sorts of contributions to infringement satisfy the requirements for inducement liability. It remains an open question whether inducement liability applies only to defendants who distribute an infringing device or if it can apply to defendants who facilitate or encourage infringement in other ways.[67] Moreover, it remains

(stating that "inducing copyright infringement is analogous to inducing trademark infringement").

63. Hewlett-Packard Co. v. Bausch & Lomb, Inc., 909 F.2d 1464, 1469 (Fed. Cir. 1990).

64. Tiffany A. Parcher, Comment, *The Fact and Fiction of* Grokster *and* Sony*: Using Factual Comparisons to Uncover the Legal Rule*, 54 UCLA L. REV. 509, 521 (2006).

65. Adams, *supra* note 18, at 635; Parcher, *supra* note 64, at 522–23.

66. Adams, *supra* note 18, at 635 n.2.

67. *See* Sverker K. Hogberg, *The Search for Intent-Based Doctrines of Secondary Liability in Copyright Law*, 106 COLUM. L. REV. 909, 949–50 & nn.208–09 (2006). Given technological changes shaping the distribution of intellectual property and the prevalence of user-generated content, intermediaries that do not distribute content themselves are becoming increasingly important. Jane C. Ginsburg, *Separating the* Sony *Sheep from the* Grokster *Goats: Reckoning the Future Business Plans of Copyright-Dependent Technology Entrepreneurs*, 50 ARIZ. L. REV. 577, 577–78 (2008). Hence, an inducement doctrine that exempts non-distributors

unclear whether the same materiality standard required for knowing facilitation liability applies or whether inducement plaintiffs may dispense with a materiality standard altogether.[68]

However, it is clear that when the intent standard for inducement liability has been satisfied, the safe harbors for supply of substantially noninfringing materials are no longer available. The Supreme Court's recent *Grokster* decision holds that the safe harbor for provision of substantially noninfringing technologies does not apply to defendants that "actively induce" infringement.[69] In other words, those who distribute technologies capable of noninfringing uses with the intent of facilitating infringement will be liable. Similarly, a defendant found to have actively induced patent infringement cannot take advantage of the exemption for distribution of a "staple article of commerce."[70]

As illustrated by the rift between the majority and Judge Kozinksi in the *Visa* case and by Table 1 below, the content of the contribution standard for both types of contributory infringement remains uncertain. Given this uncertainty, courts have turned to legal analogies outside of intellectual property law to find purchase for their decisions. The next Part describes how the material contribution standard is evaluated in determining indirect liability for criminal conduct and why this standard should not be applied to civil intellectual property disputes.

from liability would fail to capture key intermediaries in the production and dissemination of infringing content.

68. *Compare* Perfect 10, Inc. v. Visa Int'l Serv. Ass'n., 494 F.3d 788, 800–02 (9th Cir. 2007) (indicating that the two types of contributory liability could be described as "material contribution liability" and "inducement liability") *with* Sumit R. Shah, Note, *Modding the Web: Secondary Liability Under Copyright and Web Modification Software in a Post-*Grokster *World*, 85 TEX. L. REV. 703, 726 n.159 (2007) (suggesting that the Supreme Court is moving toward two theories of contributory infringement: "contributory infringement, which is when a defendant materially contributes to infringement with knowledge of infringement, and inducement of infringement, which is when a defendant purposefully encourages infringement in a way that materially contributes to infringement").

69. MGM Studios, Inc. v. Grokster, Ltd., 545 U.S. 913, 934–37 (2005).

70. *Id.* at 934–35 & n.10; *see also* Ricoh Co. v. Quanta Computer, Inc., 550 F.3d 1325, 1336–40 (Fed. Cir. 2008).

TABLE 1 – COMPARISON OF THE TWO TYPES OF CONTRIBUTORY INFRINGEMENT

	Knowing Facilitation	**Inducement**
Mental State Requirement	• Satisfied by actual or constructive knowledge of the infringement • For patent and copyright, safe harbor for supplying materials capable of substantial noninfringing uses	• Defendant must specifically intend for the direct infringer to infringe • Unclear whether defendant can be liable if he or she believes that the direct infringer's conduct is legal • No safe harbor for supplying materials capable of substantial noninfringing uses
Contribution Requirement	• Contribution to infringement must be "material" • Satisfied by manufacturing or distributing the infringing product or directly controlling and monitoring the instrumentality used to infringe • Unclear what other activities are "material"	• Unclear whether "material" standard of knowing facilitation applies or whether a lesser standard applies

III. COMPARING INTELLECTUAL PROPERTY CONTRIBUTORY LIABILITY TO CRIMINAL LAW CONTRIBUTORY LIABILITY

This Part sketches out the basic requirements for liability as a criminal accomplice and compares those requirements to the criteria for contributory infringement liability established in Part II.

Accomplice liability demands proof not only of the defendant's knowledge of someone else's criminal act, but compelling proof that the defendant intended for that criminal act to occur. By contrast, no proof of intent is needed for knowing facilitation infringement. Moreover, contributory infringement doctrine demands evidence of a significant contribution to the directly infringing activity while extremely trivial acts can subject a criminal defendant to accomplice liability.

A. Accomplice Liability Doctrine

In his dissent in the *Visa* case, Judge Kozinski raised the accomplice liability standards of criminal law as an appropriate analogy for determining secondary liability standards for intellectual property.[71] He argued that Visa satisfied the material contribution threshold because its payment processing service facilitates infringement in the same manner that the driver of a getaway car or the financial backer of a drug deal facilitates a criminal transaction.[72] Like Kozinski, other judges have turned to criminal law analogies to solve questions of contributory intellectual property liability.[73] Meanwhile, Congress continues to expand criminal penalties for intellectual property violations,[74] demonstrating increasing acceptance of importing criminal law concepts to intellectual property regulation.[75] Federal law enforcement agencies have

71. *Visa*, 494 F.3d at 815 (Kozinski, J., dissenting).

72. *Id.*

73. *See, e.g.*, Venegas-Hernandez v. ACEMLA, 424 F.3d 50, 57–58 (1st Cir. 2005) (explaining that secondary copyright infringement liability is "a kind of abettor liability" akin to similar liability in criminal law); *In re* Aimster Copyright Litig., 334 F.3d 643, 651 (7th Cir. 2003) (analogizing contributory copyright infringement to criminal aiding and abetting); Sims v. W. Steel Co., 551 F.2d 811, 817 (10th Cir. 1977) (comparing inducer of patent infringement to an accessory before the fact); Trs. of Colum. Univ. v. Roche Diagnostics GMBH, 272 F. Supp. 2d 90, 104 (D. Mass. 2002) (stating that Section 271(b) of the Patent Act "is analogous to a criminal statute imposing liability for one who acts as an accessory before the fact"); *see also* Vengegas-Hernandez v. Sonolux Records, 370 F.3d 183, 196 (1st Cir. 2004) ("Our decision to open this issue on remand is by analogy to criminal law. A decision in an infringement suit to increase the statutory rate based on a finding of willfulness, like an upward departure from a sentencing guideline's range, is a punitive measure meant to deter.").

74. *See* The Enforcement of Intellectual Property Rights Act of 2008, Pub. L. No. 110-403, §§ 201–206 (2008).

75. Stuart P. Green, *Plagiarism, Norms, and the Limits of Theft Law: Some Observations on the Use of Criminal Sanctions in Enforcing Intellectual Property Rights*, 54 HASTINGS L.J. 167, 172 (2002) (describing "an explosion in recent years in the use of criminal sanctions for

recently stepped up investigative efforts and filed more cases for crimes involving intellectual property infringement,[76] even shifting prosecutorial priorities to target the operators of peer-to-peer file sharing networks.[77] Seeing civil penalties as lacking deterrent effect, states are also enacting more criminal laws designed to safeguard the interests of intellectual property owners.[78] With criminal law analogues becoming increasingly important to intellectual property right holders,[79] an examination of the soundness of applying criminal law secondary liability principles to intellectual property is appropriate.

Like intellectual property law, criminal law recognizes liability for the actions of others. The doctrine of "accomplice liability" provides for the criminal responsibility of one who acts with another in the perpetration of a crime.[80] The doctrine has a lengthy historical pedigree.[81] It roughly corresponds to contributory liability in

intellectual property offenses"). Legal scholars suggest that the trend towards greater criminalization of intellectual property rights violations can be attributed to the lobbying prowess of the entertainment and software industries as well as genuine fears over the infringing potential of the Internet and global trade. JULIE E. COHEN ET AL., COPYRIGHT IN A GLOBAL INFORMATION ECONOMY 511 (2d ed. 2006); Michael M. DuBose, *Criminal Enforcement of Intellectual Property Laws in the Twenty-First Century*, 29 COLUM. J.L. & ARTS, 481, 482–85 (2006).

76. Daniel Newman et al., *Intellectual Property Crimes*, 44 AM. CRIM. L. REV. 693, 695 (2007). In recent years, the Department of Justice has realized a fifty percent increase in convictions for intellectual property offenses. Kim F. Nativadad, Note, *Stepping It Up and Taking It to the Streets: Changing Civil and Criminal Copyright Enforcement Tactics*, 23 BERKELEY TECH. L.J. 469, 485 (2008).

77. *See* Press Release, U.S. Attorney's Office W. Dist. of Va., Wise, Virginia Man Sentenced in Peer-to-Peer Piracy Crackdown (Oct. 17, 2006), *available at* http://www.usdoj.gov/criminal/cybercrime/stanleySent.htm.

78. *See* Newman et al., *supra* note 76, at 695–96; *see also* William Triplett, *Feds Deliver Piracy Conviction*, VARIETY, June 29, 2008 (reporting on first jury trial conviction for criminal copyright infringement for peer-to-peer file sharing).

79. Hogberg, *supra* note 67, at 943 (discussing application of mens rea requirement in criminal statutes to contributory copyright infringement).

80. BLACK'S LAW DICTIONARY 17 (6th ed. 1990). Accomplice liability is a particularly confusing doctrine because it is referred to by so many different names. Although I use the term accomplice liability in this Article because it is the most common term for criminal contributory liability, there are several different terms used in different jurisdictions to describe a doctrine where a defendant may be convicted of a crime "even though he or she is not the actual perpetrator of the criminal act." *See* 21 AM. JUR. 2D *Criminal Law* § 162. Alternatively, the principles of accomplice liability may be referred to as accountability, criminal aider and abettor liability, joint criminal liability, joint criminal venture, acting in concert, complicity, and the law of parties. *Id.*

81. *See* United States v. Peroni, 100 F.2d 401, 402 (2d Cir. 1938) (locating the first judicial recognition of the doctrine in fourteenth century English common law); Grace E.

intellectual property law, in that, like contributory liability, accomplice liability looks to the mental state of the defendant as well as his actions to see if they meet the required standard.[82] In criminal law, the requirement that a defendant commit his wrongful act with knowledge and willfulness is referred to as mens rea.[83] The requirement of a particular wrongful act needed to subject the defendant to liability is referred to as actus reus.[84]

1. Mens rea

In the majority of cases, accomplice liability requires that it be proven beyond a reasonable doubt that the defendant has the specific intent to cause another to commit the underlying crime.[85] There are actually two types of mens rea that can be at stake in accomplice liability cases.[86] First, the law addresses the mens rea of knowingly aiding the conduct of another person. For an accomplice liability conviction in any jurisdiction, the trier of fact must conclude that the defendant knew that its actions were facilitating the activities of another.[87] Inadvertent or unknowing encouragement or assistance will not subject a party to accomplice liability.[88]

Second, the law also recognizes the mens rea of having the same object as the elements of the underlying crime.[89] If the defendant

Mueller, Note, *The Mens Rea of Accomplice Liability*, 61 S. CAL. L. REV. 2169, 2169 (1988) ("Anglo-American jurisprudence has recognized accomplice liability since its inception.").

82. Also, like intellectual property law, on rare occasions, criminal law imposes vicarious liability for the acts of others. Unlike intellectual property law, however, vicarious liability in the criminal context has been strictly limited to those occasions when it is specifically required by statute, imposes only a mild penalty, and the offense carries no significant moral overtones. PETER W. LOW, CRIMINAL LAW 277 (2d ed. 2002).

83. United States v. Greenbaum, 138 F.2d 437, 438 (3d Cir. 1943).

84. LOW, *supra* note 82, at 266–67.

85. WAYNE R. LAFAVE & AUSTIN W. SCOTT, JR., CRIMINAL LAW 579–80 (2d ed. 1986). In some jurisdictions, merely knowingly doing things that help others commit crimes is enough to subject the party to liability. *See* Eugene Volokh, *Crime-Facilitating Speech*, 57 STAN. L. REV. 1095, 1174 & n.295 (2005).

86. Moore, *supra* note 14, at 396; Tyler B. Robinson, Note, *A Question of Intent: Aiding and Abetting Law and the Rule of Accomplice Liability Under § 924(c)*, 96 MICH. L. REV. 783, 792 (1997).

87. 2 WAYNE R. LAFAVE, SUBSTANTIVE CRIMINAL LAW § 13.2 (2d ed. 2003).

88. Hicks v. United States, 150 U.S. 442, 449 (1893); State v. Grebe, 461 S.W.2d 265, 268 (Mo. 1970) (en banc).

89. LAFAVE, *supra* note 87, § 13.2(c) ("The prevailing view is that the accomplice must also have the mental state required for the crime of which he is to be convicted on an accomplice theory."); Mueller, *supra* note 81, at 2169.

intends to aid or encourage the commission of the direct actor's crime, then sufficient intent exists to establish accomplice liability. But if the defendant lacks the same intent to commit a particular crime as the direct actor, then there usually can be no accomplice liability.[90] For example, in order for an accomplice to be convicted of the crime of mayhem, which requires a specific intent to maim, it is not enough for the prosecution to prove intent to aid a battery. Rather, the prosecution must demonstrate beyond a reasonable doubt that the defendant intended for maiming to occur through his assistance or encouragement to the direct actor.[91]

Sometimes the defendant may not intend for the crime to happen but is aware that her conduct facilitates the crime. In two limited circumstances, this awareness may satisfy the mens rea requirement. First, courts sometimes permit accomplice liability for only knowingly, not intentionally, rendering aid if the crime is especially serious or dangerous.[92] Knowing but unintentional aid to a group planning to rob a bank or commit treason may suffice for accomplice liability.[93] But such aid is insufficient for cases involving gambling,[94] unlawful sale of alcohol,[95] or the majority of other crimes.[96]

Second, in the relatively rare circumstance of those crimes not requiring proof of either the perpetrator's criminal purpose or knowledge that his behavior would almost certainly cause the prohibited result,[97] accomplice liability may be found without

90. United States v. Matos-Quiñones, 456 F.3d 14, 20 (1st Cir. 2006).

91. Commonwealth v. Hogan, 396 N.E.2d 978, 979–80 (Mass. 1979).

92. LOW, *supra* note 82, at 271; CHRISTOPHER KUTZ, COMPLICITY: ETHICS AND LAW FOR A COLLECTIVE AGE 213–14 (2000).

93. Hanauer v. Doane, 79 U.S. 342, 346–49 (1870) (treason); Regina v. Bainbridge, 1 Q.B. 129, 130–32 (1960) (U.K.) (bank robbery).

94. State *ex rel.* Dooley v. Coleman, 170 So. 722, 723 (Fla. 1936).

95. Graves v. Johnson, 60 N.E. 383, 383 (Mass. 1901).

96. *See* Staples v. United States, 511 U.S. 600, 605–06 (1994) (suggesting that the default rule under the common law is for every crime to require evil intent for the crime to occur on the part of the defendant); KUTZ, *supra* note 92, at 213–14; G. Robert Blakey & Kevin P. Roddy, *Reflections on* Reves v. Ernst & Young*: Its Meaning and Impact on Substantive, Accessory, Aiding Abetting and Conspiracy Liability Under RICO*, 33 AM. CRIM. L. REV. 1345, 1389–90 (1996) ("The federal courts of appeals now uniformly use 'intent' as the necessary state of mind for accomplice liability . . . ."). *But see* Baruch Weiss, *What Were They Thinking?: The Mental States of the Aider and Abettor and the Causer Under Federal Law*, 70 FORDHAM L. REV. 1341, 1373 (2002) (contending that some federal courts fail to apply the intent standard for mens rea for aiding and abetting crimes).

97. KUTZ, *supra* note 92, at 213–14 ("[A]lmost all felonies require more than mere

specific intent to facilitate the crime.[98] For accomplice liability to hold, however, a more limited form of intent must be proven. The prosecution must show that the defendant intended to commit the act that facilitated the perpetrator's actions *and* intended to aid the perpetrator in the actions that ultimately resulted in the crime.[99] For example, the Colorado Supreme Court determined that someone who drove the perpetrator of a killing to the victim's home to forcibly collect a gambling debt could be found guilty as an accomplice to reckless manslaughter.[100] The defense argued that the mens rea requirement for accomplice liability could not be satisfied because the defendant was a good friend of the victim and would never have intended to help the perpetrator kill his friend.[101] The Court disagreed, holding that intent to facilitate a killing is not required for accomplice liability for reckless manslaughter:

> [W]e do not require that the complicitor himself intend to commit the crime that the principal commits for crimes defined in terms of recklessness and negligence. In those cases, the complicitor must only intend to aid or assist the principal to engage in conduct that "grossly deviates from the standard of reasonable care and poses a substantial and unjustifiable risk of death to another."[102]

Not all courts permit accomplice liability for crimes of recklessness or negligence, however; some even deem this analytically impossible.[103]

knowledge on the part of [the perpetrator].").

98. LAFAVE, *supra* note 87, § 13.2; Audrey Rogers, *Accomplice Liability for Unintentional Crimes: Remaining Within the Constraints of Intent*, 31 LOY. L.A. L. REV. 1351, 1368 (1998). For example, a defendant who intended to encourage his brother to discharge a weapon into a crowd but did not necessarily intend for anyone to die could be found guilty of second-degree murder when the shot resulted in death. State v. Garnica, 98 P.3d 207, 209–13 (Ariz. Ct. App. 2004). *But see, e.g.*, State v. Etzweiler, 480 A.2d 870, 874–75 (N.H. 1984) (holding that it is impossible for someone to be an accomplice to an unintentional crime), *superseded by statute*, N.H. REV. STAT. ANN. § 626:8 (2001), *as recognized in* State v. Anthony, 861 A.2d 773 (2004).

99. Rogers, *supra* note 98, at 1368.

100. Grissom v. People, 115 P.3d 1280, 1282–85 (Colo. 2005).

101. *Id.* at 1282.

102. *Id.* at 1285 (quoting Bogdanov v. People, 941 P.2d 247, 251 (Colo. 1997)).

103. *E.g.*, *Etzweiler*, 480 A.2d at 874–75; People v. Marshall, 106 N.W.2d 842, 843–44 (Mich. 1961) (no conviction for being an accomplice to vehicular manslaughter); Maughon v. State, 71 S.E. 922, 926 (Ga. Ct. App. 1911). *But see* People v. Abbott, 445 N.Y.S.2d 344, 347 (N.Y. App. Div. 1981) (accomplice convicted for encouraging vehicular manslaughter in drag racing competition); State v. McVay, 132 A. 436, 439 (R.I. 1926). There is also disagreement on this issue among the limited group of scholars that have studied the question of accomplice liability for unintentional crimes. *See* Rogers, *supra* note 98, at 1371. Some

Courts are particularly reluctant to find accomplice liability without specific intent for strict liability crimes.[104] The doctrine is not uniform from state to state, but the prevailing rule is that even though the principal charged with a strict liability criminal offense may be convicted without evidence of a particular mental state, an accused accomplice will not be liable without proof of intent to facilitate commission of the strict liability crime.[105] At the least, proof must exist that the defendant intended to aid the principal in her actions.[106] Courts typically refuse to apply the doctrine of accomplice liability to defendants who knowingly but unintentionally aid others in strict liability crimes.[107] For example, although possessing illegal machine guns is a strict liability criminal offense, someone will not be liable as an accomplice to that crime unless there is proof of the accomplice's "intent to aid" and "desire to bring about the illegal possession of machine guns."[108]

Thus, unlike prosecutions for accomplice liability for underlying intentional crimes, specific intent to facilitate the actual crime itself is not necessarily required for acting as an accomplice to a crime of recklessness, negligence, or strict liability, but the accomplice must intend to aid the proscribed activity.[109] Accomplice liability for involuntary manslaughter provides a good illustration of the doctrine. Although it is unlikely that someone could possess sufficient intent for conviction as an accomplice to involuntary manslaughter when the killing resulted from a sudden and unpremeditated blow, accomplice liability can exist for involuntary

scholars also disagree as to the consistency of the accomplice liability case law in this area. *See* Sanford H. Kadish, *Reckless Complicity*, 87 J. CRIM. L. & CRIMINOLOGY 369, 372 & n.5 (1997); Paul H. Robinson, *Imputed Criminal Liability*, 93 YALE L.J. 609, 637 n.100 (1984); Weiss, *supra* note 96, at 1351 (describing case law on accomplice's required mental state as "chaos").

104. In general, strict liability criminal offenses are disfavored. *See* MODEL PENAL CODE § 2.05 cmt. (1985) (stating that strict liability is per se inappropriate whenever the offense carries the possibility of probation or imprisonment). Nevertheless, for a very limited number of crimes, no proof of a culpable mental state is required for conviction of the principal actor. For example, a business may be criminally liable for distributing misbranded or adulterated drugs even though it had no knowledge or intent that such distribution would occur. United States v. Dotterweich, 320 U.S. 277, 281 (1943).

105. LAFAVE, *supra* note 87, § 13.2(c).

106. Rogers, *supra* note 98, 1368.

107. LAFAVE, *supra* note 87, § 13.2(c); Kadish, *supra* note 12, at 347 n.48.

108. United States v. Lawson, 872 F.2d 179, 181 (6th Cir. 1989).

109. LAFAVE, *supra* note 87, § 13.2(c).

manslaughter when the killing results from a grossly negligent act and the accomplice intended to encourage that negligent act.[110] For example, when a defendant intentionally encouraged a boat's captain and engineer to use a boiler that the defendant knew was old and worn, the defendant could be held liable as an accomplice when the boiler exploded and killed several ship passengers.[111] Even though the defendant did not intend to kill the passengers, he did specifically intend for the old and worn boiler to be used in a manner that put the passengers at risk.[112]

Apart from these two exceptions, which are not always recognized, the law demands proof that the accused accomplice subjectively intended for the crime to occur. The requirement of intent to bring about the underlying criminal act for accomplice liability has been adopted by all federal circuits,[113] as well as most state courts.[114] Even when the underlying crime is an unintentional one or particularly threatening to public safety, an accomplice must somehow associate himself with the criminal venture and want it to succeed in order to trigger liability.[115]

2. Actus reus

Accomplice liability also requires a particular wrongful deed, known as actus reus, in order to subject the defendant to liability. The actus reus of accomplice liability corresponds to the contribution requirement for contributory infringement. A defendant is liable for the crime of another if, with the intent to facilitate the commission of the crime, he "gave assistance or

110. State v. McVay, 132 A. 436, 437–38 (R.I. 1926).

111. *Id.*

112. *Id.*

113. United States v. Ledezma, 26 F.3d 636, 641 (6th Cir. 1994).

114. *E.g.*, People v. Marshall, 106 N.W.2d 842, 843–44 (Mich. 1961); State v. Gartland, 263 S.W. 165, 170–71 (Mo. 1924). Most state accomplice liability statutes are in agreement, although some interstate disagreement continues to exist regarding accomplice liability for the furtherance of negligent acts. *See* LAFAVE, *supra* note 87, § 13.2(b). Some jurisdictions permit a lesser type of liability called "criminal facilitation" for knowingly but unintentionally rendering aid to a person who intends to commit a crime. *E.g.*, N.Y. PENAL LAW § 115.05 (McKinney 2009).

115. LAFAVE, *supra* note 87, § 13.2(b); *e.g.*, State v. Vincent, 479 A.2d 237, 243 (Conn. 1984) ("An accessory must have both the intent to help the principal and the intent to commit the crime.").

encouragement or failed to perform a legal duty to prevent it . . . ."[116] As one scholar has put it, "To be an accomplice, my act must have something to do with why, how, or with what ease the legally prohibited result was brought about by someone else."[117]

Although the accused accomplice must have "something to do" with the underlying crime, the actus reus requirement is of secondary importance as compared to the mens rea standard.[118] As one court of appeals remarked, it "does not take much to satisfy" the actus reus standard in an accomplice liability case.[119] "The most trivial assistance is sufficient basis to render the secondary actor accountable for the actions of the primary actor."[120] "Proof of any form of participation" is enough to support a conviction for accomplice liability, provided the requisite mental state has been established.[121] Thus, relatively unimportant acts of assistance like preparing a meal for the perpetrator,[122] taking care of the perpetrator's child while he

116. LAFAVE, *supra* note 87, § 13.2; MODEL PENAL CODE § 2.06(3) (1985). In the past, accomplice liability actually referred to three separate types of liability. A "principal in the second degree" provided aid to the actual perpetrator and was "present" at the commission of the crime. JOHN KAPLAN ET AL., CRIMINAL LAW: CASES AND MATERIALS 860 (3d ed. 1996); LAFAVE, *supra* note 87, § 13.1. An "accessory before the fact" was someone who aided the actual perpetrator in committing the felony but was not actually present at the scene. KAPLAN ET AL., *supra*; LAFAVE, *supra* note 87, § 13.1. An "accessory after the fact" did not aid the perpetrator in committing the crime, but did assist him in avoiding capture afterwards. KAPLAN ET AL., *supra* at 861. The complexity inherent in categorizing contributory behavior into these three different types of liability eventually caused most jurisdictions to abandon the three distinctions in accomplice liability. Now, except for accessories after the fact, "all parties to the crime face prosecution for the substantive crime itself and thus face the same punishment or range of punishments." *Id.*

117. Moore, *supra* note 14, at 401.

118. Joshua Dressler, *Reassessing the Theoretical Underpinnings of Accomplice Liability: New Solutions to an Old Problem*, 37 HASTINGS L.J. 91, 102 (1985); Robinson, *supra* note 86, at 793.

119. United States v. Taylor, 226 F.3d 593, 597 (7th Cir. 2000) (quoting United States v. Woods, 148 F.3d 843, 848 (7th Cir. 1998)); *see also* United States v. Sanders, 211 F.3d 711, 722 n.1 (2d Cir. 2000) ("The requirement that one who aids and abets a crime must contribute to its success should not be understood too literally . . . .").

120. Dressler, *supra* note 118, at 102.

121. State v. Gonzalez-Gongora, 673 S.W.2d 811, 813 (Mo. Ct. App. 1984); *see also* Cannon v. State, 904 P.2d 89, 100 (Okla. Crim. App. 1995) ("Only slight participation is needed to change a person's status from mere spectator to aider and abettor."); Commonwealth v. Savage, 695 A.2d 820, 825 (Pa. Super. Ct. 1997) ("An accomplice must have done something to participate in the venture. However, the least degree of concert or collusion in the commission of the offense is sufficient to sustain a finding of responsibility as an accomplice.") (quoting Commonwealth v. Calderini, 611 A.2d 206, 207–08 (Pa. Super. Ct. 1992)).

122. Alexander v. State, 102 So. 597, 598 (Ala. Ct. App. 1925).

commits the underlying crime,[123] lending the perpetrator a shirt,[124] or even being present and applauding the perpetrator's criminal act[125] can satisfy the actus reus standard.

One question the courts have wrestled with is whether an accused accomplice may be convicted for selling goods to a buyer in the ordinary course of business when the retailer is aware that the buyer intends to use the goods to commit a crime.[126] By and large, a seller of retail goods that provides materials for a crime may be held liable as an accomplice.[127] As one court explained, "One who sells a gun to another knowing that he is buying it to commit a murder, would hardly escape conviction as an accessory to the murder by showing that he received full price for the gun . . . ."[128] What is essential is a determination that the retailer had the required mens rea, i.e., intent to sell the instrumentality for use in a criminal endeavor.

The case law governing retail sales of instruments used to accomplish crimes demonstrates the lax standards courts apply in determining whether the actus reus for accomplice liability has been satisfied. Courts typically assume that a defendant's selling an instrumentality used to commit a crime is sufficient to satisfy the actus reus requirement.[129] While proof of some affirmative act is required so that the law does not punish the accomplice for mere thoughts in sympathy with the commission of a crime,[130] the

123. State v. Duran, 526 P.2d 188, 188–89 (N.M. Ct. App. 1974).

124. GEORGE P. FLETCHER, RETHINKING CRIMINAL LAW 677–78 (1978) (recounting a German case where the court found that the defendant's lending a smock to his friend so that he would not stain his clothes while beating someone up was sufficient for accomplice liability).

125. *See* Wilcox v. Jeffery, [1951] 1 All E.R. 464 (K.B.) (U.K.).

126. Rogers, *supra* note 98, at 1358; Candace Courteau, Comment, *The Mental Element Required for Accomplice Liability: A Topic Note*, 59 LA. L. REV. 325, 345 (1998).

127. In some states, the retailer will be punished as an accomplice while in others, the retailer is liable but under a separate criminal statute for "knowing facilitation," which carries a reduced penalty. Mueller, *supra* note 81, at 2187.

128. Backun v. United States, 112 F.2d 635, 637 (4th Cir. 1940).

129. *See e.g.*, *id.* ("[T]hose who make a profit by furnishing to criminals, whether by sale or otherwise, the means to carry on their nefarious undertakings aid them just as truly as if they were actual partners with them . . . ."); Town Tobacconist v. Kimmelman, 462 A.2d 573, 588–90 (N.J. 1983) (allowing criminal prosecution for sale of drug paraphernalia with knowledge of purchaser's intent to use with controlled substances).

130. For accomplice liability, there must be some action that demonstrates that the defendant expressly or impliedly gave her assent to the underlying crime. State v. Burgess, 96 S.E.2d 54, 57–59 (N.C. 1957).

determination of whether the accomplice had the intent to contribute to the criminal act is the essential piece of the accomplice liability puzzle, not actus reus.[131] When retailers are charged as accomplices, the cases often boil down to one central question: the retailer's intent.[132] In essence, accomplice liability is designed to punish the accomplice for his intent to contribute, not for his actions in furtherance of the principal's crime.[133]

B. Comparison with Contributory Infringement Doctrine

As it stands currently, contributory infringement law does not require the strong showings of intent required for accomplice liability in criminal law. Specific intent to facilitate a crime is usually required for accomplice liability.[134] By contrast, intent to bring about the ultimate act of infringement is only necessary for inducement infringement liability, not for knowing facilitation infringement. Moreover, while both contributory liability doctrines allow the defendant's mental state to be inferred through circumstantial evidence, infringement law takes a comparatively generous approach in determining what evidence is probative of knowledge of the underlying illegal act. Most importantly, accomplice liability places little stock in the actus reus requirement while contributory infringement decisions often hinge on whether the defendant's actions were "material" enough to justify liability.

These are important doctrinal differences. Mental states that

131. Weiss, *supra* note 96, at 1347–48 ("Because virtually any act of assistance, no matter how insubstantial, satisfies the 'act' element . . . the mental element is really what defines the aider and abettor.").

132. In *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911), a case involving contributory copyright infringement, Justice Holmes provided some background on retailer liability as criminal accomplices:

> In some cases where an ordinary article of commerce is sold nice questions may arise as to the point at which the seller becomes an accomplice in a subsequent illegal use by the buyer. It has been held that mere indifferent supposition or knowledge on the part of the seller that the buyer of spirituous liquor in contemplating such unlawful use is not enough to connect him with the possible unlawful consequences but that if the sale was made with a view to the illegal resale, the price could not be recovered.

Id. at 62–63.

133. Robinson, *supra* note 86, at 793 ("[I]t is the principal's commission of the offense, and not the acts of assistance or influence, for which the accomplice is punished.").

134. *See supra* Part II.A.1.

would be insufficient to trigger criminal accomplice liability are sufficient for purposes of contributory infringement liability. A defendant may be liable for contributory infringement without proof that she intended for the direct actor to infringe.[135] On the other hand, the prosecution in an accomplice liability case must demonstrate that the defendant had the specific intent to cause the underlying crime to be committed.[136] Thus, someone who helped the direct actor falsify corporate records could not be held liable as an accessory for the direct actor's filing of a fraudulent tax return based on those records without evidence that the defendant "contemplated" the filing of the fraudulent returns.[137] Giving assistance with mere "knowledge of the perpetrator's general criminal purpose" is not enough; there must be proof of intent to further the perpetrator's particular crime.[138]

By contrast, contributory infringement defendants can be held liable even if they had no specific knowledge that infringement was taking place. For example, a defendant accused of knowing facilitation of trademark infringement will be liable for failing to take precautionary measures if it can be reasonably expected to know that someone is using its product to infringe.[139] Thus, the manufacturer

135. *See* MEMC Elec. Materials, Inc. v. Mitsubishi Materials Silicon Corp., 420 F.3d 1369, 1378 n.4 (Fed. Cir. 2005) (where the defendant "had the intent to induce the specific acts constituting infringement, intent additionally to cause an infringement can be presumed"); *see also* Hogberg, *supra* note 67, at 950–51 (contrasting the specific intent requirement for inducement infringement liability with the lack of such a requirement for standard contributory infringement liability). Direct infringement of intellectual property rights is a strict liability offense. One may be directly liable for trademark, copyright, or patent infringement without having any knowledge or intent that the infringement took place. *See* 15 U.S.C. § 1114(1)(a) (2000) (trademarks); 17 U.S.C. § 501(a) (2000) (copyrights); 35 U.S.C. § 271(a) (2000) (patents); Gideon Parchomovsky & Kevin A. Goldman, *Fair Use Harbors*, 93 VA. L. REV. 1483, 1497 (2007) ("U.S. copyright law ostensibly establishes a standard of strict liability; the mental state of a putative infringer is irrelevant to the issue of direct liability. Courts have interpreted liability under the Copyright Act very broadly, ruling that it requires neither intent nor knowledge, thus making even unconscious copying actionable."); Roger D. Blair & Thomas F. Cotter, *An Economic Analysis of Seller and User Liability in Intellectual Property Law*, 68 U. CIN. L. REV. 1, 6 (1999) ("Because patent infringement [like copyright and trademark infringement] is a strict liability tort, the patentee may enjoin the unauthorized manufacture, use, or sale of the invention, regardless of the infringer's state of mind.").

136. *See supra* Part II.A.1.

137. People v. Weiss, 256 A.D. 162, 163 (N.Y. App. Div. 1939), *aff'd* 21 N.E.2d 212 (N.Y. 1939).

138. People v. Baldera, 711 P.2d 480, 508 (Cal. 1985).

139. Coca-Cola Co. v. Snow Crest Beverages, Inc., 64 F. Supp. 980, 985 (D. Mass. 1946); *see also* Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 854 (1982) (citing *Snow*

of "Polar Cola" could be liable for trademark infringement if it should have expected that bars purchasing its product were substituting "Polar Cola" when customers ordered "Coke."[140] The mental state requirement for knowing facilitation of copyright infringement is similar. Intent to facilitate infringement is not required. Instead, the standard for the knowledge requirement is objective. Courts ask if the defendant had "constructive knowledge" or "apparent knowledge" of the infringing activity.[141] By holding contributory defendants to an objective standard, contributory infringement doctrine encourages businesses to adopt reasonable precautions when engaging in transactions affecting intellectual property and discourages businesses from intentionally avoiding evidence of infringement.[142]

Another significant difference between the two indirect liability doctrines can be found in the way courts interpret evidence of mental state. For contributory liability of intellectual property infringement, knowledge of the direct actor's infringing activity can be inferred from ambiguous evidence.[143] For example, knowledge of copyright infringement was "imputed to an advertising agency because its client, the direct infringer, exhibited the 'well known indicia of the fly-by-night operator—smallness, lack of permanent location, and financial unreliability' . . . ."[144] In addition, knowledge will be imputed for purposes of contributory trademark liability when a defendant landowner has reason to suspect that a vendor is selling infringing goods on its property.[145]

Courts have begun to rely on new types of evidence to satisfy the knowledge requirement. According to recent decisions, an indirect financial benefit from the direct copyright infringer's conduct is evidence of a culpable mental state. For example, in *Grokster*, in

Crest with approval).

140. *Coca-Cola Co.*, 64 F. Supp. at 985.

141. Cable/Home Commc'ns Corp. v. Network Prods., Inc., 902 F.2d 829, 846 (11th Cir. 1990); Vault Corp. v. Quaid Software Ltd., 847 F.2d 255, 262 (5th Cir. 1988).

142. 5 PATRY, *supra* note 1, § 21:47.

143. *See* Craig A. Grossman, *The Evolutionary Drift of Vicarious Liability and Contributory Infringement: From Interstitial Gap Filler to Arbiter of the Content Wars*, 58 S.M.U. L. REV. 357, 373, 383–84 (2005).

144. *Id.* (quoting Screen Gems-Columbia Music, Inc. v. Mark-Fi Records, Inc., 256 F. Supp. 399, 404 (S.D.N.Y. 1966)).

145. Hard Rock Café Licensing Corp. v. Concession Servs., Inc., 955 F.2d 1143, 1149 (7th Cir. 1992).

determining whether the mental state requirement for contributory liability was met, the Supreme Court relied heavily on Grokster's business model, pointing out that because Grokster relied on advertising to turn a profit from its free file-sharing service, it received a financial benefit as more users joined its network and it could charge more for advertising.[146] The Court reasoned that because the vast majority of activity on the network involved infringement of copyrighted works, Grokster's business model depended on infringement and such a business model was powerful evidence that a court could rely on in imputing knowledge of the direct infringers' conduct.[147] In addition, particularly in the online context, courts read a business's failure to take prophylactic measures against downstream infringement as evidence of a culpable mental state. For example, the Seventh Circuit held a file-sharing service liable, in part, because the service did not demonstrate that it would have been disproportionately costly to employ a filtering device to prevent illegal downloading of copyrighted content.[148] Other contributory infringement decisions have relied on a defendant's failure to implement technological safeguards as evidence of a guilty mind.[149]

Criminal law, however, takes the mens rea requirement quite seriously and the state faces a heavy burden of proof in demonstrating the defendant's culpable state of mind. Although circumstantial evidence can be used to determine the mens rea for accomplice liability,[150] the courts are selective as to what evidence warrants an inference of intent to facilitate the crime of another. Not

146. MGM Studios, Inc. v. Grokster, Ltd., 545 U.S. 912, 939–40 (2005). Although the Court contended that it was articulating a standard for the inducement type of contributory infringement, it seems that its reasoning should also apply to knowing facilitation infringement. Given the inducement doctrine's requirement of a specific intent to infringe, any evidence probative of a culpable mental state in that context should also be probative in the context of knowing facilitation infringement.

147. *Id.*

148. *In re* Aimster Copyright Litig., 334 F.3d 643, 653 (7th Cir. 2003).

149. *Grokster*, 545 U.S. at 939; Monotype Imaging, Inc. v. Bitstream, Inc., 2005 WL 936882, at *6–*7 (N.D. Ill., Apr. 21, 2005); *see also* Perfect 10, Inc. v. Amazon.com, Inc., 487 F.3d 701, 728 (9th Cir. 2007) (stating that "a service provider's knowing failure to prevent infringing actions could be the basis for imposing contributory liability"); Tiffany, Inc. v. eBay, Inc., 576 F. Supp. 2d 463, 518 (S.D.N.Y. 2008) (holding internet auctioneer not contributorily liable for trademark infringement, in part because of the technological measures it undertook to prevent counterfeiting).

150. *See* Commonwealth v. Holbrook, 629 A.2d 154, 156 (Pa. Super. Ct. 1993).

only must the prosecution demonstrate beyond a reasonable doubt that the defendant intended to facilitate the underlying criminal act, but criminal law courts are loathe to find the mens rea requirement satisfied from speculative evidence. Take, for example, the case of a defendant charged with aiding and abetting the use of a firearm in kidnapping.[151] Although there was uncontroverted evidence that a passenger riding in the defendant's car pointed a gun at the defendant's ex-girlfriend's current boyfriend, causing the boyfriend to flee, that the defendant took advantage of the situation by grabbing his ex-girlfriend and placing her in his vehicle, that he immediately drove with her to the U.S.-Mexico border, and that he threatened to kill her if she revealed the kidnapping to the authorities, the Ninth Circuit overturned a conviction for aiding and abetting.[152] Despite this evidence, the Ninth Circuit concluded that it was possible for a jury to find that the defendant did not "consciously and intentionally" assist the passenger in using a firearm to kidnap his ex-wife.[153] Similarly, the New Mexico Court of Appeals refused to find a defendant indirectly liable for trafficking in methamphetamines even though it was demonstrated that the defendant tried to shoplift over 500 tablets of over-the-counter medication containing the ingredients for making methamphetamine, that another party had offered to purchase these tablets from the defendant, and that the defendant had sold this medication to the same party in the past with knowledge that it would be used to make methamphetamines.[154] Although seemingly strong evidence existed suggesting that the defendant possessed the required mindset, both courts concluded that more evidence was needed before the defendant could be liable as an accomplice.[155]

151. United States v. Bancalari, 110 F.3d 1425, 1429–30 (9th Cir. 1997).

152. *Id.*

153. *Id.*

154. State v. Maldanado, 114 P.3d 379, 380–82 (N.M. Ct. App. 2005).

155. *See also* Gains v. State, 417 So. 2d 719, 722 (Fla. Dist. Ct. App. 1982) (the driver of a getaway car avoided liability for armed robbery, even though he led police on a chase away from the scene of the robbery, because the court deemed the proof insufficient to prove that the driver was "a knowing participant in the crime"); People v. Burrel, 235 N.W. 170, 170–71 (Mich. 1931) (court refused to convict the driver of a car as an accomplice to statutory rape even though he drove the car onto a dark street, parked the car, and "sat in the front seat with arms over the steering wheel and his head resting on his arms" while the rape occurred in the back seat); People v. Hafeez, 792 N.E.2d 1060 (N.Y. 2003) (evidence that the defendant lay in wait with the perpetrator of a murder to attack the victim was insufficient to find the mens rea necessary for an accomplice liability conviction under a New York statute for "depraved

Finally, as it stands today, contributory infringement doctrine requires a rigorous analysis of the contribution requirement. Although the doctrine has not defined exactly what makes a contribution "material," courts analyze this requirement with great care. In the *Visa* case, the knowledge standard was not even evaluated as the court battled only over whether or not Visa materially contributed to the infringing behavior.[156] By contrast, the contribution requirement for accomplice liability can be satisfied by innocuous actions and means little in comparison with the mens rea requirement.[157] Table 2 below summarizes the differences between accomplice liability and current contributory infringement doctrine.

indifference murder").

156. Perfect 10, Inc. v. Visa Int'l Serv. Ass'n., 494 F.3d 788, 795 (9th Cir. 2007).

157. *See supra* Part III.A.2.

TABLE 2 – COMPARISON OF ACCOMPLICE LIABILITY AND CONTRIBUTORY INFRINGEMENT LIABILITY

	Accomplice Liability	**Contributory Infringement Liability**
Mental State Requirement	• For most criminal acts, mens rea requires that contributory defendant specifically intend to facilitate crime • Courts reluctant to speculate as to state of defendant's mind	• No proof of intent to facilitate infringement needed for knowing facilitation infringement • Circumstantial evidence generously interpreted, including failure to install anti-infringement safeguards and receipt of a financial benefit from infringement
Contribution Requirement	• Actus reus requirement is minimal, does not require causation • May be satisfied by conduct unessential to the criminal activity, including provision of food, clothing, child care, or applause for the perpetrator	• Rigorous requirement that can exempt defendant from liability even if mental state requirement has been satisfied • Contours of requirement remain unclear • Courts rely at various times on "control;" provision of site, services, or components for infringement; "directness" of defendant's relationship with actual infringer

Given these significant differences between contributory infringement law and accomplice liability, Judge Kozinski's appeal to criminal law analogies makes little sense. In making the argument that the material assistance prong for contributory copyright and trademark liability simply turns on whether the conduct substantially assists the infringement, not on what he argued were superfluous distinctions made by the majority, Judge Kozinksi pointed to examples from accomplice liability. He explained that criminal courts have no problem in finding that those who knowingly lend money to drug dealers or drive a principal to the scene of a crime are

substantially contributing to criminal activity.[158] By offering these criminal law analogies, Judge Kozinski implied that criminal law and intellectual property law apply the same standards in determining what indirect activities are sufficient to trigger liability for the legal violations of another.[159] But accomplice liability standards largely omit rigorous consideration of the actus reus requirement. Instead, the defendant's actions are only an afterthought once the mens rea requirement has been satisfied. By contrast, contributory infringement law places great emphasis on the material contribution requirement. Thus, intellectual property and criminal law differ dramatically as to what activities are sufficient to result in indirect liability.[160] While criminal contributory liability demands a higher degree of mental culpability and greater proof of that culpability than contributory infringement, intellectual property doctrine places a higher burden on the plaintiff to satisfy the contribution requirement. The next part addresses whether contributory infringement doctrine should be revised to match the standards for accomplice liability.

IV. WHY THE ANALOGY BETWEEN ACCOMPLICE LIABILITY AND CONTRIBUTORY INFRINGEMENT FAILS

Many scholars have tried to find an underlying unity in both civil and criminal law.[161] In Anglo-American law, both legal doctrines share a common origin with tort law being derived from early

158. *Visa*, 494 F.3d at 815.

159. *Id*.

160. A somewhat different calculation is involved in construing the scope of statutes imposing *criminal* liability for infringement. The No Electronic Theft Act, 17 U.S.C. § 506(a)(2), and the Digital Millennium Copyright Act, 17 U.S.C. §§ 1201–05, provide criminal penalties for certain acts of copyright infringement. To determine if certain acts of encouragement or facilitation trigger these criminal sanctions, a court would need to consult traditional criminal accomplice liability standards. *See* Geraldine Szott Moohr, *The Crime of Copyright Infringement: An Inquiry Based on Morality, Harm, and Criminal Theory*, 83 B.U. L. REV. 731, 743 (2003). While imposition of criminal liability for certain intellectual property crimes has proved controversial, *see id.* at 733 (maintaining that it is unacceptable to treat copyright infringement for personal use as a crime); Green, *supra* note 75, at 241 (stating that criminal penalties for intellectual property infringement seem out of place); I. Trotter Hardy, *Criminal Copyright Infringement*, 11 WM. & MARY BILL RTS. J. 305, 340–41 (2002) ("Unfortunately, though, the 'social attractiveness' of greater criminalization may only be apparent to legislators, law enforcement agencies, and those industries that depend on owning and protecting copyrights."), this Article is concerned with the use of accomplice liability analogies to determine the scope of the *civil* doctrine of contributory infringement.

161. Hall, *supra* note 9, at 753.

English criminal law.[162] Both bodies of law use many of the same terms (e.g., assault, battery, conspiracy, fraud, defamation, and trespass).[163] A single action by a defendant may give rise to both criminal and tort suits.[164] Such commonalities led Oliver Wendell Holmes to conclude that, "the general principles of criminal law and civil liability are the same."[165]

Nevertheless, the differences between criminal law and the law of another discrete set of legal wrongs, intellectual property infringement, are more striking than the similarities. Just because courts are willing to hold babysitters, cooks, and those who applaud illegal activity liable as criminal accomplices, this does not mean that the bar for material contribution should be set at the same level in the context of civil infringement. In this Part, I discuss why accomplice liability principles are a poor fit for contributory infringement.

Secondary liability doctrines determine responsibility in different ways. In ancient times, contributory liability often depended on the defendant's physical presence during another's wrongful act.[166] Some of the more modern doctrines, like vicarious liability, assess responsibility on the basis of the defendant's relationship with the direct actor, regardless of the defendant's knowledge or participation in the wrongful activity.[167] Unless the defendant and the direct actor fall into one of three relationships—master and servant, principal and agent, or employer and independent contractor—the defendant cannot be vicariously liable in tort.[168] Similarly, under the doctrine of conspiracy, a defendant may become liable for the actions of another by joining in a complicit relationship with other wrongful actors.[169]

162. Nathan Isaacs Combs, Note, *Civil Aiding and Abetting Liability*, 58 VAND. L. REV. 241, 250 (2005).

163. *See, e.g.*, Keyzer v. Amerlink, Ltd., 618 S.E.2d 768, 773 (N.C. Ct. App. 2005), *aff'd* 627 S.E.2d 462 (N.C. 2006) (explaining that "exclusivity of possession" is the basis for both civil and criminal trespass actions); 5 WITKIN, SUMMARY OF CALIFORNIA LAW, Torts § 381 (10th ed. 2006) (recognizing that in tort actions for assault and battery, the California courts assume that criminal code definitions of "assault" and "battery" are applicable).

164. JOHN C.P. GOLDBERG ET AL., TORT LAW: RESPONSIBILITIES AND REDRESS 33 (2004).

165. OLIVER WENDELL HOLMES, JR., THE COMMON LAW 44 (1881).

166. John H. Wigmore, *Responsibility for Tortious Acts—Its History*, 7 HARV. L. REV. 315, 322 (1894).

167. ATIYAH, *supra* note 11, at 3.

168. *Id.*

169. Halberstam v. Welch, 705 F.2d 472, 478 (D.C. Cir. 1983). *See also* IZHAK

Other civil law doctrines impose liability, without a particular relationship requirement, when the defendant stands to benefit from the loss attributable to the direct actor's behavior.[170]

Criminal law determines the liability of accomplices by measuring the nexus between the accomplice's mental state and the ultimate criminal action. Unless the accomplice specifically intends for the perpetrator's criminal behavior to occur, there is no liability. The nexus requirement furthers the retributive goals of criminal law by ensuring that the defendant unambiguously endorses the perpetrator's criminal activity. Such an approach to contributory liability is not available in the context of intellectual property, however. Evidentiary hurdles and theoretical differences between intellectual property and criminal law demand a separate methodology for determining contributory infringement. In Part V, I propose that contributory infringement liability be grounded on a different metric: causation. Before suggesting a new method for analyzing these types of intellectual property cases, however, the following material explains why accomplice liability doctrine cannot cure what ails contributory infringement law.

A. Accomplice Liability's Nexus Between Defendant's Mental State and the Illegal Action

When multiple actors participate in the same socially undesired enterprise, the law must determine when an actor is sufficiently involved to face legal consequences. Criminal law assesses liability by examining the strength of the link between the mental state of the actor and the ultimate illegal act. For the actual perpetrator of the illegal act, this is a relatively easy question. Assuming that the perpetrator intends his actions, the link between the perpetrator's mental state and the ultimate illegal act is as strong as it can be.

Things get trickier when a court must analyze the nexus between the defendant's mental state and an illegal act committed by another party. It is unlikely that there is a complete overlap between the mental state of the secondary party and the illegal action performed by the direct actor. People participating in group activity rarely

ENGLARD, THE PHILOSOPHY OF TORT LAW 175 (1993) (discussing the use of "special relationships" in tort law to impose a duty of particular persons to prevent deliberate acts of wrongdoing by another).

170. *See* Fleming James, Jr., *Some Reflections on the Bases of Strict Liability*, 18 LA. L. REV. 293, 297 (1958).

organize in perfect unanimity towards identical shared goals.[171] Individuals may agree to work together, but each brings their own expectations, intuitions, and motivations to the project. Nevertheless, accomplice liability doctrine mandates a tight nexus between the defendant's mindset and the ultimate crime. As discussed above, unless the defendant specifically intends for the criminal act to take place (or at least intends for the direct actor to behave in a way that is practically certain to lead to the criminal act), there is usually no liability.[172]

The justification for requiring such a tight nexus between the defendant's mental state and the act of another lies in the animating philosophy behind criminal sanctions. Historically, the primary justification for criminal punishment has been the theory of retribution,[173] which theorizes that criminal law exists to punish morally inappropriate behavior.[174] Under retributivist theory, the state sets limits on freedom of action according to moral concerns.[175] The social norms of the community shape the boundaries of criminal conduct.[176] Criminal punishment serves a civic purpose by expressing the state's indignation and disapproval of the defendant's conduct and vindicating the victim's autonomous rights in life or property.[177]

Under retributivist theory, accomplice liability is designed to punish those who unmistakably support the same criminal act as the perpetrator even if they do not commit the act themselves.[178]

171. KUTZ, *supra* note 92, at 90.

172. *See supra* Part III.A.1.

173. Kyron Huigens, *On Commonplace Punishment Theory*, 2005 U. CHI. LEGAL F. 437, 450 (characterizing this as the "prevailing view among criminal law theorists for a half-century or more").

174. Moohr, *supra* note 160, at 748; *see also* H.L.A. HART & TONY HONORÉ, CAUSATION IN THE LAW 395 (2d ed. 1985) (describing retribution as "the principle that the severity of punishment is to be measured by the wickedness of the criminal").

175. 2 JAMES FITZJAMES STEPHEN, A HISTORY OF THE CRIMINAL LAW OF ENGLAND 81–82 (1883) ("The criminal law thus proceeds upon the principle that it is morally right to hate criminals, and it confirms and justifies that sentiment by inflicting upon criminals punishments which express it."); Thomas W. Merrill & Henry E. Smith, *The Morality of Property*, 48 WM. & MARY L. REV. 1849, 1885 (2007) ("[W]e usually think of criminal law as condemning acts that are regarded as unambiguously immoral.").

176. *See* Dan M. Kahan, *The Secret Ambition of Deterrence*, 113 HARV. L. REV. 413, 420 (1999) (explaining the difference between illegal theft and legal competition as their placement "against the background of social norms").

177. JOEL FEINBERG, *The Expressive Function of Punishment*, *in* DOING AND DESERVING: ESSAYS IN THE THEORY OF RESPONSIBILITY 98, 100–05 (1970).

178. *See* Mueller, *supra* note 81, at 2173 (explaining that "[d]esert is calculated by the

Whether it is choosing to encourage or aid a robbery,[179] the beating of a child,[180] or a dangerous drag race,[181] the accomplice, although not committing the actual crime, expresses his mental agreement with an act that violates accepted social norms and disrespects the value of the victim's life. By expressing a reason for his conduct that undervalues the welfare of others, the accomplice signals that his views offend established social codes and warrant punishment.[182] Criminal liability for complicit behavior furthers the law's retributive goals by holding accountable those whose deeds reflect an unacceptable lack of respect for the welfare of others, even if they do not commit the disrespectful action themselves.[183]

Probably the best example in literature of a person deserving of moral condemnation, and hence criminal sanction, for contributing to a crime is Iago in *Othello*.[184] Although Othello is the direct actor who murders his wife, Desdemona, Iago manipulates Othello and several others with misleading statements and planted evidence to orchestrate that result. Accomplice liability will only be found when there is unmistakable proof of tight overlap between the mental state of the accomplice and the ultimate criminal act. Iago clearly satisfies this standard.[185] He advises Othello on exactly how to kill Desdemona.[186] In his soliloquies to the audience, he makes clear that his behavior is completely voluntary. In fact, what is so chilling about Iago is that there are no outside forces propelling his efforts to ruin Othello and kill Desdemona.[187] He is consumed with malice, but for no discernable reason. The malice is entirely of his own making. He

level of culpability involved in the crime, and culpability is tied to the criminal's mental state"); Aimee D. Borromeo, Comment, *Mental Retardation and the Death Penalty*, 3 LOY. J. PUB. INT. L. 175, 186–88 (2002) (discussing mental state required for retributive punishment).

179. State v. Sam, 907 A.2d 99, 113–15 (Conn. App. 2006).

180. State v. Walden, 293 S.E.2d 780, 786–87 (N.C. 1982).

181. State v. McFadden, 320 N.W.2d 608, 614–17 (Iowa 1982).

182. Guyora Binder, *The Culpability of Felony Murder*, 83 NOTRE DAME L. REV. 965, 1034–35 (2008).

183. *See* KUTZ, *supra* note 92, at 139 ("Responses are warranted to what we do and who we are, not because of some deep metaphysics of causal responsibility, but because of what our actions and gestures of repair indicate about the view we take of our relations with others.").

184. *See* People v. McCoy, 24 P.3d 1210, 1216–17 (Cal. 2001) (using the example of the Iago character to illustrate principles of accomplice liability for homicide).

185. Kadish, *supra* note 12, at 365 ("Iago's actions leave no doubt what his game is.").

186. Iago tells Othello: "Do it not with poison, strangle her in her bed." WILLIAM SHAKESPEARE, OTHELLO, THE MOOR OF VENICE act 4, sc. 1.

187. *See* EDWARD PECHTER, OTHELLO AND INTERPRETIVE TRADITIONS 62 (1999).

holds himself above society's norms and acts strictly out of self interest.[188] This is made most clear at the end of the play when he not only brings about Desdemona's murder at Othello's hand, but kills his wife, Emilia, and his patron, Roderigo, without remorse.[189]

Thus, Iago shows that he is completely indifferent to human welfare.[190] This is what makes him deserving of retributive punishment.[191] In assessing accomplice liability, criminal law looks to whether the accomplice's behavior transgressed moral boundaries. Although perhaps not always as deserving of retribution as the evil Iago, culpable accomplices typically demonstrate disrespect for human life or dignity. A defendant that feeds ammunition to someone shooting into a crowd is an accomplice to reckless endangerment.[192] A street drag racer exhibits sufficient disrespect for human life that he becomes an accomplice to the reckless vehicular assault committed by his drag racing opponent.[193] When an actor embarks on a plan of action that potentially involves the use of deadly force by another, she "crosse[s] a moral divide" that subjects her, as an accomplice, to derivative liability for the deadly actions of others.[194]

The immoral aspect of accomplice liability lies not in the act itself, but in the intentional choice to do a social wrong.[195] There is no way to determine if someone has transgressed moral boundaries without conducting a vigorous examination of the defendant's mindset. If our shared morality is largely based on the notion that individuals must display sufficient concern for the welfare of

188. FAITH NOSTBAKEN, UNDERSTANDING OTHELLO 193 (2000); MARVIN ROSENBERG, THE MASKS OF OTHELLO 174 (1992).

189. SHAKESPEARE, *supra* note 186, act 5, sc. 2.

190. *See* JANE ADAMSON, OTHELLO AS TRAGEDY: SOME PROBLEMS OF JUDGMENT AND FEELING 72 (1980).

191. *Id*. at 100.

192. State v. Garnica, 98 P.3d 207, 209 (Ariz. App. 2004).

193. People v. Hart, 778 N.Y.S.2d 94, 96 (N.Y. App. Div. 2004).

194. United States v. Powell, 929 F.2d 724, 727 (D.C. Cir. 1991).

195. Michael S. Moore, *Prima Facie Moral Culpability*, 76 B.U. L. REV. 319, 320 (1996) (Culpability occurs when one "choose[s] to do a wrong in circumstances when that choice is freely made."). Similarly, through prosecution for attempted but unsuccessful crimes, criminal law permits punishment based on a defendant's possession of the required mental state even if the ultimate wrongful act remains uncompleted. *See* LAFAVE, *supra* note 87, § 11.3. Punishment for attempt is not allowed, however, based on mental state alone. For conviction, the accused must have taken a "substantial step" towards completion of the crime. *Id*. § 11.4; *see* United States v. Resendiz-Ponce, 549 U.S. 102, 106, 114–15 (2007).

others,[196] no punishment is possible unless the defendant demonstrates insufficient concern for his fellow citizens.[197] The nexus requirement evaluates the inner workings of the defendant's mind, probing for expressions of agreement with the perpetrator's criminal behavior that warrant retributive punishment.

The requirement of significant overlap between the accomplice's mental state and the underlying illegal act can leave many secondary parties exempt from legal regulation. The case of Iago is an easy one. We know from his monologues that he is an instigator, seeking the death of Desdemona and Othello's ruin. Even though he does not murder Desdemona himself, we know that he desired and planned for that act to happen.[198] The nexus between Iago's mental state and the wrongful act of Desdemona's murder is tight. In contrast to the reader's ability to confidently judge and condemn Iago, however, the criminal justice system normally does not have access to lengthy confessional soliloquies to determine the exact mental state of an accomplice liability defendant.[199] Without proof beyond a reasonable doubt and to a "moral certainty" of a culpable mental state, there can be no accomplice liability.[200] Given this high threshold for liability, accused accomplices may often avoid criminal liability in situations where it may seem reasonable to infer the defendant's evil intent.[201]

This high threshold is a calculated policy choice.[202] In order to protect individual autonomy interests, accomplice liability doctrine demands a strictly-defined shared overlap of criminal intent between the accomplice and the perpetrator. In the criminal context, the law cannot tolerate false positives, i.e., convictions of innocent

196. *See Matthew* 7:12 (King James) ("Therefore all things whatsoever ye would that men should do to you, do ye even to them."); *Analects of Confucius* 15:3 ("What you do not wish upon yourself, extend not to others."); *Last Sermon of Muhammad* ("Hurt no one so that no one may hurt you.").

197. *See* VICTOR TADROS, ACT, AGENCY, AND INDIFFERENCE: THE FOUNDATIONS OF CRIMINAL RESPONSIBILITY 83 (2005).

198. *See* SHAKESPEARE, *supra* note 186, act. 5, sc. 2.

199. *Cf.* KUTZ, *supra* note 92, at 207 (discussing difficulties of determining intent in criminal cases).

200. Kelly v. State, 139 So. 2d 326, 329 (Ala. 1962).

201. *See supra* text accompanying notes 151–56.

202. *See In re* Winship, 397 U.S. 358, 372 (1970) (Harlan, J., concurring) (Justice Harlan noted that he "view[s] the requirement of proof beyond a reasonable doubt in a criminal case as bottomed on a fundamental value determination of our society that it is far worse to convict an innocent man than to let a guilty man go free.").

defendants.[203] Requiring specific intent to further the perpetrator's crime makes sense given the restraint needed in the imposition of criminal sanctions. Criminal penalties are supposed to be a "last resort" because they subject defendants to social stigma not present in civil damage awards.[204] A tight nexus serves retributive interests by limiting the imposition of state-sanctioned suffering to those secondary actors that truly intend for immoral activity to occur.[205]

203. *Cf.* David L. Faigman, *Judges as "Amateur Scientists,"* 86 B.U. L. REV. 1207, 1215 (2006) (explaining that the reasonable doubt standard is employed for situations where the law seeks to minimize false positives).

204. Green, *supra* note 75, at 228, 230; *see also* KUTZ, *supra* note 92, at 208 (explaining that any criminal law system must be structured to avoid false positives because "nothing can repair the violence done to one's sense of autonomy and worth by unjust punishment"); Roberto Galbiati & Nuno Garoupa, *Keeping Stigma out of Administrative Law: An Explanation of Consistent Beliefs*, 15 SUP. CT. ECON. REV. 273, 273 (2007) (explaining that the stigma of an adverse adjudication is greater in the criminal context, with its higher standard of proof, than in the administrative context).

205. Kadish, *supra* note 12, at 398 (indicating that the nexus requirement for accomplice liability is necessary to avoid an undesirable expansion of criminal liability). After retribution, the other prevailing justification for criminal punishment is deterrence. Aaron Xavier Fellmeth, *Civil and Criminal Sanctions in the Constitution and Courts*, 94 GEO. L.J. 1, 17–18 (2005) (referring to retribution and deterrence as the two dominant contemporary criminal law theories). In contrast to retributivists, deterrence-based theorists are often uncomfortable with finding an explicit basis for criminal sanctions in normative judgments as to what is right and wrong. Binder, *supra* note 182, at 1000. Instead, they justify criminal penalties as a means to prevent conduct that is harmful to others. Moohr, *supra* note 160, at 749. The nexus requirement also serves deterrent interests in that it incarcerates those who completely sympathize with criminal behavior and thus may be likely to act criminally themselves in the future.

Yet, even under a deterrence-based conception of criminal law, liability must be determined in some way based on social norms and shared moral values, not merely on the potential for harm. After all, some actions that result in harm to others are deemed socially beneficial. *See* State v. Pendleton, 567 N.W.2d 265, 268 (Minn. 1997) (holding that a homeowner may use deadly force to prevent a burglar from taking her real or personal property); State v. Haley, 667 P.2d 560, 563 (Or. Ct. App. 1983) (holding that the necessity defense absolves a defendant for illegal actions that were necessary to prevent a threat of bodily harm). Similarly, facilitating the infliction of bodily harm violates social norms in some situations, but not in others. A bystander may encourage a potential victim to defend herself with violent force yet not face criminal accomplice liability. *See* Elaine M. Chiu, *Culture as Justification, Not Excuse*, 43 AM. CRIM. L. REV. 1317, 1329 (2006) (explaining self-defense according to utilitarian theory). A military subordinate who aids in a violent act may escape liability under a defense of obedience to superior orders. *See In re* Agent Orange Prod. Liab. Litig., 373 F. Supp. 2d 7, 87 (E.D.N.Y. 2005). To decide which acts of assistance to those who commit violence should be exempted from liability, deterrence advocates must ask some of the same questions as retributivists. Without an "evil mind" that satisfies the mens rea requirement, there can be no accomplice liability because the defendant has not expressed a sentiment that clashes with established moral principles. LAFAVE, *supra* note 87, § 1.2, at 8; *see also* Mueller, *supra* note 81, at 2173 (explaining that "[d]esert is calculated by the level of

B. Difficulties in Applying the Nexus Requirement to Contributory Infringement

For three reasons, it does not make sense to require the same tight nexus between the defendant's mental state and the illegal activity of another in the infringement context. First, intellectual property disputes present evidentiary difficulties typically not found in criminal cases. In both contexts, intent may be determined through circumstantial evidence. The trier of fact may impute an intent to commit robbery based on the accomplice's presence in the getaway car[206] or intent to facilitate patent infringement based on the contributory defendant's prior unsuccessful attempts to obtain a license from the patent holder.[207] Making inferences from such evidence in the intellectual property context, however, is more difficult and less appropriate. Transactions between contributors and direct infringers are often conducted over a distance and through multiple intermediaries.[208] As the connection between the contributor and direct infringer becomes more tenuous, it becomes more difficult to ascertain the contributor's attitude towards the direct infringer's conduct. The availability of ambiguous defenses to infringement, such as fair use, can further cloud attempts to discern the intent of the contributor.[209] If it is unclear whether the direct infringer believed that her conduct was fair use, then it will be doubly unclear whether the once-removed contributor believed that as well.

This assessment of mental state is further complicated because contributory infringement defendants are typically businesses while accomplice liability defendants are usually individuals.[210] Because

culpability involved in the crime, and culpability is tied to the criminal's mental state"). At bottom, deterrence theorists and retributivists agree that there must be some moral criterion for assessing culpability, and, for purposes of accomplice liability, this requires an examination of the defendant's intent.

206. United States v. Lugo Guerrero, 524 F.3d 5, 15 (1st Cir. 2008). *But see* Gains v. State, 417 So. 2d 719, 722 (Fla. Dist. Ct. App. 1982).

207. Fuji Photo Film Co. v. Jazz Photo Corp., 394 F.3d 1368, 1377–78 (Fed. Cir. 2005).

208. *See generally* Benjamin H. Glatstein, Comment, *Tertiary Copyright Liability*, 71 U. CHI. L. REV. 1605 (2004) (advocating for a copyright liability regime sufficient to govern the actions of entities with no relationship to the direct infringer).

209. *See* Adams, *supra* note 18, at 635.

210. *See* Geraldine Scott Moohr, *Of Bad Apples and Bad Trees: Considering Fault-Based Liability for the Complicit Corporation*, 44 AM. CRIM. L. REV. 1343, 1345–46 (2007) (noting

determining the mental state of an organization involves the consideration of the thoughts and perceptions of several individuals at once with differing levels of responsibility, determining the specific intent of an organization is comparatively difficult.[211] Businesses involved in the distribution or supply of intellectual property or components of intellectual property are usually involved in many transactions at once. By contrast, criminal accomplices typically cannot simultaneously conduct multiple criminal activities. As a result, it is easier to assume that the criminal accomplice intended the ultimate consequences of the perpetrator's activity than to assume that a business conducting hundreds of simultaneous transactions specifically desired the outcome caused by one of its clients. Courts may also have difficulty in differentiating between benign business reasons for engaging in an activity and intentional efforts to infringe.[212]

Second, even if the evidence in intellectual property disputes did lend itself to determinations of specific intent, a specific intent requirement would prevent courts from implementing solutions to rampant infringement problems. Requiring the same tight nexus between the contributor's mental state and illegal activity found in criminal law would exempt from liability all contributors that acted with knowledge but without intent. After the *Grokster* decision, successful cases of inducement infringement may be few and far between as companies learn to avoid public statements that could be seized upon as evidence of a culpable mental state.[213] Thus,

trend towards greater prosecution of individuals and lesser prosecution of firms for corporate crime).

211. *See* David C. Fortney, Note, *Thinking Outside the "Black Box": Tailored Enforcement in Environmental Criminal Law*, 81 TEX. L. REV. 1609, 1627 n.120 (2003) ("Naturally, in a small business it is much easier to prove the *mens rea* of business owners or managers because there are fewer employees and each is subject to greater supervision.").

212. *See, e.g.*, Hewlett-Packard Co. v. Bausch & Lomb, Inc., 909 F.2d 1464, 1470 (Fed. Cir. 1990) (interpreting a contractual provision indemnifying the direct infringer for its infringement as merely facilitating "the sale [of the direct infringer] at the greatest possible price" and not probative of the contributory defendant's intent to induce infringement); *see also* Tim Wu, *The Copyright Paradox*, 2005 SUP. CT. REV. 229, 231 (2005) (noting that antitrust scholars have rejected a focus on evidence of intent because "'bad behavior' is sometimes just another name for competitive behavior, of the kind the legal system might want to encourage").

213. Bartholomew & Tehranian, *supra* note 17, at 1413 n.228; *see also* 3 NIMMER, *supra* note 55, at 12-115 to 12-116 (offering "easy to satisfy" suggestions on how potential contributory infringers can minimize liability through cautious advertising practices and refraining from certain internal communications).

exemption of knowledgeable intermediaries from liability leaves direct infringers as the only plausible target for enforcement of intellectual property rights. But the sheer number of direct infringers, as in the case of individual users of music and video file-sharing services, as well as the ability in the digital age to conduct infringing activities in remote jurisdictions with the benefit of anonymizing technologies, often makes the exclusive prosecution of direct infringers impractical.[214]

Courts evaluating contributory infringement cases have already diagnosed this problem, recognizing a need for a legal mechanism that puts pressure on online intermediaries.[215] They have realized that requiring too great of an overlap between mental state and action would immunize most contributory infringers, and limiting liability to direct infringers would jeopardize creative incentives. If accomplice liability standards had been applied in the *Amazon.com* and *Visa* cases, both businesses would likely have been exempt from liability. The millions of transactions conducted by search engines and credit card companies every day would make it difficult to impute an intent to infringe from their behavior.[216] A choice to implement accomplice liability's nexus requirement would be a choice to allow rampant infringement to continue unchecked.

Third, intellectual property law's non-retributive theoretical underpinnings make requirement of a tight nexus between the mindset of the contributory defendant and the actions of the direct infringer unnecessary. The nexus requirement for accomplice liability stems from criminal law's retributive basis. If citizens are to be made to suffer for their conduct, that conduct must be considered immoral[217] and the trier of fact must be certain of the citizen's

214. *See* Robert T. Baker, *Finding a Winning Strategy Against the MP3 Invasion: Supplemental Measures the Recording Industry Must Take to Curb Online Piracy*, 8 UCLA ENT. L. REV. 1, 10–12 (2000); June Chung, *The Digital Performance Right in Sound Recordings Act and Its Failure to Address the Issue of Digital Music's New Form of Distribution*, 39 ARIZ. L. REV. 1361, 1385 (1997); *see also* Lemley & Reese, *supra* note 1, at 1427 (recognizing that anonymity and infringement from locations outside of the United States will hamper efforts by copyright holders to prevent illegal file sharing, but believing that enforcement efforts can still have some success).

215. *See* MGM Studios, Inc. v. Grokster, Ltd., 545 U.S. 912, 929–30 (2005); *In re* Aimster Copyright Litig., 334 F.3d 543, 645–46 (7th Cir. 2003); Tiffany, Inc. v. eBay, Inc., 576 F. Supp. 2d 463, 501–02 (S.D.N.Y. 2008).

216. *See* Consolidated Answering Brief of All Defendants-Appellees, Perfect 10, Inc. v. Visa Int'l Serv. Ass'n., No. 05-15170, at 34–36 (9th Cir. Oct. 17, 2005).

217. Moohr, *supra* note 160, at 774.

improper motives.[218] For most crimes, the immoral nature of the accomplice's conduct lies in her conscious decision to make someone commit an act that she knows is wrongful. Accomplice liability's nexus requirement limits the last resort of criminal punishment to immoral conduct by only including defendants that intend for the perpetrator's bad acts to occur. The rigorous nexus requirement permits some accomplices to escape liability, but this is deemed a worthwhile price to pay to avoid false positives.[219]

By contrast, instead of being grounded on commonly shared moral values, intellectual property law's guiding purpose is instrumental.[220] Decisions as to liability and the scope of copyright and patent rights are often made based on a calculation of what will generate the greatest number of expressive or inventive works in society.[221] Trademark law is not calibrated necessarily to generate more trademarks, but it is designed to provide for an efficient marketplace that consumers can navigate as quickly and reliably as possible.[222] Both of these rationales for intellectual property protection are in keeping with utilitarian theories in providing for "the greatest happiness of the greatest number."[223] Accordingly, contributory infringement doctrine focuses its attention on the consequences of the infringement, not on the personal

218. *See supra* note 201 and accompanying text.

219. *See supra* Part IV.A.

220. COHEN ET AL., *supra* note 75, at 7 (explaining that the Framers of the U.S. Constitution embraced the utilitarian rationale for copyright protection); ROBERT P. MERGES ET AL., INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 10 (rev. 4th ed. 2007) ("Utilitarian theory, and the economic framework built upon it, has long provided the dominant paradigm for analyzing and justifying the various forms of intellectual property protection."); Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 623–24 (2004) (noting the prevailing view of trademark law as designed to reduce consumer search costs "is now nearly total," although incomplete). Although moral precepts cannot help but be a part of any adjudication, courts and legal scholars are particularly uncomfortable with discussions of morality and just punishment in the context of intellectual property. *E.g.*, Sari Louis Ferraud Int'l v. Viewfinder, Inc., 406 F. Supp. 2d 274, 281 (S.D.N.Y. 2005) ("Copyright and trademark law are not matters of strong moral principle."), *vacated and remanded,* 489 F.3d 474 (2d Cir. 2007); *cf.* Combs, *supra* note 162, at 252–53 (maintaining that tort law has "a lesser emphasis on morality" than criminal law).

221. MERGES ET AL., *supra* note 220, at 11 ("The principal objective of much of intellectual property law is the promotion of new and improved works . . . .").

222. William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 265–66 (1987) ("[T]rademark law, like tort law in general . . . can best be explained on the hypothesis that the law is trying to promote economic efficiency.").

223. JEREMY BENTHAM, AN INTRODUCTION TO THE PRINCIPLES OF MORALS AND LEGISLATION 4–5 & n.1 (Prometheus Books 2007) (1780).

blameworthiness of the defendant, by emphasizing the defendant's material contribution. It is the impact of the contributory defendant's actions on the direct infringer that matters most, not the degree to which the defendant is out of step with community moral norms. In addition, the typical remedy in any case of intellectual property infringement is an injunction preventing the defendant's further use of the work in question.[224] Because the limited nature of intellectual property relief does not inflict the same devastating costs on defendants as criminal sanctions, there is no need to limit legal responsibility to only those who specifically intend for the underlying illegal conduct to occur.

In sum, contributory infringement doctrine does not profit from analogies to accomplice liability. Criminal law relies on social norms and widely held views of moral conduct to set the boundaries of punishable behavior. In terms of accomplice liability doctrine, this translates to an emphasis on the link between the defendant's mental state and the ultimate criminal act and a corresponding lack of attention to the defendant's actual contribution to the underlying criminal endeavor. Given the different evidence available in intellectual property cases, the practicalities involved in reining in massive simultaneous online infringement, and the contrasting theoretical justifications for criminal punishment and intellectual property protection, analogizing accomplice liability to contributory infringement makes little sense. If they are to be borrowed from another body of law, contributory infringement standards must come from a different area of legal doctrine than accomplice liability.

224. *See* eBay v. MercExchange, 547 U.S. 388, 395 (2006) (Roberts, C.J., concurring) (suggesting that injunctions will remain the standard remedy in patent cases because of valuation concerns); Philip J. Weiser & Dale Hatfield, *Spectrum Policy Reform and the Next Frontier of Property Rights*, 15 GEO. MASON L. REV. 549, 568 n.105 (2008) ("In the intellectual property context, injunctive relief is generally the available and appropriate remedy, but the state of the law in this area remains controversial."). The Lanham Act specifically states that remedies for trademark infringement must be non-punitive. 15 U.S.C. § 1117 ("Such [damages] shall constitute compensation and not a penalty."). Legal scholarship tends to agree that relief from infringement should be tailored to incentivizing creative output, not to proportionately calibrating punishment to the defendant's bad acts. *See, e.g.*, Blair & Cotter, *supra* note 135, at 18 (maintaining that intellectual property damages awards should be enhanced in some circumstances by a multiplier to maintain the necessary incentives for copyright, patent, and trademark rights holders).

V. A THEORY OF CONTRIBUTORY INFRINGEMENT CAUSATION

If intellectual property's guiding rationale is utilitarian, then one might conclude that there simply needs to be an analysis of contributory infringement based on utilitarian principles. The problem, however, is that the consequentialist theory behind intellectual property protection offers little traction to those seeking workable content for the material contribution requirement. Many would argue that it is impossible to use theories as to the potential economic effects of different levels of intellectual property protection to calibrate the exact boundaries of infringement liability.[225] For every intellectual property regime, there is a dispute as to the economic impact of increased intellectual property protection.[226] Utilitarian theory can only tell us so much about whether or not entities like Visa and Google should be held contributorily liable.

Moreover, even if courts could apply economic theory to determine the optimal level of liability for contributory infringement, it is not clear that the law should be organized in this manner. Criticism of law and economics scholarship posits that the rationality of human behavior is variable.[227] It stands to reason that rational compliance with the law decreases when the law fails to track human intuition. Thus, it is not helpful to simply urge potential contributory infringers to behave in a way that provides the greatest good for the greatest number. A successful theory of accountability for the actions of others needs to offer guidance to citizens so they can structure their behavior accordingly. A law's motivational force

225. CRAIG ALLEN NARD & R. POLK WAGNER, PATENT LAW 8–9 (2008); George L. Priest, *What Economists Can Tell Lawyers About Intellectual Property: Comment on Cheung*, *in* 8 RESEARCH IN LAW AND ECONOMICS: THE ECONOMICS OF PATENTS AND COPYRIGHTS 19, 21–23 (John Palmer ed., 1986); Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1573–76 (1993).

226. *See, e.g.*, J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARK AND UNFAIR COMPETITION § 2:12, at 2-30.1 to 2-30.2 (4th ed. 2008) (stating that there is no consensus among economists as to whether trademarks and advertising create barriers to market entry); FRITZ MACHLUP, THE ECONOMICS OF INFORMATION AND HUMAN CAPITAL 165 (1984) (opining that it may be impossible to identify the total costs and benefits of the patent system); Salil K. Mehra, *Software as Crime: Japan, the United States, and Contributory Copyright Infringement*, 79 TUL. L. REV. 265, 301–02 (2004) (discussing difficulties of calibrating a system of copyright enforcement).

227. Ronald Chen & Jon Hanson, *Categorically Biased: The Influence of Knowledge Structures on Law and Legal Theory*, 77 S. CAL. L. REV. 1103, 1129 (2004).

will be insufficient unless its basis is obvious to those affected.[228] People do not see themselves as agents who are supposed to go forth and maximize group well-being.[229] Instead, we need to look for another method for determining responsibility for the acts of another.

One way of determining responsibility for contributory acts that is rarely employed in the accomplice liability context is causation. Modern accomplice liability eschews a study of causation in favor of an analysis of mental state.[230] Relatively innocuous conduct that does little to facilitate the underlying criminal act satisfies the actus reus requirement for accomplice liability.[231] The retribution rationale for criminal sanctions apportions punishment on the basis of the expressive content of one's behavior, not causation.[232] Yet despite its lack of significance in accomplice liability, causation is an important rubric that guides other bodies of law and our own innate sense of accountability. As discussed earlier, a viable system of accountability must be understandable to others if it is to guide behavior. We intuitively believe that even in the absence of fault, individuals bear some responsibility for the consequences of their actions.[233] Christopher Kutz has noted that in evaluating social responsibility for an action, we often apply what he calls the Individual Difference Principle.[234] The Individual Difference Principle holds that an individual is accountable for a harm if she did something that "made a difference to its occurrence."[235] If the individual's actions had no impact on the realization of the harm, then the individual is not

228. KUTZ, *supra* note 92, at 129.

229. *Id.* at 55.

230. HART & HONORÉ, *supra* note 174, at 325 (stating that ordinary causal limitations are disregarded in situations where a defendant is criminally liable for harm not caused by his own conduct but by the conduct of another); Mueller, *supra* note 81, at 2173 ("[S]ince the concept of culpability provides the basis for our criminal justice system, the act requirement is secondary to the mental element.").

231. *See supra* notes 118–25 and accompanying text.

232. FLETCHER, *supra* note 124, at 680 ("[T]hat one can contribute to a result without causing it lies at the foundation of accessorial liability.").

233. HART & HONORÉ, *supra* note 174, at xxxv ("That we are responsible for the harm we cause is a principle that makes an immediate appeal to common moral sensibility."); Larry Alexander & Kimberly Kessler Ferzan, *Culpable Acts of Risk Creation*, 5 OHIO ST. J. CRIM. L. 375, 386 n.32 (2008) (stating that holding actors accountable for harms they nonculpably created "seems intuitively correct").

234. KUTZ, *supra* note 92, at 3.

235. *Id.*

accountable.[236]

We can see this principle at work when we think about how our own sense of responsibility is triggered by everyday events. Consider a scenario where I agree to house sit for someone and, being unfamiliar with their house, I accidentally bump into a vase, knocking it to the floor. The breaking of the vase is not my fault. I was acting with reasonable care when proceeding through the house and definitely had no intention or even knowledge that I was going to break the vase. Nevertheless, I will feel a sense of responsibility to the home owner for breaking her vase. I would definitely want to apologize for my action, and may want to pay for a replacement. The reason for this sense of responsibility on my part is causation. Because I caused the vase to break, even if it was not my fault, I bear some responsibility.

Like "material contribution," causation is a term susceptible to many meanings. It is impossible to define causation with perfect precision given the multiplicity of potential interactions between a secondary party and a direct infringer. Moreover, to some degree, causation is a policy question because defining causation determines how far the reach of the law should extend.[237] Hence, a full account of causal theory and how it can be applied in all contributory infringement scenarios is beyond the scope of this Article. Nevertheless, some discussion of causation and how it might be used to determine liability may prove useful. Causation is a legal principle applied in many other areas of the law. Given its prevalence, judges and juries should be comfortable using it to determine liability.[238] What follow are some preliminary thoughts on the boundaries of contributory infringement as suggested by causal theory.

236. *See id.*; *see also* Kadish, *supra* note 12, at 332 ("In common usage, as well as in the law, whether we may be blamed for something that results from our actions turns on whether we may be said to have been the cause of that result . . . .").

237. KAPLAN ET AL., *supra* note 116, at 320. *But see* Moore, *supra* note 14, at 407 (disagreeing with theorists who "claim a freedom for the law to define its notion of cause-in-fact as it pleases, to serve its own purposes").

238. HART & HONORÉ, *supra* note 174, at 307; *see also* David W. Robertson, *The Common Sense of Cause in Fact*, 75 TEX. L. REV. 1765, 1767 (1997) (describing the "but for" causation test as "both simple enough for everyday application in lawyers' offices and busy trial courts and at the same time comprehensive enough to solve the recurrent types of occasionally quite challenging causation difficulties").

A. Liability for Causal Contributors

We intuitively assess causal responsibility for the actions of another in various ways. As described below, we typically believe there is a causal relationship when the act at issue would not have occurred but for the action of the party responsible. Causation is found even when another party would have likely stepped in to perform the same facilitating act if the defendant had refused. Causation is more likely to be inferred on the basis of affirmative activity rather than passive inactivity. This presumption against causation for passive behavior can be overcome, however, when the behavior at issue represents a departure from ordinary circumstances.

1. "But for" causation

To the extent a causation requirement exists for accomplice liability, it simply requires that the accomplice do something that makes the ultimate criminal act infinitesimally more probable or easier to accomplish. For example, in one famous case often used to illustrate accomplice liability, the defendant sent a telegram urging the telegraph office not to deliver a previous telegram by another that was meant to warn the victim that he was being pursued by four killers.[239] It was by no means clear that receipt of the warning telegram would have saved the victim's life. Nevertheless, the Alabama Supreme Court concluded that the defendant's actions were sufficient for accomplice liability:

> The assistance given . . . need not contribute to the criminal result in the sense that but for it the result would not have ensued. It is quite sufficient if it facilitated a result that would have transpired without it. . It is quite enough if the aid merely rendered it easier for the principal actor to accomplish the end intended by him and the aider and abettor, though in all human probability the end would have been attained without it. . . . [H]e who facilitates murder even by so much as destroying a single chance of life the assailed might otherwise have had, he thereby supplements the efforts of the perpetrator, and he is guilty . . . notwithstanding it may be found that in all human probability the chance would not

239. State *ex rel.* Martin v. Tally, 15 So. 722 (Ala. 1894).

have been availed of, and death would have resulted anyway.[240]

In other words, even if the criminal act most likely would have occurred with or without the action of the accomplice, the actus reus requirement is still satisfied. In fact, even if it can be shown that the accomplice's aid had no impact on the ultimate criminal action, an accomplice with sufficient mens rea may still be liable.[241]

Such a relaxed causation standard, to the extent it can be called a causation standard, would be inappropriate for contributory infringement. Criminal law ensures that its sanctions are reserved only for those accomplices that specifically intend to aid the defendant's conduct. Because a strict intent standard is the focus of accomplice liability, the contribution standard for accomplice liability can be broad in scope without offending our sense of proportionality or just desert. When it has been demonstrated beyond a reasonable doubt that the defendant intended the crime to occur and acted to facilitate it, it seems appropriate to impose criminal liability, even if the crime would have occurred without the defendant's action. But intellectual property law, for the reasons mentioned above, cannot target liability solely on the basis of intent.[242] The knowing facilitation of infringement doctrine requires only a finding of actual or constructive knowledge.[243] This places increased pressure on the material contribution requirement, making a causation standard as broad as the standard for accomplice liability unworkable.

Instead, the causation standard for contributory infringement should be construed more narrowly but still in a manner that matches human intuition. The material contribution standard should be satisfied when the act of infringement would not have occurred but for the aid of the defendant.[244] We instinctively assign responsibility to actors when the result at issue would not have occurred in the absence of the actor's conduct.[245] Under this theory of causation, soliciting or instigating infringement would normally

240. *Id*. at 738–39.

241. Dressler, *supra* note 118, at 102–03.

242. *See supra* Part IV.B.

243. *See supra* Part II.A.1.

244. *Cf.* Dressler, *supra* note 118, at 125.

245. *See* P.S. ATIYAH, ACCIDENTS, COMPENSATION AND THE LAW 121 (3d ed. 1980) ("There is no doubt that in most cases the 'but for' test is intuitively and intelligently used to decide the issue of cause in fact.").

be a material contribution.[246] Another way to satisfy the causation standard would be to provide for the direct infringer an unusual service, i.e., one that is difficult to find or specially tailored to the defendant's needs while other customers receive standardized services. Without the contributor's provision of a unique service, the infringement would not have occurred. As a result, the contributor satisfies the requirement of "but for" causation.[247]

2. Causation and hypothetical alternatives

Our theory of causation also needs to identify what does and does not break established causal chains. For any event, there are an infinite number of actions and conditions that may be deemed necessary for that event to have taken place.[248] But to comport with our intuitive sense of just accountability, some actions that are essential to the end result need to be exempted from liability. For example, in tort law, the voluntary intervention of a second human agent usually absolves the first human agent from responsibility.[249] If A throws a lighted cigarette into dry brush that catches fire, she is the cause of the fire. But if, just as the flames are about to die out, B knowingly pours gasoline on those flames, then B becomes the cause of that fire, not A, even though A's initial act was essential to the creation of the fire.[250]

Contributory infringement cases often involve suppliers and distributors of goods. Often a business will assist a direct infringer, but one might argue that the infringement still would have taken place even without the business's involvement because the direct infringer could have hired another business to assist him if the first business refused. For example, a business might provide sheets of iron to the infringer, who shapes those sheets into an apparatus that

246. *See, e.g.*, Bauer Lamp Co. v. Shaffer, 941 F.2d 1165, 1169, 1171 (11th Cir. 1991) (sales representative held contributorily liable for trademark infringement when he claimed to "even the score" with a rival business by contacting manufacturers and asking them to produce lamps identical to those produced by plaintiff).

247. HART & HONORÉ, *supra* note 174, at 159 (explaining that the law and common intuition typically distinguishes between the causal nature of routine and independent exercises of discretion).

248. *See generally* Robert C. Hilborn, *Sea Gulls, Butterflies, and Grasshoppers: A Brief History of the Butterfly Effect in Nonlinear Dynamics*, 72 AM. J. PHYSICS 425, 425–26 (2004).

249. HART & HONORÉ, *supra* note 174, at 73–75.

250. *Id.* at 74.

infringes someone else's patent.[251] Without the supply of the iron sheets, the infringing apparatus could not have been assembled so the infringement would not have occurred but for the first business's conduct. It would seem that the causation requirement has been satisfied. Yet even though the direct infringer chose this particular business for its iron needs, it surely could have purchased the iron from another entity as well. Borrowing a term used by Joshua Dressler, I will refer to such alternative entities as "hypothetical alternative causes."[252] In one sense, the first business causes the infringement by providing a material needed for the ultimate act of infringement. But in another sense, it does not satisfy a "but for" causation standard because a host of other businesses would have willingly stepped in to provide the same service. In the *Visa* case, the majority and Judge Kozinski battled over this notion of hypothetical alternative cause. Kozinski rejected it, arguing that because "infringement can always be carried out by other means," the existence of alternative sources of aid should not prevent satisfaction of the material contribution standard.[253] The majority, however, suggested that the existence of other viable funding mechanisms demonstrated that Visa's provision of payment services was not material.[254]

A viable causation theory for intellectual property protection requires that the existence of hypothetical alternative causes not be allowed to break otherwise sufficient causative chains.[255] A contrary rule would contradict established precedent. Just as there are other ways than Visa to submit payments online, there are other search engines than Google. Under the *Visa* majority's rationale, the Google search engine could not materially contribute to infringement by touting infringing websites because consumers could choose to locate the infringing websites through other search engines. Yet the Ninth Circuit found that Google could be contributorily liable while exempting Visa. For consistency, a

251. *See* Millner v. Schofield, 17 F. Cas. 392, 392–93 (Va. Cir. Ct. 1881) (No. 9609A).

252. Dressler, *supra* note 118, at 131.

253. Perfect 10, Inc. v. Visa Int'l Serv. Ass'n, 494 F.3d 788, 814 (9th Cir. 2007).

254. *Id.* at 797–98.

255. *See* HART & HONORÉ, *supra* note 174, at 249 ("In the case of a hypothetical alternative cause, the generally accepted view is that defendant's wrongful or criminal act has caused the harm, for which the wrongdoer is therefore criminally or civilly responsible, despite the existence of a set of alternative conditions sufficient to produce the same harm.").

hypothetical alternative supplier of online payment services should not break the causal chain.

More importantly, a theory of causation that recognizes that an actor can *cause* infringement by another even if hypothetical alternative causers were available to perform the same actions matches our own intuitive view of when facilitation of a wrong should result in responsibility. For example, if a friend lets me borrow his car and, due to years of wear and tear, the car breaks down during my drive, I feel some responsibility for returning a nonworking car to my friend. I would apologize to my friend even though the breaking down of the car was not my fault, and I drove the car in a normal manner. In a sense, the breaking down of the car during the time period when I borrowed it is mere chance. If my friend had lent the car to one other person immediately before me, that person would have brought back a nonfunctional car, not me. Nevertheless, because I was the one whose willful physical action resulted in the car breaking down, I accept some responsibility. Under the *Visa* majority's reasoning, a business that provides a service to the direct infringer can always avoid liability if another business exists to take its place. Our own intuition suggests, however, that the actor that contributed to an event bears responsibility even if another hypothetical actor could have just as easily substituted in that actor's stead.[256]

3. Failures to act and abnormal environmental causes

Our causation theory also needs to address passive contributions to infringement. Sometimes the contributor's causing of the infringement will be obvious, as in the case of a business that supplies a component that can only be used in a device that infringes another's patent. But for that component, the direct infringer could

256. In some situations, we may intuitively believe that the supplier's contribution is too minimal to justify the imposition of contributory liability even if the supplier's contribution is "necessary" for the infringing activity to occur. For example, the *Visa* majority fretted that an overly broad reading of the *Napster* definition of "material contribution" would make liable not only credit card companies but even utilities that provide the electricity necessary for operation of infringing websites. *Visa*, 494 F.2d at 800. While it may be necessary to screen out certain de minimis activities from the material contribution requirement, the existing doctrine should obviate some of the majority's concerns as it requires knowledge of infringement for liability and exempts contributory defendants that distribute staple articles of commerce without the intent to cause infringement. *See supra* Part I.A.1.

never have assembled the materials that allowed him to infringe.[257] In other situations, however, the defendant does not take any affirmative physical action that immediately aids the direct infringer. A landlord may provide the site and facilities where the trademark infringement occurs but does nothing else to facilitate the sale of counterfeit goods.[258] A radio station may unknowingly permit a purchaser of air time to play copyrighted music but offer no other assistance to the purchaser's infringement and still be held liable.[259] The causation principles for contributory infringement should take into account situations where the contributor undertakes no specific willful act that facilitates the infringement but by failing to act may still be responsible for creating the environment where the infringement can occur.

Accountability for certain failures to act comports with intuitive notions of responsibility. Even when our affirmative willful behavior is not directly involved, we often feel responsible when an injury occurs in our presence that we could have prevented. Failure to act, under the right circumstances, is commonly viewed in causal terms.[260] If someone drowns in my swimming pool, I feel accountable. Even if the victim was not an invited guest and entered my pool without my knowledge, I may still feel a sense of responsibility for not preventing her death.

Historically, courts have been reluctant to find entities liable for inaction.[261] Nevertheless, liability for nonfeasance is an essential part of the law.[262] When the defendant's behavior amounts to a failure to act, the trier of fact engages in an especially searching analysis of the circumstances of the plaintiff's injury to determine if the defendant's behavior falls under an exception to the general rule that defendants

257. *See, e.g.*, Wallace v. Holmes, 29 F. Cas. 74, 80 (Conn. Cir. Ct. 1871) (No. 17,100).

258. *See, e.g.*, Habeeba's Dance of the Arts v. Knoblauch, 430 F. Supp. 2d 709, 711–12, 714 (S.D. Ohio 2006).

259. *See* Rodgers v. Quests, Inc., 213 U.S.P.Q. 212, 214 (N.D. Ohio 1981).

260. *See* HART & HONORÉ, *supra* note 174, at 2–3.

261. *See, e.g.*, DeShaney v. Winnebago County, 489 U.S. 189, 200–02 (1989) (distinguishing between "the State's affirmative act of restraining the individual's freedom," which triggers the protections of the Due Process Clause, and the State's failure to act to protect the individual's liberty interests, which does not).

262. *See* Andrew Weissman & David Newman, *Rethinking Criminal Corporate Law*, 82 IND. L.J. 411, 418–20 (2008) (describing the gradual retreat from misfeasance/nonfeasance distinction in American law).

are not liable in tort for a failure to act for the plaintiff's benefit.[263]

To assess whether the responsibility I feel for my failure to prevent the drowning in my pool should give rise to legal accountability, the circumstances surrounding the victim's death must be scrutinized to look for the presence of anything unusual. In ferreting out the cause of illegal actions, courts assess whether the behavior at issue should be considered a "cause" or a "condition."[264] A condition is a typically present environmental factor that leads to a result.[265] The presence of oxygen is necessary for a house to catch on fire, yet we would not describe the presence of oxygen as a cause of the fire. Instead, the presence of oxygen is a condition. By contrast, a cause is something that provides an explanation as to why a result occurred. A child playing with matches would be deemed a cause of the fire, not a condition. A parent's failure to supervise the child while that child was in the proximity of matches might be deemed a cause as well. In determining why the victim drowned in my pool, bystanders would ask whether there was anything unusual about my home or pool that attracted the victim. Did I somehow advertise the presence of the pool to the neighborhood? Did I maintain my pool in an inherently unsafe manner? Was the placement of my pool unusually accessible to trespassers? Did I typically observe and prevent outsiders from entering my pool area and fail to do that on this occasion? The point of such questions is to determine whether some behavior of mine can be labeled as an abnormal factor in the victim's death, and thus a cause and not a condition. When a contributory infringer behaves in a non-routine fashion, this is important circumstantial evidence of causation.[266]

The difference between cause and condition is a useful way to explain the disparate contributory infringement holdings in the *Visa* and *Amazon.com* cases. First, Perfect 10's claim against Visa focused on Visa's failure to prevent infringing behavior. As mentioned above, courts are less likely to find liability for a failure to act as compared to evidence of affirmative misconduct. Given Visa's attenuated relationship to the directly infringing websites, it would have been

263. *See* DAN C. DOBBS, THE LAW OF TORTS 853–55 (2000).

264. *See* HART & HONORÉ, *supra* note 174, at 35.

265. *See id.*

266. *Cf.* Lockheed Martin Corp. v. Network Solutions, Inc., 194 F.3d 980, 984–85 (9th Cir. 1999) (finding domain name registrar not liable for contributory trademark infringement after noting the routine nature of the registrar's routing services).

particularly difficult for Perfect 10 to argue that Visa's behavior constituted affirmative aid to the infringers. Businesses looking to accept online credit card payments do not arrange for acceptance of such payments with Visa directly. Instead, they contact what Visa labels "acquirers," i.e., merchant banks. Visa remains in the background, leaving it to the merchant banks to process the actual transactions.[267] Because Visa does not engage in any significant activity with businesses that transact with the merchant banks that are part of its network, its role in the infringement could only be construed as a failure to act.[268]

Second, Visa's failure to act represented a typical condition of the commercial environment. The payment processing services at issue in *Visa* were entirely routine. Visa does not tailor its services for each individual business.[269] In non-infringement contexts, credit card companies have been found contributorily liable, but only because they altered their typical services in a way that facilitated the conduct of the direct tortfeasor.[270] But in its involvement with the websites that infringed on Perfect 10's rights, Visa did nothing to depart from standard operating procedure. Judge Kozinski maintained in his dissent that Visa's contribution to the infringing websites was material because the ability to accept credit card payments is crucial to internet commerce.[271] While that may be true, the real question a court should be asking is whether Visa behaved unusually with regard to the infringing transaction. From the facts at hand, it appears that Visa helped arrange the processing of payments that allowed the infringement to take place, but Visa was in no sense

267. *See* Accept Visa Online, http://usa.Visa.com/merchants/new_acceptance/accept_online.html (last visited Sept. 15, 2009) (directing businesses to contact an acquirer to set up online payments with Visa).

268. One way for a court to determine whether the defendant's action is a cause or a condition is to ascertain whether the contributor was present at the moment of illegal conduct. *See* RESTATEMENT (SECOND) OF TORTS § 876(b) cmt. d (1979). Not only does presence offer circumstantial evidence that may allow a court to infer knowledge, but it also may allow a court to conclude that the contributor's behavior was out of the ordinary. Of course, mere presence, by itself, is not enough to demonstrate causation, but it may serve as an important sign that the defendant's behavior was causal.

269 *See In re* Visa Check/MasterMoney Antitrust Litig., 280 F.3d 124, 137 (2d Cir. 2001) (affirming district court finding that Visa does not engage in merchant-specific pricing).

270. *See, e.g.*, Schulz v. Neovi Data Corp., 60 Cal. Rptr. 3d 810, 817–18 (Cal. Ct. App. 2007).

271. Perfect 10, Inc. v. Visa Int'l Serv. Ass'n., 494 F.3d 788, 810–14 (9th Cir. 2007) (Kozinski, J., dissenting).

actively facilitating infringement or engaging in any behavior different from its standard business practices for accepting credit card transactions. Because Visa's behavior was neither active nor out of the ordinary, it can be described as a condition of infringement but not its cause.

By contrast, Google's conduct may be described as active and abnormal, a cause rather than a condition. Google's actions were qualitatively more affirmative and intimately involved with the infringers and their infringing content than Visa's actions. To catalog the infringing websites' content, Google scanned the infringing websites and then stored images of the infringing websites on its servers.[272] In addition, Google framed the infringing content alongside its own content. When a consumer viewed a thumbnail image from the infringing website in Google's search listings and clicked on that image, the consumer's computer screen was filled with both the Google search listings page and the content from the infringing websites.[273] As Google's contact with the infringing content became more intimate, its conduct appeared less like a failure to act and more like active facilitation. We are naturally more willing to attribute causal responsibility to affirmative conduct than to passive behavior.[274] Although it did not indicate that it was applying causative principles, the affirmative character of Google's behavior may have convinced the court to find in favor of Perfect 10.[275]

Google's conduct may also be seen as more out of the ordinary than Visa's. On the one hand, there is no indication that Google treated images from infringing websites differently than images from noninfringing websites. On the other hand, Google employed a radically new technology to scan, store, and provide copyrighted images for mass consumption. In evaluating Google's *direct* liability under the fair use doctrine, the Ninth Circuit even described its actions as "highly transformative."[276] Thus, while Visa's processing of payments from merchants represented an activity that had been taking place for years, Google's new search technology represented a

272. *See* Perfect 10 v. Google, Inc., 416 F. Supp. 2d 828, 832–33 (C.D. Cal. 2006).

273. *Id*.

274. HART & HONORÉ, *supra* note 174, at 64.

275. *Visa*, 494 F.3d at 801–02 (distinguishing the *Google* case as involving allegation of "specific acts" designed to encourage infringement).

276. Perfect 10, Inc. v. Amazon.com, Inc., 508 F.3d 1146, 1165 (9th Cir. 2007).

dramatic break from the status quo.

One danger in applying traditional causative principles to these disputes is that courts might focus too much on whether the contributory defendant's conduct was abnormal, penalizing those businesses that invest in innovative technologies. One other causative principle should help protect technologists from liability, however. Liability for failure to act should only satisfy the material contribution standard when the defendant also has the ability to correct the infringing activity. If the contributor is present but has no ability to stop the infringing behavior, then there is no causation. A defendant can hardly be deemed to have caused an event through a failure to act if it could not have prevented the event in the first place.[277] Again, this comports with our intuitive sense of causation and responsibility. When someone comes to my house and drowns in my swimming pool, I feel some responsibility, even if I took all reasonable precautions beforehand, because there was probably some way for me to stop the victim from drowning. On the other hand, if a plane crashes into my house, I do not feel responsibility for the deaths of the passengers. The difference is that there was nothing within my power to prevent the plane crash, but conceivably simple actions could have prevented the drowning in my pool. If Google's contributory liability makes sense, it makes sense because it had the ability to stop the infringing conduct but failed to do so.[278]

Looking for unusual or abnormal behavior in cases involving an alleged contributor's failure to act is a better indicator of causation than "control," which, as discussed earlier, is often cited by the courts in determining material contribution.[279] Use of the term "control" threatens to import *vicarious* liability standards into an evaluation of *contributory* liability. When the relationship between the direct infringer and the defendant is one that gives the defendant the right and ability to supervise the conduct of the direct infringer, imposition of vicarious liability is permitted.[280] Evaluation of the

277. *See, e.g.*, Pulka v. Edelman, 358 N.E.2d 1019, 1021 (N.Y. 1976).

278. Although the Ninth Circuit remanded for further consideration of Google's ability to refrain from providing access to the infringing websites, the court seemed to suggest that Google did have such an ability as it analogized Google's situation to the Napster file sharing system and the operator of an electronic bulletin board, both of which had been found to have the capability of preventing the infringing activity and were held contributorily liable. Perfect 10, Inc. v. Amazon.com, Inc., 487 F.3d 701, 728 (9th Cir. 2007).

279. *See supra* footnotes 57–58 and accompanying text.

280. *See, e.g.*, Gershwin Publ'g Corp. v. Columbia Artists Mgmt., Inc., 443 F.2d 1159,

right and ability to supervise is dangerously similar, however, to evaluation of the contributor's control over the direct infringer. Vicarious and contributory responsibility are two markedly different theories of secondary liability, and their standards should not be mixed.[281] Vicarious liability imposes liability on a defendant in the absence of any knowledge, action, or contribution to the infringement whatsoever. Instead, the doctrine simply allocates the costs of infringement to an intermediary based on that intermediary's relationship to the direct infringer.[282] Contributory infringement law, by contrast, is designed to address those situations where liability can only be justified on the basis of blameworthiness, and not mere agency. And one way of assessing personal blame is to assess whether the defendant *caused* the illegal act.[283]

B. Inducement: Liability Without Causation

An objection might be made that a causation standard for contributory liability's material contribution requirement would exempt some parties that we intuitively believe should be liable. One can envision a scenario where the defendant tries to encourage the direct infringer's illegal activity, but the direct infringer misses the defendant's cues or already has its mind made up and does not need any additional egging on to commit the act of infringement. The defendant might argue in such a situation that its relationship to the ultimate act of infringement is in no way causal, and, therefore, it has not made a material contribution. If infringement law's theoretical basis is exclusively consequentialist, then the defendant should bear no responsibility for conduct that has no effect on the underlying act of infringement.

If only the knowing facilitation analysis of contributory infringement were available, the defendant would be correct. But in

1162 (2d Cir. 1971).

281. *See* Cartoon Network v. CSC Holdings, Inc., 536 F.3d 121, 133 (2d Cir. 2008) (discussing the court's "duty to discern" the difference between contributory, vicarious, and direct infringement).

282. *See, e.g.*, Fare Deals, Ltd. v. World Choice Travel.com, Inc., 180 F. Supp. 2d 678, 685–86 (D. Md. 2001) (explaining the necessity of an agency relationship to find vicarious liability).

283. GLENYS WILLIAMS, INTENTION AND CAUSATION IN MEDICAL NON-KILLING: THE IMPACT OF CRIMINAL LAW CONCEPTS ON EUTHANASIA AND ASSISTED SUICIDE 7 (2007) (describing causation as a crucial "governing factor in establishing blameworthiness and liability").

this limited situation, infringement law can take on a retributive flavor, and lessons learned from accomplice liability prove helpful. In the scenario outlined above, the nexus between the mental state of the defendant and the act of direct infringement is tight. The defendant specifically intends the infringement. In criminal law, when the accomplice specifically intends for the perpetrator's act to occur, proof of causation from the accomplice's activity is unnecessary. As with the case of the telegram sender in Alabama, for accomplice liability the key issue is whether the accomplice unmistakably endorsed the perpetrator's criminal behavior, not whether the accomplice's behavior actually caused the criminal act.[284]

Like accomplice liability, the inducement infringement doctrine punishes actors based largely on the expressive content of their actions. It represents a temporary departure from the utilitarian calculations of most intellectual property law. The Supreme Court has held that no safe harbor exists for a contributory defendant who supplies a device capable of substantial noninfringing uses but who also specifically intends for infringement to occur.[285] Thus, a finding of intent to induce infringement forces a court to ignore the consequences of restricting the behavior of an intellectual property intermediary.

The justification for such a causation-free system of liability lies in the same retribution principles that animate criminal jurisprudence. Criminal law examines two criteria in determining whether the accused's behavior warrants punishment. First, there is the subjective question of whether the accused expected harm as a result of her actions. For the most part, actions that are taken unintentionally or involuntarily are not subject to criminal sanction.[286] The reason for this is that it would be unfair to impose suffering on someone who only acted involuntarily. It would strike too severe of a blow against personal freedom if the state could punish citizens' actions that were not made of their own free will.[287]

284. *See supra* Part IV.A.

285. MGM Studios, Inc. v. Grokster, Ltd., 545 U.S. 913, 934–37 (2005).

286. *See* Binder, *supra* note 182, at 1049 ("Traditionally, harm has been seen as most culpable when caused on purpose."); Hall, *supra* note 9, at 777 (stating that the rule that "moral culpability is posited on volitional conduct" is a "fundamental axiom of ethics").

287. *See* KUTZ, *supra* note 92, at 204 ("Unless citizens can reasonably predict and control the imposition of legal sanctions, they cannot lead good and meaningful lives within the law's constraints.").

Second, the law investigates the reason behind the defendant's decision to act despite an awareness that his behavior would result in harm. Some reasons for acting in a harmful manner are adequate and absolve the defendant from liability. For example, a motivation of self-defense justifies a defendant's acting with the intent to cause harm. But when the defendant elects to cause harm in a manner that flaunts deep-seated, widely accepted social beliefs, criminal sanctions are justified.[288] Criminal law doctrine condemns the murderer who kills for financial gain and the rapist who violates another for personal pleasure.[289] It is the expression of values that unmistakably clash with honored, accepted social values that subjects one to a criminal sanction, even for crimes that were only attempted but not consummated, or for actions that merely aided the criminal activity of another.[290]

Although it would be cruel and unusual to subject the contributory infringer to the same sanctions as the murderer or the rapist, the same justifications animate liability for the inducing variety of contributory infringement. As articulated by the Supreme Court in its *Grokster* opinion, the inducement analysis does not rely on the consequences of infringing behavior.[291] Instead, as with criminal accomplice liability, liability for inducement infringement punishes people for their outward expressions of commitment to unworthy values. In evaluating whether a defendant is liable for the inducement variety of contributory infringement, a court should evaluate whether the two criteria for criminal punishment have been satisfied.

Take the most common example in the case law on inducing infringement: the manufacture or distribution of a device that allows others to infringe. Assume that the manufacturer knows that the device can be used to infringe but that the device also allows others

288. *See* Binder, *supra* note 182, at 1050 ("Whether costs are assigned to an activity depends on its moral worth.").

289. *See* Moohr, *supra* note 160, at 749 (remarking that, under a theory of retributivism, criminal law punishes only "morally wrong conduct" and the moral code likely derives from community norms and ideals of right and wrong).

290. The imposition of liability under the felony murder rule operates on similar principles. The felony murder rule permits the imposition of criminal sanctions for murder on those who knowingly expect harm to result from their actions and facilitate that harm for socially unacceptable reasons. *See* Binder, *supra* note 182, at 967.

291. MGM Studios, Inc. v. Grokster, Ltd., 545 U.S. 913, 940 (2005).

to make noninfringing use of intellectual property.[292] Although the manufacturer knows that the device may be used by some in a completely lawful, nonharmful manner, it also knows that others can use the device to subvert the intellectual property interests of the rights holder. In this situation, the first criterion for the imposition of sanctions under criminal law, expectation of harm, is met. The manufacturer knows its device fosters infringement that will reduce the value of the property interest held by the rights holder.

The second criterion for imposing criminal sanctions is that the defendant's reason for acting in a manner that can cause harm is socially unacceptable. To satisfy this criterion, the defendant's reasoning cannot be susceptible to multiple interpretations or fall into an ambiguous moral area. Instead, it must be unmistakable that the reasons for imposing harm on others clash with generally accepted ethical principles. The inducement doctrine tracks this criterion. For inducement infringement to be found, there must be a "clear expression" of the intent to facilitate infringement.[293] In the Supreme Court's view, the Grokster file sharing service was liable because "[t]he unlawful objective [was] unmistakable."[294] In other words, Grokster's actions were not susceptible to multiple interpretations. Grokster satisfied the second criterion under criminal law because the reasons for its decision to act in a way that harmed the interests of copyright holders were indefensible. Grokster, by seeking to profit through infringing acts of others, expressed a reason for its conduct that was offensive to basic values of property ownership.

On the other hand, when a defendant knowingly distributes a device capable of some infringement but justifies its behavior through a belief that downstream users of the device will be engaging in fair use, then the second criterion for criminal liability is not satisfied. For someone to be guilty of inducing infringement, they must know that the behavior they are intentionally encouraging is illegal. If the defendant is not choosing to engage in the harmful activity for a socially unacceptable reason, the justification for criminal liability drops away. Thus, to the extent that courts have left

292. *See, e.g.*, Monotype Imaging, Inc. v. Bitstream, Inc., 376 F. Supp. 2d 877 (N.D. Ill. 2005) (defendant manufactured software program that purchasers could use to replicate copyrighted typeface).

293. *Grokster*, 545 U.S. at 919.

294. *Id.* at 940.

this question unresolved, a claim for inducement infringement should not be available when the contributory defendant subjectively believes in the legality of the direct infringer's conduct.[295]

As with accomplice liability, the standard for inducement infringement must be construed rigorously to avoid false positives. By trumping the safe harbor established for substantially non-infringing devices, inducement theory represents a significant weapon in the hands of intellectual property rights holders. As a result, the plaintiff should be able to use the doctrine only when the contributory infringer's specific intent to infringe is apparent and unmistakable. Simply knowing that infringement is likely is not enough. Given the ambiguous nature of the fair use defense in copyright and trademark law[296] and the inherent difficulties in determining specific intent,[297] liability for intentional inducement of infringement should be rare.

VI. CONCLUSION

Courts seeking to plug the doctrinal holes of contributory infringement have resorted to analogies from criminal law. At first glance, criminal contributory liability principles seem like a natural fit. Like intellectual property law, criminal law holds some individuals accountable for the illegal acts of others based on their own actions and mental state. But accomplice liability is very different from the current incarnation of contributory infringement doctrine. Whereas a contributory infringer must "materially" contribute to the infringement, an accomplice's actions need not make a difference to the performance of the ultimate criminal act. And while for most crimes it must be proved that the accomplice intended for the criminal activity to occur, a contributory infringement defendant may be liable even if she was indifferent to the direct infringer's conduct.

It would be a mistake to treat accused contributory infringers as a type of accomplice. Differences in proof and available evidence mandate a different contributory liability regime for intellectual

295. *See supra* Part II.B.

296. *See* Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1165 (2003); Erez Reuveni, *Authorship in the Age of the Conducer*, 54 J. COPYRIGHT SOC'Y U.S.A. 285, 312 (2007).

297. *See supra* Part IV.B.

property infringement. Causation offers an intuitive method for assessing the responsibility of one actor for the actions of another. Applying causative theory, the material contribution requirement for knowing facilitation of infringement would be satisfied when the infringement would not have occurred but for the accused contributor's behavior. Certain failures to act should also result in contributory liability, but only when the failure to act represents a departure from background norms. On the other hand, criminal law does offer some guidance for courts struggling to define the boundaries of inducement infringement, where evidence of a culpable mental state is more important than the materiality of the contributor's conduct. These suggested approaches to contributory infringement doctrine match common sense expectations of the responsibility we owe to others. Parties to contributory infringement suits deserve predictable and consistent rulings. They also deserve a body of doctrine that comports with social intuitions of fairness and blame.