

SUPREME COURT OF THE UNITED STATES

545 U.S. 913

METRO-GOLDWYN-MAYER STUDIOS INC. ET AL. v. GROKSTER, LTD., ET AL.

CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

No. 04—480 Argued: March 29, 2005 --- Decided: June 27, 2005

Respondent companies distribute free software that allows computer users to share electronic files through peer-to-peer networks, so called because the computers communicate directly with each other, not through central servers. Although such networks can be used to share any type of digital file, recipients of respondents' software have mostly used them to share copyrighted music and video files without authorization. Seeking damages and an injunction, a group of movie studios and other copyright holders (hereinafter MGM) sued respondents for their users' copyright infringements, alleging that respondents knowingly and intentionally distributed their software to enable users to infringe copyrighted works in violation of the Copyright Act.

Discovery revealed that billions of files are shared across peer-to-peer networks each month. Respondents are aware that users employ their software primarily to download copyrighted files, although the decentralized networks do not reveal which files are copied, and when. Respondents have sometimes learned about the infringement directly when users have e-mailed questions regarding copyrighted works, and respondents have replied with guidance. Respondents are not merely passive recipients of information about infringement. The record is replete with evidence that when they began to distribute their free software, each of them clearly voiced the objective that recipients use the software to download copyrighted works and took active steps to encourage infringement. After the notorious file-sharing service, Napster, was sued by copyright holders for facilitating copyright infringement, both respondents promoted and marketed themselves as Napster alternatives. They receive no revenue from users, but, instead, generate income by selling advertising space, then streaming the advertising to their users. As the number of users increases, advertising opportunities are worth more. There is no evidence that either respondent made an effort to filter copyrighted material from users' downloads or otherwise to impede the sharing of copyrighted files.

While acknowledging that respondents' users had directly infringed MGM's copyrights, the District Court nonetheless granted respondents summary judgment as to liability arising from distribution of their software. The Ninth Circuit affirmed. It read *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U. S. 417, as holding that the distribution of a commercial product capable of substantial noninfringing uses could not give rise to contributory liability for infringement unless the distributor had actual knowledge of specific instances of infringement and failed to act on that knowledge. Because the appeals court found respondents' software to be capable of substantial noninfringing uses and because respondents had no actual knowledge of infringement owing to the software's decentralized architecture, the court held that they were not liable. It also held that they did not materially contribute to their users' infringement because the users themselves searched for, retrieved, and stored the infringing files, with no involvement by respondents beyond providing the software in the first place. Finally, the court held that respondents could not be held liable under a vicarious infringement theory because they did not monitor or control the software's use, had no agreed upon right or current ability to supervise its use, and had no independent duty to police infringement.

Held: One who distributes a device with the object of promoting its use to infringe copyright, as shown by clear expression or other affirmative steps taken to foster infringement, going beyond mere distribution with knowledge of third party action, is liable for the resulting acts of infringement by third parties using the device, regardless of the device's lawful uses. Pp. 928–941.

(a) The tension between the competing values of supporting creativity through copyright protection and promoting technological innovation by limiting infringement liability is the subject of this case.

Despite offsetting considerations, the argument for imposing indirect liability here is powerful, given the number of infringing downloads that occur daily using respondents' software. When a widely shared product is used to commit infringement, it may be impossible to enforce rights in the protected work effectively against all direct infringers, so that the only practical alternative is to go against the device's distributor for secondary liability on a theory of contributory or vicarious infringement. One infringes contributorily by intentionally inducing or encouraging direct infringement, and infringes vicariously by profiting from direct infringement while declining to exercise the right to stop or limit it. Although "[t]he Copyright Act does not expressly render anyone liable for [another's] infringement," *Sony*, 464 U. S., at 434, these secondary liability doctrines emerged from common law principles and are well established in the law, *e. g., id.*, at 486. Pp. 928–931.

(b) *Sony* addressed a claim that secondary liability for infringement can arise from the very distribution of a commercial product. There, copyright holders sued Sony, the manufacturer of videocassette recorders, claiming that it was contributorily liable for the infringement that occurred when VCR owners taped copyrighted programs. The evidence showed that the VCR's principal use was "time-shifting," *i.e.*, taping a program for later viewing at a more convenient time, which the Court found to be a fair, noninfringing use. 464 U.S., at 423–424. Moreover, there was no evidence that Sony had desired to bring about taping in violation of copyright or taken active steps to increase its profits from unlawful taping. *Id.*, at 438. On those facts, the only conceivable basis for liability was on a theory of contributory infringement through distribution of a product. *Id.*, at 439. Because the VCR was "capable of commercially significant noninfringing uses," the Court held that Sony was not liable. *Id.*, at 442. This theory reflected patent law's traditional staple article of commerce doctrine that distribution of a component of a patented device will not violate the patent if it is suitable for use in other ways. 35 U.S.C. §271(c). The doctrine absolves the equivocal conduct of selling an item with lawful and unlawful uses and limits liability to instances of more acute fault. In this case, the Ninth Circuit misread *Sony* to mean that when a product is capable of substantial lawful use, the producer cannot be held contributorily liable for third parties' infringing use of it, even when an actual purpose to cause infringing use is shown, unless the distributors had specific knowledge of infringement at a time when they contributed to the infringement and failed to act upon that information. *Sony* did not displace other secondary liability theories. Pp. 931–934.

(c) Nothing in *Sony* requires courts to ignore evidence of intent to promote infringement if such evidence exists. It was never meant to foreclose rules of fault-based liability derived from the common law. 464 U.S., at 439. Where evidence goes beyond a product's characteristics or the knowledge that it may be put to infringing uses, and shows statements or actions directed to promoting infringement, *Sony's* staple-article rule will not preclude liability. At common law a copyright or patent defendant who "not only expected but invoked [infringing use] by advertisement" was liable for infringement. *Kalem Co. v. Harper Brothers*, 222 U.S. 55, 62–63. The rule on inducement of infringement as developed in the early cases is no different today. Evidence of active steps taken to encourage direct infringement, such as advertising an infringing use or instructing how to engage in an infringing use, shows an affirmative intent that the product be used to infringe, and overcomes the law's reluctance to find liability when a defendant merely sells a commercial product suitable for some lawful use. A rule that premises liability on purposeful, culpable expression and conduct does nothing to compromise legitimate commerce or discourage innovation having a lawful promise. Pp. 934–937.

(d) On the record presented, respondents' unlawful objective is unmistakable. The classic instance of inducement is by advertisement or solicitation that broadcasts a message designed to stimulate others to commit violations. MGM argues persuasively that such a message is shown here. Three features of the evidence of intent are particularly notable. First, each of the respondents showed itself to be aiming to satisfy a known source of demand for copyright infringement, the market comprising former Napster users. Respondents' efforts to supply services to former Napster users indicate a principal, if not exclusive, intent to bring about infringement. Second, neither respondent attempted to develop filtering tools or other mechanisms to diminish the infringing activity using their

software. While the Ninth Circuit treated that failure as irrelevant because respondents lacked an independent duty to monitor their users' activity, this evidence underscores their intentional facilitation of their users' infringement. Third, respondents make money by selling advertising space, then by directing ads to the screens of computers employing their software. The more their software is used, the more ads are sent out and the greater the advertising revenue. Since the extent of the software's use determines the gain to the distributors, the commercial sense of their enterprise turns on high-volume use, which the record shows is infringing. This evidence alone would not justify an inference of unlawful intent, but its import is clear in the entire record's context. Pp. 937—940.

(e) In addition to intent to bring about infringement and distribution of a device suitable for infringing use, the inducement theory requires evidence of actual infringement by recipients of the device, the software in this case. There is evidence of such infringement on a gigantic scale. Because substantial evidence supports MGM on all elements, summary judgment for respondents was error. On remand, reconsideration of MGM's summary judgment motion will be in order. Pp. 940—910.

380 F.3d 1154, vacated and remanded.

SOUTER, J., delivered the opinion for a unanimous Court. GINSBURG, J., filed a concurring opinion, in which REHNQUIST, C. J., and KENNEDY, J., joined, *post*, p. 942. BREYER, J., filed a concurring opinion, in which STEVENS and O'CONNOR, JJ., joined, *post*, p. 949.

Donald B. Verrilli, Jr., argued the cause for petitioners. With him on the briefs for the motion picture studio and recording company petitioners were *Ian Heath Gershengorn, William M. Hohengarten, Steven B. Fabrizio, Thomas J. Perrelli, Matthew J. Oppenheim, David E. Kendall, Thomas G. Hentoff, Kenneth W. Starr, Russell J. Frackman, George M. Borkowski, Robert M. Schwartz, Gregory P. Goeckner, Dean C. Garfield, Elaine J. Goldenberg, Matthew Hersh, Steven M. Marks, and Stanley Pierre-Louis. Carey R. Ramos, Peter L. Felcher, Aidan Synnott, Theodore K. Cheng, Kelli L. Sager, Andrew J. Thomas, Jeffrey H. Blum, and Jeffrey L. Fisher* filed briefs for the songwriter and music publisher petitioners.

Acting Solicitor General Clement argued the cause for the United States as *amicus curiae* urging reversal. With him on the brief were *Assistant Attorney General Keisler, Deputy Solicitor General Hungar, Douglas H. Hallward-Driemeier, Anthony A. Yang, David O. Carson, and John M. Whealan.*

Richard G. Taranto argued the cause for respondents. With him on the brief were *H. Bartow Farr III, Cindy A. Cohn, Fred Von Lohmann, Michael H. Page, Mark A. Lemley, Charles S. Baker, and Matthew A. Neco.*^[1]

1. [Jump up](#) Briefs of *amici curiae* urging reversal were filed for the State of Utah et al. by *Mark Shurtleff*, Attorney General of Utah, and by the Attorneys General for their respective jurisdictions as follows: *Troy King* of Alabama, *Gregg Renkes* of Alaska, *Terry Goddard* of Arizona, *Mike Beebe* of Arkansas, *M. Jane Brady* of Delaware, *Charles J. Crist, Jr.*, of Florida, *Thurbert E. Baker* of Georgia, *Douglas B. Moylan* of Guam, *Mark J. Bennett* of Hawaii, *Lawrence G. Wasden* of Idaho, *Lisa Madigan* of Illinois, *Steve Carter* of Indiana, *Phill Kline* of Kansas, *Gregory D. Stumbo* of Kentucky, *Charles C. Foti, Jr.*, of Louisiana, *Thomas F. Reilly* of Massachusetts, *Michael A. Cox* of Michigan, *Mike Hatch* of Minnesota, *Jim Hood* of Mississippi, *Jeremiah W. (Jay) Nixon* of Missouri, *Mike McGrath* of Montana, *Jon Bruning* of Nebraska, *Brian Sandoval* of Nevada, *Peter C. Harvey* of New Jersey, *Patricia A. Madrid* of New Mexico, *Roy Cooper* of North Carolina, *Wayne Stenehjem* of North Dakota, *Jim Petro* of Ohio, *W. A. Drew Edmondson* of Oklahoma, *Thomas W. Corbett, Jr.*, of Pennsylvania, *Patrick Lynch* of Rhode Island, *Henry McMaster* of South Carolina, *Lawrence E. Long* of South Dakota, *Paul G. Summers* of Tennessee, *Greg Abbott* of Texas, *William H. Sorrell* of Vermont, *Jerry Kilgore* of Virginia, *Darrell V. McGraw, Jr.*, of West Virginia, and *Peg Lautenschlager* of Wisconsin; for the American Federation of Musicians of the United States and Canada et al. by *George H. Cohen, Patricia Polach, and Laurence Gold*; for the American Society of Composers, Authors and Publishers et al. by *I. Fred Koenigsberg, Michael E. Salzman, and Marvin L. Berenson*; for Americans for Tax Reform by *Carter G. Phillips, Alan Charles Raul, Jay T. Jorgensen, and Eric A. Shumsky*; for the Commissioner of Baseball et al. by *Robert Alan Garrett and Hadrian R. Katz*; for Defenders of Property Rights by *Theodore B. Olson, Thomas H. Dupree, Jr., Matthew D. McGill, Nancie G. Marzulla, and Roger Marzulla*; for International Rights Owners by *Christopher Wolf*; for Kids First Coalition et al. by *Viet D. Dinh*; for Law Professors et al. by *James Gibson*; for Macrovision Corp. by *Geoffrey L. Beauchamp, Kelly G. Huller, and James H. Salter*; for Napster, LLC, et al. by *Barry I. Slotnick*; for the National Academy of Recording Arts & Sciences, Inc., et al. by *Jon A. Baumgarten and Jay L.*

Cooper; for the National Association of Broadcasters by *Marsha J. MacBride, Jane E. Mago, Benjamin F. P. Ivins, and Jerianne Timmerman*; for the National Association of Recording Merchandisers by *Alan R. Malasky and Melanie Martin Jones*; for the Progress & Freedom Foundation by *James V. DeLong*; for the Video Software Dealers Association by *John T. Mitchell*; and for Professor Peter S. Menell et al. by *Mr. Menell, pro se*.

Briefs of *amici curiae* urging affirmance were filed for Altnet, Inc., by *Roderick G. Dorman*; for the American Civil Liberties Union et al. by *Christopher A. Hansen, Steven R. Shapiro, Sharon M. McGowan, Ann Brick, and Jordan C. Budd*; for the American Conservative Union et al. by *David Post*; for the Cellular Telecommunications & Internet Association et al. by *Andrew G. McBride, Joshua S. Turner, Michael Altschul, James W. Olson, Frank L. Politano, Laura Kaster, Jeffrey A. Rackow, Grier C. Raclin, Michael Standard, John Thorne, Sarah B. Deutsch, and Paul J. Larkin, Jr.*; for the Consumer Electronics Association et al. by *Bruce G. Joseph and Scott E. Bain*; for the Consumer Federation of America et al. by *Peter Jaszi*; for the Distributed Computing Industry Association by *Mr. Dorman*; for the Eagle Forum Education & Legal Defense Fund by *Andrew L. Schlafly and Karen B. Tripp*; for the Free Software Foundation et al. by *Eben Moglen*; for Intel Corp. by *James M. Burger and Jonathan D. Hart*; for Internet Law Faculty by *William W. Fisher III and Jonathan Zittrain*; for Law Professors by *J. Glynn Lunney, Jr.*; for the National Association of Shareholder and Consumer Attorneys by *Kevin P. Roddy and Matthew E. Van Tine*; for Sixty Intellectual Property and Technology Law Professors et al. by *Deirdre K. Mulligan and Pamela Samuelson*; for Sovereign Artists et al. by *James R. Wheaton*; for Computer Science Professor Harold Abelson et al. by *James S. Tyre*; for Professor Edward Lee et al. by *Mr. Lee, pro se*; for Charles Nesson by *Mr. Nesson, pro se*; and for Malla Pollack et al. by *Ms. Pollack, pro se*.

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