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FROM MONKEY SELFIES TO OPEN SOURCE:
The Essential Interplay of Creative Culture, Technology, Copyright Office Practice, and the Law

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ABSTRACT

The 2016 Distinguished Roger L. Shidler Lecture was delivered on July 22, 2016 at the University of Washington School of Law, Center for Advanced Study & Research on Innovation Policy during the 2016 Global Innovation Law Summit.

INTRODUCTION

It is a tremendous honor to join you for this global summit and to deliver the distinguished Shidler lecture. I have read about Mr. Shidler’s life and legacy, and I imagine he would be gratified to see the experts who have gathered here today in the name of innovation policy. It seems to me that Seattle is the perfect backdrop for this discussion, doubly blessed as it is with breathtaking natural beauty and world class entrepreneurs. One nourishes and informs the human spirit, and the other expresses our relentless drive to create, compete, and progress.

* Maria A. Pallante served as United States Register of Copyrights from June 1, 2011 to October 29, 2016. She would like to thank Catherine Zaller Rowland for her assistance with the lecture.
What is the role of copyright law in this inspiring but frenetic world we share? As a primary goal, copyright recognizes the importance of authors and confirms that, in a civilized society, creative expression is valuable and should be supported and built upon. Authors have spoken to us for centuries through a variety of art forms, and we would all agree that without authors, society would be profoundly poorer and less aware of both the history and potential of the human condition.

But authors also are catalysts. Thus, while the law incentivizes and seeks to protect the contributions of authors as writers, artists, performers, producers, designers, and documentarians—and justly so—it also recognizes the downstream investment and innovation of those who build upon their creativity. These actors, including publishers and technologists, also will find motivations and accommodations in the law. Copyright is inherently innovative in this way. It starts from the premise that creativity begets creativity, and—appropriately—offers both short term and long-term rewards.

In terms of economic impact, the copyright framework is forceful, with multiple sectors contributing billions in revenue and combined trillions to the balance of trade while drawing on both the rights and limitations in the law.¹

Of course, innovation does not stand still—and sometimes it is in the eye of the beholder—which brings me to monkey selfies.

I. Monkey Selfies

Selfies, in general, are such a part of modern life that the Oxford Dictionaries named “selfie” the Word of the Year for 2013. On Instagram alone, over 270 million photos have been tagged as #selfie. Both men and women take part: for example, 50% of men and 52% of women have taken a selfie, with selfies accounting for 30% of the photos taken by people between the ages of 18 and 24. Selfies are so popular, it is no wonder that the animal kingdom has gotten in on the act, monkeys in particular.

Indeed, no ordinary person could have predicted the legal debate of 2012 involving an Indonesian monkey, a British wildlife photographer, Wikimedia, and PETA, an animal rights organization based in the United States. But copyright lawyers have embraced the case—Naruto v. Slater—which presents issues of copyright ownership, choice of law, attribution, and compensation, not to mention the joyful selfies taken by a curious six-year old crested macaque.

David Slater, a British citizen, photographer, and wildlife enthusiast, gave the monkeys his camera as an experiment. The

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monkeys took some blurry images, and some good ones, which Slater sent to a news agency. Slater also published a book and claimed copyright in the images. Some of the images were uploaded to Wikipedia without the consent of Slater (or any animal).

And here is where the law—and the Copyright Office—fits in. When Slater objected to Wikipedia’s use, Wikipedia first took the images down but quickly put them back up. TechDirt ran an article on the dust-up, and Slater also objected to that site’s use of the images. Both Wikipedia and TechDirt maintained that Slater did not have the copyright in the images because Slater did not take the pictures, the monkeys did, and copyright law requires human


8 Complaint for Copyright Infringement and Demand for Jury Trial at 1, Naruto v. Slater, No. 15-cv-04324-WHO (N.D. Cal. Sept. 21, 2015).


authorship.\textsuperscript{12}

During this time—in 2014—my staff and I happened to issue a long awaited, multiyear revision of the \textit{Compendium of U.S. Copyright Office Practices}, nearly 1,300 pages thick and updated for the digital environment. The \textit{Compendium} included, “[a] photograph taken by a monkey” as an example of something that the Office will not register (along with works produced by nature, plants, or divine or supernatural beings).\textsuperscript{13} No less than the Los Angeles Times took note, announcing that a “public draft of the Compendium of U.S. Copyright Office Practices, Third Edition says the office will register only works that were created by human beings.”\textsuperscript{14} Keep in mind that no one sought to actually register a monkey selfie in this case, and because the images are not U.S works, registration is not a requirement of bringing suit in the United States.\textsuperscript{15}


\textsuperscript{13} U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES, § 313.2 (2014).


\textsuperscript{15} Complaint for Copyright Infringement and Demand for Jury Trial at 9, \textit{Naruto v. Slater}, No. 15-cv-04324-WHO (N.D. Cal. Sept. 21, 2015).
This is when PETA entered the jungle. It claimed to act as a next friend and filed suit against Slater for using the monkeys’ images in his book.\textsuperscript{16} In a lawsuit filed in the Northern District of California for copyright infringement, PETA alleged that Naruto, the monkey it befriended, indeed owned the copyright in the works because “authorship” under the Copyright Act is sufficiently broad so as to permit the protections of the law to extend to any original work, including those created by Naruto.”\textsuperscript{17} Slater shot back with a motion to dismiss for lack of standing because there was no human authorship, noting that “[m]onkey see, monkey sue is not good law.”\textsuperscript{18} You don’t get facts like this in patent law! The district court dismissed the case, in part pointing to the Copyright Office’s expertise on copyrightability issues.\textsuperscript{19} But the story is not over—yet—because PETA has appealed to the Ninth Circuit.\textsuperscript{20}

The case is entertaining, but it raises some additional legal questions. For example, what would happen in foreign jurisdictions? There was a question as to whether Indonesian law might possibly provide for ownership of the images, perhaps by the Indonesian government, because the images were captured in a government

\begin{itemize}
\item \textsuperscript{16} Complaint for Copyright Infringement and Demand for Jury Trial at 1-2, Naruto v. Slater, No. 15-cv-04324-WHO (N.D. Cal. Sept. 21, 2015).
\item \textsuperscript{17} Complaint for Copyright Infringement and Demand for Jury Trial at 2, Naruto v. Slater, No. 15-cv-04324-WHO (N.D. Cal. Sept. 21, 2015).
\item \textsuperscript{18} Motion to Dismiss the Complaint for Lack of Standing and Failure to State a Claim upon Which Relief Can Be Granted at 2, Naruto v. Slater, No. 15-cv-04324-WHO (N.D. Cal. Nov. 6, 2015).
\item \textsuperscript{20} Notice of Appeal and Representation Statement of Plaintiff Naruto at 1, Naruto v. Slater, No. 15-cv-04324-WHO (N.D. Cal. Mar. 20, 2016).
\end{itemize}
park which may or may not have owned the monkey.\textsuperscript{21}

And why all the attention on the monkey? Mr. Slater is the one who trekked into the wilderness, engendered trust with a group of primates, and created the ambience and technical props that were arguably designed to facilitate a monkey taking a selfie. Does this foresight and activity qualify as authorship? It fails under the U.S. Supreme Court Case, \textit{Feist Publications, Inc. v. Rural Telephone Service Co.}, which rejected sweat of the brow labor as a legal basis for copyright protection.\textsuperscript{22}

On the other hand, \textit{Feist} affirmed low thresholds for securing copyrightability in general, and compilations of uncopyrightable facts, in particular.\textsuperscript{23} Did Mr. Slater arrange Naruto’s photo? Did he design or produce it? What are the factual standards? Naruto toyed around with the camera and, by all accounts, took a handful of accidental photos. But, as some have observed, more exceptional animals might be capable of purposeful arrangement or expression.\textsuperscript{24} If so, this would seem to work against the role of the human photographer as master creator, producer and author, all of which for now goes well beyond the simple statement in the Copyright Office Compendium.


\textsuperscript{23} \textit{Id.} at 345, 348.

\textsuperscript{24} Aurelia J. Schultz, \textit{Monkey See, Monkey Do, Monkey get Copyright, too?}, 1709 BLOG (July 13, 2011, 3:05 AM), http://the1709blog.blogspot.com/2011/07/monkey-see-monkey-do-monkey-get.html.
II. Performers

Moving to performers, *Google v. Garcia* is another case in which Copyright Office practice intersected with somewhat provocative facts. The case involves an actress claiming that she had a copyright claim in the dramatic performance she delivered and which was fixed in tangible form, although not by her, when it was filmed during the production of a low budget film *Desert Warrior*.25

The actress was paid $500 for a few days’ work, but her lines were thereafter redubbed (viewable on a YouTube trailer under the title, *Innocence of Muslims*).26 In the revised version, she appears to be asking, “Is your Mohammed a child molester?”27 When the trailer appeared on YouTube, Garcia received death threats, including a *fatwa*.28 The case has an extended procedural history, and it happened to emerge just after the World Intellectual Property Organization (WIPO) concluded an international treaty in Beijing, in which member states agreed to protect performances, albeit with some flexibility as to national laws, and to which the United States is a signatory.29

Under Copyright Office practice, an “actor or actress in a motion picture is either a joint author in the entire work or, as most often is the case, is not an author at all by virtue of a work made for

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25 *Garcia v. Google, Inc.*, 786 F.3d 733 (9th Cir. 2015).
26 Id. at 737-38.
27 Id. at 737.
28 Id. at 738.
hire agreement.”\textsuperscript{30} If a separate stand-alone work that is independently authored, fixed and sufficiently creative is incorporated into a motion picture, it can be considered a discrete work. Taking note, the appeals court eventually held that granting Garcia a copyright in her particular performance would result in a “legal morass” and splinter a movie “into many different ‘works,’ even in the absence of an independent fixation.”\textsuperscript{31} Here, the court refers to the problems such a scheme would cause for films like Ben-Hur or Lord of the Rings, which each reportedly had tens of thousands of actors.\textsuperscript{32}

Some of the practical issues will be of ongoing interest to the Copyright Office, including: how registration practices might better accommodate or at least document the contributions or intellectual property interests of performers, including foreign or independent performers who do not routinely agree to transfer their rights to the producer.

\textbf{III. Software and Computer Programs}

I now turn to software, which has its own fair share of emerging issues. Software is protected in the United States as form of literary property, but it is unique because it is, by its very nature, functional, something that is fatal to copyright protection for other types of works.

Over the years, the Copyright Office has had to dig deeply

\textsuperscript{30} Garcia, 786 F.3d at 752.
\textsuperscript{31} Id. at 742.
\textsuperscript{32} Id. at 742-43.
into what constitutes “software” or “computer programs.” The Register of Copyright has the authority to make differentiations for registration requirements and has consistently done so for software—applicants need not provide the entire code to the Office for examination, but may instead provide a sample (known as identifying material), a practice linked to earlier times and concerns about trade secrets.\(^\text{33}\)

This kind of flexibility is important, but it has to be rationalized with the government’s interest in creating a meaningful public record, especially when users of copyright rely on the public record for transactions and liability assessments. The Copyright Office anticipated this when we issued the 2014 Compendium, noting that in the years ahead, we will introduce a number of public discussions to address the registration and public indexing of digital works, including software, which may have multiple authors, multiple dates of creation, multiple dates of publication, and proprietary content.\(^\text{34}\)

Software also presents policy questions aside from copyright registration because it is so ubiquitous in modern life, from our phones to our home thermostats. This may at times create certain practical tensions between copyright law and the operation of a

\(^{33}\) U.S. Copyright Office, Compendium of U.S. Copyright Office Practices §§ 102.2(B), 1509.1(C), 1509.1(C)(a)-(b) (3d ed. 2014) (“Compendium (Third)”).

modern world. Among other questions, the Office is reviewing whether and to what extent the design, distribution, and legitimate uses of everyday products are enabled and/or frustrated by the application of copyright law.\(^\text{35}\)

Most in the copyright community (both copyright owners and software users) acknowledge that software embedded in everyday products presents a unique scenario, far afield from the origins of copyright law. But there is also acknowledgment of the importance of copyright to innovation. In the words of Microsoft, “[f]orty years of software innovation have generated massive benefits for software creators, consumers and the economy” and “[a]t the same time, the U.S. copyright regime has proved remarkably adept at balancing the interests of creators, consumers, and the public...”\(^\text{36}\)

Nevertheless, issues have arisen in recent years. These include definitional issues (what is embedded software), the role of technological protection measures, the application of the merger doctrine and scenes a faire to software, and confusion over the value or identification of ownership in a license-heavy software market, and how that impacts digital first sale and therefore exhaustion.


IV. Anti-circumvention of TPMs

As we look at software policy, we also are reviewing the policies around technological protection measures (TPMs) in a separate public study. As many of you know, U.S. law bars most circumvention of TPMs because, according to the U.S. Congress, these measures prevent piracy and support new ways of disseminating copyrighted material to users.\(^{37}\) The law also directs a rulemaking process designed by Congress to protect non-infringing uses, including fair use, which the Supreme Court has held is a fail-safe for free expression.\(^{38}\) The rulemaking process provides the public with an opportunity to request limited exemptions, in other words, to make the case as to why circumvention may be warranted in any given case.\(^{39}\)

This rulemaking has grown exponentially since it was implemented a decade and a half ago. In 2000, the Copyright Office received about 400 comments, resulting in two exemptions.\(^{40}\) Contrast this with the sixth rulemaking, completed in 2015, during which we received nearly 40,000 comments resulting in exemptions for twenty-two types of circumvention categories out of twenty-seven requests.\(^{41}\)


\(^{40}\) Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies, 65 Fed. Reg. 64,556, 64,557, 64,574 (Oct. 27, 2000).

\(^{41}\) U.S. Copyright Office, Section 1201 Rulemaking: Sixth Triennial Proceeding to Determine Exemptions to the Prohibition on
In conducting the rulemaking, the Copyright Office has repeatedly highlighted the limitations and permeations of both the rulemaking process and underlying law. For example, in the most recent rulemaking, we noted that the statute’s anti-trafficking provisions, while useful in curbing bad actors, may hinder the ability of third parties to provide assistance to the exemptions’ intended beneficiaries and can be addressed through a statutory change in the rulemaking process.\(^{42}\) In the same recommendation, we suggested it would be beneficial to have a presumption of renewal in instances where proposals are resubmitted from the previous cycle and face no meaningful opposition, a change that would lessen the burden on proponents and make the process more efficient.\(^{43}\) Keep in mind that this is now a process that governs the software found in automobiles, tractors, and pacemakers, as well as more traditionally creative expression, such as that found in film.

But once again the story has some twists and turns. The Electronic Frontier Foundation has filed suit against the U.S. government (including the Attorney General and the Register of Copyrights), challenging the constitutionality of making non-infringing activities (and free expression in particular) subject to a triennial rulemaking process.\(^{44}\)

\(^{42}\) *Id.* at 4-5.
\(^{43}\) *Id.* at 4.
\(^{44}\) Complaint for Declaratory and Injunctive Relief at 2-4, Green v. U.S. Dep’t of Justice, No. 1:16-cv-01492-EGS (D.D.C. July 21, 2016); See also Motion to Dismiss the Complaint, 1:16-cv-01492-EGS (D.D.C. September 29, 2016) filed after the date of the Shidler Lecture.
V. Open Source

Of course TPMs are but one of many business models employed by copyright owners. At the other end of the spectrum, open source software draws on traditional copyright protections while offering flexible rules for collaboration. It has become so prevalent that a 2016 survey found 78 percent of businesses ran open source software. Indeed, the Copyright Office’s own set of strategic plans calls for the agency to heavily utilize open source platforms.

Open source is popular in part because it offers developers fairly clear rules, for example placing limitations on subsequent distribution methods requiring users to share the original code, providing notice of modifications, providing appropriate attribution, and agreeing to license the new work to others. Models like these are effective; however, it would be wrong to equate this with a weakening of copyright law. More precisely, copyright is critical for their success. For example, in one case, Jacobsen v. Katzer, the Federal Circuit found that exceeding the scope of an open source license could constitute an infringement, not merely a contractual

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violation, after the defendants failed to comply with, among other things, the copyright owner’s attribution and modification notice requirements. The court said that “[c]opyright licenses are designed to support the right to exclude,” and that “money damages alone do not support or enforce that right.”

VI. Video Games

One copyright industry that employs open source platforms to the tremendous enjoyment of consumers is the video game industry. Video games perhaps offer the best example of how creativity, technology, and the law work together to advance new art forms—and new Copyright Office practices. And they are incredibly creative.

Today, video games go far beyond software—many have sophisticated scripts, musical scores, animation, and design elements that are as richly creative as any expressive work on the market. Even the Supreme Court has weighed in on the significance, explaining that “[l]ike the protected books, plays, and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player’s interaction with the

48 Jacobsen v. Katzer, 535 F.3d 1373, 1376, 1382 (Fed. Cir. 2008) (remanded and was later settled).
49 Id. at 1381-82.
Today’s video and computer games also challenge gender and age assumptions. For example, the average U.S. game player is 35 years old, and “[w]omen age 18 or older represent a significantly greater portion of the game-playing population (31%) than boys age 18 or younger (17%).”

Forty-eight per cent of the most active gamers play social games, and games are played on a variety of devices, from dedicated handheld systems to phones to personal computers. Games are not just for the players—they have ballooned to become a spectator sport. The website Twitch.tv allows people to watch and engage with tournaments and boasts 100+ million unique viewers per month (and 1.7 million unique broadcasters per month).

Because video games provide such complex and interrelated copyright claims, the Copyright Office Compendium allows registration of audiovisual and computer program components separately. But ownership and authorship can be complicated. Employee/employer relationships are common, but a whole host of people bring the product to market—from producers to game developers.

50 Brown v. Entm’t Merchants Ass’n, 564 U.S. 786, 790 (2011). In this case, the Court found that video games qualify for First Amendment protection and affirmed the Ninth Circuit Court of Appeal’s decision to enjoin a California law relating to the sale of “violent video games” to minors. Id. at 790, 804-05.


52 Id. at 5.


54 COMPENDIUM (THIRD) § 807.7(A)(1).
designers to artists to engineers and audio designers. This can lead to confusion when the employment relationship is unclear, or garner new practices for attribution. For example, it is not only that the sound track is critical to a game, but also that games have become a prominent vehicle, one of the very few, in which composers may be commissioned to write original scores and provided an orchestra budget to do so.

VII. Attribution

Attribution, also known as the paternity right, is part of the moral rights tapestry under copyright law and related regimes, an area where the United States mostly has watched foreign jurisdictions. This past spring, the Copyright Office sponsored a Public Symposium, in which one noted professor, Jane Ginsburg of Columbia Law School, stated that “[o]f all the many counter-intuitive features of US copyright law—and they abound—the lack of an attribution right may present the greatest gap between perceived justice and reality.” A best-selling book author and former president of the Authors Guild, Scott Turow, emphasized the importance of being known, explaining that if attribution is not a

56 Id. at 10.
right that is valued, “you have diminished the glory of authorship.” 58 And Professor Sean O’Connor here at the University of Washington, noted the important role of attribution in incentivizing publication, that is, not only the commitment to create but also to publish in order to build a robust public discourse. 59

Attribution can have financial consequences, as well, which brings me to the music industry. When licensing music, the inability to correctly identify the owners of a work leads to inefficiencies and economic losses for the many parties involved in creating songs. This view is strongly held by stakeholders and was a focus of our 2015 study, Copyright and the Music Marketplace. 60 Among other findings, our report recommended that the government regulate the collection of, and access to, authoritative ownership data. 61

More systemically, our report addressed the unprecedented impact of technology on the music business and the need for significant across the board reform (as the age of mechanical reproductions give way to a world in which music is predominantly streamed). 62 As policy reports go, my staff and I thought this one was a long time coming, but it seemed to hit a popular nerve.

58 Symposium, Session 4: The Importance of Moral Rights to Authors, 8 GEO. MASON J. OF INT’L.COM. L. 87, 104 (2016) (Scott Turow, Author).
59 Symposium, Session 4: The Importance of Moral Rights to Authors, 8 GEO. MASON J. OF INT’L.COM. L. 87, 104 (2016) (stating that attribution “gets people putting their stuff out there, publically releasing it—not necessarily free, economically, but putting it out there so it could be part of a robust public discourse”).
61 Id. at 183-84.
62 Id. at 12-14, 133-34.
The press called it “a bombshell of a report” calling for “dramatic changes in the way royalty rates are set and recorded music is licensed.”63 Another called it a “rare instance of a government agency getting out in front of moving technology.”64 Innovative government!

**VIII. Orphan Works and Small Claims**

Of special concern to the Copyright Office is the protection of small creators, without whom music wouldn’t be music and innovation would be the singular domain of corporations. But solutions need to further the goal of a fair and balanced copyright system. Ten years ago the Copyright Office published a major report on orphan works, works for which copyright owners cannot be identified and/or located.65 Among other things, the Report proposed limiting the remedies available to a copyright owner if the user has performed a diligent search for the copyright owner, and it also encouraged the user to name the author and copyright owner of the work, if reasonably possible.66

We viewed attribution as “an essential and important part of

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66 *Id.* at 8-13.
preserving the author’s interests in the work.”67 And, in fact at the time of the report, “for those authors who adopt one of the many forms of Creative Commons licenses, about 94% of them opt for a license that requires attribution.”68

But as is often the case, our study of one policy issue uncovered another policy issue, because it was during this orphan works discussion that the issue of small claims came to the fore. Frustrated copyright owners, including a large number of photographers, testified that their by-lines were frequently stripped from their works, especially on digital works.69

We launched a separate study, which by its nature involved not only copyright and contract issues, but also questions about the Constitutional requirements for judicial proceedings.70 There was an outpouring of interest from creators of every kind, who stressed the fact that traditional lawsuits are impractical and out of reach for many disputes, but that the consequences are significant.71

Songwriters testified that while “small claims and random infringements may seem unimportant, taken in the aggregate, they have an effect on the livelihoods of individual creators akin to the infamous torture ‘death by a thousand cuts.’”72

67 Id. at 111.
68 Id.
70 U.S. COPYRIGHT OFFICE, COPYRIGHT SMALL CLAIMS 5-7 (2013).
71 Id. at 1-2.
72 Id. at 2.
In 2013, my staff and I recommended the creation of an alternative and voluntary forum for small claims—to be operated by the Copyright Office—for disputes valued at no more than $30,000 dollars.\textsuperscript{73} The process would offer copyright owners, as well as defendants, the opportunity to resolve small infringement matters and related claims, without or without the aid of attorneys.\textsuperscript{74}

Just last week, a bill was introduced in the House of Representatives,\textsuperscript{75} and I will leave the topic with this thought. This development is a terrific example of an expert agency working to dissect policy issues, over a period of several years, and crafting recommendations that not only lead Congress, but also the agency itself, to consider innovative improvements to the copyright system.

CONCLUSION

In conclusion, I note that the technology revolution has brought us many things, but one of the best things is a reminder that innovation thrives on creative expression—whether or not that is reserved to the human race.

\textsuperscript{73} Id. at 3, 97-99, 102-03, 109-110.
\textsuperscript{74} Id. at 103-07, 119-20.
\textsuperscript{75} CASE Act of 2016, H.R. 5757, 114th Cong. (2016).
"REASONABLE ZONES OF PRIVACY"—THE SUPREME COURT’S STRUGGLE TO FIND CLARITY IN THE AMERICAN LANDSCAPE REGARDING FOURTH AMENDMENT RIGHTS

Alex Alben *
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ABSTRACT

The U.S. Supreme Court has struggled over the years to develop the concept of what constitutes a "reasonable zone of privacy" when it comes to intrusion on an individual's physical space or activities. With the advent and widespread adoption of new technologies such as drones and listening devices, concern for protecting privacy has magnified, yet court doctrine remains inconsistent. The author, Washington State’s Chief Privacy Officer, reviews the history of Supreme Court "search and seizure" rulings in prominent cases to identify both patterns and flaws on the topic of protecting citizen privacy.

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* Alex Alben was named the first chief privacy officer of Washington State in 2015. He is a graduate of Stanford University and Stanford Law School. In his first job he worked as a researcher for Walter Cronkite at CBS News and then for CBS Reports. After law school, he served as an entertainment lawyer for Orion Pictures and Warner Bros., before beginning a tech career in Seattle with senior management positions at Starwave Corp. and RealNetworks, Inc. Alben teaches a section of the Privacy Law Clinic at the University of Washington School of law. The opinions expressed in this article are his own.
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INTRODUCTION

On May 31, 2016, the Fourth Circuit Court of Appeals in Virginia ruled *en banc*, by a 12-3 vote, that our most durable privacy law—the Fourth Amendment—does not protect cell phone data pinpointing a caller’s location.\(^1\) In this particular case, law enforcement convicted two Baltimore men of multiple armed robberies in 2011 by analyzing 221 days of their wireless location data, which pinpointed 29,000 different locations.\(^2\) The court reasoned that, because cell phone owners know that their location information is shared with their wireless carrier, as under the third-party doctrine, an individual can claim "no legitimate expectation of privacy" in information that he has voluntarily turned over to a third party.\(^3\)

The *Graham* ruling calls into question whether a "reasonable expectation of privacy" exists with respect to wireless location data. It also seems to contradict the broad pro-privacy affirmation expressed the Supreme Court’s unanimous decision in *Riley v.*

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1 United States v. Graham, 824 F.3d 421, 428 (4th Cir. 2016) ("[T]he Government’s acquisition of that information (historical CSLI) pursuant to § 2703(d) orders, rather than warrants, did not violate the Fourth Amendment.").
2 *See generally* Graham, 824 F.3d 421 (4th Cir. 2016).
3 *Id.* at 427 ("Applying the third-party doctrine to the facts of this case, we hold that Defendants did not have a reasonable expectation of privacy in the historical CSLI.").
California, which held that police must obtain a search warrant before opening an individual’s cell phone incident to a search.\(^4\)

The definition of 'zones of privacy' has evolved over three distinct phases of Supreme Court jurisprudence. The first phase, from 1891-1924, involved the arcane "open fields" or “open view” doctrine.\(^5\) The second phase, from 1928-1967, allowed for widespread government wire-tapping, but ended with the Court’s 1967 ruling in *Katz v. United States*, which articulated a “reasonable zone of privacy” standard.\(^6\) Finally, the "open fields" doctrine reemerged in the 1980’s in conjunction with contemporary drug cultivation operations. As a result, the Court reverted to finding no violation of the Fourth Amendment — even in cases of intrusion on private property.\(^7\) Examining these three eras sheds considerable light on the privacy rights, or lack thereof, in America today.

I. NEW TECHNOLOGIES AND ZONES OF PRIVACY

While the Supreme Court has historically struggled to define a person’s reasonable zone of privacy, technology has run circles around the judiciary. Fifteen years ago, the public had very little expectation that private companies would take satellite photographs to compile aerial views of every American neighborhood, down to recognizable houses, gardens, garages, and lawns.\(^8\) Nor did people commonly exercise property rights in vertical air space above her

\(^4\) Riley v. California, 134 S. Ct. 2473, 2493 (2014) ("[A] warrant is generally required before such a search, even when a cell phone is seized incident to arrest.").

\(^5\) The terms "open fields" and "open view" are used interchangeably in this article, although later decisions tend to use the "open view" phrase to describe the general doctrine.


\(^7\) See Hester v. United States, 265 U.S. 57 (1923)

domain extending all the way up to outer space. With the rapid and widespread adoption of new technologies, lawmakers have generally surrendered potential privacy claims to Google, Bing and other mapping services as these technologies expanded.

Google Street View poses a closer case for privacy advocates, in part because of how it acquires data. A camera-laden car mapping a neighborhood might snap a photograph of an individual in an embarrassing pose. This technology, however, has widely been ruled to be legal in a variety of jurisdictions because the mapping vehicle is using public streets and taking photos of scenery that can otherwise be seen with the naked eye. In this sense, Google’s resources and technology have logarithmically expanded the old legal doctrine of "open view."

U.S. law might not have permitted Google Street View, however, had, a strange and enduring definition of a person’s home through physical invasion or curtilage not been articulated by the Supreme Court over eighty years ago.

9 While the ad coelum doctrine refers to ownership of land up to the heaven and down to the center of the earth, it had little practical application above ground until the invention of airplanes. See Environmental Justice, Peter S. Wentz, p. 177, SUNY Press, 1988. When a man tried to claim ownership of certain rights in asteroid Eros 433, the Ninth Circuit held that he stated no recognizable legal claim either under common law or the Outer Space Treaty. Nemitz v United States and or, Decision on motion to dismiss, 2004 WL 3167042 (D Nev 2004), ILDC 1986 (US 2004), 26th April 2004, United States.


11 See, e.g., Boring v. Google, Inc., 598 F. Supp. 2d 695, 700 (W.D. Pa. 2009) (ruling in favor of Google and dismissing privacy claims because Google Street View were images that were in plain sight. Interestingly the court noted it would be "hard to believe" the plaintiffs suffered "shame or humiliation.").

12 The open fields doctrine holds that persons cannot assert protection for activities conducted in open fields because such areas are not protected places or things under a plain language reading of the fourth amendment. See Seth H. Ruzi, Reviving Trespass-Based Search Analysis Under the open view Doctrine: Dow Chemical Co. v. United States, 63 N.Y.U. L. Rev. 191, 196 (1988) (citing Hester v. United States, 265 U.S. 57 (1923)).

13 Olmstead v. United States, 277 U.S. 438 (1928).
II. PHASE I—THE STRANGE DOCTRINE OF CURTILAGE AND
OPEN FIELDS (1891-1924)

Much of the failure of American courts to delineate reasonable zones of privacy traces back to the historic Supreme Court ruling in Olmstead v. United States.\(^\text{14}\) In writing for the majority’s ruling on relatively modern technology—telephones and the government interception of telephone wire transmissions—Chief Justice William Howard Taft drew on the ancient property concepts that informed most privacy law in the late 19th and early 20th centuries.\(^\text{15}\) Taft concluded that a Fourth Amendment violation does not occur unless there has been an official search and seizure of a person’s papers, or tangible material effects.\(^\text{16}\) Further, a search would not occur unless there was an "actual physical invasion of his house or curtilage for the purpose of making a seizure."\(^\text{17}\)

Prior to Olmstead, courts adhered to an archaic construction of zones of privacy. One has to turn to the 1891 edition of Black’s Law Dictionary to find a working definition of "curtilage:"

"The enclosed space of ground and buildings immediately surrounding a dwelling-house. In its most comprehensive and proper legal signification, it includes all that space of ground and buildings thereon which is usually enclosed within the general fence immediately surrounding a principal messuage and outbuildings, and yard closely adjoining to a dwelling-house, but it may be large enough for cattle to be levant and couchant therein."\(^\text{18}\)

\(^{14}\) Id.
\(^{15}\) Id.
\(^{16}\) Id. at 466. Additionally, a Fourth Amendment analysis is outside the scope of this Article.
\(^{17}\) Id. (emphasis added)
\(^{18}\) Curtilage, BLACK’S LAW DICTIONARY 311 (6th ed. 1891) (first alteration in original) (emphasis added).
For those not familiar with "messuage," it is a property law term referring to a dwelling and its outbuildings and curtilage.\textsuperscript{19} For those not raised in 18th century French farmhouses, "levant and couchant" refer to the practice of cattle rising up and lying down.\textsuperscript{20}

While humans tend to conduct illegal activities indoors, we have the outdoorsy moonshine and marijuana-growing businesses to thank for the evolution of our legal doctrines on privacy and open fields. In \textit{Hester v. United States},\textsuperscript{21} the Supreme Court explored the question of whether a person’s zone of privacy extended to the open fields surrounding a home or farm, an inquiry that would lead to the creation of the "open fields" doctrine. In 1924, federal agents stood 50-100 yards away from Hester’s farm and observed him handing a quart bottle to another man.\textsuperscript{22} The bottle contained home-grown distilled spirits, illegal in the Prohibition Era.\textsuperscript{23} On this basis, the agents subsequently arrested Hester, who claimed in court that they had trespassed on his property and violated his Fourth Amendment rights.\textsuperscript{24}

The Court felt no sympathy for Hester, reasoning that if his fields were readily visible from an adjacent property and the agents had conducted no physical trespass, the unfortunate moonshiner had no Fourth Amendment privacy argument to make.\textsuperscript{25} Justice Oliver Wendell Holmes encapsulated the Court’s reasoning, holding that "the special protection accorded by the Fourth Amendment to the people in their 'persons, houses, papers and effects', is not extended to the open fields."\textsuperscript{26}

Thus, "open fields" remained fair game for law enforcement for decades. First articulated in \textit{Hester}, the doctrine informed much of the Supreme Court’s thinking as new technologies came onto the scene after the turn of the century.

\textsuperscript{19} \textit{Messuage}, \textsc{Black’s Law Dictionary} (10th ed. 2014) available at Westlaw BLACKS.
\textsuperscript{20} \textit{Levant and couchant}, \textsc{Black’s Law Dictionary} (10th ed. 2014) available at Westlaw BLACKS.
\textsuperscript{21} \textit{Hester v. United States}, 265 U.S. 57 (1924).
\textsuperscript{22} \textit{Id.} at 58.
\textsuperscript{23} \textit{Id.}
\textsuperscript{24} \textit{Id.}
\textsuperscript{25} \textit{Id.}
\textsuperscript{26} \textit{Id.} at 59.
III. PHASE II – WIRETAPPING FROM OLMSTEAD TO KATZ (1928-1967)

Over a forty-year period, American courts allowed telephone and broadcast technologies to flourish without scrutiny under the Fourth Amendment—at least in the context of wiretapping—until Olmstead v. United States.\(^{27}\) Presiding over the 1928 case of prominent Seattle bootlegger Roy Olmstead, the Supreme Court held that federal agents had not conducted a search-and-seizure within the meaning of the Fourth Amendment after wiretapping Olmstead’s telephone line to record his conversations with members of his illegal liquor distribution operation.\(^{28}\)

In 1924, federal agents tapped Olmstead’s phone and took notes on his conversations. These were then transcribed in a "black book" that the prosecutor used to charge a total of forty-seven defendants, including Olmstead’s attorney and his wife Elise.\(^{29}\) Given the unsophisticated technology of the time, the agents could not see the numbers that Olmstead and his associates were dialing. To solve this problem, they crossed the tapped phone line with another line, causing interference.\(^{30}\) Olmstead then had to verbally instruct the operator which number he wished to dial. The FBI

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\(^{27}\) Olmstead, supra note 13; see also Daryl C. McClary, *Olmstead, Roy (1886-1966) — King of King County Bootleggers*, History Link (Nov. 13, 2002), http://www.historylink.org/File/4015. (Olmstead had served on the Seattle Police force as an enforcer of Seattle’s early prohibition law and later the 18th Amendment when it came into effect in 1920. Olmstead observed the operations of the region’s bootleggers and concluded he could do better. After serving a brief prison sentence for running an alcohol smuggling operation while still a member of the force, he returned to bootlegging full time, smuggling alcohol from Canada primarily by small boats to beaches and coves in Washington State).

\(^{28}\) Olmstead, supra note 13, at 464.

\(^{29}\) See Daryl C. McClary, *Olmstead, Roy (1886-1966) — King of King County Bootleggers*, History Link (Nov. 13, 2002), http://www.historylink.org/File/4015.

\(^{30}\) Olmstead, supra note 13, at 487.
agents posted within earshot of his office recorded these numbers in their notebooks, then did a "reverse look-up" to find the addresses linked to them. After a twenty-four-hour trial, Olmstead was sentenced to four years of hard labor and fined $8,000.

The case arrived at the Supreme Court in 1928, when former President William Howard Taft presided as Chief Justice. Writing for the Court, Taft demonstrated he had a rudimentary understanding of telephony by stating that he simply did not see a Fourth Amendment violation because the government did not intrude on Olmstead’s physical space: "[t]here was no searching. There was no seizure. The evidence was secured only by the sense of hearing. There was no entry of the houses or offices of the defendants."

The Supreme Court did not decide Olmstead unanimously. Justice Louis Brandeis examined the facts surrounding the wiretap and concluded that the federal agents had indeed violated the Constitution. In his dissent, Brandeis inquired, "can it be that the Constitution affords no protection against such invasions of individual security?" Justice Brandeis understood an invasion of privacy does not require a physical intrusion given the evolution of modern technology such as telephony.

Six years later, Congress passed the Communications Act in 1934, which explicitly outlawed the practice of wiretapping telephones without a court warrant. However, the Act did not address the legality of bugs and other forms of electronic eavesdropping.

Thirty-three years later, the Supreme Court considered

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31 See Daryl C. McClary, supra note 29.
32 Id.
33 Olmstead, supra note 13, at 464.
34 Olmstead, 277 U.S. at 464.
35 Id. at 474 (Brandeis, J., dissenting).
whether the FBI had violated a man’s expectation of privacy under the Fourth Amendment when it tapped a phone booth outside of his Los Angeles apartment due to suspicion that he was placing illegal bets on college basketball games.\textsuperscript{38} In 1967, Charles Katz was in fact one of the country’s most successful basketball handicappers and bettors, having evaded persistent law enforcement efforts to catch him in the act.\textsuperscript{39} By disabling one phone booth and planting recording devices on the tops of two others on Sunset Boulevard, FBI agents managed to overhear his betting conversations with associates in Miami and Boston.\textsuperscript{40}

There was one flaw with the FBI’s plan: the agents did not have a search warrant when they intercepted Katz’s conversations.\textsuperscript{41} As a result, Katz’s attorneys filed an appeal arguing that the recordings could not be used as evidence against him on Fourth Amendment grounds.\textsuperscript{42} Following \textit{Olmstead}, however, the court of appeals rejected Katz’s argument, citing the absence of a physical intrusion into the phone booth itself and ignoring the FBI’s elaborate surveillance scheme in targeting Katz and monitoring his calls via the two working phone booths.\textsuperscript{43}

Nevertheless, Katz ultimately prevailed. The Supreme Court ruled 7-1 that Katz was entitled to constitutional protection for his conversations.\textsuperscript{44} Justice Potter Stewart wrote for the Court:

"The Fourth Amendment protects people, not places. What a person knowingly exposes to the public, even in his own home or office, is not a subject of Fourth Amendment protection. But what he seeks to

\textsuperscript{38} Katz v. United States, 389 U.S. 347 (1967).
\textsuperscript{40} Katz at 131.
\textsuperscript{41} Id.
\textsuperscript{42} Id. at 133.
\textsuperscript{43} Id. at 134.
\textsuperscript{44} Katz, 389 U.S. 347, 359.
preserve as private, even in an area accessible to the public [e.g., a phone booth] may be constitutionally protected.”

A concurring opinion by John Marshall Harlan introduced the idea of a "reasonable" expectation of Fourth Amendment protection. Harlan invented a two-part test for "reasonableness" in this context: "first, that a person have exhibited an actual (subjective) expectation of privacy and, second, that the expectation be one that society is prepared to recognize as ‘reasonable.’"

IV. PHASE III – OPEN FIELDS AND DRUGS: THE 1980s

As the illegal production of alcohol prompted many open fields cases in a prior era, several cases in the 1980s reached the Supreme Court dealing with a new illicit activity that triggered reflection on meaning of the Fourth Amendment. Growing marijuana in open fields occupied the Court’s attention in the 1984 case of Oliver v. United States. Oliver cultivated a marijuana crop in a field adjacent to his Kentucky property. Despite a posted "No Trespassing" sign, Kentucky State Police parked their vehicle, walked around a gate and proceeded down a footpath until they spotted the marijuana plants, about a mile from the gate. They arrested Oliver.

Once again, the Court found no search-and-seizure, due to the open nature of the landscape where the illegal growing operation was situated. Seeking to draw a distinction between portions of a property where an individual or family might have some expectation

45 Id. at 351.
46 Id. at 361 (Harlan, J., concurring).
47 Id. at 361 (Harlan, J., concurring).
50 Id. at 173.
51 Id.
52 Id..
53 Id. at 184.
of property and other portions where they would not, the Court reasoned: "open fields do not provide the setting for those intimate activities that the Amendment is intended to shelter from government interference or surveillance."

Three years later, agents of the Drug Enforcement Administration found a chemical manufacturing plant in a private barn on private ranch. Led by the smell of chemicals and the sound of a running motor, they skirted several fences—including at least one spiked with barbed wire—crossed a gate and entered the barn, where they apprehended their target. Although the Court of Appeals ruled that the barn—surrounded by several fences, was clearly within the owner’s "curtilage"—the Supreme Court in United States v. Dunn disagreed, holding that this area was not "intimately tied to the home itself." Apparently, running a drug lab is not an intimate family activity.

One might view Hester, Oliver and Dunn as 'result oriented' rulings, where courts knew that an illegal activity had occurred and chose to justify the fact that law enforcement failed to get a warrant by deciding that there is no zone of privacy if the activity is within 'open view' or even in a barn. Before sophisticated surveillance technology, such rulings posed a threat to moonshiners and pot growers, but not to the average citizen in terms of government spying on private activities indoors or outdoors. Privacy is no longer defined by the parameters of human senses such as vision or hearing, but now finds a new range of threats based on devices that take the concept of surveillance to a new plane. With the advent of drones,
thermal imaging and high-resolution cameras, the game has changed. "Curtilage" seems like a very quaint notion when a police officer can operate a bird-sized battery-powered drone and maneuver it directly over a suspect’s home or outside a window.\textsuperscript{60} In these cases, law enforcement should simply get a warrant. They might have been tipped to the location of drug operation by an informant or other lead, but flying a surveillance drone over the scene violates any basic "reasonable expectation" of privacy in one’s property, whether indoors or outdoors.

CONCLUSION

Of all the Supreme Court’s struggles to develop a consistent doctrine to define a zone of privacy, the \textit{Katz} formulation makes the most sense, because privacy rights should travel with the individual. The inherent vagueness of what is "reasonable" in different situations only creates room for uncertainty, especially as technology and our cultural norms continue to evolve. Now that the Fourth Circuit has ruled that no warrant is required for a wireless carrier to turn location data over to law enforcement, U.S. citizens live in a 'Catch-22' where individuals supposedly have "reasonable expectations" of privacy in physical spaces, such as phone booths, but almost no expectation of location privacy when they are using their cell phones.

With the introduction of new technologies—ranging from Google Earth aerial photographs to drone surveillance—the question of where public space ends and private space begins has reached a critical phase. Deciding the scope of a person’s "zone of privacy" will be the front-line question for judges and technology advocates to determine for the next generation. Examining the colorful and salient cases surveyed above hopefully provides a few

\textsuperscript{60} Hope Reese, \textit{Police are now using drones to apprehend suspects and administer non-lethal force: A police chief weighs in, \textit{TECHREPUBLIC} (Nov. 25 2015, 4:00 AM), http://www.techrepublic.com/article/police-are-now-using-drones-to-apprehend-suspects-and-administer-non-lethal-force-a-police-chief/.
clues as to the way courts may eventually answer the question of where privacy begins in the modern world of smart phones and surveillance technologies.

Given the inherent privacy interest of people as they move about the world, it seems paramount to address this question. Most Americans do not have a "reasonable expectation" that law enforcement can easily discover their whereabouts when making phone calls or strolling through a mall.61 Further, with the emergence of data analytics, law enforcement can potentially trace individuals through the course of a day, whenever they trigger a safety camera or license plate reader.62 The recent reforms of the Patriot Act passed in 2015 have pared back the government’s right to intercept our private communications, but the surveillance apparatus still exists.63 If we apply different privacy protections to different technologies, we run the risk of fundamentally eroding our remaining privacy rights. Despite the march of technology, is it too much to ask that we can conduct our legal private activities within reasonable zones of privacy?

62 Thirteen states have adopted varying limits on retention of automated license plate reader images. See National Conference of State Legislatures web page, dated Feb. 27, 2017 and last checked March 7, 2017.
Practice Pointers

- Keep updated on new legislation. As the privacy landscape continues to rapidly evolve, we can identify new ideas for the protection of personal data and privacy rights, especially at the state and local levels.
- Keep up-to-date on new technology. New tools, platforms and devices may use personally-identifiable information in innovative ways, which inexorably creates novel privacy questions. Explore the data retention practices and policies of the new technologies you or your clients might adopt for personal use.
- Seek answers outside the field of law. Generally, privacy issues may not be limited to the legal field. Technology tends to outpace law, and consulting technology and communications publications will provide valuable context for considering privacy issues.
ABSTRACT

Two recent holdings from the United States Court of Appeals for the Federal Circuit in Promega Corp. v. Life Technologies Corp. have come under fire from members of the patent community. In Promega, the Federal Circuit held that i) 35 U.S.C. § 271(f)(1) does not require a third party to "actively induce the combination" of a patented invention, and ii) that a single component can be a "substantial portion" of the components of patented invention. In this Article, I argue that the Federal Circuit decided these issues correctly in light of the policy considerations that went into Congress's enactment of 35 U.S.C. § 271(f) following the Supreme Court's unpopular Deepsouth decision. I further argue that there is no requirement of knowledge of a patent to find inducement under § 271(f)(1), only knowledge of the infringing acts. Overturning these holdings would, in effect, have ushered in a return to the world immediately after the Deepsouth decision, before the implementation of 35 U.S.C. § 271(f).
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INTRODUCTION

In 1972, the Supreme Court held Deepsouth Packing Company's building and exporting unassembled parts of a machine to be permissible, in spite of the fact that such actions would infringe upon the patents of Laitram Corporation Corp. had those parts been assembled in the United States.¹ Concerning Deepsouth's activities

in the U.S., the Court wrote, "[w]e cannot endorse the view that the
'substantial manufacture of the constituent parts of (a) machine'
constitutes direct infringement when we have so often held that a
combination patent protects only against the operable assembly of
the whole and not the manufacture of its parts." Because the Court
found no direct infringement, it could not find contributory
infringement. 3 Criticism of the Deepsouth decision 4 ultimately
motivated Congress to amend 35 U.S.C. § 271(f) by adding sections
(f)(1) and (f)(2). 5

In 2014, the Federal Circuit interpreted those sections,
sparking criticism from the patent bar. 6 Specifically, Promega
Corporation v. Life Technologies Corporation 7 held that 35 U.S.C.
§ 271(f)(1) does not require a third party for one "to actively induce
the combination" of a patented device, 8 and that a single component
of an invention can be a "substantial portion of the components." 9
Notable among the decision's critics, Professor Jason Rantanen has
argued that this holding are "probably erroneous—doctrinal
developments," 10 that the majority's first holding is an incorrect
textual analysis, 11 and that the second holding makes 35 U.S.C. §

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2 Id. at 528 (paraphrasing Laitram Corp. v. Deepsouth Packing Co., 443 F.2d
936, 939 (5th Cir. 1971)).
3 Id. at 526 ("[l]t is established that there can be no contributory infringement
without the fact or intention of a direct infringement.").
4 See, e.g., Neil M. Zipkin, Infringement and Assembly Abroad—Patent
Protection Takes a Vacation in Deepsouth, 47 ST. JOHN'S L. REV. 662, 663–64,
691 (1973).
6 Jason Rantanen, Promega v. Life Tech, pt. 2: Inducing Oneself, PATENTLY-O
(Jan. 8, 2015), http://patentlyo.com/patent/2015/01/promega
-inducement-ones.html.
7 Promega Corp. v. Life Technologies Corp., 773 F.3d 1338, 1350–57 (Fed. Cir.
2014).
8 Id. at 1351.
9 Id. at 1356.
10 Rantanen, supra note 7.
11 Id.
Proceeding in five parts, this Article examines this conflict in detail and supports the Federal Circuit's holding on these issues. Part II of the Article provides a technical background for the patents in suit in Promega. Part III of the Article addresses the details of the case: subsections III.A, III.B, and III.C respectively discuss the patents-in-suit, the accused products, and the majority opinion, paying particular attention to the two holdings relating to self-inducement to infringe a patent and the meaning of "a substantial portion of the components." Part IV.A examines the concept of a continuum of acts required for indirect patent infringement from inducement to contributory infringement, with specific attention to the substantiality and scienter requirements for such acts. Part IV.B discusses the controversy over what constitutes a substantial portion of the components with respect to § 271(f)(1), and proposes an interpretation of the statute to resolve the issues raised in Promega. Part IV.C investigates the question of whether the Promega decision requires a third party who actually commits the infringement in order to find inducement. Part IV.D looks into the legislative history of 35 U.S.C. § 271(f)(1) with regard to knowledge of the patent being infringed, and ultimately argues that the statute requires only knowledge of the act that infringes, not knowledge of the patent, for inducement liability to attach.

I. BACKGROUND

The method of identifying patterns in DNA, called short-tandem repeat ("STR") profiling, has become an important tool in forensic analysis of crime scenes and paternity testing. In order to obtain a large enough DNA sample, a technician must first make multiple copies of the DNA in a process called amplification; this is commonly achieved through a technique called polymerase chain

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12 Rantanen, supra note 7.
13 See infra Part IV.
reaction ("PCR").\(^{15}\) Polymerase is an enzyme that copies strands of DNA.\(^{16}\) In order for polymerase to do its work, technicians use a primer or marker molecule to target the start and end, or locus, of the STR of interest.\(^{17}\) Traditionally, a technician replicates one STR at a time. This process can be time-consuming.\(^{18}\) The patents and accused infringing products in the case of *Promega Corp. v. Life Technologies Corp.* encompass methods for amplifying multiple STRs simultaneously, greatly increasing the speed of the process.\(^{19}\)

II. **Promega Corp. v. Life Technologies (Fed. Cir. 2014)**

**A. Basis of the Controversy**

Promega owns four patents claiming methods for multiplex STR loci amplification.\(^{20}\) Promega is also the exclusive licensee of a fifth patent from the Max-Planck-Gesellschaft zur Förderung der Wissenschaften (The Max Planck Society), known as the Tautz patent.\(^{21}\)

The Tautz patent claims a kit for analyzing polymorphism in a DNA sample.\(^{22}\) This kit contains a) a mixture of primers; b) a polymerase; c) the G, C, T, and A nucleotides; d) a buffer solution; and e) template DNA.\(^{23}\)

Life Technologies Corporation ("LifeTech") makes kits that include all of the limitations claimed by the Tautz patent.\(^{24}\) The kits

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15 Promega Corp. v. Life Technologies Corp., 773 F.3d 1338, 1341 (Fed. Cir. 2014).
16 Id.
17 Id. at 1341–42.
18 Id.
19 Id.
22 Tautz Patent, supra, col. 16, l. 43–61.
23 Id.
24 Promega Corp. v. Life Technologies Corp., 773 F.3d 1338, 1344 (Fed. Cir. 2014); see also id. at 1350.
are used for multiplexing DNA samples, including but not limited to the STR combinations claimed by Promega's patents. LifeTech manufactures the polymerase component of the kit in the United States, and ships it overseas to a subsidiary facility in the United Kingdom, where workers assemble the polymerase with the remaining items to form the complete kits for worldwide distribution. In 2006, a predecessor company to LifeTech obtained a limited cross-license to the alleged inventions in the four Promega patents and the Tautz patent for "Forensics and Human Identity Applications."

B. Procedural History

Promega filed suit against LifeTech in 2010 for direct and induced infringement, alleging sales of the accused kits in applications beyond those subject to the limited 2006 license. The District Court judge instructed the jury to evaluate induced infringement under 35 U.S.C. § 271(f)(1), including sales of "all kits made, used, offered for sale, sold within the United States or imported into the United States, as well as kits made outside the United States where a substantial portion of the components were supplied from the United States." LifeTech objected to the inclusion of the § 271(f)(1) instruction, arguing that because its own subsidiary owned the U.K. facility completing the final assembly of the accused kits, inducement was inapplicable: a company cannot induce itself to infringe a patent under § 271(f)(1).

The jury attributed all of LifeTech's worldwide sales to infringing acts in the United States, and awarded $52 million in lost profits to Promega. LifeTech moved for judgment as a matter of law ("JMOL") on damages for infringement. The judge granted

25 Id. at 1344.
26 Id.
27 Id. at 1356 (quoting the confidential licensing agreement).
28 Id.
29 Id. at 1345 (emphasis added).
30 Id. at 1344.
31 Id. at 1350.
32 Id. at 1341.
LifeTech's motion and denied Promega's motion to reconsider.\textsuperscript{33} Both parties appealed to the United States Court of Appeals for the Federal Circuit.\textsuperscript{34}

\textit{C. Majority Opinion}

Writing for the majority, Judge Chen decided that "to actively induce the combination" of an infringing device under 35 U.S.C. § 271(f)(1) does not require a third party,\textsuperscript{35} and that "there are circumstances in which a party may be liable under § 271(f)(1) for supplying . . . a single component for combination outside the United States."\textsuperscript{36} The "single component" analysis interpreted the plain meaning of the words "substantial" and "portion."\textsuperscript{37} The court held that these words connoted importance and essentiality.\textsuperscript{38} LifeTech’s counsel argued that Congress explicitly chose the use of the plural "components" in (1), and the use of "component" in (f)(2), and that therefore, (f)(1) required "components" plural for inducement.\textsuperscript{39} The court rejected this argument, noting that they were used in different contexts.\textsuperscript{40} The court also highlighted subsection (f)(2)'s focus on inducement regarding any component "especially made for use in [a patented] invention . . . not a staple article or commodity suitable for substantial non-infringing uses."\textsuperscript{41} Among the six findings of the Federal Circuit panel, these two have garnered the most attention of commentators in the world of patent law.\textsuperscript{42} Members of the patent bar community have argued that these holdings are erroneous and likely to be overturned by the Supreme

\begin{itemize}
\item \textsuperscript{33} Id.
\item \textsuperscript{34} Id.
\item \textsuperscript{35} Id. at 1351.
\item \textsuperscript{36} Id. at 1353.
\item \textsuperscript{37} Id.
\item \textsuperscript{38} Id.
\item \textsuperscript{39} Id. at 1354.
\item \textsuperscript{40} Id.
\item \textsuperscript{41} Id. (quoting 35 U.S.C. § 271(f)(1)–(2) (2010)).
\item \textsuperscript{42} Id. at 1351; see also Rantanen, supra note 7.
\end{itemize}
Relying on a strict interpretation of the statutory language, the Federal Circuit found that the object of the inducement is not necessarily a third party. Rather, it is the combination of infringing components that the word "inducement" applies. While the court acknowledged that the word 'induce' can mean 'to influence another person,' it took a broad view of the meaning of the word, citing the Oxford English Dictionary, "[t]o bring about, bring on, produce, cause, give rise to." Further, the court noted that, in drafting § 271(f)(1), Congress could have included the word another to indicate that inducement required a separate party, but ultimately did not.

Because there is a lack of clear precedent on these matters, the court went on to examine the legislative history of § 271(f), and found that "[i]n order to be liable as an infringer under paragraph (f)(1), one must supply or cause to be supplied 'all or a substantial portion' of the components in a manner that would infringe the patent if such combination occurred within the United States." In particular, the legislative history states Congress's policy goal in enacting section § 271(f)(1) was to "prevent copiers from avoiding United States patents by supplying components of a patented product in this Country so that the assembly of the components may be completed abroad." The court noted, "it is unlikely that Congress intended § 271(f)(1) to hold companies liable for shipping components overseas to third parties, but not for shipping those same components overseas to themselves or their foreign

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43 Rantanen, supra note 7.
44 Promega Corp. v. Life Technologies Corp., 773 F.3d 1338, 1351 (Fed. Cir. 2014).
45 Id. (citing VII OXFORD ENGLISH DICTIONARY 888 (2d ed. 1989)).
46 Id.
48 Legislative History, supra note 50, at 5828.
subsidiaries.

While LifeTech relied upon *Global-Tech Appliances, Inc. v. SEB S.A.* to argue that inducement requires a third party, the court distinguished *SEB* by noting that the case implied the presence of inducement of another party, because under *SEB*’s facts, there actually was another party. Taken together, § 271(a) and (b) naturally presume a direct infringer, and one who induces that party to infringe. However, the court found analogies to § 271(b) to be of limited value because § 271(f)(1) lacks a companion statute regarding strict liability infringement like that of § 271(a). Accordingly, the court held that one need not induce another in order to be liable under § 271(f)(1).

2. "Substantial Portion of the Components"

Congress also took issue with the Federal Circuit’s finding that "there are circumstances in which a party may be liable under § 271(f)(1) for supplying or causing to be supplied a single component for combination outside the United States." Here, again, the court relied upon dictionaries for the plain meaning of "substantial," finding that it equates to "essential." In defining "portion" as "a part of a whole," the court found no support for the assertion that a portion need include a "certain quantity" of an invention. In other words, one component can be sufficiently "substantial" to satisfy § 271(f)(1).

LifeTech argued that the inclusion "substantial" within the statutory language "substantial portion of the components," suggests that a defendant can be liable under § 271(f)(1) only when they supply more than one component. The court rejected this

49 Promega, 773 F.3d at 1353.
49 Id.
50 Id.
51 Id.
52 Id. at 1353 (emphasis added).
53 Id. (citing XVII OXFORD ENGLISH DICTIONARY 67 (2d ed.1989)).
54 Id. (citing AM. HERITAGE COLL. DICTIONARY 1066 (4th ed. 2000)).
55 Id. at 1354.
interpretation, holding that 271(f)(1) applies to "a substantial portion of the components," not merely "the components" of a patented invention. 56 In short, the action of the subject of the statutory language (the inducer), acts on the singular noun "portion," not the plural noun "components." 57

Next, LifeTech relied on Microsoft v. AT&T Corp., 58 highlighting two footnotes where the Supreme Court noted that § 271(f)(1) and (2) differ in the number of components that one must supply to be liable. 59 Yet the Promega court noted that LifeTech ignored the next lines where the Supreme Court discussed § 271(f)(1) in the context of a single component. 60 LifeTech then argued that, because the Supreme Court discussed § 271(f)(2) in the context of a single component, the court had implied that § 271(f)(2) applied only to combinations of more than one component. 61 The Federal Circuit found this argument unpersuasive. 62

Applying this understanding to Promega, the Federal Circuit found that the polymerase component of the accused kit was a substantial portion of the components of the invention because the kit was useless without it. 63 The court relied upon LifeTech's own testimony that the polymerase was "one of the 'main' and 'major'

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56 Id.
58 Promega Corp. v. Life Technologies Corp., 773 F.3d 1338, 1354 (Fed. Cir. 2014).
59 Id. at 1355. While the two paragraphs differ, among other things, on the quantity of components that must be "supplie[d] ... from the United States" for liability to attach, see infra, at 1760, n. 18, that distinction does not affect our analysis. Paragraph (2), like (1), covers only a "component" amenable to "combination."

Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer. 35 U.S.C. § 271(f)(1); see also Microsoft v. AT&T, 550 U.S. 437, 454 (2007).
60 Id.
61 Id. at 1356.
62 Id. at 1358.
63 Id.
components of the accused kits."\(^{64}\) Accordingly, the Federal Circuit found that, without the polymerase component, the testing kit "would be inoperable because no PCR would occur."\(^{65}\) The Federal Circuit overturned the district court's grant of LifeTech's motion for JMOL, siding with the jury finding that LifeTech was liable for infringement under 35 U.S.C. § 271(f)(1).\(^{66}\)

This decision left the post-Promega world with an inadequate understanding of what constituted a substantial portion of the components of an invention. Short of an accused infringer's admission, the Federal Circuit provided no factors or guidance to determine what constitutes a 'substantial portion,' whether it is merely something required to make the invention work, or something more.\(^{67}\) For instance, it is likely that the kit would not operate without the buffer solution, which is presumably a commodity. Yet the court did not address whether a commodity component required for the invention to function, or a component with no non-infringing uses could count as a substantial portion under § 271(f)(1).

III. DISCUSSION

A. Statutory Landscape and the Indirect Infringement Continuum

To support the Federal Circuit's finding that a single component can represent a substantial portion of the components of an invention, it is necessary to examine the different types of indirect infringement covered by the various sections of 35 U.S.C. § 271. Four separate subsections of 35 U.S.C. § 271 codify the law of indirect infringement—specifically subsections (b), (c), (f)(1), and (f)(2).\(^{68}\) These subsections represent a continuum of acts required to

\(^{64}\) Id.
\(^{65}\) Id. at 1358.
\(^{66}\) Id. at 1357.
\(^{67}\) Id. at 1356.
\(^{68}\) 35 U.S.C. § 271 (2010). Subsection (c) discusses contributory infringement, which is itself a subset of the concept of inducement.
find indirect infringement with inducement represented by § 271(b) at one end, and contributory infringement represented by § (f)(2) and (c) at the other. Section 271(b) involves the act of inducing someone (arguably even oneself) to infringe a patent, and has three requirements—knowledge of the patent at issue, the intent to infringe, and an underlying act of direct infringement—in order for liability to attach.\textsuperscript{69}

By contrast, contributory infringement deals with the act of supplying components that are then combined to infringe a patent.\textsuperscript{70} The statute explicitly requires that the supplier must know the components will be combined in an infringing manner to find contributory infringement.\textsuperscript{71} The applicability of each subsection depends on what the accused infringers, knew, intended, and actually did to bring about the controversy by both direct and indirect means.

Despite the Supreme Court's decision, Section 271(f)(1) continues to occupy the murky middle ground at issue in \textit{Promega}. However, the differences between (f)(1), (f)(2), and 271(c), coupled with the provision's legislative history, may speak to Congress's intent in considering what counts as a "substantial portion" of the components and whether inducement requires a third party. The legislative history also suggests that the Supreme Court ruling in \textit{SEB} regarding § 271(b)'s knowledge of infringement requirement was never intended to apply to §271(f)(1).

1. \textit{The Continuum of Acts Required to Find Indirect Infringement: 35 U.S.C. § 271(b) to § 271(f)(2)}

At one end of the continuum lies § 271(b). U.S. patent holders seeking to enforce their patents in foreign countries often rely on the inducement theory in § 271(b) because it has exceptions to extraterritorial limitations and thus may extend the reach of U.S. patent law to foreign countries.\textsuperscript{72} The section's scant text contains


\textsuperscript{70} 35 U.S.C. § 271(c); 35 U.S.C. § 271(f)(2).

\textsuperscript{71} 35 U.S.C. § 271.

\textsuperscript{72} \textit{See e.g.}, Global-Tech Appliances, 563 U.S. at 754.
no requirement that shipment of components, substantial or otherwise, be involved in order to induce. Providing instructions to a party to use an item in an infringing manner may be sufficient for liability to attach under § 271(b). However, the subsection has one key limitation. Unlike direct infringement, which is a strict liability offense, inducement requires both knowledge—or, more rarely, willful blindness—of a patent and the intent to infringe upon it.

At the opposite end of the continuum are § 271(c) and (f)(2). These subsections deal with contributory or contribution-like infringement, and its elements are decomposed in Table 1 below.

<table>
<thead>
<tr>
<th></th>
<th>271(c) 76</th>
<th>271(f)(1) 77</th>
<th>271(f)(2) 78</th>
</tr>
</thead>
<tbody>
<tr>
<td>Whoever offers to sell or sells or imports into the United States a component of a patented machine . . . or a patented process constituting a material part of the invention not a staple article or commodity of commerce suitable for substantial noninfringing use</td>
<td>Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention knowing the same to be especially made or especially adapted for use in an infringement of such patent not a staple article or commodity of commerce suitable for substantial noninfringing use</td>
<td>Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention knowing that such component is so made or adapted not a staple article or commodity of commerce suitable for substantial noninfringing use</td>
<td></td>
</tr>
</tbody>
</table>

73 Id. at 759.
74 35 U.S.C. § 271(a) (20152012).
76 35 U.S.C. § 271(c).
This decomposition highlights many similarities between subsections (f)(2) and (c), but also a few key differences. In particular, the phrase in subsection (c) discussing the kind of part—*a material part of the invention* in subsection (c)—corresponds to the phrase *especially made* in (f)(2). This language provides some evidence of Congressional intent for purposes of interpreting "substantial portion of the components" under subsection (f)(1), whose statutory language and legislative history are otherwise silent as to what constitutes *substantial*. Further, § 271(c) deals *solely* with acts in the U.S. Congress directed the intent clause of subsection (f)(2) towards intent to combine components overseas, and the supply clause ties that intent to combine back to the shores of the U.S., which puts it within the purview of 271(b).

**B. What is a Substantial Portion of the Components?**

The majority in *Promega* held that a single component of a patented invention could constitute a "substantial portion of the components" under § 271(f)(1).⁷⁹ Professor Rantanen, however, has

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⁷⁹ Promega Corp. v. Life Technologies Corp., 773 F.3d 1338, 1356 (Fed. Cir.)
taken issue with the majority's holding and cautions that this could greatly expand liability under the provision. Specifically, he argues "[the] 'especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use' provision of subsection (f)(2) serves to narrow the scope of subsection (f)(1). Applying a strict textual interpretation to the facts in Promega seems to prove this view correct, provided that we assume that the accused kit requires all five components to function. If LifeTech were shipping just the buffer solution—a common commodity—overseas, finding patent infringement based on the buffer would not seem like a correct result.

These criticisms of the Promega decision highlight the ambiguity of the court's interpretation of subsection (f)(1). However, both § 271(c) and subsection (f)(2) as well as the statute's legislative history strongly suggest that—although not stated explicitly—subsection (f)(1) is concerned with the infringement of material components of an invention, or components that are especially adapted to the invention, regardless of their commodity status. Because of this ambiguity in both the statute and case law, the task of threading the needle between these poles of the indirect infringement continuum is extremely difficult.

Members of the patent bar community have proposed various fixes to Deepsouth's clarity problem. This Article focuses
on answering the question of what constitutes a "substantial portion of the components" by reading the word "substantial"—which means "quantity" according to its plain definition—to mean "material," which addresses the substance of the invention. Under this theory, the components must be especially adapted for use, but the §271(c) and subsection (f)(2) requirements regarding commodity status of the components would be removed. In effect, I would interpret section (1) as follows:

Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial material portion of the components especially adapted for use in of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

The word "material" has support in early bills first proposed to fix the Deepsouth problem which read, "[w]hoever without authority supplies . . . the material components of a patented invention." Applying the facts of the Promega case to each of such assembly, requiring only minor integration, does in fact take place abroad, shall be liable as a direct infringer.\textsuperscript{87} \textsuperscript{87} See supra Part I for a discussion of the Deepsouth case.\textsuperscript{88} \textsuperscript{88} substantial, adj., relating to size, quantity, solidity, etc. OXFORD ENGLISH DICTIONARY ONLINE, http://www.oed.com.du.idm.oclc.org/view/Entry/193050?redirectedFrom=substantial& (accessed March 12, 2016); material, adj., of or relating to matter or substance. OXFORD ENGLISH DICTIONARY ONLINE, http://www.oed.com.du.idm.oclc.org/view/Entry/114923?rskey=v5dKH8&result=1&isAdvanced=false (accessed March 12, 2016).\textsuperscript{89} \textsuperscript{89} 35 U.S.C. §§ 271(c), (f)(2) (2015).\textsuperscript{90} \textsuperscript{90} See, e.g., infra note 113 (emphasis added).
these sections puts this rule to the test. Recall that the accused kits contained five components, only one of which LifeTech manufactured in the U.S. and shipped to the U.K. for assembly and distribution worldwide.\(^8\) If LifeTech had shipped other components overseas, would the result change? The following sections address the components of the accused kits in decreasing order of what would seem to be their special adaptation for use in the kit at issue in Promega.

1. The Mixture of Primers

Supposing the primers were made in the U.S. and then shipped overseas, what would result if they were evaluated for § 271(f)(1) compliance at different points along the indirect infringement continuum? Putting aside the question of self-inducement, and assuming there is an underlying act of predicate infringement in the U.S. under § 271(a), § 271(b) could be sufficient to capture the sale of the primers to a party who then infringes the Tautz patent provided that Promega could show intent and knowledge of the patent as required by the holding in SEB.\(^9\) If those elements are missing or Promega cannot prove them, § 271(b) cannot stop LifeTech. Since the primers are leaving the U.S. and not being imported as a component, we can ignore § 271(c). While § 271(f)(2) would initially seem to protect Promega because the primers are not a commodity and are especially adapted for use,\(^9\) the provision has the same problem as § 271(b) with regard to the requirement of "intent and knowledge".

By contrast, the proposed reading of § 271(f)(1) would require only that we determine whether the primers are material to the invention and were specially adapted for use in the kit. Based on the

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\(^{8}\) Tautz Patent, supra note 21 (showing the five components: a) a mixture of primers; b) a polymerase; c) the G, C, T, and A nucleotides; d) a buffer solution; and e) template DNA)).


\(^{9}\) Promega Corp. v. Life Technologies Corp., 773 F.3d 1338, 1342 (Fed. Cir. 2014) (commenting on the laborious process for determining the proper set of primers that will multiplex the targeted set of STRs).
labor-intensive trial-and-error process which must be followed to determine which set of primers will multiplex the targeted set of STRs, the primers are demonstrably an essential component of the invention. It will not work without them. The mixture of primers gets to the very heart of the claimed invention. Furthermore, the primers were especially adapted for use in the invention and mark the beginning and ends of the STRs, whose successful combination is a laborious trial-and-error effort. Thus, the proposed § 271(f)(1) reading would offer protection to Promega.

2. The Polymerase

Both the § 271(b) and the § 271(f)(2) analyses of the invention's polymerase component proceed in much the same way as for the primer mixture, and both have the same weakness of requiring predicate direct infringement in the U.S. to satisfy both "knowledge" and "intent" to infringe. I will not belabor analyses under these sections further.

The proposed reading of § 271(f)(1) requires that we ask whether polymerase is material to the invention. The polymerase is material because the invention does not work without it; the DNA cannot be amplified without polymerase, a fact admitted by LifeTech's own witness at trial. The analysis becomes more complicated with polymerase, in considering whether it is a commodity item or whether it has been especially made or adapted for the invention. It is possible to take a commodity item and adapt it for a special use in a patent. This analysis has been summarized below.

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91 Id.
92 See supra Part II.
93 See id.
94 Promega, 773 F.3d at 1356.
Table 2. Inducement liability for polymerase under § 271(f)(1) (proposed) and § 271(f)(2).

<table>
<thead>
<tr>
<th>For a material component:</th>
<th>Especially made/adapted</th>
<th>Not especially made/adapted</th>
</tr>
</thead>
<tbody>
<tr>
<td>Commodity</td>
<td>Liability attaches under 271(f)(1) (proposed)</td>
<td>No liability for inducement under 271(f)(1) (proposed) or 271(f)(2).</td>
</tr>
<tr>
<td>Not a Commodity</td>
<td>Liability for inducement attaches under 271(f)(2), if Promega proves knowledge of the patent. If it cannot prove knowledge, liability attaches under 271(f)(1) (proposed)</td>
<td></td>
</tr>
</tbody>
</table>

If polymerase is a commodity that has not been especially made for the invention, then liability will not attach under either § 271(f)(1) or § 271(f)(2), because the commodity has substantial non-infringing uses and has not been especially adapted. If polymerase is not a commodity, but has been especially made or adapted, then liability under § 271(f)(2) will attach, provided that Promega can prove scienter. If Promega cannot prove scienter, liability could attach under the proposed reading of § 271(f)(1). The key difference between the two is the question of scienter: whether LifeTech knew of the Tautz patent and its infringing acts. The test would thus satisfy the interests of the policy underlying patent law. If polymerase is a commodity that is adapted for the kits claimed in the Tautz patent, the proposed reading of § 271(f)(1) would protect Promega from LifeTech's activities altogether.

3. The G, C, T, A Nucleotides

Based on the same reasoning as the analyses above, these molecules are material to the invention because the kit would not

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95 Note that these nucleotides alone, being molecules found in nature, are not patent-eligible subject matter under 35 U.S.C. § 101, as affirmed by the Supreme Court in Mayo Collaborative Services v. Prometheus Laboratories, Inc., 132 S. Ct. 1289, 1293 (2012) ("The Court has long held that this provision contains an important implicit exception...: [L]aws of nature, natural phenomena, and abstract ideas are not patentable...").
work without them.\(^96\) In order to replicate DNA, it is necessary to have the underlying nucleotide building blocks available\(^97\). However, this component would fail the especially adapted prong of the proposed § 271(f)(1) test because nucleotides are present in every living organism known to science and were not especially adapted for the kit. They also fall under the purview of § 271(f)(2) as having substantial non-infringing uses. This result aligns with common sense: shipping common components overseas for combination in an infringing product should not be seen as inducement to infringe.

4. The Buffer Solution

As with previous components, the buffer solution is likely to be material because the kit cannot work without it; it is one of the claimed components of the invention.\(^98\) If the buffer solution were not especially adapted for the accused kit, the proposed interpretation of § 271(f)(1) would allow manufacture of the buffer in the U.S. for shipment overseas. Further, the solution falls under the commodity or staple exception in § 271(f)(2). In the case of the nucleotides, inducement liability could attach only where the buffer had been especially adapted.

5. The Template DNA

For purposes of the template DNA are certainly material to the kit.\(^99\) Under the proposed interpretation of § 271(f)(1), the question becomes whether the template DNA was especially adapted for the kit. Thus, if Promega "especially adapted" the template DNA for use in the kit, export for foreign combination would expose LifeTech to liability under the proposed reading of § 271(f)(1) even without the knowledge of infringement required under § 271(f)(2). Once again, this approach yields a fair result.


\(^97\) Id.

\(^98\) Tautz Patent col. 16, l. 43–61, supra note 23.

\(^99\) See supra Part II.
6. Summary

In each of the five analyses above, the proposed interpretation of § 271(f)(1) would not only fall in line with common sense, but would be consistent with the U.S. Constitution's aim "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their respective . . . Discoveries." 100 This interpretation would also protect a patent holder from having the key pieces of its inventions shipped overseas for infringing purposes— the exact situation Congress was trying to avoid when it enacted 35 U.S.C. § 271(f) to close the DeepSouth loophole. 101 Further, it could provide added protection to patent holders who cannot prove scienter on the part of the accused infringer, which is in line with Congress's intent in enacting § 271(f). 102

Such an interpretation would also avoid the question raised in Promega as to whether one component can be a "substantial" part of the invention. The quantity of the components should be irrelevant; rather, the materiality of the components is key. Suppose, for instance, that the preferred embodiment of an invention was comprised of a hundred parts, and an accused infringer exported ninety-nine non-material parts overseas for combination with the last part. Further suppose that the invention would not work without the last part. Under certain readings of § 271(f)(1), this would look like a substantial portion of the components and should allow liability to attach. Moreover, it seems absurd to hold someone liable as an infringer through the extraterritorial imposition of U.S. law if such parts are not required to make the accused device work. However, the proposed interpretation of § 271(f)(1), would not attach liability under such conditions. As such, the patent holder would be left with recourse to § 271(a), should the infringer import

100 U.S. CONST. art. I, § 8, cl. 8.
101 Promega Corp. v. Life Technologies Corp., 773 F.3d 1338, 1352 (Fed. Cir. 2014) ("Congress . . . sought to 'prevent copiers from avoiding United States patents by supplying components of a patented product in this Country so that the assembly of the components may be completed abroad.'" (citing Legislative History, supra note 49, at 5828)).
102 See infra Part IV.D.
the accused device into the U.S., sensibly limiting the extraterritoriality of U.S. patent law.

Now suppose that one material part of the previous invention was made in the U.S. for combination with the other ninety-nine overseas. LifeTech's reading of § 271(f)(1) as introduced in Promega would not count such an action as infringement. By contrast, the proposed interpretation of § 271(f)(1) would catch this activity as infringement by attaching liability to the action of shipping a material piece of another's patent overseas for assembly to skirt U.S. patent law. Further, because § 271(f)(1) does not require knowledge of the patent, the proposed interpretation puts a useful tool into the hands of U.S. patent holders. As such, this would be an appropriate exercise of the extraterritoriality of U.S. law.

C. Self-Inducement: Is it Infringement?

One of the controversial holdings of the Promega case was that a party may be liable under 35 U.S.C. § 271(f)(1) for supplying a component even to onself for combination outside the U.S.\(^{103}\) In other words, one could induce oneself to infringe a patent. The patent blogosphere criticized this decision;\(^{104}\) Rantanen in particular attacked the majority's textual analysis of 35 U.S.C. § 271(f)(1) as "deeply flawed."\(^{105}\) Both Rantanen and Promega's majority rely on dictionaries to examine the meaning of 'induce' under the provision.\(^{106}\) However, this view misses the larger points of the policy that Congress wished to effectuate when it enacted § 271(f)—namely, to close the loophole left by the Supreme Court's Deepsouth decision. Overturning Promega would have brought about a return of Deepsouth, where infringers would need only set up "finishing plants" abroad to receive the components of a device that, once assembled, would infringe a U.S. patent.\(^{107}\)

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\(^{103}\) Promega, 773 F.3d at 1353.

\(^{104}\) See, e.g., Rantanen, supra note 7.

\(^{105}\) Id.

\(^{106}\) Id.; see also Promega, 773 F.3d at 1351.

Rantanen rebuffed the Federal Circuit's argument that Congress could have added the word "another" to the statute if it had intended to restrict inducement to third parties\textsuperscript{108} by claiming that "[t]ypically, the principle is invoked in the context of a parallel statute."\textsuperscript{109} However, this view misses both the rich legislative history of § 271(f) and the continuum of indirect infringement that Congress has laid down over the years, with contributory infringement at one end—represented by § 271(c) and (f)(2)—inducement at the other end with § 271(b), and § 271(f)(1) in the middle to apply to inducement to combine a substantial portion of the components of an infringing device.\textsuperscript{110}

Rantanen further noted the Supreme Court has required inducement of another in patent and copyright cases respectively.\textsuperscript{111} However, \textit{Promega} stands firmly within both the law as written and the intent of the Congress that drafted it.\textsuperscript{112} The Federal Circuit analyzed the plain meaning of the term "induce," construing it to mean "to bring about, or to cause."\textsuperscript{113} No version of the bill, the court noted, suggests that Congress intended to require the presence of a third party by adding the word "another" to the statute.\textsuperscript{114} In reviewing the legislative history, the court also found that Congress had focused on closing the loophole left by the Supreme Court's unpopular \textit{Depsouth} decision, not on a question of whether inducement is a three-party affair.\textsuperscript{115}

Any future decision which attempts to overturn the Federal Circuit's \textit{Promega} decision would open a gaping loophole in the

\textsuperscript{108} Rantanen, supra note 7.
\textsuperscript{109} Id.
\textsuperscript{110} See supra Part IV.B.
\textsuperscript{111} See id.
\textsuperscript{112} See infra Part IV D.
\textsuperscript{113} Promega Corp. v. Life Technologies Corp., 773 F.3d 1338, 1351 (Fed. Cir. 2014).
\textsuperscript{114} Id.
\textsuperscript{115} Id. at 1352 ("Congress . . . sought to ‘prevent copiers from avoiding United States patents by supplying components of a patented product in this Country so that the assembly of the components may be completed abroad.’" (citing Legislative History, supra note 49, at 5828)).
extraterritorial reach of U.S. patent law. It would allow domestic companies to escape infringement liability under § 271(f)(1) by shipping infringing components to themselves, rather than to a third-party. Because direct infringement does not apply abroad, § 271(f)(1) determines instead that "[w]hoever . . . supplies . . . components . . . in such a manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such a combination occurred within the United States, shall be liable."116 Would Congress have intended to treat more harshly a domestic company that shipped components abroad to a foreign company than a domestic company that shipped the components to itself overseas? Finding that inducement of the combination of infringing components, rather than focusing on the actor doing the inducement, would prevent such a result.

D. Knowledge of Infringement Versus Knowledge of Acts

1. 35 U.S.C. § 271(f)(1) does not require knowledge of the patent.

When considering infringement under 35 U.S.C. § 271, it is important to address the accused infringer's intentions, level of knowledge, and actions. For example, § 271(b), (c), and (f)(2)117 all require some knowledge of indirect infringement, either explicitly, or via Supreme Court precedent.118 Whether an alleged infringer knew they were infringing a patent, or whether they merely had knowledge of the acts that form the basis for the infringement is often critical. Whether the same can be said for section f(1) has yet to be addressed in any court.

The text of 35 U.S.C. § 271(f)(1) suggests that an individual needs only to supply components that, when combined outside the country, would infringe upon a patent in order for infringement liability to attach.119 However, "[i]ntent and knowledge" of a patent are not explicit requirements under § 271(f)(1), nor has the case law

117 35 U.S.C. §§ 271 (b), (c), (f)(1)-(2).
read them into the statute as it has for § 271(b). Under § 271(f)(1), it is the act of supplying the components, their combination, or hypothetical combination, to infringe a patent that attaches liability; knowledge of the patent is not required.

As an example, suppose that LifeTech had merely developed an infringing product in parallel to Promega with no knowledge of the Tautz patent. If, under this scenario, LifeTech sold this device in the U.S., its sales would be direct infringement under § 271(a). Under the same scenario, however, if LifeTech shipped the components to outside the U.S. for assembly, liability would attach under § 271(f)(1), even without evidence of knowledge of the patent. On the other hand, if LifeTech knew of the Tautz patent and subsequently shipped its components abroad for combination, liability would attach under § 271(f)(2), provided Promega could prove LifeTech’s knowledge of the patent.

Requiring knowledge of the act which created infringement, but not of the fact of infringement itself, addresses concerns raised by critics. In his amicus brief in Global-Tech Appliances, Inc. v. SEB S.A., Ted Sichelman—Director of the Center for Intellectual Property Law & Markets, and Professor of Law at the University of San Diego—argued that presumably one would only need bury one’s head in the sand and avoid looking for patents, and remain blissfully ignorant to the possible infringement landscape around him in order to avoid liability under § 271(f)(1). Ignorance of the law would become the ultimate defense as would-be infringers strategically avoided looking at patents as part of their clearance-to-practice activities. Provided the maker of an infringing widget knew he was making the widget, whether he was aware of any patents infringed upon should be irrelevant.

2. Congress Did Not Intend § 271(f)(1) to Require Knowledge of

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120 See Global-Tech Appliances, 563 U.S. at 764.
the Patent or Intent.

Reading intent into § 271(f)(1) does not comport with the legislative history of the statute. In fact, the history shows that Congress considered, and removed, the intent and knowledge requirements from early versions of § 271(f), splitting the proposed sections into § 271(f)(1)—which has no knowledge and intent requirements—and § 271(f)(2), which had both.\textsuperscript{124} Without a requirement for knowledge of the infringing act, the bright-line difference between subsections (f)(1) and (f)(2) becomes intent.

Is it logical to question that Congress intended § 271(f)(1) to require only knowledge of acts, not knowledge of infringement, for liability to attach? While such an interpretation would seem to fly in the face of the Supreme Court’s decision in \textit{SEB} regarding 35 U.S.C. § 271(b),\textsuperscript{125} the statute’s legislative history supports the theory that knowledge of acts should be sufficient for liability. An early version of § 271(f) appears in a 1983 Senate bill; this version included an intent element and elided the "actively induce" element, but otherwise paralleled the current language of § 271(f)(1).\textsuperscript{126} The presence of intent in S. 1535, absent from the version of § 271(f)(1) that became law, indicates Congress considered intent in subsection (f)(1) before removing it. Moreover, bills seeking to fix the \textit{Deepsouth} ruling appeared in various forms in the 98th Congress, all containing both elements of knowledge and intent.\textsuperscript{127}

In June 1984, the American Intellectual Property Law Association ("AIPLA") advised Congress to remove the knowledge

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\item \textit{See also supra} Part IV.B.
\item Global-Tech Appliances, Inc. v. SEB S.A., 563 U.S. 754, 766 (2011) (holding that induced infringement requires knowledge of the patent in suit).
\item S. 1535, 98th Cong. § 1 (1983) ("Whoever without authority supplies or causes to be supplied in the United States the material components of a patented invention, where such components are uncombined in whole or in part,\textit{ intending} that such components will be combined outside of the United States, and\textit{ knowing} that if such components were combined within the United States the combination would be an infringement of the patent, shall be liable as an infringer.") (emphasis added); \textit{see, e.g.}, H.R. 4526, 98th Cong. (1983); H.R. 4814, 98th Cong. (1984).
\item S. 1535, 98th Cong. § 1 (1983).
\end{enumerate}
\end{footnotesize}
requirement from the pending House bill.\textsuperscript{128} The AIPLA's argument centered on a potential plaintiff's difficulty in proving both infringement and a "knowing" state of mind on the part of the defendant.\textsuperscript{129} The AIPLA thought that requiring knowledge would allow an accused infringer an "easy escape" from liability and would essentially gut the provision.\textsuperscript{130} This recommendation was eventually codified as 35 U.S.C. § 271(f)(1), without elements for knowledge or intent.\textsuperscript{131}

The AIPLA was rightly concerned that a knowledge of infringement requirement would lead to an "easy escape" for infringers.\textsuperscript{132} Its report to Congress noted that "[t]he holding in the Deepsouth Case enables domestic copiers to circumvent the protection afforded by the patent laws by taking simple evasive

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\textsuperscript{128} AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION, REPORT TO THE SUBCOMMITTEE ON COURTS, CIVIL LIBERTIES, AND THE ADMINISTRATION OF JUSTICE, COMMITTEE ON THE JUDICIARY (Jun. 13, 1984). ("We recommend that the word "knowing" be deleted from line 5 on page 2 [of H.R. 4526, 98th Cong. (1983)]. Section § 271(f) like existing Section 271(a) defines activities which constitute direct infringement of a patent. If a patentee brings suit pursuant to Section 271(a), he must prove that the alleged infringer committed the infringing acts. A judge or jury decides whether or not the patent was infringed. Section § 271(f) as drafted would require that the patentee not only prove that the alleged infringer committed the infringing acts and intended the combining of the material components outside of the U.S. but also that he did so 'knowing' that components when combined would "be an infringement of the patent." The existence of this state of mind in the alleged infringer would be extremely difficult to prove. Proof of infringement involves both facts and law and cannot be known until after a court determination. Therefore, for the patentee to prove that the alleged infringer "knew" would be an easy escape for the unscrupulous infringer and would effectively nullify the section. But more importantly, the reason § 271(f) should be added to the law is that patent rights should be protected whether an infringer finally assembles the infringing product in the U.S. or arranges to have it done in a foreign country. We see no reason to require a higher burden of proof in one set of circumstances and not the other.") [hereinafter AIPLA Report].
\textsuperscript{129} Id.
\textsuperscript{130} Id.
\textsuperscript{131} Id.
\textsuperscript{132} AIPLA Report, supra note 134.
\end{flushright}
production and marketing tactics.\textsuperscript{133} Similarly, the Houston Patent Law Association warned of just such an effect of the \textit{Deepsouth} case in 1973, writing, "[u]nder the \textit{Deepsouth} holding, American industry is encouraged to construct 'finishing plants' overseas, . . . [t]his situation would allow an infringer to set up shop next door to a patent-protected inventor whose product enjoys a substantial foreign market and deprive him of valuable business."\textsuperscript{134} Is the construction of such a finishing plant anything but self-inducement? The Houston Report also made the argument that it is contrary to notions of efficiency and cost to force a patent holder to defend itself against an infringer in numerous foreign jurisdictions, rather than just the single infringing company in the U.S. inducing itself.\textsuperscript{135}

Further, Senator Strom Thurmond noted that the purpose of the early bills addressing \textit{Deepsouth} was "[t]o declare it to be patent infringement to supply components of an invention patented in the United States for final assembly abroad if the purpose of the shipment abroad is to circumvent a U.S. patent."\textsuperscript{136} Nothing in the statute's legislative history suggests that the purpose of the proposed legislation was only to apply to inducement of others.\textsuperscript{137} The plain language "to circumvent a U.S. patent" applies to the situation of direct infringement.\textsuperscript{138} Congressional records make it clear that Congress wrote § 271(f) to overcome \textit{Deepsouth}\textsuperscript{139}—specifically the Supreme Court's determination that "[w]e cannot endorse the view that the 'substantial manufacture of the constituent parts of (a) machine' constitutes direct infringement."\textsuperscript{140} If § 271(f) was designed to overcome \textit{Deepsouth}, it follows that it was Congress's intention that the new statute would construe the manufacture of the constituent parts as direct infringement. In its report on 98 S. 1535—a predecessor to the bill that would become 35 U.S.C. § 271(f)—the reviewing Senate committee stated that "[t]he bill simply amends

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\item \textsuperscript{133} \textit{Id.}; H.R. 6286, 98th Cong. (1984).
\item \textsuperscript{134} \textit{Houston Report, supra} note 107.
\item \textsuperscript{135} \textit{Id.}
\item \textsuperscript{137} \textit{Id.}
\item \textsuperscript{138} \textit{Id.; see also} 35 U.S.C. § 271(a) (2012).
\item \textsuperscript{140} \textit{Deepsouth Packing Co. v. Laitram Corp.}, 406 U.S. 518, 528 (1972).
\end{enumerate}
\end{footnotesize}
the patent law so that when components are supplied for assembly abroad to circumvent a patent, the situation will be treated the same as when the invention is "made" or "sold" in the United States."\(^\text{141}\) Making, selling, or using a patented invention in the U.S. is direct infringement under 35 U.S.C. 271(a).\(^\text{142}\) This strongly suggests that Congress never wanted to exclude self-inducement under § 271(f)(1).

Upholding the *Promega* decision would largely eliminate the practice of opinion counsel, which has historically been self-serving. If a finding of infringement requires knowledge, alleged infringers could skirt the law simply by procuring an attorney's letter to show that they had a reasonable belief that their devices did not infringe.\(^\text{143}\) While the Supreme Court has eliminated the use of opinion counsel with regard to invalidity of patents, it has not addressed opinion counsel with respect to patent infringement.\(^\text{144}\) Once the requirement for knowledge of infringement is removed, however, the loophole from infringement liability closes.

Most practically, overturning the Federal Circuit in *Promega* would effectively invite such evasive production tactics as discussed in the AIPLA Report.\(^\text{145}\) Any company could simply set up an assembly subsidiary in another country in order to infringe to its heart's content, much to the detriment of American ingenuity and the patent provision of the U.S. Constitution.\(^\text{146}\) By gutting the law that was meant to overturn such tactics, *DeepSouth* would rise again.

**CONCLUSION**

The Federal Circuit correctly concluded in *Promega* that one can induce oneself to infringe a patent, and that a single component can constitute a "substantial portion of the components" under 35 U.S.C. § 271(f)(1). Presuming a continuum of indirect infringement

\(^{141}\) Sichelman Brief, *supra* note 128, at 34.  
\(^{142}\) *Id.*  
\(^{143}\) *Id.*  
\(^{145}\) AIPLA Report, *supra* note 134.  
\(^{146}\) U.S. CONST. art. I, § 8, cl. 8.
ranging from 35 U.S.C. § 271(b) to 271(c) and (f)(2), this Article has proposed a new interpretation of § 271(f)(1) to find indirect infringement when a material portion of components of a patented device are shipped overseas for combination. This would focus attention on the importance of the components to the function of a device, rather than the quantity. The proposed interpretation also would require that the components be especially adapted for use in the patented device. Lastly, this Article argued that § 271(f)(1) requires only knowledge of the acts ultimately constituting infringement, rather than knowledge of the patent those acts infringe. Should the Supreme Court affirm the Federal Circuit's holding, it will keep Deepsouth from rising again.

**Practice Pointers**

- Where possible, showing that an accused infringer knew of or intended to infringe a patent, should be the preferred course of action. This could allow a plaintiff to recover enhanced damages.\(^\text{152}\)
- Direct patent infringement in the U.S. is essentially a strict liability offense under 35 U.S.C. § 271(a). An accused infringer operating in a complete vacuum, unaware of a patent, can still infringe it.
- Under the current law, it is inducement to infringe a patent to ship a substantial portion of the components of a patented device overseas for combination, if that combination would constitute infringement in the U.S.

Revenge Porn and Narrowing the CDA: Litigating a Web-Based Tort in Washington

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Abstract

Effective September 2015, the Washington State Legislature passed two statutes which created both civil and criminal liability against individuals who distribute "intimate images" of others without their consent. These statutes were created to combat the modern phenomenon colloquially known as "revenge porn." Revenge porn is the non-consensual distribution of nude or sexually explicit photographs or videos, created with the intent to humiliate or harass the person these images depict. In addition to causing emotional damage to the victim, revenge porn can also produce broader consequences such as loss of employment and stalking. Traditionally, litigating these kinds of offenses has been difficult because traditional tort theories have been ruled inadequate, defendants often fall back on the Communications Decency Act ("CDA") to protect websites hosting such material, and, until recently, such offenses were not taken seriously. This Article focuses on the practical concerns of litigating civil cases under Washington’s revenge porn statute and its constitutional limitations under the CDA and the First Amendment.


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INTRODUCTION

"Revenge porn", and nonconsensual pornography in general, are uniquely modern phenomena where someone posts sexually explicit or suggestive pictures or video of another person on the Internet without their consent in order to humiliate them. Some people engage in revenge porn by publicly posting nude and/or sexually explicit pictures and videos of former romantic partners on the Internet, often alongside their names and social media accounts, in
order to humiliate their former partner. In a recent example of nonconsensual pornography, a group of hackers stole private photographs from famous actresses—most of which were nude photos—and published them on every Internet outlet they could find.²

Many view revenge porn as the foolishness of 'kids these days', and often blame the victim or tell them to "get over it"; however, these cases can seriously impact the victim’s life.³ In addition to the psychological damage caused by the initial humiliation and breach of trust, many victims lose their jobs and suffer other negative consequences in their personal lives.⁴

This Article begins with an outline of failed attempts to litigate revenge porn cases under traditional tort law. It then explains the elements of a revenge porn claim under WASH. REV. CODE § 4.24.795 (2015).⁵ The Article goes on to discuss the possibility of litigation against host websites in the face of CDA protection, followed by a discussion of the First Amendment concerns regarding revenge porn. Lastly, this Article explores the ongoing harm caused by this problem.

² Jason Meisner, Chicago Man to Plead in Agreement Over ‘Celebegate’ Photo Hacking, CHICAGO TRIBUNE, (August 31, 2016), http://www.chicagotribune.com/news/local/breaking/ct-celebrity-photos-hacking-chicago-suspect-met-20160830-story.html (While the hackers were not former romantic partners, this is still an example of non-consensual pornography.)


⁴ In one example, a teacher in Texas was fired after a co-worker discovered online photos of the teacher where her breasts were visible. See Heather L. Carter et al., Have You Googled Your Teachers Lately? Teachers’ Use of Social Networking Sites, 89 PHI DELTA KAPPAN 681, 683 (2008).

⁵ There is both a civil and criminal version of this statute. This Article focuses on the civil version for the sake of brevity. The criminal version can be found at WASH. REV. CODE § 9a.86.010.
I. FAILED ATTEMPTS TO LITIGATE REVENGE PORN UNDER TRADITIONAL TORT LAW

Litigants have attempted to combat revenge porn offenses under several traditional tort theories. Some victims have even attempted to copyright the photos in question in order to compel the host website to take them down. Not only did such demands not work, but the copyright process made the photos the victim was attempting to keep private even more public. Other traditional tort theories—such as defamation/false light, intentional infliction of emotional distress ("IIED"), breach of privacy, and libel—have similarly failed. This next section will address these failings in greater detail.

A. Defamation or False Light Theories

Defamation, stated broadly, is when one person publishes false and harmful things about another. Several courts have ruled against defamation or false light theories in cases of revenge porn because the material published does not always contain false claims, or even any fact-based claims at all. For example, in the recent case of Patel v. Hussain, a spurned ex-boyfriend published sexually explicit photos and videos of the victim, taken over the course of several years. Because none of these photos or videos were published alongside any factual claims about the victim, true or false, the Texas Court of Appeals denied relief under a theory of defamation. Specifically, the court held that the "a jury’s finding of substantial truth precludes liability for a defamation claim." Based on this, and similar lines of reasoning, false light theories have also

7 Id. ("[Submitting the nude photos for copyright protection] made Hilary cringe. ‘I thought, well no, this must be wrong ... they’re forcing me to disclose them further when that’s what I was trying to prevent.’").
10 Patel at 158.
11 Id. at 174.
been unsuccessful in providing relief to most victims of revenge porn.\textsuperscript{12}

\textbf{B. IIED Theories}

The plaintiff in \textit{Patel} was also denied relief under a theory of IIED.\textsuperscript{13} This tort usually arises as a "gap filler" when other theories of liability are unavailable to a plaintiff.\textsuperscript{14} On appeal, the \textit{Patel} court held that the victim’s invasion of privacy claims barred her from recovering under an IIED theory.\textsuperscript{15} Essentially, because other tort theories were triable, the court reasoned that this gap had already been filled and concluded that IIED was not available. Even in cases where IIED claims are available, a successful claim requires that the harm suffered be "utterly intolerable in a civilized community."\textsuperscript{16} In certain communities, being a victim of revenge porn might be considered offensive, but potentially not enough to be "utterly intolerable in a civilized community." As such, courts may suggest that not every victim of revenge porn suffers from emotional harm in a way actionable under traditional tort law.

\textbf{C. Breach of Privacy Theories}

A breach of privacy claim in a revenge porn case commonly

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\item Id: but see also, \textsc{Restatement (Second) of Torts} § 652E, cmt. a (1976). (explaining that falsehood is a required element of a false light claim.).
\item Patel v. Hussain, 485 S.W.3d at 158.
\item Id. at 176 (citing Hoffmann–La Roche Inc. v. Zeltwanger, 144 S.W.3d 438, 447 (Tex. 2004))
\item Id. at 176.
\item \textsc{Restatement (Second) of Torts} § 46, cmt. d (2016).
\item See \textsc{Restatement (Second) of Torts} § 46 (2016) Illustration 4. Plaintiffs are expected to be "hardened to a certain amount of rough language, and to occasional acts that are definitely inconsiderate and unkind." Illustration 4 pushes at the boundaries of what is tolerable in a civilized community. It reads, "A makes a telephone call but is unable to get his number. In the course of an altercation with the telephone operator, A calls her a God damned woman, a God damned liar, and says that if he were there he would break her God damned neck. B suffers severe emotional distress, broods over the incident, is unable to sleep, and is made ill. A's conduct, although insulting, is not so outrageous or extreme as to make A liable to B."
fails for two reasons. First, the published images or videos may not be "substantially certain to become public knowledge" and thus do not meet the standard for invasion of privacy.\textsuperscript{18} In many revenge porn cases, the published images remain available only to a small audience.\textsuperscript{19} Second, the published images may be considered of legitimate concern to the public.\textsuperscript{20} Many celebrities have had intimate images of themselves stolen and published, some of whom have made their sex lives part of their careers.\textsuperscript{21} Thus, a victim who is publicly open about their sex life may also be barred from recovering on invasion of privacy claims.\textsuperscript{22}

II. LEGISLATIVE HISTORY – REVENGE PORN AND TRADITIONAL TORTS

Legislative notes strongly suggest that the Washington State Legislature viewed a new statute for revenge porn as unnecessary because existing causes of action under traditional tort doctrine should have addressed the issue. As the committee notes, "[i]t/ability currently exists for some harms that result from disclosure of embarrassing or emotionally distressful material."\textsuperscript{23} That the legislature nevertheless enacted a bill directed specifically towards revenge porn is a clear message to judges, juries, and litigators that these cases should not be taken as some modern anomaly brought on as a symptom of an oversensitive culture or careless youths.\textsuperscript{24} This statement indicates that the committee

\textsuperscript{18} \textit{Restatement (Second) of Torts} §652E cmt. A (1977).
\textsuperscript{21} \textit{Id.}
\textsuperscript{22} \textit{Id.}
\textsuperscript{24} According to Laura Higgins, operator of the UK based revenge porn helpline, "Police forces often don't take it seriously. There's a lot of victim-blaming that
believed the law already holds individuals liable who disclose information that is embarrassing to others, and that revenge porn should be treated no differently.

The codified elements of revenge porn are nearly identical to those of several traditional torts. As the legislature noted in its review, "[t]he tort of invasion of privacy is codified in statute and is based on the common law tort of public disclosure of private facts." 25

The bill summary also notes that, "[t]he tort of intentional infliction of emotional distress, also known as the tort of outrage, exists when a defendant engages in extreme and outrageous conduct to intentionally or recklessly inflict emotional distress on a plaintiff." 26 This language highlights the harm and intent elements of Wash. Rev. Code § 4.24.795. On the surface, this statute places a limit on speech, but so do laws concerning IIED, which is a much broader category of speech. Alternatively, this shows that these claims are to be framed similarly to negligence claims—specifically, plaintiffs would need to show (1) that defendants had a duty to not distribute material that should be considered private, (2) a breach of this reasonable expectation of privacy, (3) causation, and (4) damages.

In light of the legislature's deliberate parallels to these tort claims, future litigators in revenge porn suits would be well-advised to frame their cases around elements common to similar torts. For example, by showing that a reasonable expectation of privacy existed, a complaint can read like an invasion of privacy claim. By showing that the defendant’s behavior was so severe and outrageous that it caused emotional harm to the plaintiff, a complaint can read like an IIED claim. In such cases, litigators should seek to show that something private was knowingly disclosed to the public without the concerned party’s consent.

26 Id.
III. ELEMENTS OF A REVENGE PORN CLAIM UNDER WASH. REV. CODE § 4.24.795

A. Elements broadly

Thirty-four states, including Washington, recently passed statutes to create both public and private causes of action for victims of nonconsensual pornography. Some of these statutes have had limited success; others have not.

Washington’s private cause of action for victims of revenge porn has three elements. Any person who (1) distributes an "intimate image" of another person, (2) that they acquired that image under circumstances that a reasonable person would know it was supposed to remain private, and (3) distributes the image knowing that the distribution would cause that person harm will be liable under this statute. The statute defines its key terms, such as "intimate images," and sets out specific factors for juries to consider when assessing the reasonable expectation of privacy.

B. What is an "Intimate Image"?

Section five of WASH. REV. CODE § 4.24.795(5) defines an "intimate image" as "any photograph, motion picture film, videotape, digital image, or any other recording or transmission of another person ... that was taken in a private setting." In creating this definition, the Washington State Legislature cast a broad net in terms of the various formats with which such images could be

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29 "Intimate image" is defined in WASH. REV. CODE § 4.24.795(5) (2016); see also Part III.B infra.
32 Id.
captured. Most modern media could be summed up as "digital images," but this definition likely expands the statute to cover analogous forms such as VHS or Betamax since both would be considered a "motion picture film" or "videotape."

This section also establishes criteria for what makes an image "intimate." Images are only "intimate" if they depict "[s]exual activity, including sexual intercourse defined in RCW 9A.44.010," or "[a] person’s intimate body parts, whether nude or visible through less than opaque clothing." This language suggests that certain kinds of images will not be protected by the statute. For example, sharing images of someone in opaque lingerie or wearing a swimsuit may not be actionable under the statute. While risqué photographs published without a plaintiff’s knowledge may cause distress, the publication is unlikely to be actionable as revenge porn unless intimate body parts are visible or the image depicts sexual activity.

C. Reasonable Expectation of Privacy

The revenge porn statute does not explicitly define a "reasonable expectation of privacy." Instead, it lists factors that determine "whether a reasonable person would know or understand that the image was to remain private."

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33 Id. ("'intimate image' means any photograph, motion picture film, videotape, digital image, or any other recording or transmission of another person who is identifiable from the image itself or from information displayed with or otherwise connected to the image.")


was the photo taken in the privacy of a home, or was it taken during a professional photo-shoot or public event? Arguably, photos taken at home carry a greater expectation of privacy than those taken in public. The circumstances of distribution may also be a factor: photos posted on a photographer’s art blog would likely carry less culpability than myexgirlfriend.com. The former implies some consent to publication, while the latter does not. Lastly, the statute also allows courts to consider "other relevant factors". This is a standard legislative catch-all indicating the list above is not meant to be exhaustive. Often the privacy element in revenge porn cases is fact-intensive, as these offenses happen in a wide variety of settings. As such, attorneys would be well advised to develop the facts of these cases in great detail.

D. Damages and Attorney’s Fees

Quantifying damages under this statute presents some difficulty. WASH. REV. CODE § 4.24.795 states that anyone who distributes intimate images of another person without their consent is subject to "actual damages including, but not limited to, pain and suffering, emotional distress, economic damages, and lost earnings, reasonable attorneys’ fees, and costs." While some of these damages will be easily calculable, damages due to emotional distress, pain and suffering, and so on, are notoriously nebulous in a legal context.

IV. Obstacles to Revenge Porn Litigation

A. The Communications Decency Act ("CDA") Could Bar Litigation against Host Websites

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42 WASH. REV. CODE § 4.24.795(2).
43 The Restatement (Second) of Torts § 924 cmt. b, 912 cmt. a (1979) states that "[n]o rule can be stated profitably on the amount of damages recoverable for [emotional] harms." In another section, it states that one cannot prove with certainty any real equivalence between emotional damages and compensation in money.
The CDA provides a defense to host websites, and thus has barred causes of action against the root cause of revenge porn. However, recent cases across several circuits have shown that the CDA does not offer complete immunity to websites from lawsuits.

Congress enacted the CDA in 1998 in response to *Stratton Oakmont, Inc. v. Prodigy Services* and several similar cases. In *Stratton*, the court held that the defendant’s message board was akin to a newspaper; as such, by taking steps to police the content of this message board, the defendant had engaged in an editorial function that exposed it to publisher liability. As later courts have also observed, Congress did not want to punish website operators for engaging in this kind of self-policing. Rather, Congress passed the CDA to protect website operators from this liability, and to bolster the "free and open" nature of the Internet.

Under the CDA, "[n]o provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another information content provider." An interactive service provider is defined as "any information service, system, or access software provider that provides or enables computer access by multiple users to a computer server." This essentially means that those who post are responsible for their words, but those who host the content are not. This has the practical

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46 See, e.g., Fair Housing Council of San Fernando Valley v. Roommates.com, 521 F.3d 1157, 1163 (9th Cir. 2008).
47 See *Stratton* at *3. ("The choice of material to go into a newspaper and the decisions made as to the content of the paper constitute the exercise of editorial control and judgment . . . , and with this editorial control comes increased liability.").
48 J.S. v. Vill. Voice Media Holdings, 359 P.3d 714, 724 (Wash. 2015) ("Before it passed this statute, Congress weighed the competing policies of fostering robust interactive service provider growth, promoting self-policing by the interactive service provider industry, and protecting against victimization by Internet advertisements") (emphasis added).
effect of barring plaintiffs from seeking remedy against online platforms that host "revenge porn."

Two landmark cases have addressed this matter. In *Fair Housing Council of San Fernando Valley v. Roommates.com* the Ninth Circuit imposed criminal liability against an "interactive service provider." The *Roommates* court found that the defendant was an "information content provider," despite the fact that the bulk of their website went to hosting third-party content. This was because the defendant had "materially contributed" to the unlawful nature of the content in question. By requiring that users submit information regarding their race, marital status, etc., the defendant had developed and materially contributed to content that could potentially violate the Fair Housing Act. However, the defendant also encouraged its users to post additional comments, many of which contained discriminatory content. These, the court held, were not subject to publisher liability. Nothing about the defendant’s "additional comments" section required users to submit discriminatory content or any other form of content that could potentially violate the Fair Housing Act on its own. Thus, the Ninth Circuit granted the defendant immunity from liability for these comments.

This is significant to revenge porn cases because some websites may not explicitly host this type of content. For example, if a defendant uploads their images to a content neutral website (e.g., Facebook or Imgur), then the host website will fail the material contribution test and likely be protected by the CDA.

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52 *Fair Housing Council of San Fernando Valley v. Roommates.com*, 521 F.3d 1157 (9th Cir. 2008).
53 The CDA defines the term as "any person or entity that is responsible, in whole or in part, for the creation or development of information provided through the Internet or any other interactive computer service." 47 U.S.C. § 230(f)(3).
54 See *Roommates*, 521 F.3d at 1167–1168. ("…we interpret the term "development" as referring not merely to augmenting the content generally, but to materially contributing to its alleged unlawfulness").
55 *Id.* at 1169.
56 Examples of comments included "NOT looking for black Muslims," and "[no] psychos or anyone on mental medication." See *id.* at 1174.
57 *Facebook.com* is a generic social media website. *Imgur.com* is a website that hosts any images its users will post (subject to their terms and conditions).
The Sixth Circuit also relied on this idea of "material contribution" in *Jones v. Dirty World Entertainment*. While the court found the defendant immune from suit under the CDA, the court employed the material contribution test to determine immunity in a civil suit. The *Jones* court specifically stated that "the CDA does not necessarily leave persons who are the objects of anonymously posted, online, defamatory content without a remedy." *Jones* suggests that there may not be blanket immunity for website operators in either a civil or criminal context. Under *Jones*, if a content host passes the material contribution test, then it crosses the line from "interactive service provider" into "information content provider," and is open to liability.

The statutory language giving rise to the material contribution test is the definition of "information content provider." Under the CDA’s definition, a content provider is "any person or entity that is responsible, in whole or in part, for the creation or development of information provided through the Internet or any other interactive computer service." The *Roommates* court decided that a website can operate in two capacities: (1) as an interactive service provider whose activities are immune under the CDA; and (2) as an "information content provider," which is not immune under the CDA. The court held that:

"... if [a website] passively displays content that is created entirely by third parties, then it is only a service provider with respect to that content. But as to content that it creates itself, or is "responsible, in whole or in part" for creating or developing, the website is also a content provider."

Substituting "material contribution" for "development" does not,

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59 Id. The comments giving rise to the plaintiff’s defamation suit were merely edited and displayed by the defendant according to the Sixth Circuit.
60 Id. at 417.
61 Fair Housing Council of San Fernando Valley v. Roommates.com, 521 F.3d 1157, 1162 (9th Cir. 2008).
63 Roommates at 1162.
64 Id.
on its own, clarify the limits of CDA immunity. While the Roommates court did not provide a clear definition of "material contribution," it listed a number of factors to weigh in the test. Each factor requires a website operator to do something beyond passively transmitting other people’s data. The contribution also needs to go beyond simply providing users with the option to create illegal or unlawful content. For example, simply hosting images—be they nude photos or pictures of dogs—contributes nothing to the content that users post on a website. However, a website that collects nude photos from all corners of the internet on its own initiative is doing more than passively transmitting its users’ data, and will likely be found to have made a "material contribution".

This debate led to the Sixth Circuit’s decision in Jones. The Jones court held that an online tabloid, which selected and edited defamatory comments about private individuals did not "materially contribute" to the unlawful content. The defendant in Jones operated a website dedicated entirely to the public humiliation of private individuals through comments and photographs submitted by third parties. While the substantive content came from submissions, the defendant both curated and published content with his own commentary. Nevertheless, the court held that the defendant was merely performing a passive editorial function and was thus free from liability.

The term "material contribution" remains demonstrably vague—due in part, the Jones court suggested, to the policy reasons behind the CDA. The court stated that Congress "envisioned a free and open internet," and that the immunity that § 230 provides serves that purpose. However, not only do the words "free and open" not appear in the section the court cited (§ 230(a)(1)-(5)), but the actual statement of policy is § 230(b), which states in a sub-provision that "it is the policy of the United States … to ensure vigorous

65 Id. at 1166-1167.
66 Id. at 1168.
68 All of this was supposedly done for the purpose of “humor.” Id. at 403.
69 Id. at 416.
70 Id. at 417.
71 Id.
enforcement of Federal criminal law to deter and punish trafficking in obscenity, stalking, and harassment by means of computer.”\textsuperscript{72} This suggests that, at least on a criminal level, the CDA was passed in part to prevent forms of harassment like revenge porn, and not to provide online harassers a shield against liability. A surprising number of courts have ignored this language in leading CDA cases.\textsuperscript{73}

\textit{FTC v. Accusearch Inc.} also weighed in on the definition of "material contribution" under the CDA. In this case, the Tenth Circuit denied the defendant immunity under the CDA, holding that "a service provider is ‘responsible’ for the development of offensive content only if it in some way specifically encourages development of what is offensive about the content."\textsuperscript{74} This "encouragement test" was mentioned in the \textit{Jones} appeal,\textsuperscript{75} but was ultimately dismissed. The key difference between \textit{Jones} and \textit{Accusearch}, the Sixth Circuit reasoned, was that the defendant in \textit{Accusearch} had bought and sold the offensive content for money, whereas the defendant in \textit{Jones} collected and published his content for free.\textsuperscript{76}

However, one does not have to offer money to constitute solicitation of illegal material. There are many websites whose \textit{raison d'etre} is the collection and publication of revenge porn.\textsuperscript{77} While revenge porn websites often do not offer money in exchange for their content, they still exist solely to propagate this type of material and to profit from it. This "encouragement" or "solicitation test", should Washington courts adopt it, would circumvent CDA immunity by showing that the host site exists solely to publish harmful, non-consensual content that is unlawful under Washington statute.

Attorneys will likely have to target websites hosting revenge porn rather than the original posters alone in order to more

\textsuperscript{72} 47 U.S.C. § 230(b)(5) (emphasis added).
\textsuperscript{73} One notable exception, which will be discussed below, is J.S. v. Village Voice Media Holdings L.L.C., 359 P.3d 714, 720, Wiggins J. Concurring (Wash. 2015).
\textsuperscript{74} 570 F.3d 1187, 1199 (12th Cir. 2009) (emphasis added).
\textsuperscript{75} Jones v. Dirty World Entertainment, 755 F.3d 398, 414 (6th Cir. 2014).
\textsuperscript{76} Id.
\textsuperscript{77} Id. at 413 (quoting \textit{Accusearch}, 570 F.3d 1187 at 1200).
effectively deter non-consensual pornography. Depending on the circumstances, a revenge porn website might do nothing more than passively publish other people’s illicit photos. Or it might, for example, contribute materially to its third party content by requiring submissions to include personal information of the person depicted. As such, attorneys should also emphasize the statement of policy embodied in section (b) of the CDA because revenge porn is the exact type of "stalking, and harassment by means of computer" that the CDA was designed to punish.


In 2015, the Supreme Court of Washington decided a landmark case regarding the limits of CDA immunity. In *J.S. v. Village Voice Media Holdings, L.L.C.*, a group of minors sued a website operator who hosted ads that allegedly led to children being "bought and sold for sexual services online on Backpage.com in advertisements." The issue before the court was whether the plaintiffs’ case should be dismissed under Washington Superior Court Civil (CR) Rule 12(b)(6), in spite of a potential conflict with the CDA, or whether the case should be allowed to go forward. The majority opinion, authored by Justice Gonzales, highlighted the fact that, when considering a Rule 12(b)(6) motion, courts must "accept as true the allegations in a plaintiff’s complaint and any reasonable inferences therein."

The plaintiffs in *Village Voice* alleged that the defendants had "developed content requirements that it [knew would] allow pimps and prostitutes to evade law enforcement," and that "the content requirements [were] nothing more than a method developed by [the

82 *Vill. Voice Media Holdings*, 359 P.3d at 717.
83 *Id.* at 716 (quoting Reid v. Pierce County, 961 P.2d 333, 336 (Wash. 1998)).
defendants] to allow pimps, prostitutes, and Backpage.com to evade law enforcement for illegal sex trafficking, including the trafficking of minors for sex."\textsuperscript{84} Given the deference granted to the plaintiffs’ allegations under Rule 12(b)(6), the Washington Supreme Court found that the facts as alleged were sufficient to satisfy the material contribution test of \textit{Roommates.com}, and remanded the case back to the trial court.\textsuperscript{85}

The concurring opinion of Justice Wiggins delved further into the defendants’ failure to qualify for CDA immunity. Justice Wiggins examined the language of the CDA and determined "that subsection 230(c)(1) creates a defense to, not an immunity [from], liability."\textsuperscript{86} The defense created under the CDA only applies when the "plaintiff seeks to treat [the defendant], under a state law cause of action, as a publisher or speaker of information."\textsuperscript{87} The "[p]laintiffs’ claims that Backpage.com created "content rules" specifically designed to induce sex trafficking and evade law enforcement did not treat Backpage.com as the publisher or speaker of another’s information.\textsuperscript{88}

If Justice Wiggins’ concurrence in \textit{Village Voice} takes hold, litigators should not frame their complaints on the basis of publisher liability, but rather as a direct violation of R.C.W. § 4.94.795. Indeed, the civil statute does not say "[a] person who \textit{publishes} an intimate image of another person," but instead "[a] person who \textit{distributes} an intimate image of another person" intentionally and without consent is subject to liability.\textsuperscript{89} As such, complaints against revenge porn websites should use language that invokes the material contribution test found in \textit{Roommates} and \textit{Jones}. The language should emphasize the following: (1) that a defendant’s website distributes non-consensual pornography; (2) that website holds itself out to the public as a distributor of non-consensual

\textsuperscript{84} Id. at 718.
\textsuperscript{85} Id. at 717 ("Viewing J.S.’s allegations in the light most favorable to J.S., as we must at this stage, J.S. alleged facts that, if proved true, would show that Backpage did more than simply maintain neutral policies prohibiting or limiting certain content").
\textsuperscript{86} Id. at 721.
\textsuperscript{87} Id. at 719.
\textsuperscript{88} Id.
pornography; and (3) this materially contributes to the distribution of non-consensual pornography featuring the plaintiff.\footnote{The language of the statute specifically mentions CDA immunity. \textit{See WASH. REV. CODE} § 4.24.795(7) (2016) ("Nothing in this section shall be construed to impose liability on an interactive computer service, as defined in 47 U.S.C. 230(f)(2)") For further reading on the CDA as it relates to revenge porn, \textit{see} Peter W. Cooper, \textit{The Right to be Virtually Clothed}, 91 WASH. L. REV. 817, 828 (2016). Cooper frames the CDA defense in terms akin to someone who puts up "an empty newsrack" (the host site) and the users who fill the rack with whatever content they choose. It could (and perhaps should) be argued that there is a substantive distance between putting up a cork board saying "post pictures here," and putting up a cork board that specifically says, "illegally post nude photos of your ex-lovers in order to humiliate them here."}

B. First Amendment Concerns

Critics of revenge porn laws, such as the ACLU,\footnote{Rick Stone, \textit{In Florida, 'Revenge Porn' Is a Moving Target}, WLRN (Dec. 4, 2013, 7:56 AM), http://wlrn.org/post/florida-revenge-porn-moving-target.} have asserted that these statutes could be interpreted too broadly, and ultimately infringe upon the publisher’s First Amendment right to free speech.\footnote{\textit{See} Amanda L. Cecil, \textit{Taking Back the Internet: Imposing Civil Liability on Interactive Computer Services in an Attempt to Provide an Adequate Remedy to Victims of Nonconsensual Pornography}, 71 WASH. & LEE L. REV. 2513, 2535 (2014).} However, many of these concerns are precisely why intent and actual harm requirements were written into similar statutes in other states.\footnote{Cecil, \textit{supra} note 93 ("In response to [First Amendment] criticisms, California narrowed the scope of its law by adding the intent and proof of harm requirements.".).} In \textit{F.C.C. v. Pacifica Foundation},\footnote{\textit{F.C.C. v. Pacifica Foundation}, 438 U.S. 726 (1978).} the Supreme Court of the United States declared that speech that is highly offensive, harmful, and does not hold any social value is not entitled to protection under the First Amendment. Specifically, the Court held that "[s]uch utterances are no essential part of any exposition of ideas, and are of such slight social value as a step to truth that any benefit that may be derived from them is clearly outweighed by the social interest in order and morality."\footnote{\textit{Id.} at 746.} So long as juries are likely to be convinced that the harm inflicted by this content significantly
outweighs any social benefit it might offer, the First Amendment should not deter litigation under this statute.\textsuperscript{96} Attorneys should emphasize the harm caused by non-consensual pornography, as well as the malice behind it.

Further, revenge porn falls under a number of exceptions to First Amendment protection. The most logical of these is the obscenity exception. In \textit{Miller v. California}, the Supreme Court held that "[a]t a minimum, prurient, patently offensive depiction or description of sexual conduct must have serious literary, artistic, political, or scientific value to merit First Amendment protection."\textsuperscript{97} Given that revenge porn likely does not have such value,\textsuperscript{98} it likely falls within the obscenity exception found in \textit{Miller}.

Secondly, given the fact that revenge porn is intended to harm the victim’s reputation and "blacken their good name," it will likely fall under the defamation exception established in \textit{New York Times Co. v. Sullivan}.

Third, given the fact that revenge porn is illegal in Washington, and often accompanied by the target’s personal information (e.g., name, address, phone numbers, links to social media accounts, etc.), revenge porn could fall under the incitement exception found in \textit{Brandenburg v. Ohio}.

Nearly half of all revenge porn victims report that they have been stalked and harassed by people who saw

\textsuperscript{96} While there doesn’t appear to be a revenge porn case decided on First Amendment grounds, in \textit{Milo v. Martin}, the court noted that, when it comes to the CDA “Congress apparently made a choice ‘not to deter harmful online speech through the separate route of imposing tort liability on companies that serve as intermediaries[,]’” 311 S.W.3d 210, 215 (Tex. Ct. App. 2010). This suggests that Congress has not contemplated revenge porn and how it relates to the First Amendment.

\textsuperscript{97} Miller v. California, 413 U.S. 15, 26 (1973) (emphasis added).

\textsuperscript{98} Hunter Moore publically admitted that his revenge porn website existed only to cause public humiliation. Murray, \textit{supra} note 4.

\textsuperscript{99} New York Times Co. v. Sullivan, 376 U.S. 254, 269 (1964) ("Libel can claim no talismanic immunity from constitutional limitations. It must be measured by standards that satisfy the First Amendment.")

\textsuperscript{100} Brandenburg v. Ohio, 395 U.S. 444, 447 (1969) ("[F]ree speech and free press do not permit a State to forbid or proscribe advocacy of the use of force or of law violation except where such advocacy is directed to inciting or producing imminent lawless action and is likely to incite or produce such action.") (emphasis added).
their nude photos online. 101 The Brandenburg states that speech that is likely to create "imminent lawlessness" and is "likely to incite or produce such [lawless] action." 102 Given the fact that many revenge porn websites post their victim’s personal information (e.g., address, workplace, etc. 103), and the high percentage of victims who experience stalking as a result, 104 the imminence and likelihood requirements of Brandenburg’s incitement exception are satisfied. Thus, revenge porn websites arguably incite people to perform unlawful acts (such as distributing revenge porn) and also incite people to stalk and harass revenge porn victims.

C. The Legal Profession Remains Unfamiliar with the Internet

Washington State’s revenge porn revenge porn statute was passed in part because there was a "lack of understanding of what revenge porn was," within the legal profession. 105 There is still a presumption that sharing any kind of intimate content, be it a photo for your long-distance sweetheart or one taken for other purposes, implies that such content becomes open to the public. 106 However, revenge porn causes a great deal of emotional harm and has the potential to ruin lives. Litigators and courts alike need to take these offenses seriously, both in the technical aspects of revenge porn and the harm it causes for the sake of clients and society as whole.

102 Brandenburg v. Ohio, 395 U.S. at 447.
103 Franks, supra note 101 at 11.
104 Franks, supra note 101.
106 See, e.g. Rebecca Pocklington, Jennifer Lawrence to blame for her naked picture leak - says Ricky Gervais (who later deleted his comment), MIRROR CELEBRITY NEWS, (Sep. 23, 2014), http://www.mirror.co.uk/3am/celebrity-news/jennifer-lawrence-blame-naked-picture-4145801.
CONCLUSION

Revenge porn is a serious offense that affects many people—mostly women—in today’s world. Washington’s legislature has made it clear that this problem should be treated as a violation of privacy and as a malicious infliction of emotional harm. Therefore, the legal community should not hesitate to take these cases, both against individual offenders and websites hosting this content. While the CDA and the First Amendment present obstacles to litigation, they are not impossible to overcome. Attorneys seeking to hold host websites liable need to demonstrate that the host "materially contributed" to the illicit nature of the content by showing that they did more than passively transmit information from third parties. Many of the predecessor statutes to WASH. REV. CODE § 4.24.795 have been challenged on several grounds, and if Washington’s statute is to survive, then litigators must tread carefully to avoid both CDA and First Amendment defenses.

Lastly, this statute represents an encouraging step in the right direction for Washington State and the country as a whole. Lawyers in the contemporary era are grappling with problems that previous generations could not have anticipated. This demonstrates an attempt by the law to enter into the twenty first century by showing that an individual’s rights do not end at the computer screen. WASH. REV. CODE § 4.27.795, and its criminal counterpart, will grant victims an adequate remedy for the very real damage that revenge porn can cause. The legal profession would do well to take these cases seriously.
PRACTICE POINTERS

- Revenge porn is actionable when someone distributes nude photos of someone without their consent and with the intent to cause them harm.
- Revenge porn is unlikely to be protected under the First Amendment because it falls under a number of exceptions to free speech, including obscenity, defamation, and incitement.
- Host websites for such material are generally protected under the CDA; however, case law expanding upon the material contribution test suggests that revenge porn websites may be subject to liability for revenge porn as well.
- Attorneys would be well-advised to examine how, if at all, hosts of non-consensual pornography and revenge porn contribute to the illegal nature of their content.