

AN ODYSSEY THROUGH COPYRIGHT'S VICARIOUS DEFENSES

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It is rare that an issue of fundamental importance to copyright litigation goes wholly unaddressed. Yet that rare situation applies to the question of how courts should treat affirmative defenses raised by "related" defendants, i.e., those who are claimed not to have committed the infringement itself (the "primary" defendants) but who are nonetheless sought to be held responsible on the theories of vicarious liability or contributory infringement. Should those defenses inure to the benefit solely of the defendant who pleads them? Or should they be evaluated in the context of the primary claim of infringement, and thus radiate outward for the benefit of all defendants in the action? Although legions of cases confront such vicarious defenses, they do so in a wholly uncritical fashion—some adopt the former approach, others the latter; their unifying point is that they fail to articulate any basis for drawing the distinction. Neither do the scholarly commentaries treat this issue, notwithstanding that it would seem to be essential to sound progress in the field.

*The case law's failure to address this disparity would give rise to no problems if only everyone's intuition invariably agreed as to which cases fit into which categories. Recently, however, I found myself for the first time ever disagreeing with how a particular court evaluated the affirmative defense of a related defendant. The case in question is *Religious Technology Center v. Netcom On-Line Communications Services, Inc.*, 907 F. Supp. 1361 (N.D. Cal. 1995), which rejected the primary defendant's fair use defense, and then when confronting the related defendant's summary judgment motion recalibrated the entire fair use equilibrium with respect to the circumstances of that new defendant. To evaluate the wisdom of that court's treatment of the vicarious fair use defense, it is necessary to take several gigantic strides backwards and to articulate a framework for how related defendants may assert their affirmative defenses, whether personally or globally.*

Happily, on a recent archaeological romp, I encountered some ancient judicial opinions in which resolution to these issues emerges full-blown from the judicial brow. I hereby present them unedited.

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IN THE UNITED STATES DISTRICT COURT
FOR THE OUTER DISTRICT OF THE
PELOPONNESUS
(THERMOPYLAE DIVISION)

ACHILLES,) Case No. CV 453-AZ-T
)
Plaintiff,) MEMORANDUM
) AND ORDER
)
v.)
)
ZENO et al.,)
)
Defendants.)

TEIRESIAS, District Judge.

This case presents a fascinating issue of first impression: When a copyright infringement action proceeds against related defendants who raise affirmative defenses, do those defenses relate to the primary defendant or to secondary liability? Determining that at times the former and at other times the latter situation should pertain, this opinion formulates a taxonomy of related defenses.

I
UNDERLYING FACTS

Plaintiff Achilles claims to be author of the copyrighted work in question, an epic poem entitled The Iliac. Attached to his complaint is a certificate of copyright registration filed within five years of the poem's publication, duly listing Achilles as author. See 17 U.S.C. § 410 (1994).

Achilles complains of the unauthorized performance of his work at the Hippodrome Theater located in Halicarnassus. From the complaint, it appears that defendant Zeno performed a one-man show in that theater for one night only. Plaintiff's allegation is that Zeno set the copyrighted work to calliope music with a terpsichorean overlay; he entitled his performance with those sacred interpolations The Sacroiliac. Plaintiff contends that the unauthorized performance of The Sacroiliac constitutes infringement of his copyright in The Iliac.

II

JURISDICTION AND VENUE

Challenging the jurisdiction of this court to adjudicate causes of action under Title 17 of the United States Code, defendants initially sought the dismissal of this action. In a previous order, the court denied that request:

Locales as diverse as the Canal Zone and East Berlin have hosted United States district courts in the past. At present, they continue to sit in such far-flung locales as Samoa and the Northern Mariana Islands. And now the instant defendants contend that a court sitting in the very cradle of civilization is without power to adjudicate fundamental rights of culture precisely where culture itself originated? I don't think so!

Achilles v. Zeno, 1 F. Sapp. 2222, 2223 (O.D. Plps. 533 B.C.E.) (confronting Peisistratean recension). The court also denied a request for change in venue, holding that it would be much more fun to try the case locally. See *id.*

An additional preliminary matter at this juncture is whether this court has subject matter jurisdiction over the performance that took place extraterritorially in Halicarnassus. I have elected to exercise jurisdiction over this cause of action, relying for precedent on *London Film Productions Ltd. v. Intercontinental Communications, Inc.*, 580 F. Supp. 47, 48-49 (S.D.N.Y. 1984) (exercising jurisdiction to adjudicate claims of violation of Chilean copyright law through performance in Chile, and citing for support, 3 Melville B. Nimmer, *Nimmer on Copyright*, § 17.03, at 17-22 to -24 (1982)). But see *ITSI T.V. Prods., Inc. v. California Auth. of Racing Fairs*, 785 F. Supp. 854, 866 (E.D. Cal. 1992) (discerning "no clear authority for exercising such jurisdiction" and refusing "to enter the bramble bush of ascertaining and applying foreign law without an urgent reason to do so").

Defendants contest the persuasiveness of the *London Film* case, citing David R. Toraya, Note, *Federal Jurisdiction Over Foreign Copyright Infringement Actions—An Unsolicited Reply to Professor Nimmer*, 70 Cornell L. Rev. 1165 (1985). Putting aside the insolence of that unsolicited reply, I note that the scholarly article itself emanates from Cornell, which purports to be located in Ithaca. Having made an exhaustive tour of that island—and also following the court's *sua sponte* examination of Odysseus, its ruler—I have determined that it contains no institution of higher learning or otherwise named "Cornell." I thus conclude that the cited article must be part of some gigantic hoax.

III

DRAMATIS PERSONAE

As already stated, the allegation of copyright infringement is directed primarily against Zeno. Nonetheless, that primary infringer is not a party to this action. Zeno, paradoxically, evaded service of process through a clever ruse—he informed the marshal attempting to serve him that such service was impossible, given that the marshal first would have to approach him halfway, then traverse the remaining half, and only thereafter the half that remained, *kai ta loipa*, and thus could never effectuate such service. Evidently, the marshal retreated in confusion to a monastery from which he has not yet emerged.

Although Zeno is not a party to the action, the allegations of the complaint continue to maintain that he alone committed copyright infringement. Nonetheless, various other individuals are alleged to have assisted in the infringing conduct. Achilles alleges various facts against those related defendants, maintaining that each is either vicariously liable for Zeno's performance or materially aided it in such a manner as to be liable as a contributory infringer. See Shapiro, *Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304, 307 (2d Cir. 1963) (discussing vicarious liability); *ITSI*, 785 F. Supp. at 861 (describing contributory infringement). In particular, those allegations run against the following defendants: Briseis, Chloe, Daphnis, Epicurus, Flavius, Gaia, Hector, Iphigenia, and Jocasta. Not named in the current complaint but potentially subject to suit in an amended recension are Klytemnestra, Laertes, Menelaus, Nestor, Oedipus, and Paris. As the various defenses of those related defendants are canvassed below, the role of each in the infringing conduct will be clarified as necessary for the resolution of this matter.

IV

VICARIOUS DEFENSES

Before turning to each of the related defendants' allegations, it is worth emphasizing that the mere absence of Zeno from this litigation does not by itself accord any defense. It arises not infrequently that the primary infringer is unavailable for suit—whether because judgment-proof, deceased, beyond the arm of the law, or otherwise. In such cases, judgment may still proceed on theories of vicarious liability and contributory infringement against those defendants over whom jurisdiction lies. See 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright*, § 12.04[A][3][a], at 12-85 to -88 (1997); see also *Danjaq, S.A. v. MGM/UA Communications, Co.*, 773 F. Supp. 194, 201 (C.D. Cal. 1991); cf. *Sony Corp. of Am. v. Universal City Studios*,

Inc., 464 U.S. 417, 434 (1984) (“The two respondents in this case do not seek relief against the Betamax users who have allegedly infringed their copyrights.”).

Nonetheless, there can be no secondary liability absent primary infringement. See *Sony*, 464 U.S. at 434 (“To prevail, they have the burden of proving that users of the Betamax have infringed their copyrights and that Sony should be held responsible for that infringement.”). Therefore, regardless of whether Zeno is haled into court or not, to the extent that Zeno himself did not commit copyright infringement, this proceeding would end forthwith. See *Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc.*, 964 F.2d 965, 970 (9th Cir. 1992) (approving district court holding that because declaratory plaintiff neither directly infringed nor infringed by authorization upon defendant’s copyright, plaintiff did not violate Copyright Act). In other words, to the extent that no primary infringement occurred, it is unnecessary to delve into the niceties of each other party’s defenses; instead, the case as a whole could simply be dismissed. That consideration will reemerge at several crucial points in the succeeding analysis.

A. *Personal Jurisdiction*

The first related defendant against whom suit is brought is Briseis. The allegations of the complaint are cloudy. Evidently, Briseis was at one point plaintiff’s beloved. However, when she called Achilles a “heel,” he was mortally offended. At that point, he charged that she had transferred her affections to Zeno and thus that she was responsible for Zeno’s acts of infringement.

Counsel for Briseis has appeared specially before this tribunal, claiming that personal jurisdiction over her is lacking. Towards that end, counsel has submitted a declaration showing that Briseis has never entered this jurisdiction; has never performed business affecting this jurisdiction; and, indeed, has never left her ancestral home of Lyrnessus. Plaintiff has failed to counter any of those allegations.

I therefore hold that Briseis lies outside of this court’s jurisdiction. See *Roth v. Garcia Marquez*, 942 F.2d 617, 620-25 (9th Cir. 1991) (holding that limited personal jurisdiction over foreign defendant existed where defendant had entered forum [or “agora” as I would put it] and performed business as usual). On that basis, I grant her defense and dismiss her from the action.

The court’s ruling on this issue has no impact on any of the other defendants. Simply stated, none of the remainder has specially ap-

peared to contest personal jurisdiction; indeed, all appear to have conceded that such jurisdiction exists.

To recur to the issue that launched this opinion, it therefore appears that, in this first incarnation at least, the affirmative defense is personal—it affords an excuse solely to the individual who raises it, neither exerting an impact on any other defendant, whether primary or related, nor affecting the course of the proceedings as a whole. Nonetheless, before drawing any generalizations from this solitary resolution, it is necessary to proceed onwards.

B. *Private Performance*

Chloe and Daphnis, according to the allegations of the complaint, commissioned Zeno to engage in the infringing performance at the Hippodrome Theater. In their answer, they concede that they did indeed induce Zeno to perform the subject work and, in fact, paid him for his services. However, they counter that they are lovers who rented out the cavernous Hippodrome for an intimate performance in which they constituted the only two members of the audience. On that basis, they allege that no “public” performance took place on the night in question. They therefore conclude that Achilles has not suffered trespass on any of his statutory rights. See 17 U.S.C. § 106(4) (1994) (“[T]he owner of copyright under this title has the exclusive rights . . . to perform the copyrighted work *publicly* . . .” (emphasis added)).

Strictly speaking, Daphnis and Chloe are not interposing an affirmative defense. Instead, their contention is that an element of the plaintiff’s *prima facie* case is lacking. I agree with the proposition that Achilles’s case must fail to the extent that he cannot demonstrate a public performance of his work. Nonetheless, because contested issues of fact remain as to how many people—apart from the paying audience of two—were present at the Hippodrome Theater during the subject performance, I will reserve judgment on this matter pending further inquiry.

Nonetheless, this defense sheds light on our primary inquiry: To the extent that the instant related defendants can negate an essential element of the *prima facie* case, then the lawsuit as a whole crumbles. In other words, should this court accept as fact the proposition that no public performance occurred, then the result would be not simply to immunize Daphnis and Chloe from liability, but to resolve all matters adversely to Achilles. In the face of such a finding, he would be unable to establish any liability against Zeno as primary defendant or against any of the other related defendants.

Thus, the tally so far is one and one—in the case of Briseis's jurisdictional pleading, the upshot would affect her and her alone; but in the case of the performance defense, it would affect all defendants. Nonetheless, given that Daphnis and Chloe did not assert an affirmative defense, strictly speaking, but instead negated an element of Achilles's own case, it still remains to determine whether identical considerations would govern in that distinct context. Thus, the prime issue in this case has not yet been squarely addressed.

C. *Fair Use*

Epicurus is the next related defendant. The complaint alleges that he played the calliope during the performance of *The Sacroiliac*. Though that musical performance does not implicate *simpliciter* Achilles's literary copyright in *The Iliac*, the complaint alleges that Epicurus's participation was integral to the infringing performance at the Hippodrome Theater, and thus that he is vicariously liable.

Epicurus interposes a defense of fair use. He claims that his goal in life is to seek personal happiness and that the act of playing the calliope contributed to his own inner sense of well-being. Given that he did not derive any profit from his musical renditions on the night in question, he claims that any infringement for which he may be responsible falls clearly on the safe side of the fair use doctrine. See *Sony*, 464 U.S. at 442 (upholding noncommercial use as fair use).

Fair use is typically the most slippery defense in the entire law of copyright. See *Time Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 144 (S.D.N.Y. 1968) (stating that "doctrine is entirely equitable and is so flexible as virtually to defy definition"). For that reason, the court will return to an analysis of its implications after considering the balance of the defenses raised.

D. *Diplomatic Immunity*

The next defendant named in the complaint is Flavius, former Roman Ambassador to this country. The complaint alleges that, with full knowledge of the infringing performance to follow, Flavius smuggled the Mixo-Lybian music—allegedly scored in Calabria—into this country in his diplomatic pouch. Flavius contends that service of process on him is null and void, given the full and complete diplomatic immunity that our laws accord him. In this particular, Flavius is absolutely correct. He is therefore dismissed forthwith from this action. See *General Elec. Capital Corp. v. Grossman*, 991 F.2d 1376, 1381-82 (8th Cir. 1993) (holding that diplomatic immunity shields entity even when it has lost its diplomatic status prior to filing of suit).

Of course, such diplomatic immunity as Flavius enjoys exerts no impact whatsoever on the status of any other defendant in this case. For that reason, Flavius's defense is as personal to him as was Briseis's to her. But it is still premature to determine whether this resolution portends a momentum in favor of viewing affirmative defenses in copyright infringement litigation as personal to the defendant urging them.

E. Eleventh Amendment Immunity

The complaint alleges that Gaia participated in the infringement based on an elaborate conspiracy to infringe copyright. See 3 Nimmer & Nimmer, *supra*, § 12.04[A][3][c], at 12-96 (noting possibility that conspiracy to infringe may be cognizable claim). Without delving into the grand scheme out of which this alleged conspiracy is constructed, suffice it to say that Gaia has advanced a dispositive defense under the Eleventh Amendment.

Gaia is a federation loosely composed of sovereign entities. Under the Eleventh Amendment to the United States Constitution, federal courts lack power to adjudicate copyright cases against individual states. See *id.* § 12.01[E][2][b], at 12-40 to -41. For current purposes, the parties concede that Gaia stands in the shoes of those individual states.

Achilles laments that such a ruling immunizes the several states from any act of copyright infringement—state universities, plaintiff contends, could capitalize on such a ruling to run copy mills, to engage in unlicensed performances, to pirate software on a massive basis, etc. I find plaintiff's parade of horrors to be no exaggeration. See H. Stephen Harris, Jr. & Michael P. Kenny, *Eleventh Amendment Jurisprudence After Atascadero: The Coming Clash with Antitrust, Copyright, and Other Causes of Action Over Which the Federal Courts Have Exclusive Jurisdiction*, 37 *Emory L.J.* 645, 704-05 (1988) (arguing that Court's Eleventh Amendment jurisprudence poses "ominous" threat to public policy, in part because it will "allow states to violate the copyright laws with impunity"). In fact, Justices Stevens and Souter of the United States Supreme Court have already noted this danger. Unfortunately, they did so in their capacity as dissenters. See *Seminole Tribe of Fla. v. Florida*, 116 S. Ct. 1114, 1134 (1996) (Stevens, J., dissenting) (lamenting that majority opinion "prevents Congress from providing a federal forum for a broad range of actions against states, [including] those sounding in copyright and patent law"); *id.* at 1173 (Souter, J., dissenting) (criticizing majority for dis-

counting concern about "the opportunity of [the Nation's] citizens to enforce federal rights in a way that Congress provides").

Until such time as the full Supreme Court wakes up to the damage wrought by its recent jurisprudence in the sphere of the Eleventh Amendment, I have no choice but to follow its rulings. Accordingly, Gaia's Eleventh Amendment defense is granted, and it is dismissed from the case. See *Chavez v. Arte Publico Press*, 59 F.3d 539 (5th Cir. 1995).

Although the defenses of diplomatic immunity and Eleventh Amendment immunity stem from different doctrinal roots, their upshot is the same: In both instances, the subject defendant is released from liability. In the case of Gaia, no less than in that of Flavius, the defense is personal. Accordingly, this defense exerts no impact on other defendants.

A trend would thus seem to be building that vicarious defenses affect only the defendant who urges them, rather than others who may be named in the case. However, more examination is still in order before drawing any firm conclusion.

F. *Ineligible Nationability*

Defendant Hector shouts that Achilles has no standing to assert copyright ownership in *The Iliac*. Notwithstanding the presumption of validity conveyed by the copyright certificate listing Achilles as author, Hector maintains that Achilles undertook his composition activities within the scope of his employment duties.

In particular, Rhododactylos, Inc. (RDI), the loan-out corporation for Hector's father, Priam, allegedly hired Achilles. RDI is organized under the laws of Troy. Hector thus concludes that RDI constitutes the author of the work under the work-for-hire doctrine. See 17 U.S.C. § 201(b) (1994) (stating that employer is considered author when work made for hire); see also 1 Nimmer & Nimmer, *supra*, § 5.03[A], at 5-12 to -14.1 (explaining consequences of determination that work was made for hire). Inasmuch as the United States lacks any copyright relations with Troy, published works by its nationals are ineligible for United States copyright protection. See 9 Nimmer & Nimmer, *supra*, app. 20 (listing other independent nations and summarizing United States's copyright relations with each). Therefore, concludes Hector, Achilles lacks any United States copyright ownership and the entire case must be dismissed.

Hector has advanced a legally cognizable defense by pointing to the citizenship of RDI. Notwithstanding Senator Hatch's fervent hope, fictively uttered in Ithaca, that United States accession to the

Berne Convention would "provid[e] substantial copyright protection to authors and artists of *all* nations," Orrin G. Hatch, *Better Late Than Never: Implementation of the 1886 Berne Convention*, 22 *Cornell Int'l L.J.* 171, 180 (1989) (emphasis added), the millennium of universal copyright protection has not yet dawned. Instead, the complaint collapses into a Trojan Horse to the extent that RDI is vested with copyright ownership.

Achilles responds by citing the registration certificate appended to his complaint, which lists himself as author and his citizenship as American. Given the filing of that registration certificate within five years of first publication of the work, it constitutes *prima facie* evidence of the claims advanced therein. See 17 U.S.C. § 410(c) (1994) (stating that "the certificate of a registration made before or within five years after first publication of a work shall constitute *prima facie* evidence of the validity of the copyright" in "any judicial proceedings"). Achilles thereupon urges the court not even to entertain Hector's defense.

I reject Achilles's position. The *prima facie* presumption of the certificate simply orders the proof in the case; absent any showing by the defense, Achilles's eligibility for United States copyright protection would therefore be presumed. Nonetheless, in this case Hector specifically controverts the allegations of the certificate. Given that the certificate creates merely a *prima facie* presumption, rather than an irrebuttable presumption, Hector's proof is perfectly cognizable. See *Carol Barnhart Inc. v. Economy Cover Corp.*, 594 F. Supp. 364, 367 (E.D.N.Y. 1984) (holding that certificates of registration are *prima facie*, rebuttable evidence of copyrightability), *aff'd*, 773 F.2d 411, 414 (2d Cir. 1985); see also 3 *Nimmer & Nimmer*, *supra*, § 12.11[A], at 12-160 (stating that certificate creates *prima facie* presumption which court is free to reexamine and rebut). Accordingly, the burden now shifts back to Achilles to negate Hector's sworn statements, which appear on their face to be admissible and in good order. The court will hold an evidentiary hearing on the question of national eligibility.

To the extent that the court concludes that Hector is correct and that RDI is the constructive author of *The Iliac*, then the defense will be granted. Because, under that scenario, the entire action would be dismissed, Hector's defense—like Daphnis and Chloe's—would appear to be general rather than specific.

In the defenses confronted previously, the tally indicated that vicarious defenses inure to the benefit solely of the affected defendant, rather than generally. The exception was the defense urged by

Daphnis and Chloe—but, as discussed above, that defense was in fact not an affirmative defense.

In the case of Hector, the burden of proof lies on him, as is the case with a true affirmative defense. Nonetheless, it would appear that Hector's defense based on national origin is not, strictly speaking, an affirmative defense—notwithstanding that the burden of proving it lies on him. Instead, Hector, like Daphnis and Chloe, has attempted to negate one element of the plaintiff's prima facie case. Thus, we still have yet to confront a true affirmative defense that would affect any defendant other than the individual urging it. Perhaps such a defense is indeed as mythical as the unicorn.

G. Forfeiture

Defendant Iphigenia ceaselessly proclaims "sacrifice." As best the court can unravel her confused asseverations, the claim of sacrifice, translated to the facts of the instant dispute, appears to amount to a claim of forfeiture of copyright protection.

In particular, Iphigenia claims that first publication of *The Iliad* occurred approximately 2,600 years prior to the adoption of the Copyright Act of 1976. On that basis, Iphigenia maintains that the maximum term of copyright subsistence for the work has long since expired. See 17 U.S.C. § 304 (1994) (setting duration of copyright protection at seventy-five years for works published before 1978).

Plaintiff rejects that claim based on the Ninth Circuit's recent holding in *Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162 (9th Cir. 1996). In that case, a panel of the Ninth Circuit held that publication abroad without copyright notice does not begin the United States term running. Given that publication of *The Iliad* over the last three millennia has not been accompanied by the formality, "© 650 B.C.E. by Achilles," plaintiff maintains that the copyright term did not begin to run and therefore that this was a work protected by common law copyright, which will subsist until December 31, 2002. See 17 U.S.C. § 303 (1976) (stating that all hitherto common law copyrights have expiration date of December 31, 2002 effective January 1, 1978).

Iphigenia replies that such a construction is patently absurd. This court wholeheartedly agrees. See 1 *Nimmer & Nimmer*, supra, § 4.01[C][1], at 4-7 (stating that publication abroad under 1909 Act ended common law copyright and triggered statutory rights). Indeed, one of the great chestnuts in the annals of United States copyright history, dealing with copyright protection for *Uncle Tom's Cabin*, contains the following language: "By the publication of Mrs. Stowe's book, the creations of the genius and imagination of the author have

become as much public property as those of Homer or Cervantes. . . . All her conceptions and inventions may be used and abused by imitators, play-rights and poetasters." *Stowe v. Thomas*, 23 F. Cas. 201, 208 (C.C.E.D. Pa. 1853) (No. 13,514). Nonetheless, no matter how fervently this court accepts the rectitude of Iphigenia's protest, it is still bound under the Fogg-Lowry Peloponnesian/Hollywood Consolidation Act, 20 Cent. Fox 1955, to follow Ninth Circuit law even when that law is absurd. For that reason, Iphigenia's first claim of sacrifice is rejected.

Iphigenia's second basis for claiming sacrifice is through copyright forfeiture based on publication without the requisite copyright notice. Iphigenia has tendered to the court a version of *The Iliad* published in Athens, Georgia [sic!], in 1950 without any copyright notice. On that basis, Iphigenia claims that copyright for the work was forfeit. Nothing in *Twin Books* requires a contrary construction. On that basis, the work would seem to reside in the United States public domain. See 2 Nimmer & Nimmer, *supra*, § 7.13[B], at 7-119 to -120.

Achilles counters that the 1950 publication was unauthorized. He claims that it therefore failed to satisfy the prerequisites of "publication" under the Copyright Act. To the extent that his assertions are credited, he is correct. See *id.* § 7.03, at 7-23 to -26.4.

Thus, a question of fact remains for this court to resolve whether Achilles consented to the 1950 United States publication. To the extent that he did not, then Iphigenia's defense will be denied.

By contrast, to the extent that the evidence shows that the 1950 unnoticed publication occurred with the consent of Achilles, then Iphigenia's affirmative defense will prevail. Under that scenario, she would have proven that the copyrighted work has lapsed into the public domain. Moreover, given that Achilles is an American citizen, those works would not be eligible for copyright restoration under the Uruguay Round Agreements Act. See 17 U.S.C. § 104A (1994); see also 3 Nimmer & Nimmer, *supra*, § 9A.04, at 9A-25.

When contrasted with resolution of all the various defenses previously confronted, the upshot of Iphigenia's defense is revolutionary—to the extent that her affirmative defense is credited, the result is to defeat the cause of action entirely. In this particular, therefore, Iphigenia advances the mythical defense that had eluded all her predecessors: An affirmative defense that, if accepted, would inure to the benefit of all defendants in the action.

H. Substantial Similarity

The final related defendant is Jocasta. Maintaining that she has a special genius for sniffing out progeny, Jocasta maintains that *The Sacroiliac* is not in fact the child of *The Iliac*. Based on a sophisticated analysis and comparison of the two works, she maintains that substantial similarity is lacking.

Jocasta is on solid ground in urging lack of substantial similarity as a cognizable defense. Indeed, the mere fact that there is undeniably some similarity between *The Sacroiliac* and *The Iliac* does not itself vouchsafe that the threshold for infringement has been crossed. In one of the earliest cases in United States copyright jurisprudence, no less an authority than Justice Story noted that “[t]here are many imitations of Homer in the *Aeneid*; but no one would say that the one was a copy from the other.” *Emerson v. Davis*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436).

At this early stage in the proceedings, the court is not prepared to rule on either the admissibility of the critical analysis underlying Jocasta’s submission or upon the merits of the defense of substantial similarity. See 4 *Nimmer & Nimmer*, supra, § 13.03[E], at 13-27.

However, particularly in light of the disposition of Iphigenia’s defense, the court wishes to add a word about the effect should Jocasta’s defense be accepted: If, indeed, substantial similarity is lacking, then Jocasta would have negated an essential element of the plaintiff’s prima facie case. On that basis, she would have scored a decisive blow on behalf of all defendants, not merely herself.

* * *

Before reverting to the tangled brier of fair use, it is worth completing the tally. Briseis, Flavius, and Gaia asserted defenses that immunized themselves personally and no one else. Daphnis and Chloe, Hector, Iphigenia, and Jocasta each advanced defenses that, if accepted, would immunize all defendants in the case.

There is a fundamental difference between these two types of defenses. To illustrate, even if every defendant named in the complaint enjoyed the same personal jurisdiction defense that Briseis advanced, nonetheless the granting of her defense would be conditional, in the sense that it would not absolutely end the copyright infringement claim. For Achilles, even after suffering the dismissal of every defendant named in the complaint based on personal jurisdiction, could still amend to bring in new defendants Klytemnestra, Laertes, and Menelaus, who may not be able to advance the same defense based on lack of personal jurisdiction.

By contrast, the affirmative defense exemplified by Iphigenia is unambiguously universal. Once this court accepts the affirmative defense that copyright protection for plaintiff's work has been forfeited due to formal defects, nothing remains in the case to litigate. Even were Achilles to amend to bring in all manner of new defendants, it would avail him naught. For Iphigenia's defense proves fatal to the case as a whole.

V

FAIR USE REDUX

Fortified by resolution of the foregoing matters, we now revert to fair use, the most difficult issue in the case. Based on the defenses constructed above, it would appear undeniable that defenses to infringement ranging from absence of substantial similarity to forfeiture through lack of copyright notice are gauged based on the infringing action as a whole, not with reference to the particular defendant who urges them. It would be more than passing strange indeed to decouple fair use—the paradigmatic affirmative defense—from that methodology and to gauge it as if it were analogous to a claim of sovereign immunity or lack of jurisdiction over the person of the defendant.

Taking a step backwards to obtain an Olympian overview, in most cases not involving verbatim similarity, the primary defendant interposes two classic defenses: (1) lack of substantial similarity, thus negating an element of the plaintiff's *prima facie* case, and (2) fair use, thus affirmatively defeating even any *prima facie* case that is established. Courts typically consider those inquiries in tandem. If the plaintiff fails to prevail on either, then no copyright infringement existed. At that point, the lawsuit ends, and there is no need to investigate any further issues that the related defendants could interpose.

Does this framework work in practice as well as in theory? Analysis begins with a case in which, contrary to the construction urged above, the court treated the seemingly general affirmative defense of fair use as one of specific application.

A. Netcom

In *Religious Technology Center v. Netcom On-Line Communications Services Inc.*, 923 F. Supp. 1231 (N.D. Cal. 1995), Judge Whyte issued a panoramic opinion in a case of cutting-edge application. Plaintiff owned various "holy scriptures" belonging to the Church of Scientology. One defendant was Dennis Erlich, a former Scientology minister "turned vocal critic of the church" whose pulpit is now the

Usenet newsgroup alt.religion.scientology. *Id.* at 1238. But in addition to Erlich, plaintiffs also sued Thomas Klemesrud, operator of the BBS that serviced Erlich, as well as Netcom, one of the country's largest Internet service providers, which provided the facilities linking Klemesrud's BBS to the Internet. The court weighed at length Erlich's fair use defense, concluding ultimately that plaintiffs had demonstrated a likelihood of success on their claims that Erlich's behavior was not immunized under the doctrine of fair use. See *id.* at 1242-50.

Some months later, Judge Whyte issued another opinion in this cutting-edge case. See *Religious Tech. Ctr. v. Netcom On-Line Communications Servs. Inc.*, 907 F. Supp. 1361 (N.D. Cal. 1995). This later opinion (albeit codified in an earlier volume of the *Federal Supplement*) addresses the defenses of defendant Netcom. The court concluded first that Netcom was not directly liable for copyright infringement. See *id.* at 1367-73. Having exonerated Netcom on that basis, the court then turned to the question whether Netcom should be held as a related defendant to have committed contributory infringement or to be vicariously liable. See *id.* at 1373-81. In this context, the court considered Netcom's fair use defense. Its conclusion on this score is particularly pertinent:

The proper focus here is on whether Netcom's actions qualify as fair use, not on whether Erlich himself engaged in fair use; the court has already found that Erlich was not likely entitled to his own fair use defense, as his postings contained large portions of plaintiffs' published and unpublished works quoted verbatim with little added commentary.

Id. at 1378. In considering the various fair use factors and balancing them equitably, the court ultimately concluded that a question of fact remained whether a valid fair use defense existed on the facts presented to it. See *id.* at 1380.

B. *Fleeing the Gold*

With all due deference to Judge Whyte's pair of masterful opinions in *Netcom*, "even 'Homer sometimes sleeps.'" *Universal City Studios, Inc. v. Nintendo Co.*, 615 F. Supp. 838, 846 (S.D.N.Y. 1985) (quoting Lord Byron, *Don Juan* 184 (T.G. Steffan et al. eds., Yale Univ. Press 1988) (1821)). At the outset, it is worth noting that the excerpt just quoted does not cite any authority whatsoever for the proposition that the proper focus lies on Netcom's activities rather than on Erlich's. Instead, that conclusion emerges as an unadorned *ipse dixit*.

Once the court concluded that Erlich was likely to fail on his fair use defense, its focus on Netcom should have pretermitted any reconsideration of the fair use defense. Instead, the inquiry should have been limited to whether the elements of vicarious liability were likely established against Netcom. In other words, the questions should have been: Did Netcom have the ability to supervise and direct Erlich's activities, and did it have an obvious and direct financial interest in the exploitation of the Scientology scriptures? See 3 Nimmer & Nimmer, *supra*, § 12.04[A][1], at 12-67 (noting that supervisory capacity and direct financial interests are prerequisites to finding of vicarious liability). Perhaps many of the circumstances that the court cited in the fair use analysis would also have been relevant to an illumination of those factors. Nonetheless, with genuine respect, it appears that the actual focus in that decision was misdirected in this one particular.

A rich literature exists on whether bulletin board operators should be liable for the infringements of others. See, e.g., Niva Elkin-Koren, *Copyright Law and Social Dialogue on the Information Superhighway: The Case Against Copyright Liability of Bulletin Board Operators*, 13 *Cardozo Arts & Ent. L.J.* 345, 348 (1995) (“[I]mposing liability on BBS operators hinders rather than promotes the potential of digital technology as a genuinely democratic medium.”); David Nimmer, *Brains and Other Paraphernalia of the Digital Age*, 10 *Harv. J.L. & Tech.* 1, 33-37 (1996) (counseling restraint in adopting new rules in light of uncertain nature of future technological progress); R. Carter Kirkwood, *Comment, When Should Computer Owners Be Liable for Copyright Infringement by Users?*, 64 *U. Chi. L. Rev.* 709, 727 (1997) (arguing that bulletin board operators should be subject to vicarious and contributory infringement rather than direct infringement). It would be *ultra vires* to rehearse that debate here.

What is relevant, instead, are the terms of the discussion. To the extent that financial interest is lacking, as noted above, vicarious liability is avoided. Thus, *Netcom's* discussion of the fourth fair use factor—effect of Erlich's conduct on the plaintiffs' potential market—translated back to the appropriate domain, could indeed illuminate the propriety of holding defendant Netcom vicariously liable.

By the same token, an element of contributory infringement is that the related defendant must “materially contribute[] to the infringing conduct of another.” *Gershwin Publ'g Corp. v. Columbia Artists Management, Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971) (footnote omitted). Again, the court's discussion of the third fair use factor—substantiality of Erlich's appropriation—likewise translated back

to the appropriate domain, could conceivably similarly illuminate the propriety of holding Netcom a contributory infringer.

In sum, the important conclusions that the *Netcom* court drew may all remain pertinent to the appropriate disposition of the case. But it is essential to channel each into its appropriate legal category, rather than conflating its significance.

C. *Postulating a "Rule"*

If indeed my learned colleague was in error in the modality of determining the fair use vicarious defense in *Netcom*, then the question remains as to what overarching structure should pertain. Abstracting from the defenses confronted above, the principle emerges that to the extent a defense "relates to" the circumstances of the infringement, it is general; by contrast, to the extent that it "relates to" the circumstances of the defendant, it is specific. That rough-and-ready "rule" accounts for the disposition of all the defenses urged by each related defendant from Briseis to Jocasta.

1. *Authority and "Proof"*

Ideally, this court would like to cite the statute itself for the rectitude of that approach, instead of abstracting it from the various defenses confronted above. But the statute itself contains literally only one word creating liability for related defendants, and that solitary word cannot illuminate the present inquiry. See 17 U.S.C. § 106 (1994) ("[T]he owner of copyright under this title has the exclusive rights to do and to *authorize* any [specified activity]" (emphasis added)).

As a fall-back position, resort could be had to the intent of Congress on this score as contained in the legislative history. See generally Jessica D. Litman, *Copyright, Compromise, and Legislative History*, 72 *Cornell L. Rev.* 857 (1987) (examining "unusual" legislative history of 1976 Copyright Act). But the court's review of the House and Senate Reports for the current Copyright Act reveals no intent, nor even any awareness, of how to calibrate the affirmative defenses of related defendants.

Accordingly, the court has proceeded on the basis of pure reason, "triangulating" application of the fair use affirmative defense from more secure points of reference on which there can be no reasonable dispute. That exercise has revealed that fair use is a general defense to be gauged against the circumstances of the primary infringer rather than the particular defendant who urges it.

The “proof” that this court’s approach, rather than that followed in *Netcom*, is correct comes from the granddaddy case implicating related defendants for copyright infringement. In the very case that Epicurus cites, *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984), the Supreme Court gauged the fair use of the contested Betamax recorder against the circumstances of the primary infringers, not the related defendant who happened to be present in court. To be even more explicit, notwithstanding that the plaintiff motion picture studios in that case filed suit against Sony Corporation as contributory infringer rather than against the entire American public for being primary infringers, both majority and dissenters gauged the four fair use factors vis-à-vis the public’s conduct, not Sony’s.

Thus, all nine Justices followed the procedure outlined here, rather than the novel one employed by *Netcom*. Although no case until *Netcom* explicitly considered a claim that the fair use defense should be judged against the circumstances of the related defendant rather than the primary infringer, a unanimous United States Supreme Court constitutes adequate authority for these purposes. Moreover, such sparse references as the literature contains support this method of proceeding. See Elkin-Koren, *supra*, at 367-68 (urging use of *Sony* framework before *Netcom* case handed down).

2. *Analysis at Bar*

As translated to the instant facts, therefore, Epicurus should be allowed to raise a fair use defense—*relating solely to Zeno’s conduct*. This court therefore should weigh each of the statutory fair use factors as to Zeno’s subject performance of *The Sacroiliac* at the Hippodrome Theater. To the extent that the fair use defense prevails, then Epicurus will have scored a victory for all of his confreres. Conversely, to the extent that Zeno’s fair use defense fails, then there remains nothing in this particular affirmative defense for Epicurus to plead personally.

Of course, Epicurus may negate his own vicarious liability by proving that essential elements did not attend his calliope performance. To the extent that, as seems likely, he lacked a direct or even indirect financial interest in Zeno’s purported infringement, then he will have succeeded in exonerating himself from vicarious liability. See 3 Nimmer & Nimmer, *supra*, § 12.04[A][1], at 12-67 (“[D]efendant must have ‘an obvious and direct financial interest in the exploitation of copyrighted materials.’” (quoting *Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304, 307 (2d Cir. 1963))). But that victory would be personal and wholly unrelated to the fair use defense that he initially wished to plead.

3. *Shadow Dancing in Plato's Cave*

A separate way to appreciate how to apply affirmative defenses emerges out of the thought experiment of transposing the affirmative defense from the related defendant to the primary defendant. Thus, imagine that instead of Briseis alleging lack of personal jurisdiction, Zeno himself had done so. Even if that defense were accepted, the absence of Zeno as a defendant over whom the court enjoys jurisdiction, as was previously noted, would not exert any impact on the other defendants in the action. By parallel reasoning, if Zeno, instead of Flavius, enjoyed diplomatic immunity, the balance of the defendants would likewise be unaffected. See 3 *Nimmer & Nimmer*, supra, § 12.04[A][3][a], at 12-85 (stating related defendant may be found liable even when direct infringer not subject to service of process).

On the other side of the ledger, if Zeno instead of Jocasta were to demonstrate lack of substantial similarity, the case would end against all defendants. Likewise, if Zeno were to prevail on Iphigenia's defense of lack of valid copyright notice upon publication, then the case would similarly cease against all defendants.

Turning to the key question of fair use, it would seem beyond peradventure that to the extent Zeno prevailed on that affirmative defense, the case would end against all defendants. For the defense would vouchsafe the permissibility of Zeno's conduct and would negate the existence of any infringement. Absent primary infringement, the question of liability of related defendants does not even arise. See *id.* at 12-85 to -88 (arguing that third party liability should exist only when direct liability is present).

In light of the above considerations, it would seem that there is no basis to evaluate fair use with respect to the particular facts of Epicurus's conduct. Just as Zeno's hypothetical failure to prevail on the grounds of absence of substantial similarity would doom Jocasta's substantial similarity defense, so Zeno's failure on the fair use affirmative defense leaves nothing left over for Epicurus to urge. This formulation provides yet another avenue to discredit *Netcom's* allowance of *Netcom* to assert a fair use defense even after *Erlich's* assertion of the same defense had previously failed.

VI

ADDITIONAL DEFENDANTS

Achilles has made a motion to add new defendants into the complaint: Klytemnestra, Laertes, Menelaus, Nestor, Oedipus, and Paris. Those defendants have resisted Achilles's motion to amend on the basis that they enjoy dispositive affirmative defenses. Specifically, those

defendants justify their conduct under the doctrines of the statute of limitations, laches, estoppel, and abandonment/waiver.

I find it unnecessary to rule on the motion to amend at this juncture. As previously noted, some of the defenses offered by the existing parties may prove dispositive of the entire case. Thus, to the extent that the subject performance at the Hippodrome Theater is ruled to have been private rather than public, then not only will Chloe and Daphnis have prevailed on their particular defense, but the case as a whole will end. Under that scenario, it would be unnecessary to rule any further as to Oedipus or Paris, for example. Accordingly, the court reserves judgment on the motion to amend.

CONCLUSION

Confusion is hereby dispelled concerning which related defendants can assert what vicarious defenses: When the defense relates to the action as a whole, it should result in dismissal of the entire action; by contrast, when it relates solely to the circumstances of an individual defendant, only that particular individual can benefit by the defense prevailing. All persons in receipt of this exposition are hereby admonished not to conflate these categories ever again.

It is so ordered.

AT THE INFERNAL COURT OF APPEALS
IN THE STYX

ACHILLES,)
)
Plaintiff,)
)
v.)
)
ZENO et al.,)
)
Defendants.)
<hr/>	

Before HADES and NYX, Circuit Judges, and CERBERUS, District Judge (sitting by designation).

PER CURIAM:

The parties have filed cross-appeals from the trial court’s disposition of various affirmative defenses. Because the opinion below simply categorized various defenses without reaching a final disposition as to any of the parties, we consider it to be a nonappealable order. Indeed, it is almost akin to an advisory opinion. Cf. Lotus Dev. Corp. v. Borland Int’l, Inc., 788 F. Supp. 78, 799 F. Supp. 203 (D. Mass. 1992) (setting forth lengthy opinions detailing what proper scope of jury instructions might be were case presented to jury, notwithstanding that case was later tried before bench), rev’d, 49 F.3d 807 (1st Cir. 1995), aff’d by an equally divided court, 116 S. Ct. 804 (1996). For that reason, we remand proceedings to the district court for trial and entry of a final judgment from which appeal may be duly taken.

Remanded.

CERBERUS, District Judge, concurring in part:

Though my colleagues have been hell-bent to dispose of this case as quickly as possible, I believe that it presents puzzles worthy of greater attention. Whilst my learned brethren accuse me of undue doggedness in ferreting out the issues that this fascinating case presents, I believe that judicial economy is served by outlining the relevant parameters at this juncture, before the parties and court below expend further efforts in developing a record under a potentially flawed standard. Too, I find the approach taken below overly dogmatic. Nonetheless, I agree in large part with the framework articulated by the district court.

The particular defendants against whom Achilles filed suit represent the easy class. To a person, each raises an affirmative defense that is straightforward and unambiguous. Indeed, one gets the sense that Achilles's entire case was constructed through the machinations of the gods on high for their own amusement, only to confound us poor mortals just as we thought we had grasped the subtleties of the issues implicated.

The sole exception to that ease of categorization is the fair use affirmative defense raised by Epicurus. The district court resolved that issue in a logical and coherent fashion. Nonetheless, with all due deference, Judge Teiresias was blind to the nuances latent in some of the more esoteric copyright defenses.

Subtle defenses happen to arise precisely as to those defendants who have not yet been brought into this action. Those defenses severely test the easy distinctions offered by the opinion below. Although I believe that that framework ultimately passes the test, the strain of the exercise should not be underestimated.

I am aware of no court or commentator who would dispute that personal jurisdiction, diplomatic immunity, and sovereign immunity under the Eleventh Amendment are all specific defenses. Thus, it is only logical to conclude that Briseis, Flavius, and Gaia are fighting battles solely on behalf of their own respective interests. I am equally unaware of any authority for the proposition that a case could continue to trial even after the infringement at issue has been demonstrated to be based on faulty copyright ownership or absence of infringement. For that reason as well, Chloe and Daphnis, Hector, Iphigenia, and Jocasta are defending themselves by attempting to slay Achilles's entire case, with the result that he would no longer be able to proceed against anyone. Those matters appear to me uncontroversial, and for that reason I concur completely with Judge Teiresias in those particulars.

Nonetheless, among all of those defenses, the only instance of a general affirmative defense was Iphigenia's claim of copyright forfeiture due to improper copyright notice. I feel queasy about plotting not only a line, but a whole plane, from that single fixed point.

Apart from the defenses confronted in the court below, a host of defenses remain that do not fall as unambiguously onto one side or the other. Those are the defenses raised by the parties that Achilles currently wishes to implead into the case. To obtain a more rounded understanding of how vicarious defenses work in the copyright arena, it is worth pondering each of those additional defenses.

The court below articulated the rule that a general defense "relates to" the circumstances of the infringement, whereas a specific de-

fense “relates to” the circumstances of the defendant who pleads it. Although that formulation may adequately account for named defendants Briseis to Jocasta, it is not always so clearly applied. For the posited rule is itself subject to permeable interpretation. It is no coincidence that fair use is precisely the arena in which divergent results have emerged. For fair use is geared at negating the circumstances of infringement and to that extent is general; yet simultaneously, fair use concerns itself with the conduct of the particular defendant and is to that extent specific. See 4 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright*, § 13.05[A][1][d], at 13-165 to -168 (1997) (discussing impact of character of defendant’s conduct in fair use adjudication). Thus, more discernment is in order before casting these distinctions in concrete.

* * *

To test the applicability of this proposed rule, it is helpful to confront some other defenses that may likewise cross the line from general to specific: Statute of limitations and its close cousin, laches.

I

STATUTE OF LIMITATIONS

Achilles has indicated a desire to amend the complaint to bring in additional defendants Nestor and Oedipus. Both oppose being included in this action on the basis of a statute of limitations defense. In particular, Oedipus claims that he has been nursing a swollen foot (and other more painful disfigurements) for the last three years and thus has not facilitated any infringing conduct during that time. Nestor claims that he is so old that he cannot remember anything that has happened in the last twenty years, so that Zeno’s performance must have taken place earlier.

The factual circumstances underlying the allegations against Nestor and Oedipus are crucial to resolution of the issues posed here. Oedipus concedes that Zeno’s performance of *The Sacroiliac* at the Hippodrome Theater occurred well within the three-year period of the statute of limitations. See 17 U.S.C. § 507(b) (1994) (limiting maintenance of civil action to within three years after claim accrued). On that basis, this cause of action as a whole may proceed. The allegations against Oedipus are that five years ago, as a noted patron of the arts, he actively financed, encouraged, and induced Zeno to develop the infringing performance, then contemplated for an upcoming “Honor Among Thebes” celebration. In the event, Oedipus suffered some unfortunate reversals, the celebration never occurred, and as

previously noted, Oedipus has been living in seclusion for the past three years during the statute of limitations period.

The question thus arises how to evaluate Oedipus's defense. It is useful to contrast his situation with Nestor's defense—that Zeno's performance itself took place over twenty years ago, long before the bar of the three-year statute. As a factual matter, Nestor thus controverts the allegations of the complaint, which co-defendant Oedipus by contrast concedes. Nonetheless, pending development of a factual record below, it is impossible to determine who is correct.

Nestor's statute of limitations defense, if accepted, renders the infringement as a whole nonactionable. Logic dictates that Nestor could not have acted during the past three years to aid, support, encourage, or finance an infringement which itself had concluded many years earlier. On that basis, Nestor's statute of limitations defense, if accepted, inures to the benefit of all and thus qualifies as a general defense within the framework articulated above.

But Oedipus's defense is wholly different, even though it may nominally bear the same label. For his statute of limitations defense is specific to his own conduct. A recent case, *Makedwde Publishing Co. v. Johnson*, 37 F.3d 180 (5th Cir. 1994), confronted facts that illuminate the instant circumstances. In that case, the district court held the primary defendant liable under the continuing-tort theory of *Taylor v. Meirick*, 712 F.2d 1112, 1119 (7th Cir. 1983) (allowing plaintiffs to "reach back" and get damages for entire duration of alleged violation even where some wrongful acts occurred outside statute of limitations period), for activities that he personally undertook over three years prior to the filing of suit because he had failed "to take reasonable steps to prevent others with whom he had previously collaborated from continuing to infringe." *Makedwde Publ'g*, 37 F.3d at 182 (citing *Taylor*, 712 F.2d at 1119). The Fifth Circuit reversed on this issue of first impression. See *id.* at 181. It applied the statute of limitations literally to bar any action against a defendant whose own conduct predated the three-year cutoff of the statute. See *id.* at 182 ("Jones is only liable for *his* acts of infringement committed within three years prior to Plaintiffs' lawsuit.").

The foregoing authority indicates that *primary* defendants are to be held liable only to the extent that their own personal conduct falls within the three years of the statute of limitations. On the issue of first impression as to how *related* defendants are to be treated under parallel circumstances, we should adopt the same rationale: Such defendants are to be held liable only to the extent that their own conduct falls within the three years of the statute of limitations. Assuming that Oedipus's claim that his conduct long predated that bar is found accu-

rate, then the motion to amend the complaint to add him as a defendant should be denied.

Thus, the inquiry into the statute of limitations defense has produced anomalous results. Defendants such as Nestor who assert it with respect to the underlying infringement and all acts of the primary defendant have asserted a general affirmative defense, which inures to the benefit of the entire class of defendants. By contrast, defendants such as Oedipus who isolate the defense to their own particular conduct have urged a specific defense, which benefits no one else. In this way, the statute of limitations defense actually straddles the boundary between general and specific.

II LACHES

Achilles also wishes to amend the complaint to bring in Paris as a co-defendant. Paris disclaims any responsibility for the entire mess, maintaining that others are solely to blame.

In particular, Paris maintains that he and Achilles jointly attended the "Honor Among Thebes" preparations, and Achilles agreed at that time that Paris would become proprietor of *The Iliac*. Paris further maintains that he has been holding himself out as the rightful owner of *The Iliac* since that date.

A series of recent cases has sustained a defense of laches when an inordinate delay of time has occurred, during which period the defendant reasonably believed himself to be the author of a contested work "and conducted business accordingly." *Jackson v. Axton*, 814 F. Supp. 42, 44 (C.D. Cal. 1993), *aff'd* and remanded, 25 F.3d 884 (9th Cir. 1994). On the basis of that line of cases, Paris's laches defense would appear to be valid.

As always, the question remains whether that determination is specific or general. Because the laches defense hinges on the conduct of Paris himself, it would appear to be a paradigmatic case of a specific defense. Accordingly, Paris's victory does not undermine Achilles's case against any of the remaining defendants.

But as with the statute of limitations defense considered above, the question must also be asked from the opposite perspective—what if Paris contended that Zeno has enjoyed a laches defense ever since Achilles's conduct at the "Honor Among Thebes" festival many years ago? Does such a defense aid Zeno alone, or others as well?

Given that laches inherently inquires as to the conduct of the defendant, it appears to be a specific defense, rather than a general one bound up in the infringement itself. Accordingly, we are left with an

interesting juxtaposition: If Zeno prevailed based on the statute of limitations, the case would end against all related defendants; but Zeno's victory on the closely allied issue of laches leaves other defendants unaffected. By this stage, the pristine lines constructed by the district court below are beginning to blur.

III RES JUDICATA

Those lines blur even further when we consider defenses of claim preclusion or issue preclusion. This additional facet also provides another prism through which to view our main inquiry.

As noted by the court below, to the extent that Jocasta prevailed on a defense of substantial similarity, the case would end against all defendants. Let us now entertain the converse possibility: Jocasta alleges absence of substantial similarity but loses on that defense. Once Achilles has prevailed as to his *prima facie* case, what impact does that victory import vis-à-vis other defendants?

Were Achilles to proceed to trial against Klytemnestra, his initial victory on the question of substantial similarity against Jocasta would not prove decisive in that context. In other words, Klytemnestra would remain at liberty to relitigate substantial similarity. The question therefore arises whether that circumstance causes the entire fabric patched together below to unravel.

The answer is that it does not. The reason that Klytemnestra could contest substantial similarity is that issue preclusion binds only those against whom issues have been determined; it does not provide litigants a sword with which to stab new parties who were not privy to the underlying dispute. On that basis, Klytemnestra remains at liberty to litigate the question of substantial similarity anew.

Nonetheless, the crucial realization here is that the substantial-similarity defense that Klytemnestra would urge relates solely to Zeno's conduct. In other words, Klytemnestra would not be focusing on her particular circumstances to construct an argument. Instead, she would be asking the court to reconsider its initial determination that Zeno's performance was substantially similar to Achilles's copyrighted work—just as Jocasta tried (but failed) to convince the court about the absence of Zeno's similarity.

The foregoing hypothetical imagines the loss of a defense, rather than a win by a primary or related defendant. This circumstance opens an entirely new window on the district court's analysis, which was framed entirely at examining victorious defenses.

As noted by the court below, to the extent that Zeno prevails on a defense of fair use, *Sony* mandates that the case as a whole end. From that circumstance, the district court concluded the converse—that to the extent Zeno's fair use defense did not prevail but failed instead, nothing would remain in the fair use arena for Epicurus to litigate. The majority opinion in *Sony* itself does not mandate that result. In other words, there is room, even within the *Sony* framework, for Judge Whyte to rule as he did in *Netcom*.

If logic permits that result, then the only remaining question is whether one can construct any good reason for it. I cannot. Indeed, the only argument that I can make in support of the proposition that a related defendant can relitigate the fair use defense after the primary defendant failed is the circumstance, to which I alluded above, that part of the fair use inquiry evaluates the defendant's conduct. See 4 *Nimmer & Nimmer*, supra, § 13.05[A][1][d], at 13-165 to -168 (stating that propriety of defendant's conduct is relevant to whether use is fair or not). Thus, one could imagine the rejection of a primary defendant's fair use defense on the grounds that she purloined the manuscript in issue and, therefore, comes to court as a bad actor. Cf. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 563 (1985) (denying *The Nation's* fair use defense against copyright infringement claim that stemmed from its publication of excerpts from manuscript it knew had been stolen). One can further imagine a related defendant in the same action whose personal conduct is unblemished. In that circumstance, can we not imagine that the primary defendant's loss of fair use does not necessarily presage the similar disposition of the related defendant's defense?

As I say, that is the best argument that I can construct; nonetheless, it strikes even me as unconvincing. The fair use inquiry is composed out of four nonexclusive factors; the inquiry just noted into the defendant's conduct simply occupies one subsidiary portion of the first nonexclusive factor. As such, it constitutes a fractional amount of the fair use inquiry. It strikes me as both bad doctrine and bad policy to exalt that subcomponent into the essence of the fair use inquiry. All of the remaining factors, as well as the remaining subcomponents of the first nonexclusive factor, inquire into the primary defendant's usage as a whole to determine whether it is "fair," rather than into any particular circumstance of the defendant urging the fair use defense. On that basis, I am fortified in the two major conclusions of this concurrence: (1) Fair use is a general defense that "relates to" the infringement as a whole rather than to the circumstance of a particular defendant; and (2) the boundaries drawn here are far less than hermetic.

IV OTHER DEFENSES

Although many affirmative defenses have already been confronted, others remain. Related to laches, for instance, is the defense of estoppel. Estoppel is a defense integrally bound up with the particular facts of the defendant's infringing conduct. See, e.g., *Chi-Boy Music v. Charlie Club Inc.*, 930 F.2d 1224, 1228 (7th Cir. 1991) ("For estoppel to apply in a copyright action, the copyright owner must be aware of the infringing conduct and yet act in a way that induces the infringer to rely upon such action to his detriment."); see also 4 *Nimmer & Nimmer*, supra, § 13.07, at 13-275 ("[T]he party to be estopped must know the facts of the defendant's infringing conduct.").

A related defendant who claims that she changed her particular conduct in reliance on the plaintiff's representations presents the easy case—her defense, if successful, is entirely specific and thus benefits no other co-defendant. But what of a related defendant who claims that the primary infringer changed his position in such reliance? It would seem that that defense is also specific; thus, as applied to the instant case, it might immunize Zeno no less than were he to advance a successful personal jurisdiction or diplomatic immunity claim, without affecting the cause of action as a whole.

* * *

Because I cannot improve on Judge Teiresias's formulation, I approve of his proposed method of handling the fair use affirmative defense of a related defendant. Further, I accept the test that a general defense "relates to" the circumstances of the infringement, whereas a specific defense "relates to" the circumstances of the defendant who pleads it. Finally, I agree that that test produces the unambiguously correct results for each defendant from Briseis to Jocasta.

I add these remarks concerning the statute of limitations and laches so as to underline that the foregoing distinctions are more slippery than the decision below allows. If future cases determine, based on the precise circumstances presented, to evaluate laches or estoppel of the primary infringer as a general defense rather than as the specific defense that they seem to me to be, I would not be shocked. By the same token, I can understand why Judge Whyte in *Netcom* analyzed fair use as a specific defense. Nonetheless, for the reasons set forth in the opinion below, as amplified by the observations in this concurrence, I disagree with the *Netcom* approach and would therefore treat the fair use defense of an affirmative defendant as relating solely to the underlying infringement.

NYX, Circuit Judge, specially concurring:

Good night!

Judge Teiresias was not blind to the vital issues underlying this case; Judge Cerberus, however, has simply been chasing his tail in belaboring various hypotheticals.

By now, it should be clear that a defense that "relates to" the particular defendant urging it is specific and benefits no one else; by contrast, a defense that "relates to" the infringement as a whole is general and thus affects the entire cause of action. As the estimable Cerberus has delineated, that formulation sometimes produces unanticipated results: To wit, making the statute of limitations sometimes general and sometimes specific and decoupling a general statute of limitations defense from a laches defense. But that frustration of our uncritical expectations hardly furnishes a reason to discard this formulation. Instead, it provides a reason to celebrate the critical human facilities that lead to such discernment.

The linchpin of Judge Teiresias's analysis was to demonstrate the flaw in *Netcom*'s treatment of the fair-use defense of a related defendant. In this regard, he hit the nail exactly on the head.

What is noteworthy about *Netcom* is that it determined that the fair use factors should be calibrated against *Netcom*'s, rather than Erlich's, behavior without citing any authority whatsoever for that method of proceeding. The lack of precedent for *Netcom* is worth highlighting because that case itself now exists as authority for other courts to cite. Indeed, that process has already begun. See *Sega Enters. Ltd. v. MAPHIA*, 948 F. Supp. 923, 934 (N.D. Cal. 1996) (citing *Netcom* for proposition that Internet provider may urge independent fair use defense). Before other courts are similarly led astray, I believe we should nip in the bud that inappropriate method of analysis. (Although we are doing so pursuant to the fiction of a judicial opinion embedded into a law review article, cf. Lon Fuller, *The Case of the Speluncean Explorers*, 62 *Harv. L. Rev.* 616 (1949) (setting out several fictitious opinions for invented murder case), the efficacy of that device should not be underestimated, see William Eskridge, Jr., *The Case of the Speluncean Explorers: Twentieth-Century Statutory Interpretation in a Nutshell*, 61 *Geo. Wash. L. Rev.* 1731, 1743 (1993) ("Fuller's fictional exercise must be counted as one of the important jurisprudential documents in this century."))

As opposed to calibrating fair use with respect to the related defendant's conduct, all nine Justices of the United States Supreme Court, in *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984), proceeded contrariwise. Instead, they applied the

four fair use factors vis-à-vis the conduct of the primary infringer. Accordingly, the *Netcom* approach cannot stand.

By emphasizing that the *Netcom* result is not, strictly speaking, inconsistent with the *Sony* majority, Judge Cerberus is barking up the wrong tree. Given that he wishes to examine the supposition that fair use is lacking as to the primary defendant, he should have turned his attention to the *Sony* dissent, given that the four dissenters viewed fair use as absent under the facts there presented. What is most noteworthy for current purposes is that their analysis hinged entirely on the use of home users as failing to constitute a "productive use" and otherwise being unfair. See *id.* at 475-86 (Blackmun, J., dissenting). Justice Blackmun's dissent contains not a hint that, as imagined by Judge Cerberus, the denial of a primary defendant's fair use defense leaves room for the related defendant to continue to interpose any residual fair use argument. Indeed, Sony Corporation itself argued the existence of fair use solely with reference to the conduct of home tapers, not by virtue of its own conduct. See *id.* at 480. These considerations should suffice to dispel the notion that any Justice of the United States Supreme Court would adopt my learned colleague's tortured notion that the unsuccessful fair use defense of a primary defendant leaves anything left in that realm live for further argumentation.

* * *

Fair use is a vital defense, indeed integral to the proper functioning of the copyright laws. See *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1542 n.22 (11th Cir. 1996) (Birch, J.) ("Although the traditional approach is to view 'fair use' as an affirmative defense, this writer, speaking only for himself, is of the opinion that it is better viewed as a right granted by the Copyright Act of 1976."). It is therefore a task of the utmost importance to define how that defense is to be treated when urged by related defendants. For all the reasons set forth herein, that defense should be calibrated solely against the circumstances of the primary infringer, not, as in *Netcom* and *Sega Enterprises*, with regard to the circumstances of the related defendant.

The conclusion below was so fine as to deserve repetition:

Confusion is hereby dispelled concerning which related defendants can assert what vicarious defenses: When the defense relates to the action as a whole, it should result in dismissal of the entire action; by contrast, when it relates solely to the circumstances of an individual defendant, only that particular individual can benefit by the defense prevailing. All persons in receipt of this exposition are hereby admonished not to conflate these categories ever again.

See *Achilles v. Zeno*, 1 F. Sapp. 2555, 2575 (O.D. Plps. 533 B.C.E.).

* * *

Perhaps future archaeologists will one day unearth the Supreme Court opinion blasting away the foregoing framework. I, for one, hope not. The distinctions that emerge from this trio of opinions strike me as useful lanterns to illuminate future developments in the amphitheater of vicarious defenses.