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Searching for Answers in a Digital World: How *Field v. Google* Could Affect Fair Use Analysis in the Internet Age

*David Cook**

I. INTRODUCTION

It is hard to believe that just fifteen or twenty years ago, most people did not even own a computer, much less use the Internet on a daily basis. Today, the Internet touches every facet of life. With the rise of the vast wealth of information available on the Internet, there is a need for an efficient way to find and use that information. Companies such as Google, Yahoo, Microsoft, and others have rushed to fill that need through their popular search engines. As these new areas of technology develop, legal and policy issues also emerge – especially in the area of intellectual property law. On the one side, it is clear that society increasingly demands more efficient and effective ways to harness the power of the Internet. On the other side many artists, writers, and inventors argue that this new technology is trampling upon their intellectual property rights.

This case note will focus on the potential impact that a new federal district court case, *Field v. Google*,[1] is likely to have in this emerging area of Internet intellectual property law. This note argues that the court correctly decided the issue and that its analysis of implied licenses and the "transformative" nature of search engines will likely open the way for the growth of not only search engines, but also major initiatives such as the Google Library Project.

II. FACTUAL BACKGROUND

Field v. Google involved an attorney/poet who claimed that Google's "cached" copies of his poetry website constituted copyright infringement of his exclusive property rights in the poetry.[2,3] In an effort to manufacture a claim against Google, Field created a website of his poetry which was free and open to the public, then deliberately set the technical parameters for his site to *allow* Google's search engine to index and make a "cached" copy of

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* J.D. Candidate, Southern Methodist University Dedman School of Law, 2008; B.A. in Political Science, Baylor University, 2005. I would like to thank my wife, Nicole Cook, who has always supported me throughout my law school career and helped a great deal in editing this case note. Likewise, I would like to thank the entire SMU Science and Technology Law Review staff for their help and support.

1. Field v. Google, 412 F. Supp. 2d 1106 (D. Nev. 2006).

2. *Id.* at 1110.

3. A "cached" copy of a website is essentially a digital snapshot of that website at a particular moment in time. *See* Google Webmaster Help Center—Remove cached pages, http://www.google.com/remove.html.

his site.[4],[5] After Google users visited the cached copies of his website, Field claimed that by making a cached copy of his site and giving the public access to that copy, Google infringed on his exclusive rights to reproduce and distribute copies of his poetry.[6] After an extensive discussion of the values of search engines to society, the court concluded that Google's cached copies of Field's website did not infringe on Field's copyrights, and held that: 1) Google held an implied license to use the material; 2) Field was estopped from asserting his claim; 3) Google's use fell under the "Fair Use" exception to 17 U.S.C. § 107; and 4) Google's use fell under the safe harbor provision of the Digital Millennium Copyright Act.[7]

III. THE COURT'S REASONING

In finding that Google had not directly infringed on Field's copyrights, the court emphasized the passive nature of Google's actions.[8] It highlighted that it was users, rather than Google itself, who requested and viewed the material from Field's webpage.[9] The court emphasized that Google simply provided an automated service to users.[10] Citing *Religious Technology Center v. Netcom On-Line Communications Services, Inc.*,[11] the court held that "automated, non-volitional conduct . . . in response to a user's request" does not constitute direct infringement of an individual's copyright.[12] Key to the court's holding on this matter was the fact that, without the actions of individual users requesting certain webpages, the alleged infringement would never have occurred.[13] Thus, Google's passive, automatic retrieval of information *only* upon users' requests did not infringe on Field's copyrights since

4. *Field*, 412 F. Supp. 2d at 1114.

5. A robots.txt file is a file commonly used in the webpage industry to give search engines instructions on whether they may index a site. By using neither a robots.txt file nor an alterative method to alert search engines not to index his site, Field wanted Google to index his site so that he would have a cause of action for a lawsuit. *See* Google Webmaster Help Center—Remove your entire website, http://www.google.com/remove.html.

6. *Field*, 412 F. Supp. 2d at 1110.

7. *Id.* at 1109.

8. *Id.* at 1115.

9. *Id.*

10. *Id.*

11. Religious Tech. Ctr. v. Netcom On-Line Commc'n Svcs., Inc., 907 F. Supp. 1361, 1369-70 (N.D. Cal. 1995) (holding that infringement requires a volitional act on the defendant's part, and not merely automated copying made at the direction of others).

12. *Field*, 412 F. Supp. 2d at 1115.

13. *Id.*

such automated actions could not be considered a "volitional" act on Google's part.

Another important result of the court's analysis was the implied license it found Field gave to Google. The court reasoned that since Field knew of the technical methods of alerting search engines not to index his site and did not utilize those methods, he had given Google an implied license for their use.[14] As the court noted, Field was not simply a confused website owner who had accidentally allowed search engines to index and cache his copyrighted works; he actually knew about the technical solutions available to instruct search engines not to index or cache his site, and yet, did nothing to prevent them from doing so.[15] In this way, Field *knew* that Google and other search engines would index and cache his site and his silent acquiescence reasonably led to the conclusion that Field gave them an implied license to use his work for their search engine activities.[16] The court also noted the ease with which website owners could instruct search engines not to use their site and highlighted the fact that such technical instructions were the industry standard.[17]

In accordance with its finding of an implied license, the court held that Field was estopped from pursuing his claim against Google.[18] The court noted that: 1) Field knew of Google's use of his site; 2) he intended Google to use his site and rely on his silent acquiescence to its indexing and caching; 3) Google did not know Field was trying to lure it into a trap; and 4) Google relied to its detriment on Field's actions by indexing and caching his copyrighted works.[19] Thus, Field's bad faith was a key factor in finding that he was estopped from asserting his copyright infringement claims The court again highlighted the fact that if Field had used the aforementioned technical methods to alert Google not to use his site, this dispute would never have ended up in court.[20]

The most important and influential section of the court's reasoning revolved around its finding that Google's actions fell under the "Fair Use" exception of the Copyright Act.[21] The Fair Use exception to general copyright law "creates a limited privilege in those other than the owner of a copyright to use the copyrighted material in a reasonable manner without the

14. *Id.* at 1116.

15. *Id.*

16. *Id.*

17. *Id.* at 1112-13.

18. *Id.* at 1117.

19. *Id.* at 1118.

20. *Id.*

21. Digital Millennium Copyright Act, 17 U.S.C. § 107 (1998).

owner's consent"[22] for such purposes as research, teaching, criticism, and satire.[23] Congress, in codifying the Fair Use Doctrine, listed four factors for courts to use when determining whether a certain use falls under this exception:

> 1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
> 2) the nature of the copyrighted work;
> 3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
> 4) the effect of the use upon the potential market for or value of the copyrighted work.[24]

In assessing the first factor, the court weighed heavily in favor of Google, citing the highly "transformative" nature of its search engine activities as being dispositive.[25] The court strongly emphasized the fact that Google served "socially important purposes [and] 'benefited the public by enhancing information-gathering techniques on the Internet.'"[26] It noted that while Field intended his works to serve artistic functions, the purposes of Google's cached copies of these works were different, and did not merely "supersede the objects of the original creation," but instead were transformative.[27] The court highlighted several societal functions which Google's cached copies provided: 1) allowing users to access an archival copy of a website when the site is inaccessible; 2) allowing users to see whether changes have been made to a site over time; and 3) highlighting users' search terms within the cached page.[28] In addition, Google's cached copies were transformative in that they did not purport to replace the original copy of the work.[29] On the contrary, the court noted that every cached Google page had conspicuous language at the top denoting the fact that the copy was merely a

22. *Field*, 412 F. Supp. 2d at 1117 (quoting Fisher v. Dees, 794 F.2d 432, 435 (9th Cir. 1986)).

23. Digital Millennium Copyright Act § 107.

24. *Id.*

25. *Field*, 412 F. Supp. 2d at 1119.

26. *Id.* at 1118 (quoting Kelly v. Arriba Soft Corp., 336 F.3d 811, 820 (9th Cir. 2003)).

27. *Id.* (quoting Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994)) (noting that "[t]he central purpose of this investigation is to see . . . whether the new use 'supersedes the objects of the original creation . . . or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is 'transformative.'").

28. *Id.* at 1118-1119.

29. *Id.* at 1119.

snapshot of the page, not a substitute for the contents of the actual webpage.[30]

In analyzing the first factor, the court made important judgments regarding the commercial nature of the work. Citing the Supreme Court's decision in *Campbell v. Acuff-Rose Music, Inc.*, the court held that "where a use is found to be transformative, the 'commercial' nature of the use is of less importance in analyzing the first fair use factor."[31] Furthermore, the court emphasized that while Google was a profit-making commercial entity, it did not seek to profit *directly* from the cached copy of Field's work.[32] Ultimately, the court determined that Google's commercial status was of little importance in considering the first factor of the fair use analysis.[33]

The court similarly spent little time on the second factor—the nature of the copyrighted work. While it noted that Field's poetry was "creative," it pointed out that he had made his website free and open to the public.[34] By putting his works on a free website and not using technical methods to alert Google not to cache his site, the court held that he freely opened his creative works to the public. Thus, the second factor weighed only slightly in his favor.[35]

Likewise, the court held that the third factor in the Fair Use analysis, the amount and substantiality of the use, favored Google. Citing *Sony Corp. v. Universal City Studios, Inc.*, the court observed that "the Supreme Court has made clear that even copying of entire works should not weigh against a fair use finding where the new use serves a different function from the original, and the original work can be viewed by anyone free of charge."[36] In addition, the court concluded that the purposes behind Google's cached copies of webpages could not be accomplished by only copying portions of the websites—a full copy of the website was necessary to be able to provide society

30. *Id.* (noting that each cached copy included a link to the original website and the following message: "Google's cache is the snapshot that we took of the page as we crawled the web. The page may have changed since that time.").

31. *Id.* at 1119 (quoting Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994)).

32. *Id.* at 1120 (stressing that Google did not display any advertisements on the cached copy of Field's site, and did not solicit business in any way through the cached version of the site).

33. *Id.*

34. *Id.*

35. *See id.*

36. *Id.* (citing Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 449-50 (1984)).

with the full functions of Google's caching system.[37] Thus, since a full copy of the site was necessary, the court found that this factor was neutral.[38]

Again citing *Sony Corp.*, the court found that the fourth fair use factor—the effect of the use on the potential market for the work—weighed heavily in Google's favor.[39] The court emphasized that Field had intentionally placed his works on a free website and that he had never tried to sell any of his poetry.[40] Likewise, in response to Field's claim that he could have marketed the rights to cache his site, the court noted that there was no market for such caching rights and even major sites like Disney, ESPN, and others did not receive compensation for the rights to cache their sites.[41]

In addition to the four statutory fair use factors, the court added its own factor—whether the parties acted in good faith—to its analysis of the Fair Use exception.[42] The court emphasized the wide discrepancy between Google's good faith and Field's attempts to lure the search engine into litigation.[43] Google honored all requests by website owners not to index or cache their site, and even devoted a portion of its own website to explaining how to request non-inclusion in the index and caching system.[44] Likewise, Google made a good faith effort to identify cached copies as simply "snapshots" of a webpage while providing links to the actual webpage itself.[45]

Finally, the court also concluded that Google's cached copies fell under the safe harbor provisions of the Digital Millennium Copyright Act.[46] Field claimed that Google's actions did not satisfy three areas of the safe harbor provisions: 1) Google's cached copies did not constitute "intermediate and temporary storage" under Section 512(b); 2) Google did not satisfy the requirement under Section 512(b)(1)(B) "that the material in question be transmitted from the person who posts the material online to another person at the direction of the other person"; and 3) Google's cache did not satisfy the re-

37. *Id.* at 1121 (citing Kelly v. Arriba Soft Corp., 336 F.3d 811, 820-21 (9th Cir. 2003)).

38. *Id.*

39. *Id.* (citing Sony Corp., 464 U.S. at 450) (explaining that "[a] use that has no demonstrable effect upon the potential market for, or value of, the copyrighted work need not be prohibited in order to protect the author's incentive to create").

40. *Id.*

41. *Id.*

42. *Id.* at 1121-22 (citing Digital Millennium Copyright Act § 107) (allowing courts to consider other factors besides the four statutory fair use factors)).

43. *Id.* at 1123.

44. *Id.* at 1122; *see also* Google Webmaster Help Center—Removing my content from the Google index, http://www.google.com/remove.html.

45. *Field*, 412 F. Supp. 2d at 1122.

46. *Id.*

quirements of Section 512(b)(1)(C) that the storage be done through "an automated technical process" and be "for the purpose of making the material available to users . . . who request access to the material from the [originating site]."[47] The court, however, concluded that Google satisfied all three of these requirements. Its cached copies, which were only retained for 14 to 20 days, were "temporary"; Field himself allowed Google's Googlebot to crawl his website, satisfying Section 512(b)(1)(B)); and Google's cached copying was certainly an "automated technical process" which was used to make information available to users who requested that information.[48]

IV. CRITIQUE OF THE COURT'S REASONING

While certain areas of the court's analysis in *Field* were extremely effective and will have a positive impact on the progress of Internet-driven culture, other areas of the court's reasoning left much to be desired with respect to protecting the rights of copyright holders. Importantly, the court discussed in great detail the transformative nature of Google's search engine activities and highlighted the significance of those activities to the growth and effectiveness of the Internet. The court's analysis correctly noted the importance of search engines to our society and also broadened the scope of acceptable services technology companies may provide to society. Likewise, the court correctly held that Field gave Google an implied license to use his website for indexing and caching purposes. The idea that website owners give an implied license to search engines when they post material on the Internet correctly aligned the court's analysis with the public policy favoring the efficiency and effectiveness of information gathering on the Internet. Yet the court failed to protect some of the legitimate interests of copyrights holders by not defining standards for the first and fourth Fair Use factors. As a result, the court left many questions open for future cases.

In analyzing the first Fair Use factor, the court correctly emphasized the transformative nature of Google's search engine activities and opened the way for other highly beneficial services of this kind, such as the Google Library Project, to proceed. This analysis was important for the continued growth of the Internet as a key part of society's information super-highway. The court correctly emphasized the importance of search engines in daily life, noting that limiting their functions by rigidly construing copyright laws would hinder society's technological growth. The access search engines provide is increasingly important not only for helping individuals make better choices and stay connected, but also to protect the freedoms of information-gathering that digital-age users expect.[49] This decision also made great

47. *Id.* at 1124.

48. *Id.*

49. Urs Gasser, *Regulating Search Engines: Taking Stock and Looking Ahead*, 8 YALE J.L. & TECH. 201 (2006), *available at* http://research.yale.edu/lawmeme/yjolt/files/20052006Issue/spring06-gasser.pdf ("Access in the sense of access

strides in setting a broad standard for other socially beneficial Internet services such as Google's own Library Project. Similar to the societal value of search engines, Google's Library Project contributes to society by giving users access to a searchable database of an enormous collection of the world's foremost literary works.[50] As Hannibal Travis noted, however, just like other major societal initiatives such as highways and railroad systems, the vital functions of search engines and the potential of the Google Library Project could be derailed by individuals who seek a rigid application of existing laws to favor themselves at society's expense.[51] Therefore, the court's emphasis on the societal benefits of search engines solidified the public's interest in maintaining open access to digital information.

Likewise, the court's holding that Field's actions had given Google an implied license to use his works was important in setting a broad standard for search engines. Its analysis implies that once a copyright holder puts his works on a free website and does nothing to alert search engines not to use those works, his material is freely available for search engines and others to use in transformative, socially beneficial ways.[52] Such a conclusion allows Google and other search engines broad powers to continue their current indexing and caching. This ruling is consistent with public policy allowing search engines and other valuable services to utilize the full power of the Internet to aid society when doing so would not offend the *express* wishes of individual copyright holders.[53] Such a policy protects the socially-important functions of search engines and other transformative activities, while also protecting assiduous copyright holders who take the necessary steps to opt-out of this implied license theory.[54] Furthermore, this policy fits with the everyday realities of the Internet, where reasonable users understand that whatever they post on the Internet is accessible and usable by anyone with a

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to search infrastructure is crucial for users, because it is the prerequisite for the . . . freedom to efficiently and effectively make choices among alternative sets of ideas, information, and opinions in the digital age.").

50. *See* Jonathan Band, *The Google Library Project: Both Sides of the Story*, 2 PLAGIARY: CROSS-DISCIPLINARY STUDIES IN PLAGIARISM, FABRICATION, AND FALSIFICATION 1, 1-2 (2006), *available at* http://www.plagiary.org/Google-Library-Project.pdf.

51. *See* Hannibal Travis, *Building Universal Digital Libraries: An Agenda for Copyright Reform*, 33 PEPP. L. REV. 761, 786 (2006).

52. *See* Daniel Holevoet & Sarah Price, Copyright Reform for the Digital Age: A Closer Look at Google (Spring 2006) (unpublished Graduate presentation, Yale University), *available at* http://zoo.cs.yale.edu/classes/cs457/.

53. *Id.* at 22 (proposing that all information posted on the Internet carry an implied license for its use in the absence of technical steps taken by the copyright holder to prevent such use).

54. *Id.* at 24.

computer and Internet access.[55] At the same time, the idea that copyright holders should be forced to take affirmative steps to opt-out of a socially beneficial use of their work also seemingly opens the door for other socially beneficial projects such as the Google Library Project. If website owners have to opt out of search engine indexing and caching, should book publishers not also be required to take the easy steps to opt-out of socially beneficial, transformative projects like the Google Library Project if they do not want their works used in that way?[56]

Although the court conducted a thorough analysis of the transformative nature of search engines and the issue of implied licenses, it failed to set such broad standards in other areas of its analysis, most notably in its discussion of the first and fourth Fair Use factors. In addressing the first factor, the court correctly decided that search engine activities were transformative and beneficial to society; however it spent too little time discussing the reasons why the commercial nature of Google's enterprise was negated by its transformative functions. The court correctly recognized that Google's cached copies, which did not include any advertisements or solicit business from users in any way, exhibited little, if any, commercial tendencies. This ruling that the transformative nature of use outweighs the indirect commercial benefits from a cached copy is supported by the Supreme Court's reasoning in *Campbell*.[57] This analysis, however, fails to establish when commercial activities outweigh a use's transformative nature, or even factors in determining this balancing test. Such precedent without further explanation could have broad impacts on technology law, as it implies that the transformative nature of the work will often and easily outweigh other, more intrusive commercial methods of using another's copyrighted work. Without a set of factors for determining when commercial activities outweigh transformative use, copy-

55. *See Employers Look at Facebook, Too*, June 20, 2006, http://www.cbsnews.com/stories/2006/06/20/eveningnews/main1734920.shtml (noting the ever-growing phenomenon of employers looking at interviewees Facebook profiles to discern the character of the potential employee, even where interviewees do not give permission to do so).

56. Evidence suggests that requiring Google to find every copyright holder of every book they digitize, as well as negotiate with them for the rights to digitize, would completely destroy the financial viability of this project. *See* Band, *supra* note 50, at 9 (estimating that transaction costs for finding copyright holders would exceed $25 billion, and would cause Google to either scrap the Library Project or not digitize a large number of works); *see also* Travis, *supra* note 51, at 836 (noting that unlike public projects like highways, where officials only have to deal with a small number of property owners in negotiating property rights, digital libraries would be required to negotiate with millions of intellectual property rights holders in an opt-in system).

57. *See* Campbell v. Acuff-Rose Music Inc., 510 U.S. 569, 579 (2007) (holding that "the more transformative the new work, the less important the other factors, including commercialism, become").

right holders are left to wonder whether their materials will be wildly exploited by profit-driven enterprises in the future.

In analyzing the fourth Fair Use factor, the impact of the use on the potential market for the work, the court similarly failed to make any judgments to help define this factor for the future. While the court correctly noted that large website owners do not make money off the right to cache their sites, the court merely dismissed the notion that Field's works held actual or potential economic value without making any determinations which might help for future cases. The court's ruling in *Field* suggests that a copyright holder must show a more immediate, actual market for his works, and at the very least, a present intention to market the works in the future. Such a rule would deprive many copyright holders of their rights in the initial stages of their works' acceptance and would have broad ranging implications for other transformative initiatives like Google's Library Project. For example, this ruling suggests that if the copyright holder of a book can show no definable *current* market for his book or present intention to market the book in the future, Google is free to digitize that work for its searchable library database. It is estimated that the percentage of copyrighted but out-of-print books in university libraries could constitute as many as 65% of those libraries' holdings. When coupled with the estimated 15% that are part of the public domain, the ruling in *Field* might freely open 80% of the holdings of libraries up to Google for digitization.[58]

In addition, the court's analysis of the fourth Fair Use factor leaves out the possibility that search engine activities actually promote and benefit the market for a copyrighted work. The Ninth Circuit, in *Kelly*, suggested that search engine activities might actually benefit the market for a work and that such a benefit to the work's market should be factored into the court's analysis.[59] Yet the court in *Field* failed to recognize that a search engine might benefit the market for a copyrighted work, thus leaving this question unanswered for future cases. Adopting the Ninth Circuit's view, which allows the benefits of a transformative use on the market as a factor in the analysis, would have aided initiatives like the Google Library Project, which many concede has the potential to benefit the marketing of large numbers of out-of-print books.[60] By declining to consider beneficial use as a factor in the analysis, the court in *Field* failed to take an opportunity to further solidify its

58. Hal Varian, The Google Library Project 5 (Feb. 24, 2006) (unpublished manuscript prepared for the AEI-Brookings discussion), *available at* http://www.ischool.berkeley.edu/~hal/Papers/2006/google-library.pdf.

59. Kelly v. Arriba Soft Corp., 336 F.3d 811, 821 (9th Cir. 2003).

60. *See* Band, *supra* note 50, at 5 (suggesting that Google's searchable database of digital books may increase the market for many books by showing users the relevance of those books and guiding them to such books); *see also* Varian, *supra* note 58, at 12 (quoting the President of the American Association of Publishers as saying "Google Print Library could help many authors get more exposure and maybe even sell more books. . .").

position that transformative uses of copyrighted works should be broadly protected in today's modern society.

V. CONCLUSION

The court in *Field* correctly decided the issues at hand, and in so doing, laid a groundwork for copyright law in the Internet age which will have broad implications for the future. Its analysis of search engines' transformative natures, as well as its discussion of implied licenses, establishes the foundation for future rulings and solidifies these important standards in copyright law. Finally, the *Field* ruling preserves the important functions which search engines provide for society, and may have implications for other transformative Internet initiatives as well.