BITTORRENT COPYRIGHT TROLLS: A DEFICIENCY IN THE FEDERAL RULES OF CIVIL PROCEDURE?

I. WHO ARE COPYRIGHT TROLLS?

Who are copyright trolls? Simply put, "copyright trolls" are law firms, individual attorneys, or other organizations that acquire the copyright of a particular work, usually a movie, and subsequently sue Internet users with the intent of extracting settlements using questionable legal tactics that border on extortion.[1] The tactics typically used by copyright trolls involve copyright infringement allegations against large groups of anonymous "Doe" defendants for the purpose of minimizing court costs, utilizing the incredibly high statutory damages in copyright law to intimidate defendants, and causing them to settle quickly with little or no litigation and without regard to innocence or guilt.[2]

A. COPYRIGHT TROLL TACTICS

Lawsuits initiated by copyright trolls typically proceed along a common path. First, copyright trolls work with companies that specialize in monitoring peer-to-peer file sharing networks such as those using the BitTorrent protocol.[3] These companies collect the IP address and timestamp data of anyone believed to be uploading or downloading the copyrighted material owned by the troll.[4]

Once a copyright troll obtains a list of IP addresses alleged infringers of its intellectual property rights, the next step is to find the people associated with those IP addresses. To accomplish this,

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1. *Copyright Trolls*, ELECTRONIC FRONTIER FOUNDATION, https://www.eff.org/issues/copyright-trolls (last visited Oct. 26, 2013).
2. *Id.*
3. *Who are copyright trolls?*, FIGHT COPYRIGHT TROLLS, http://fightcopyrighttrolls.com/about/ (last visited Oct. 26, 2013).
4. *Id.*

the troll will file a lawsuit against a large group of "Doe" defendants.[5] By consolidating the defendants, the copyright troll can save tens of thousands of dollars on court filing fees.[6] Subsequently, the troll secures a subpoena from the court ordering the Internet service provider ("ISP") that serves the particular IP addresses to match the IP addresses with the actual individual subscribers.[7]

Having obtained the subscriber names and other contact information of those accused of the copyright infringement, the copyright troll then sends out "litigation settlement" demand letters to all of the accused infringers threatening a lawsuit that can result in a judgment of 150,000 dollars.[8] These demand letters typically require the accused to pay a settlement, typically an amount that is just shy of the cost of litigation, in return for a waiver of claims against them.[9] Because the settlement amount requested is typically similar to the cost the defendant would bear to retain an attorney and dispute the allegations, but without the guarantees of a relatively small monetary outlay, and expedient resolution of the matter, many defendants decide to simply settle.[10] Furthermore, in most cases, copyright trolls have no intention of ever actually litigating the case on its merits, as litigation is costly, and it is less expensive to settle with as many defendants as possible, voluntarily

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5. *John Doe Defendant Law & Legal Definition*, USLEGAL, http://definitions.uslegal.com/j/john-doe-defendant/ (last visited Oct. 26, 2013)("John Doe defendant refers to an anonymous defendant. There may be situations in which the plaintiff does not, at the time of filing suit, know the person's name. In such cases, the anonymous defendant is labeled as John Doe.").

6. The filing fee for a civil action in a federal district court is three hundred and fifty dollars. 28 U.S.C. § 1914 (2006). Thus, an action initiated against one hundred joined "Doe" defendants would only cost three hundred and fifty dollars to file, however, individual actions against those same defendants would cost thirty five thousand dollars in filing fees. *Who are copyright trolls?*, *supra* note 3.

7. *Who are copyright trolls?*, *supra* note 3.

8. *Id.* "In a case where . . . the court finds, that infringement was committed willfully, the court in its discretion may increase the award of statutory damages to a sum of not more than $150,000." 17 U.S.C. § 504(c)(2)(2013).

9. *Who are copyright trolls?*, *supra* note 3.

10. *Id.*

dismiss the case, and move on to the next batch of "Doe" defendants.[11]

II. BITTORRENT AND PEER-TO-PEER TECHNOLOGY

In order to understand many of the problems associated with mass BitTorrent litigation it is first necessary to have a thorough understanding of the technology involved. Once an understanding of the technology is established, the law is applied, and only then will the problems with this particular form of litigation become apparent. Because of the somewhat complex nature of the underlying technology, this Part will attempt to thoroughly educate the reader without becoming overly technical.

BitTorrent is a popular Internet file sharing protocol,[12] designed to facilitate the transfer of large files as quickly as possible while using the smallest amount of Internet bandwidth.[13] The technology is also commonly referred to as peer-to-peer file sharing. Although BitTorrent is a form of peer-to-peer file transferring, it is actually a distinct protocol.[14] The technology is free to use,[15] and most computer users with a moderate level of technological understanding can set up a machine to begin downloading files using this protocol. Once the computer is ready to use, even a novice user may download nearly any digital file he/she chooses. Using BitTorrent to share media files over the Internet is common because of the ease of use, and relatively low amounts of Internet bandwidth required.

Unlike other protocols designed to transfer files, BitTorrent maximizes download speeds by breaking up a large file into small

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11. *Id.*

12. "[P]rotocol: A set of rules and description of how to do things. In the case of the BitTorrent protocol, it is a set of rules describing how BitTorrent clients should communicate and transfer data with each other." *Glossary*, BITTORRENT, http://www.bittorrent.com/help/manual/glossary (last visited Oct. 26, 2013).

13. Carmen Carmack, *How BitTorrent Works*, HOWSTUFFWORKS (Mar. 26, 2005), http://computer.howstuffworks.com/bittorrent.htm.

14. *Id.*

15. *Frequently Asked Questions*, BITTORRENT, http://www.bittorrent.com/help/faq/concepts (last visited Oct. 26, 2013).

pieces called blocks.[16] Users can download blocks from other users attempting to download the same file or others who have completed the download.[17] Because BitTorrent makes downloading large files incredibly fast and easy, especially those files that are popular, many users use the BitTorrent protocol to upload and download music, television programs, movies, software, and various other forms of digital content that is often protected by United States copyright law.[18]

This section will not attempt to try and examine the moral and ethical implications of the BitTorrent protocol and its use by potential infringers, but rather it will give the reader a working knowledge base from which the reader will be better equipped to comprehend the technological implications on the law as it currently stands. The following section will examine how the BitTorrent protocol works and how it differs from traditional, more simplistic file transfer methods that courts have examined in the past.

A. TRADITIONAL DOWNLOADS

The section will compare and contrast BitTorrent from traditional file transfers. This section will further contain an examination of the traditional paradigm of downloading a file from a website. Knowledge of how downloading works is important due to cases where the United States Supreme Court defined personal jurisdiction in the context of the Internet. The fact patterns of these cases have included files that have either been uploaded[19] or

16. Carmack, *supra* note 13.

17. *Id.*

18. See Nic Healy, *Game of Thrones: the once and future king of BitTorrent*, CNET AUSTL. (June 24, 2013), http://m.cnet.com.au/game-of-thrones-the-once-and-future-king-of-bittorrent-339344690.htm?redir=1.

19. "[U]pload: to transfer (as data or files) from a computer to the memory of another device (as a larger or remote computer)." *Upload*, MERRIAM-WEBSTER, http://www.merriam-webster.com/dictionary/upload (last visited Oct. 26, 2013).

downloaded[20] to a site. Alternatively, cases have also focused on the end users' interactions with the website in question.

In a "traditional download" a user finds a webpage with a link to the file that the user wants to download.[21] Similar to the file transfers using the BitTorrent protocol, this process has always been as simple as "Googling" whatever it is the user is looking for. Once the desired web page is found, downloading is a simple matter of clicking the link to begin the file transfer.[22]

In more technical terms, the user's web browser, the client,[23] communicates to the server,[24] which hosts the web page and the file, to begin downloading the file to the user's computer.[25] The relationship between server and client is a hub and spoke configuration; the clients do not communicate with one another and are only aware of the server, regardless of how many clients are attempting to download the same file. The client and the server communicate by way of one of several protocols such as FTP or HTTP.[26] In this classic configuration the speed at which the transfer could be completed is limited by several variables. For instance, the communication protocols handle data in different ways and the amount of users trying to communicate with the server plays a large role as well.[27] As the amount of traffic for a particular server increases, each connection is given less bandwidth.[28] Additionally,

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20. "[D]ownload: to transfer (as data or files) from a usually large computer to the memory of another device (as a smaller computer)." *Download,* MERRIAM-WEBSTER, http://www.merriam-webster.com/dictionary/downloading (last visited Oct. 26, 2013).

21. Carmack, *supra* note 13.

22. *Id.*

23. *See infra* note 24.

24. Generally speaking, a server is a computer designed to process requests and deliver data to other (client) computers over a network or the Internet. Servers typically are configured with additional processing, memory, and storage capacity to handle the load of servicing multiple client computers. Marshall Brain, *How Web Servers Work*, HOWSTUFFWORKS (Apr. 1, 2000), http://computer.howstuffworks.com/web-server.htm.

25. Carmack, *supra* note 13.

26. *Id.*

27. *Id.*

28. "[B]andwidth is a term used to describe how much information can be

the more attempts to download the same file, the more stress that is put on the server, further impeding download speeds.[29]

B. PEER-TO-PEER FILE TRANSFERS

Peer-to-peer file transfers are distinct from the traditional centralized server model. First, peer-to-peer transfers utilize a non-web browser client to locate the desired file.[30] Secondly, the files are located on other personal computers instead of a centralized server.[31] The personal computers that are sharing files are called peers because they are computers just like the user's computer as opposed to a server.[32] Typically, users maintain a "shared" folder that is available for other users to download from. Using the peer-to-peer software, users initiate a search for the file a user wants to download.[33] When this search is initiated, the peer-to-peer client connects to other computers that are both connected to the Internet and running the same software.[34] When the peer-to-peer client locates the file in another computer's shared folder, the transfer begins.[35] Conversely, this process also happens in the reverse. Other users of the peer-to-peer software who find desirable files on your hard drive may download a file from you as well.

The principle issues with these file distribution systems (which BitTorrent solves) are that of limited bandwidth and system resources.[36] For instance, if several users are attempting to download the same file from one computer, the download speed of the users will be limited by the upload speed of the computer they

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transmitted over a connection. It is usually given as bits per second, or as some larger denomination of bits, such as Megabits per second, expressed as kbit/s or Mbit/s." *What Is Bandwidth?*, WISEGEEK, http://www.wisegeek.com/what-is-bandwidth.htm (last visited Oct. 26, 2013).

29. *See* Carmack, *supra* note 13.
30. *Id.*
31. *Id.*
32. *Id.*
33. *Id.*
34. *Id.*
35. *Id.*
36. *Id.*

are all trying to download from. The computer uploading the file to multiple peers will distribute its available bandwidth amongst the multiple downloaders.[37] Consequently, the limitation is the upload speed of the host computer as well as the number of peers downloading.[38] This problem is further exacerbated by the fact that many ISPs limit subscribers' upload bandwidth to a fraction of their download bandwidth.[39] The combination of these limiting factors results in users only being able to utilize a fraction of their maximum download speeds. File queries can also eat up valuable bandwidth.[40]

Further, an additional problem posed by this model is caused when users disconnect from the network or close the peer-to-peer program as soon as they have finished downloading the desired file and deprive other users the ability to download from that computer.[41] These users who download files and immediately disconnect from the network or close the peer-to-peer program are aptly called "leechers."[42]

C. THE BITTORRENT PROTOCOL

The BitTorrent protocol was developed to solve several of the problems associated with traditional peer-to-peer file sharing.[43] Unlike traditional peer-to-peer transfers where the individual computers handle the searching and keeping track of file locations,

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37. *Id.*

38. *Id.*

39. *Why is uploading slower than downloading?*, FETCH SOFTWORKS, http://fetchsoftworks.com/fetch/help/Contents/Tutorial/SlowUploads.html (last visited Oct. 26, 2013) ("Most high-speed Internet connections, including cable modems and DSL, are asymmetric — they are designed to provide much better speed for downloading than uploading. Since most users spend much more time downloading (which includes viewing web pages or multimedia files) than they do uploading, high-speed Internet providers have designed their systems to give priority to downloading.").

40. Carmack, *supra* note 13.

41. *Id.*

42. *Id.*

43. *The Basics of BitTorrent*, BITTORRENT, http://www.bittorrent.com/help/manual/chapter0201 (last visited Oct. 26, 2013).

the BitTorrent protocol utilizes a centralized server called a tracker,[44] which handles much of this work, and reduces the work load on individual computers.[45] BitTorrent also employs a tit-for-tat system, which prevents the problem of leeching,[46] a problem on other peer-to-peer systems.[47] Finally, the BitTorrent protocol is far superior in its utilization of available Internet bandwidth.[48] Instead of downloading the entire file directly from a peer, the file is broken up into smaller pieces called blocks,[49] and can be downloaded from multiple peers at once.[50] Once all of the blocks have been downloaded, they are then reassembled on the user's computer and become available for use.

A user of the BitTorrent protocol needs to search for the torrent file they are looking for in a search engine, similar to the process of searching a particular file for traditional file downloading.[51] A user only needs to add the suffix ".torrent" to the file name while searching in various search engines.[52] Countless websites offer BitTorrent files and many are solely dedicated to searching for torrent files.[53] These sites work similarly to traditional search engines, but they only return results of BitTorrent files.

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44. "[T]racker: a server that keeps track of the peers and seeds in a swarm. A tracker does not have a copy of the file itself, but it helps manage the file transfer process." *Frequently Asked Questions*, *supra* note 15.

45. Carmack, *supra* note 13.

46. "[L]eech or leecher: usually refers to a peer that is downloading while uploading very little, or nothing at all. Sometimes this is unintentional and due to firewall issues. The term leech is also sometimes used to simply refer to a peer that is not seeding yet." *Frequently Asked Questions*, *supra* note 15.

47. Carmack, *supra* note 13.

48. *Id.*

49. "[B]lock: A block is a piece of a file. When a file is distributed via BitTorrent, it is broken into smaller pieces, or blocks. Typically the block is 250kb in size, but it can vary with the size of the file being distributed. Breaking the file into pieces allows it to be distributed as efficiently as possible. Users get their files faster using less bandwidth." *Frequently Asked Questions, supra* note 15.

50. Carmack, *supra* note 13.

51. *Id.*

52. *Downloading With BitTorrent*, BITTORRENT, http://www.bittorrent.com/help/manual/chapter0204 (last visited Oct. 26, 2013).

53. *See, e.g.*, THE PIRATE BAY, www.thepiratebay.com (last visited Oct. 26, 2013);TORRENTZ, http://torrentz.eu (last visited Oct. 26, 2013).

Once the user finds the desired torrent file,[54] the file is opened with a BitTorrent client.[55] The client then reads the torrent file and communicates with the tracker using a process called scraping.[56] Upon communication from the client, the tracker searches for other computers that are running BitTorrent clients who have that specific file either in a completed form, or in the process of downloading.[57] Computers with the complete file are referred to as seeds,[58] and computers with only portions of the file are referred to as peers.[59] The tracker then identifies all of the users that are currently uploading or downloading the particular file that is associated with the torrent file.[60]

The "swarm" consists of users connected to the network who possess all part of a file.[61] The tracker then helps to coordinate the transfer of files from users in the swarm who have the file to those who do not.[62] Unlike traditional file transfers and peer-to-peer transfers, the BitTorrent protocol downloads multiple parts of the file, or blocks,[63] from multiple users at the same time.[64] The user is

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54. "[T]orrent file: a file which describes what file or files are being distributed, where to find parts, and other info needed for the distribution of the file." This term should be differentiated from what is commonly referred to as a 'torrent.' A torrent generally, is the instance of the file or group of files being distributed via BitTorrent, i.e. the digital content the user is actually interested in downloading." *Frequently Asked Questions*, *supra* note 15.

55. "[C]lient: the BitTorrent software used to download and upload files." *Id.*

56. "[S]crape: This is when a client sends a request to the tracker for information about the statistics of the torrent, like who to share the file with and how well those other users are sharing." *Id.*

57. *Id.*

58. "[S]eed: a complete copy of the file being made available for download." *Id.*

59. "[P]eer: one of a group of clients downloading the same file." *Id.*

60. Carmack, *supra* note 13.

61. "[S]warm: a group of seeds and peers sharing the same torrent." *Frequently Asked Questions*, *supra* note 15.

62. Carmack, *supra* note 13.

63. "[B]lock: A block is a piece of a file. When a file is distributed via BitTorrent, it is broken into smaller pieces, or blocks. Typically the block is 250kb in size, but it can vary with the size of the file being distributed. Breaking the file into pieces allows it to be distributed as efficiently as possible. Users get their files faster using less bandwidth." *Frequently Asked Questions*, *supra* note 15.

64. Carmack, *supra* note 13.

also uploading parts of the file once they have been downloaded.[65] The ability to download multiple pieces of the file simultaneously solves a major problem with traditional peer-to-peer file transfer methods: the limitation of upload speeds. These speeds are typically much slower than the download speeds from ISPs. By downloading different blocks of the file from different clients, the overall download speed is no longer limited by the upload speed of a particular computer and the number of users connected to and downloading from the client that it is running.[66] As the number of clients connected to the swarm increases, more sources will become available for each part of the file, which increases availability,[67] and decreases the resources needed from each connected machine, resulting in an overall average increase in download speeds.[68] Because of this enhanced ability to download files at greater speeds, the BitTorrent protocol has become very popular when users wish to download large popular files.[69] The tracker also keeps track of the ratio of the amount of data the user has downloaded to the amount of data the user has uploaded. The higher this ratio is, the higher the user's overall ranking becomes, which means the tracker will allow the user to download simultaneously, and thus increase the user's download speeds.[70] This tit-for-tat system encourages the user to keep the BitTorrent client running and the file available for others to download even after the user has completed downloading the file.[71] At this point the user has become a seeder.[72] The BitTorrent client will continue

65. *The Basics of BitTorrent*, *supra* note 43.

66. Carmack, *supra* note 13.

67. "[A]vailability: The number of existing full copies of the file available to the client for downloading. The higher this number is, the potentially easier and quicker it can be to download the complete file (not accounting for other factors). If this number is less than one (for example, 0.65) then there is not a full copy of the file available to download." *Frequently Asked Questions, supra* note 15.

68. Carmack, *supra* note 13.

69. *Id.*

70. *Id.*

71. *Id.*

72. "[S]eeder/seeding: a peer that is done downloading a file and is now just making it available to others," *Frequently Asked Questions*, *supra* note 15.

to seed the file until the user pauses the transfers or removes the torrent from the queue.[73]

III. SUBPOENAS

One of the first challenges that "Doe" defendants face is the subpoena.[74] Copyright holders do not have the actual identities of the defendants, only their IP addresses; plaintiffs must subpoena ISPs to match the IP addresses with the names, home addresses, telephone numbers, email addresses, and Media Access Control addresses ("MAC addresses") of the "Doe" defendants in order to serve them complaints and summons.[75] After initiating the suit, copyright holders request leave from the court to conduct discovery before the usual Rule 26(f) conference.[76] Because the suit cannot go forward without any named parties, the request is granted and the copyright holders are allowed to subpoena the ISPs for the "Doe" defendants' identifying information.[77]

After being served with the subpoena, ISPs typically send letters to their subscribers identified by IP address in the subpoena, stating that the subscriber has been named in a lawsuit, typically for damages of $150,000,[78] and that the ISP will have to comply with

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73. *Id.*

74. FED. R. CIV. P. 45(a)(1)(A)(iii) (providing that subpoenas "command each person to whom it is directed to . . . produce [the] designated documents [and] electronically stored information . . . in that person's possession, custody, or control.").

75. *See, e.g.*, Hard Drive Prods., Inc. v. Does 1-188, 809 F. Supp. 2d 1150, 1152-53 (N.D. Cal. 2011).

76. FED. R. CIV. P. 26(f) (providing in part that "[e]xcept in a proceeding exempted from initial disclosure . . . or when the court orders otherwise, the parties must confer as soon as practicable—and in any event at least 21 days before a scheduling conference is to be held or a scheduling order is due . . .").

77. *Hard Drive Prods., Inc.*, 809 F.Supp.2d at 1153.

78. 17 U.S.C. § 504(c)(2) (2013)("In a case where the copyright owner sustains the burden of proving, and the court finds, that infringement was committed willfully, the court in its discretion may increase the award of statutory damages to a sum of not more than $150,000.").

the subpoena and identify the subscriber unless the subscriber files an objection or motion to quash the subpoena with the court.[79]

Upon receiving the letter from the ISP, the defendant finds himself in a very difficult position. He has a few options available to him: do nothing, file an objection or motion with the court, hire an attorney, or settle. None of these options are particularly appealing, and many people wish to avoid being named in a copyright infringement lawsuit.[80] Many defendants choose to settle due to the above stated reasons.[81] However, some defendants make the choice to litigate but still want to avoid being named. Accordingly, one course of action is to file a motion to quash the subpoena in order to prevent their ISPs from disclosing the identifying information to the copyright holder.[82] Alternatively, "Doe" Defendants may request that the court issue a protective order.[83]

The process of quashing the subpoena is potentially the most difficult challenge a "Doe" Defendant can face. Rule 45 of the Federal Rules of Civil Procedure states that "the issuing court must quash or modify a subpoena that: . . . requires disclosure of privileged or other protected matter, if no exception or waiver applies."[84] In opposition to the subpoenas, many defendants make motions to quash the subpoenas as well as motions for protective orders to keep their identities confidential.[85] "Doe" defendants also commonly raise objections related to First Amendment privacy

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79. *See Who are copyright trolls?*, supra note 3.

80. *Id.* ("In addition, fear to be named in a lawsuit and hence be associated with a porno case, which can ruin families and careers, creates an additional pressure. Consequently, many innocent people indeed opt to settle.").

81. *Id.*

82. *Hard Drive Prods., Inc.*, 809 F.Supp.2d at 1153.

83. FED. R. CIV. P. 26 (c)(1)("A party or any person from whom discovery is sought may move for a protective order. . . . The court may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense.").

84. FED. R. CIV. P. 45(c)(3)(iii).

85. *See, e.g.*, John Wiley & Sons, Inc. v. Doe Nos. 1-30, 284 F.R.D. 185, 188 (S.D.N.Y. 2012).

concerns, improper joinder, and personal jurisdiction, to protect their identity.[86]

A. MOTION TO QUASH

Many courts recognize that individuals have at least a limited First Amendment privacy interest in anonymous Internet usage.[87] When considering a "Doe" defendant's motion to quash, courts have applied a five-factor test, originally set forth in *Sony Music Entertainment Inc. v. Does 1-40,*[88] to determine whether the motion should be granted.[89] The first four factors of the test almost invariably weigh against the "Doe" Defendants. The five factors set forth in *Sony Music* are as follows: "(1) a concrete showing of a prima facie claim of actionable harm; (2) specificity of the discovery request; (3) the absence of alternative means to obtain the subpoenaed information; (4) a central need for the subpoenaed information to advance the claim; and (5) the party's expectation of privacy."[90] The anonymous nature of the BitTorrent protocol makes it impossible for the copyright holders to obtain the identities of the

86. *Id.* at 192.

87. *See, e.g.*, Sony Music Entm't Inc. v. Does 1-40, 326 F. Supp. 2d 556, 562 (S.D.N.Y. 2004).

88. *See id.* ("The factors include (1) a concrete showing of a prima facie claim of actionable harm; (2) specificity of the discovery request; (3) the absence of alternative means to obtain the subpoenaed information; (4) a central need for the subpoenaed information to advance the claim; and (5) the party's expectation of privacy.").

89. Courts in the D.C., First, Third, Fourth, Sixth, Seventh, Ninth, and Tenth Circuits have applied the "Sony Test." *See* Art of Living Foundation v. Does, No. 10–5022, 2011 WL 3501830, at *3 (N.D.Cal. Aug.10, 2011); First Time Videos, LLC. v. Does 1–500, 276 F.R.D. 241, 248–49 (N.D.Ill.2011); Call of the Wild, 770 F.Supp.2d at 341; Warner Bros. Records, Inc. v. Doe, No. 08–116, 2008 WL 5111884, at *7 (E.D.N.C. Sept.26, 2008); Fonovisa, Inc. v. Does 1–9, No. 07–1515, 2008 WL 919701, at *9 (W.D.Pa. Apr.3, 2008); Interscope Records v. Does 1–14, 558 F.Supp.2d 1176, 1178 (D.Kan. 2008); London–Sire Records, Inc. v. Doe 1, 542 F.Supp.2d 153, 163 (D.Mass.2008); LaFace Records, LLC v. Does 1–5, No. 07–187, 2007 WL 2867351, at *2 (W.D.Mich. Sept.27, 2007).

90. 326 F. Supp. 2d at 564-65 (citations omitted).

defendants, and enable a showing of the third factor of the *Sony Music* test.[91]

The fifth factor, however, the defendant's expectation of privacy, leaves room for discussion. Courts applying this test seem to give dispositive weight to the fact that many Internet service providers require subscribers to sign terms of service agreements which prohibits subscribers from using the service to violate any laws, specifically copyright, as well as retaining the ISP's right to disclose the subscriber's information.[92] In order to weigh this factor against the defendants, courts must assume that the account holder is the person that actually downloaded the copyrighted work. In light of the terms of service agreements, defendants who have actually infringed the copyright in question have lost any expectation of privacy. However, defendants who have not actually downloaded the work, abiding by the terms of service, have every expectation of privacy. Because this assumption could very well be erroneous,[93] courts should consider the merits of the defenses raised, and then make a determination as to this factor. Absent such consideration, courts will likely continue to conclude that this factor weighs in favor of the copyright holders and will be potentially aiding in the improper extraction of settlements from innocent defendants.

Although the five factor test may seem to unduly favor the copyright holders, when compared to some courts' treatment of improper joinder, venue, and lack of personal jurisdiction defenses, the test appears thorough. Many courts refuse to even consider the issues of improper joinder when considering the motion to quash

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91. *Id.* at 566.

92. *See, e.g., Optimum Online Residential Terms of Service*, OPTIMUM, https://www.optimum.net/pages/Terms/Internet/Residential.html (last visited Mar. 2, 2014) ("Subscriber also agrees not to store, distribute or otherwise disseminate any material or content over the Optimum Online Service in any manner that constitutes an infringement of third party intellectual property rights, including but not limited to copyrights. Cablevision reserves the right to take action at its own discretion and as required by the Digital Millennium Copyright Act, any other applicable laws, rules or regulations, or court order.").

93. *See* discussion *supra* Part II(b).

the subpoena.[94] Similarly, with regard to venue and personal jurisdiction, courts have considered these defenses "premature" because at this stage of litigation the defendant is not yet a named plaintiff.[95] Thus, "Doe" Defendants cannot raise these challenges to protect their identities until after their identities have already been disclosed. Courts should change their practices to examine the merits of these defenses before the disclosure of the defendants' identities actually occurs.

B. MOTION FOR PROTECTIVE ORDER

If the motion to quash is denied, many defendants apply for a protective order in the alternative.[96] Although some courts have essentially applied the same five factor test discussed above to motions for protective orders,[97] others have determined that the fifth factor of the test, granting a motion for a protective order, can mitigate the concerns raised over the defendants' expectation of privacy.[98] For example, the court in *Malibu Media, LLC v. John Does 1-16* "issue[d] a protective order requiring that all parties refer to the defendants in [the] case by his or her John Doe number in any matters filed of record until further order."[99] However, the

94. *See* John Wiley & Sons, Inc. v. Doe Nos. 1-30, 284 F.R.D. 185, 192 (S.D.N.Y. 2012) (explaining that although the issue of joinder should be considered, the issue should not be discussed in relation to a motion to quash a subpoena because the remedy for improper joinder is severance, not the quashing of the subpoena).

95. *Id.*

96. FED. R. CIV. P. 26(c)(1) ("[T]he court may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense . . . ").

97. *See Wiley*, 284 F.R.D. at 192 ("For reasons identical to those discussed [regarding the motion to quash the subpoena], I do not find good cause to issue a protective order").

98. *See* 902 F. Supp. 2d. at 699 (concluding that any detriment to the John Does' expectation of privacy is mitigated by granting their request to proceed anonymously).

99. Malibu Media, LLC 902 F. Supp. 2d 690, 702 (E.D. Pa. 2012).

court still allowed the disclosure of the defendants' identities to the copyright holder through *in camera* submissions.[100]

Although this approach is a step in the right direction towards curtailing the abusive litigation tactics of copyright holders in mass BitTorrent litigation, it is far from perfect. Even if the protective order was guaranteed the protection of "Doe" Defendants' identities from public disclosure,[101] removing the specter of public embarrassment, it would still not prevent the copyright holders from contacting the now-named defendants to extract settlements. However, courts presiding over these should look to *Malibu Media* as an example of a court using the protective order available under Rule 26, to balance the countervailing interests of legitimate copyright holders protecting their legal interests, and Copyright Trolls seeking to extort settlements out of defendants through abusive litigation tactics, and defendants' privacy interests through the fashioning of a protective order on a case-by-case basis.

IV. JOINDER

Among the largest problems with the Copyright Troll model is the availability of joinder and the rate at which it has been granted. The Federal Rules of Civil Procedure allow a plaintiff to join multiple defendants in a single action if (1) "any right to relief is asserted against them jointly, severally, or in the alternative with respect to or arising out of the same transaction, occurrence, or series of transactions or occurrences" and (2) "any question of law or fact common to all defendants will arise in the action."[102] However, courts throughout the country are split on whether the

100. *Id.*

101. Although the court issued a protective order forbidding the disclosure of the defendants' identities, it alluded to the possibility that the order could be modified at a later time. *Id.* at 701("Plaintiff does contend that any protective order should only prevent the disclosure of the moving Does' identities until trial and/or judgment is entered . . . . The Court is always open to consider modification of a protective order.").

102. FED. R. CIV. P. 20.

joinder of multiple "Doe" Defendants in mass BitTorrent copyright infringement litigation is proper.[103]

Indeed, the Supreme Court has held that "the impulse is toward entertaining the broadest possible scope of action consistent with fairness to the parties; joinder of claims, parties and remedies is strongly encouraged,"[104] this particular model of litigation did not exist in 1966 when *United Mine Workers* was decided and, accordingly, should not be given the weight it has been by courts like the one in *Raw Films*. Instead, courts should exercise their discretion and deny joinder in these mass BitTorrent lawsuits.[105]

The main point of contention and the source of the disagreement between courts has been the "same transaction, occurrence, or series of transactions or occurrences" element of the joinder requirements.[106] Again, the confusion is most likely due to a

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103. The court in *Raw Films, Ltd. v. John Does 1-15* compiled a list of cases representative of this split throughout the country. No. 11-7248, 2012 WL 1019067 at *5 (E.D. Pa. Mar. 26, 2012). *Compare* Hard Drive Prods., Inc. v. Does 1–55, No. 11–2798, 2011 WL 4889094, at *5 (N.D.Ill. Oct.12, 2011) (finding joinder appropriate), *and* Donkeyball Movie, LLC v. Does 1–171, 810 F.Supp.2d 20, 27–28 (D.D.C.2011) (finding joinder appropriate), *with* Hard Drive Prods. Inc. v. Does 1–30, No. 11–345, 2011 WL 4915551, at *4 (E.D.Va. Oct.17, 2011) (finding joinder inappropriate), *and* Hard Drive Prods., Inc. v. Does 1–188, 809 F.Supp.2d 1150, 1156–64 (N.D.Cal.2011) (finding joinder inappropriate).

104. United Mine Workers of Am. v. Gibbs, 383 U.S. 715, 724 (1966).

105. *See* FED. R. CIV. P. 21 ("[o]n motion or on its own, the court may at any time, on just terms, add or drop a party. The court may also sever any claim against a party"); *see also* Mary Kay Kane, § 1652 Permissive Joinder of Parties under Rule 20(a)—Purpose and Scope, 7 Fed. Prac. & Proc. Civ. § 1652 (3d ed.) ("[T]he court has discretion to deny joinder if it determines that the addition of the party under Rule 20 will not foster the objectives of the rule, but will result in prejudice, expense or delay.").

106. *Compare* AF Holdings LLC v. Does 1-1,058, 286 F.R.D. 39, 46 (D.D.C. 2012) (holding copyright owner's allegations, that 1,058 unknown individuals illegally infringed the owner's copyright by downloading and distributing the owner's movie using a file-sharing protocol called BitTorrent, and that each unknown individual used the BitTorrent protocol and exchanged bits of the owner's motion picture was sufficient to establish at the pleading stage that the owner's claims against the unknown individuals potentially stemmed from the same transaction or occurrence and was logically related, as required for permissive joinder, despite the wide range of dates and times over a four-month period in which the alleged infringing activity took place; based on owner's allegations that each unknown individual was a possible source and may have

misunderstanding of the BitTorrent technology. For example, the court in *Raw Films* stated that

> [e]ven if no Doe defendant directly transmitted a piece of the work to another Doe defendant, the Court is satisfied that at this stage of the litigation the claims against each Doe defendant appear to arise out of the same series of transactions or occurrences, namely, the transmission of pieces of the same copy of the work to the same investigative server.[107]

This conclusion is based on the erroneous assumption that all defendants who make any transaction with one server, are themselves connected. For example, the same result could be achieved if one defendant uploaded one part of the work to the investigation server and then terminated his Internet connection, then another defendant joining the swarm, uploading or downloading a part then terminating his Internet connection, and so on until all of the defendants had engaged in a transaction with this particular server. Here, it is easy to see that it is possible for the defendants to have no connection to one another whatsoever.

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been responsible for distributing the movie to other unknown individuals, who were also using the same file-sharing protocol), *and* Barnhart v. Town of Parma, 252 F.R.D. 156 (W.D.N.Y. 2008) (holding that under the rule allowing joinder of additional plaintiffs, if plaintiffs assert a right to relief arising out of the same transaction or occurrence, joinder does not depend on the existence of claims arising from the same incident or occurrence; rather, term "transaction" is a word of flexible meaning that may comprehend a series of many occurrences, depending not so much upon the immediateness of their connection as upon their logical relationship), *with* Liberty Media Holdings, LLC v. BitTorrent Swarm, 277 F.R.D. 669 (S.D. Fla. 2011) (holding that John Doe users of peer-to-peer (P2P) file sharing program had not participated in or contributed to same transactions or occurrences, and thus permissive joinder of users was not warranted in action alleging users had used P2P program to join a "swarm" of hosts to download and illegally distribute copyrighted movie; P2P program was decentralized and operated such that any pieces of video copied or uploaded by individual users could have been sent to any of hundreds or thousands of individuals who had participated in said "swarm," and even if John Doe users had been part of same "swarm," their alleged infringing activities, subject to two exceptions, had taken place on different dates and times over two-month period).

107. Raw Films, Ltd. v. John Does 1-15, No. 11-7248, 2012 U.S. Dist. LEXIS 41645 at *9-10 (E.D. Pa. Mar. 23, 2012).

Furthermore, the *Raw Films* court also found that the claims against the "Doe" Defendants were logically related for the purposes of joinder because "they will feature largely duplicative proof regarding the nature of BitTorrent, the plaintiff's ownership interest in the copyright for the work, and the forensic investigation conducted by the plaintiff."[108]

Although it is certainly true that the copyright holders will be asserting essentially the same case against each of the defendants, joinder is not proper simply because multiple unrelated defendants used the same BitTorrent protocol to cause the same type of harm to one plaintiff.[109] Allowing Copyright Trolls to join multiple defendants only because the defendants harmed the copyright holder in the same way would eviscerate the "same transaction or occurrence" requirement of permissive joinder. The court in *Fonovisa* aptly stated that

> [if] courts reasoned that . . . the transactional test could be satisfied by merely alleging that the plaintiffs suffered the same harm from alleged violations of their copyrights, "a copyright plaintiff could join as defendants any otherwise unrelated parties who independently copy material owned by the plaintiff." Moreover, under this logic, there would be virtually no limit to the number of parties that could be joined, which would effectively nullify the transactional requirement.[110]

Moreover, if the cases against the individual defendants were tried separately, they would present vastly different factual scenarios thereby allowing the "Doe" Defendants to present individual defenses based on their particular circumstances. Because, as discussed above, the copyright holder's theory of recovery is essentially identical for each "Doe" Defendant, the only

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108. *Id.*

109. *See* Arista Records, LLC v. Does 1-11, 1:07-CV-2828, 2008 WL 4823160, at *6 (N.D. Ohio Nov. 3, 2008) (adopting the position that "the mere common use by otherwise separate and unrelated defendants of the same program in inflicting the same type of harm on a single plaintiff is inadequate to support a finding that the defendants' actions were 'concerted.'").

110. Fonovisa, Inc. v. Does 1-9, No. 07-1515, 2008 WL 919701 at *5 (W.D. Pa. Apr. 3, 2008) (citing Bridgeport Music, Inc. v. 11C Music, 202 F.R.D. 229, 232 (M.D. Tenn. 2001)).

real burden on the plaintiff is the court-filing fee for each suit it brings. When this low burden is balanced against "Doe" Defendants' interests in not being extorted, and against the public's interest in not allowing the legal system to be abused, it is clear that courts should not entertain the broadest possible scope of joinder in these cases, but a scope that seems reasonable under the circumstances. Although *Raw Films* pointed out that courts that permitted the joinder of "Doe" Defendants have done so "by finding it appropriate as an initial matter and permitting any defendant, once named and served, to challenge the appropriateness of joinder later in the case,"[111] the arguments above still hold the same force even after the defendants have been named. Thus, it is in the interest of judicial economy, as well, to sever the "Doe" Defendants as early in the action as possible and leave it to the copyright holder to bring suit against the individual defendants if the copyright holder believes it will succeed in its action on the merits.

V. PERSONAL JURISDICTION

Issues of personal jurisdiction have become less prevalent in recent cases, due in large part to the public availability of free and easily accessible tools, which can determine the likely location of particular IP addresses in the copyright holder's complaint.[112] However, it is still possible for some out-of-state defendants to be named in a lawsuit that is being litigated hundreds of miles away. Faced with an exponentially increasing amount of online activity once reserved for the physical world, courts must now apply traditional legal principles, such as jurisdictional statutes and due process, to fact patterns involving the Internet. Although many legal concepts have been well settled, the application of traditional legal principles "derived from notions of state sovereignty and territorial limits . . . to [a] technology with no geographical

111. *Raw Films*, U.S. Dist. LEXIS 41645 at *12.

112. *See, e.g.*, *Lookup IP Address Location*, WHATISMYIPADDRESS, http://whatismyipaddress.com/ip-lookup (last visited Oct. 26, 2013).

boundaries or physical presence" often presents novel issues, requiring a thorough understanding of the underlying technological concepts in addition to traditional legal analysis.[113] To counteract the inherently territorial nature of personal jurisdiction, I will use an example to illustrate the difficulties of the personal jurisdiction inquiry. Since its long-arm statute does not extend to the outer bounds of constitutionality and it differs somewhat as far as it is concerned with the "situs of the injury," discussed *infra*, New York will be used for this analysis.

In order to determine whether a non-domiciliary alleged to have committed copyright infringement may be sued in New York, two issues must be discussed. First, does the alleged conduct satisfy the requirements of New York's long-arm statute?[114] Second, assuming the requirements of the long-arm statute are satisfied, does the exercise of jurisdiction comport with due process?[115]

Moreover, the Copyright Act provides no jurisdictional provisions; the long-arm statute of the forum state, in this instance New York, governs the question of personal jurisdiction.[116] In New York, long-arm jurisdiction is set forth in New York Civil Practice Law and Rules ("N.Y. C.P.L.R.") section 302.[117] Moreover, many intellectual property infringement claims against out-of-state

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113. Katherine Neikirk, Note, *Squeezing Cyberspace into International Shoe: When Should Courts Exercise Personal Jurisdiction over Noncommercial Online Speech?*, 45 VILL. L. REV. 353, 354-55 (2000).

114. LaMarca v. Pak-Mor Mfg. Co., 735 N.E.2d 883, 886 (N.Y. 2000).

115. *Id.*

116. Penguin Grp. (USA) Inc. v. Am. Buddha, 609 F.3d 30, 35 (2d Cir. 2010) *certifying question to*, 933 N.E.2d 205 (N.Y. 2010) *and certified question answered*, 946 N.E.2d 159 (N.Y. 2011).

117. N.Y. C.P.L.R. 302 (McKinney 2008) ("[A] court may exercise personal jurisdiction over any non-domiciliary who: 1) transacts any business within the state or contracts anywhere to supply goods or services in the state; or 2) commits a tortious act within the state; or 3) commits a tortious act without the state causing injury to person or property within the state if he (i) regularly does or solicits business, or engages in any other persistent course of conduct, or derives substantial revenue from goods used or consumed or services rendered, in the state, or (ii) expects or should reasonably expect the act to have consequences in the state and derives substantial revenue from interstate or international commerce; or 4) owns, uses or possesses any real property situated within the state.").

defendants argue that jurisdiction is proper under N.Y. C.P.L.R. section 302(a)(3)(ii).[118] An analysis of these sections of the statute will prove illustrative in answering the question at hand. For the purposes of this analysis, structured around N.Y. C.P.L.R. section 302(a)(3)(ii), it is implicit that the defendant does not transact or solicit any business and has not committed a tortious act or owns any real property within New York; his only connection with the forum state is the alleged infringing conduct. Generally, it is because of the alleged infringer's lack of contacts with New York that N.Y. C.P.L.R. section 302(a)(3) typically governs.[119] The remainder of this analysis will analyze a New York court's ability to exercise jurisdiction within the confines of the framework discussed above.

A. NEW YORK LONG-ARM STATUTE ANALYSIS

In *LaMarca*,[120] the New York Court of Appeals outlined five elements that need to be satisfied in order to confer personal jurisdiction upon the court under N.Y. C.P.L.R. section 302(a)(3)(ii).[121] Those elements are:

> 1) defendant committed a tortious act outside the State; 2) the cause of action arises from that act; 3) the act caused

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118. *See, e.g., Penguin Grp.,* 609 F.3d at 35; Capitol Records, LLC v. VideoEgg, Inc., 611 F. Supp. 2d 349, 362 (S.D.N.Y. 2009), *and* Citigroup Inc. v. City Holding Co., 97 F. Supp. 2d 549, 567-68 (S.D.N.Y. 2000), (analyzing personal jurisdiction over an alleged copyright infringer under N.Y. C.P.L.R. section 302(a)(3)(ii)).

119. If the defendant transacts or solicits business, commits a tortious act or owns any real property within New York, N.Y. C.P.L.R. sections 302(a)(1, 2, 4) respectively, would be available for use in conferring personal jurisdiction. Thus, these factual limitations are typical of a N.Y. C.P.L.R section 302(a)(3) analysis.

120. *LaMarca*, 735 N.E.2d. at 886-87.

121. N.Y. C.P.L.R. § 302 provides in part that:

> (a) a court may exercise personal jurisdiction over any non-domiciliary . . . who . . .
>
> 3. commits a tortious act without the state causing injury to person or property within the state . . . if he
>
> (ii) expects or should reasonably expect the act to have consequences in the state and derives substantial revenue from interstate or international commerce.

> injury to a person or property within the State; 4) defendant expected or should reasonably have expected the act to have consequences in the State; and 5) defendant derived substantial revenue from interstate or international commerce.[122]

These elements must be satisfied for courts to properly exercise jurisdiction.

1. Defendant Committed a Tortious Act Outside of the State

Where copyright infringement has occurred, it is settled New York law that the infringer has committed a tortious act at the location of the infringement.[123] In order to make a *prima facie* showing of copyright infringement and thus satisfy the first element of N.Y. C.P.L.R. section 302(a), the plaintiff must show that "(1) the plaintiff owns the copyright or copyrights at issue; and (2) the third party infringed the copyrights by unauthorized copying or distribution."[124]

Furthermore, the plaintiff must generally only introduce into evidence a copyright registration certificate to complete his *prima facie* showing that he is the copyright holder,[125] this element will generally be satisfied and need not be discussed further.[126] Additionally, the underlying technologies of the BitTorrent protocol dictate that users who download files using this method are simultaneously copying those files as well as distributing them,[127] which are two distinct copyright violations.[128] Moreover,

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122. *LaMarca*, 735 N.E.2d. at 886.

123. *See Penguin Grp.*, 609 F.3d at 35.

124. Arista Records LLC v. Lime Group LLC, 784 F. Supp. 2d 398, 423 (S.D.N.Y. 2011).

125. In any judicial proceeding the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. 17 U.S.C. § 410(c) (West 2013).

126. For a more in-depth discussion of the necessary elements of a copyright holder's prima facie case, *see* 18 AM. JUR. 2d *Copyright and Literary Property* § 227.

127. *See* United States v. Am. Soc'y of Composers, Authors & Publishers, 485 F. Supp. 2d 438, 441 (S.D.N.Y. 2007) ("Downloading is the transmission of a

as ownership and actual infringement are easily satisfied in this kind of case, a court will likely hold that the defendant committed a tortious act outside of the state for the purpose of a N.Y. C.P.L.R. section 302 analysis.

2. The Cause of Action Arises from the Out-of-State Tortious Act

Because C.P.L.R. 302(a)(3) is essentially a self-defining category for tortious acts, this prong is satisfied as long as the copyright holder alleges that the harm he has suffered is due to the out-of-state tortious act.[129] Thus, in the case of an alleged act of out-of-state copyright infringement, where the resulting economic injury is to an in-state plaintiff, this prong is satisfied.

3. The Act Caused Injury to a Person or Property within the State

In copyright infringement cases involving the uploading of copyrighted works to the Internet, the New York Court of Appeals has determined that the situs of the injury is the location or the principal place of business of the copyright holder.[130] Because

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digital file over the internet from a server computer, which hosts the file, to a client computer, which receives a copy of the file during the download . . .the client establishes a connection to the server, which transmits the file over the internet to the client, where the file is saved-generally stored on the client's hard drive-for future use . . . ."); *See also Beginner's Guide*, BITTORRENT,(last visited Oct. 26, 2013), http://www.bittorrent.com/help/guides/beginners-guide.("BitTorrent is a protocol [a set of rules and description of how to do things] allowing you to download files quickly by allowing people downloading the file to upload [distribute] parts of it at the same time").

128. *See* 17 U.S.C. § 106 (West 2013) ("[only] the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:(1) to reproduce the copyrighted work . . . ; and (3) to distribute copies . . . of the copyrighted work to the public by sale or other transfer of ownership . . . .").

129. *See* N.Y. C.P.L.R. § 302 (McKinney 2008).

130. Penguin Grp. (USA) Inc. v. Am. Buddha, 946 N.E.2d 159, 163-64 (N.Y. 2011) (explaining that although it may make sense in traditional commercial tort cases to equate a plaintiff's injury with the place where its business is lost or

downloading files using the BitTorrent protocol necessarily involves uploading those files to other BitTorrent users as well,[131] New York courts will likely conclude that New York residents and businesses that hold the copyrights have suffered injury within the state. Thus, an out-of-state defendant who downloads a New York copyright holder's work has injured that copyright holder in New York for the purposes of determining personal jurisdiction.

Although, in determining that the situs of the injury is the location of the copyright holder, the New York Court of Appeals placed great weight on the intent of the infringer,[132] New York courts will still likely conclude that this element is satisfied. For example, although *Penguin Group* dealt with an infringer who intended to make the copyrighted works available to the general public, including residents of New York, courts will likely arrive at the same conclusion when dealing with BitTorrent users since it takes considerable expertise to utilize the protocol,[133] showing that users of the BitTorrent protocol know what they are doing.

4. Defendant Expected or Should Reasonably Have Expected the Act to Have Consequences in the State

New York courts should not conclude that a BitTorrent user who downloads a copyrighted work using the BitTorrent protocol expected or should reasonable expect, or foresee, the act to have consequences within the state. When analyzing this prong of the long-arm statute, courts have required "tangible manifestations" of

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threatened, it is illogical to extend that concept to online copyright infringement cases where the place of uploading is inconsequential and where it is difficult, if not impossible, to correlate lost sales to a particular geographic area).

131. *See Frequently Asked Questions*, *supra* note 15.

132. *Penguin Grp.*, 946 N.E.2d at 165 ("The location of the infringement in online cases is of little import inasmuch as the primary aim of the infringer is to make the works available to anyone with access to an Internet connection, including computer users in New York.").

133. *See generally Setup Guide*, BITTORRENT, http://www.bittorrent.com/help/guides/beginners-guide (last visited Oct. 26, 2013) (explaining how to specify the upload speed, forward the correct ports, and test the configuration).

a defendant's intent or "concrete facts known to the nondomiciliary that should have alerted it" to the possibility of being hauled into court in New York.[134] In the context of intellectual property infringement via the Internet, this has essentially been construed to mean actual knowledge of the copyright and the identity of its holder as well as its location.[135]

For example, in *Royalty Network*, the court held that the defendant, an operator of a website that made the plaintiff's copyrighted works available for download, could not have reasonably foreseen consequences in New York, because there was nothing in the record to indicate that it had knowledge that the plaintiff had been assigned the rights in the copyright at issue, even though the defendant was fully aware the works were copyrighted.[136] Although, in *McGraw-Hill*, the court held that "[it] is reasonably foreseeable that the provision of materials that infringe the copyrights and trademarks of a New York company will have consequences in New York,"[137] in that case the defendant had direct dealings with the plaintiff and knowledge of its copyrights.[138]

Due to the nature of the process of downloading a file via BitTorrent, it is unlikely that a copyright holder alleging infringement will be able to plead facts showing sufficient tangible manifestations of the defendant's intent or concrete facts known to the downloader that would have alerted him to the possibility of being sued in New York. In order to initiate a typical download

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134. Royalty Network Inc. v. Dishant.com, LLC, 638 F. Supp. 2d 410, 424 (S.D.N.Y. 2009).

135. *See generally id.* (holding that without something in the record to show defendants' knowledge that harm in New York was a reasonably foreseeable consequence of their conduct, this element was not satisfied); McGraw-Hill Companies, Inc. v. Ingenium Technologies Corp., 375 F. Supp. 2d 252, 256 (S.D.N.Y. 2005) (holding that the defendant who signed a licensing agreement with the plaintiff and then violated the plaintiff's intellectual property rights could reasonably foresee injury to the plaintiff at its principal place of business in New York).

136. *See Royalty Network*, 638 F. Supp. 2d at 424.

137. *McGraw-Hill*, 375 F. Supp. 2d at 256.

138. *Id.*

through BitTorrent, a user need only enter the name of the file he or she is looking for, accompanied by the term "torrent" in a search engine, initiate the search and click on a webpage with the torrent tracker file that he or she is looking for.[139] Next, the user clicks on the tracker associated with the file he or she wants.[140] Because this process does not furnish the user with any knowledge as to the copyright holder,[141] the plaintiff will fail in its assertion that the defendant expected or should reasonably expect the act to have consequences within New York.

Although as discussed above,[142] it may be argued that the alleged infringer intended to copy and distribute the copyrighted work to other forums via the BitTorrent process, without the showing of "tangible manifestations" or "concrete facts known to the nondomiciliary" the copyright holder cannot show that the alleged infringer knew of the connection to New York copyright holders, and thus this element should be held to be unsatisfied.

5. Defendant Derived Substantial Revenue from Interstate or International Commerce

The fifth element of N.Y. C.P.L.R. section 302 requires that the defendant derived substantial revenue from interstate or international commerce.[143] The reasoning behind this element is an attempt to ensure that the assertion of personal jurisdiction would be fair, because a defendant "engaged in extensive business activities on an interstate or international level" is "generally

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139. *See Glossary*, BITTORRENT, http://www.bittorrent.com/help/manual/glossary ("A torrent is small file containing metadata from the files it is describing. In other contexts, it is sometimes used to refer to the swarm connected around that small file.") (last visited Oct. 26, 2013); *See id.* ("A tracker is something that a client connects to in order to share its IP and port, as well as obtain information, including peer lists.").

140. *Downloading With BitTorrent*, BITTORRENT, http://www.bittorrent.com/help/manual/chapter0204 (last visited Oct. 26, 2013).

141. *See, e.g.*, THE PIRATE BAY, http://thepiratebay.sx/browse (last visited Oct. 26, 2013)(providing an example of a website that hosts torrent files).

142. *See supra* Part II.

143. *See* N.Y. C.P.L.R. 302(a)(ii)(McKinney 2008).

equipped to handle litigation away from his business location" and thus, C.P.L.R. section 302(a)(3)(ii) does not encompass non-domiciliaries "whose business operations are of a *local* character."[144] Because this element has typically only been satisfied by large business entities and not by individuals,[145] courts should not conclude that a single BitTorrent user falls into this category.

Because New York courts are unlikely to conclude that the fourth and fifth elements of the long-arm statute have been satisfied, they will never even reach the question of whether they can assert personal jurisdiction under the Due Process Clause.

B. DUE PROCESS CLAUSE

Although New York courts have a long-arm statute that does not extend to the outer limits of the Due Process Clause, some states do.[146] Therefore, these states must only determine whether the court's personal jurisdiction over a non-domiciliary defendant alleged to have committed copyright infringement using the BitTorrent protocol will comport with due process.[147] A court may only exercise jurisdiction over an out-of-state defendant and comport with due process, provided that the defendant has "certain minimum contacts with [the forum state] such that the maintenance

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144. N.Y.JUD.CONF., 12th Ann. Rep. 339, 342-43 (1967).

145. *Compare In re* N.Y. Cnty. DES Litig., 615 N.Y.S.2d 882 (N.Y. App. Div. 1994) (allowing DES victims who were injured in New York to sue a California manufacturer of DES whose product was marketed only in states west of the Mississippi), *with* Ingraham v. Carroll, 687 N.E.2d 1293, 1296 (N.Y. 1997) (discussing that the "diversity of the physician's pool of patients," whether the patients cross state lines to see him as a result of vacations, the physician's proximity to the border, or referrals based on the reputation of the physician as a specialist "cannot convert an otherwise local practice to an interstate business activity.").

146. *See, e.g.*, CAL. CIV. PROC. CODE § 410.10 (West 2007) ("A court of this state may exercise jurisdiction on any basis not inconsistent with the Constitution of this state or of the United States.")

147. *See LaMarca*, 735 N.E.2d. at 886. *See also* U.S. CONST. amend. XIV, § 1.

of the suit does not offend 'traditional notions of fair play and substantial justice.'"[148]

1. Minimum Contacts

The Supreme Court has held that while foreseeability is not irrelevant, in order to meet the "certain minimum contacts" prong of *International Shoe*, something more than foreseeability is required.[149] Rather, the defendant must "purposefully avail[] itself of the privilege of conducting activities within the forum State," making it reasonably foreseeable to be sued there.[150] For example, although the first issue under C.P.L.R. section 302(a)(3)(ii), discussed above, is whether the defendant reasonably could foresee injury in New York, the due process clause goes beyond that and requires that the defendant must reasonably anticipate defending an action as a result of purposeful conduct directed toward the state, the "purposeful availment" requirement.[151] Thus, foreseeability plus some other affirmative act directed at the forum state is necessary.

First, it has already been explained above that courts should not conclude that the defendant could have foreseen being hauled into court in a foreign state for clicking on a link and subsequently downloading a file.[152] But, even if a court did hold that the defendant could have foreseen the injury in another forum, the court must still forestall exercising personal jurisdiction for lack of any affirmative action directed at the forum state.

Alternatively, while courts do not hold that Internet "presence" subjects a non-resident defendant to jurisdiction everywhere, if a defendant's substantial Internet presence within the forum state is established, that presence can be viewed as an additional contact justifying the exercise of personal jurisdiction when other, more

148. Int'l Shoe Co. v. Washington. 326 U.S. 310, 316 (1945).
149. *See* World-Wide Volkswagen Corp. v. Woodson, 444 U.S. 286 (1980).
150. *Id.* at 297.
151. *Id.*
152. *See supra* Part I,D.

traditional contacts also are present.[153] Because BitTorrent users, individually, do not have any form of substantial Internet presence within the meaning of that definition, and because those other, more traditional, contacts will not likely be present if a copyright holder plaintiff is relying on a long-arm statute, no amount of BitTorrent use can justify exercising jurisdiction over the nondomiciliary BitTorrent defendant.

2. Traditional Notions of Fair Play and Substantial Justice

Although courts should not conclude that a BitTorrent user's downloading of a work in a particular forum constitutes sufficient minimum contacts, for the purposes of further illustrating the point, the second, fair play and substantial justice, prong of the Due Process requirements need to be examined. In order to determine whether the "traditional notions of fair play and substantial justice" component of the due process clause has been met, courts will look to the *Burger King* and *Asahi* cases for guidance.[154] This due process component essentially asks whether it is reasonable to assert jurisdiction over the defendant.[155] In *Asahi*, the Court held that in order to determine the reasonableness of exercising jurisdiction, several factors must be examined: 1) the burden on the defendant; 2) the interests of the forum State; 3) the plaintiff's interest in obtaining relief; 4) the interstate judicial system's interest in obtaining the most efficient resolution of controversies; and 5) the shared interest of the several States in furthering fundamental substantive social policies.[156] Because a balancing of these factors will weigh heavily against the reasonableness of pulling the defendant into the forum state, courts will likely hold

153. *See* Stephen J. Newman, *Proof of Personal Jurisdiction in the Internet Age*, 59 AM. JUR. PROOF OF FACTS 3d 1 (Originally published in 2000).

154. *See, e.g.*, LaMarca v. Pak-Mor Mfg. Co., 735 N.E.2d 883, 888 (N.Y. 2000); Burger King Corp. v. Rudzewicz, 471 U.S. 462 (1985); Asahi Metal Indus. Co. v. California, 480 U.S. 102 (1987).

155. *LaMarca*, 735 N.E.2d at 888.

156. See *Asahi*, 480 U.S. at 113.

that asserting jurisdiction over the alleged copyright infringer does not comport with due process.

3. Burden on the Defendant

Here, the burden on the BitTorrent user will be somewhat dependent on where the user is actually located. However, it is highly unlikely that a court would weigh this factor in favor of a defendant, unlike the defendant in *Asahi*, a Japanese tire valve component manufacturer who would have had to travel to a court in California where it would need to defend itself in an action in a foreign legal system,[157] a BitTorrent user alleged to have committed copyright infringement would probably be domestic and would presumably have at least some familiarity with the United States legal system.

C. INTERESTS OF THE FORUM STATE

States have a strong interest in providing a convenient forum for their copyright holders. For example, New York would have a strong interest in providing a forum for a New York copyright holder who has suffered economic injury in New York as a result of a BitTorrent user's infringement should be entitled to relief under New York law. By contrast, in *Asahi*, the main action involving the United States citizen had been settled and the only remaining claim was the Taiwanese defendant's indemnification claim against Asahi, a claim that could just as easily be settled in Taiwan, where the transaction that gave rise to the litigation took place.[158] However, this analysis can change. For instance, in a copyright infringement action, the plaintiff does not necessarily have to be a resident of the forum state or incorporated in the forum state and this is often the case. In summation, if the copyright holder is a resident or has its business in the forum state, this factor weighs heavily in favor of the plaintiff. However, if the plaintiff is

157. *Id.* at 106
158. *Id.* at 114.

simply attempting to use the courts of the forum state to extract settlements from the forum state's residents as well as residents of foreign states, courts should weigh this factor heavily against the Copyright Troll. Thus, this factor is fact specific and courts must scrutinize the motivations of the copyright holder in analyzing this factor within the context of mass copyright infringement suits.

1. Plaintiff's Interest in Obtaining Relief

Again, in weighing this factor the court should look to the fact and circumstances surrounding the copyright holder in determining its motivations. In *Asahi*, the court discussed the fact that "[defendant had] not demonstrated that it is more convenient for it to litigate its indemnification claim against Asahi in California rather than in Taiwan or Japan."[159]

Like *Asahi*, here, several factors need to be considered in asserting jurisdiction. First, the identity of the copyright holder should be examined. A citizen or business organization of the forum will want to litigate in its home state for convenience, however this factor is nullified if the copyright holders are availing themselves of the courts of a particular forum and are attempting to pull more defendants into that forum for the copyright holder's convenience. This being the case, like in *Asahi*, a Copyright Troll will have a difficult time convincing the court that its more convenient for it to litigate in the particular forum when it could just as easily litigate in the forum where the defendant is subject to general jurisdiction. Although, because of the nature of BitTorrent file transfers, it is probable that the copyright holder will seek to recover from more than one defendant.[160] If the copyright holder chooses to do so, being able to join multiple defendants, or in the alternative bringing multiple separate actions against them, the

159. *Id.*

160. *See, e.g.*, Next Phase Distrib., Inc. v. John Does 1-27, 284 F.R.D. 165 (S.D.N.Y. 2012) (attempting to join twenty-seven defendants); Malibu Media, LLC v. John Does 1-5, 285 F.R.D. 273 (S.D.N.Y. 2012) (attempting to join five defendants); Digital Sin, Inc. v. Does 1-176, 279 F.R.D. 239 (S.D.N.Y. 2012) (attempting to join 127 defendants).

ability to bring all of the claims in one centralized location will allow the plaintiff to conserve litigation resources.[161] Although joinder may be convenient for the Copyright Troll, courts should consider the alternative to conferring jurisdiction. Indeed, the alternative to bringing all of the claims in a single forum is to force the Copyright Troll to bring the claims in each of the forums where the individual defendants reside, thereby giving the Copyright Troll an incentive to only pursue meritorious claims rather than pursuing litigation with no other purpose than the extraction of settlements. Because of the foregoing reasons, courts should weigh this factor heavily against asserting personal jurisdiction over the non-domiciliary defendant.

2. Interstate Judicial System's Interest in Obtaining the Most Efficient Resolution of Controversies

In evaluating the fourth factor, courts will consider where the witnesses and evidence are likely to be located in relation to the forum state.[162] In a BitTorrent copyright infringement action, both the computer hardware and related networking components that were used to allegedly make and distribute copies of the copyrighted works, as well as witnesses, are likely to be located wherever the BitTorrent user resides. The difficulty of transporting physical evidence and witnesses must be weighed heavily, in spite of the fact that much of the evidence relating to the digital transmission and the proof of copyright themselves are documentary in nature.[163] However, because the goal of the inquiry is to determine the most efficient resolution of controversies, the ability to consolidate actions rather than potentially burdening numerous forums by requiring multiple actions, should weigh this factor in favor of asserting jurisdiction.

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161. Even if a plaintiff could not join all of the defendants, it would still save a great amount of resources on travel expenses, as the defendants could be scattered throughout the country.

162. *See* Metro. Life Ins. Co. v. Robertson-Ceco Corp., 84 F.3d 560, 574 (2d Cir. 1996).

163. *See* Kernan v. Kurz-Hastings, Inc., 175 F.3d 236, 245 (2d Cir. 1999).

3. Shared Interest of the Several States in Furthering Fundamental Substantive Social Policies

This last factor requires courts to consider the common interests of the several states in promoting substantive social policies.[164] In weighing this factor, courts will require the parties to show or suggest "substantive social policies [that] would be furthered or undermined by permitting the case . . . to go forward in [the forum.]"[165] In mass BitTorrent copyright infringement litigation, the fundamental substantive social policy of preventing abusive litigation tactics has been raised on innumerable occasions,[166] as well as policy arguments made in the context of disputes against early discovery and joinder of parties.[167] Thus, because they are compelling and significant to this area of litigation, policy arguments are likely to convince a court to prevent a case from being deliberated in its forum and, instead, favor litigation in a more appropriate forum.

Weighing these five factors, with the second, third, and particularly the fifth factor weighing heavily against favoring the exercise of jurisdiction, courts should not find that jurisdiction is reasonable under the Due Process Clause analysis.

However, Copyright Trolls have also argued that the highly interwoven nature of the BitTorrent protocol justifies the exercise of personal jurisdiction over every defendant if the court can constitutionally exercise personal jurisdiction over just one individual defendant.[168] This argument is based on a false assumption rooted in a misunderstanding of the BitTorrent protocol, which is that each individual user is simultaneously

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164. *Metro. Life Ins. Co.*, 84 F.3d at 575.

165. *Kernan*, 175 F.3d at 245.

166. *See* In re BitTorrent Adult Film Copyright Infringement Cases, Nos. 11-3995(DRH)(GRB), 12-1147(JS)(GRB), 12-1150(LDW)(GRB), 12-1154(ADS)(GRB), 2012 WL 1570765 (E.D.N.Y. May 1, 2012) (discussing the potential coercive extraction of settlements from plaintiffs and avoidance of court filing fees).

167. *Id.*

168. DigiProtect USA Corp. v. Does 1-240, No. 10 CIV. 8760(PAC), 2011 WL 4444666 (S.D.N.Y. Sept. 26, 2011).

connected to all of the other users in a swarm.[169] As discussed above, members of the swarm are only connected to a finite group of other member of the swarm. As the court in *DigiProtect* correctly pointed out, "this technology may make it possible for two strangers to enable each other to commit infringement without even knowing it, this mere possibility does not suggest that it has actually occurred; they may have participated in entirely different swarms."[170] Furthermore, and perhaps most illustrative of the flaws in this reasoning, is that it is only possible for users to participate in swarms when they are connected to the Internet. Thus, unless every defendant was connected to the Internet and connected to the tracker at the same time, the argument rapidly deteriorates.

CONCLUSION

Many of the suggestions made in this Note regarding how courts should decide mass BitTorrent copyright infringement litigation are based on an understanding of the technical underpinnings of the BitTorrent protocol, which many may not find persuasive. One of the reasons why issues of jurisdiction, joinder, and their associated defenses are still, for the most part, largely undecided is because the many of the Copyright Troll cases discussed above have never been tried on their merits. Indeed, these cases have all been settled or dismissed when the feasibility of profitability is diminished. One judge, however, refuses to tolerate the perpetuation of this system.

On October 3, 2012, District Judge Baylson for the Eastern District of Pennsylvania issued a ruling which forced *Malibu Media, LLC v. John Does 1-16* out of the "John Doe" phase and into the trial phase of litigation.[171] Although he acknowledged that

169. Complaint at ¶ 10, DigiProtect USA Corp. v. Does 1-240, (S.D.N.Y. Nov. 19, 2010) (No. 10 CV 8760) 2010 WL 4823575 ("[E]very user simultaneously receives information from and transfers information to one another . . . more or less simultaneously and in concert with one another, thus connecting peers physically present in this jurisdiction to peers elsewhere in a shared and mutually supportive network of unlawful copying.").

170. *DigiProtect USA Corp.*, 2011 WL 444666, at * 8-9.

171. Houstonlawy3r, *Going to Trial: Good!*, TORRENTLAWYER (Oct. 18, 2012), http://torrentlawyer.wordpress.com/2012/10/18/malibu-media-troll-going-

there are many practical reasons for granting a "Doe" Defendant's motion to sever,[172] Judge Baylson decided to force all five defendants that moved for severance and the copyright holder to litigate.[173] Judge Baylson, acknowledging that he was penalizing the moving defendants to an extent, put measures in place to protect their identities, in addition to forcing the trial forward. These measures included: issuing a protective order preventing the disclosure of the defendants' identities during discovery, requiring service of the complaint on the defendants within ten days, requiring an answer from the defendants within fourteen days of service, requiring initial discovery requests within 14 days of service of the complaint, and requiring that the final disposition of the case on the merits be within six months.[174] Furthermore, Judge Baylson warned that "[i]f Plaintiff decides instead to continue to "pick off" individual John Does, for confidential settlements, the court may draw an inference that Plaintiff is not serious about proving its claims, or is unable to do so."[175] Additionally, recognizing the burden on the defendants, Judge Baylson stressed that:

> the five John Does will have adequate remedies to recover most, if not all, of these litigation expenses and/or damages from Plaintiff, such as a Rule 54 motion for costs, a lawsuit for abuse of civil process, a Rule 11 motion for sanctions, and a motion to recover excessive costs under 28 USC § 1927. More fundamentally, as

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to-trial-good/.

172. The practical reasons cited for granting severance were "(i) the likelihood that each John Doe defendant will assert different defenses, thereby adding factual and legal questions that are not common among all defendants, (ii) many John Doe defendants are proceeding pro se, and will therefore incur significant expense serving papers and attending depositions of all other parties to the lawsuit, (iii) the likelihood that many of the John Doe defendants are not the actual individuals who illegally downloaded the motion pictures in question, (iv) the likelihood that joinder will facilitate coercive settlements among the John Doe defendants; and (v) plaintiff's avoidance of paying filing fees by pursuing mass actions." Malibu Media, LLC v. Does 1-16, 902 F.Supp.2d 690, 700 (E.D. Pa. 2012).

173. *Id.* at 701-2.

174. *Id.* at 703-4

175. *Id.* at 701

> mentioned above, because this is a copyright case, a successful defense will likely result in an award of attorney's fees to any John Doe who prevails under 17 U.S.C. § 505.[176]

Additionally, Judge Baylson ordered that "[a]ll proceedings against the remaining John Does will be stayed until further order of the Court."[177]

After Judge Baylson determined that a "Bellwether" trial would be the best way to proceed, based on the plurality of these kinds of infringement actions, a non-jury trial was held on June 10, 2013.[178] Based on testimony presented at that trial, Judge Baylson correctly stated "I now believe that joinder of multiple defendants in a single complaint alleging copyright infringement through the use of BitTorrent technology is neither necessary nor appropriate."[179] He continued, stating that "members of BitTorrent 'swarms' are not essential parties for copyright infringement suits involving BitTorrent technology because the 'swarm is formed automatically by the software, and not by any actual association of these defendants."[180] Finally, after stressing factors disfavoring joinder in these types of cases, such as case management problems, delays, plaintiff avoidance of separate filing fees, and the increased pressure on defendants to settle, Judge Baylson concluded that "I recommend against requiring joinder under Rule 19 and also against allowing it under Rule 20(a)."[181]

Because Judge Baylson effectively forced the plaintiffs to litigate, he was able to reach final dispositions on issues that, because of the high likelihood of never reaching the trial stage, may have continued to go unanswered. The results of this case should provide invaluable guidance for courts presiding over future BitTorrent and Copyright Troll litigation. Hopefully, other judges

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176. *Id.* at 702-3

177. *Id.*

178. Malibu Media, LLC v. John Does 1, 6, 13, 14, 950 F.Supp.2d 779, 780 (2013).

179. *Id.* at 784.

180. *Id.*

181. *Id.*

will follow Judge Baylson's example, force these issues to be litigated, and assist in resolving many of the uncertainties surrounding this area of the law.

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