

RECENT DEVELOPMENTS

PLAYBOY ENTERPRISES v. CHUCKLEBERRY PUBLISHING: THE SOUTHERN DISTRICT COURT OF NEW YORK SEPARATES THE “MEN” FROM THE “BOYS” ON THE INTERNET

When Tattilo Editrice, S.p.A. (Tattilo), an Italian publisher of the Italian male sophisticate magazine, *Playmen*, announced plans to begin publishing in the United States in 1979, Playboy Enterprises, Inc. (PEI), publisher of *Playboy* magazine, sought and received an injunction permanently enjoining Tattilo from using the word “Playmen” in a title or subtitle of any male sophisticate magazine published, distributed, or sold in the United States.¹ In January of 1996, PEI discovered that Tattilo had established a World Wide Web (WWW) site on the Internet featuring *Playmen Pro* and *Playmen Lite*.² These web sites contained the Italian magazine’s cover, its “Women of the Month” spread, sexually explicit photographs, and special discounts on other Tattilo products.³ PEI filed suit in the United States District Court for the Southern District of New York, alleging that Tattilo was in contempt of the 1981 injunction, which enjoined Tattilo from distributing any products in the United States using the name “Playmen.”⁴ The district court, Judge Shira Scheindlin, held that the web site, accessible in the United States, constituted distribution under the 1981 injunction and, thus, Tattilo was in contempt. *Playboy Enterprises v. Chuckleberry Publishing, Inc.*, 939 F. Supp. 1032 (S.D.N.Y. 1996).

“The Internet is not a physical or tangible entity, but rather a giant network which interconnects innumerable smaller groups of linked computer networks. It is thus a network of networks.”⁵ Born as

1. See *Playboy Enters. v. Chuckleberry Publ’g, Inc.*, 687 F.2d 563, 564 (2d Cir. 1982).

2. See *Playboy Enters. v. Chuckleberry Publ’g, Inc.*, 939 F. Supp. 1032, 1033-34 (S.D.N.Y. 1996). Tattilo’s web site, “<http://www.playmen.it>,” was created and maintained in Italy. It featured *Playmen Lite*, a free service displaying moderately explicit photographs, and *Playmen Pro*, a more sexually explicit site which could not be accessed until the user paid a subscription fee that required the user to fax a form to Tattilo in Italy. The subscriber then received a username and password via e-mail. On reconsideration, *Playmen Lite* was found to be an advertisement for *Playmen Pro*. Essentially, the two services were deemed by the court to be one and the same; that is, both services constituted the *Playmen* Internet site. See *id.* at 1044.

3. See *id.* at 1035.

4. See *id.* at 1033.

5. *ACLU v. Reno*, 929 F. Supp. 824, 830 (E.D. Pa. 1996).

ARPANET in 1969, the Internet was developed by U.S. defense contractors conducting military/defense related research.⁶ The Internet has since expanded so that current estimates of the number of users range from 25 to 100 million people,⁷ and it is expected to expand to 200 million users by 1999.⁸

No single entity—academic, corporate, governmental, or non-profit—administers the Internet. It exists and functions as a result of the fact that hundreds of thousands of separate operators of computers and computer networks independently decided to use common data transfer protocols to exchange communications and information with other computers. . . . There is no centralized storage location, control point, or communications channel for the Internet, and it would not be technically feasible for a single entity to control all of the information conveyed on the Internet.⁹

Individuals can access the Internet through universities, employers, “free-nets,”¹⁰ local libraries, commercial on-line services,¹¹ and bulletin board systems (BBS).¹² Once a user has accessed the Internet, he or she uses an information retrieval system, such as the WWW, to locate a site, home page, or other information.¹³

The WWW contains a variety of documents stored in various formats—from text to images to sounds.¹⁴ All of the document sites have

6. *See id.* at 831.

7. *See* Richard S. Zembek, *Jurisdiction and the Internet: Fundamental Fairness in the Networked World of Cyberspace*, 6 ALB. L.J. SCI. & TECH. 339, 344 (1996) (citations omitted).

8. *See* *ACLU*, 929 F. Supp. at 831.

9. *Id.* at 832.

10. *See id.* at 833. “Free-nets” are community networks that provide a local link to the Internet for citizens. *See id.*

11. *See id.* These include such providers as America Online, CompuServe, the Microsoft Network, and Prodigy. *See id.*

12. *See id.* at 833-34. Bulletin board systems allow a subscriber to dial in to a local line where they are connected with the BBS. The BBS is then connected to the Internet provider. The services can be set up by anyone with the right equipment—from a single person to a corporation. Thus, the BBS’s are a sort of medium or conduit to access the Internet. *See id.*

13. *See id.* at 836.

14. *See id.*

an address.¹⁵ Entities can then “publish”¹⁶ information on the Internet which can be accessed by end users.

Once a provider posts its content on the Internet, it cannot prevent that content from entering any community. Unlike the newspaper, broadcast station, or cable system, Internet technology necessarily gives a speaker a potential worldwide audience. Because the Internet is a network of networks . . . , any network connected to the Internet has the capacity to send and receive information to any other network.¹⁷

Further, it is estimated that forty percent of Internet content originates outside the United States.¹⁸

[M]odern communication has reduced the world’s vastness into mere geographical lines, crossed over millions of times each second, without either a sovereign’s or traveler’s awareness. Unlike the physical journeys of the past, today’s world exploration most often occurs via computer modem and the world’s network of networks—the [I]nternet. Individuals sign on to the [I]nternet and surf through ‘cyberspace,’ often without an awareness or realization that they have legally traveled outside of their home.¹⁹

This potential to reach a global market with the click of a mouse has proven alluring to many commercial enterprises.²⁰ In the past few years, a number of lawsuits involving the use of the Internet have arisen.²¹ Several cases specifically examine the issue of using the Internet to “distribute.”²²

15. *See id.* Here, *Playmen*’s address was “http://www.playmen.it.” “Playmen” signifies the name of the magazine, while “.it” signals that the site originates in Italy. *See Chuckleberry*, 939 F. Supp. at 1035.

16. *See ACLU*, 929 F. Supp. at 837. “When information is made available, it is said to be ‘published’ on the Web.” *See id.*

17. *See id.* at 844.

18. *See id.* at 848.

19. Zembek, *supra* note 7, at 343 (citations omitted).

20. This is clearly shown by the rapid development of web sites and home pages. *See generally* Zembek, *supra* note 7.

21. For examples, see *infra* note 86.

22. *See, e.g., Religious Tech. Ctr. v. Netcom On-Line Communication Servs., Inc.*, 907 F. Supp. 1361 (N.D. Cal. 1995); *Sega Enters. v. Maphia*, 857 F. Supp. 679 (N.D. Cal. 1994); *Playboy Enters. v. Frena*, 839 F. Supp. 1552 (M.D. Fla. 1993).

The first U.S. case to address the issue of what constitutes distribution on the Internet also arose from a lawsuit filed by PEI.²³ In *Playboy Enterprises v. Frena*, the Middle District Court in Florida considered the unauthorized use of *Playboy* photographs on a BBS.²⁴ From his home, George Frena operated a BBS containing *Playboy* photographs, which were used without PEI's permission.²⁵ Subscribers could view and download the photos, as well as add to the BBS by uploading their own images.²⁶ Although Frena contended that the images were placed on the BBS by subscribers without his knowledge,²⁷ the court found Frena liable for the unauthorized public distribution of copyrighted materials.²⁸ Notably, this ruling was delivered despite the fact that Frena did not personally create any unauthorized copies.²⁹ The *Frena* court indicated that the critical factor in the case was that the defendant actually supplied a product that contained unauthorized copies of protected images.³⁰ "It does not matter that Defendant Frena claims he did not make the copies itself [sic]."³¹

Several months later, in *Sega Enterprises Ltd. v. Maphia*, a district court in California addressed the same issue.³² In this case, the defendants operated a computer BBS which they used to distribute *Sega* brand video games without authorization.³³ The defendants provided downloading privileges to subscribers who were required to either upload additional *Sega* games, programs, or information, or to pay for other goods advertised on the BBS.³⁴ The *Sega Enterprises* court followed *Frena*, holding that "[e]ven if defendants do not know exactly when games will be uploaded to or downloaded from the MAPHIA bulletin board, their role in the copying, including provision of facilities, direction,

23. See *Frena*, 839 F. Supp. at 1552.

24. See *id.* at 1554.

25. See *id.*

26. See *id.* One hundred and seventy of the photographs were copies of pictures taken from PEI's copyrighted materials. See *id.* at 1554, 1559. Further, PEI's text, name, and symbol were all removed from the images, only to be replaced by the defendant's business name and phone number. See *id.* at 1559.

27. See *id.* at 1559.

28. See *id.* at 1561. Frena argued "that he, innocently and without malice, allowed subscribers to upload whatever they wanted onto [the] BBS." *Id.* at 1559.

29. See *id.* at 1556-57, 1559.

30. See *id.* at 1556.

31. *Id.* (citing JAY DRATLER, JR., INTELLECTUAL PROPERTY LAW: COMMERCIAL, CREATIVE AND INDUSTRIAL PROPERTY § 6.01[3], at 6-15 (1991)).

32. *Sega Enters. v. Maphia*, 857 F. Supp. 679 (N.D. Cal. 1994).

33. See *id.* at 683-84.

34. See *id.*

knowledge and encouragement, amounts to contributory copyright infringement.”³⁵

However, the following year, the same district court held that a computer BBS and its Internet access provider were *not* liable for copyright infringement committed by a BBS subscriber.³⁶ In *Religious Technology Center v. Netcom*, a BBS subscriber, Dennis Erlich, posted portions of the copyrighted works of L. Ron Hubbard on the Internet in order to facilitate discussion and criticism of the Church of Scientology.³⁷ The Church sued not only Erlich, but also the BBS he utilized and its Internet access provider, Netcom.³⁸

In its decision, the *Religious Technology Center* court distinguished the case from both *Frena* and *Sega Enterprises*.³⁹ The court found that *Frena* was not applicable because the *Frena* court

was looking only at the exclusive right to distribute copies to the public, where liability exists regardless of whether the defendant makes copies. Here, however, plaintiffs do not argue that Netcom is liable for its public distribution of copies. Instead, they claim that Netcom is liable because its computers in fact made copies. Therefore, [*Frena*] . . . has no bearing on the issue of direct liability for unauthorized reproductions.⁴⁰

Furthermore, the court was unconvinced that the circumstances and holding in *Sega Enterprises* were sound justification for a finding of direct infringement where copies were made by users who upload files on the defendant’s BBS.⁴¹ The court cited evidence in the *Sega Enterprises* opinion indicating that the BBS operators in that case engaged in contributory, rather than direct, copyright infringement.⁴² Accordingly, the court concluded that neither *Frena* nor *Sega Enterprises* “requires

35. *Id.* at 686-87 (citing *Frena*, 839 F. Supp at 1555-56).

36. *See* *Religious Tech. Ctr. v. Netcom On-Line Communication Servs., Inc.*, 907 F. Supp. 1361, 1372 (N.D. Cal. 1995).

37. *See id.* at 1365. The Church of Scientology held the copyright interest in Hubbard’s works. *See id.*

38. *See id.*

39. *See id.* at 1370-71.

40. *Id.* at 1370.

41. *See id.* at 1371.

42. *See id.* “Contributory copyright infringement liability is based upon the defendant’s relationship to direct infringement; if the defendant was implicated in acts constituting direct infringement, it may be held liable for contributory infringement.” *Ez-Tixz, Inc. v. Hit-Tix, Inc.*, 919 F. Supp. 728 (S.D.N.Y. 1996).

finding Netcom liable for direct infringement of plaintiff's exclusive right to reproduce their works."⁴³

Applying its previous analysis of the *Frena* reproduction issue, the court examined the plaintiff's distribution and display arguments.⁴⁴ The court stated that "[o]nly the subscriber should be liable for causing the distribution of plaintiff's work, as the contributing actions of the BBS provider are automatic and indiscriminate."⁴⁵ Thus, the *Religious Technology Center* court maintained that only the subscriber who actually uploaded the infringing material may be held liable, because holding BBS and Internet access providers responsible for such actions would lead to "unreasonable liability."⁴⁶ The court reasoned that "[a]lthough copyright is a strict liability statute, there should still be some element of volition or causation which is lacking where a defendant's system is merely used to create a copy by a third party."⁴⁷

In the noted case, the district court began by quickly outlining the standard for holding a party in contempt.⁴⁸ Then, in a conclusory manner, the court asserted jurisdiction over Tattilo in order to enforce the 1981 injunction.⁴⁹ The court deemed Tattilo's lack of significant contacts to the United States irrelevant, handling the jurisdictional issue in a footnote.⁵⁰ It dismissed the fact that Tattilo is "an Italian corporation with no agent or office within the United States . . . [and that] it does not sell, distribute, publish, or advertise for its text-based Italian *Playmen* magazine in this country. However, this [c]ourt retained jurisdiction over Defendant for the purposes of enforcing the 1981 injunction."⁵¹

Tackling the issue at hand, the court addressed "whether the Defendant distributed or sold the *Playmen* magazine in the United States when it established an Internet site containing pictorial images under the

43. *Religious Tech. Ctr.*, 907 F. Supp. at 1372.

44. *See id.* at 1371-72.

45. *Id.* at 1372.

46. *See id.*

47. *Id.* at 1370.

48. *See Playboy Enters. v. Chuckleberry Publ'g, Inc.*, 939 F. Supp. 1032, 1036 (S.D.N.Y. 1996). "A court has the power to hold a party in civil contempt when (1) there is a 'clear and unambiguous' court order; (2) there is clear and convincing proof of noncompliance; and (3) the party has not attempted to comply in a reasonably diligent manner." *Id.* (citing *New York State Nat'l. Org. for Women v. Terry*, 886 F.2d 1339, 1351 (2d Cir. 1989), *cert. denied*, 495 U.S. 947 (1990)).

49. *See id.* at 1036 n.4.

50. *See id.*

51. *Id.*

'Playmen' name."⁵² The first question the court considered was "whether a fifteen-year-old injunction prohibiting certain traditional publishing activities should be applied to the recent development of cyberspace and the Internet."⁵³ The defendant argued that because the Internet did not exist in 1981 when the original injunction was issued, "the complained of activities [could not] be 'clearly and unambiguously' barred."⁵⁴ The court ultimately determined that, although the Internet was technically in existence in 1981, the use of images on the Internet could not have been considered by the court at the time the injunction was issued.⁵⁵ Despite this concession, the court concluded that even if the parties had not contemplated Internet use when the injunction was issued, this type of distribution was nevertheless barred because the purpose of the injunction "was to restrict the ability of the defendant to distribute its product in the United States, where it has been found to infringe upon the trademark of *Playboy*."⁵⁶ Thus, in order to uphold the spirit of the injunction, the injunction had to apply to Internet use as well.⁵⁷

The court then examined the actual injunction to determine if the three prongs of Provision 1(c) of the injunction were violated.⁵⁸ The court first considered whether the word "Playmen" was used as part of any trademark, service mark, brand name, trade name, or other business or commercial designation.⁵⁹ It found that there was evidence to support

52. *Id.* at 1036.

53. *Id.*

54. *Id.*

55. *See id.* at 1037. The court found that the Internet as it is today, an information highway, was not developed until the late 1980s. *See id.*

56. *Id.*

57. *See id.* Tattilo also attempted to argue that this decision should be left to the legislature. *See id.* To support this theory, Tattilo cited a Wisconsin case, which addressed the issue of whether a posting on an electronic bulletin board could be considered a "periodical." *See id.* (citing *It's In the Cards, Inc. v. Fuschetto*, 535 N.W.2d 11 (Wis. Ct. App. 1995)). The Wisconsin court in that case found the question was best left to the legislature and deferred. *See The Cards*, 535 N.W.2d at 14. However, the *Chuckleberry* court distinguished *The Cards* case because it dealt with interpretation of a legislative statute, whereas the noted case dealt with interpretation of a court order. *See Chuckleberry*, 939 F. Supp. at 1038.

58. *See Chuckleberry*, 939 F. Supp. at 1038. Provision 1(c) of the former injunction permanently enjoined the defendant from:

using "Playboy," "Playmen," or any other word confusingly similar with either such word in or as part of any trademark, service mark, brand name, trade name, or other business or commercial designation, in connection with the sale, offering for sale or distributing in the United States, importing into or exporting from the United States, English language publications and related products.

Id.

59. *See id.* at 1037.

this inquiry: that the Internet site's URL was "www.playment.it,"⁶⁰ that the word "Playmen" appeared prominently on the home page,⁶¹ and that the "Playmen" name and logo appeared on every page of the website.⁶² Secondly, the court determined that the "Playmen" name was used in connection with an English language publication or related product because the pictorial image on the Internet constituted a product.⁶³ This product, in turn, contained sufficient English sections to allow access for English-speaking users.⁶⁴

Finally, the court meticulously considered the third prong of the injunction provision.⁶⁵ The court addressed "whether uploading pictorial images onto a computer which may be accessed by other users constitutes a 'distribution.'"⁶⁶ In order to make that determination, the court looked at two cases:⁶⁷ *Frena*⁶⁸ and *Religious Technology Center*.⁶⁹ The court determined that the defendant did more than provide access to the Internet, it also provided its own services, *Playmen Lite* and *Playmen Pro*, and their content.⁷⁰ Further, the defendant encouraged use of these services, including image downloading, by equipping the web site with an option for users to view or download the images.⁷¹ Thus, the availability of the services and the invitation to download their images convinced the *Chuckleberry* court that this constituted a distribution.⁷² Finally, the

60. See *id.* at 1038. The acronym URL stands for "Uniform Resource Locator," which is the term used to indicate the specific address on the Internet where information may be obtained. For example, the URL of the *Tulane Journal of International and Comparative Law* is <www.law.tulane.edu/journals/jicl.htm>.

61. The court likened the home page to "the electronic equivalent of a magazine cover and table of contents." *Id.*

62. See *id.*

63. See *id.*

64. See *id.*

65. See *id.* at 1039.

66. *Id.*

67. See *id.*

68. *Playboy Enters. v. Frena*, 839 F. Supp. 1552 (M.D. Fla. 1993). The *Chuckleberry* court interpreted *Frena* to hold that "unauthorized uploading of copyrighted images, with the knowledge that the images would be downloaded by other bulletin board subscribers, constituted a distribution." *Chuckleberry*, 939 F. Supp. at 1039.

69. *Religious Tech. Ctr. v. Netcom On-Line Communication Servs.*, 907 F. Supp. 1361 (N.D. Cal. 1995). The *Chuckleberry* court interpreted *Religious Technology Center* as "refus[ing] to extend the *Frena* doctrine to an Internet access provider because [the provider defendant] Netcom did not create or control the content of the information available to its subscribers." *Chuckleberry*, 939 F. Supp. at 1039. The *Chuckleberry* court then agreed that it would be unfair to hold a "conduit" liable. See *id.* (citing *Religious Technology Center*, 907 F. Supp. at 1372).

70. See *Chuckleberry*, 939 F. Supp. at 1039.

71. See *id.*

72. See *id.* On motion for reconsideration, the court found significant the fact that the defendant charged for access to *Playmen Pro*. See *id.* at 1042. Furthermore, even though *Playmen*

court found that this distribution occurred in the United States because the defendant actively solicited in the United States.⁷³ This determination was supported by the fact that American subscribers were required to fax a form to Italy in order to receive a password and username via e-mail.⁷⁴

Having found that Tattilo's actions satisfied all the prongs of the distribution section of the injunction, the court held that Tattilo violated the 1981 injunction with its use of the Internet.⁷⁵ The court held:

While this court has neither the jurisdiction nor the desire to prohibit the creation of Internet sites around the globe, it may prohibit access to those sites in this country. Therefore, while Tattilo may continue to operate its Internet site, it must refrain from accepting subscriptions from customers living in the United States.⁷⁶

In so holding, the court decreed that “[c]yberspace is not a safe haven from which Tattilo may flout the [c]ourt’s injunction.”⁷⁷

Lite was a free service, it was held to be an advertisement for *Playmen Pro*. *See id.* Thus, they were held to be the same service. *See id.* at 1044. The court also reinforced its holding—that the web site constituted distribution—by recounting its previous findings, as well as by addressing a new argument posed by the defendant. *See id.* Tattilo alleged that *Playmen Lite* was not a violation of the injunction because it could be accessed without making contact with Tattilo (*i.e.*, obtaining a password or username). *See id.* The court, however, found that *Playmen Lite* was still in violation of the injunction due to the previous finding that the *Playmen Lite* constituted an advertisement for *Playmen Pro* and because it allowed users to download images. *See id.* In finding that the two services were actually one and the same, or the “Playmen Internet Service,” *Playmen Lite* was found to also be in violation of the injunction because it merely constituted “free distribution” of Tattilo’s product. *See id.* (emphasis added).

73. *See id.* at 1039.

74. *See id.* The defendant’s argument that it was merely posting an image in Italy whereby the American user must, “in effect, transport himself to Italy to view Tattilo’s pictorial displays,” was rejected by the court. *Id.*

75. *See id.* at 1040.

76. *Id.* The court further stated that:

[T]he Internet deserves special protection as a place where public discourse may be conducted without regard to nationality, religion, sex, age, or to monitors of community standards of decency [The] special protection [of the Internet] does not extend to ignoring court orders and injunctions. If it did, injunctions would cease to have meaning and intellectual property would no longer be adequately protected. In the absence of enforcement, intellectual property laws could be easily circumvented through the creation of Internet sites that permit the very distribution that has been enjoined. Our long-standing system of [intellectual property] protections has encouraged creative minds to be productive. Diluting those protections may discourage that creativity.

Id. (citations omitted).

77. *Id.*

The court imposed sanctions on the *Playmen* website in order to ensure that it was no longer accessible from the United States.⁷⁸ To be sure, users of either *Playmen* service are now required to obtain a password from Tattilo, which allows Tattilo to filter out American users.⁷⁹ In its decision on the motion for reconsideration, the court added: "If technology cannot identify the country of origin of e-mail addresses, these passwords and user IDs should be sent by mail. Only in this way can the court be assured that U.S. users are not accidentally permitted to access *Playmen Lite*."⁸⁰

The decision in the noted case falls squarely within the existing law on Internet distribution.⁸¹ Although the *Frena*, *Sega Enterprises*, and *Religious Technology Center* courts disagreed on the issue of whether or not an Internet conduit may be held liable, all three courts unquestionably agreed that a subscriber, the person who actually posts the images, may be held liable.⁸² Thus, the noted case seems to easily fit within the broader existing case law on this issue. Specifically, the *Chuckleberry* court addressed only the narrow issue of whether or not Tattilo, the party that uploaded the images, was liable.⁸³ Two factors, however, set this case apart, making the issues that the court fails to thoroughly address both interesting and noteworthy.

First, the court's basis for personal jurisdiction over Tattilo was the past injunction.⁸⁴ However, an unresolved issue is whether the court could have asserted jurisdiction over Tattilo if no previous injunction

78. See *id.* at 1041. The court gave Tattilo two weeks to comply with the following requirements (or pay \$1,000 each day thereafter until in full compliance):

- (1) Shut down the site or refrain from accepting new subscribers in the United States;
- (2) Invalidate passwords and usernames of current American users;
- (3) Refund subscription money due for terminating subscriptions early;
- (4) Give Playboy Enterprises all gross profits earned from American users on the subscriptions and sale of goods and services from the web site;
- (5) Revise the Internet site to indicate that no access is available to U.S. users;
- (6) Pay Playboy Enterprises' attorney's fees.

See *id.*

79. See *id.* at 1045.

80. *Id.* at 1045 n.4.

81. See, e.g., *Religious Tech. Ctr. v. Netcom On-Line Communication Servs., Inc.*, 907 F. Supp. 1361 (N.D. Cal. 1995); *Sega Enters. v. Maphia*, 857 F. Supp. 679 (N.D. Cal. 1994); *Playboy Enters. v. Frena*, 839 F. Supp. 1552 (M.D. Fla. 1993).

82. See *Religious Tech. Ctr.*, 907 F. Supp. at 1372; *Sega Enters.*, 857 F. Supp. at 686; *Frena*, 839 F. Supp. at 1556, 1561.

83. See *Chuckleberry*, 939 F. Supp. at 1033.

84. See *id.* at 1036 n.4.

existed. That is, if PEI did not have the 1981 injunction against Tattilo and had filed suit for trademark infringement for use of a confusingly similar name on the Internet, would Tattilo be subject to U.S. jurisdiction?⁸⁵ Although several courts have addressed this issue,⁸⁶ a definitive resolution has not been delivered.⁸⁷

85. It appears that there was no question of jurisdiction in the 1981 injunction because Chuckleberry Publishing, the company that Tattilo retained to distribute *Playmen* magazine in English, was a New York corporation. See *Playboy Enters. v. Chuckleberry Publ'g, Inc.*, 486 F. Supp. 414, 418 (S.D.N.Y. 1980). Due to their inclusion in the action, sufficient ties existed to link Tattilo to the forum state of New York. See *id.* However, in the noted case, Chuckleberry Publishing is not a party, and the motion for contempt is levied solely at Tattilo, an Italian corporation with no assets in, nor ties to, the United States. See *Playboy Enters. v. Chuckleberry Publ'g*, 939 F. Supp. at 1033, 1036 n.4. Thus, in the present action, definite contacts to the state of New York are lacking, with the exception of Internet use.

86. Compare *CompuServe, Inc. v. Patterson*, 89 F.3d 1257, 1268-69 (6th Cir. 1996) (holding that personal jurisdiction existed in Ohio over a Texas resident, who had contracted with CompuServe (based in Ohio) to distribute software, even though the contact was only through electronic and regular mail and the defendant had never visited the forum state), *Maritz, Inc. v. Cybergold, Inc.*, 947 F. Supp. 1338, 1340 (E.D. Mo. 1996) (holding that personal jurisdiction existed over the defendant based only on the availability of information on the Website in Missouri, even though the site was physically located on a server located in California), and *Inset Systems, Inc. v. Instruction Set, Inc.*, 937 F. Supp. 161, 162-65 (D. Conn. 1996) (holding that jurisdiction over a Massachusetts company in Connecticut was proper even though their only contact with the forum state was through advertising on the Internet and a toll-free phone number) with *Pres-Kap, Inc. v. System One, Direct Access, Inc.*, 636 So.2d 1351, 1353 (Fla. Dist. Ct. App. 1994), *cert. denied*, 645 So.2d 455 (Fla. 1994) (holding that no jurisdiction existed in Florida over a New York based corporation who utilized the Florida based corporation's on-line service because such a decision "would have far-reaching implications for business and professional people who use 'on-line' computer services" even though they have no idea where the service is based), and *Bensusan Restaurant Corp. v. King*, 937 F. Supp. 295, 300-01 (S.D.N.Y. 1996) (holding that no jurisdiction existed in New York over a Missouri-based web site that went by the name "The Blue Note" (the same name as a famous New York club) because the Missouri club did not purposefully avail itself to the New York market and demanding the web operator to defend such an action would be unfair).

87.

Activity in cyberspace, . . . , creates new relationships among individuals that differ from their analogues in the more usual, physical existence. These new relationships strain legal principles and categories that currently direct judicial power over individual action, either civilly or criminally. The fundamental jurisdictional premise of the common law is physical presence, either actual or constructive, within the jurisdiction attempting to assert authority over an individual. The body of the individual may be located in the jurisdiction, the individual may perform an action that has physical effects within the jurisdiction, or the individual may transfer some physical object into the jurisdiction. In addition, the boundaries of the jurisdiction itself are defined in physical, geographical terms. In a very relevant sense, cyberspace is a new, and separate, jurisdiction.

William S. Byassee, *Jurisdiction of Cyberspace: Applying Real World Precedent to the Virtual Community*, 30 WAKE FOREST L. REV. 197, 199 (1995).

In the noted case, Tattilo's website was accessible globally, and it was not directed specifically at the U.S. market. In fact, it is impossible to direct a web site at only one specific country or to bar a website from entering a country.⁸⁸ Once a website is posted, it is immediately accessible by users in all nations.⁸⁹ Thus, the question to consider is whether the court would have had jurisdiction, without the injunction, over an Italian corporation whose contacts with the United States were solely through a globally accessible Internet website.

Under the three-prong personal jurisdiction analysis currently applied, one must ask if there were sufficient contacts.⁹⁰ First of all, although Tattilo "purposefully availed" itself of the global market offered by the Internet, it did not specifically direct its marketing at the United States. Furthermore, the degree of Tattilo's contacts with the State of New York raise questions of their sufficiency under tests of jurisdiction. Finally, the standard of proving sufficient contacts is higher when foreign market participants are forced to defend themselves in the United States.⁹¹ These issues can evidently be argued either way, yet one might note that the District Court for the Southern District of New York recently declined to extend jurisdiction over a Missouri website operator, whose site was accessible in New York and infringed a New York corporation's name, because it determined that the Missouri website was not targeting the New York market.⁹² A modification of the tests for acquiring personal jurisdiction over a defendant, operating not physically, but via the Internet, seems to be in order to address this new way to access all markets.

88. See *ACLU v. Reno*, 929 F. Supp. 824, 844 (E.D. Pa. 1996).

89. See *id.* "Foreign content is otherwise indistinguishable from domestic content (as long as it is in English). . . ." *Id.* at 848.

90. See *Asahi Metal Indus. Co. v. Superior Court of California*, 480 U.S. 102, 108-16 (1987); *Burger King Corp. v. Rudzewicz*, 471 U.S. 462, 471-87 (1985); *Worldwide Volkswagen Corp. v. Woodson*, 444 U.S. 286, 291-99 (1980); *International Shoe Co. v. Washington*, 326 U.S. 310, 316 (1945).

91. See *Asahi*, 480 U.S. at 113-16.

92. See *Bensusan Restaurant Corp. v. King*, 937 F. Supp. 295, 299 (S.D.N.Y. 1996).

Second, the *Chuckleberry* court ordered Tattilo to either discontinue its *Playmen* websites or exclude web users living in the United States.⁹³ The court further instructed that if Tattilo's present system of distributing passwords and usernames is unable to determine who is American and who is not, the passwords and usernames must be distributed via postal mail, since this medium indicates the postmark and return address of the user.⁹⁴

Although the court's solution seems sufficient on its face, it manifests a lack of knowledge of Internet access and functioning. First of all, there are numerous ways for American users to obtain a password without being estopped by this court's order. Whether by obtaining the password via a foreign user, or routing an application for a username and password through a foreign country, the ways around the order are endless for a resourceful Internet user. Moreover, it is ridiculous to assume that an order from a New York District Court will be obediently followed by an Italian corporation with no contacts in the United States, except access to its website.⁹⁵ Because there are effectively no means to monitor Tattilo's website to ensure that the defendant is complying with the court order, as well as no way to censor websites that are accessible in the United States, the court is blindly relying on Tattilo's good faith to obey the order. Tattilo has no assets that can be seized in the United States and no corporate charter that can be revoked; therefore, it is practically impossible for the court to enforce its order.

Although the holding of the noted case fits neatly within the existing, and quickly developing, case law, a glance beneath the surface of the opinion raises questions about the holding's effectiveness. Are such decisions merely empty threats to foreign corporations who access the American market via the Internet? The answer seems to be "yes." Without enforcement mechanisms, American courts are relegated to promulgating appropriate forms of conduct, and thereafter, hoping that Internet users obey their dictates. Perhaps, as Internet jurisprudence and technology develop simultaneously, better solutions will be determined. But for now, it seems that little can be done to keep foreign corporations

93. See *Playboy Enters. v. Chuckleberry Publ'g, Inc.*, 939 F. Supp. 1032, 1045 (S.D.N.Y. 1996).

94. See *id.* Ironically, the court carves out an exception, stating that an Italian user who subsequently moves to the United States could maintain his or her subscription. See *id.* at 1040.

95. See *id.* at 1036 n.4. In fact, although Tattilo was unable to physically publish *Playmen* magazine in the United States due to the 1981 injunction, that portion of the 1981 order was the only manifestation of Tattilo's compliance. See *id.* at 1040. Incidentally, Tattilo still owes Playboy Enterprises \$5,000 in attorney's fees from the 1981 action. See *id.* at 1040 n.7.

from infringing trademarks, copyrights, and other laws of the United States when the medium of choice is the Internet.

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