No. 00-9185

IN THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

UNIVERSAL CITY STUDIOS, INC., PARAMOUNT PICTURES CORPORATION, METRO-GOLDWYN-MAYER STUDIOS INC., TRISTAR PICTURES, INC., COLUMBIA PICTURES INDUSTRIES, INC., TIME WARNER ENTERTAINMENT COMPANY, L.P., DISNEY ENTERPRISES INC., and TWENTIETH CENTURY FOX FILM CORPORATION,
Plaintiffs-Appellees,

SHAWN C. REIMERDES and ROMAN KAZAN,
Defendants,

v.

ERIC CORLEY aka Emmanuel Goldstein and 2600 ENTERPRISES, INC.,
Defendants-Appellants.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK,
THE HONORABLE LEWIS A. KAPLAN
No. 00-Civ.-0277 LAK, 111 F. Supp. 2d 294 (S.D.N.Y. 2000)

BRIEF AMICUS CURIAE OF INTELLECTUAL PROPERTY LAW PROFESSORS IN SUPPORT OF DEFENDANTS-APPELLANTS, SUPPORTING REVERSAL

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STATEMENT OF CONSENT PURSUANT TO FED. R. APP. P. 29(a)

Pursuant to a separate document filed with the Court, both defendants-appellants and plaintiffs-appellees have consented to the filing of all briefs amicus curiae in this matter, including this Brief Amicus Curiae of Intellectual Property Law Professors in Support of Defendants-Appellants, Supporting Reversal.

CERTIFICATE OF COMPLIANCE PURSUANT TO FED. R. APP. P. 32(a)(7)(C)

I certify, pursuant to Fed. R. App. P. 32(a)(7)(C) and Circuit Rule 32(a), that the attached Brief Amicus Curiae of Intellectual Property Law Professors in Support of Defendants-Appellants, Supporting Reversal is proportionately spaced, has a typeface of 14 points, and contains 6,979 words (based on the word count of the word processing system used to prepare the brief).

Dated: January 26, 2001. Respectfully submitted,

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STATEMENT OF INTEREST OF AMICI

Amici are law professors who teach and write about intellectual property law at law schools within the United States.[1] We care deeply about the fundamental constitutional principles underlying United States intellectual property law, and are committed to ensuring that intellectual property law continues to develop in accordance with these principles. We have no interest in the outcome of this litigation except as it pertains to these concerns. This case raises a number of important questions concerning the interpretation and constitutionality of the Digital Millennium Copyright Act's (DMCA) provisions barring the manufacture, importation, and distribution of technologies capable of circumventing technological protections applied to copyrighted works, 17 U.S.C. § 1201(a)(2), (b)(1) (hereinafter the "anti-device provisions"). We write only to address whether the anti-device provisions are a proper exercise of congressional authority under the intellectual property power, the commerce power, or the power to enact laws that are necessary and proper to effectuate these other powers. U.S. Const. art. I, § 8, cls. 3, 8, 18. We believe that they are not.

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[1] Amici do not represent or speak for their institutions in this matter, and institutional affiliations are listed for identification purposes only. Amici wish to acknowledge the invaluable assistance of Georgetown law students Rebecca Bjork, Troy Klyber, and Glenn Levy in the preparation of this brief.

SUMMARY OF ARGUMENT

Congress may legislate only pursuant to a power specifically enumerated in the Constitution. Neither the text nor the legislative history of the DMCA indicates which power Congress relied on to enact the anti-device provisions. Even if Congress had specified a particular source of constitutional authority, however, it would not matter. The DMCA's anti-device provisions are not a valid exercise of any of Congress' enumerated powers. They prohibit devices without regard for originality, duration of copyright, or infringement of copyright in the underlying, technologically-protected work; therefore, they are not a valid exercise of the intellectual property power. Nor are they a lawful exercise of the necessary and proper power or the commerce power, because they contravene specific limits on Congress' power under the Intellectual Property Clause. As a separate ground of invalidity, the anti-device provisions also violate limits on the scope of copyright protection required by the First Amendment.

ARGUMENT

I. The Intellectual Property Clause Authorizes Protection for "Writings," Not Prohibition of Technologies Regardless of Originality, Duration, or Infringement.

The Intellectual Property Clause authorizes Congress only to grant exclusive rights in "[w]ritings" and "[d]iscoveries," and only for "limited [t]imes."

U.S. Const. Art. I, § 8, cl. 8; *The Trade-Mark Cases*, 100 U.S. 82, 93-94 (1879). Congress' placement of the anti-device provisions in Title 17 of the United States Code, home to the Copyright Act, suggests that it may have believed these provisions to be an exercise of the intellectual property power. *See id.* at 93. But the anti-device provisions are not limited in scope to protection of statutory rights in writings still under copyright protection; instead, they ban devices regardless of whether the devices are actually used to gain access to, or infringe copyright in, a work that copyright protects.

The Intellectual Property Clause "is both a grant of power and a limitation." *Graham v. John Deere Co.*, 383 U.S. 1, 5 (1966). It permits grants of exclusive protection only for those "discoveries" in the "useful arts" that would not have been obvious to one reasonably skilled in the art, *Graham*, 383 U.S. at 6, and only for those "writings" that constitute original expression, *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349-50 (1991). Congress may not extend protection to unoriginal subject matter, nor to ideas, processes, methods of operation, and the like unless the threshold for patentability is met. *Feist*, 499 U.S. at 349-50; *Baker v. Selden*, 101 U.S. 99, 103-04 (1879). Nor may it grant protection for proper subject matter in perpetuity. A law that protects informational goods without regard for these limitations cannot claim the

Intellectual Property Clause as its authority. *The Trade-Mark Cases*, 100 U.S. at 93-94 (holding that Intellectual Property Clause could not authorize law protecting trademarks regardless of "novelty, invention, discovery, or any work of the brain" or of "fancy or imagination").

The anti-device provisions do not meet this exacting standard. They operate regardless of whether the device is used to access information that is a constitutionally protectable writing, regardless of whether the work so accessed has passed into the public domain, and regardless of whether the desired use of the work would infringe copyright. Indeed, they operate regardless of whether the accused device has been used at all. *See* 17 U.S.C. § 1201(a)(2), (b)(1). *The Trade-Mark Cases* make clear that the Intellectual Property Clause does not permit such a tenuous connection. The House Commerce Committee recognized as much. *See* H.R. Rep. 105-551, Part 2, 105th Cong., 2d Sess. 23-25 (1998) (recommending that a ban on devices be implemented "as free-standing provisions of law" external to Title 17, "in large part because these regulatory provisions have little, if anything, to do with copyright law"). Congress may have believed that the prohibition was necessary to effectuate its intellectual property power in the digital age. That, however, is a belief that implicates a different enumerated power, to which we now turn.

II. The Necessary and Proper Clause Does Not Empower Congress to Abrogate Limits on the Intellectual Property Power.

Congress may have seen the DMCA's anti-device provisions as an exercise of its power "[t]o make all [l]aws which shall be necessary and proper for carrying into [e]xecution" the intellectual property power. U.S. Const. Art. I, § 8, cl. 18. The Necessary and Proper Clause affords Congress a wide degree of latitude in exercising the other powers enumerated in Article I. *See McCulloch v. Maryland*, 17 U.S. (4 Wheat.) 316, 413-21 (1819). However, the clause is not an unlimited grant of authority. In particular, Congress may not use the necessary and proper power to avoid clear limits on its other enumerated powers under pretext of advancing them. The Intellectual Property Clause is a limited grant of authority, and the anti-device provisions abrogate these limits.

A. A Law That Contravenes Affirmative Limits on Another Enumerated Power Is Not "Proper".

A wide degree of latitude to determine what is "necessary" does not translate into an equally wide degree of latitude to determine what is "proper."[2] To the contrary, the necessary and proper power allows Congress only those means "which are appropriate, which are plainly adapted to that end, [and] which

[2] The doctrine of "rational basis" review is rooted in *McCulloch*'s interpretation of "necessary." Laurence H. Tribe, 1 American Constitutional Law § 5-3, at 799-804 (3d ed. 2000).

are not prohibited, but consist with the letter and spirit of the constitution." *McCulloch*, 17 U.S. (4 Wheat.) at 421. Therefore, it is not enough that Congress enacted the anti-device provisions with the legitimate goal of providing effective protection for copyrighted works. As Chief Justice Marshall emphasized in *McCulloch*, the Necessary and Proper Clause is instrumentalist by design, but does not thereby become an instrument for rendering other constitutional limits toothless. This Court must inquire whether the means that Congress chose would have that effect here.

This limitation is not merely theoretical. The Court's recent decision in *United States v. Lopez*, 514 U.S. 549 (1995), illustrates that it is real, and cannot be overcome by mere assertion of a relation, however indirect, between the activity sought to be regulated and a power actually granted to Congress. *See* 514 U.S. at 566-68 (holding that intrastate activity may be regulated pursuant to Congress' commerce power only if it "substantially affect[s]" interstate commerce)[3]; *see also id*. at 587-88 (Thomas, J., concurring) (observing that a contrary interpretation of congressional power under the Commerce and Necessary and Proper

[3] The majority opinion in *Lopez* did not hold itself out as interpreting the Necessary and Proper Clause, but plainly it was; the power to regulate intrastate activities for their effects on interstate commerce can have no other source. *See Garcia v. San Antonio Metro. Transit Auth.*, 469 U.S. 528, 584-85 (1985) (O'Connor, J., dissenting).

Clauses would render "many of Congress' other enumerated powers under Art. I, § 8 . . . wholly superfluous"); *cf. City of Boerne v. Flores*, 521 U.S. 507 (1997) (holding that the Religious Freedom Restoration Act exceeded Congress' constitutional authority to remedy state violations of the Fourteenth Amendment using "appropriate legislation"); *Katzenbach v. Morgan*, 384 U.S. 641, 651 (1966) ("[T]he *McCulloch v. Maryland* standard is the measure of what constitutes 'appropriate legislation' under § 5 of the Fourteenth Amendment."). Any other rule would render Congress the ultimate arbiter of the scope of its own authority, yet this cannot be. *See Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 177 (1803); *cf. City of Boerne*, 521 U.S. at 529 (reasoning that invocation of the "appropriate legislation" power to justify legislation redefining the scope of Fourteenth Amendment protection would treat the Constitution as "'alterable when the legislature shall please to alter it'" (quoting *Marbury*)).

Nor does this result change when Congress implements a treaty.[4] Congress is free of subject matter limitations when it invokes the necessary and proper power to enact implementing legislation; thus, it need not confine the scope of such legislation to interstate commerce or avoid subject matter reserved to the states by the Tenth Amendment if the treaty requires otherwise. *See Missouri v. Holland*, 252 U.S. 416, 432-33 (1920) (protection of migratory birds); *De Geofroy v. Riggs*, 133 U.S. 258, 266-67 (1890) (ability of aliens to inherit property). But it is not therefore free to ignore other, affirmative constraints on the manner in which it may exercise its power. *See* Restatement (Third) of Foreign Relations Law § 302(2) & cmt. b (1987) ("The view, once held, that treaties are not subject to

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[4] *McCulloch*'s interpretation of "necessary" notwithstanding, it is worth noting that the DMCA's anti-device provisions substantially exceed the threshold level of protection that will be required by the WIPO Copyright Treaty once it has taken effect. The treaty requires only that member states provide "adequate legal protection and effective legal remedies *against the circumvention* of effective technological measures that . . . restrict acts, in respect of their works, which are not authorized by the authors concerned or permitted by law." World Intellectual Property Organization Copyright Treaty, Dec. 20, 1996, art. 11, S. Treaty Doc. No. 105-17 (1997) (emphasis added). In contrast, the anti-device provisions closely parallel treaty language proposed by the United States that the WIPO delegates rejected out of concern that it would imperil access to public domain information and foreclose lawful, noninfringing uses of copyrighted works. *See* Pamela Samuelson, *The U.S. Digital Agenda at WIPO*, 37 Va. J. Int'l L. 369, 409-14 (1997). A majority of the WIPO delegates believed that a device ban was neither necessary nor proper when judged in light of international copyright norms. Holding that a device ban also lacks constitutional propriety will not jeopardize United States compliance with the treaty.

constitutional restraints is now definitely rejected."); *Holland*, 252 U.S. at 433 ("We do not mean to imply that there are no qualifications to the treaty-making power . . . . The treaty in question does not contravene any prohibitory words to be found in the Constitution."); *De Geofroy*, 133 U.S. at 267 ("The treaty power . . . is in terms unlimited, except by those restraints which are found in that instrument against the action of the government . . . . It would not be contended that it extends so far as to authorize what the constitution forbids."). "In effect, such construction would permit amendment of [the Constitution] in a manner not sanctioned by Article V." *Reid v. Covert*, 354 U.S. 1, 17 (1957) (plurality opinion) (holding that Congress may not waive the protections of the Fifth and Sixth Amendments for overseas-based military dependents charged with capital offenses). Once again, that is not the law.

In sum, with or without the treaty power as backstop, the Necessary and Proper Clause does not empower Congress to redefine its own authority to avoid specific, affirmative limits on that authority. It follows that Congress may not rely on the Clause to foreclose access to public domain information, including copyright-expired information, or prevent lawful, noninfringing use of copyrighted works, if the Intellectual Property Clause forbids it from doing so.

The anti-device provisions do all of these things, and the Intellectual Property Clause forbids them.

B. The Intellectual Property Power Is Limited By Design.

The Intellectual Property Clause both confers and restricts the power to protect intellectual creations. *See Graham v. John Deere Co.*, 383 U.S. 1, 5 (1966); *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348-49 (1991) ("This [constitutional limit on the scope of copyright protection] is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art."); Yochai Benkler, *Constitutional Bounds of Database Protection: The Role of Judicial Review in the Creation and Definition of Private Rights in Information*, 13 Berkeley Tech. L.J. 535, 539-52 (2000). The Clause's limitations are the product of a distinct vision of what constitutes progress, and what promotes it.

The limitations on the intellectual property power originate in the history of Anglo-American intellectual property law. The original English patents were Crown monopolies extended to favored manufacturers, and were widely resented as arbitrary restraints on trade. Edward C. Walterscheid, *The Early Evolution of the United States Patent Law: Antecedents (Part 2)*, 76 J. Pat. & Trademark Off. Soc'y 849, 853 (1994). The original English copyright, a Crown monopoly

granted only to Crown-licensed printing houses, was both a powerful instrument of state censorship and the tool for perfecting ironclad monopolization of the book trade. The Crown enlisted licensed booksellers in the suppression of undesirable ideas; the booksellers, in turn, enlisted the Crown in aid of their monopolies. They invoked their royal charter as authority for private ordinances granting themselves exclusive rights in perpetuity and "continually petitioned the Star Chamber to provide greater protection." L. Ray Patterson, *Understanding the Copyright Clause*, 47 J. Copyright Soc'y 365, 378-79 (2000).[5]

The licensing laws and the monopolies that they enabled were denounced (albeit circumspectly) by leading exponents of the liberal political theory to which the Framers subscribed. Most famously, in *Areopagitica*, a well-known political tract with which the Framers were surely familiar, John Milton argued that ideas were not "a staple commodity . . . to [be] mark[ed] and license[d] like our broadcloth and our woolpacks." John Milton, *Areopagitica: A Speech for the Liberty of Unlicensed Printing* 29 (H.B. Cotterill ed. 1959) (1644). In 1694, following the Glorious Revolution of 1688, the royal licensing laws were allowed

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[5] One could substitute "property rights" for "royal charter" and "Congress" for "the Star Chamber" in the foregoing sentence and arrive at an uncannily accurate depiction of the lobbying behavior of the modern-day copyright industries, including plaintiffs in this action. *See* Jessica Litman, *Copyright Legislation and Technological Change*, 68 Or. L. Rev. 275 (1989).

to lapse. In 1709, Parliament enacted the first modern copyright law, the Statute of Anne, which vested a fourteen-year statutory copyright in authors. Undeterred, the publishers sought a judicial declaration that this statutory copyright merely supplemented a preexisting natural law copyright that authors could assign to publishers in perpetuity. In 1774, however, the House of Lords rejected this attempt to restore the publishers' monopoly and held that no natural law copyright existed, and that copyright was a purely statutory right created for the utilitarian purpose of encouraging literary efforts. *Donaldson v. Beckett*, 1 Eng. Rep. 837 (H.L. 1774); *see* Patterson, *supra*, at 380-83.

The Framers of the Constitution were aware of this then-recent history, and intended the Intellectual Property Clause to serve both an anti-censorship function and an anti-monopoly function. As to government censorship, the power to grant "exclusive rights" to "authors" of "writings" safeguards the private production of information independent of government sponsorship or control. *See* Marci A. Hamilton, *The Historical and Philosophical Underpinnings of the Copyright Clause*, Benjamin N. Cardozo School of Law Occasional Papers in Intellectual Property No. 5, at 9-12 (1998); Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 Yale L.J. 283, 352-59 (1996); L. Ray Patterson & Stanley W. Lindberg, The Nature of Copyright: A Law of Users' Rights 125-28

(1991). This safeguard operates in conjunction with the Press Clause of the First Amendment, U.S. Const. amdt. 1, which repudiates the intent behind the Stationers' Laws by ensuring that anyone who so desires may operate a press.

The Clause's concern with censorship and monopolies, however, extends far beyond overt state suppression of ideas. As Prof. Patterson has shown, the policies embodied in the Statute of Anne and upheld in *Donaldson v. Beckett* were well-understood on this side of the Atlantic. *See* Patterson, *supra*, at 380-83. Accordingly, the Framers did not authorize Congress simply to confer patents and copyrights, as they could easily have done, but more precisely "to promote the [p]rogress of [s]cience and useful [a]rts." This grant incorporates and enforces a specific vision of the sorts of exclusive rights that are permitted: rights limited not only in duration, *see* U.S. Const. art. I, § 8, cl. 8, but also in scope. These rights are not "property" rights — again, terminology which the Framers knew well and could easily have chosen, and which has powerful natural law antecedents — but limited monopolies to be prescribed by statute. Because patents and copyrights are statutory rights, and because monopolies are disfavored, the limits inherent in the Clause's carefully chosen language must be strictly observed.

As to patents, the Clause requires that the grant of patent protection be jealously guarded, and be extended only to those innovations that represent a

sufficiently nonobvious contribution to "the sum of useful knowledge." *Graham*, 383 U.S. at 6. As *Graham* explains, any other rule — for example, a rule extending protection to trivial or easily anticipated advances — would result in a regime "whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available." *Id*. Such a regime would frustrate progress, not promote it; therefore, it is not an option that Congress is free to choose. *See id*. at 5-6 ("Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose"); Benkler, *supra*, at 541-44. In addition, the Framers contemplated, and swiftly wrote into law, public disclosure as quid pro quo for the patent grant. The patentee must disclose the claimed invention in sufficient detail "'to apprise the public of what is still open to them.'" *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996) (quoting *McClain v. Ortmayer*, 141 U.S. 419, 424 (1891)); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146-47 (1989) (citing Patent Act of 1790, 1 Stat. 109, 110); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480-81 (1974).

Similarly, to avoid the twin evils of censorship and monopoly, the Clause requires that copyright be limited in both scope and effect. As in the case of patents, this principle dictates, first, that no-one may invoke copyright to

appropriate facts, ideas, or other information out of the public domain. *Feist*, 499 U.S. at 349-50 (holding that Intellectual Property Clause compels denial of copyright protection to facts, and also to unoriginal compilations of facts); *Baker v. Selden*, 101 U.S. 99, 103-04 (1879) (denying copyright protection to accounting system that had not received patent protection, and suggesting that Intellectual Property Clause requires this result); *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834) (denying copyright protection to transcriptions of Supreme Court arguments and opinions); *Clayton v. Stone*, 5 F. Cas. 999 (C.C.S.D.N.Y. 1829) (denying copyright protection to news reports); *see generally* Benkler, *supra*, at 544-48; Jessica Litman, *The Public Domain*, 39 Emory L.J. 965 (1990).[6]

The principle of limited protection requires, further, that copyright not confer the exclusive right to control all uses of a work. The copyright regime created by Parliament, contemplated by the Framers, and enacted by the first Congress was simply a right of publication. *See* Patterson, *supra*, at 369-70. The Copyright Act of 1976 bestows additional rights on authors, but scrupulously preserves fair use and other doctrines that limit attempts to control personal use of

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[6] By extension of this reasoning, federal copyright law and policy preempt all but narrow "hot news" protection for facts under state misappropriation law. *See National Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 852-54 (2d Cir. 1997).

lawfully acquired copies of works. *See, e.g.*, 17 U.S.C. §§ 102(b) (idea-expression distinction), 107 (fair use), 109(a) (first sale). As courts throughout our history have recognized, a right to censor uses would promote neither learning nor "progress." *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575-76 (1994) (fair use parody); *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 432 & n.13 (1984) (personal noncommercial copying) ("[Copyright] protection has never accorded the copyright owner complete control over all possible uses of his work."); *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339 (1908) (resale of lawfully acquired books); *Stover v. Lathrop*, 33 F. 348 (C.C.D. Colo. 1888) (same) ("The effect of a copyright is not to prevent any reasonable use of the book which is sold. I may use the book for reference, study, reading, lending, copying passages from it at my will."); *Sega Enterprises, Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1992) (reverse engineering of lawfully acquired software to discover uncopyrightable functional principles).

History repeats itself. The anti-device provisions are the lineal descendants of the royal licensing laws, and accomplish precisely the result that the Framers sought to avoid.

C. The Anti-Device Provisions Abrogate the Limits on the Intellectual Property Power.

The DMCA's anti-device provisions destroy the Intellectual Property Clause's carefully crafted balance. First, as the District Court recognized, the provisions effectively nullify the public's ability to make fair use of the underlying copyrighted works when the desired use requires exact copying. *Universal City Studios, Inc. v. Reimerdes*, 111 F. Supp. 2d 294, 322-24 (S.D.N.Y. 2000). It is simply insufficient to say, as the District Court did, that many would-be fair users don't need to copy, and can content themselves with transcribing portions of the script, or with playing the recorded sounds or images directly from the DVD to their intended audience. *Reimerdes*, 111 F. Supp. 2d at 337-38. Where images and sounds are concerned, direct copying of excerpts is the analogue to direct quotation, which is the essence of what fair use protects. *See, e.g.*, *Maxtone-Graham v. Burtchaell*, 803 F.2d 1253, 1260-65 (2d Cir. 1986), *cert. denied*, 481 U.S. 1059 (1987); *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 307 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967); *Wojnarowicz v. American Family Association*, 745 F. Supp. 130, 143-47 (S.D.N.Y. 1990); *Time, Inc. v. Bernard Geis Associates*, 293 F. Supp. 130, 146 (S.D.N.Y. 1968).

Second, the anti-device provisions effectively nullify the public's ability to access, use, and copy public domain material, including copyright-expired material, shielded by technological protection systems. *See* David Nimmer, *A Riff on Fair Use in the Digital Millennium Copyright Act*, 148 U. Pa. L. Rev. 673, 727-39 (2000) (providing examples). This problem is, if anything, more important than the first. Unlike fair use, copying from the public domain is not judged according to a balancing test. It is always the public's right.

Third, as interpreted by the District Court, the anti-device provisions forbid reverse engineering of platform-dependent technological protection systems to allow other platforms to interoperate with the systems. This, in turn, effectively prevents individuals who have purchased protected works — for example, DVDs encrypted with CSS, compatible only with the Windows operating system — from using a device such as DeCSS to view these lawfully purchased copies. Both prohibitions exceed the constitutional limits of copyright protection. Reverse engineering of computer microcode to discover the uncopyrightable functional principles embodied in the code prevents private monopolization of unpatented technical standards. *See Sony Computer Entertainment, Inc. v. Connectix Corp.*, 203 F.3d 596, 602-03 (9th Cir.), *cert. denied*, 121 S. Ct. 172 (2000); *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1540 n.18 (11th Cir. 1996); *Sega Enterprises*, 977

F.2d at 1526; *cf. Bonito Boats*, 489 U.S. at 155-56, 159-61.[7] And, as we have noted, copyright does not, and cannot, give copyright owners the right to control private uses of lawfully acquired copies of works. *See supra* pp. 15-16.

The anti-device provisions do exclude some devices, but the exclusions fail to preserve these constitutionally protected uses. First, the statutory language exempts devices that have another "commercially significant purpose." 17 U.S.C. § 1201(a)(2)(B), (b)(1)(B). But fair use by definition rarely will be "commercially significant." *See* 17 U.S.C. § 107 (directing court to consider, among other factors, "the effect of the use upon the potential market for or value of the copyrighted work"); *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 562 (1985). A device that facilitated access solely to public domain content might meet the "commercially significant" test, but this possibility evaporates if the public domain materials are repackaged with copyrighted content. *See* Nimmer, *supra*, at 712-14, 727-28. In any event, the anti-device provisions ban even devices with other commercially significant uses if they are "primarily designed" for circumvention of works protected by copyright or marketed

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[7] Congress crafted a limited exception to the anti-device provisions for certain kinds of reverse engineering. 17 U.S.C. § 1201(f). The District Court ruled that this exception did not apply. *Reimerdes*, 111 F. Supp. 2d at 319-20. If that is right — a question that we do not address — then the anti-device provisions are constitutionally infirm.

with knowledge that they will be so used. *See* 17 U.S.C. § 1201(a)(2)(A) & (C), (b)(1)(A) & (C).

It is no answer to these problems to say, as the District Court did, that this result is what Congress intended. *Reimerdes*, 111 F. Supp. 2d at 322-24. That option was not open to Congress. Nor is it an answer to say that copyright infringement is an "epidemic" that warrants drastic intervention, *id*. at 331-32; Congress is not free to choose a cure that would kill the patient. Because the anti-device provisions abrogate clear, specific limits on Congress' intellectual property power, they may not stand as an exercise of Congress' power under the Necessary and Proper Clause.[8] To so hold would be to conclude that Congress may effectively amend the Constitution to remove restrictions with which it disagrees. As decisions from *Marbury* and *McCulloch* to *Reid* and *City of Boerne* have affirmed, the Constitution dictates otherwise.

[8] This Court must, of course, consider whether the anti-device provisions can be construed to avoid these constitutional difficulties. *See* 17 U.S.C. § 1201(c)(1) ("Nothing in this section shall affect rights, remedies, limitations, or defenses to copyright infringement, including fair use, under this title.").

III. The Commerce Clause Does Not Empower Congress to Abrogate Limits on the Intellectual Property Power.

Finally, Congress may have intended the anti-device provisions as an exercise of the commerce power.[9] What Congress may not do using the Necessary and Proper Clause, however, it also may not do using the Commerce Clause. Neither Congress nor this Court may adopt a construction of any power enumerated in Article I that would nullify limits on other Article I powers, or render other Article I powers superfluous.

The commerce power is plenary only up to a point. As discussed above, it may not be extended, via the necessary and proper power, to reach activities only tenuously connected to interstate commerce. In addition, Congress may not rely on the commerce power to enact legislation that overrides other, more specific constitutional constraints. Thus, in *Railway Labor Executives Ass'n v. Gibbons*, 455 U.S. 457 (1982), the Court reasoned that Congress could not invoke the

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[9] Nowhere in those provisions appears the usual restriction to activities "in commerce." *The Trade-Mark Cases*, 100 U.S. at 95 (1879). Nonetheless, other Circuits hold that this omission is not fatal if the Court concludes that the commerce power in fact authorizes the law. *See United States v. Olin Corp.*, 107 F.3d 1506, 1510 (11th Cir. 1997); *United States v. Rybar*, 103 F.3d 273, 285 (3d Cir. 1996), *cert. denied*, 522 U.S. 807 (1997); *United States v. Wall*, 92 F.3d 1444, 1449 n.11 (6th Cir. 1996), *cert. denied*, 519 U.S. 1059 (1997); *United States v. Wilson*, 73 F.3d 675, 685 (7th Cir. 1995), *cert. denied sub nom. Skott v. United States*, 519 U.S. 806 (1996).

commerce power to enact the challenged law if it was bankruptcy legislation and violated the Bankruptcy Clause's uniformity requirement. *See id*. at 468-69 ("If we were to hold that Congress had the power to enact nonuniform bankruptcy laws pursuant to the Commerce Clause, we would eradicate from the Constitution a limitation on the power of Congress to enact bankruptcy laws").

These principles apply with full force to legislation designed to establish or expand protection for intellectual property rights. Congress may not invoke the Commerce Clause to extend exclusive protection to public domain or copyright-expired subject matter, or to eliminate fair use of copyrighted expression, any more than it may invoke the Necessary and Proper Clause to do so. *See* Benkler, *supra*, at 548-52; Julie E. Cohen, *Copyright and the Jurisprudence of Self-Help*, 13 Berkeley Tech. L.J. 1089, 1131-32 (1998); William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 Geo. Wash. L. Rev. 359 (1999).

Whether the DMCA's anti-device provisions create an impermissible conflict with the Intellectual Property Clause, and are therefore unlawful even if enacted under the commerce power, is a question of first impression. In *United States v. Moghadam*, 175 F.3d 1269, 1275-76 (11th Cir.), *cert. denied*, 120 S. Ct. 1529 (2000), the court acknowledged that a law enacted pursuant to the commerce

power cannot survive review if it is "fundamentally inconsistent" with the Intellectual Property Clause. *Id*. at 1280-82. The court went on to hold that the particular legislation challenged by the defendant did not create such a conflict as applied to that defendant. *Id*. Whether that conclusion was correct is not at issue here; appellants do not challenge the anti-bootlegging laws, and do not allege a conflict with the Intellectual Property Clause's fixation requirement. Moreover, the *Moghadam* court expressly suggested that a different challenge to the anti-bootlegging statute, based on its grant of perpetual protection to live musical performances, would likely succeed. *Id*. at 1281. Were *Moghadam* binding on this Court, it would not dictate the answer to the question presented here. The discussion in Section II.B, above, sets forth the principles that must guide that decision. If those principles are valid — and the Supreme Court has repeatedly upheld them — then the anti-device provisions cannot survive.

IV. The Anti-Device Provisions Violate First Amendment Limits on the Scope of Copyright Protection.

The First Amendment independently constrains the sorts of copyright protection that Congress may grant. Here too, the anti-device provisions fail the required constitutional scrutiny. Congress has supplied a blunt instrument where the law requires narrower tailoring.

A. The First Amendment Constrains Congress' Power to Protect Copyrighted Works.

Both the fair use doctrine and the idea-expression distinction in copyright law serve indispensable First Amendment functions. The fair use doctrine prevents private censorship, and preserves First Amendment freedoms, by shielding critical commentary and parody of privately owned expression. *Harper & Row*, 471 U.S. at 560; *Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65, 74-75 (2d Cir. 1999); *Twin Peaks Productions, Inc. v. Publications Int'l, Ltd.*, 996 F.2d 1366, 1378 (2d Cir. 1993); *cf. New York Times Co. v. Sullivan*, 376 U.S. 254, 265 (1964) (holding that standards of liability in defamation law must accommodate First Amendment concerns). The idea-expression distinction ensures that uncopyrightable facts and ideas and unpatentable functional principles remain in the public domain for future creators to build on. *Harper & Row*, 471 U.S. at 556; *Attia v. Society of New York Hosp.*, 201 F.3d 50, 54 (2d Cir. 1999), *cert. denied*, 121 S. Ct. 109 (2000); *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1170 (9th Cir. 1977).

These limits on the scope of copyright are designed to sever the link between state-granted monopolies and censorship. Without these doctrines as safety valves to prevent "abuse of the copyright owner's monopoly as an instrument

to suppress" facts, ideas, and critical commentary, copyright law would impermissibly abridge the freedom of speech. *Harper & Row*, 471 U.S. at 559-60.[10]

Effectuating these First Amendment protections requires preserving the option to make direct copies. In focusing on alternative, second-best options open to users of technologically protected works, *Reimerdes*, 111 F. Supp. 2d at 336-38, the District Court missed the point and misstated the law. In the context of intellectual property, the First Amendment does not require proof that the affected individuals lack alternative avenues of expression. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) ("[A] restriction on the *location* of a speech is different from a restriction on the *words* the speaker may use. . . . [T]he 'no alternative avenues' test does not sufficiently accommodate the public's interest in free expression. . . ." (emphasis in original)); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 28-29 (2d Cir.), *cert. denied*, 483 U.S. 1013 (1987); *Cardtoons L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 971 (10th Cir. 1996); *cf. Cohen v. California*, 403 U.S. 15, 26 (1971) ("[W]ords are often chosen as much for their emotive as their cognitive force. We cannot sanction the view that the

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[10] Whether the First Amendment requires additional limits on copyright protection is a separate question, which we do not address.

Constitution, while solicitous of the cognitive content of individual speech has little or no regard for that emotive function which practically speaking, may often be the more important element of the overall message sought to be communicated.”). In particular, effective fair use commentary on a visual or audiovisual work may require direct copying. *See, e.g.*, *Hustler Magazine, Inc. v. Moral Majority, Inc.*, 796 F.2d 1148, 1153-56 (9th Cir. 1986); *Wojnarowicz*, 745 F. Supp. at 143-47; *Time, Inc.*, 293 F. Supp. at 144-46.[11]

The District Court's “alternative avenues” approach is especially inadequate as applied to copying of public domain material.[12] Public domain information, including copyright-expired information, is no-one's “property.” Within the constitutional framework of copyright law, the right to copy from the public domain is the essence of what the First Amendment protects.

[11] For similar reasons, in the context of fair use parody the Court has counseled against too grudging an approach to the question whether a defendant copied too much. *See Campbell*, 510 U.S. at 588-89.

[12] The District Court did not directly address this question, but appeared to suggest that inability to copy from public domain works does not present a constitutional problem as long as alternative avenues of access to those works exist, or as long as only a few such works have been rendered inaccessible. *Reimerdes*, 111 F. Supp. 2d at 322 n.159, 338 n.245.

B. The Anti-Device Provisions Are Not Appropriately Tailored to Minimize Restrictions on First Amendment Activity.

At the very least, a law that would vitiate these constitutionally-required safety valves within copyright law must be evaluated according to the standard set forth in *United States v. O'Brien*, 391 U.S. 367 (1968), for scrutiny of content-neutral laws that burden speech: The government interest must be substantial, and the restriction on speech must be "no greater than is essential to the furtherance of that interest." *Id.* at 377.[13] Judged against this standard, the anti-device provisions fall far short. Although the government interest in protecting copyrighted works from infringement is substantial, the law that Congress wrote — a flat prohibition that sweeps within its reach all lawful uses of circumvention technologies as well as all unlawful ones — is not even arguably tailored to minimize restrictions on protected activity.

At least one more appropriately tailored model for protecting copyright owners against the inroads caused by circumvention technologies was readily available to Congress. The doctrine of contributory copyright infringement has evolved to provide precisely the safeguards that the DMCA so conspicuously

[13] Arguably, the anti-device provisions are not content-neutral, and therefore merit a stricter review. Since the provisions fail *O'Brien* scrutiny in any event, this Court need not address that question.

omits. In sharp contrast to the anti-device provisions, copyright law distinguishes between multi-purpose technologies and unlawful uses of those technologies. Sixteen years ago, in another lawsuit brought by these plaintiffs, the Supreme Court ruled that a technology designed to enable copying of copyrighted works — the VCR — could not serve as the basis for contributory infringement liability because it had substantial noninfringing uses. *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 440-42 (1984) ("Indeed, it need merely be capable of substantial noninfringing uses."). The *Sony* standard is derived from the patent law rule that manufacture and sale of "a staple article or commodity of commerce suitable for substantial noninfringing use" will not trigger contributory infringement liability. 35 U.S.C. § 271(c); *see Sony*, 464 U.S. at 440-42.

The doctrine of contributory infringement nonetheless affords strong protection for copyright owners. Courts have uniformly extended contributory infringement liability to those who use dual-purpose devices actively to participate in acts of infringement, as well as to those who knowingly provide facilities to infringers. *See, e.g.*, *Fonovisa, Inc. v. Cherry Auction, Inc.*, 76 F.3d 259 (9th Cir. 1996) (flea market operator); *Sega Enters. v. MAPHIA*, 948 F. Supp. 923 (N.D. Cal. 1996) (internet bulletin board operator); *A&M Records, Inc. v. General Audio Video Cassettes, Inc.*, 948 F. Supp. 1449 (C.D. Cal. 1996) (provider of blank

"time-loaded" audiocassettes); *RCA Records v. All-Fast Sys., Inc.*, 594 F. Supp. 335 (S.D.N.Y. 1984) (commercial operator of audiocassette copying machine). In short, the doctrine of contributory infringement is robust, and well advances the government's interest in copyright enforcement.

As the District Court recognized, the anti-device provisions eliminate the time-honored distinction between multi-purpose technologies and unlawful uses by establishing direct liability for manufacturing or distributing the technologies even when legally substantial — though commercially insignificant — noninfringing uses exist.[14] The Court reasoned that this was what Congress intended. *See Reimerdes*, 111 F. Supp. 2d at 323-24. Once again, however, this choice was not for Congress to make.

It bears repeating that the overriding government interest is not to protect copyrights, but to promote progress. U.S. Const. art. I, § 8, cl. 8. The "substantial noninfringing use" doctrine in patent and copyright is grounded, ultimately, in this mandate. As the *Sony* Court recognized, a finding of contributory infringement effectively extends the intellectual property grant to encompass the accused instrumentality. *Sony*, 464 U.S. at 441 & n.21. Where a technology has other, lawful uses, "'[s]uch a rule

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[14] They also eliminate the requirement that plaintiff prove an underlying act of infringement. *See Lewis Galoob Toys, Inc. v. Nintendo of America, Inc.*, 964 F.2d 965, 970 (9th Cir. 1992), *cert. denied*, 507 U.S. 985 (1993).

would block the wheels of commerce.'" *Sony*, 464 U.S at 441 (quoting *Henry v. A.B. Dick Co.*, 224 U.S. 1, 48 (1912), *overruled on other grounds, Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 517 (1917)). This is doubly true where the other uses also further the purposes of the copyright system. A rule allowing intellectual property owners to exert broad control over circumvention technologies will stifle progress, not promote it. What is, in First Amendment parlance, a less restrictive alternative is also an alternative that furthers all of the government's interests.

C. The Anti-Device Provisions Are Invalid As Applied to DeCSS.

As the District Court noted, appellants themselves did not engage in any of the uses they identified as fair uses under copyright law. *Reimerdes*, 111 F. Supp. 2d at 320, 336-37. The relevant constitutional inquiry, however, does not concern the anti-device provisions' impact on these appellants, but their impact on DeCSS. The anti-device provisions may not be applied to bar appellants from copying, distributing, or linking to *DeCSS* because of the constitutionally protected uses it enables and the constitutionally required limits it helps to maintain.

DeCSS is a dual-use technology that enables the exercise of important constitutional rights. As described above, DeCSS facilitates fair use, and also facilitates lawful access to and use of public domain (including copyright-expired)

information. In addition, individuals who have purchased DVDs encrypted with CSS and who do not use the Windows operating system can use DeCSS to view these lawfully purchased copies. DeCSS was created, moreover, via the lawful and constitutionally privileged practice of reverse engineering. Theoretically, DeCSS also could be used to decrypt copyrighted motion pictures prior to making, distributing, or displaying infringing copies. In fact, plaintiffs were unable to identify a single instance in which defendants or anyone else used DeCSS to pirate works protected by CSS. *Reimerdes*, 111 F. Supp. 2d at 314 & n.120. Even if it could be so used, however, DeCSS itself is simply a tool with a range of potential applications. The anti-device provisions foreclose all of them. None of Congress' enumerated powers authorizes this sweeping interdiction, and substantially less restrictive means of protecting copyright owners' legitimate interests are available. If the limits on copyright protection required by the First Amendment are to mean anything, the anti-device provisions cannot stand.[15]

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[15] Again, this Court must consider whether a saving construction is available. *See* 17 U.S.C. § 1201(c)(4) ("Nothing in this section shall enlarge or diminish any rights of free speech or the press for activities using consumer electronics, telecommunications, or computing products.").

V. Conclusion.

The DMCA's anti-device provisions lack constitutional mooring, and may not be invoked to bar appellants, or anyone else, from reproducing, distributing, or linking to DeCSS. If Congress wishes to afford protection for "technological measures" applied to protect copyrighted works beyond that which copyright law already affords, it must return to the drawing board.

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