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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

UNITED STATES OF AMERICA,

Plaintiff,

v.

ELCOM, LTD., a/k/a ELCOMSOFT CO., LTD. and DMITRY SKLYAROV,

Defendants.

Case No. CR 01-20138 RMW

(CORRECTED) MEMORANDUM OF POINTS AND AUTHORITIES OF AMICI CURIAE

Date: April 1, 2002
Time: 9:00 a.m.
Judge: Hon. Ronald M. Whyte

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STATEMENT OF INTEREST OF AMICI

Amici are law professors who teach and write about intellectual property law and technology 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.

SUMMARY OF ARGUMENT

Congress may legislate only pursuant to a power 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, but 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.

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[1] A list of the professors joining this brief is attached hereto as Exhibit A. Amici do not represent or speak for their institutions in this matter, and institutional affiliations are listed for identification purposes only.

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 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

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[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).

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 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

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[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).

[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 required by the WIPO Copyright Treaty. The treaty requires only that member states provide "adequate legal protection and effective legal remedies *against the circumvention* of effective technological