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PACIFIC BELL INTERNET SERVICES

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

PACIFIC BELL INTERNET SERVICES,

Plaintiff,

v.

RECORDING INDUSTRY ASSOCIATION OF AMERICA, INC., MEDIASENTRY, INC. d/b/a MEDIAFORCE, and IO GROUP, INC., d/b/a TITAN MEDIA, TITANMEDIA.COM, TITANMEN.COM,

Defendants.

Case No. C 03-3560 SI

PBIS' MOTION FOR SUMMARY JUDGMENT RE CLAIM TWO (DECLARATORY RELIEF UNDER ARTICLE III OF THE UNITED STATES CONSTITUTION)

Date: October 31, 2003
Time: 9:00 a.m.
Courtroom: 10, 19th Floor
Judge: Hon. Susan Illston

Date Comp. Filed: July 30, 2003

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NOTICE OF MOTION AND MOTION

TO ALL PARTIES AND THEIR COUNSEL OF RECORD:

NOTICE IS HEREBY GIVEN that on October 31, 2003 at 9:00 a.m., or as soon thereafter as the matter may be heard, in the courtroom of the Honorable Susan Illston, Courtroom 10, 19th Floor, located at 450 Golden Gate Avenue, San Francisco, California, Plaintiff Pacific Bell Internet Services ("PBIS") will and hereby does move for summary judgment as to claim two of its complaint in this action, which seeks a declaratory judgment that the subpoena power contained in 17 U.S.C. § 512(h) is limited to judicial process issued and enforced in aid of a pending lawsuit under the Copyright Act. The motion is based on this Notice of Motion and Motion, the following Memorandum of Points and Authorities, the Declaration of Rhonda K. Compton filed herewith, and the papers, records, and pleadings on file in this case. This motion is made on the ground that PBIS is entitled to judgment as a matter of law on claim two of its complaint.

MEMORANDUM OF POINTS AND AUTHORITIES

I. SUMMARY OF ARGUMENT

Claim two of PBIS' complaint addresses the constitutionality of 17 U.S.C. § 512(h), the subpoena provision of the DMCA.[1] Defendants the Recording Industry Association of America ("RIAA") and Io Group, Inc., doing business as Titan Media, TitanMedia.com and TitanMen.com ("Titan"), have both sent PBIS subpoenas issued under the purported authority of section 512(h), notwithstanding the lack of any pending federal court action to which the information sought relates, and PBIS has a reasonable apprehension (based on the sending of thousands of purported DMCA notices to PBIS by Defendant MediaSentry, doing business as MediaForce ("MediaForce")) that MediaForce, too, will send PBIS such subpoenas. The RIAA and Titan have each requested and been granted subpoenas without having made any showing of a live case or controversy within the meaning of Article III of the United States Constitution. If

[1] PBIS has limited the present motion to claim two of its complaint, because that is the claim that most clearly presents an issue of pure law, and which is thus most plainly susceptible to summary judgment at an early stage.

the DMCA authorizes such subpoenas, it unconstitutionally purports to expand the federal judicial power beyond the scope authorized by Article III.

II. BACKGROUND

A. The DMCA's Subpoena Provision

The Digital Millennium Copyright Act of 1998 ("DMCA") amended the Copyright Act; it sought to balance copyright owners' interests in protecting their rights with the need to protect and foster the Internet as an important medium of free expression. Title I of the DMCA provided new rights to copyright holders, barring the circumvention of technological "self-help" measures used to protect their copyrights. *See* 17 U.S.C. §§ 1201-1205. Self help was to be copyright owners' principal new remedy. Title II of the DMCA codified immunities for Internet Service Providers ("ISPs"), which turn upon the particular role they play in the handling, storage, and dissemination of Internet content. 17 U.S.C. § 512.[2] In both titles, Congress recognized the substantial interest in protecting the privacy and freedom of expression of the over 100 million Internet users in this country. *See, e.g.*, *id.* §§ 512(m), 1205; *see also* S. Rep. No. 105-190, at 18 (1998) ("[T]he committee concluded that it was prudent to rule out any scenario in which section 1201 might be relied upon to make it harder, rather than easier, to protect personal privacy on the Internet.").

Title II of the DMCA codified a crucial distinction between different functions in which an ISP might be engaged. At one end of the spectrum, an ISP may be "hosting" information on its own network or systems. *See* 17 U.S.C. § 512(c). At the other end of the spectrum, an ISP may merely act as a passive conduit for communications created, controlled, and stored by others, storing the information only as long as necessary to transmit it. *Id.* § 512(a). Falling somewhere in between these two extremes are "caching" functions, in which an ISP stores intermediate or temporary copies of information hosted elsewhere on the Internet, in order to increase speed and ease of access to that information, *id.* § 512(b); and search services, which may provide hyperlinks to information stored permanently (or at least semi-permanently)

[2] A copy of 17 U.S.C. § 512 is attached as an addendum to this Motion for the convenience of the Court.

elsewhere on the Internet, *id.* § 512(d).

The DMCA makes clear that ISPs enjoy the same immunities that have traditionally applied to entities that provide a pure "transmission" or "conduit" function. 17 U.S.C. § 111(a)(3) (pre-DMCA statutory limitation on liability for passive carriers); *see also, e.g., WGN Continental Broadcasting Co. v. United Video,* 693 F.2d 622, 624-25 (7th Cir. 1982) (discussing section 111(a)(3)). Consistent with this recognition, section 512(a) does not impose *any specific duties* on ISPs serving as a conduit for transmission of the content of others. By contrast, subsections (b), (c), and (d) of section 512 impose limited duties to assist copyright owners in protecting their property interests where the ISP has some access to, or control over, the particular material claimed to be infringing. These duties are carefully calibrated depending upon the ISP's involvement with, and control over, the material at issue. Thus, in stark contrast to subsection (a), subsection (c) (which relates to "hosting" functions) provides that where a user stores content on the service provider's systems or network (*e.g.*, the provider "hosts" a website) it must respond to a specifically defined DMCA notice that the material is infringing. *Id.* § 512(c)(1)(C).

Title II of the DMCA also contains a unique subpoena provision, section 512(h), which is at issue here. This provision was designed to require an ISP to identify the owner of particular content stored on the provider's network that is claimed to be infringing in a valid DMCA notice as provided in subsection (c). *See id.* § 512(h)(4) (notice must "satisf[y] the provisions of subsection (c)(3)(A)" for any subpoena to issue). The limitation of this unique subpoena power to the subsection (c) context makes perfect sense in light of the service provider's ability to examine and control the content stored on its own systems. It also reflects the difference between burdening ISPs with the role of "copyright policeman," requiring them to invade the privacy of their subscribers, and requiring ISPs to exercise narrowly targeted, content-specific functions for material resident on their own facilities.

On its face, section 512(h) imposes no requirement that there be a pending court case prior to issuance of a subpoena. Indeed, the requesting party need not even allege the elements of any civil action within the jurisdiction of the federal courts. Although the requestor must

recite that the subpoena's "purpose" is to identify an alleged infringer and that information obtained will be used for "protecting rights" under the copyright laws, no suit need ever be brought, or even contemplated, for a subpoena to issue. 17 U.S.C. § 512(h)(2)(C).

Indeed, the notice that accompanies the subpoena requires only the assertion of "a good faith belief" – but not even necessarily a reasonable one or one resulting from a reasonable investigation – that infringement has occurred.[3] That is, the showing necessary to obtain a Section 512(h) subpoena need not even pass the Rule 11 sanctions test for filing a lawsuit.[4]

Finally, nothing in section 512(h) requires notice to the real party in interest (the purported infringer), and thus nothing requires that any attempt be made to bring the potential adverse party before the court.

B. Defendants' Actions

The RIAA has obtained issuance of hundreds of DMCA subpoenas that purport to require that PBIS identify subscribers at unique listed Internet Protocol ("IP") addresses at particular dates and times[5] that were allegedly involved in using copyrighted materials without authorization. Declaration of Rhonda K. Compton ("Compton Decl.") ¶ 2 & Exhs. A-D. According to the RIAA, these PBIS subscribers were using "peer-to-peer" applications (such as KaZaA, Gnutella, and eDonkey) – *i.e.*, software that allows multiple users to exchange files residing on their personal computers directly with those on the personal computers of others – to

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[3] *See id.* § 512(c)(3)(A)(v); *Rossi v. Motion Picture Ass'n of Am.*, No. 02-00239BMK, 2003 U.S. Dist. LEXIS 1864, at *8-*9 (D. Haw. Apr. 29, 2003) (stating that "good faith" provision in subsection (c) does not even "require[] a copyright holder to conduct an investigation to establish actual infringement prior to sending a notice to an ISP").

[4] Section 512(h) does not require the pleading of the elements of an infringement cause of action. While an action for copyright infringement can be brought only by the owner of the exclusive rights, 17 U.S.C. § 501(b); *Gardner v. Nike, Inc.*, 279 F.3d 774, 781 (9th Cir. 2002), section 512(h) allows agents of copyright owners to obtain subpoenas. And while registration of the copyright with the U.S. Copyright Office is a *jurisdictional* prerequisite to an infringement lawsuit, 17 U.S.C. § 411, section 512(h) requires no such proof of registration.

[5] Whenever a user is connected to the Internet, the ISP assigns the user a numerical "address." This IP address cannot be associated with the user's name and real address, allowing users to browse web sites, read email, and post speech to chat rooms anonymously. Many copyright owners now use electronic robots or "bots" to search the Internet for words or other snippets suggesting the presence of copyrighted material. When they identify such material, they use software to associate the material with an IP address, which they can then use to identify the ISP.

infringe copyrights owned by RIAA member companies. *See id.*, Exhs. A-D.

Similarly, Titan has previously served a subpoena on PBIS purporting to order it to identify subscribers at 59 unique listed IP addresses at particular dates and times that were, according to Titan, allegedly involved in using copyrighted materials without authorization. *Id.* ¶ 3 & Exhs. E-F. As with the RIAA subpoenas, the subscribers whose identities Titan sought were purportedly using peer-to-peer applications. *See id.*, Exh. F. Although Titan subsequently withdrew this subpoena, it has continued to send PBIS notices under the purported authority of the DMCA. *Id.* ¶¶ 4-5 & Exhs. G-H. A notice received on September 23, 2003 states that PBIS "may receive a subpoena requiring you to provide the name and other identifying information for this subscriber," requests that PBIS send a copy of the notice to the subscriber, and refers the subscriber to the web site address www.TitanLegal.com. *Id.*, Exh. H. The web page at www.TitanLegal.com states, "If you do not accept this offer to settle we will subpoena . . . your service provider for your name and address and WE WILL PURSUE ADDITIONAL ACTION INCLUDING FILING A FEDERAL LAWSUIT AGAINST YOU seeking maximum damages, attorney's fees and costs." *Id.,* Exh. I.

MediaForce has not yet served PBIS with any DMCA subpoenas, but it has sent PBIS thousands of purported DMCA notices based on PBIS' provision of conduit functions to subscribers using peer-to-peer applications. Compton Decl. ¶ 7 & Exh. J. As explained above, sending valid DMCA notices to a service provider is a necessary precondition to obtaining DMCA subpoenas.

III. ARGUMENT: PBIS Is Entitled to Judgment as a Matter of Law that a Judicial Subpoena Cannot Be Issued or Enforced Outside a Pending Case or Controversy

Summary judgment is appropriate where there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); *Anderson v. Liberty Lobby,* 477 U.S. 242, 248-49 (1986). Claim two of PBIS' complaint presents a pure issue of law, and thus is amenable to resolution on a motion for summary judgment. *Williams v. City of Oakland,* 915 F. Supp. 1074, 1075 (N.D. Cal. 1996).

In disregard of Article III, 17 U.S.C. § 512(h) purports to authorize the issuance of judicial process absent a pending case, without any requirement that the elements of a legal cause of action be alleged, and without the presence of the potentially adverse party (the person whose identifying information is sought). In so doing, the statute attempts to impose upon the judiciary the non-judicial function of supervising investigation by a private non-litigant on an *ex parte* basis. This the Constitution does not permit. Article III does not authorize the use of federal judicial power to investigate *possible* civil wrongdoing or to identify *possible* defendants outside the context of an actual "case" or "controversy."

A. Courts may act only where there is a pending case or controversy

Article III of the Constitution limits the exercise of federal judicial power to specifically enumerated "cases" and "controversies." U.S. Const., art. III, § 2. A "case" in the constitutional sense has consistently been defined as "a suit instituted according to the regular course of judicial procedure." *Muskrat v. United States*, 219 U.S. 346, 356 (1911) (citation omitted). "The requirement that a case or controversy anchor [a federal court's] jurisdiction as a threshold matter spring[s] from the nature and limits of the judicial power of the United States and is inflexible and without exception." *United States v. Larson*, 302 F.3d 1016, 1019 (9th Cir. 2002) (internal quotations omitted).

Article III's case or controversy clause requires, at a minimum, an adversarial proceeding that involves at least two parties, a cause of action within the jurisdiction of the federal courts, and a prayer for judicial relief that is determinative of some set of rights or obligations as between those parties. *Hayburn's Case*, 2 U.S. 408 (1792); *Osborn v. Bank of United States*, 22 U.S. 738, 819 (1824); *United States v. Ferreira*, 54 U.S. 40 (1851); *Gordon v. United States*, 117 U.S. Appx. 697, 699-706 (1864); *Muskrat*, 219 U.S. at 353-63. "A justiciable controversy is definite, concrete, real, and substantial; it is subject to specific relief. A controversy is not justiciable if it is hypothetical, abstract, academic, or moot." *Campbell v. Wood*, 18 F.3d 662, 680 (9th Cir. 1994). In the absence of such a case or controversy, a federal court is without authority to take any judicial action except dismissal of the proceeding. *Ex parte McCardle*, 74 U.S. 506, 514 (1868); *Mansfield, C. & L.M. Ry. Co. v. Swan*, 111 U.S. 379, 382 (1884); *Steel Co.*

v. Citizens for a Better Env't, 523 U.S. 83, 94 (1998).

Congress cannot expand the federal courts' case or controversy jurisdiction by legislation that would convert them into free-floating investigative bodies to discover facts unconnected to the adjudication of actual disputes. *See Hayburn's Case*, 2 U.S. at 410 (concluding that a law assigning judges the task of taking pension applications and making recommendations to the Secretary of War unconstitutionally imposed duties "not of a judicial nature"); *United States v. Ferreira*, 54 U.S. 40, 46-47 (1851) (striking down a law assigning Florida judges the task of adjusting claims by Spanish inhabitants under the Treaty of 1819 in *ex parte* proceedings based "upon such evidence as he may have before him, or be able himself to obtain").

As the Supreme Court explained in *United States v. Morton Salt Co.*, 338 U.S. 632 (1950), "[f]ederal judicial power itself extends only to adjudication of cases and controversies and it is natural that its investigative powers should be jealously confined to these ends." *Id.* at 641-42. In upholding the ability of a federal agency to monitor compliance with a previously entered judicial decree, the Court drew a sharp distinction between these "investigative and accusatory duties," properly lodged in an executive agency, and the more limited role of the Article III courts. *Id.* at 643. While the agency could engage in a "fishing expedition" for evidence of civil or criminal wrongs, "[c]ourts have often disapproved the employment of the judicial process in such an enterprise." *Id.* at 641-42; *see also Marbury v. Madison*, 5 U.S. 137, 171-72 (1803); *United States v. Yale Todd* (U.S. 1794), *inserted by order of the Court at United States v. Ferreira,* 54 U.S. 40, 52-53 (1851); *Gordon*, 117 U.S. Appx. at 699-706; *United States Catholic Conf. v. Abortion Rights Mobilization, Inc.*, 487 U.S. 72, 76 (1988).[6]

[6] Assigning the clerk of the court the non-judicial role of issuing subpoenas for private parties outside of any pending case will also interfere with operations of the Judicial Branch itself by diverting resources from their proper adjudicative role. Indeed, the clerk's office of the district court in Washington, D.C. has already been flooded with subpoena requests and has been forced to reassign personnel from other tasks. *See RIAA Nearing 1,000 Subpoenas Against File-Sharing Suspects*, SiliconValley.com, July 18, 2003, *at* <http://www.siliconvalley.com/mld/siliconvalley/6335275.htm>; *see also Music Industry Files First Wave of Lawsuits Against Swappers,* USAToday.com, Sep. 9, 2003, *at* <http://www.usatoday.com/life/2003-09-08-riaa_x.htm> ("The RIAA this summer filed more than 1,600 subpoenas requiring Internet service providers to turn over personal data about subscribers."). In other litigation addressing the DMCA's subpoena provision, Judge Bates of the District Court for the District of Columbia alluded to this possibility as a substantial separation of powers concern, but held that the concern

B. Federal courts may issue subpoenas where there is a pending, live controversy

1. Federal courts may issue subpoenas in aid of a pending federal case, but the DMCA does not require a pending federal case

Subpoenas issued by federal courts are also subject to Article III's case or controversy limitation. Issuance and enforcement of a subpoena by a federal court in the context of a case pending before a federal court plainly will not run afoul of Article III, because the existing case must itself satisfy Article III. Because the DMCA's subpoena provision does not require a pending federal court case, however, that authority is not enough to support 17 U.S.C. § 512(h).

Moreover, while federal courts have limited authority to issue or enforce subpoenas in other contexts, that limited authority is insufficient to provide constitutional cover for section 512(h). In *In re Verizon Internet Services, Inc.,* 257 F. Supp. 2d 244, 256 (D.D.C. 2003), an action to which PBIS was not a party, Judge Bates of the District Court for the District of Columbia held that the DMCA's subpoena provision does not violate Article III. In so holding, Judge Bates relied on several scenarios in which federal courts issue or enforce subpoenas, notwithstanding the lack of any pending federal case. As explained below, the scenarios considered by Judge Bates do not support the conclusion that the DMCA's subpoena provision is constitutional.

2. Federal courts may issue subpoenas in aid of a pending controversy before Congress or an administrative agency, but the DMCA does not require such a pending controversy

Judge Bates relied on the existence of several statutes that authorize courts to issue subpoenas in connection with pending legislative or administrative controversies, notwithstanding the lack of a pending federal court action. The mere existence of these provisions does not support finding the DMCA's subpoena provision constitutional; PBIS is unaware of any court opinion addressing the constitutionality of these other subpoena provisions. However, this Court need not grapple with the question whether these other provisions, not presently before the Court, are constitutional, because each of those provisions, unlike the

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was "speculative" because "no barrage of requests has occurred." *In re Verizon Internet Services, Inc.,* 257 F. Supp. 2d 244, 256 (D.D.C. 2003). What the district court deemed to be speculation at the time *Verizon* was decided has now clearly come to pass.

DMCA, requires that there be a pending controversy *somewhere.*

Where there is a pending controversy before Congress or an administrative agency, Congress may authorize the judicial branch to issue and enforce subpoenas in aid of resolution of that dispute. Thus, for example, the Federal Contested Elections Act ("FCEA"), 2 U.S.C. § 318 *et seq.,* authorizes a judge or clerk of a district court to issue subpoenas for depositions in connection with contested House elections. *See* 2 U.S.C. § 388. In *McIntyre v. Morgan,* 624 F. Supp. 658 (S.D. Ind. 1985), the court held that this provision is limited to situations in which the subpoenas are issued in connection with a pending FCEA action.[7] *See id.* at 663; *see also* 2 U.S.C. § 386(c) (prescribing time of taking of depositions in an FCEA action). In so holding, the court recognized that "in order for there to be a 'case' or 'controversy' there must be a genuine dispute between the parties, not between one party and someone not before the Court." *Id.* at 661; *see also id.* at 661-62 (Article III requires an alleged injury "that fairly can be traced to the challenged actions of the defendant, and not injury that results from the independent action of some third party not before the court" (quoting *Simon v. Eastern Kentucky Welfare Rights Organization,* 426 U.S. 26, 41-42 (1976)). In sum, in order for a valid FCEA subpoena to issue, there must be a live case or controversy between an elected Representative and a party contesting that election.

Similarly, 35 U.S.C. § 24 allows courts to issue deposition subpoenas only where there is a pending "*contested case* in the Patent and Trademark Office." 35 U.S.C. § 24 (emphasis added). Court-issued subpoenas in connection with proceedings under the Railway Labor Act can only issue where there is a pending arbitration between a carrier and its employees. *See* 45 U.S.C. § 157. Subpoenas under the Plant Variety Protection Act must be issued in connection with a "*contested case* in the Plant Variety Protection Office." 7 U.S.C. § 2354(a) (emphasis added).

In contrast, the DMCA's subpoena provision does not require that there be any pending

[7] In order to contest an election under the FCEA, the party contesting the election (the "contestant") file a notice of contest with the Clerk of the House of Representatives, and must serve the notice on the person declared the winner in the contested election (the "contestee"). *See* 2 U.S.C. §§ 381, 382.

case or controversy, whether in federal court or elsewhere – indeed, because the person whose identity is being sought need not be given any notice of the subpoena, one of the parties to the *possible* controversy generally will not even know that there *is* a possible controversy.

3. Courts also have limited authority to issue subpoenas in connection with pre-filing discovery

In *Verizon,* Judge Bates also analogized the DMCA's subpoena provision to Rule 27 of the Federal Rules of Civil Procedure, which allows a party to petition for an order allowing discovery to be taken prior to the filing of an action in federal court. *See* 257 F. Supp. 2d at 252-54. Unlike the DMCA's subpoena provision, however, Rule 27 includes key procedural safeguards to ensure that ordering the discovery sought is consistent with Article III.

A petition pursuant to Rule 27 must be founded on an actual case or controversy between adverse parties that are before the Court. The verified petition must aver that the petitioner expects to file an action cognizable in federal court, though he or she is presently unable to do so, and must also identify the persons the petitioner expects will be adverse parties in that action. Fed. R. Civ. P. 27(a)(1). In contrast, a person seeking a subpoena under § 512(h) need not indicate that he or she expects to file suit against the purported infringer. *See* 17 U.S.C. § 512(h).

Moreover, a Rule 27 petitioner must serve the petition "in the manner provided in Rule 4(d) for service of summons" on the expected adverse parties. Fed. R. Civ. P. 27(a)(2). A Rule 27 petition thus bears all the hallmarks of an Article III case or controversy. Indeed, the Supreme Court had described a petition to perpetuate testimony as a "suit." *State of Ariz. v. State of Cal.,* 292 U.S. 341, 347 (1934). Further, a court must affirmatively determine that the petitioner has made a proper showing under Rule 27 *prior* to issuance of an order allowing discovery. *See, e.g., Petition of State of N.C.,* 68 F.R.D. 410, 412 (S.D.N.Y. 1975) (denying Rule 27 petition where the petitioner failed to establish that the anticipated action would be within federal jurisdiction).[8] The DMCA's subpoena provision does not require any notice to the

[8] Courts may also order pre-suit discovery in connection with foreign disputes. 28 U.S.C. § 1782(a). Section 1782(a) was amended in 1964 to allow subpoenas to issue notwithstanding the lack of a pending court action, but still applies only where there are "judicial or quasi-judicial

person whose identifying information is sought, and requires issuance of a subpoena upon a mere averment that the requesting party has a "good faith belief" that the target of the subpoena has engaged in infringing activity. No showing of a factual basis in support of this "belief" is required. Judge Bates' attempt to analogize section 512(h) to Rule 27 was inapt.

C. Federal courts may *enforce* subpoenas duly issued by other governmental bodies

Finally, federal courts may *enforce* subpoenas issued by other governmental bodies – but the subpoenas must themselves be valid (i.e. issued pursuant to some duly authorized grant of power). For example, a grand jury's authority itself to issue subpoenas was already well-established at the time the United States were formed. *See Kastigar v. United States,* 406 U.S. 441, 443-44 (1972) (grand jury's subpoena power dates back at least to 1612).

The grand jury is a "constitutional fixture in its own right," that belongs to none of the three branches of the government. *United States v. Williams,* 504 U.S. 36, 47 (1992) (quotation marks and citations omitted). Although the grand jury functions "under judicial auspices," the judicial branch's "direct involvement in the functioning of the grand jury has generally been confined to the constitutive one of calling the grand jurors together and administering their oaths of office." *Id.* Because the grand jury is not subject to Article III's limitations, it may engage in investigations regardless of whether there is a pending case or controversy. *Id.* at 48. However, the grand jury has no power to compel compliance with its subpoenas. *Id.* That function is left to the judiciary. *Id.* Article III is fully honored in this process because once enforcement proceedings are initiated, there is a live controversy pending before the federal court – between the grand jury and the reluctant witness.

Similarly, when Congress (or an agency acting pursuant to a lawful delegation of powers from Congress) issues subpoenas, Article III is not offended if federal courts are asked to enforce them. In *Interstate Commerce Comm'n v. Brimson,* 154 U.S. 447 (1894), the Supreme Court

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controversies." *In re Letters of Request to Examine Witnesses from the Court of Queen's Bench for Manitoba, Canada,* 488 F.2d 511, 512 (9th Cir. 1973) (quoting and agreeing with district court); *see also In re Letters Rogatory from the Toyko District, Tokyo,* 539 F.2d 1216, 1218-19 (9th Cir. 1976). Moreover, where there is no pending foreign action, section 1782(a) has been construed to incorporate the safeguards prescribed by Rule 27 of the Federal Rules of Civil Procedure. *In re Letter of Request from Supreme Court,* 138 F.R.D. 27, 30-31 (S.D.N.Y. 1991).

held that enforcement of duly-issued ICC subpoenas was judicial in nature, and thus consistent with Article III. The Court reaffirmed the principle that Congress "may not impose upon the courts of the United States any duties not strictly judicial." *Id.* at 485. Duties related to the enforcement of ICC subpoenas, however, "are judicial in their nature." *Id.* Enforcement of a duly issued ICC subpoena requires a "determination of the issues between [the ICC] and a witness," *id.* at 486, and thus requires adjudication of a live controversy.

This judicial power – to enforce duly issued subpoenas – is not enough to support the DMCA's subpoena provision, because under the DMCA, a subpoena is not issued by an agency, but rather *by the court,* without any requirement of a live case or controversy. 17 U.S.C. § 512(h)(4). "[T]he subpoena power of a court cannot be more extensive than its jurisdiction." *United States Catholic Conference v. Abortion Rights Mobilization, Inc.*, 487 U.S. 72, 76 (1988). Unlike non-judicial bodies such as grand juries, federal courts lack any authority to engage in investigations absent a live case or controversy. *Williams,* 504 U.S. at 48. Thus, "if a district court does not have subject-matter jurisdiction over the underlying action, and the process was not issued in aid of determining that jurisdiction, then the process is void and an order of civil contempt based on refusal to honor it must be reversed." *United States Catholic Conf.,* 487 U.S. at 76; *see also Morton Salt*, 338 U.S. at 642 ("The *judicial* subpoena power . . . is subject to those *limitations inherent in the body that issues them* because of the provisions of the Judiciary Article of the Constitution." (emphases added)).

When a DMCA supboena issues in the absence of a pending federal case, there *is no underlying action,* and thus a federal court is wholly without authority to issue a subpoena. Under *United States Catholic Conference,* a subpoena issued without authority is void; there is nothing to enforce, and thus there cannot be a live controversy over its enforcement.

D. The DMCA's subpoena provision violates Article III to the extent that it purports to authorize federal courts to issue subpoenas absent a pending controversy

The DMCA unconstitutionally attempts to expand federal courts' subpoena power. Section 512(h) does not limit federal courts' involvement to the mere enforcement of subpoenas issued by an administrative agency, but directly involves them in the actual issuance of the

subpoenas without a pending or impending case. As explained above, this is beyond a federal court's authority.

To the extent that Defendants believe that they have evidence sufficient to establish that some person whose identity they do not know is infringing their copyrights, the proper recourse is to sue that person as a Doe defendant, and to seek leave to take discovery to identify the defendant under well-established procedures that are consistent with Article III.[9] Judge Jensen addressed the issue of when discovery will be allowed prior to service of process on the defendant in *Columbia Insurance Co. v. Seescandy.com,* 185 F.R.D. 573 (N.D. Cal. 1999). Judge Jensen began by observing that "[a]s a general rule, discovery proceedings take place only after the defendant has been served" but that "in rare cases, courts have made exceptions." *Id.* at 577. Judge Jensen ultimately allowed the plaintiff to seek the identity of the defendant from third parties, but only after establishing several prerequisites for seeking that discovery, including that the plaintiff "establish to the Court's satisfaction that plaintiff's suit against defendant could withstand a motion to dismiss." *Id.* at 579. These requirements were designed, *inter alia*, to "ensure that federal requirements of jurisdiction and justiciability can be satisfied," "to prevent abuse of this extraordinary application of the discovery process and to ensure that plaintiff has standing to pursue an action against defendant." *Id.* at 578-79. Significantly, Judge Jensen held that the "plaintiff must make some showing that an act giving rise to civil liability actually occurred" before forcing disclosure of the defendant's identity and that "[a] conclusory pleading will never be sufficient to satisfy this element." *Id.* at 579-80.

In issuing a subpoena pursuant to the DMCA, a federal court acts with but one party before it, no pending controversy (whether in federal court or elsewhere), no idea whether the

[9] The RIAA contends that the process of discovering the elements of a claim is as simple as two steps – logging on and searching files: "By logging onto these open networks and searching for files like any other user, the RIAA is able to identify the Internet Protocol addresses ('IP addresses') of individuals who are illegally uploading or downloading our works." Testimony of Cary Sherman, President, RIAA, before the Senate Commerce Committee, Sept. 19, 2003, *at* <http://commerce.senate.gov/hearings/testimony.cfm?id=919&wit_id=2584>. What the RIAA seeks, however, is the subpoena power without ever filing a claim or putting a case before a court. The evidence of this is already clear. The RIAA has reportedly obtained in excess of 1600 subpoenas, yet it has reportedly filed no more than 261 lawsuits. *See supra,* note 6 and articles cited therein.

person the requesting party seeks to unmask is even within the personal jurisdiction of any federal court, and without any assurance that any federal case can or will ever be brought. To the extent that the DMCA's subpoena provision is invoked outside the context of a federal case, it is unconstitutional.

IV. CONCLUSION

For the foregoing reasons, PBIS respectfully requests that the Court grant its motion for summary judgment as to claim two of its complaint, and that the Court declare that the subpoena power contained in 17 U.S.C. § 512(h) is limited to judicial process issued and enforced in aid of a pending lawsuit under the Copyright Act.

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