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7
8 UNITED STATES DISTRICT COURT
9 NORTHERN DISTRICT OF CALIFORNIA
10 SAN FRANCISCO DIVISION
11

12 PACIFIC BELL INTERNET SERVICES,
13
14 Plaintiff,

15 v.

16 RECORDING INDUSTRY ASSOCIATION
OF AMERICA, INC., MEDIASENTRY, INC.
d/b/a MEDIAFORCE, and IO GROUP, INC.,
17 d/b/a TITAN MEDIA, TITANMEDIA.COM,
TITANMEN.COM,
18

19 Defendants.

Case No. C 03-3560 SI

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

Date: November 21, 2003
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Courtroom: 10, 19th Floor
Judge: Hon. Susan Illston

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1 I. INTRODUCTION¹

2 PBIS' opening brief explained that a subpoena purportedly authorized by 17 U.S.C.
3 § 512(h) is a curious beast, neither fish nor fowl, that violates Article III of the Constitution. The
4 subpoena is not a legislative subpoena, issued by Congress or an agency operating with power
5 delegated from Congress. It is not an executive subpoena, issued by a grand jury or by some
6 department of the Executive Branch pursuant to its power to "take Care that the laws be
7 faithfully executed." U.S. Const. Art. II, § 3. It is not a subpoena issued or enforced by the
8 courts in aid of either the legislative or executive branch. Finally, because it is not a subpoena
9 issued in connection with any concrete legal dispute, extant or expected, and in light of the
10 constitutional rule that the judicial power extends only to cases or controversies, the subpoena
11 contemplated by § 512(h) falls outside the judicial power as well.

12 Nevertheless, DMCA subpoenas purport to carry *some* form of authority, else they could
13 simply be ignored. Equally clearly, the authority they purport to carry is judicial,
14 notwithstanding the RIAA's contention (erroneously adopted by the *Verizon* Court) that they are
15 simply ministerial acts of court clerks apparently moonlighting as *ex officio* agents of the
16 recording industry. After all, were PBIS simply to ignore them, it could anticipate being held in
17 contempt of *court*, not "contempt of clerk." That exercise of judicial power, absent a case or
18 controversy, is unconstitutional.

19 II. ARGUMENT

20 In opposition, the RIAA² makes three principal assertions: first, that no case or

21 _____
22 ¹ Titan and MediaSentry both incorporated by reference the RIAA's opposition to PBIS' motion
23 for summary judgment. Beyond the arguments raised by the RIAA, Titan and MediaSentry each
24 argue that summary judgment should be denied, because PBIS' claims against them should be
dismissed. The latter argument fails for the reasons stated in PBIS' oppositions to their
respective motions to dismiss. The arguments incorporated by reference from the RIAA's
opposition fail for the reasons expressed below.

25 The United States' opposition, for the most part, merely repeats arguments raised by the
26 RIAA. *See* U.S.' Oppo. at 2:2 ("the United States only seeks here to highlight certain
arguments"). To the extent that the United States has presented arguments not raised by the
27 RIAA, those arguments are addressed, below, in the context in which they arise.

28 ² The RIAA's opposition to PBIS' motion for summary judgment purports to limit the RIAA's
role in this case to that of an agent for five specific RIAA members: Universal Music Group,
EMI Music North America, Sony Music Entertainment Inc., BMG Music, and Univision Music,

1 controversy is required to allow a subpoena to issue because institutions other than courts
2 routinely issue (and courts routinely enforce) subpoenas without a pending case or controversy;
3 second, that if a case or controversy is required, § 512(h) comes close enough to requiring one
4 because it is analogous to Rule 27 (which the RIAA presumes to be constitutional); and third,
5 that if a case or controversy is required, and if the analogy to Rule 27 is not enough to provide
6 one, the RIAA's desire for the records held by an ISP, and the ISP's resistance to that desire,
7 amounts to a case or controversy cognizable by Article III.

8 None of those assertions has merit. First, the fact that an institution other than a court
9 may issue a subpoena without a case or controversy does not bear on the question whether a
10 court may do so – the Constitution and our constitutional system bestows different powers on
11 different branches of government. Congress, an agency, or the executive branch may exercise
12 general investigatory powers to decide whether a case should be brought; courts, confined by the
13 Constitution to acting in “cases” or “controversies,” may not. Second, Rule 27 provides no
14 support for § 512(h) because if Rule 27 is constitutional, it is simply because it comes with both
15 a long historical pedigree and stringent functional requirements, while § 512(h) has neither.
16 Third, the mere fact that one party wants something another party has, but can't get it, does not
17 amount to a case or controversy in the constitutional sense of those words.

18 Section 512(h) remains an unprecedented innovation, requiring courts to lend their
19 coercive power to private actors with no pending case, no expected case, no requirement that
20 there be a subsequent case (or even an allegation that one may follow), no governmental
21 oversight, and no basis in the constitutional scheme.

22
23
24 Inc. See RIAA's Oppo. at 1 n.1. First, a *defendant* cannot limit its role in a lawsuit by fiat
25 announced in an unadorned footnote. Second, the RIAA has obtained numerous subpoenas
26 directed to PBIS that seek the identity of PBIS subscribers who have purportedly infringed
27 copyrights owned by Time Warner subsidiaries – subsidiaries that are not mentioned in the
28 RIAA's footnote. See PBIS' Oppo. to Pet. of Time Warner for Leave to File Brief as *Amicus Curiae* at 2 (filed Oct. 31, 2003). Either the RIAA is acting on behalf of record labels owned by Time Warner – in which case footnote 1 in its opposition brief is, at a bare minimum, highly misleading; or it has applied for DMCA subpoenas based, in part, on the purported infringement of copyrights that are not owned by any party on whose behalf the RIAA has been acting.

1 **A. A Federal Court’s Exercise of Subpoena Power Is Constrained by Article III**

2 “Federal judicial power itself extends only to adjudication of cases and controversies and
3 it is natural that its investigative powers should be jealously confined to these ends.” *United*
4 *States v. Morton Salt Co.*, 338 U.S. 632, 641-42 (1950). This limitation also applies to
5 subpoenas, because “the subpoena power of a court cannot be more extensive than its
6 jurisdiction.” *United States Catholic Conference v. Abortion Rights Mobilization, Inc.*, 487 U.S.
7 72, 76 (1988).

8 The familiar issuance of subpoenas in connection with pending federal court cases, Fed.
9 R. Civ. P. 45, is consistent with this limitation, because a pending federal court action is a
10 “case.” The DMCA’s subpoena provision, however, purports to authorize the clerk of a court to
11 issue a subpoena without requiring that there be a case or controversy that is being adjudicated.
12 *See* 17 U.S.C. § 512(h). Unless this anomaly can be explained, section 512(h) violates Article
13 III. As explained below, the RIAA’s arguments fail to justify section 512(h), and thus the
14 DMCA’s subpoena provision must be limited to judicial process issued and enforced in aid of a
15 pending lawsuit under the Copyright Act.

16 **B. DMCA Subpoenas Are an Attempted Exercise of Judicial Power**

17 The RIAA argues that DMCA subpoenas are not issued as an exercise of judicial power,
18 but fails to explain the power under which they *do* issue. *See* RIAA’s Oppo. at 13:16-22:3.
19 Citing *Mistretta v. United States*, 488 U.S. 361 (1989), the RIAA argues that Article III is not
20 violated when judges are assigned extrajudicial duties. The issue in *Mistretta*, however, was
21 whether Article III judges could be required to serve on the United States Sentencing
22 Commission, a body that exercises quasi-legislative powers. *See id.* at 372. The Supreme Court
23 held that nothing in Article III prohibits federal judges from serving on independent
24 commissions such as the Sentencing Commission. *Id.* at 397. As the Court explained, nothing in
25 *Hayburn’s Case*, 2 U.S. 408 (1792), or *United States v. Ferreira*, 54 U.S. 40 (1851), prohibits
26 Congress from conferring upon a federal judge non-judicial powers if those powers are “assigned
27 to judges acting individually as commissioners.” 488 U.S. at 403. “Congress may authorize a
28 federal judge, *in an individual capacity*, to perform an executive function without violating the

1 separation of powers.” *Id.* (emphasis added).³

2 When it enacted the DMCA, by contrast, Congress did not appoint court clerks to a new
3 and additional position in which they would exercise legislative power. When court clerks issue
4 DMCA subpoenas, they act in the same manner that they do when they issue subpoenas pursuant
5 to Rule 45 in aid of pending federal actions. Indeed, the subpoenas are signed by the court clerk
6 using the title of “Clerk” of the “United States District Court.” *See, e.g.*, Declaration of Rhonda
7 K. Compton, Exhs. A-D (filed Sept. 26, 2003). The subpoenas are assigned case numbers and
8 thus appear, in form, substantially the same as they would if they were issued pursuant to
9 pending federal litigation. Nothing suggests that the clerk has somehow magically been
10 transformed into a non-judicial officer.

11 The RIAA also notes that subpoenas are often issued in other contexts even where no
12 federal complaint is pending. In many instances, the RIAA points to investigative subpoenas
13 issued by governmental bodies other than federal courts. As PBIS explained in its moving
14 papers, however, governmental bodies that are not constrained by Article III are not subject to
15 the case or controversy limitation on judicial power. *See* PBIS’ Mot. at 11:16-17 (grand juries)
16 (citing *United States v. Williams*, 504 U.S. 36, 48 (1992)). These examples thus offer no support
17 for the RIAA’s argument that a *court clerk* is not exercising judicial power when issuing DMCA
18 subpoenas. *See* PBIS’ Mot. at 12:7-23.

19 The RIAA also cites examples where court clerks issue subpoenas absent a complaint
20 pending in federal court, but the cited examples are situations in which there *is* a controversy – in
21 the Article III sense – pending before some body. PBIS explained that distinction thoroughly in
22 its moving papers. *See* PBIS’ Mot. at 8:17-9:24. For example, judicial officers are authorized to
23 issue subpoenas under the Federal Contested Elections Act (“FCEA”). *See* 2 U.S.C. § 388.
24 Although FCEA controversies are resolved before the House, when the House adjudicates a
25

26 ³ For the same reason, federal judges can exercise powers as extradition officers, because
27 Congress has empowered them in that instance to act as *executive* officers rather than in their
28 capacity as judicial officers. *See Lo Duca v. United States*, 93 F.3d 1100, 1105-07 (2d Cir.
1996); *Lopez-Smith v. Hood*, 121 F.3d 1322, 1327 (9th Cir. 1997) (citing *Lo Duca*) (“We agree
with the conclusion of the Second Circuit”).

1 contested election under the FCEA, it exercises judicial power. *See Dornan v. Sanchez*, 978 F.
2 Supp. 1315, 1321-22 & n.5 (C.D. Cal. 1997). The FCEA thus does not implicate the exercise by
3 a judicial officer of legislative power, but the exercise of judicial power by the legislature. *See*
4 *also McIntyre v. Morgan*, 624 F. Supp. 658, 661-63 (S.D. Ind. 1985) (holding that the FCEA's
5 subpoena power is limited to aiding FCEA actions pending before the House, and noting that "in
6 order for there to be a 'case' or 'controversy' there must be a genuine dispute between the
7 parties, not between one party and someone not before the Court").

8 In a similar manner, although the Federal Arbitration Act ("FAA") authorizes the use of
9 subpoenas where the only pending controversy is before a private arbitral body, *see* 9 U.S.C. § 7,
10 that arbitration must be a matter over which a district court, but for the agreement to arbitrate,
11 "would have jurisdiction under Title 28, in a civil action or in admiralty of the subject matter of a
12 suit arising out of the controversy between the parties." 9 U.S.C. § 4. Just as with the FCEA, the
13 FAA's subpoena power requires a concrete and pending controversy in the Article III sense,
14 albeit one in which some body other than a federal court is exercising authority that is judicial in
15 nature.

16 The same analysis applies to many of the statutes the RIAA cites, in which bodies other
17 than federal courts are exercising authority that plainly is judicial in nature. *See* 35 U.S.C. § 24
18 (contested cases in the Patent and Trademark Office); 45 U.S.C. § 157 (Railway Labor Act
19 arbitrations); 7 U.S.C. § 2354(a) (contested cases in the Plant Variety Protection Office). The
20 fact that the other body is not a federal court is of no import, and any suggestion by the RIAA to
21 the contrary elevates form over substance. Those examples thus also fail to support the RIAA's
22 argument that issuance of DMCA subpoenas does not involve judicial power. *See* PBIS' Mot. at
23 9:25-10:3.

24 In any event, the RIAA's argument ultimately founders due to a failure to explain what
25 exactly it is that the RIAA thinks the court clerk *is* doing, if not exercising judicial power.
26 Perhaps a court clerk could be said to be exercising Article I power when issuing subpoenas in
27 contested congressional elections. And perhaps the same could be said when a court clerk issues
28 subpoenas in aid of disputes pending before administrative agencies or arbitral bodies. Given the

1 quasi-judicial character of those proceedings, PBIS would argue otherwise. *See Dornan*, 978 F.
2 Supp. at 1321-22 & n.5. The key point, however, is that the court clerk is exercising *some* sort of
3 duly authorized power – judicial or legislative – in those instances.

4 The DMCA is decidedly different. Congress is not supervising the RIAA’s campaign
5 against filesharers. Nor is an agency.⁴ If a court clerk is not exercising judicial power when
6 issuing a DMCA subpoena, then what power is being exercised? The RIAA leaves that question
7 unanswered – and indeed the question is unanswerable, for the simple reason that the “clerk of
8 [the] United States district court” (17 U.S.C. § 512(h)(1)) is, in fact, exercising judicial power
9 when issuing DMCA subpoenas. Were it otherwise, the subpoenas would be based on no power
10 whatsoever, and would no more compel a response than a letter from a private citizen asking for
11 the same information.

12 **C. Rule 27, Even if Constitutional, Provides No Support for Holding Section 512(h)**
13 **Constitutional**

14 The RIAA also argues that section 512(h) must be constitutional, because otherwise Rule
15 27 would be unconstitutional. This argument fails for at least two reasons. First, the practice
16 governed by Rule 27 – suits to perpetuate testimony – predates the Constitution itself, and that
17 historical pedigree may insulate Rule 27 from constitutional challenge in a way that is uniquely
18 limited to Rule 27 itself. Second, contrary to the RIAA’s assertions, Rule 27 contains important
19 differences from section 512(h) that militate in favor of Rule 27’s constitutionality and against
20 section 512(h)’s.

21 **1. Rule 27 has a distinguished historical pedigree that may insulate it – but not**
22 **more modern innovations – from constitutional challenge**

23 The Supreme Court noted in *Rosenberger v. Rector and Visitors of University of*
24 *Virginia*, 515 U.S. 819 (1995), that the “singular, 200-year pedigree of legislative chaplains . . .
25 justified carving out an exception” to the ordinary understanding the Establishment Clause. *Id.*

26 ⁴ The lack of any oversight is significant. In sharp contrast to the many subpoena procedures
27 cited by the RIAA, the adversarial process is not available to police the use of DMCA
28 subpoenas, because the adverse party – the purported infringer – is not given notice of the
proceedings. *See* 978 F. Supp. at 1322 (noting that for both discovery in court actions and
discovery pursuant to the FCEA “the adversarial system regulates the propriety of a particular
subpoena”).

1 at 872 n.2 (citing *Marsh v. Chambers*, 463 U.S. 783, 791 (1983)). The Court declined, however,
2 to adopt a broad rule based on this unusual example. “Given that the decision [in *Marsh*]
3 upholding this practice was expressly limited to its facts . . . it would stand the Establishment
4 Clause on its head to extract from it a broad rule permitting the funding of religious activities.”
5 515 U.S. at 872 n.2.

6 The Supreme Court has adopted a similar approach to its interpretation of Article III, as
7 applied to longstanding practices that might otherwise appear to be contrary to the general rules
8 restricting federal judicial power. In *Vermont Agency of Natural Resources v. United States ex*
9 *rel. Stevens*, 529 U.S. 765 (2000), the Supreme Court held that *qui tam* suits, in which a relator
10 sues to remedy an injury-in-fact suffered by the government, do not violate Article III’s case or
11 controversy requirement. The Court’s holding was based on two alternative grounds. First, it
12 reasoned that a *qui tam* relator is, effectively, the assignee of a portion of the government’s
13 damages claim, and thus the relator has “representational standing” as an assignee. *Id.* at 773-74.

14 Alternatively, the Court reasoned that “the long tradition of *qui tam* actions in England
15 and the American Colonies” established that such actions are consistent with Article III. *Id.* The
16 Court noted that the practice of allowing *qui tam* actions originated toward the end of the 13th
17 century, and that “[*q*]ui *tam* actions appear to have been as prevalent in America as in England,
18 at least in the period immediately before and after the framing of the Constitution.” *Id.* at 774-
19 77. The Court concluded that “this history [is] well nigh conclusive with respect to the question
20 before us here: whether *qui tam* actions were ‘cases and controversies of the sort traditionally
21 amenable to, and resolved by, the judicial process.’” *Id.* at 777 (quoting *Steel Co. v. Citizens for*
22 *Better Environment*, 523 U.S. 83, 102 (1998)); see also *Marsh v. Chambers*, 463 U.S. 783, 790
23 (1983) (special deference is owed to “[a]n act passed by the first Congress assembled under the
24 Constitution, many of whose members had taken part in framing that instrument”).

25 The practice of allowing suits to perpetuate testimony, now governed by Rule 27, has a
26 similarly distinguished historical pedigree. The RIAA concedes that suits to perpetuate
27 testimony have “a pedigree stretching back to the time of the Framers.” RIAA’s *Oppo.* at 2:5;
28 see also *Arizona v. California*, 292 U.S. 344, 347 (1934) (noting that suits to perpetuate

1 testimony were “known as an independent branch of equity jurisdiction before the adoption of
2 the Constitution”). This history is, in and of itself, sufficient to explain why Rule 27 might well
3 withstand constitutional challenge, were its constitutionality at issue in the present proceedings.
4 The historical fact of suits to perpetuate testimony should not, however, be presumed to reflect a
5 broad rule authorizing federal courts to interfere in matters where there is no pending case or
6 controversy. *See Rosenberger*, 515 U.S. at 872 n.2; *cf. Vermont Agency*, 529 U.S. at 777.⁵

7 **2. Rule 27 is not precedent for section 512(h), because Rule 27 contains**
8 **substantive requirements that section 512(h) does not**

9 The RIAA attempts to convince the Court that the DMCA’s subpoena provision is in all
10 material respects identical to Rule 27, but can only do so by ignoring key differences between
11 the two. According to the RIAA, a § 512(h) subpoena, just like a Rule 27 subpoena, is a prelude
12 to a potential federal court action.” RIAA’s Oppo. at 9:20-21. Section 512(h), however,
13 promises no such thing, while Rule 27 requires it. *Compare* 17 U.S.C. § 512(h)(2)(C) (requiring
14 only that the information sought “will only be used for the purpose of protecting rights under this
15 title,” but not requiring any statement regarding a future lawsuit) *with* Fed. R. Civ. P. 27(a)(1)
16 (petitioner must aver that he or she “expects to be a party to an action cognizable in a court of the
17 United States” (emphasis added)). No petitioner under Rule 27 could swear such an oath unless
18 she affirmatively intended to file a complaint; no petitioner under section 512(h) is required to
19 hold any such intention.

20 The undisputed facts confirm that the RIAA *could not* have met the requirement of Rule

21 ⁵ The RIAA also notes, without explanation, that courts of equity have allowed bills of discovery
22 to ascertain the identity of a party against whom suit may be brought. RIAA’s Oppo. at 9:14-17.
23 An equitable bill of discovery, however, originally “required the plaintiff in such a bill to set
24 forth his case upon the merits, and it allowed the defendant, not only to demur, so raising the
25 validity of the plaintiff’s action at law, but even to plead facts which would defeat that action.”
26 *Pressed Steel Car Co. v. Union P. R. Co.*, 241 F. 964, 966 (S.D.N.Y. 1917) (Learned Hand, J.)
27 (citation omitted). By the early twentieth century, the procedure had been simplified, but the
28 requesting party was still required to “plead those facts which entitle him to a discovery.” *Id.*
Stated in modern terms, the party seeking discovery was required to plead facts that
demonstrated an objective basis for a federal complaint. As PBIS explained in its moving
papers, the DMCA’s subpoena provision requires only a subjective “good faith belief” – which
apparently may be divorced from any actual objective facts – that infringement has occurred.
PBIS’ Mot. at 4:4-7 & nn. 3-4. Thus, just as the RIAA cannot rely upon analogy to suits to
perpetuate testimony, neither can it rely on analogy to bills of discovery.

1 27 for a substantial number of the DMCA subpoenas it has obtained. The RIAA has obtained
2 over 1,600 subpoenas in its recent campaign against music fans. *See* PBIS' Mot. at 7 n.6. The
3 RIAA, however, has filed suit only against a fraction of these purported infringers.⁶ Even if one
4 excludes subpoenas that purportedly resulted in settlements⁷ and the subpoenas contested by
5 PBIS, hundreds of subpoenas obtained by the RIAA have turned out not to be preludes to suits.

6 The RIAA next claims that a party requesting a DMCA subpoena "has a certain cause of
7 action for copyright infringement." RIAA's Oppo. at 9:23. Again, this statement is false. In
8 requesting a DMCA subpoena, the requesting party must submit a DMCA notice that states that
9 the complaining party has a "good faith belief" that infringement has occurred, and the
10 complaining party "is authorized to act on behalf of the owner of an exclusive right that is
11 allegedly infringed," 17 U.S.C. § 512(c)(3)(A)(v)-(vi). But section 512(h) requires no objective
12 basis for the "good faith belief" of infringement, *Rossi v. Motion Picture Ass'n of Am.*, No. 02-
13 00239BMK, 2003 U.S. Dist. LEXIS 12864, at *8-*9 (D. Haw. Apr. 29, 2003),⁸ and requires no
14 statement that the copyright allegedly infringed is registered with the U.S. Copyright Office,
15 which is a jurisdictional prerequisite to an infringement lawsuit, 17 U.S.C. § 411.

16 The RIAA's attempt to explain away the other differences between Rule 27 and section
17 512(h) are also without merit.⁹ The RIAA concedes that Rule 27 prohibits *ex parte* discovery,
18 but argues that *ex parte* proceedings are allowed by Article III, citing Rule 65(b). *Ex parte*

19
20 ⁶ *See Recording Industry Begins Suing P2P File Sharers Who Illegally Offer Copyrighted Music*
21 *Online*, www.RIAA.com, Sept. 8, 2003, at <<http://www.riaa.com/news/newsletter/090803.asp>>
(261 lawsuits filed); *RIAA files 80 new file-swapping suits*, News.com, Oct. 30, 2003
(hereinafter, "80 new file-swapping suits"), at <<http://news.com.com/2100-1027-5099738.html>>
(80 lawsuits filed).

22 ⁷ *See 64 Individuals Agree To Settlements In Copyright Infringement Cases*, www.RIAA.com,
23 Sept. 29, 2003, at <<http://www.riaa.com/news/newsletter/092903.asp>> (12 settlements post-
24 subpoena, but prior to filing of a complaint); *80 new file-swapping suits*, *supra*, note 6 (124
settlements post-subpoena and warning letter, but prior to filing of a complaint).

25 ⁸ The lack of any requirement of a *showing* that infringement has occurred is particularly notable
given that one need not be an attorney to request a DMCA subpoena.

26 ⁹ In this regard, the proof of the pudding is in the eating: if – as the RIAA suggests – the
27 DMCA's subpoena power is coextensive with that of Rule 27, we wouldn't be here. But of
28 course the two statutes are not coextensive, which is why the RIAA and its members lobbied
Congress for the DMCA, rather than simply relying on the Rule 27 procedures already available
to them.

1 restraining orders, however, are subject to sharp limits and substantial judicial oversight, *see* Fed.
2 R. Civ. P. 65(b), and they are issued in connection with filed lawsuits. Those limits are similar
3 to the requirements set forth by Judge Jensen in *Columbia Insurance Co. v. Seescandy.com*, 185
4 F.R.D. 573 (N.D. Cal. 1999). Notably, Judge Jensen expressly stated that these requirements are
5 necessary to “ensure that federal requirements of jurisdiction and justiciability can be satisfied.”
6 *Id.* at 578. While *ex parte* proceedings may not be *per se* unconstitutional, *see Federal Deposit*
7 *Ins. Corp. v. Bank One, Waukesha*, 881 F.2d 390, 394 (7th Cir. 1989), that does not mean that a
8 lack of notice to the adverse party has no constitutional significance. Rather, section 512(h)’s
9 lack of a requirement of notice to the other real party in interest, combined with its lack of any
10 requirement that a complaint be on file, or be expected to be filed, collectively demonstrate that
11 the DMCA’s subpoena provision fails to ensure that subpoenas are issued only in a manner
12 consistent with Article III’s requirement of a case or controversy.

13 The United States argues that, in fact, section 512(h)’s “good faith” requirement is the
14 same as the showing courts have required in order to obtain discovery in “John Doe”
15 proceedings. U.S.’ Oppo. at 11 n.9. That is incorrect. First, in *Columbia Insurance*, Judge
16 Jensen required far more than a good faith belief that the defendant’s conduct violated a statute.
17 He required that the plaintiff “make some showing that an act giving rise to civil liability actually
18 occurred.” 185 F.R.D. at 580. In determining that the plaintiff in that case had met that
19 standard, Judge Jensen looked well beyond the subjective beliefs held by the plaintiff, going so
20 far as to consider substantial evidence in support of the plaintiff’s trademark infringement claim.
21 *Id.* (considering, among other things, thirty-one email messages proffered by the plaintiff that
22 evidenced “actual confusion,” which is an element of a trademark infringement claim). Nor is
23 *Doe v. 2The-Mart.com Inc.*, 140 F. Supp. 2d 1088 (W.D. Wash. 2001), to the contrary. Indeed,
24 the subpoena at issue in *2The-Mart.com* sought the identity of a third-party witness in connection
25 with an underlying case pending in the Central District of California, in which both the plaintiffs
26 and the defendants were named parties. *Id.* at 1089-90 (“There is a federal court lawsuit pending
27 in the Central District of California in which the shareholders of TMRT have brought a
28 shareholder derivative class action against the company and its officers and directors alleging

1 fraud on the market. . . . By subpoena, TMRT seeks to obtain the identity of twenty-three
2 speakers . . .”). The subpoena in *2The-Mart.com*, which related to a pending federal complaint
3 in which neither the plaintiffs nor defendants were “Doe” parties, plainly did not violate Article
4 III.¹⁰ Second, by filing a “John Doe” complaint, the plaintiff certifies that it has made “an
5 inquiry reasonable under the circumstances,” and that the complaint’s allegations “have
6 evidentiary support or, if specifically so identified, are likely to have evidentiary support after a
7 reasonable opportunity for further investigation or discovery.” Fed. R. Civ. P. 11(b).¹¹ In short,
8 because “John Doe” proceedings require the filing of a complaint, there necessarily is a
9 requirement of more than a mere subjective good faith belief that the plaintiff has a cause of
10 action upon which relief can be granted.

11 Finally, the RIAA argues that section 512(h) is no different than a hypothetical statute
12 that does away with procedures such as the one fashioned by Judge Jensen and that instead
13 authorizes *immediate* issuance of subpoenas in “John Doe” actions. The short answer is that the
14 RIAA’s hypothetical statute is just that – hypothetical. The RIAA must resort to attacking PBIS’
15 position by relying on a hypothetical statute for the very reason that courts have not interpreted
16 existing law in the way the RIAA would like. Rather, courts permit subpoenas seeking the
17 identity of John Doe defendants only if the complainant can make a *prima facie* showing that the
18 law has been violated. *See, e.g., Columbia Ins.*, 185 F.R.D. at 579-80. It is far from clear that

19 _____
20 ¹⁰ The United States also relies, indirectly, on an unpublished state court opinion that was
21 subsequently reversed, albeit on other grounds, by the Virginia Supreme Court. *See In re*
22 *Subpoena Duces Tecum to America Online, Inc.*, No. 40570, 2000 WL 1210372 (Va. Cir. Ct. Jan
23 31, 2000), *rev’d on other grounds sub nom. America Online, Inc. v. Anonymous Publicly Traded*
24 *Co.*, 542 S.E.2d 377 (Va. 2001). First, Article III does not apply to state court proceedings.
25 *ASARCO v. Kadish*, 490 U.S. 605, 617 (1989). Second, although the Virginia court did state that
26 it was determining whether the plaintiff in the underlying case had a “good faith” basis for its
27 allegations, the court required that the plaintiff demonstrate an objective *factual* basis for its
28 claims. 2000 WL 1210372, at *8 (“this Court required APTC to produce the subject Internet
postings, so that the Court could better determine whether there is, in fact, a good faith basis for
APTC’s allegations”).

29 ¹¹ Although Rule 11 applies on its face to a request for a DMCA subpoena, *see* Fed. R. Civ. P.
30 11(b) (Rule 11 applies to any paper presented to the court), that merely means that the request
31 must satisfy the requirements set forth in section 512(h). That is, Rule 11 requires that there be
32 evidentiary support for the assertion that the requesting party *has a good faith belief* that
33 infringement has occurred. Because section 512(h) does not require an assertion that

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1 Congress could authorize identity subpoenas in “John Doe” suits based only on the information
2 required by section 512(h). Indeed, given that section 512(h) does not require allegations that
3 the requesting party owns the purportedly infringed copyright or that the copyright is registered
4 with the Copyright Office, the RIAA’s hypothetical statute would be incompatible with the basic
5 rules governing all complaints. In any event, whether such a statute, were it ever to be enacted,
6 would be constitutional has not been determined by any court, and thus this hypothetical statute
7 serves as no precedent to authorize section 512(h).¹²

8 In light of the foregoing, PBIS respectfully disagrees with Judge Bates’ conclusion that
9 “the requirements for obtaining a § 512(h) subpoena are similarly rigorous” to those under Rule
10 27. *In re Verizon Internet Services, Inc.*, 257 F. Supp. 2d 244, 252 (D.D.C. 2003). Rule 27 does
11 not render section 512(h) constitutional, because of both the long historical tradition that
12 supports Rule 27 (but not modern innovations like section 512(h)) and the significant functional
13 differences noted immediately above.

14 **D. The Possible Dispute Between the Requesting Party and the ISP Is Not an Article III**
15 **Case or Controversy**

16 The RIAA’s final argument regarding Article III – that there is a cognizable Article III
17 dispute between the party that applied for a DMCA subpoena and the ISP from whom the
18 information is sought – is a desperate bootstrap. If the RIAA were correct, the requirement of a
19 case or controversy would be meaningless. Article III requires more than a dispute – after all,

20 infringement in fact *has* occurred (but only an assertion of a good faith belief), Rule 11
21 apparently requires no more. *See Rossi*, 2003 U.S. Dist. LEXIS 12864 at *8-*9.

22 ¹² Perhaps aware that this argument is nothing but a straw man, the RIAA further argues that
23 PBIS is wrong to suggest that the prohibition of discovery prior to a Rule 26 conference has
24 constitutional implications, noting that prior to the 1993 amendments (and as of the 1946
25 amendments) to Rule 26, a plaintiff could take depositions without leave of court twenty days
26 after commencement of an action. What the RIAA neglects to mention is that courts construed
27 Rule 26 (as amended in 1946 and prior to the 1993 amendments) to require service of the
28 complaint and summons on the defendants prior to the noticing of any depositions by the
plaintiff. *Application of Royal Bank of Canada*, 33 F.R.D. 296, 299 (S.D.N.Y. 1963);
Westerman v. Grow, 198 F. Supp. 309, 309-10 (S.D.N.Y. 1961); *Netter v. Ashland Paper Mills,*
Inc., 19 F.R.D. 529, 531 (S.D.N.Y. 1956); *Caribbean Constr. Corp. v. Kennedy Van Saun Mfg.*
& Eng’g Corp., 13 F.R.D. 124, 126-27 (S.D.N.Y. 1952). Discovery prior to notice to the
adverse party is and has been the exception, subject to stringent judicial oversight, not the rule.
See Columbia Ins., 185 F.R.D. at 577.

1 any time one party argues a lack of a case or controversy, there necessarily is a dispute over that
2 point.

3 Statutes authorizing suits against fiduciaries who have breached their duties by, for
4 example, failing to provide information to which the complaining party has a statutory right are
5 not to the contrary. As the RIAA points out, when an ERISA administrator fails to produce
6 information to which a plan beneficiary is entitled under the act, that statutory violation can be
7 remedied using judicial power. The ERISA scheme, however, is qualitatively different than
8 section 512(h). An administrator who “fails or refuses to comply with a request for any
9 information which such administrator is required by this subchapter to furnish to a participant or
10 beneficiary” can be liable to the “participant or beneficiary in the amount of up to \$100 a day
11 from the date of such failure or refusal, and the court may in its discretion order such other relief
12 as it deems proper.” 29 U.S.C. § 1132(c)(1). In order to obtain such relief, the participant or
13 beneficiary must *file a lawsuit against the administrator*. *Id.* § 1132(a)(1)(A). In other words,
14 federal courts may be called upon to adjudicate a suit by an ERISA plan beneficiary or
15 participant for statutory damages against an ERISA plan administrator. Such a lawsuit is, in all
16 respects, an Article III controversy, and the RIAA fails to explain why that statutory scheme
17 suggests that the lawsuit-less use of DMCA subpoenas in *discovery* proceedings against a third
18 party is constitutional.

19 Statutes authorizing suits against government agencies to enjoin them from failing to
20 comply with the law are similarly unhelpful to the RIAA’s cause. The RIAA cites 5 U.S.C.
21 § 552(a), apparently attempting to call the Court’s attention to 5 U.S.C. § 552(a)(4)(B), which
22 authorizes individuals to sue agencies for failure to comply with the Freedom of Information Act
23 (“FOIA”). As with the ERISA provision, a FOIA suit begins with a *complaint* filed in federal
24 court. 5 U.S.C. § 552(a)(4)(B). The next step is an answer filed by the defendant agency. *Id.*
25 § 552(a)(4)(C). Citizen lawsuits to enjoin government officials to follow the law are Article III
26 controversies. *Cf. Ex parte Young*, 209 U.S. 123 (1908). The DMCA’s subpoena provision is,
27 again, entirely different. ISPs are not government officials, and the DMCA’s subpoena provision
28 does not require the filing of a complaint.

1 The United States' argument, that cases and controversies need not be "presented by
2 traditional forms of procedure, invoking only traditional remedies," U.S.' Oppo. at 10 n.8
3 (quoting *Nashville, Chattanooga & St. Louis Ry. v. Wallace*, 288 U.S. 249, 264 (1933)), fares no
4 better. While "traditional forms of procedure" are not required, in order to satisfy Article III's
5 requirement of a case or controversy, the "case [must] retain[] the essentials of an adversary
6 proceeding, involving a real, not a hypothetical, controversy, which is finally determined by the
7 judgment below." 288 U.S. at 264. Section 512(h) fails this test. First, only one adversary is
8 present – the party requesting the subpoena need not give notice to the purported infringer, and
9 need not make any showing that the purported infringer even is subject to the jurisdiction of the
10 court that issues the subpoena. Second, the requesting party need only have a "good faith" belief
11 that infringement has occurred, and thus no showing of an *actual* controversy, rather than a mere
12 subjective belief in one, is required. Finally, resolution of the *only* proceeding pending *anywhere*
13 – the miscellaneous matter that is docketed when the request for a subpoena is filed – will not
14 "finally determine" the theoretical dispute between the requesting party and the purported
15 infringer. Although "Congress is not confined [in fashioning federal courts' jurisdiction] to
16 traditional forms or traditional remedies," *Aetna Life Ins. Co. of Hartford, Conn. v. Haworth*, 300
17 U.S. 227, 240 (1937), it cannot extend a federal court's jurisdiction to matters that lack "the
18 essentials of an adversary proceeding, involving a real, not a hypothetical, controversy, which is
19 finally determined by the judgment below." *Nashville, Chattanooga & St. Louis Ry.*, 288 U.S. at
20 264; *see also Aetna Life Ins. Co.*, 300 U.S. at 242 (holding that there was a case or controversy
21 "between parties who face each other in an adversary proceeding").

22 In order to qualify as a case or controversy, a dispute must be "of the sort traditionally
23 amenable to, and resolved by, the judicial process." *Steel Co.*, 523 U.S. at 102. Judicial process
24 is not traditionally brought to bear on a private party's desire for information as part of the
25 investigation of a possible cause of action.¹³

26 _____
27 ¹³ In an argument that appears only in the introduction to its brief, the RIAA also argues that "[a]
28 'case or controversy' . . . clearly exists at the time a DMCA subpoena issues. Indeed, the express
requirements of § 512(h) guarantee the existence of a concrete dispute under federal copyright
law between the copyright owner and an alleged infringer." RIAA Oppo. at 1:20-23. Contrary

1 **E. Whether Provisions Other than Section 512(h) Must Be Struck as Unconstitutional**
2 **Is Not Before the Court**

3 The RIAA finally argues that if section 512(h) is unconstitutional, the entirety of section
4 512 must be struck. PBIS disagrees, but the disagreement is academic. The only Article III
5 issue raised by PBIS' complaint is the constitutionality of section 512(h). No party has sought a
6 ruling, much less alleged a present case or controversy, over the severability of section 512(h).
7 Whatever ramifications this Court's ruling might have in other contexts is a question that should
8 be left for another day.

9 **III. CONCLUSION**

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

15 Dated: November 7, 2003

KEKER & VAN NEST, LLP

16
17 By: 

18 RAGESH K. TANGRI
19 Attorneys for Plaintiff
20 PACIFIC BELL INTERNET SERVICES
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25 to the RIAA's bald assertion, however, that is not a "concrete dispute cognizable under federal
26 law." *Id.* at 1:21. Rather, the DMCA authorizes parties to obtain court-issued process for the
27 purpose of merely investigating a dispute that might (or might not) later be brought as a federal
28 lawsuit. A dispute in which only one party (the requesting party) shows up, of which the other
party has not even been apprised, in which no relief from the other party to the dispute (the
purported infringer) has been sought, and regarding which the first party has not even indicated it
expects it will ever file suit bears no resemblance to an Article III controversy.