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9 [See Exhibit A]

10 UNITED STATES DISTRICT COURT
11 NORTHERN DISTRICT OF CALIFORNIA
12 SAN FRANCISCO DIVISION

13 321 STUDIOS,

14 Plaintiff,

15 v.

16 METRO-GOLDWYN-MAYER STUDIOS,
17 INC., et al.,

18 Defendants.

Case No. C 02-1995 SI

**BRIEF AMICI CURIAE OF COPYRIGHT
LAW PROFESSORS IN SUPPORT OF
PLAINTIFF'S OPPOSITION TO
DEFENDANT'S MOTION FOR PARTIAL
SUMMARY JUDGMENT**

19 METRO-GOLDWYN-MAYER STUDIOS
20 INC., et al.,

21 Counterclaimants,

22 v.

23 321 STUDIOS, also known as 321 Studio,
24 LLC; ROBERT MOORE, an individual;
25 ROBERT SEMAAN, an individual; and
26 VICTOR MATTISON, an individual,

27 Counterclaim Defendants.
28

Date: April 25, 2003
Time: 9:00 A.M.
Judge: Hon. Susan Illston

1 **STATEMENT OF INTEREST OF AMICI**

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

14 **SUMMARY OF ARGUMENT**

15 Congress is empowered to legislate only pursuant to a power enumerated in the
16 Constitution. Neither the text nor the legislative history of the DMCA indicates which power
17 Congress relied on to enact the anti-device provisions, but the DMCA’s anti-device provisions
18 are not a valid exercise of any of Congress’ enumerated powers. They prohibit devices without
19 regard for originality, duration of copyright, or infringement of copyright in the underlying,
20 technologically-protected work. Therefore, they are not a valid exercise of the intellectual
21 property power. Nor are the DMCA provisions justifiable under the Commerce Clause. Insofar
22 as the anti-circumvention rules do not permit fair uses to be made of copyrighted works, these
23 rules also violate limits on the scope of copyright and copyright-like protection required by the
24 First Amendment.

25
26 _____
27 ¹ A list of the professors joining this brief is attached hereto as Exhibit A. Amici do not
28 represent or speak for their institutions in this matter, and institutional affiliations are listed for
identification purposes only.

1 ARGUMENT

2 **I. The Intellectual Property Clause Authorizes Protection for “Writings,” Not for**
3 **Technologies Regardless of Originality, Invention, Duration, or Infringement.**

4 The Intellectual Property Clause authorizes Congress only to grant exclusive rights in
5 “[w]ritings” and “[d]iscoveries,” and only for “limited [t]imes.” U.S. Const. Art. I, § 8, cl. 8;
6 *The Trade-Mark Cases*, 100 U.S. 82, 93-94 (1879). Congress’ placement of the anti-device
7 provisions in Title 17 of the United States Code, home to the Copyright Act, suggests that it may
8 have believed these provisions to be an exercise of the intellectual property power. *See id.* at 93.
9 But the anti-device provisions are not limited in scope to protection of statutory rights in writings
10 still under copyright protection; instead, they ban devices regardless of whether the devices are
11 actually used to gain access to, or infringe copyright in, a work that copyright protects.

12 The Intellectual Property Clause “is both a grant of power and a limitation.” *Graham v.*
13 *John Deere Co.*, 383 U.S. 1, 5 (1966). It permits grants of exclusive protection only for those
14 “discoveries” in the “useful arts” that would not have been obvious to one reasonably skilled in
15 the art, *Graham*, 383 U.S. at 6, and only for those “writings” that constitute original expression,
16 *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349-50 (1991). Congress may not
17 extend protection to unoriginal subject matter, nor to ideas, processes, methods of operation, and
18 the like unless the threshold for patentability is met. *Feist*, 499 U.S. at 349-50; *Baker v. Selden*,
19 101 U.S. 99, 103-04 (1879). Nor may it grant protection for proper subject matter in perpetuity.
20 *Eldred v. Ashcroft*, 123 S.Ct. 769, 778 (2003). A law that protects informational goods without
21 regard for these limitations cannot claim the Intellectual Property Clause as its authority. *The*
22 *Trade-Mark Cases*, 100 U.S. at 93-94 (holding that Intellectual Property Clause could not
23 authorize law protecting trademarks regardless of “novelty, invention, discovery, or any work of
24 the brain” or of “fancy or imagination”).

25 The anti-device provisions do not meet this exacting standard. They operate regardless of
26 whether the device is original or inventive, and regardless of whether it is used to access
27 information that is a constitutionally protectable writing, regardless of whether the work so
28 accessed has passed into the public domain, and regardless of whether the desired use of the

1 work would infringe copyright. Indeed, they operate regardless of whether the accused device
2 has been used at all. *See* 17 U.S.C. § 1201(a)(2), (b)(1). *The Trade-Mark Cases* make clear that
3 the Intellectual Property Clause does not permit such a tenuous connection. The House
4 Commerce Committee recognized as much. *See* H.R. Rep. 105-551, Part 2, 105th Cong., 2d
5 Sess. 23-25 (1998) (recommending that a ban on devices be implemented “as free-standing
6 provisions of law” external to Title 17, “in large part because these regulatory provisions have
7 little, if anything, to do with copyright law”). Congress may have believed that the prohibition
8 was necessary to effectuate its intellectual property power in the digital age. That belief,
9 however, is incorrect.

10 **A. The Anti-Device Provisions Create New Intellectual Property Rights That Fail the**
11 **Constitutional Requirements of the Intellectual Property Clause .**

12 The anti-circumvention provisions of the Digital Millennium Copyright Act (DMCA)
13 creates three new intellectual property rights that plainly fail to satisfy three constitutional
14 requirements under Article I, Section 8, Clause 8. The grant of rights to control certain acts of
15 circumvention and the development and distribution of circumvention technologies is perpetual
16 in nature, not “for limited times” as the Constitution requires. *Eldred v. Ashcroft*, 123 S.Ct. 769,
17 778-81 (2003) (discussing the “limited times” requirement, although finding it satisfied by a
18 twenty year extension of copyright terms). Justice Stevens in his dissent explains that the
19 rationale for the balance created by the “limited times” requirement is the “promised access”
20 members of the public rely on at the expiration of the copyright term. *Eldred*, 123 S.Ct. at 800.
21 *Eldred* reiterates that grants of intellectual property rights are justifiable only if an intellectual
22 product is either an original expression by an author or an inventive discovery in the useful arts.
23 *Eldred*, 123 S.Ct. at 784-86. Anti-circumvention rights, however, do not depend on either
24 originality or invention. In *Eldred*, the Court cited approvingly to numerous precedents holding
25 that disclosure of an innovation is a requirement for grants of exclusive rights in technological
26 works. *Id.* at 787. The DMCA, in contrast, grants exclusive rights to control the development
27 and distribution of technologies without any disclosure as a quid pro quo. Furthermore, the
28 DMCA frustrates the legitimate access of copyrighted works by the general public, which “is the

1 overriding purpose of the constitutional provision.” *Eldred*, 123 S.Ct. at 800 (Stevens,
2 *dissenting*). Given these constitutional deficiencies, the DMCA anti-circumvention rules cannot
3 “promote the progress of science and useful arts.” They cannot, therefore, fulfill the
4 constitutional objective for granting intellectual property rights. *Eldred*, 123 S.Ct at 784-85.
5 Judge Whyte did not have the benefit of the Supreme Court’s *Eldred* decision when he opined
6 that the DMCA anti-circumvention rules were constitutional.² See *United States v. Elcom, Ltd.*,
7 203 F. Supp.2d 1111, 1127-42 (N.D. Cal. 2002). If *Eldred* is correct that copyright is generally
8 compatible with the First Amendment because of “built-in free speech safeguards,” such as fair
9 use and the idea/expression distinction, *Eldred*, 123 S.Ct. at 789-90, the same cannot be said of
10 the DMCA anti-circumvention rules which, as interpreted in cases such as *Universal City*
11 *Studios, Inc. v. Corley*, 273 F.3d 429, 443-44, 458-59 (2d Cir. 2001), lack fair use limitations.

12 **B. The Intellectual Property Power Is Limited By Design .**

13 The Intellectual Property Clause both confers and restricts the power to protect
14 intellectual creations. See *Graham v. John Deere Co.*, 383 U.S. 1, 5 (1966); *Feist Publications,*
15 *Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348-49 (1991) (“This [constitutional limit on the scope
16 of copyright protection] is neither unfair nor unfortunate. It is the means by which copyright

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18 ² Judge Whyte also did not have the benefit of very recent scholarship that delves into
19 constitutional deficiencies of the DMCA rules. See, e.g., Craig Allen Nard, *The DMCA’s Anti-*
20 *Device Provisions: Impeding the Progress of the Useful Arts*, 8 Wash. U. J. L. & Pol’y 19, 34-35
21 (2002) (“the anti-device provisions are inconsistent with patent law’s constitutional command to
22 promote the progress of the useful arts”); L. Ray Patterson, *The DMCA: A Modern Version of*
23 *the Licensing Act of 1662*, 10 J. Intell. Prop. L. 33, 57 (2002) (“the unconstitutionality of the
24 DMCA is beyond doubt”); Eugene R. Quinn, *An Unconstitutional Patent in Disguise: Did*
25 *Congress Overstep Its Constitutional Authority in Adopting the Circumvention Prevention*
26 *Provisions of the Digital Millennium Copyright Act?*, 41 Brandeis L. J. 33, 37 (2002)
27 (concluding that the DMCA anti-circumvention rules are unconstitutional because they “provide
28 patent protection that lasts forever, and fails [sic] to inquire whether the patentability
requirements in the Constitution are satisfied). See also Yochai Benkler, *Free As the Air to*
Common Use: First Amendment Constraints on the Enclosure of the Public Domain, 74 N.Y.U.
L. Rev. 354, 414-29 (1999); Jane C. Ginsburg, *From Having Copies to Experiencing Works:*
The Development of an Access Right in, available at http://papers.ssrn.com/paper/paper.taf?abstract_id=222493, forthcoming in U.S. COPYRIGHT LAW (Hugh Hansen,
ed. 2003); Glynn S. Lunney, *The Death of Copyright: Digital Technology, Private Copying and*
the DMCA, 87 Va. L. Rev. 813, 910-11 (2001); Neil Weinstock Netanel, *Locating Copyright*
Within the First Amendment Skein, 54 Stan. L. Rev. 1, 74-81 (2001); Jason Sheets, *Copyright*
Misused: The Impact of the DMCA Anti-Circumvention Measures on Fair and Innovative
Markets, 23 Hastings Comm. & Ent. L. J. 1, 25-27 (2001).

1 advances the progress of science and art.”); Yochai Benkler, *Constitutional Bounds of Database*
2 *Protection: The Role of Judicial Review in the Creation and Definition of Private Rights in*
3 *Information*, 13 Berkeley Tech. L.J. 535, 539-52 (2000); Paul J. Heald & Suzanna Sherry,
4 *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute*
5 *Constraint on Congress*, 2000 U. Ill. L. Rev. 1119, 1142-67 (2000). The Clause’s limitations are
6 the product of a distinct vision of what constitutes progress, and what promotes it.

7 The limitations on the intellectual property power originate in the history of Anglo-
8 American intellectual property law. The original English patents were Crown monopolies
9 extended to favored manufacturers, and were widely resented as arbitrary restraints on trade.
10 Edward C. Walterscheid, *The Early Evolution of the United States Patent Law: Antecedents*
11 *(Part 2)*, 76 J. Pat. & Trademark Off. Soc’y 849, 853 (1994). The original English copyright, a
12 Crown monopoly granted only to Crown-licensed printing houses, was both a powerful
13 instrument of state censorship and the tool for perfecting ironclad monopolization of the book
14 trade. The Crown enlisted licensed booksellers in the suppression of undesirable ideas; the
15 booksellers, in turn, enlisted the Crown in aid of their monopolies. They invoked their royal
16 charter as authority for private ordinances granting themselves exclusive rights in perpetuity and
17 “continually petitioned the Star Chamber to provide greater protection.” L. Ray Patterson,
18 *Understanding the Copyright Clause*, 47 J. Copyright Soc’y 365, 378-79 (2000).³

19 The licensing laws and the monopolies that they enabled were denounced (albeit
20 circumspectly) by leading exponents of the liberal political theory to which the Framers
21 subscribed. Most famously, in *Areopagitica*, a well-known political tract with which the
22 Framers were surely familiar, John Milton argued that ideas were not “a staple commodity . . . to
23 [be] mark[ed] and license[d] like our broadcloth and our woolpacks.” John Milton,
24 *Areopagitica: A Speech for the Liberty of Unlicensed Printing* 29 (H.B. Cotterill ed. 1959)
25 (1644). In 1694, following the Glorious Revolution of 1688, the royal licensing laws were

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27 ³ One could substitute “property rights” for “royal charter” and “Congress” for “the Star
28 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

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

9 The Framers of the Constitution were aware of this then-recent history, and intended the
10 Intellectual Property Clause to serve both an anti-censorship function and an anti-monopoly
11 function. As to government censorship, the power to grant "exclusive rights" to "authors" of
12 "writings" safeguards the private production of information independent of government
13 sponsorship or control. See Marci A. Hamilton, *The Historical and Philosophical*
14 *Underpinnings of the Copyright Clause*, Benjamin N. Cardozo School of Law Occasional Papers
15 in Intellectual Property No. 5, at 9-12 (1998); Neil Weinstock Netanel, *Copyright and a*
16 *Democratic Civil Society*, 106 Yale L.J. 283, 352-59 (1996); L. Ray Patterson & Stanley W.
17 Lindberg, *The Nature of Copyright: A Law of Users' Rights* 125-28 (1991). This safeguard
18 operates in conjunction with the Press Clause of the First Amendment, U.S. Const. amdt. 1,
19 which repudiates the intent behind the Stationers' Laws by ensuring that anyone who so desires
20 may operate a press.

21 The Clause's concern with censorship and monopolies, however, extends far beyond
22 overt state suppression of ideas. As Prof. Patterson has shown, the policies embodied in the
23 Statute of Anne and upheld in *Donaldson v. Beckett* were well-understood on this side of the
24 Atlantic. See Patterson, *Understanding the Copyright Clause*, at 380-83. Accordingly, the
25 Framers did not authorize Congress simply to confer patents and copyrights, as they could easily
26 have done, but more precisely "to promote the [p]rogress of [s]cience and useful [a]rts." This
27

28 Litman, *Copyright Legislation and Technological Change*, 68 Or. L. Rev. 275 (1989).

1 grant incorporates and enforces a specific vision of the sorts of exclusive rights that are
2 permitted: rights limited not only in duration, *see* U.S. Const. art. I, § 8, cl. 8, but also in scope.
3 These rights are not “property” rights — again, terminology which the Framers knew well and
4 could easily have chosen, and which has powerful natural law antecedents — but limited
5 monopolies to be prescribed by statute. Because patents and copyrights are statutory rights, and
6 because monopolies are disfavored, the limits inherent in the Clause’s carefully chosen language
7 must be strictly observed.

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

23 Similarly, to avoid the twin evils of censorship and monopoly, the Clause requires that
24 copyright be limited in both scope and effect. As in the case of patents, this principle dictates,
25 first, that no-one may invoke copyright to appropriate facts, ideas, or other information out of the
26 public domain. *Feist*, 499 U.S. at 349-50 (holding that Intellectual Property Clause compels
27 denial of copyright protection to facts, and also to unoriginal compilations of facts); *Baker v.*
28

1 *Selden*, 101 U.S. 99, 103-04 (1879) (denying copyright protection to accounting system that had
2 not received patent protection, and suggesting that Intellectual Property Clause requires this
3 result); *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834) (denying copyright protection to
4 transcriptions of Supreme Court arguments and opinions); *Clayton v. Stone*, 5 F. Cas. 999
5 (C.C.S.D.N.Y. 1829) (denying copyright protection to news reports); *see generally* Benkler,
6 *supra*, at 544-48; Heald & Sherry, *supra*, at 1165-66; Jessica Litman, *The Public Domain*, 39
7 Emory L.J. 965 (1990).⁴

8 The principle of limited protection requires, further, that copyright not confer the
9 exclusive right to control all uses of a work. The copyright regime created by Parliament,
10 contemplated by the Framers, and enacted by the first Congress was simply a right of
11 publication. *See* Patterson, *Understanding the Copyright Clause*, at 369-70. The Copyright Act
12 of 1976 bestows additional rights on authors, but scrupulously preserves fair use and other
13 doctrines that limit attempts to control personal use of lawfully acquired copies of works. *See*,
14 *e.g.*, 17 U.S.C. §§ 102(b) (idea-expression distinction), 107 (fair use), 109(a) (first sale). As
15 courts throughout our history have recognized, a right to censor uses would promote neither
16 learning nor “progress.” *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575-76 (1994)
17 (fair use parody); *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 432 &
18 n.13 (1984) (personal noncommercial copying) (“[Copyright] protection has never accorded the
19 copyright owner complete control over all possible uses of his work.”); *Bobbs-Merrill Co. v.*
20 *Straus*, 210 U.S. 339 (1908) (resale of lawfully acquired books); *Stover v. Lathrop*, 33 F. 348
21 (C.C.D. Colo. 1888) (same) (“The effect of a copyright is not to prevent any reasonable use of
22 the book which is sold. I may use the book for reference, study, reading, lending, copying
23 passages from it at my will.”); *Sega Enterprises, Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir.
24 1992) (reverse engineering of lawfully acquired software to discover uncopyrightable functional
25 principles).

26 _____
27 ⁴ By extension of this reasoning, federal copyright law and policy preempt all but narrow “hot
28 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).

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

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

4 The DMCA's anti-device provisions destroy the Intellectual Property Clause's carefully
5 crafted balance. First, the provisions effectively nullify the public's ability to make fair use of
6 the underlying copyrighted works when the desired use requires exact copying. *See Universal*
7 *City Studios, Inc. v. Reimerdes*, 111 F. Supp. 2d 294, 322-24 (S.D.N.Y. 2000), *aff'd sub nom.*
8 *Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2d Cir. 2001). It is simply insufficient to
9 say that many would-be fair users don't need to copy, and can content themselves with
10 transcribing portions of the text, or with reading directly from the text to their intended audience.
11 *See Corley*, 273 F.3d at 459; *Reimerdes*, 111 F. Supp. 2d at 337-38. The fair use doctrine shields
12 direct copying for purposes other than quotation. For example, one might use the DVD Copy
13 Code to transfer a lawfully purchased copy of a motion picture to a different device. *Cf. Sony*
14 *Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 442-55 (1984) (holding that
15 recording of television programs for "time-shifting" was fair use); *Recording Industry Ass'n of*
16 *America v. Diamond Multimedia Sys., Inc.*, 180 F.3d 1072, 1079 (9th Cir. 1999) (holding that
17 portable MP3 player that enabled "space-shifting" of digital music files was not a "digital audio
18 recording device" under the Audio Home Recording Act, and that this result was "consistent
19 with the Act's main purpose" because it facilitated "paradigmatic noncommercial personal use").
20 Moreover, since motion pictures incorporate images and sounds, direct copying of excerpts is the
21 analogue to direct quotation, which is essential. *See, e.g., Maxtone-Graham v. Burtchaell*, 803
22 F.2d 1253, 1260-65 (2d Cir. 1986), *cert. denied*, 481 U.S. 1059 (1987); *Rosemont Enterprises,*
23 *Inc. v. Random House, Inc.*, 366 F.2d 303, 307 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009
24 (1967); *Hofheinz v. AMC Production, Inc.*, 147 F. Supp. 2d 127, 137-38 (S.D.N.Y. 2001); *Norse*
25 *v. Henry Holt & Co.*, 847 F. Supp. 142, 145-46 (N.D. Cal. 1994); *Wojnarowicz v. American*
26 *Family Association*, 745 F. Supp. 130, 143-47 (S.D.N.Y. 1990); *Time, Inc. v. Bernard Geis*
27 *Associates*, 293 F. Supp. 130, 146 (S.D.N.Y. 1968).

1 Second, the anti-device provisions effectively nullify the public’s ability to access, use,
2 and copy public domain material, including copyright-expired material, shielded by
3 technological protection systems. *See* David Nimmer, *A Riff on Fair Use in the Digital*
4 *Millennium Copyright Act*, 148 U. Pa. L. Rev. 673, 727-39 (2000) (providing examples). This
5 problem is, if anything, more important than the first. Unlike fair use, copying from the public
6 domain is not judged according to a balancing test. It is always the public’s right. In dictum, the
7 *Corley* court characterized this argument as “premature and speculative” absent evidence that a
8 copyright owner actually had applied a technological measure to prevent copying from the public
9 domain. *Corley*, 273 F.3d at 445. With all due respect to the Second Circuit, we fail to see how
10 Congress’ authority to enact a law can be made to depend on the subsequent conduct of the law’s
11 beneficiaries. Such conduct might inform a First Amendment overbreadth inquiry; it has no
12 bearing here.

13 Third, the anti-device provisions forbid reverse engineering of platform-dependent
14 technological protection systems to allow other platforms to interoperate with the systems. This,
15 in turn, effectively prevents individuals who have purchased protected works — for example,
16 DVDs— from using a device such as the DVD Copy Plus to view these lawfully purchased
17 copies on DVD players that do not unlock the CSS encryption. Both prohibitions exceed the
18 constitutional limits of copyright protection. Reverse engineering of computer microcode to
19 discover the uncopyrightable functional principles embodied in the code prevents private
20 monopolization of unpatented technical standards. *See Sony Computer Entertainment, Inc. v.*
21 *Connectix Corp.*, 203 F.3d 596, 602-03 (9th Cir.), *cert. denied*, 121 S. Ct. 172 (2000); *Bateman*
22 *v. Mnemonics, Inc.*, 79 F.3d 1532, 1540 n.18 (11th Cir. 1996); *Sega Enterprises*, 977 F.2d at
23 1526; *cf. Bonito Boats*, 489 U.S. at 155-56, 159-61.⁵ And, as we have noted, copyright does not,
24 and cannot, give copyright owners the right to control private uses of lawfully acquired copies of
25 works. *See supra* pp. 15-16.

26
27 ⁵ Congress crafted a limited exception to the anti-device provisions for certain kinds of reverse
28 engineering. 17 U.S.C. § 1201(f). Whether this provision shields the reverse engineering at
issue here is a separate question, which we do not address.

1 The anti-device provisions do exclude some devices, but the exclusions fail to preserve
2 these constitutionally protected uses. First, the statutory language exempts devices that have
3 another “commercially significant purpose.” 17 U.S.C. § 1201(a)(2)(B), (b)(1)(B). But fair use
4 by definition rarely will be “commercially significant.” See 17 U.S.C. § 107 (directing court to
5 consider, among other factors, “the effect of the use upon the potential market for or value of the
6 copyrighted work”); *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 562
7 (1985). A device that facilitated access solely to public domain content might meet the
8 “commercially significant” test, but this possibility evaporates if the public domain materials are
9 repackaged with copyrighted content. See *Nimmer, supra*, at 712-14, 727-28. In any event, the
10 anti-device provisions ban even devices with other commercially significant uses if they are
11 “primarily designed” for circumvention of works protected by copyright or marketed with
12 knowledge that they will be so used. See 17 U.S.C. § 1201(a)(2)(A) & (C), (b)(1)(A) & (C).

13 It is no answer to these problems to say that this result is what Congress intended.
14 *Corley*, 273 F.3d at 443-44 & n.13. That option was not open to Congress. Nor is it an answer
15 to say that copyright infringement is an “epidemic” that warrants drastic intervention, *Reimerdes*,
16 111 F. Supp. at 331-32; Congress is not free to choose a cure that would kill the patient.

17 **II. The Commerce Clause Does Not Empower Congress to Abrogate Limits on the** 18 **Intellectual Property Power.**

19 Finally, Congress may have intended the anti-device provisions as an exercise of the
20 commerce power.⁶ But the Commerce Clause may not be used to abrogate limits on the
21 intellectual property power. Neither Congress nor this Court may adopt a construction of any
22 power enumerated in Article I that would nullify limits on other Article I powers, or render other
23 Article I powers superfluous.

24 ⁶ Nowhere in those provisions appears the usual restriction to activities “in commerce.” *The*
25 *Trade-Mark Cases*, 100 U.S. at 95 (1879). Nonetheless, this omission is not fatal if the Court
26 concludes that the commerce power in fact authorizes the law. See *Brown v. Investors Mortgage*
27 *Co.*, 121 F.3d 472, 476 (9th Cir. 1997); *United States v. Olin Corp.*, 107 F.3d 1506, 1510 (11th
28 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).

1 The commerce power is plenary only up to a point. Congress may not rely on the
2 commerce power to enact legislation that overrides other, more specific constitutional
3 constraints. Thus, in *Railway Labor Executives Ass’n v. Gibbons*, 455 U.S. 457 (1982), the
4 Court reasoned that Congress could not invoke the commerce power to enact the challenged law
5 if it was bankruptcy legislation and violated the Bankruptcy Clause’s uniformity requirement.
6 *See id.* at 468-69 (“If we were to hold that Congress had the power to enact nonuniform
7 bankruptcy laws pursuant to the Commerce Clause, we would eradicate from the Constitution a
8 limitation on the power of Congress to enact bankruptcy laws”).

9 These principles apply with full force to legislation designed to establish or expand
10 protection for intellectual property rights. Congress may not invoke the Commerce Clause to
11 extend exclusive protection to public domain or copyright-expired subject matter, or to eliminate
12 fair use of copyrighted expression. *See* Benkler, *supra*, at 548-52; Julie E. Cohen, *Copyright and*
13 *the Jurisprudence of Self-Help*, 13 Berkeley Tech. L.J. 1089, 1131-32 (1998); William Patry,
14 *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional*
15 *Collision*, 67 Geo. Wash. L. Rev. 359 (1999); Malla Pollack, *The Right to Know?: Delimiting*
16 *Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause,*
17 *and the First Amendment*, 17 Cardozo Arts & Ent. L.J. 47, 55-74 (1999).

18 Whether the DMCA’s anti-device provisions create an impermissible conflict with the
19 Intellectual Property Clause, and are therefore unlawful even if enacted under the commerce
20 power, is a question of first impression. In *United States v. Moghadam*, 175 F.3d 1269, 1275-76
21 (11th Cir.), *cert. denied*, 120 S. Ct. 1529 (2000), the court acknowledged that a law enacted
22 pursuant to the commerce power cannot survive review if it is “fundamentally inconsistent” with
23 the Intellectual Property Clause. *Id.* at 1280-82. The court went on to hold that the particular
24 legislation challenged by the defendant did not create such a conflict as applied to that defendant.
25 *Id.* Whether that conclusion was correct is not at issue here; appellants do not challenge the anti-
26 bootlegging laws, and do not allege a conflict with the Intellectual Property Clause’s fixation
27 requirement. Moreover, the *Moghadam* court expressly suggested that a different challenge to
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1 the anti-bootlegging statute, based on its grant of perpetual protection to live musical
2 performances, would likely succeed. *Id.* at 1281. Were *Moghadam* binding on this Court, it
3 would not dictate the answer to the question presented here. The discussion in Section II.B,
4 above, sets forth the principles that must guide that decision. If those principles are valid — and
5 the Supreme Court has repeatedly upheld them — then the anti-device provisions cannot survive.

6 **III. The Anti-Device Provisions Violate First Amendment Limits on the Scope of**
7 **Copyright Protection.**

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

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

12 Both the fair use doctrine and the idea-expression distinction in copyright law serve
13 indispensable First Amendment functions. The fair use doctrine prevents private censorship, and
14 preserves First Amendment freedoms, by shielding critical commentary and parody of privately
15 owned expression. *Harper & Row*, 471 U.S. at 560; *Nihon Keizai Shimbun, Inc. v. Comline Bus.*
16 *Data, Inc.*, 166 F.3d 65, 74-75 (2d Cir. 1999); *Dr. Seuss Enterprises, L.P. v. Penguin Books*
17 *USA, Inc.*, 109 F.3d 1394, 1400 (9th Cir.), *cert. dismissed*, 521 U.S. 1146 (1997); *Twin Peaks*
18 *Productions, Inc. v. Publications Int'l, Ltd.*, 996 F.2d 1366, 1378 (2d Cir. 1993); *cf. New York*
19 *Times Co. v. Sullivan*, 376 U.S. 254, 265 (1964) (holding that standards of liability in defamation
20 law must accommodate First Amendment concerns). The idea-expression distinction ensures
21 that uncopyrightable facts and ideas and unpatentable functional principles remain in the public
22 domain for future creators to build on. *Eldred*, 123 S.Ct. at 789; *Harper & Row*, 471 U.S. at
23 556; *Attia v. Society of New York Hosp.*, 201 F.3d 50, 54 (2d Cir. 1999), *cert. denied*, 121 S. Ct.
24 109 (2000); *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1170 (9th Cir.
25 1977).⁷

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27 ⁷ We are mystified by the *Corley* court's suggestion that the Supreme Court's observations
28 about the First Amendment functions of fair use carry little weight. *Corley*, 273 F.3d at 458.
The Ninth Circuit, certainly, has not agreed. *See, e.g., Dr. Seuss*, 109 F.3d at 1400; *Los Angeles*

1 These limits on the scope of copyright are designed to sever the link between state-
2 granted monopolies and censorship. Without these doctrines as safety valves to prevent “abuse
3 of the copyright owner’s monopoly as an instrument to suppress” facts, ideas, and critical
4 commentary, copyright law would impermissibly abridge the freedom of speech. *Harper &*
5 *Row*, 471 U.S. at 559-60.⁸

6 Effectuating these First Amendment protections requires preserving the option to make
7 direct copies. In focusing on alternative, second-best options open to users of technologically
8 protected works, the *Corley* and *Reimerdes* courts missed the point and misstated the law.
9 *Corley*, 273 F.3d at 459; *Reimerdes*, 111 F. Supp. 2d at 336-38. In the context of copyright, the
10 First Amendment does not require proof that the affected individuals lack alternative avenues of
11 expression. As both the Supreme Court and the Ninth Circuit have acknowledged, the open-
12 ended nature of the fair use inquiry counsels against such a rule. *See Campbell*, 510 U.S. at 580
13 n.14 (observing that satire, like parody, may qualify as fair use depending on the facts); *Dr.*
14 *Seuss*, 109 F.3d at 1400 n.6 (rejecting district court’s adoption of a rigid presumption against
15 finding satire to be fair use); *cf. Cohen v. California*, 403 U.S. 15, 26 (1971) (“[W]ords are often
16 chosen as much for their emotive as their cognitive force. We cannot sanction the view that the
17 Constitution, while solicitous of the cognitive content of individual speech has little or no regard
18 for that emotive function which practically speaking, may often be the more important element
19 of the overall message sought to be communicated.”); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d
20 Cir. 1989) (“[A] restriction on the *location* of a speech is different from a restriction on the
21 *words* the speaker may use. . . . [T]he ‘no alternative avenues’ test does not sufficiently
22 accommodate the public’s interest in free expression. . . .” (emphasis in original)); *L.L. Bean,*
23 *Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 28-29 (2d Cir.), *cert. denied*, 483 U.S. 1013 (1987);
24 *Cardtoons L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 971 (10th Cir. 1996). In
25
26 *News Serv. v. Tullo*, 973 F.2d 791, 795 (9th Cir. 1992).

27 ⁸ Whether the First Amendment requires additional limits on copyright protection is a separate
28 question, which we do not address.

1 particular, effective fair use commentary on a work that incorporates sounds or images may
2 require direct copying. *See, e.g., Hofheinz*, 147 F. Supp. 2d at 137-38; *Wojnarowicz*, 745 F.
3 Supp. at 143-47; *Time, Inc.*, 293 F. Supp. at 144-46.⁹

4 The “alternative avenues” approach is especially inadequate as applied to copying of
5 public domain material.¹⁰ Public domain information, including copyright-expired information,
6 is no-one’s “property.”¹¹ Within the constitutional framework of copyright law, the right to copy
7 from the public domain is the essence of what the First Amendment protects.

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

10 At the very least, a law that would vitiate these constitutionally-required safety valves
11 within copyright law must be evaluated according to the standard set forth in *United States v.*
12 *O’Brien*, 391 U.S. 367 (1968), for scrutiny of content-neutral laws that burden speech: The
13 government interest must be substantial, and the restriction on speech must be “no greater than is
14 essential to the furtherance of that interest.” *Id.* at 377.¹² Judged against this standard, the anti-
15 device provisions fall far short. Although the government interest in protecting copyrighted
16 works from infringement is substantial, the law that Congress wrote — a flat prohibition that
17 sweeps within its reach all lawful uses of circumvention technologies as well as all unlawful
18 ones — is not even arguably tailored to minimize restrictions on protected activity.

19 ⁹ For similar reasons, in the context of fair use parody the Court has counseled against too
20 grudging an approach to the question whether a defendant copied too much. *See Campbell*, 510
21 U.S. at 588-89.

22 ¹⁰ The *Reimerdes* court did not directly address this question, but appeared to suggest that
23 inability to copy from public domain works does not present a constitutional problem as long as
24 alternative avenues of access to those works exist, or as long as only a few such works have been
25 rendered inaccessible. *Reimerdes*, 111 F. Supp. 2d at 322 n.159, 338 n.245; *see also Corley*, 273
26 F.3d at 445 (endorsing this reasoning).

27 ¹¹ *See Veeck v. Southern Bldg. Code Cong. Int’l, Inc.*, 293 F.3d 791, 799 (5th Cir. 2002)(en banc)
28 (holding unacceptable private ownership of the law, even if private owner allowed extended
access, “public ownership of the law means precisely that ‘the law’ is in the ‘public domain’ for
whatever use the citizens choose to make of it.”)

¹² 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.

1 At least one more appropriately tailored model for protecting copyright owners against
2 the inroads caused by circumvention technologies was readily available to Congress. The
3 doctrine of contributory copyright infringement has evolved to provide precisely the safeguards
4 that the DMCA so conspicuously omits. In sharp contrast to the anti-device provisions,
5 copyright law distinguishes between multi-purpose technologies and unlawful uses of those
6 technologies. Sixteen years ago, the Supreme Court ruled that a technology designed to enable
7 copying of copyrighted works — the VCR — could not serve as the basis for contributory
8 infringement liability because it had substantial noninfringing uses. *Sony Corp. of America v.*
9 *Universal City Studios, Inc.*, 464 U.S. 417, 440-42 (1984) (“Indeed, it need merely be capable of
10 substantial noninfringing uses.”). The *Sony* standard is derived from the patent law rule that
11 manufacture and sale of “a staple article or commodity of commerce suitable for substantial
12 noninfringing use” will not trigger contributory infringement liability. 35 U.S.C. § 271(c); *see*
13 *Sony*, 464 U.S. at 440-42.

14 The doctrine of contributory infringement nonetheless affords strong protection for
15 copyright owners. Courts have uniformly extended contributory infringement liability to those
16 who use dual-purpose devices actively to participate in acts of infringement, as well as to those
17 who knowingly provide facilities to infringers. *See, e.g., Fonovisa, Inc. v. Cherry Auction, Inc.*,
18 76 F.3d 259 (9th Cir. 1996) (flea market operator); *Sega Enters. v. MAPHIA*, 948 F. Supp. 923
19 (N.D. Cal. 1996) (internet bulletin board operator); *A&M Records, Inc. v. General Audio Video*
20 *Cassettes, Inc.*, 948 F. Supp. 1449 (C.D. Cal. 1996) (provider of blank “time-loaded”
21 audiocassettes); *RCA Records v. All-Fast Sys., Inc.*, 594 F. Supp. 335 (S.D.N.Y. 1984)
22 (commercial operator of audiocassette copying machine). In short, the doctrine of contributory
23 infringement is robust, and well advances the government’s interest in copyright enforcement.

24 The anti-device provisions eliminate the time-honored distinction between multi-purpose
25 technologies and unlawful uses by establishing direct liability for manufacturing or distributing
26 the technologies even when legally substantial — though commercially insignificant —
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1 noninfringing uses exist.¹³ The *Reimerdes* court reasoned that this was what Congress intended.
2 See *Reimerdes*, 111 F. Supp. 2d at 323-24. Once again, however, this choice was not for
3 Congress to make.

4 It bears repeating that the overriding government interest is not to protect copyrights, but
5 to promote progress. U.S. Const. art. I, § 8, cl. 8. The “substantial noninfringing use” doctrine
6 in patent and copyright is grounded, ultimately, in this mandate. As the *Sony* Court recognized, a
7 finding of contributory infringement effectively extends the intellectual property grant to
8 encompass the accused instrumentality. *Sony*, 464 U.S. at 441 & n.21. Where a technology has
9 other, lawful uses, “[s]uch a rule would block the wheels of commerce.” *Sony*, 464 U.S. at 441
10 (quoting *Henry v. A.B. Dick Co.*, 224 U.S. 1, 48 (1912), *overruled on other grounds*, *Motion*
11 *Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 517 (1917)). This is doubly true
12 where the other uses also further the purposes of the copyright system. A rule allowing
13 intellectual property owners to exert broad control over circumvention technologies will stifle
14 progress, not promote it. What is, in First Amendment parlance, a less restrictive alternative is
15 also an alternative that furthers all of the government’s interests.

16 **C. The Anti-Device Provisions Are Invalid As Applied to DVD Copy.**

17 Even if defendant 321 Studios itself did not engage in any of the uses it identifies as fair
18 uses under copyright law, the relevant constitutional inquiry does not concern the anti-device
19 provisions’ impact on this defendant, but their impact on the DVD Copy programs. The anti-
20 device provisions may not be applied to bar defendant from copying, distributing, or linking to
21 the DVD Copy programs because of the constitutionally protected uses it enables and the
22 constitutionally required limits it helps to maintain.

23 DVD Copy is a dual-use technology that enables the exercise of important constitutional
24 rights. As described above, the DVD Copy programs facilitate fair use, and also facilitate lawful
25 access to and use of public domain (including copyright-expired) information. In addition,

26 _____
27 ¹³ They also eliminate the requirement that plaintiff prove an underlying act of infringement.
28 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).

1 individuals who have purchased DVDs containing the CSS encryption and who do not use a
2 DVD player that unlocks the CSS encryption can use the DVD Copy program to view these
3 lawfully purchased copies. Theoretically, the DVD Copy code also could be used to decrypt
4 copyrighted DVDs prior to making, distributing, or displaying infringing copies. Even if it could
5 be so used, however, the DVD Copy programs themselves are simply tools with a range of
6 potential applications. The anti-device provisions foreclose all of them. Congress' enumerated
7 powers do not authorize this sweeping interdiction, and substantially less restrictive means of
8 protecting copyright owners' legitimate interests are available. If the limits on copyright
9 protection required by the First Amendment are to mean anything, the anti-device provisions
10 cannot stand.¹⁴

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27 ¹⁴ Again, this Court must consider whether a saving construction is available. *See* 17 U.S.C.
28 § 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.”).

1 **IV. Conclusion.**

2 The DMCA’s anti-device provisions lack constitutional mooring, and may not be invoked
3 to bar defendant 321 Studios, or anyone else, from reproducing, distributing, or linking to the
4 DVD Copy programs. If Congress wishes to afford protection for “technological measures”
5 applied to protect copyrighted works beyond that which copyright law already affords, it must
6 return to the drawing board.

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8 Dated: March 14, 2003.

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Respectfully submitted,

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