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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

UNITED STATES OF AMERICA, Plaintiff, vs. ELCOM LTD., a/k/a ELCOMSOFT CO., LTD., AND DMITRY SKLYAROV, Defendant	Case No.: CR 01-20138 RMW AMICUS BRIEF OF THE ELECTRONIC FRONTIER FOUNDATION, ACM COMMITTEE ON COMPUTING LAW AND TECHNOLOGY, AMERICAN ASSOCIATION OF LAW LIBRARIES, CONSUMER PROJECT ON TECHNOLOGY, ELECTRONIC PRIVACY INFORMATION CENTER, MUSIC LIBRARY ASSOCIATION, AND U.S. PUBLIC POLICY COMMITTEE OF ACM IN SUPPORT OF MOTION TO DISMISS

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I. Statement of Interest

The Electronic Frontier Foundation (EFF) is a non-profit, civil liberties organization working to protect rights in the digital world. EFF actively encourages and challenges industry and government to support free expression, privacy, and openness in the information society. Founded in 1990, EFF is based in San Francisco. EFF has members all over the world and maintains one of the world's most linked-to Web sites (http://www.eff.org). EFF has an interest in this case because of its longstanding goal of ensuring that the Constitutional rights that Americans enjoy in the non-digital world are transferred intact into cyberspace. In furtherance of that goal, EFF has served as legal counsel to several individuals and organizations that have faced claims under the DMCA.

The Association for Computing Machinery (ACM) is a leading society of computer professionals in education, industry, and government. Founded in 1947, ACM has 75,000 members in the US and around the world concerned with issues of research, development and deployment of advanced information technology. ACM has long been involved with issues relating to the interaction of computing, information, technology, and the law. ACM studies and expresses its opinion on legal issues through its Committee on Computing Law and Technology (ACM Law), which includes experienced technologists and lawyers. The U.S. Public Policy Committee of ACM (USACM) facilitates communication between computer professionals and policy-makers on issues of concern to the computing community. The variety of experts associated with USACM study issues of policy and then provide expert resources to assist public leaders in understanding the ramifications of their decisions

The American Association of Law Libraries (AALL) is a nonprofit educational organization of over 5,000 members who respond to the legal information needs of law professors and students, attorneys, and members of the general public as well legislators, judges, and other public officials at all levels of government, corporations and small businesses. AALL's mission is to promote and enhance the value of law libraries, to foster law librarianship and to provide leadership and advocacy in the field of legal information and information policy. Copyright and the preservation of fair use are among the central public policy concerns of the Association.

Consumer Project on Technology (CPT) is a nonprofit started by Ralph Nader in 1995. CPT is active in a number of issue areas, including intellectual property, telecommunications, privacy and electronic commerce, plus a variety of projects relating to antitrust enforcement and policy.

The Electronic Privacy Information Center (EPIC) is a non-profit, public interest research organization focusing on civil liberties issues in the field of electronic information. EPIC works to protect privacy, the First Amendment, and constitutional values in new communications media through policy research, public education and litigation.

The Music Library Association is the professional organization in the United States devoted to music librarianship, and to all aspects of music materials in libraries. Founded in 1931, MLA provides a forum for study and action on issues that affect music libraries and their users, and promotes the establishment, growth, and use of music libraries.

II. Introduction

Intellectual property law has long been understood as a constitutional bargain that "involves a difficult balance between the interests of authors and inventors in the control and exploitation of their writings and discoveries on the one hand, and society's competing interest in the free flow of ideas, information, and commerce on the other hand," *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984).

Accordingly, copyright has always been limited by "safety valves" that prevent copyright owners from unduly restricting others' freedom to speak, thus protecting our cultural commons. *See* Neil Weinstock Netanel, *Locating Copyright within the First Amendment Skein*, 54 Stan. L. Rev. , 4 n. 11 (2001) (listing "the distinction between copyrightable expression and uncopyrightable fact and idea, the fair use privilege, and copyright's limited duration"); Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. Rev. 354 (1999); Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180, 1186-1204 (1970)("Nimmer First Amendment").

It is against this background that this case must be understood. At the heart of this case lies a simple question: can the law can be used to protect technology that undermines the copyright bargain? Put another way, if computer code allows publishers to eliminate unilaterally these constitutional "safety valves," may the law still enforce that code?

These questions arise because Congress, through the Digital Millennium Copyright Act ("DMCA"), created a new kind of protection for copyrighted works: a ban on manufacture and "trafficking" in technologies designed to circumvent "technological measures" that protect a copyright owner's rights. 7 U.S.C. §1201(b). Under the government's indictment of Elcomsoft here, the DMCA does not require intent to aid and abet copyright infringement or any other unlawful act, not even for the imposition of criminal liability; it does not require that any copyright infringement actually be facilitated. Moreover, under the indictment the DMCA does not ensure that circumvention technologies such as AEBPR remain available for fair users or noninfringing users of copyrighted works.

The DMCA assumes that content owners will apply technological measures to restrict the use of copyrighted work. It attempts to create a new level of protection for the technological measures themselves, instead of for the underlying works, as part of an overall goal of preventing copyright infringement. What the government's application of the DMCA here overlooks, however, is that those same technological measures can deny the public the rightful benefits of the copyright bargain. As they have done throughout the history of American copyright law, courts must act here to ensure that the copyright bargain retains meaningful "safety valves."

III. Factual/technological background

The technologies at issue in this case exemplify the problem created by an unchecked interpretation the DMCA. Adobe's eBook Reader technology is one example of a new breed of technologies known as digital rights management or "DRM." The

eBook Reader was designed to give e-book publishers nearly perfect control over what lawful owners of copies of e-books can do with their copies. As Adobe has said: "Lending, printing, copying, giving and text-to-speech are permissions enabled by the publisher."[1] *See* Stephen Kramarsky, *Copyright Enforcement in the Internet Age: The Law and Technology of Digital Rights Management,* DePaul-LCA J. Art & Ent. L. 1, 14 n. 43 (2001) (DRM systems give publishers "the ability to restrict the number of times a work can be played or copied, the kinds of users or machines that can access it, whether it can be given away or resold and whether it will eventually 'expire,' among other things").

The consequence of this, of course, is that the publisher decides which "permissions" are allowed to the purchaser of an eBook. Thus, e-book publishers may (and most do) use Adobe's eBook Reader technology to prevent lawful purchasers from printing or copying any of the text for fair use purposes such as commentary, review or even a school project, from "space-shifting" the copy onto a computer other than that on which the copy was originally downloaded,[2] from exercising first-sale rights to lend or

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1 <http//www.adobe.com/aboutadobe/pressroom/pressreleases/200108/elcomsoftqa.html>(visited January 28, 2002)

2 *Cf. Recording Ind. Assoc. of America v. Diamond Multimedia Systems, Inc.*, 180 F.3d 1072, (9th Cir. 1999). At issue in *Diamond* was the legality of a consumer device that stores and plays digital music recordings under the Audio Home Recording Act. 17 U.S.C. § 1001 et seq. The Ninth Circuit said: "The [device] merely makes copies in order to render portable, or 'space-shift,' those files that already reside on the user's hard drive . . . Such copying is paradigmatic noncommercial personal use entirely consistent with the purposes of the Act." *Id.* at 1079 (citing *Sony*, 464 U.S. at 455).

sell the copy,[3] or from having one's computer read the e-book aloud or convert it to Braille as a blind person might wish to do.[4]

Defendant Elcomsoft's Advanced E-Book Processor ("AEBPR") program permits a legitimate owner of a copy of an e-book in Adobe's format to translate that copy into Portable Document Format ("PDF"), a format readable by any Adobe Acrobat reader, not just the specific eBook reader. Once translated, a lawful owner can exercise the full panoply of rights on the public's side of the copyright bargain -- making fair use of the text, space-shifting the book onto a different computer, etc. And only a legitimate owner of a copy can do so, because AEBPR will not translate the e-book without the "key" provided upon lawful purchase.

The indictment in this case is based upon Adobe's fears that a purchaser of an eBook will use AEBPR to translate an eBook into PDF format and then will use the PDF version to infringe the copyright of the book. The indictment of Elcomsoft is based solely on the "trafficking" of AEBPR. The government has made no allegation that anyone has actually used AEBPR in the manner Adobe fears, much less that Elcomsoft has done so. Nor has it alleged that Elcomsoft participated or aided in any scheme to infringe copyrights or engaged in behavior that would subject it to liability for contributory or vicarious copyright infringement.

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[3] 17 U.S.C. § 109(a) (codifying judicially created first sale privilege).

[4] *See* 17 U.S.C. 121 (authorizing adaptation of copyrighted works for the visually impaired).

Thus this case presents the core constitutional question arising from the DMCA quite plainly: can the creation and publication of a computer program that permits both Constitutionally protected and unlawful uses of copyrighted works be banned? Or must restrictions on such programs be tailored to allow constitutionally protected uses?[5]

This court should construe the DMCA to protect constitutional and noninfringing uses of copyrighted works. This may be accomplished by allowing users access to the tools necessary to make those uses except when the distributor aids and abets in copyright infringement or engages in a conspiracy to commit copyright infringement. Under this construction, Elcomsoft's publication of AEBPR does not violate the DMCA. Without this sort of limiting construction, however, the DMCA must be declared unconstitutional.

IV. Copyright Both Promotes and Is Cabined by the First Amendment.

U.S. copyright law is bound up with the First Amendment in two ways. On one hand, the economic incentives created by copyright law encourage the production and dissemination of First Amendment protected expression. On the other hand, copyright law and jurisprudence have always ensured that copyright interests do not unduly impair the First Amendment rights of the public.

A. Copyright promotes the First Amendment by providing incentives for creating and distributing expression.

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[5] Another core constitutional question arises from the constitutional protection afforded to the computer program itself. Elcomsoft has explored those issues thoroughly in its motion. Accordingly, this brief will focus on the constitutional issues raised by the uses of the AEBPR.

Copyright protects authors' rights in order to serve the public welfare *Twentieth Century Music Corp. v. Aiken*, 422 U.S 51, 156 (1975) ("The immediate effect of our copyright law is to secure a fair return for an 'author's' creative labor. But the ultimate aim is to stimulate artistic creativity for the general public good."); *Sony* 464 U.S. at 429 ("The copyright law . . makes reward to the owner a secondary consideration") *(internal quotation marks and citation omitted).*

A major aspect of this public good is a rich and vibrant public commons of culture and information. Accordingly, copyright was intended to serve as the "engine of free expression" by providing economic incentives for creative activity while ensuring the public access to these creations. *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 558 (1985); *id.* at 546; Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283, 288 (1996) Thus the fundamental bargain that underlies copyright law

> To encourage authors to create and disseminate original expression, [copyright law] accords them a bundle of proprietary rights in their works. But to promote public education and creative exchange, [copyright law] invites audiences and subsequent authors to use existing works in every conceivable manner that falls outside the province of the copyright owner's exclusive rights. Copyright law's perennial dilemma is to determine where exclusive rights should end and unrestrained public access should begin.

Id. at 285

B Copyright avoids constitutional conflict with the First Amendment because of its "safety valves"

Copyright law is potentially in tension with the First Amendment. *See* Mark A. Lemley & Eugene Volokh, *Freedom Of Speech and Injunctions In Intellectual Property Cases, 48:2* Duke L.J.147, 165 (Nov., 1998)("Copyright law restricts speech"). The original English copyright regime was founded as a powerful instrument of state censorship. The booksellers helped the Crown suppress undesirable ideas; the Crown, in turn, protected the booksellers' monopolies. L. Ray Patterson, *Understanding the Copyright Clause*, 47 J. Copyright Soc'y 365, 378-79 (2000). Over time, copyright shed its censorial history, becoming a system aimed at preserving a limited incentive for the creation of new works. The Framers were well aware of this history, and intended the Intellectual Property Clause to serve both an anti-censorship function and an anti-monopoly function. Patterson, *supra*, at 383.

Accordingly, copyright law has long found it necessary to accommodate the First Amendment rights of individuals to use expression. Copyright law strikes this balance in several ways. Both the idea/expression dichotomy and the uncopyrightability of facts limit copyright's scope. *See e.g.* Netanel, *First Amendment Skein, supra,* at 2. Copyright must be of limited duration so that all copyrighted works eventually enter the public domain. And while copyright law grants authors certain monopoly rights over their works, each of those is limited by the reservation of rights by the public, regardless of the copyright owner's wishes. The public's rights serve indispensable functions for both the First Amendment and the copyright bargain. As explained further below, these limitations are severely reduced, if not outright eliminated, through the broad interpretation of the DMCA reflected in the government's indictment.

V. The DMCA presents significant constitutional problems

A DMCA's Changes to the Copyright Bargain

If copyright law is to continue to be true to the First Amendment and its constitutional roots,6 the grant of additional rights to copyright holders should foster rather than stifle creative expression.7 The DMCA represents an unprecedented expansion of copyright law. To comprehend its scope, and the First Amendment problems it presents, it is helpful to conceptualize copyright protections as consisting of concentric rings of liability to copyright holders.8 The chart below illustrates this metaphor.[9]

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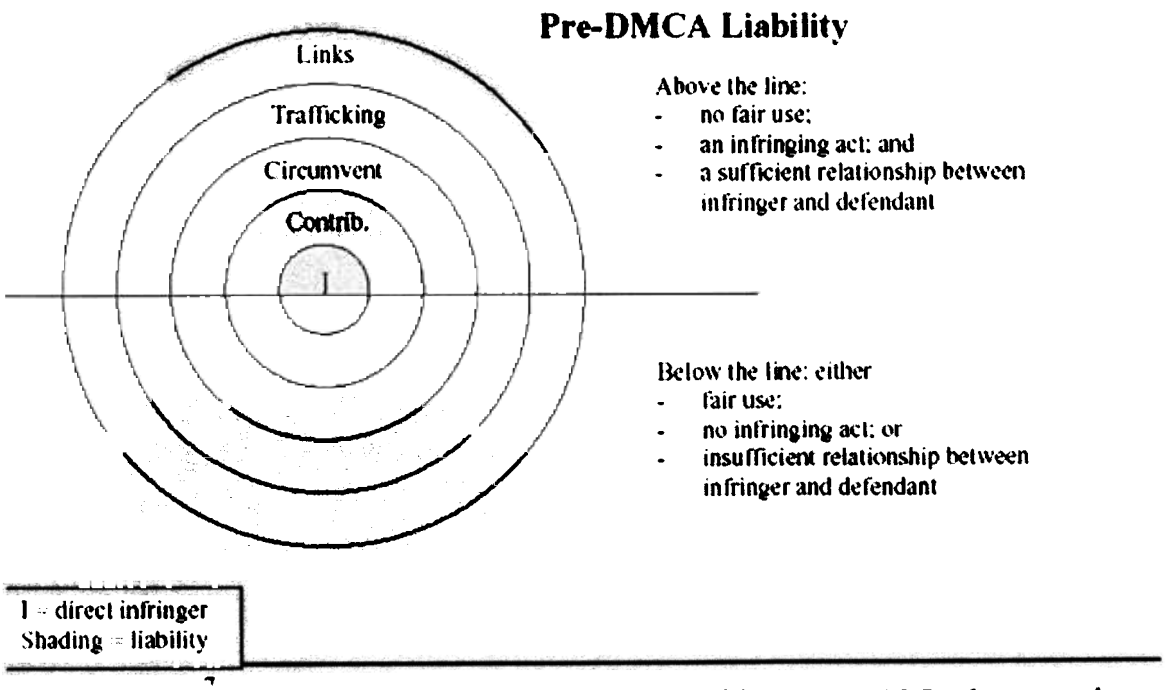
6 *See generally* Melville B. Nimmer First Amendment; Paul Goldstein, "Copyright and the First Amendment," 70 Colum. L. Rev. 983 (1970).

7 Benkler, *supra,* at 386-89 (1999); James Boyle, *A Politics of Intellectual Property: Environmentalism for the Net?*, 47 Duke L.J. 87, 89 (1997).

8 *See* Benkler, *supra* at 358

9 All three of the charts used in this brief (see also pages __& _) were developed by the ACLU for the amicus brief in the 2nd Circuit Appeal in *Universal v. Corely*. <http://www.aclu.org/court/corley.pdf> (visited January 29, 2002).



At the core is direct liability for copyright infringement.10 In the next ring are the indirect liability doctrines of contributory infringement and vicarious liability that courts have read into copyright law. *See Sony,* 464 U.S. at 434-435 These first two rings of liability accommodate free speech concerns by recognizing fair use rights.

The DMCA adds a third ring of indirect liability for circumventing technical measures used to protect access to copyrighted works ("the anti-circumvention provision"),11 and a fourth ring for making or trafficking in circumvention technology ("the anti-trafficking provision").12 In addition to holding that the third and fourth rings

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10 17 U.S.C. § 106, § 501

11 17 U.S.C. §1201(a)(1)(A) "No person shall circumvent a technological measure that effectively controls access to a work protected under this title."

12 17 U.S.C. §1201(b)(1). "No person shall manufacture, import, offer to the public, provide, or otherwise traffic in any technology, product, service, device, component, or part thereof, that –

of liability do not allow fair use rights, the Second Circuit in *Universal v. Corley*, 273 F.3d 429, 455 (2nd Cir. 2001), supported by the Government in its role as Intervener,[13] added a fifth ring of indirect liability based on mere links to sites containing circumvention technology.

As the circles of indirect liability expand outward, the quantum of free speech shrinks – unless the law incorporates limiting principles to preserve a robust domain for free speech interests.[14]

Courts have imposed indirect liability for copyright infringement in situations in which third parties have knowingly and materially participated in illegal behavior. If indirect liability is expanded without regard to (1) whether there were any underlying acts of infringement; (2) whether any relationship exists between the actual infringers and the

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(A) is primarily designed or produced for the purpose of circumventing a technological measure that effectively protects a right of a copyright owner under this title in a work or a portion thereof;

(B) has only limited commercially significant purpose or use other than to circumvent a technological measure that effectively protects a right of a copyright owner under this title in a work or a portion thereof; or

(C) is marketed by that person or another acting in concert with that person with that person's knowledge for use in circumventing protection afforded by a technological measure that effectively protects a right of a copyright owner under this title in a work or a portion thereof.

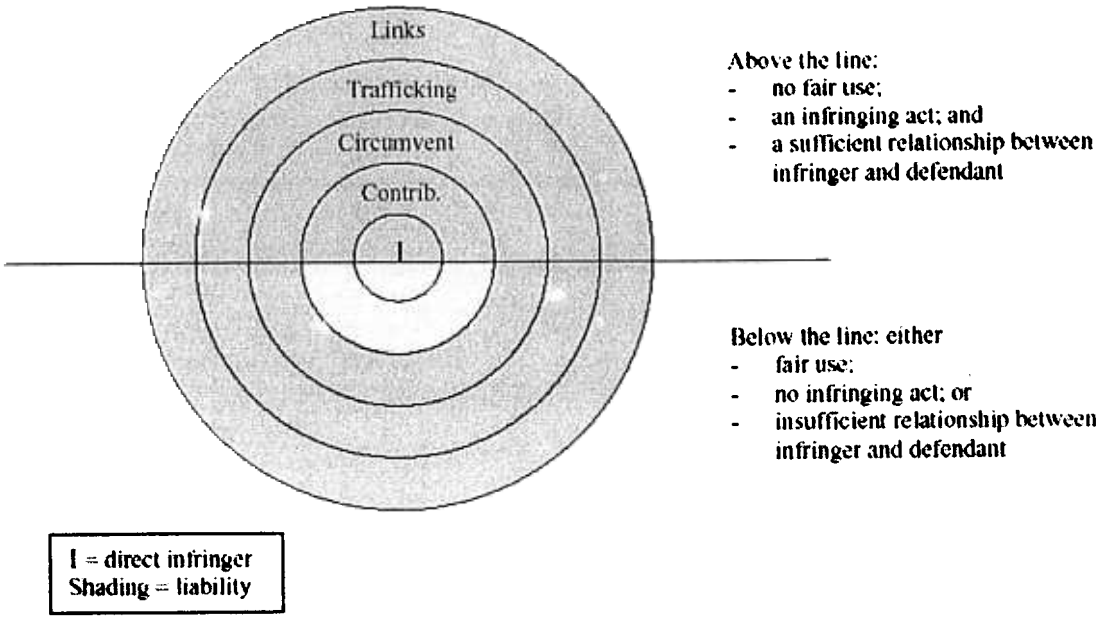
17 U.S.C. § 1201(a)(2) similarly prohibits trafficking in technology "for the purpose of circumventing protection afforded by a technological measure that effectively controls access to a work protected under this title"

13 *See e.g.* <http://www.eff.org/IP/Video/MPAA_DVD_cases/20010620_ny_doj_supl_brief.html> (visited January 26, 2002).

14 *See* Benkler, *supra,* at 393 ("An increase in the amount of material one owns decreases the communicative components freely available to all others.").

person the plaintiff seeks to hold indirectly liable; and, most importantly, (3) whether a fair use or other free speech right applies, that expansion presents grave constitutional problems. Unfortunately, this case triggers those concerns.

Government Interpretation of DMCA Liability



The government here seeks to hold Elcomsoft criminally liable for activities in the bottom half of the "trafficking" circle in the chart above. This is because the indictment contains no allegation, much less evidence, that the posting of the program caused any underlying acts of infringement. Nor is there allegation that the defendant either substantially contributed to copyright infringement or had any ability to control the acts of any users of AEBPR, as indirect liability standards would require. Finally, AEBPR is a tool that facilitates, and in some cases makes possible, fair uses and noninfringing uses of eBooks, as well as uses of works that are not protected by copyright.

The government's broad interpretation of the DMCA thereby lays the legal foundation for eliminating the public benefits of the copyright bargain, replacing traditional copyright law with a system that gives publishers total control over how works can be experienced.[15] Under that interpretation, the DMCA's anti-trafficking provisions permit copyright owners to nullify the public's ability to access, use, and copy expression whenever that expression is shielded by technology. As a result, they present a tremendous threat to free expression by negating the limiting principles designed to preserve the copyright bargain.

B. Unless Narrowly Construed, the DMCA Eliminates Much of the Public Side of the Copyright Bargain

The Copyright Act, of course, grants content owners certain "exclusive" powers over in their works. 7 U.S.C. § 106. But these are limited in many ways. 7 U.S.C. §§ 107-120. Copyright has never accorded the copyright owner complete control over all possible uses of his work. *Sony*, 464 U.S. at 432. A use of a copyrighted work does not infringe copyright unless it conflicts with one of the specific, exclusive rights enumerated in the Copyright Act. *Twentieth-Century Music*, 422 U.S. at 154-155. As explained further below, the government's interpretation of the DMCA effectively eliminates much of the public side of the copyright bargain, or, at best, puts the public's ability to exercise it's rights into the exclusive control of the content owners. This shift, if not restrained by a narrow interpretation of the statute, runs afoul of the Constitution.

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15 See David Nimmer, *A Riff on Fair Use in the Digital Millennium Copyright Act*, 148 U. Pa. L. Rev. 673, 727-39 (2000) (providing examples); Pamela Samuelson, *Intellectual Property and the Digital Economy: Why the Anti-Circumvention Regulations Need to Be Revised*, 14 Berkeley Tech. L.J. 519, 536-57 (1999).

1. Unless Limited, the DMCA Allows Publishers To Control (And Extract Payment For) Works In The Public Domain.

Under the Intellectual Property Clause, copyright must be limited in time such that all works eventually pass into the public domain. "[Copyright] is intended to allow the public access to the products of their genius after the limited period of exclusive control has expired." *Sony*, 464 U.S. at 429; *see* Jessica Litman, *The Public Domain*, 39 Emory L.J. 965 (1990). Although the DMCA purports to protect only copyrighted works, unless limited its prohibitions reach much further, including into the public domain. *See* David Nimmer, *A Riff on Fair Use in the Digital Millennium Copyright Act*, 148 U. PA. L. REV. 673, 727-32 (2000) (presenting case studies showing how DMCA could render illegal otherwise legal activity)("Nimmer Riff").

Consider, for instance, a Shakespeare play with a new introduction published in eBook Reader format. Nimmer Riff, *supra*, at 712 (compilation of 19th-century cookbooks given new introductions "considered as a whole[] would be subject to copyright protection") (footnote omitted). But while the new compilation as a whole would be copyrightable, only the new material is actually protected by copyright; Shakespeare's words are in the public domain. Copying or printing those words is not infringement. Despite this, eBook Reader technology permits the publisher to deny the lawful owner of the eBook the ability to print or copy any of Shakespeare's unprotected expression.

Suppose now that the lawful owner of the Shakespeare eBook wished to circumvent the publisher's "permissions" to copy just Shakespeare's words. This act of circumvention for non-copyrighted works is not itself unlawful under copyright law or the DMCA. In order to accomplish this legal act, however, the user will need a software tool. Yet under the government's view of the trafficking prohibition, these tools may not be distributed. This is because the government asserts that the DMCA prohibits the

creation or "providing" of circumvention technologies, even if the goal is to allow access and copyright circumvention of non-copyrighted works.

The result is the same even if the e-book includes *only* Shakespeare's play. So long as the book is protected by eBook Reader and the publisher chooses not to "permit" legitimate uses, such uses are effectively impossible because of the lack of suitable tools By the same token, a copyright owner can effectively prevent an e-book from ever effectively entering the public domain, despite the expiration of copyright. Once the book has been placed into the eBook format, the tools necessary to circumvent the eBook "permissions" are prohibited.

2. The Government's Interpretation Of The DMCA Allows Publishers To Negate Classic Fair Use.

One key element of the copyright bargain is fair use. "Any individual may reproduce a copyrighted work for a 'fair use'; the copyright owner does not possess the exclusive right to such a use." *Sony*, 464 U.S. at 432 ("all reproductions of the work . . . are not within the exclusive domain of the copyright owner; some are in the public domain.")

Fair use includes copying all or part of another copyrighted work in order to engage in critical commentary, news reporting, and other free speech-related activities. *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966) (fair use to reproduce portions of article in critical biography of Howard Hughes); *Triangle Pub., Inc. v. Knight-Ridder Newspapers, Inc.*, 626 F.2d 71 (5th Cir. 1980) (fair use to reproduce cover of TV Guide in comparison of competing guide); *Sony*, 464 U.S. at 425 (copy of entire work may be fair use)

Fair use is rooted in the constitutional purpose of copyright. *Campbel v. Acuff-Rose Music*, 510 U.S. 569 at 575 (1994) ("some opportunity for fair use of copyrighted materials has been thought necessary to fulfill copyright's very purpose"); *id.* at 577 (fair

use "permits [and requires] courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is intended to foster") (internal quotation marks and citation omitted).

The fair use doctrine has also ensured that copyright laws are consistent with the First Amendment. *See Harper & Row*, 47 U.S. at 560 (suggesting constitutional dimension of fair use doctrine in mediating between copyright and First Amendment interests, although ruling against news magazine that had not made fair use in publishing key excerpts of a not-yet published memoir); *Nihon Keizai Shimbun v. Comline Business Data*, 166 F.3d 65, 74 (2d Cir. 1999) (First Amendment concerns protected by fair use)

Although the First Amendment is often referenced, courts have generally not needed to rely explicitly on the constitutional basis for fair use because of its longstanding doctrinal home in American copyright law *See, e.g., Time, Inc. v. Bernard Geis Assocs.*, 293 F.Supp. 130 (S.D.N.Y. 1968) (fair use to reproduce frames of Zapruder film in order to explain author's theory of Kennedy assassination)

When Congress finally codified fair use in the Copyright Act of 1976, it identified several categories of favored uses, i.e., for "criticism, comment, news reporting, teaching , scholarship, [and] research," all of which are free speech-related uses of copyrighted works. 7 U.S.C. § 107 The codification of fair use was meant "to restate the present judicial doctrine of fair use, not to change, narrow or enlarge it in any way *See* H.R. REP. NO. 94-1476, p. 66 (1976). Congress intended that fair use continue to evolve, "especially during a period of rapid technological change." *Ibid* ("courts must be free to adapt the doctrine to particular situations on a case-by-case basis ")

True to Congress's intent, courts have since 1976 frequently invoked fair use to mediate tensions between interests of copyright owners and subsequent users of copyrighted works in cases involving new technologies that posed challenging questions for copyright law See, e.g., *Sony, supra* (time-shift copying of television programs held fair use); *Sega Enterprises, Ltd. v. Accolade, Inc.*, 977 F.2d 510 (9th Cir. 1992) (fair use

to reverse-engineer computer program for legitimate purpose of getting access to information necessary to make compatible program, which furthers constitutional purposes of copyright); *Lewis Galoob Toys, Inc. v. Nintendo of America, Inc.* 964 F.2d 965 (9th Cir. 1992), *cert. denied*, 507 U.S. 985 (1993)(fair use for users to employ tool to alter game displays); *cf. Diamond*, 180 F.3d at 1079 (9th Cir. 1999) (space-shift copying of music also fair use).

The DMCA requires application of the fair use doctrine as well. By using eBook Reader technology, a publisher can entirely prevent copying of any part of an e-book, even though copying small snippets would be lawful under the fair use doctrine. A publisher can prevent reasonable "space-shifting" of the e-book from one device to another, because eBook Reader controls the copy owner's ability to perform such a transfer. A person might want to use a language translation program to translate an English e-book into his or her native language, but would be unable to do so without the permission to copy the text into the translation program. In these situations as well as many others, even though making fair use of an e-book is perfectly lawful, the necessary tools -- like AEBPR -- are prohibited. *See Corley*, 273 F.3d at 457 (no fair use defense to DMCA's anti-trafficking provisions).

3. An Overbroad Interpretation of the DMCA Allows eBook Publishers to Eliminate the Purchaser's First-Sale Rights.

Fair use is not the only benefit of the copyright bargain. The "exclusive" right to control distribution of a particular copy of a work is limited by the first sale doctrine. *See Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 349-350 (1908) (exclusive right to "vend" under 1909 Copyright Act applied only to first sale); 17 U.S.C. § 109(a) (owner of particular lawful copy may "without the authority of the copyright owner, [] sell or otherwise dispose of the possession of that copy"). The first sale doctrine furthers First

Amendment interests by ensuring there are alternative distributors for creative expression. Having only a single source available for obtaining particular information breeds private censorship. Allowing several individuals to learn from one copy of a work helps spread knowledge and information. Libraries and used book stores function almost solely from the privileges conferred by the first sale doctrine.

Under the first sale doctrine, once a person has lawfully acquired a copy of a book, he or she is free to lend, sell, or give that copy to anyone else. 17 U.S.C. § 109(a). But technological measures permit publishers to prevent any transfer of a work For instance, the eBook Reader technology allows publishers to prevent lending (temporarily forgoing one's own use of the copy) or giving (permanently relinquishing the ability to use the copy) of an e-book by tying the purchased e-book to the particular device on which it was downloaded.

4. The Government's Interpretation of the DMCA Allows Content Holders To Eliminate The Public's Right Of Private Performance.

Similarly, while copyright owners have the right to control public display and performance of their works, private performances are deliberately beyond the control of the copyright owner *Sony*, 464 U.S. at 468. One may, without any authorization, sing a copyrighted lyric in the shower (*Twentieth-Century Music v. Aiken*, 422 U.S. 155 at 155 (1975); or use a book for private reference. *cf. Stover v. Lathrop*, 33 F. 348 (C.C.D. Colo. 1888) ("The effect of a copyright is not to prevent any reasonable use of the book which is sold. may use the book for reference, study, reading, lending, copying passages from it at my will.").

Through the use of technological protection systems and the legal protection of the DMCA, however, copyright owners can go beyond control of public performances to usurp control over certain private performances. For instance, individuals use "text-to-speech" software so that their computers can read electronic files aloud to them.

Assuming the file has been legitimately obtained and that no additional reproductions are required, such reading aloud which constitutes a private performance of a literary work for which no permission is required. But in the face of restrictions built into the Adobe eBook Reader technology, individuals will no longer be able to use their own "text to speech" tools to exercise their private performance rights.

5. The Government's Broad Interpretation of the DMCA Can Prevent Purchasers from Accessing Their Own Books.

Given the realities of modern business, an inflexible interpretation of the DMCA Can also prevent lawful purchasers of eBooks from reading their own books. In January, 2002, MightyWords, one of the premier eBook publishers, ceased business operations.[16] As a result, none of the lawful purchasers of those eBooks has any further ability to repair a broken eBook or transfer the book to a new Machine (something allowed witch individual permission by MightyWords while it was in operation). In essence, due to the business failure of MightWords, its eBooks are timed out – becoming completely inaccessible to users who undergo any significant changes in their computer systems. A program such as AEBPR could allow owners of MightWorks eBooks to access and use their books despite the fact that the company no longer exists. Yet under the government's interpretation, providing AEBPR to a MightyWorks customer is a criminal violation of the DMCA. Thus directly contrary to the goals and purposes of the copyright bargain, the DMCA effectively makes these eBooks inaccessible not only to the public, but to some of those who have bought and paid for them.

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16 See <http//mightywords.com> (noticeof shutdown of company); See also <http//siliconvalley.internet.com/news/article/0,2198,3531_940111,00.html>

VI. The DMCA Must Be Narrowly Construed Or Invalidated

There is ample evidence that Congress did not intend to eliminate fair or noninfringing use in the 1201 context. First, and most importantly, with regard to fair use rights, the statute itself states: "Nothing in this section shall affect rights, remedies, limitations, or defenses to copyright infringement, including fair use, under this title." 1201(c)(1). As the Registrar of Copyrights said:

> [T]his legislation clarifies existing law and expands specific exemptions for laudable purposes. These specific exemptions are supplemented by the broad doctrine of fair use. Although not addressed in this bill, fair use is both a fundamental principle of the U.S. copyright law and an important part of the necessary balance on the digital highway. Therefore the application of fair use in the digital environment should be strongly reaffirmed."[17]

Fortunately, the DMCA is susceptible to a constitutional interpretation.[18]

Revisiting the charts used above, the interpretation would be as follows:

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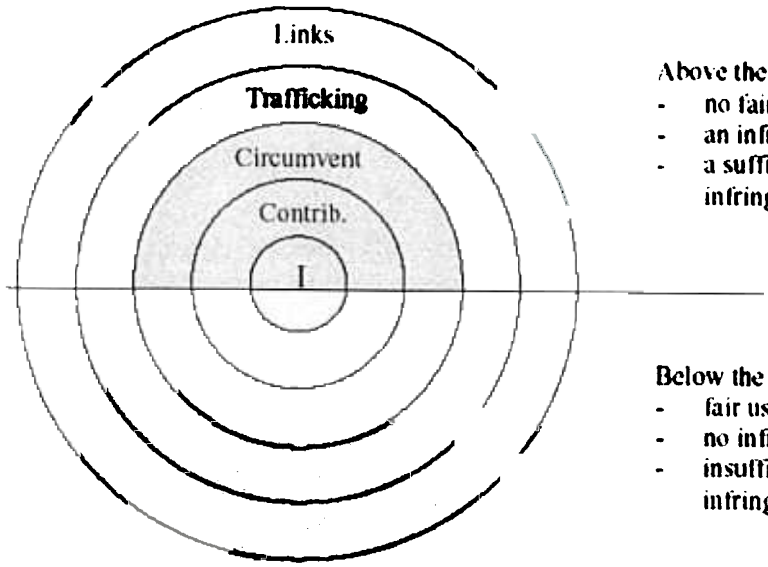
[17] Testimony of Marybeth Peters, Registrar of Copyrights and Associate Librarian for Copyright Services p. 40. (H.R. 2441 and S. 1284). Joint Hearing before the Subcommittee of Courts and Intellectual Property of the House Committee on the Judiciary and the Senate Committee on the Judiciary - -- NII Copyright Protection Act of 1995.

[18] This section of the brief incorporates arguments from the amicus brief of the ACLU, et. al. in the 2nd Circuit Appeal in *Universal v. Corely*, <http://www.aclu.org/court/corley.pdf> (visited January 29, 2002).

Constitutional Interpretation of Liability Under DMCA



Above the line:
- no fair use;
- an infringing act; and
- a sufficient relationship between infringer and defendant

Below the line: either
- fair use;
- no infringing act; or
- insufficient relationship between infringer and defendant

In other words, liability under the DMCA occurs when a Court has found

1. That there is no noninfringing use, fair use or free speech right to offer the program.

2. That a sufficient relationship exist between the publisher of the program and infringers under the aiding and abetting or conspiracy standards[19]; and

3. That the program was used to infringe copyrights or that an imminent danger of copyright infringement exists under the First Amendment standards.[20]

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[19] *See e.g. Central Bank of Denver N.A. v. First Interstate Bank of Denver. N.A.*, 511 U.S. 164, 190 (1994)(aiding and abetting requires intentional acts); *United States v. Superior Growers Supply, Inc.*, 982 F.2d 173, 177-78 (6th Cir. 1992); *United States v. Campa*, 679 F.2d 1006, 1013 (1st Cir. 1982) (aiding and abetting requires that underlying offense in fact be committed); *Direct Sales Co. v. United States*, 319 U.S. 703 (1943)(conspiracy requirements).

[20] Under traditional First Amendment standards, speaker liability even for subsequent violent acts is not allowed "unless that speech is capable of producing imminent lawless action."

One way to do this within the statutory scheme is through the definition of the terms of the statute. §1201(b) carefully is, by its very terms, limited to technologies that "effectively protect a right of a copyright owner." If the phrase "right of a copyright owner" is limited to the list of exclusive rights granted an owner under copyright law (the top half of the chart above), then acts done for purposes that are outside the copyright owner's rights (the bottom half of the chart), are simply outside the scope of the statute.

Alternately, the court could rely on the statute's express preservation of free speech and fair use, seen in §1201(c)(1) and (c)(3).[21] No matter how the construction is accomplished, creation of "safety valves" in the DMCA to match the longstanding ones that exist in copyright law, is necessary for the statute to remain within the bounds of the constitution.[22]

A. Without a Narrowing Construction, the DMCA is Unconstitutional.

If this Court finds that the DMCA is incapable of narrowing constructions such as those outlined above, the statute must be voided. *See Virginia v. American Booksellers Assoc.*, 484 U.S. 383, 397 (1988); *Blount v. Rizzi*, 400 U.S. 410, 419 (1971). Without free

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Brandenburg v. Ohio, 395 U.S. 444, 447 (1969).

[21] *See* Jane C. Ginsburg, *Copyright Use and Excuse on the Internet*, 24 Colum.-VLA J.L. & Arts 1, 8-9 (discussion of how §1201(c)(3) can be read to allow fair use under the DMCA).

[22] "[T]here is no question that the copyright law is far more nuanced and contains far more exceptions than the Digital Millennium Copyright Act. The technological protections are much more rigid than the law they are intended to protect." Comments of Jonathan Band, 50 Am. U. L. Rev. 363 American University Law Review December *2000 Symposium PANEL ONE: THE ROAD TO NAPSTER: INTERNET TECHNOLOGY & DIGITAL CONTENT* Washington D.C. Thursday, November 16, 2000.

speech safeguards the expansion of indirect liability into a fourth ring of liability for trafficking in circumvention technology unconstitutionally restricts speech that was clearly in the public domain or otherwise protected by the First Amendment prior to the DMCA. *See Benkler*, *supra*, at 385-429; *see, e.g.*, Nimmer Riff at 739 (noting the "conscious contraction of user rights" by Congress). As a result, the broadly construed anti-trafficking provision operates as an effective ban on a variety of expressive technologies capable of substantial noninfringing uses. Unless narrowly construed, such an effective ban on protected speech violates the First Amendment. See *ACLU I*, 521 U.S. 844 (1997) (striking down the Communications Decency Act because it operated as an effective ban on speech protected for adults). AEBPR is, of course, only one of countless technologies covered by the statute. Without a narrowing construction, the statute has had and will continue to have a substantial chilling effect on the development of new technologies capable of important noninfringing uses.[23]

VII. Conclusion

"Once encryption becomes the norm, the rights-holders, not Congress, will dictate what uses can and cannot be made of their properties." Kramarsky, *supra*, at 43.

In asking that the DMCA be construed narrowly, we do not question the right of eBook publishers to protect their works. We do not question their fears that digital

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[23] This includes reverse engineering a Sony AiboPet to teach it new tricks and the threats to a Princeton/Rice/Xerox team of researchers led by Professor Edward Felten who sought to publish the results of analysis of technological protection measures at a scientific conference. *See e.g.* <http://www.sciam.com/explorations/2002/012102aibo/> (visited January 26, 2002) and <http://www.eff.org/Legal/Cases/Felten_v_RIAA/> (visited January 27, 2002).

publishing under the prevalent business model presents increased risks of copyright infringement. We only claim that when publishers choose to publish copies of their works in digital form, their ability to control consumer uses of those copies be subject to limiting principles long established in copyright law, some of which derive from the Constitution. Even if code may protect works more completely than the law, the law may reinforce that code only to the extent the Constitution allows.

Respectfully submitted:

Dated this 4th day of February, 2002

By: _____

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