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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

UNITED STATES OF AMERICA,

Plaintiff,

v.

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

Defendants.

Case No. CR 01-20138 RMW

MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF MOTION TO DISMISS BASED ON FIRST AMENDMENT

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

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I. Introduction

The anti-trafficking provisions of the Digital Millennium Copyright Act ("DMCA") ,17 U.S.C. §1201 *et seq*, prohibit the dissemination of computer code on certain subjects because Congress believed that the availability of such computer code might enable third parties to violate the copyright laws. No matter how worthy Congress' goals may be, the DMCA is fundamentally flawed because it targets expression rather than the conduct with which it purports to be concerned. Computer programs are a form of expression. The First Amendment demands that when the government regulates expression there must be an exceptionally tight fit between the ends the government seeks to serve and the means it has chosen. There is no such tight fit here. In the anti-trafficking provisions of the DMCA, Congresst has sought to remedy potentially widespread copyright violations not by targeting the violations themselves, but by targeting computer programs that could be used to circumvent copyright protections.

The government's content-based regulation of this speech is not narrowly tailored and, as a result, the anti-trafficking provisions of the DMCA violate the First Amendment to the United States Constitution. The DMCA is fatally flawed for the additional reason that it tramples on the first amendment rights of scholars and others who need access to certain technologies in order to exercise their first amendment rights. The DMCA is also unconstitutionally vague. Finally, the DMCA is constitutionally flawed because Congress exceeded its Article I powers. For these reasons, set forth more fully below, the DMCA does not pass Constitutional muster.

II. Background

A. The Indictment

According to the indictment in this case, Dmitry Sklyarov, a 27 year old Russian graduate student in cryptology,[1] wrote a program called Advanced eBook Processor (AEBPR) as part of his Ph.D. thesis. Sklyarov is employed by Elcomsoft. The business of Elcomsoft is described more fully in the Motion to Dismiss Based on Vagueness of 17 U.S.C. § 1201.

EBooks are books in digital format that can be read on a personal computer or other

[1] Cryptology is the scientific study of the enciphering and deciphering of messages in secret code or cipher. Merriam-Webster Collegiate Dictionary, 2001.

electronic device. A purchaser of an eBook must first download a free computer program that displays the eBook. One such program is Adobe Corporation's eBook Reader. After downloading the eBook Reader, the purchaser then buys and downloads an eBook from an online retailer such as amazon.com or barnesandnoble.com. The customer may read the eBook on the computer onto which the eBook was downloaded. Depending on the settings chosen by the publisher, however, the customer may not be able to print, copy, manipulate or transfer the file to another computer.

AEBPR disables the controls set by the publisher. It allows the legitimate purchaser of an eBook to make a digital copy of the eBook in order, for example, to print a portion of it, to copy the work from an office computer to a home computer or to a handheld computer such as a Palm Pilot, or to use the eBook in conjunction with other programs.

AEBPR was available for sale on Elcomsoft's website for approximately two weeks, starting on June 20, 2001. Only a handful of copies were sold in the United States.

B. The DMCA

The DMCA does not address copyright infringement *per se*. Instead, Congress chose to focus on the security of technical measures that could be used to protect intellectual property. The so-called "anti-circumvention provision," 17 U.S.C. § 1201 (a)(1)(A), states that "No person shall circumvent a technological measure that effectively controls access to a work protected under this title." The DMCA also contains an "anti-trafficking provision, codified at 17 U.S.C. §1201(b)(1), which states[2]:

> No person shall manufacture, import, offer to the public, provide, or otherwise traffic in any technology, product, service, device, component, or part thereof, that -
>
> (A) is primarily designed or produced for the purpose of circumventing protection afforded by a technological measure that effectively protects the right of a copyright owner to a work protected under this title in a work or portion thereof;
>
> (B) has only limited commercially significant purpose or use other than to circumvent protection afforded by a technological measure that effectively

[2] 17 U.S.C. §1201(a)(2) is essentially identical, but omits the words "in a work or a portion thereof" in each subsection. Section 1201(a) is described more fully in the motion to dismiss based on vagueness.

protects the right of a copyright owner to a work protected 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 the right of a copyright owner to a work protected under this title in a work or portion thereof.

17 U.S.C. § 1204 makes the violation of the DMCA punishable by a $500,000 fine and 5 years imprisonment for a first offense, and a $1 million fine and 10 years imprisonment for each subsequent offense.

III. Argument

A. The DMCA Violates the First Amendment Because It Burdens More Speech Than Is Necessary to Serve the Government's Interest

1. Computer Code is Speech Protected By the First Amendment

Computer code is a form of expression. As such, it is speech, and is protected by the First Amendment. *See Universal Studios v. Corley*, 273 F.3d 429, 447 (2d Cir. 2001); *Karn v. U.S. Dep't of State,* 920 F. Supp. 1 (D.D.C. 1996).

Whether computer code is expressed as source code or as object code makes no logical difference to the analysis. Source code and object code are the languages used by humans to express ideas in forms understandable to and usable by computers. Most programmers write in source code languages, which involve a series of letters and symbols, with specific vocabulary, syntax and expository conventions. One simple example of the Visual BASIC programming language is as follows:

```
If Month(Date) = 2 And Day(Date) = 12 Then
  Print "Don't forget that today is your anniversary."
End If
```

The meaning of that example is as clear to those who read Visual BASIC as is this sentence to those who read English.[3] Object code has a simpler structure: a sequence of instructions, each of which is a sequence of fields, each of which has a fixed size.

All computer code is human readable. Some forms are simply more convenient to read

[3] Consider what those not trained in the language of legal citation would make of "111 F. Supp. 2d 294, 326 (S.D.N.Y. 2000)."

than others.

All computer code is expressive. Many of the ideas expressed in source code are also expressed in the assembly language code that results from compiling that code, and again in the binary machine language that is the output of the assembler. Some content may be lost: source code comments are typically not preserved in object code. But some ideas that are only implicit in the source code may be made more apparent in the object code, such as how a particular sequence of actions should be expressed in terms of processor operations in order to obtain maximum performance from the machine.

All computer code is executable. In some instances it may be advantageous to transform the code into another form first, but transformation is by no means mandatory. Because object code is just a translation of source code into another language, it should receive no less protection than any other translation. Indeed, all speech on the internet is part of the digital universe. All such speech is thus nothing more than a string of 0s and 1s. Speech on the internet does not lose its First Amendment protection merely because it has been translated into 0s and 1s, rather than being expressed in words or in symbols. The District Court for the Southern District of New York put it best:

> It cannot seriously be argued that any form of computer code may be regulated without reference to First Amendment doctrine. The path from idea to human language to source code to object code is a continuum. As one moves from one to the other, the levels of precision and, arguably, abstraction increase, as does the level of training necessary to discern the idea from the expression. Not everyone can understand each of these forms. Only English speakers will understand English formulations. Principally those familiar with the particular programming language will understand the source code expression. And only a relatively small number of skilled programmers and computer scientists will understand the machine readable object code. But each form expresses the same idea, albeit in different ways.

Universal City Studios, Inc., v. Reimerdes, 111 F. Supp. 2d 294 (S.D.N.Y. 2000), *aff'd,* 273 F.3d 429 (2d Cir. 2001).

Indeed, even "source code" itself is a relative term. The notion of what is source code changes rapidly as developments in computer technology occur. Consider the following: if one has watched even a few episodes of "Star Trek", one is familiar with the concept of humans speaking directly to and interacting with computers. In such a scenario, the source code for the

computer is the human speech itself. But that concept is not just science fiction; it is now being developed at the Spoken Language Systems (SLS) group at MIT's Laboratory of Computer Science. SLS has developed a system where humans can speak with a computer by telephone, using conversational English, to obtain information about weather forecasts, airline schedules and Boston area restaurants. *See* Http://www.sls.lcs.mit.edu/sls/whatwedo/. What SLS has developed is not as advanced as the computer interface on the starship Enterprise, of course, but it is a working example of human speech as the "source code" for a computer. It is easy to extrapolate, in the not so distant future, to computers being able to process far more complex and detailed instructions issued directly in English. The line between human speech and historic understandings of "source code" is becoming at least as blurred as the line between source code and object code. In this dynamic an area, drawing legal lines in the sand is, at best, a risky venture. *Cf. Denver Area Educational Television Consortium v. FCC*, 518 U.S. 727, 768 (1996) (Stevens, J., concurring) ("[I]t would be unwise to take a categorical approach to the resolution of novel First Amendment questions arising in an industry as dynamic as this").

The government may argue that object code is not speech because it is "functional." This is a shorthand way of saying that code is understood both by humans and by computers. Of course, computer code can, at the instruction of a person, cause a computer to execute the instructions contained in the code. But the fact that speech can be put to use by a person does not mean that it is no longer speech. *Bernstein v. United States Department of State,* 922 F. Supp. 1426, 1435 (N.D. Cal.1996) ("Instructions, do-it-yourself manuals, [and] recipes" are all "speech").

This issue can perhaps be best understood by analogy. Suppose Congress finds that there is a problem with the theft of luggage from lockers in interstate bus terminals. Further suppose that these thefts are occurring because the lockers have combination locks, and the combinations have been published in a book. Locker combinations, like computer code, have a "functional" component: they communicate information that allow a user to "unlock" something, whether a locker or an eBook. However, the possibility that such protected expression might, with some additional effort on the part of the recipient, lead to conduct (even potentially illegal conduct)

does not transform the speech into the conduct itself. If Congress chose to pass a law making the publication of the locker combinations illegal, such a regulation would be a restriction on speech.[4]

Even if computer code were deemed akin to conduct, it would still be protected by the First Amendment because it clearly communicates ideas, and is thus expressive. *See Tinker v. Des Moines Independent Community School District,* 393 U.S. 503 (1969) (black armbands); *Stromberg v. California*, 283 U.S. 359 (1931) (red flag); *U.S. v. O'Brien,* 391 U.S. 367 (burning draft cards). The meaningful constitutional distinction is not between conduct and speech, but between conduct that communicates ideas and conduct that does not. *See generally Henkin, Forward: On Drawing Lines*, 82 Harv. L.Rev. 63, 79-80 (1968). Here, as will be show, the very reason that the government seeks to regulate AEBPR is because of the ideas that it conveys.

2. The DMCA Is Subject To Strict Scrutiny Because It Is A Content Based Restriction On Speech.

The Supreme Court has recently made clear that "In determining whether a regulation is content based or content neutral, we look to the purpose behind the regulation; typically, '[g]overnment regulation of expressive activity is content neutral so long as it is '*justified* without reference to the content of the regulated speech.'" *Bartnicki v. Vopper* , -- U.S. --, 121 S.Ct. 1753, 1760 (2001), *quoting Ward v. Rock Against Racism,* 491 U.S. 781, 791 (1989).

The anti-trafficking provisions of the DMCA seek to suppress computer code that indicates how to circumvent a technological measure protecting a copyright. That regulation cannot even be articulated, much less justified, without reference to the content of the code.[5] It is precisely the content of the code that causes the government to seek to regulate it. If a programmer wrote code that helped bolster encryption technology, the DMCA would not apply.

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[4] This is not just a hypothetical situation. *See Chicago Lock Co. v. Fanberg*, 676 F.2d 400, 405 (9th Cir. 1982) (locksmith allowed to publish reverse engineering of "key codes" to sophisticated locks under trade secret theory).

[5] The fact that the DMCA does not ban all forms of computer codes relating to encryption is of no moment; the existence of exceptions for certain types of speech do not impact the level of scrutiny to which the regulation is subjected. *United States v. Playboy Entertainment Group, Inc.,* 529 U.S. 803, 812, 120 S.Ct. 1878, 146 L.Ed.2d 865 (2000) ("The Government's content-

It is only by referring to the code itself, and the instructions contained therein, that it is possible to tell whether the code is licit or illicit under the DMCA.

The Government may argue that the objective of the DMCA is to regulate copyright infringement, not speech. But the DMCA does *not* regulate copyright infringement; it regulates computer code instead. To return to the locker analogy, the Government could not justify the suppression of books with locker combinations on the ground that it seeks to prevent theft. *Chicago Lock Co.*, 676 F.2d at 405.

The Government will rely on *Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2d Cir. 2001), a civil case that involved the application of the DMCA to a computer program (DeCSS) that decrypted DVDs. In *Corley*, the Second Circuit correctly concluded that computer code, including object code, is speech. The *Corley* court then determined, however, that the DMCA is content-neutral as applied to DeCSS because the DMCA regulates the "functional" elements of the program: "The Government seeks to justify both the application of the DMCA and the posting prohibition to the Appellants solely on the basis of the functional capability of DeCSS to instruct a computer to decrypt CSS, i.e., without reference to the content of the regulated speech." *Corley*, 273 F.3d at 454. The "i.e." is where the rabbit goes into the hat in the *Corley* court's analysis. The capability of DeCSS to instruct a computer to decrypt CSS is entirely derivative of its content. To regulate one is to regulate the other.

The *Corley* court tried to justify this slippage between function and content on the ground that "the causal link between the dissemination of circumvention computer programs and their improper use is more than sufficiently close to warrant selection of a level of constitutional scrutiny based on the programs' functionality." *Id.* at 452 (quoting from *Universal I*, 111 F. Supp. 2d at 331-32). *Corley* provides no authority for this conclusion other than *Red Lion Broadcasting Co. v. FCC*, 395 U.S. 367, 386 (1969), which it cites for the proposition that "the characteristics of new media justify differences in the First Amendment standards applied to them." The Supreme Court rejected precisely this analogy in *Reno v. American Civil Liberties*

based burdens must satisfy the same rigorous scrutiny as its content-based bans").

Union, 521 U.S. 844, 868-69 (1997), distinguishing *Red Lion* and other cases pertaining to the FCC's regulation of radio and television, and concluding that "our cases provide no basis for qualifying the level of First Amendment scrutiny that should be applied to [the internet]." *Id.* at 870.

Furthermore, the supposed causal link between speech and the consequences of that speech cannot be used to justify a lower level of scrutiny. The Supreme Court has made clear that "[l]isteners' reaction to speech is not a content-neutral basis for regulation." *Forsyth County v. The Nationalist Movement*, 505 U.S. 123, 134 (1992). Indeed, as Judge Easterbrook explained in *American Booksellers v. Hudnut*, 771 F.2d 323, 333 (7th Cir. 1985):

> Much speech is dangerous. Chemists whose work might help someone build a bomb, political theorists whose papers might start political movements that lead to riots, speakers whose ideas attract violent protesters, all these and more leave loss in their wake. Unless the remedy is very closely confined, it could be more dangerous to speech than all the libel judgments in history.

The *Corley* court apparently concluded that the human intervention required to turn a computer program into "action" is so slight – pushing a few buttons – that it should be disregarded. There is no authority for that proposition. Instead, the cases about listeners' reactions to speech turn on whether the speech is so inflammatory that it renders the listeners unable to control themselves. *See, e.g., United States v. Poocha*, 259 F.3d 1077 (9th Cir. 2001) (reversing conviction for disorderly conduct for yelling obscenity to police officer); *City of Houston v. Hill*, 482 U.S. 451, 462 (1987) ("a properly trained officer may reasonably be expected to exercise a higher degree of restraint than the average citizen, and this be less likely to respond belligerently to 'fighting words'"). Under the relevant cases, what matters is not the ease with which the listener could take action, but rather whether the listener could not reasonably be expected to exercise restraint in light of the nature of the speech. *See, e.g., NAACP v. Claiborne Hardware*, 458 U.S. 886 (1982). In other words, if a mob is so aroused that it could be considered a gun, a speaker can be held liable for pulling the trigger. Here, there is no mob, and there is no trigger. Any potential infringer can sit at home and contemplate his actions at his leisure. There is absolutely nothing to suggest that the availability of a program such as AEBPR will overbear the will of the citizenry and turn them into a lawless mob.

3. The DMCA Cannot Survive Strict Scrutiny

A content-based restriction on speech is constitutional only if it is narrowly tailored to serve a compelling governmental interest. *Perry Ed. Assn. v. Perry Local Educators' Assn.*, 460 U.S. 37, 45, 103 S.Ct. 948, 74 L.Ed.2d 794 (1983). Such a regulation may be sustained only if the chosen means are necessary to further a compelling government interest, and there are no less restrictive means available. *Sable Communications of Cal., Inc. v. FCC*, 492 U.S. 115, 126 (1989) ("The Government may . . .. regulate the content of constitutionally protected speech in order to promote a compelling interest if it chooses the least restrictive means to further the articulated interest").

A narrowly tailored regulation is one in which "the means chosen do not 'burden substantially more speech than is necessary to further the government's legitimate interests.'" *Turner Broadcasting System, Inc. v. FCC,* 512 U.S. 622, 662 (1994) (quoting *Ward v. Rock Against Racism,* 491 U.S. 781, 799 (1989)). "[A] regulation is not narrowly tailored . . . where . . . a substantial portion of the burden on speech does not serve to advance [the State's content-neutral] goals." *Simon & Schuster, Inc. v. New York Crime Victims Bd.*, 502 U.S. 105 (1991) (internal quotation marks and citations omitted).

The DMCA burdens substantially more speech than is necessary to protect copyright holders from digital copyright pirates. Indeed, the DMCA does not purport to prohibit the violation of copyright laws. Instead, it regulates speech that might facilitate such violations. In enacting the anti-trafficking provisions of the DMCA, Congress focused not on the infringer himself, but rather on a person more removed from the infringement (but perhaps easier to locate). However expedient such an approach might be, it fails to maintain the crucial connection between the government's ends and the means used to accomplish them. The infringement of a copyright is wrong in and of itself; the circumvention of a technological measure protecting that copyright is only wrong in those circumstances in which a copyright will be infringed as a result.[6]

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[6] The DMCA's fit between means and ends is so tenuous that it is also constitutionally overbroad. "Where the statute unquestionably attaches sanctions to protected conduct, the

The AEBPR does not lead inexorably to the infringement of copyrights. For example, a blind man could use AEBPR in conjunction with a program to read eBooks aloud, because the technological measures in the Adobe eBook reader software must be circumvented so that the program can convert the text into an audio file. Such activity is plainly legal, not to mention beneficial.

Similarly, suppose an American historian believes that Alexander Hamilton, and not James Madison, was the author of Federalist Paper X. One way to do this would be to purchase a digitized copy of the Papers and search for certain phrases common in the writing of each man.[7] Traditionally, the researcher could search and quote from the work freely. However, if the digitized copy is encrypted, the professor would have to use AEP in order to circumvent that encryption and run a word search program on the digital copy.[8]

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likelihood that the statute will deter that conduct is ordinarily sufficiently great to justify an overbreadth attack." *Members of the City Council of Los Angeles v. Taxpayers for Vincent*, 466 U.S. 789, 801 n.19 (1984)(*citing Erznoznik v. City of Jacksonville*, 422 U.S. 205 (1975)). The overbreadth doctrine requires applies where the movant can "demonstrate a substantial risk that application of the provision will lead to the suppression of speech." *National Endowment for the Arts v. Finley*, 524 U.S. 569, 580 (1998); *see also Broaderick*, 413 U.S. at 612-615 (holding that statutes inhibiting the exercise of First Amendment rights may be invalidated on their face if the impermissible applications of the law are substantial when "judged in relation to the statute's plainly legitimate sweep"). *Cf. Salerno*, 481 U.S. at 745 (noting applicability of overbreadth doctrine to First Amendment claims); *Lehman v. Board of Elections in the City of New York*, No. 99-9015 (2d Cir. Nov. 9, 2000). Here, the DMCA poses a substantial risk that speech regarding the legitimate study and advancement of encryption and computer technology will be prohibited.

[7] This is not a hypothetical problem. *See* Bosch and Smith, *Authorship Determination Via Linear Programming: Authorship of the Disputed Federalist Papers,* http://cgm.cs.mcgill.ca/~beezer/cs644/authorship.html (attempting to resolve authorship of federalist papers using concordance generator and noting that "the first step was to obtain machine readable texts of The Federalist papers"). Similar studies have been conducted on Shakespearian texts. See W. Elliot and R. Valenza, *Was the Earl of Oxford the True Shakespeare?*, Notes and Queries, 38:501-506 (December 1991. *See also* Penn Leary, *Are There Ciphers in Shakespeare*, http://home.att.net/~tleary/ (discussing running a "Baconian Caesar cipher program" on the [presumably machine readable] text of Shakespeare's works and concluding that many of them contain ciphers demonstrating that the works were in fact written by Sir Francis Bacon); *but cf.* Terry Ross, *The Code That Failed: Testing a Bacon-Shakespeare Cipher*, http://shakespearauthorship.com/bacpenl.html (running similar tests on other works to show that the same method could be used to "prove" that Bacon wrote the King James gospels). Paper copies of each of these websites are attached as Exhibits A to D to the Declaration of Michael Celio.

[8] One can easily postulate other examples. For example, suppose a library purchases a database containing detailed information about books in it collection. The database is encrypted, but the bundled software allows librarians to search for items by author's name, book title, and subject matter. The library makes the database available to the librarians so that they can assist patrons

Congress had clear alternatives. For instance, it could have elected to make the penalties for copyright infringement more stringent. Similarly, Congress could have elected to criminalize the use of the internet to distribute infringing copies. Such an approach would be more narrowly tailored, would focus directly on the problem at hand and would not sweep within its ambit expression with legitimate purposes.

4. The DMCA Cannot Survive Even Intermediate Scrutiny

Even if the DMCA is deemed to be content neutral, it is still subject to intermediate scrutiny. Under intermediate scrutiny, restrictions on speech must be "narrowly tailored to serve a significant governmental interest" and "leave open ample alternative channels for communication of the information." *Clark v. Community for Creative Non-Violence*, 468 U.S. 288, 293 (1984); *see also City of Erie v. Paps A.M.* 120 S. Ct. 1382 (2000) (*plurality op.*). As set forth above, the DMCA is not narrowly tailored, and therefore violates the First Amendment regardless of which test is applied. The DMCA plainly "burden[s] substantially more speech than is necessary to further the government's legitimate interests." *Turner Broadcasting Sys. et. al. v. FCC*, 512 U.S. 622, 662 (1994) (*citation omitted*). For the statute to be valid, the government must demonstrate that the DMCA "eliminates the exact source of the evil it sought to remedy." *Members of the City Council of the city of Los Angeles et. al. v. Taxpayers for Vincent*, 466 U.S. 789, 808 (1984); *Ward v. Rock against Racism*, 491 U.S. 781, 799 n. 7 (1989) (loudness regulation "focus[ed] on the source of the evils the city seeks to eliminate . . . without

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in searching the collection. The library quickly recognizes that many patrons look for books by authors without knowing the correct spelling of the author's name; this causes many searches to come up empty and is frustrating to patrons. The library could easily solve this problem by employing a phonetic search algorithm such as the Soundex algorithm. The Soundex algorithm, first employed by the U.S. Census Bureau at the turn of the last century, is a well-known method for performing phonetic searches of names. The library could create a second index; one that was organized phonetically. With this new index, the library patron could successfully find books authored by "Umberto Eco" even if the person entering the search query misspelled the name as "Humberto Echo." The Soundex algorithm is robust enough to find matches so long as the query is a reasonably good phonetic representation of the actual name. Under copyright law, new indices that have a "potential to save researchers a considerable amount of time and, thus, facilitate the public interest in the dissemination of information," are favored and can be said to be a fair use of copyrighted material. Id. at 221. Under the DMCA, however, the library cannot implement the Soundex solution because access to the data is protected by technological measures.

at the same time banning or significantly restricting a substantial quantity of speech that does not create the same evils").

As explained more fully below, the government's approach to the DMCA effectively eliminates fair use, limits noninfringing uses and prevents access to material in the public domain and uncopyrightable material protected by "technological measures." Many of these uses are themselves protected expression and none of them constitute copyright infringement. The anti-trafficking provisions of the DMCA do not "respon[d] precisely to the substantive problem which legitimately concern[ed]" and that it therefore do not comport with the First Amendment. *Taxpayers for Vincent*, 466 U.S. at 810.

B. The DMCA Impermissibly Burdens the First Amendment Rights of Third Parties.

Even if circumvention devices such as the AEBPR are not constitutionally protected speech, the DMCA is nonetheless unconstitutional because it unduly burdens the first amendment rights of would-be users. The government may not enact regulations that burden what information the public may have access to, and how the public can use that information. The constitution is as offended by regulations that deny the public the right to receive and make use of information and ideas as it is by the regulation of speech itself. The government may not "limit[] the stock of information from which members of the public may draw." *First Nat'l Bank of Boston v. Bellotti,* 435 U.S. 765, 783 (1978). *See also Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.,* 425 U.S. 748, 757 (1976) (acknowledging "a First Amendment right to 'receive information and ideas,') (quoting *Kleindienst v. Mandel,* 408 U.S. 753, 762-63 (1972)); *Richmond Newspapers, Inc. v. Virginia*, 448 U.S. 555, 599 (1980) (Stewart, J., concurring) (observing that the right to listen is implied by the right to speak); *San Francisco County Democratic Cent. Committee v. Eu,* 826 F.2d 814, 824 (9th Cir. 1987). The DMCA interferes with, and in many cases makes impossible, the ability to receive and use information for legitimate legal purposes. As a result, it cannot and does not comply with the First Amendment.

1. The DMCA Impairs The First Amendment Right To Access Non Copyrighted Works.

The DMCA runs afoul of the First Amendment because it places almost unlimited power in the hands of copyright holders to control information, including information that is not even protected by copyright. Society has a strong interest in the free flow of such information. *See First Nat. Bank of Boston,* 435 U.S. at 783.

Not all eBooks are protected by copyright. A recent visit to Amazon.com's eBook section revealed digital versions of Joseph Conrad's *Heart of Darkness*, Thoreau's *Walden*, and Charles Dickens' *A Tale of Two Cities*, among other classic works of literature whose copyright all had long since expired.[9]

The purchaser of an eBook whose copyright has expired has the right to make use of this public domain information. However, under the Government's likely reading of the DMCA, it makes any circumvention of the publisher's encryption illegal. Because the technological measure – in this case the security features of an eBook program — *can* be used to protect a copyrighted work, the Government may argue that it is illegal to market a product that could circumvent it *even if the product is applied only to non-copyrighted works*. To the extent that it made illegal the circumvention of virtually all electronic security measures, the DMCA would sweep much too broadly, and would trample on the public's First Amendment right to access and use non-copyrighted works.

2. Congress Cannot Preclude Users From Exercising a First Amendment Right to Make Fair Use of Copyrighted Works

The anti-trafficking provisions of the DMCA would also violate the First Amendment to the extent that Congress expanded the rights of copyright holders beyond the boundaries permitted by the First Amendment. The Supreme Court has explained that First Amendment principles are built directly into copyright law through the doctrine of fair use. "First Amendment protections... [are] embodied in the Copyright Act's distinction between

[9] Also offered, among others, are *Madame Bovary*, *The Origin of the Species*, and *Dr. Jekyll and Mr. Hyde*. *See* http://www.amazon.com.

copyrightable expression and uncopyrightable facts and ideas, and in the latitude for scholarship and comment traditionally afforded by fair use." *Harper & Row v. Nation Enterprises,* 471 U.S. 539, 560 (1985). "To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art." *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 349-50 (1991).

In sum, the fair use doctrine is the savings clause that renders the copyright laws consistent with the First Amendment. Where the works in question "are by definition under copyright, that puts the works on the latter half of the 'idea/expression dichotomy' and makes them subject to fair use. This obviates further inquiry under the First Amendment." *See, e.g., Eldred,* 239 F.3d at 376. *See also Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65, 74 (2d Cir. 1999) ("We have repeatedly rejected First Amendment challenges to injunctions from copyright infringement on the ground that First Amendment concerns are protected by and coextensive with the fair use doctrine."); *Los Angeles News Serv. v. Tullo,* 973 F.2d 791, 795 (9th Cir. 1992) ("First Amendment concerns are also addressed in the copyright field through the 'fair use' doctrine."); 1 Nimmer § 1.10[D].

Without the fair use doctrine as a safety valve to prevent "abuse of the copyright owner's monopoly as an instrument to suppress" facts, ideas, and critical commentary, the copyright laws impermissibly would abridge the freedom of speech. *See Harper & Row*, 471 U.S. at 559-60. To the extent that it eliminated the fair use doctrine in the digital realm, Congress would breach the constitutional wall between copyright and freedom of expression.

Adobe's eBook Reader permits a publisher to prevent consumer who purchases an eBook from printing it, making a backup copy, transferring it from desktop to laptop, or even running text searches on it. All of these uses constitute "fair uses" under the Copyright Act of 1976, and the common law which it codified.

Another fair use is the ability to use a computer program to read eBooks aloud to the blind. The blind person must use a program such as AEBPR to circumvent the technological

measures in the eBook Reader in order to convert the text into an audio file. This is a fair use. Nonetheless, the Government is criminally prosecuting the defendants in this case for the sale of AEBPR. If that prosecution is successful, the blind person will lack the technological tools necessary to listen to an eBook that he has purchased. Indeed, even if the prosecution is not successful, the DMCA's sweeping provisions likely would chill the dissemination of AEBPR, and thus effectively preclude the blind person from exercising his constitutional rights. This is a clear "abuse of the copyright owner's monopoly." *See Harper & Row*, 471 U.S. at 559-60.

Similarly, the anti-trafficking provisions of the DMCA make it virtually impossible to run full-text searches, even though this too is a fair use expressly permitted by the Copyright Act. Included in the 1976 Act's definition of fair use are "purposes such as criticism, comment, news reporting, teaching ..., scholarship, or research.." § 107. These exceptions are at the heart of the First Amendment. However, the DMCA's anti-trafficking provisions would effectively prevent the hypothetical search of the Federalist Papers discussed above because would-be distributors of the tools necessary to undertake that task would hesitate to do so, for fear of criminal prosecution. This hardly "promote[s] progress." U.S. Const. Art. 1, § 8, cl. 8.

The DMCA's broad provisions, as the government has applied them in this case, also make it effectively impossible for a consumer to make a backup copy of an eBook that he or she had purchased. Because software is particularly vulnerable to accidental deletion or destruction, Congress amended §117 of the copyright code to protect personal use copies of digital media. *See* 17 U.S.C. §117(a).[10] Section117(a)(2) grants a software owner the right to make a "copy or adaptation for archival purposes [provided] all archival copies are destroyed" should the owner of the software end her rightful ownership. Courts have defined "archival purposes" broadly. For example, the owner of a software program is entitled to make an archival copy to obviate the risks of mechanical or electronic failure. See *Atari, Inc. v. JS & A Group, Inc.*, 747 F.2d 1422 (Fed. Cir. 1984). Indeed, an owner is entitled to make archival copies to protect against all types

[10] Congress has long recognized the need to allow consumers to make personal use copies of digital media. *See* Final Report of the Commission on New Technological Uses of Copyrighted Works (1979) at 13-14.

of risks, including human error and physical mishap. See *Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255, 267 (5th Cir. 1988).

The law of this circuit clearly supports the right of the purchaser of an eBook to make a fair use copy. In *RIAA v Diamond Multimedia*, 180 F.3d 1072 (9th Cir. 1999). the 9th Circuit upheld the personal use copying of digital musical recordings, explaining that it is a fair use to "make[] copies in order to render portable, or 'space-shift,' those files that already reside on a user's harddrive." *Id.* at 1079. The unanimous court stated that this type of copying falls within the personal use right of consumers to make analog or digital copies of copyrighted works for private, noncommercial use. "Such copying is paradigmatic noncommercial personal use entirely consistent with the purposes of the Act" because consumers have a right to make their music portable rather than forcibly tied to any particular media or location. *Id.*

Despite Congress' prior efforts to protect exactly such sues and an unbroken line of authority permitting such actions, the Government's interpretation of the DMCA would make illegal the tools necessary to make such copies. Moreover, a person could face civil liability for making an archival copy, notwithstanding that making a backup copy of a digital work has long been considered a "fair use" and Congress has in the past taken affirmative steps to allow just such behavior.[11]

C. The DMCA Is Unconstitutionally Vague

A statute is unconstitutionally vague under the First Amendment when it "provoke[s] uncertainty among speakers" about precisely what speech is prohibited. *Reno*, 521 U.S. at 871. Such vagueness is of particular concern in a content-based regulation of speech. "The vagueness of such a regulation raises special First Amendment concerns because of its obvious chilling effect on free speech." *Id.* at 871-872.[12]

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[11] Thus the oft-repeated analogy that fair use would not permit someone to break into a bookstore to steal a book is misleading and irrelevant. If a person has already paid for the right to view an e-Book when she purchased it, she is not breaking into a third-party's property in order to access it. Rather, she may need to break through a protection measure in order to view that e-Book on her particular operating system.

[12] In *Reno*, the Supreme Court held that a law restricting speech on the internet was unconstitutionally vague when the regulation addressed speech that was "patently offensive" to

The DMCA's vagueness must be scrutinized with particular care because the DMCA, like the statute at issue in *Reno*, imposes criminal sanctions. "The severity of criminal sanctions may well cause speakers to remain silent rather than communicate even arguably unlawful words, ideas, and images." *Reno*, 521 U.S. at 872. "Given the vague contours of the coverage of the statute, it unquestionably silences some speakers whose messages would be entitled to constitutional protection." *Id.* at 874. Further, there is a "risk of discriminatory enforcement of vague regulations" that heightens the First Amendment concerns in the context of a criminal statute even further. *Id.*

The DMCA criminalizes the manufacture and sale of a device that "is *primarily designed* or produced for the purpose of circumventing a technological measure that effectively controls access to a work protected under this title" if the device has "only *limited commercially significant purpose* or use other than to circumvent a technological measure." (emphasis added) In other words, the DMCA regulates expression based upon at least in part upon the motive of the speaker (the purpose for which the program was primarily designed and the extent to which there was a commercially significant purpose in doing so other than the circumvention of copyrighted works). This standard is too vague, too subjective, and too difficult to ascertain. (Here, for example, Mr. Sklyarov's motive in developing AEP was, at least in part, to get a PhD.) These provisions of the DMCA will chill permissible speech, because a would-be speaker may be worried that her motive, even if legitimate, will be misinterpreted. As a result, the DMCA "lacks the precision that the First Amendment requires when a statute regulates the content of speech." *Reno*, 521 U.S. at 874.

D. The DMCA Is Not A Valid Exercise of Congress' Enumerated Powers

As set forth more fully in the brief of the Amicus law professors, Congress exceeded its enumerated powers in enacting the DMCA. Congress may legislate only pursuant to a power specifically enumerated in the Constitution. The Intellectual Property Clause authorizes Congress only to grant exclusive rights in "[w]ritings" and "[d]iscoveries," and only for "limited

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the extent that it involved "sexual or excretory activities or organs" taken "in context" and "measured by contemporary community standards." Id. at 871 n. 35.

[t]imes." U.S. Const. Art. I, § 8, cl. 8; *The Trade-Mark Cases*, 100 U.S. 82, 93-94 (1879).

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

The provisions of the DMCA do not meet this exacting standard. They operate regardless of whether the device is used to access information that is a constitutionally protectable writing, regardless of whether the work so accessed has passed into the public domain, and regardless of whether the desired use of the work would infringe copyright. Indeed, they operate regardless of whether the accused device has been used at all. *See* 17 U.S.C. § 1201(a)(2), (b)(1). *The Trade-Mark Cases* make clear that the Intellectual Property Clause does not permit such a tenuous connection. The House Commerce Committee recognized as much. *See* H.R. Rep. 105-551, Part 2, 105th Cong., 2d Sess. 23-25 (1998) (recommending that a ban on devices be implemented "as free-standing provisions of law" external to Title 17, "in large part because these regulatory provisions have little, if anything, to do with copyright law").

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IV. Conclusion

For the reasons set forth above, the Digital Millennium Copyright Act in unconstitutional, and the indictment against Elcomsoft and Dmitry Sklyarov should be dismissed.

Dated: January 28, 2002

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