No. 04-480

IN THE
SUPREME COURT OF THE UNITED STATES

METRO-GOLDWYN-MAYER STUDIOS, INC,
et al.
Petitioners,
v.
GROKSTER, LTD., et al.
Respondents,

On Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

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Amicus Brief of Malla Pollack and
Other Law Professors
Supporting Grokster, Ltd., et al.

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Interest of the *Amici Curiae*

Amici curiae are law professors specializing in copyright law, constitutional law, federal courts, and related subjects. None of *amici* have any financial interest in the outcome of this litigation.[1] *Amici* provide their institutional affiliations for identification purposes only; they do not purport to represent the opinions or interests of their respective institutions. *Amici*'s sole interest in this case is to encourage the proper unfolding of law in their areas of specialty.

Authority to File

Both parties have given permission for Pollack to file this *amicus* submission. Copies of blanket permission letters have been filed with the Clerk.

Summary of Argument

1. No party has authored this brief in whole or in part. The printing of this *amicus* filing was paid for by Malla Pollack with the generous support of the University of Idaho, College of Law.

First, Petitioners' request to close down offending technology is not supported by clear statutory authority. While this Court has power to create common law,[2] in an area, such as this, where Congress has enacted detailed statutes, the Court's common law power is minimal. Title 17 U.S.C. § 1201(c)(2) does not delegate authority for this Court to promulgate new common law. Second, In the absence of congressional action, the Copyright Clause of the Constitution sets the default position as a public right of access to copyrightable and patentable subject matter. The Clause's core goal is the distribution of knowledge and technology to the general public. Petitioners' request is in extreme tension with these constitutional basics. Petitioners ask this Court to limit lawful public access to copyrightable works by outlawing a multi-purpose distribution technology on which Petitioners do not hold a patent. Third, Petitioners are requesting this Court to go beyond Congress into an area of high constitutional uncertainty by creating patent rights without the constitutionally required *quid pro quo*, a non-obvious invention. For all three of these reasons, this Court should affirm the Ninth Circuit's opinion.

Argument

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2. In the "strictest sense" federal common law refers "to the judicial 'creation' of a special federal rule of decision," but the term is often used, as in this brief, for filling the interstices of federal statutes. *See* Burlington Indus., Inc. v. Ellerth, 524 U.S. 742, 751 (1998) (internal quotation marks and citation omitted).

I. In This Case, The Court's Power to Extend Statute By Common Law Adjudication Is Vanishingly Narrow

A. Basic Principles Of Federal Common Law Restrict Discretion In This Case

"Federal courts, unlike state courts, are not general common-law courts and do not possess a general power to develop and apply their own rules of decision." City of Milwaukee v. Ill., 451 U.S. 304, 312 (1981); *see also* Erie R. Co. v. Thompkins, 304 U.S. 64, 78 (1938). "[T]he commitment to the separation of powers is too fundamental for [the Supreme Court] to pre-empt congressional action by judicially decreeing what accords with common sense and the public weal." TVA v. Hill, 437 U.S. 153, 195 (1978) (internal quotation marks and citation omitted).

Later congressional action automatically trumps earlier Court decisions. *City of Milwaukee*, 451 U.S. at 313 ("We have always recognized that federal common law is subject to the paramount authority of Congress.") (internal quotation marks and citation omitted). "[W]hen Congress addresses a question previously governed by a decision rested on federal common law the need for such an unusual exercise of lawmaking by federal courts disappears." *Id.* at 314. As statutes and statutorily-authorized agency regulations refine boundaries, federal court power to fill in interstices vanishes with the interstices. *See* Black & Decker Disability Plan v. Nord, 538 U.S. 822, 831 (2003) ("[T]he scope of permissible judicial innovation is narrower in areas where other federal actors are engaged."). When re-entering an area in which Congress acted after the creation of judicially crafted rules, the Court asks whether "the scheme

established by Congress addresses the problem formerly governed by federal common law." *City of Milwaukee*, 451 U.S. at 315 n.8; *see also* O'Melveny & Myers v. FDIC, 512 U.S. 79, 85 (1994) ("Nor would we adopt a court-made rule to supplement federal statutory regulation that is comprehensive and detailed.").

As discussed below, current statutory complexity has ended any need (or warrant) for this Court to craft common law rules outlawing provision of technology, of itself, as contributory or vicarious copyright infringement.

B. The Historical Interplay of Case Law and Statute Constrict Discretion In This Case

Contributory and vicarious copyright infringement originated in case law. *See* Kalem Co. v. Harper Bros., 222 U.S. 55, 63 (1911) (holding that defendant who sold film to exhibitors was liable for its public performance; "[i]f defendant did not contribute to the infringement it is impossible to do so except by taking part in the final act."). Contributory and vicarious copyright infringement entered the statute through the word "authorize" in 17 U.S.C. §106 (enacted as part of the Copyright Act of 1976, Pub. L. No. 94-553). "Authorize" is a suitable description of the core cases holding liable dance hall operators and managers of commercial space. *See* Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 438 n.18 (1984) (hereinafter *"Sony"*).

When this Court decided *Sony*, no earlier cases discussed possible liability in copyright for providing a technology to independent third parties. *See id.* at 427, 439. Furthermore, Congress had not enacted any rules limiting

technologies to prevent the lowering of copyright holders' income by third party use of such technology (paracopyright). This Court, therefore, looked to patent, the closest available statutory scheme, to explicate congressional intent. *See id.* at 439. One could question whether the Court, even in 1984, had the common law power to make a technology provider liable as a contributory copyright infringer absent express statutory authorization. Looked at narrowly, however, the Court did not create such liability. Trimmed to barest essentials, the holding in *Sony* was that Sony had not contributorily infringed copyright by selling machinery; Sony had not "authorized" others to engage in any of the copyright holders' exclusive rights. *See* 17 U.S.C. § 106 ("Subject to sections 107 though 118, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following . . . . .") (as quoted in *Sony*, 464 U.S. at 432 n.14).

The *Sony* decision, of course, implied that provision of certain technology might be infringing, but the exact prohibitory contours were not limed because no one was declared liable. While *amici* agree that Metro-Goldwyn-Mayer Studios v. Grokster, 380 F.3d 1154 (9th Cir.), *cert. granted*, 73 USLW 3247 (2004), is a better reading of *Sony*'s prohibitory implication than is In re Aimster Copyright Litigation, 334 F.3d 643 (7th Cir. 2003), *cert. denied*, 540 U.S. 1107 (2004), *amici* leave that argument to other briefs.

This brief argues that, whatever the best reading of *Sony*, statutory developments have pre-empted the Court's common law power to make provision of technology, of itself, into violation of a copyright holders' legal rights (even by analogy to Title 35, the Patent Act). In 1984, the possible

liability of technology providers for third party's copyright infringement was statutorily unexplored water, open for the judicial creation of common-law navigation principles. In 2005, statute has charted the area, leaving no room for new common law extensions of liability.

Since *Sony*, Congress has elaborated, separately, both the copyright and patent statutes. Congress has not inserted any patent-statute test into the copyright statute (neither the patent-statute test used by *Sony,* nor any other patent-statute test). Instead, Congress has enacted specific rules about a number of modern technologies, including internet services. *See* Small Webcaster Settlement Act of 2002, Pub. L. No. 107-321 (amending 17 U.S.C. § 114; enacted Dec. 4, 2002); Tech., Educ., and Copyright Harmonization Act of 2002, Div. C, Title III, Subtitle C of the 21st Century Dep't of Just. Appropriations Authorization Act, Pub. L. No. 107-273 (amending 17 U.S.C. ch. 1; enacted Nov. 2, 2002); Intellectual Property and High Tech. Technical Amendments Act of 2002, Div. C, Title III, Subtitle B of the 21st Century Dep't of Just. Appropriations Authorization Act, Pub. L. No. 107-273 (amending 17 U.S.C.; enacted Nov. 2, 2002); Digital Theft Deterrence and Copyright Damages Improvement Act of 1999, Pub. L. No. 106-160 (amending 17 U.S.C. ch. 5; enacted Dec. 9, 1999); Satellite Home Viewer Improvement Act of 1999, Title I of the Intellectual Property and Comm. Omnibus Reform Act of 1999, Pub. L. No. 106-113 (amending 17 U.S.C. chs. 1, 5, 12, 13; enacted Nov. 29, 1999); Computer Maintenance Competition Assurance Act, Title III of the DMCA, Pub. L. No. 105-304

(amending 17 U.S.C. §117; enacted Oct. 28, 1998); Online Copyright Infringement Liability Limitation Act, Title II of the DMCA, Pub. L. No. 105-304 (adding 17 U.S.C. §512; enacted Oct. 28, 1998); WIPO Copyright and Performances and Phonograms Treaties Implementation Act of 1998, Title I of the DMCA, Pub. L. No. 105-304 (adding 17 U.S.C. ch. 12; enacted Oct. 28, 1998); DMCA, Pub. L. No. 105-304 (amending 17 U.S.C. §§ 108, 112, 114, chs. 7, 8; enacted October 28, 1998); No Electronic Theft Act, Pub. L. No. 105-147 (enacted Dec. 16, 1997); Legislative Branch Appropriations Act, 1997, Pub. L. No. 104-197 (adding 17 U.S.C.§121; enacted Sept. 16, 1996); Digital Performance Right in Sound Recordings Act of 1995, Pub. L. No. 104-39 (amending 17 U.S.C. §§114, 115; enacted Nov. 1, 1995); Uruguay Round Agreements Act, Pub. L. No. 103-465 (amending 17 U.S.C. §104A and adding 17 U.S.C. ch. 11; enacted Dec. 8, 1994); Satellite Home Viewer Act of 1994, Pub. L. No. 103-369 (amending 17 U.S.C. §§111, 119; enacted Oct. 18, 1994); NAFTA Implementation Act, Pub. L. No. 103-182 (amending 17 U.S.C. §109 and adding 17 U.S.C. §104A; enacted Dec. 8, 1993); Audio Home Recording Act of 1992, Pub. L. No. 102-563 (adding 17 U.S.C. ch. 10; enacted Oct. 28, 1992); [Copyright Amendments], Pub. L. No. 102-561 (amending 18 U.S.C. §2319; enacted Oct. 28, 1992); [Copyright Amendments], Pub. L. No. 102-492 (amending 17 U.S.C. §107; enacted Oct. 24, 1992); Semiconductor International Protection Extension Act of 1991, Pub. L. No. 102-64 (amending 17 U.S.C. ch. 9; enacted June 28, 1991); Computer Software Rental Amendments Act of 1990, Title VIII of the Judicial Improvements Act of 1990, Pub. L. No. 101-650 (enacted

Dec. 1, 1990); Judicial Improvements and Access to Just. Act, Pub. L. No. 100-702 (amending 17 U.S.C. §912; enacted Nov. 19, 1988); Satellite Home Viewer Act of 1988, Title II of Pub. L. No. 100-667 (enacted Nov. 16, 1988); [Amendments to the Semiconductor Chip Protection Act of 1984], Pub. L. No. 100-159 (amending 17 U.S.C. ch. 9; enacted Nov. 9, 1987); [Copyright Amendments], Pub. L. No. 99-397 (amending 17 U.S.C. §§111, 801; enacted on Aug. 27, 1986); Semiconductor Chip Protection Act of 1984, Title III of Pub. L. No. 98-620 (adding 17 U.S.C. ch. 9; Nov. 8, 1984); Record Rental Amendment of 1984, Pub. L. No. 98-450 (amending 17 U.S.C. §§109, 115; enacted Oct. 4, 1984).

Under the basic rules of federal common law discussed above, this expansion of statute has two types of consequences. First, the content of the later statutes determines the continued validity of *previously created* common law rules. Second, the existence of complex new statutory provisions shrinks the judicial power to add *new* common law rules (regardless of the exact content of such statutory rules).

As to the first type of consequence, common law doctrines of contributory and vicarious copyright infringement survive in their 1998 form. The Digital Millennium Copyright Act of 1998 (hereinafter "DMCA") enacted a reference to "contributory" and "vicarious" copyright infringement. According to 17 U.S.C. § 1201(c)(2):

> Nothing in this section shall enlarge or diminish vicarious or contributory liability for copyright infringement in connection with any technology,

product, service, device, component, or part thereof. The text speaks in the present tense, as do the sparse references to this provision in the related congressional reports. *See* H.R. Rept. 105-551, Part I, 105th Cong. 2d Sess. 19 (1998) ("This provision is intended to ensure that none of the provisions in section 1201 affect the existing legal regime established in the Copyright Act and case law interpreting that statute."); *id.* Part II 41 (this provision "provides that [the DMCA] shall not alter the existing doctrines of contributory or vicarious liability for copyright infringement in connection with any technology, product, service, device, component or part thereof.").

The language of 1201(c)(2) endorses the common law of contributory and vicarious copyright infringement as it existed when the statute was enacted. At most, 1201(c)(2) authorizes the federal courts to hold a technology provider liable for vicarious or contributory copyright infringement under federal case law as it existed before the DMCA.

However, no 1998 common-law rule prohibiting technology provision *per se* may be available for adoption via 1201(c)(2). The exact contours of *Sony*-implied liability were indistinct when the DMCA was adopted. As this litigation demonstrates, the requirements for *Sony*-implied liability are still highly disputable by well qualified jurists. This lack of clear doctrine may mean the non-existence, at the relevant time, of a federal common law rule rendering provision of technology to third persons, of itself, contributory or vicarious copyright infringement. Hints in meager case law are not rules of prohibition. *Cf.* Jama v. Immigration & Customs Enforcement, No. 03-674, slip op. at 13-14 (U.S. Jan. 12, 2005) (limiting doctrine of congressional ratification to re-

enactment of identical wording and situations where "the supposed judicial consensus was so broad and unquestioned that [the Court] must presume Congress knew of and endorsed it.").

Since copyright liability is purely statutory, *see* Wheaton v. Peters, 33 U.S. (8 Pet.) 591, 661 (1834), any doubt about the existence or contours of a common law rule should be decided in favor of non-liability. A presumption that no common law prohibition exists is further supported by the constitutional base-line issue discussed in part II below, and the unconstitutional-patent issue discussed in part III below. In summary, uncertainty supports non-recognition of any anti-technology rule that might be painfully distilled from the slim pre-DMCA case law.[3]

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3. Petitioners admit they are requesting a rule not enunciated in *Sony*. *See* Brief for Motion Picture Studio and Recording Company Petitioners 33 ("This issue [of whether the defendant should be required to alter his technology] was not presented in *Sony-Betamax* because it was impossible to eliminate the infringing uses of the Betamax while preserving its noninfringing uses.").

Accepting this conclusion does not demean § 1201(c)(2) into mere surplusage. As *Sony* recognized, earlier cases had imposed liability for contributory and vicarious copyright infringement on those who "authorize" violation of the copyright holders' exclusive rights. In some circumstances, provision of technology to third persons may be such illegal authorization. For example, Napster arguably "authorized" copying of copyrighted works by indexing these works on Napster's own servers. *See* A & M Records, Inc. v. Napster, Inc., 239 F.3d 1004, 1011-12, 1023-24 (9th Cir. 2001) (affirming Napster's liability because it both controlled the index files stored on its own servers and controlled user access through log-on barriers). Aimster arguably "authorized" copying of copyrighted works by providing an on-line tutorial demonstrating how to use its technology to make illegal copies of specific, named copyrighted works. *See Aimster*, 334 F.3d at 651-52 ("In explaining how to use the Aimster software, the tutorial [Aimster provided] gives as its only examples of file sharing the sharing of copyrighted music, including copyrighted music that the recording industry had notified Aimster was being infringed by Aimster's users."). Grokster, however, has done nothing similar.[4]

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4. The sparse legislative history of "authorize" supports the distinction between Grokster and Napster. "Use of the phrase 'to authorize' is intended to avoid any question as to the liability of contributory infringers. For example, a person who lawfully acquires an authorized copy of a motion picture would be an infringer if he or she engages in the business of renting it to others for purposes of

As to the second type of consequences, the existence of complex new statutory provisions (regardless of the exact content of such statutory rules) shrinks the judicial power to add *new* common law rules. "[T]he scheme established by Congress addresses the problem formerly governed by federal common law." *City of Milwaukee*, 451 U.S. at 315 n.8. The Court has no need, and no warrant, to adopt additional common law rules "to supplement federal statutory regulation that is comprehensive and detailed." *O'Melveny & Myers*, 512 U.S. at 85.

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unauthorized public performance." H.R. Rept. No. 94-1476, 94th Cong. 2d Sess. at 61 (1976).

This conclusion is not incongruent with the content of 1201(c)(2). First, this statutory language does not expressly authorize the courts to create new common law rules regarding technology. Second, the balance of 1201(c)(2) and (1)[5] do not prioritize copyright holders' protection over the

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5. "Nothing in this section shall affect any rights, remedies, or defenses to copyright infringement, including fair use, under this title." 17 U.S.C. §1201(c)(1).

public's access rights.[6] Third, savings clauses do not eliminate

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6. Paraphrasing tax-statute cases, the DMCA "like most laws, might predominately serve one general objective, say, helping the" copyright holders limit on-line infringement, "while containing subsidiary provisions" or omissions "that seek to achieve other desirable (perhaps even contradictory) ends as well," such as allowing the development and deployment of new technological methods of distributing knowledge. Fitzgerald v. Racing Ass'n, 539 U.S. 103, 108 (2003) (upholding tax statute that helped race tracks achieve economic vitality in one way, while undercutting their economic health in another); "And the Constitution grants legislators, not courts, broad authority (within the bundle of rationality) to decide whom they wish to help with their [copyright] laws." *Id.* (substituting "copyright" for "tax").

basic principles of judicial action and pre-emption. *See, e.g.,* Geier v. Am. Honda Motor Co., 529 U.S. 861, 869 (2000) ("[T]he savings clause (like the express pre-emption provisions) does not bar the ordinary working of conflict pre-emption principles.").

In sum, Congress' multiplication of related statutes has ended this Court's ability to add new common law prohibitions against mere provision of technology or technology services. The content of the statute recognizes liability if one uses technology to "authorize" a third party to violate any of a copyright holder's exclusive rights. Grokster, however, has not authorized third party infringement; Grokster has merely supplied a technology which does not violate 17 U.S.C. § 1201.

II. Petitioners' Request Violates The Constitutionally Set Background Position

A. Copyright and Patent Are Purely Statutory Under This Court's Settled Interpretation of the Constitution

Article One, Section Eight, Clause Eight of the United States Constitution gives Congress power to create privately owned rights to exclude others from copyrightable and patentable subject matter. "The Congress shall have the power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const., Art. I, sec. 8, cl. 8 (hereinafter "the Copyright Clause").

In United States law, copyright entitlements are solely creatures of statute. *Wheaton*, 33 U.S. at 661 ("Congress, then

by this [copyright] act, instead of sanctioning an existing right, as contended for, created it."). The Court reached this conclusion regarding copyright based on the undisputed status of patent entitlements: "[T]he word 'secure', as used in the Constitution could not mean the protection of an acknowledged legal right. It refers to inventors, as well as authors, and it has never been pretended by anyone, either in this country or in England, that an inventor has a perpetual right, at common law . . . ." *Id.* at 661. Patents and copyrights are solely statutory. *See also* Fox Film Corp. v. Doyal, 286 U.S. 123, 126 (1932) ("[C]opyright is the creature of federal statute passed in the exercise of the power vested in the Congress. As this Court has repeatedly said, the Congress did not sanction an existing right, but created a new one.").

Petitioners, therefore, have no common law basis for their claim to the highest possible return on their investments in copyrightable subject matter.[7] Petitioners also lack a common law basis for a copyright remedy in the form of a patent-like power to prevent the use of technology (especially technology they did not invent).[8]

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7. The "property" right Petitioners claim is the Stationers' Company monopoly strangle hold on cultural dissemination, a bottleneck which was properly ended by Parliament with the Statute of Anne. *See* Lawrence Lessig, Free Culture 118 (2004) (explaining that Jack Valenti's assertion that "creative property" involves the same rights as physical property is an industry attempt "to restore the tradition that the British overturned in 1710.").

8. The core patent right is the right to prevent others from

making, using, selling, offering to sell, or importing technology. 35 U.S.C. § 271(a). In this case, "the District Court correctly characterized the Copyright Owners' evidence of the right and ability to supervise as little more than a contention that the software itself could be altered to prevent users from sharing copyrighted files." Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd., 380 F.3d 1154, 1165-66 (9th Cir.) (internal quotation marks and citation omitted), *cert. granted*, 73 USLW 3247 (2004); *see also* Brief for Motion Picture Studios and Recording Company Petitioners 11 (complaining that "Grokster and StreamCast have chosen not to implement [certain] available technologies. . . ."); *id.* at 26 (complaining that Respondents have "refused to adopt [certain] mechanisms. . .."). "Product manufacturers do not have an independent legal duty under copyright law to modify their products so as to control their customers' infringing conduct." Brief for the United States As *Amicus Curiae* Supporting Petitioners 19.

B. The Original Meaning of 'Progress' Affirms that the Constitutionally Set Background Position Favors the Public, Not the Copyright Holder

This Court has never separately defined the word 'progress' in the Copyright Clause. Repeated dicta, however, recognize the Clause's intertwined purposes as allowing Congress to provide an incentive for the creation of new works, the qualitative advancement of knowledge through such works, and public access to these works and their informative content. *See, e.g.,* Eldred v. Ashcroft, 537 U.S. 186, 206 (2003) ("The CTEA may also provide greater incentive for American and other authors to create and disseminate their work in the United States;" referring to the Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298); *Eldred,* 537 U.S. at 206-07 (Congress "rationally credited projections that longer terms would encourage copyright holders to invest in the restoration and public distribution of their works."); *id.* at 219 ("[C]opyright supplies the economic incentive to create and disseminate ideas.") (quoting Harper & Row v. Nation, 471 U.S. 539, 558 (1985)); *Fox Film*, 286 U.S. at 126 ("The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labor of authors.").

Assuming *arguendo* that this Court has common law power to expand prohibitions in the copyright statute, this case turns on which constitutional goal is primary, which should motivate a court filling statutory interstices. *Wheaton* demonstrates that the background right is that of the public, the right not to be excluded.

Furthermore, empirical historical research

demonstrates that in the United States of the ratifying era, the general public would have read the Copyright Clause to give Congress the power to promote the *spread* or *distribution* of knowledge and new technology by creating limited statutory incentives for writings and inventions. *See* Malla Pollack, *What is Congress Supposed to Promote?: DEFINING 'PROGRESS" IN ARTICLE I, SECTION 8, CLAUSE 8 OF THE U.S. CONSTITUTION, OR INTRODUCING THE PROGRESS CLAUSE,* 80 NEBRASKA L. REV. 754, 809 (2001) (HEREINAFTER "*PROGRESS*").

WHILE THIS COURT HAS AN ECLECTIC APPROACH TO CONSTITUTIONAL INTERPRETATION, original public meaning is a foundational component.[9] *See, e.g.,* Alden v. Maine, 527 U.S. 706, 758 (1999) ("We seek to discover [in reading the Constitution], however, only what the Framers and those who ratified the Constitution sought to accomplish....").

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9. Using modern public meaning in the Copyright Clause, furthermore, would undermine long-standing case law and statute allowing the "writings" of "authors" to include music, sculpture, and paintings. *See Progress*, *supra*, at 780.

Ratification era and related political documents are not helpful in defining 'progress'.[10] Dictionaries of the era include multiple definitions (with physical movement predominating). More importantly, these dictionaries were not based on any empirical investigation of public word use. Editors compiled dictionaries by borrowing from earlier lexicons and supplementing with ideosyncraticly chosen quotations from the literati. Dictionaries largely reflected upper class writing habits.[11] Dictionaries, therefore, may be helpful rapid reference tools, but cannot be the final word on eighteenth century definitions. The upper class slant of these dictionaries is especially troubling. The meaning of the Constitution is its meaning to the generality of the public, not to the elite. *See, e.g.,* Ogden v. Sanders, 25 U.S. (12 Wheat.) 213, 332 (1827) (Marshall, C.J.) (listing as an axiom of constitutional interpretation "that its words are to be understood in that sense in which they are generally used by those for whom the instrument was intended."); Joseph Story, Commentaries on the Constitution of the United States 332 (3d ed. 1858) (explaining that constitutions "are instruments of a practical nature . . . designed for common use, and fitted

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10. *See Progress, supra,* at 782-87.

11. *See id.* at 794-97.

for common understandings. The people make them; the people adopt them, the people must be supposed to read them . . . .").

To determine word usage by the generality of eighteenth century Americans, one should investigate what ordinary people read – primarily (often solely) the Bible and newspapers.[12] The King James Version of the Bible does not use the word 'progress',[13] but the Pennsylvania Gazette

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12. *See* Forrest McDonald & Ellen Shapiro McDonald, Requiem: Variations on Eighteenth Century Themes 9 (1988); *see also, e.g.,* David D. Hall, *The Uses of Literacy in New England, 1600-1850, in* Printing and Society in Early America 1, 1 (eds. William L. Joyce, et al., Am. Antiquarian Soc'y 1983) (importance of religious works, especially the Bible); *id.* at 12, 21-22 (explaining that Bible and other devotional works were routinely read aloud and customarily memorized, even by the illiterate); Donald S. Lutz, *Connecticut, in* Ratifying the Constitution 117, 127-30 (eds. Michael Allen Gillespie & Michael Lienesch 1989) (mentioning importance of newspaper reading); Robert Allan Rutland, The Ordeal of the Constitution 24 (1983) (same).

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13. *See* http://www.av1611.org/kjv (providing a computer searchable file of the King James Bible); <http://www.gospelcom.net/> (same). The 1611 King James Version was the standard American Bible during the ratification era. *See* Thurston Greene, The Language of the Constitution xviii (1991).

includes 575 occurrences.[14] The most common Gazette meaning of 'progress' is physical movement, spread, distribution.[15] 'Fire' is the one word must commonly employed in the phrase "the progress of ___".[16] Eighteenth century Americans also spoke of the progress of armed men (including invading troops), ravenous insects, bad weather,

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14. My search included all issues through the end of the eighteenth century, using the full text searchable database available through Accessible Archives, Inc. <http://www.accessible.com/default.htm>; *see Progress*, *supra*, at 798-803.

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15. *See Progress, supra,* at 798. "Distribution" is also the eighteenth century meaning which makes most sense both of the full Clause and of the political context. *See id.* at 788-94. For example, if 'progress' meant "quality improvement," the Federalists risked alienating possible supporters of the proposed constitution. In the eighteenth century, "science" included moral philosophy. *See id.* at 791 n.178 (providing multiple sources). Giving Congress the power to promote the quality improvement of moral philosophy would imply that mankind could improve on the Gospels. Not only would that be bad politics, but Anti-Federalists did not make this argument – strongly suggesting that the ratifying era public did not read 'progress' in Art. I, sec. 8, cl. 8 to mean "quality improvement."

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16. *See* Progress, *supra*, at 799 (reporting 51 usages).

and grave illnesses.[17] These everyday linkages demonstrate that the word 'progress' was limited neither to desirable

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17. *See id.*

outcomes[18] nor to movement along a two-dimensional line.

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18. "Chronological ordering" was a slightly less common ratification-era meaning of 'progress', *see id.* at 798 & n.216, but it did not imply quality improvement. For example, Shakespeare's famous lines on the seven stages of man, ending not with improvement, but with "second

childishness and mere oblivion, [s]ans teeth, sans eyes, sans taste, sans every thing," William Shakespeare, *As You Like It,* Act II, Scene V, ll. 147-75, is entitled "The Progress of Life" in several very common ratification era school books. *See* 1 Robert Dodsley, The Preceptor: Containing a General Course of Education. Wherein the First Principles of Polite Learning are Laid Down in a Way Most Suitable for Trying the Genius, and Advancing the Instruction of Youth 62 (3d ed. London 1758; University Microfilms Int'l, American Culture Series Reel 397.1); William Enfield, The Speaker, or Miscellaneous Pieces xxii, 208 (Baltimore, Md 1803; No. 4163, 2d Ser., Early Am. Reprints, microfiche); John Hamilton Moore, The Young Gentlemen and Lady's Monitor, and English Teacher's Assistant 356 (10th ed. , Hartford, Conn., 1801; No. 950, 2d Ser., Early Am. Imprints; microfiche). These textbooks are recognized as strong competitors by Noah Webster. *See* Noah Webster, An American Selection of Lessons in Reading and Speaking at unnumbered prefatory page (Arno Press 1974 reprint of 5th ed. 1789).

Research on other material widely read during the ratification era supports this conclusion.[19] For example, one of the few best-sellers in early America was John Bunyan's The Pilgrim's Progress (1678).[20] This famous 'progress' is an allegorical journey, as per the full title: "The Pilgrim's Progress From This World To That Which Is To Come, Delivered Under A Similitude Of A Dream: Wherein Is Discovered The Manner Of His Setting Out, His Dangerous Journey, and Safe Arrival At The Desired Country (1678). Christian, Bunyan's hero, does not arrive at "The Desired

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19 *See Progress*, 754-815.

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20. *See* Frank Luther Mott, Golden Multitudes: The Story of Best Sellers in the United States 19-20 (1947). The Gazette includes twelve booksellers' advertisements expressly listing The Pilgrim's Progress. *See* Accessible Archive Items Numbered 06302 (1744), 06382 (1744), 5272 (1742), 04907 (1742), 04850 (1741), 04533 (1741), 36763 (1765), 35749 (1765), 34048 (1764), 19071 (1755), 10647 (1749), and 27581 (1761). Many other sources confirm the extraordinary popularity of Bunyan's allegory during the ratification era. See, e.g., Benjamin Franklin, The Autobiography of Benjamin Franklin, Poor Richard's Almanac, and Other Papers 13 (ed. A.L. Burt, New York, n.d.); W. Grinton Berry, *editor's preface, to* Foxe's Book of Martyrs v, v (Baker Book House, Michigan 13th printing 1990); Mark A. Noll, Protestants In America 34 (Oxford Univ. Press 2000).

Country" because his qualitative moral improvement earns entry to heaven; his salvation is due solely to grace.[21] The standard New England hymnal, The Bay Psalm Book, contains only one mention of 'progress', referring to a divine journey.[22] John Milton's *Paradise Lost* also uses the word

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21. *See, e.g.,* Jonathan Edwards, *Sinners in the Hands of an Angry God*, (sermon delivered July 8, 1741, Enfield, Conn.), available at <http://www.leaderu.com/cyber/books/edwards/sinners.html> (explaining doctrine of salvation by grace alone).

22

22. [l.24] They have thy goings seen o God
Thy goings in progresse;
Ev'n of my God my King within
Place of his holynesse.
[l25] Singers went first, musicians then,
In midst maids with Timbrel.

The Bay Psalm Book at unnumbered pages headed "PSA lx viii" (Univ. of Chicago Press, n.d., facsimile of 1640 ed.). Unfortunately, other then-popular collections of religious songs have no occurrences of 'progress'. *See* Richard Allen, A Collection of Hymns & Spiritual Songs from Various Authors (Philadelphia 1801; microfiche; no. 38, 2d Ser., Early Am. Imprints); Elhanan Winchester, The Universalist's Hymn Book (London 1994; microform; Univ. Microfilms Int'l, reel 17 no. 27 in Early Baptist Publications). Nor does the word appear in any of the 700 psalms by Isaac Watts available on line at <http://www.ccel.org/w/watts/psalmshymns>.

'progress' only once, also invoking a journey: God's chariot proceeds "[i]n progress through the [road] of Heav'n Starr-pav'd."[23]

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23. John Milton, *Paradise Lost, in* John Milton, The Poetical Works of John Milton 1, 98 (ed. Helen Darbishire, Oxford Univ. Press 1961 reprint of 1958 ed.) (Book IV, l. 976).

In short, the Copyright Clause sets the base position (absent statute) at no copyright or patent (no author's, publisher's, or inventor's right to exclude the public). *Congress* was granted the power to create individual statutory rights to exclude the public, provided these rights promote the *distribution* of knowledge and new technology.[24]

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24. The eighteenth century meaning of 'science' is knowledge in general. *See* S. Rept. No. 82-1979, 82nd Cong., 2d Sess. 3 (1952); *see also* Noah Webster, American Dictionary of the English Language, at unnumbered page headed "SCI-SCI-SLA (Foundation for Am. Christian Educ. photo. reprint, 1998)(1828) ("SCIENCE, n. . . . (1) In a *general sense* . . . . knowledge . . . (2) In *philosophy*, a collection of the general principles or leading truths relating to any subject. . . (3) Art derived from precepts or built on principles . . . (4) Any art or species of knowledge . . . (5) One of the seven liberal branches of knowledge, viz grammar, logic, rhetoric,

The central importance of distribution does not conflict with incentivising new writings or qualitatively improving mankind's lot. As per contemporary economic research, "most of income above subsistence is made possible by international diffusion of knowledge." Peter J. Klenow & Adrés Rodrigquez-Clare, *Externalities and Growth*, National Bureau of Economic Research Working Paper 11009 (Dec. 2004), *available at* <http://www.nber.org/papers/w1109>.

Similarly, the early Enlightenment's tool for qualitative advance is the distribution of learning. If, and only if, society provides all humans with knowledge and education, then all humans will have the capacity to develop, therefore, humanity as a whole (and humanity's shared knowledge base) will improve as if by some natural process. *See* Condorcet, Sketch for a Historical Picture of the Progress of the Human Mind 33, 38, 42, 73-76, 92-93, 99-106, 117-20, 136-40, 164, 171, 173, 182-84, 186-88 (June Barraclough trans., Noonday Press, New York, n.d.); Turgot, *On Universal History, in* Turgot On Progress, Sociology and Economics 61, 116-18 (Ronald L. Meek trans. & ed., Cambridge Univ. Press 1973); *accord* John Adams, *Thoughts on Government: Applicable to the Present State of the American Colonies, in* 4 John Adams, The Works of John Adams, Second President of the United States With A Life of the Author 189, 199 (ed. Charles Francis Adams, 1851) ("Laws for the liberal education of youth, especially of the lower class of people, are so extremely wise and useful, that to a humane and generous

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arithmetic, geometry, astronomy and music").

mind, no expense for this purpose would be thought extravagant."); A Gentleman from Rhode Island, Letter of June 7, 1787, *reprinted in* Penn. Gazette, June 20, 1787 ("Nothing but the general diffusion of knowledge will ever lead us to adopt or support proper forms of government. . . . Nor does learning benefit government alone; agriculture, the basis of our national wealth and manufactories, owe all their modern improvements to it."); James Madison, Letter from James Madison to W.T. Berry (Aug. 4, 1822), *in* James Madison, The Complete Madison 337 (Saul K. Padover ed., 1953) ("Knowledge will forever govern ignorance"; "A popular government without popular information or the means of acquiring it is but a prologue to a farce or a tragedy, or perhaps both."); Noah Webster, *An Examination into the Leading Principles of the Federal Constitution, by a Citizen of America, in* Pamphlets on the Constitution of the United States Published During Its Discussion by the People 1787-1788, at 25, 66 (Paul Leicester Ford ed., 1888, Da Capo Press reprint ed. 1968) ("[L]iberty stands on the immovable basis of a general . . . diffusion of knowledge."); *see also* Gordon S. Wood, The Creation of the American Republic 1776-1787, at 72, 120, 426, 570 (1998 paperback ed.) (discussing importance of general education to ratifying generation). Similarly, many ratifying-era state constitutions encourage public education. *See* Ga. Const. (1777) Art. LIV; Mass. Const. (1780) ch. V, § II; N.C. Const. (1776) LXI; N.H. Const. (1784); Pa. Const. (1776) § 22.

The base constitutional position (no copyright or patent holder's power to exclude) and the core constitutional goal (distribution of knowledge and technology to the public) are important because Petitioners are demanding (in the name

of copyright holders' alleged rights) that the Court bar a multi-purpose *distribution system* without express statutory authority to outlaw the technology.

As discussed above, general principles cabin this Court's common-law power to add prohibitions to the Copyright Act. This section argues that this Court's common-law power is additionally circumscribed by the constitutionally set default position. Congress, not the courts, has the power to grant rights to exclude the public from copyrightable works and patentable inventions. Even Congress is allowed to grant rights to exclude the public only after deciding the complex question of what is likely to promote distribution of knowledge and new technology to the public. The briefs filed in this case demonstrate the almost prophetic quality of such legislative decisions. *See also Eldred*, 537 U.S. at 206-07 ("Congress . . . rationally credited *projections* . . . .") (emphasis added). The DMCA is a pragmatic compromise demonstrating no congressional intent beyond the facial meaning of its provisions. *Accord* Bd. of Governors of the FDIC v. Dimension Fin. Corp., 474 U.S. 361, 374 (1986) ("Invocation of the 'plain purpose' of legislation at the expense of the terms of the statute itself takes no account of the processes of compromise and, in the end, prevents the effectuation of congressional intent.").

Petitioners ask this Court to go, not only beyond statute, but triply against constitutional base line (by extending copyright holders' rights to exclude, by prohibiting distribution of a technology, and by prohibiting a distribution system). Therefore, the Constitution supports affirming the Ninth Circuit's decision for Respondents.

III. The Rule of Constitutional Doubt Bars Petitioners' Requested Relief

Petitioners' request has an additional flaw; it would push paracopyright protection to the edge (or past the edge) of constitutional limits. Respect for Congress requires the Court to refuse even "an otherwise acceptable construction of a statute" which raises "serious constitutional problems" whenever "an alternative interpretation of the statute is 'fairly possible.'" INS v. St. Cyr, 533 U.S. 289, 299-300 (2001) (citations omitted); Vt. Agency v. United States *ex rel* Stevens, 529 U.S. 765, 787 (2000) (same); Ashwander v. TVA, 297 U.S. 288, 348 (1936) (Brandeis, J., concurring) ("When the validity of an act of the Congress is drawn into question, . . . it is a cardinal principle that this Court will first ascertain, whether a construction of the statute is fairly possible by which the question may be avoided.") (citation omitted).

Courts require especially clear language before reading a statute to press Congress' constitutional limitations. *See St. Cyr*, 533 U.S. at 299 ("[W]hen a particular interpretation of a statute invokes the outer limits of Congress' power, we expect a clear indication that Congress intended that result"; invoking "plain statement rule."). Without extremely clear statutory language, the Court will not assume "that Congress intended to infringe constitutional liberties or usurp power constitutionally forbidden it." DeBartolo Corp. v. Fla. Gulf Coast Bldg. & Constr. Trades Council, 485 U.S. 568, 575 (1988) (invoking canon to prevent First Amendment question regarding "truthful[]" handbills). No such clear language backs Petitioners' interpretation of the Copyright Act, but their interpretation creates a constitutional issue.

The relief Petitioners request is to give them the power to forbid use of a technology. Petitioners request this relief as copyright holders. However, the right to prevent others from making, using, selling, offering to sell, or importing a technology is the essence of patent. 35 U.S.C. § 271(a). Furthermore, the constitutionally required minimum to obtain a patent is an inventive leap, a contribution not obvious to a person of ordinary skill in the relevant art. Graham v. John Deere Co., 383 U.S. 1, 5-12 (1966). Petitioners' claim is not based on any allegation that they have provided the public with a non-obvious advance in technology, let alone a non-obvious advance related to the technology at issue. Their request, therefore, goes beyond that denied the copyright holder in Baker v. Seldon, 101 U.S. (11 Otto) 99 (1879) (holding that copyright in a book explaining an accounting system does not include the patent right to prevent others from practicing the accounting system). As this Court recognized in 1879:

> The description of the art in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself. The object of the one is explanation; the object of the other is use. The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters-patent.

Id. at 105. *See also* 17 U.S.C. § 102(b) ("In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work."). Petitioners request a patent right without the

constitutionally required *quid pro quo*. *See Eldred*, 537 U.S. at 216 (recognizing Court's repeated invocations of "*quid pro quo*" in the "patent context.").

As to anticircumvention enablers, Congress has already granted such a technology-exclusion right to copyright holders. *See* 17 U.S.C. § 1201. These anticircumvention entitlements may be unconstitutional patents. *See* Eugene R. Quinn, *An Unconstitutional Patent in Disguise: Did Congress Overstep Its Constitutional Authority in Adopting the Circumvention Prevention Provisions of the Digital Millennium Copyright Act?*, 41 Brandeis L.J. 33 (2002) (providing full argument regarding unconstitutionality of DMCA anti-circumvention provisions as violations of U.S. Const., Art. I, sec. 8, cl. 8).

Possibly, a statute allowing copyright holders to block use of anti-circumvention technology may be a legitimate exercise of Congress' Commerce Clause power. However, Congress' ability to bypass limits in one Article One power though the less-cabined Commerce Clause is disputable at best. *See* Ry. Labor Executives Ass'n v. Gibbons, 455 U.S. 457, 468-69 (1982) (disallowing use of Commerce Clause to bypass uniformity limit in Bankruptcy Clause); *see also, e.g.,* Yochai Benkler, *Constitutional Bounds of Database Protection*, 15 Berkeley Tech. L.J. 535 (2000) (arguing that Commerce Clause is limited by Copyright Clause); Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. Ill. L. Rev. 119 (same); Robert Patrick Merges & Glenn Harlan Reynolds, *The Proper Scope of the Copyright and Patent Power*, 37 Harv. J. Leg. 45, 63 (2000) (same); William Patry, *The Enumerated Powers*

Doctrine and Intellectual Property, 67 Geo. Wash. L. Rev. 359 (1999) (same); Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment*, 17 Cardozo Arts & Ent. L. J. 47 (1999) (same).

If a constitutional challenge to the anti-circumvention provisions of the DMCA reaches this Court, it will have to decide this perplexing problem. However, Petitioners' request is not backed by any explicit statutory language. This Court should not reach such a complex constitutional issue without a sharper statutory goad.

In sum, the rule of constitutional doubt requires this Court to affirm the Ninth Circuit's decision.

Conclusion

For the three separate reasons discussed above, this Court should affirm the Ninth Circuit's decision.

Respectfully submitted: _____, 2005

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