

WHATEVER REMAINS OF COPYRIGHT DEFENSES AFTER THE DMCA

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Abstract:

The so-called anti-circumvention provisions of the Digital Millennium Copyright Act have been widely criticized because they clash with the rest of the Copyright Act, and alter the balance within the copyright law. Defendants have found it difficult to avail themselves of traditional defenses, like fair use, in order to escape DMCA liability. There are two quite different interpretations of the interaction between the DMCA and the Copyright Act. The decision of the Second Circuit in *Corley*, and its progeny, consider the DMCA and the Copyright Act as separate bodies of law, and provide very limited alternatives to defendants. A latter approach, by the Federal Circuit decision in *Chamberlain*, considers the DMCA as a piece to the scheme of the Copyright Act, and decides that no Section 1201 claim can subsist in the absence of copyright infringement. This latter decision opens the door for defendants to allege many of the traditional defenses of copyright, although it fell short of recognizing fair use specifically. The Federal Circuit relied on the interpretation of the terms “access” and “work protected” to integrate the DMCA anti-circumvention provisions to the rest of the copyright law. Defendants not reviewed by the Federal Circuit can use a similar rationale and argue a “unified approach” to the DMCA, and persuade other district and circuit courts to analyze the circumvention claims from the “inside-out.” Then, defendants can bring all of the statutory exceptions and traditional defenses of copyright they might be able to establish, like fair use and merger.

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I. Introduction

After almost nine years since its enactment, the Digital Millennium Copyright Act (DMCA) has not ceased from making news both in the legal community and in the general media.¹ This legislation has been widely criticized in the academic sphere as well as within consumer advocates.² Of its various provisions, probably the most controversial is the one codified in Chapter 12 of the Title 17, the anti-circumvention provisions.³ The generalized criticism is that it tampers with the “delicate balance” incorporated in the copyright law.⁴ Serious debate exists

1 See http://www.eff.org/IP/DMCA/DMCA_unintended_v4.pdf (highlighting the most notorious controversies of DMCA).

2 See Joseph P. Liu, *Copyright Law's Theory of the Consumer*, 44 B.C. L. REV. 397 (2003), exploring the underlying preconception within the DMCA of the consumer as a passive consumer of entertainment commodities, and advocating for an alternate view of an active, more autonomous consumer. *Id.* at 403-407; see also Diane Leenheer Zimmerman, *Adrift in the Digital Millennium Copyright Act: The Sequel*, 26 U. DAYTON L. REV. 279 (2001) , wherein the author challenges the notion that the DMCA attended to the special needs of nonprofit, educational, research and other “public interest” users to use copyrighted works. *Id.* at 279.

3 See Peter K. Yu, *Anticircumvention and Anti-anticircumvention*, 84 DENV. U. L. REV. 13 (2006). The author resumes the four main criticisms of the anti-circumvention provision. *Id.* at 34-40.

4 See Report of The House Committee on Commerce, Additional Views of Scott Klug and

on such simple things as whether there is fair use in the DMCA.⁵ Courts are still answering, or merely addressing some of these issues.⁶ These issues include what defenses exist to a claim under the DMCA. The defenses and exceptions expressly recognized within Chapter 12 are few

Rick Boucher, H.R. REP. NO. 105-551, pt. 2 (1998). Where these congressmen from the House Commerce Committee raised their opposition to the Judiciary Committee's draft of the H.R. 2281. The congressmen argued that the anti-circumvention language of the H.R. 2281 represented a mockery to the constitution and that it stands copyright law on its head. Even as amended, the congressmen explained, it fundamentally altered the balance struck in the copyright case law, and turned a limited monopoly into a perpetual one. *Id* at 85-87; *see also* David Nimmer, *A Riff on Fair Use in the Digital Millennium Copyright Act*, 148 U. PA. L. REV. 673 (2000). Where the commentator summarizes the reservations of the dissenting Representatives Klug and Boucher, and their subsequent endorsement of the bill. *Id* at 720-26.

5 *See* Nimmer, *supra* note 4. Who concludes that there is no such thing as a Section 107 fair use defense to a charge of a Section 1201 violation. *Id* at pages 720-23. *But see* Jane C. Ginsburg, *Copyright Use and Excuse on the Internet*, 24 COLUM.-VLA J.L. & ARTS 1, 8-9 (2000) (arguing that courts can use the fair use on specific facts involving Section 1201(a) because fair use is an equitable defense, even when it was codified into Section 107).

6 *See, e.g.*, *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 540 (6th Cir. 2004) (discussing fair use defense); *see also* *Chamberlain Group, INC., v. Skylink Technologies, Inc.*, 381 F.3d 1178, 1198-1200 (Fed. Cir. 2004) (Commenting on Reimerds and its reading of fair use under DMCA).

and far between, at least compared to Chapter 1.⁷ This is also a recurrent criticism, the unbalanced nature of the act, that recognizes no generally applicable defense or exception⁸. What alternatives have a defendant to a circumvention claim, who is not entitled to any of the few and very specific exceptions within Chapter 12? A frequent and natural approach has been to look at the Copyright Act, and copyright law more generally, for long-recognized defenses and privileges, like fair use.⁹ Some of the latest cases have dealt with some of these long held figures and doctrines of copyright, and might open the door, or appear to do so, for future defendants.

In this work I will explore how some of these balancing mechanisms of the copyright law have survived (or are affected by) the overlapping protection provided by Chapter 12. Particular attention will be given to the status of statutory exceptions of infringement, including fair use within the context of the DMCA,¹⁰ the alleged availability of the merger doctrine as a defense

7 See Nimmer, *supra* note 4. Where the commentator concludes that the so celebrated user safeguards in the DMCA intended to keep the balance between users and owners, on close inspection, fail to achieve such goal, and that the existence of a so-called user exception is doubtful. *Id.* at 740-41.

8 *Id.*

9 See *Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2d Cir. 2001). Where defendant alleged the unconstitutionality of the DMCA because of its effect on opportunities for fair use of copyrighted works. *Id.* at 458-59.

10 See *Chamberlain Group, INC., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004) (Where the court rejects causes of action for circumvention not related to

under the DMCA,¹¹ and the interaction between the DMCA and the general copyright law.

II. The Copyright Act

A. General Framework of The Copyright Act

The Copyright Act protects (subject to the dispositions of the Act) original works of authorship, fixed in any tangible medium.¹² What is considered a work under the Act has been the subject of

infringement); *see also* Jane C. Ginsburg, *Copyright Use and Excuse on the Internet*, 24 Colum.-VLA J.L. & Arts 1, at 8-9 (arguing the availability of fair use on cases involving Section 1201(a)). *But see* *Universal City Studios v. Reimerdes*, 111 F. Supp. 2d 294, 322-24 (S.D.N.Y. 2000) (concluding that no fair use defense is available against a Section 1201 claim).

11 *See* *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 537-38 (6th Cir. 2004) (reversing the district court decision because it did not consider idea-expression and merger principles at the first prong of the infringement test).

12 *See* 17 U.S.C. § 102 (2000). Subject matter of copyright: In general. Which provides:

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

continuous changes.¹³ The list of categories of Section 102 has evolved and extended along the years.¹⁴ At this moment the list consists of eight entries, including literary works, musical works,

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

(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.

13 See *White -Smith Music Publishing Co. v. Apollo Co.* 209 U.S. 1 (1908) (finding that piano rolls are not copies or publications).

14 See H.R. REP. NO. 94-1476 (1976). The Act of 1976 incorporated the notion of a “bundle of rights” which can be subdivided indefinitely and owned separately. Section 106 states the rights in broad terms, and subsequent Sections 107 through [122] add limitations to those rights. *Id.* at 61-65; see also 17 U.S.C. § 201(d) (2000). Which provides:

(1) The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession.

(2) Any of the exclusive rights comprised in a copyright, including

visual works of art, dramatic works, and architectural works.¹⁵ Although not included in Section 102, compilations and derivative works based on preexisting works of the previous categories, are considered protectable works themselves, only to the extent of their own original elements, contributed by the author, not for the preexisting work or works, and provided they were made lawfully.¹⁶ To be protected, a work must be original, in other words must originate from the author, and must involve a modicum of creativity.¹⁷ The fixation requirement can be as well

any subdivision of any of the rights specified by section 106 [17 U.S.C. § 106], may be transferred as provided by clause (1) and owned separately. The owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this title.

15 *See* 17 U.S.C. § 102 (2000).

16 *See* 17 U.S.C. § 103 (2000). Subject matter of copyright: Compilations and derivative works.

Which provides:

(a) The subject matter of copyright as specified by section 102 [17 USC § 102] includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

See also 1-3 Nimmer on Copyright §§ 3.01-3.02 (discussing the nature and basic elements of compilations and derivative works).

17 *See* *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). The Supreme Court

easily met by even the loading into RAM.¹⁸ The aforementioned fixation does not have to occur in a manner directly readable, or even recognized by the human senses, as long as it can be interpreted by mechanical means, as is the case with the object code of a computer program.¹⁹ A central feature of the copyright scheme is that it does not extend its protections to ideas, only the expressions of those are protected.²⁰ This came to be known as the idea/expression dichotomy.²¹

declared:

The sine qua non of copyright is originality. To qualify for copyright protection, a work must be original to the author. Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.” *Id.* at 345.

18 See *MAI Sys. Corp. v. Peak Computer*, 991 F.2d 511, 518-519 (9th Cir. 1993), *cert dismissed*, 510 U.S. 1033 (1994) (“However, since we find that the copy created in the RAM can be “perceived, reproduced, or otherwise communicated,” we hold that the loading of software into the RAM creates a copy under the Copyright Act. 17 U.S.C. § 101.”).

19 See *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1249 (3d Cir. 1983) (finding that object code can be protected under copyright, as it extends to works in any tangible means of expression “from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device,” as required by Section 102(a)).

20 See 17 U.S.C. § 102(b) (2000); see also *Baker v. Selden*, 101 U.S. 99, 103 (1880) (“The copyright of a work on mathematical science cannot give to the author an exclusive right to the methods of operation which he propounds, or to the diagrams which he employs to explain them, so as to prevent an engineer from using them whenever occasion requires. The

Corollary to that dichotomy is the so-called merger doctrine, that when the idea is so fused in the expression of it as to be inseparable one from the other, no protection will be afforded. Therefore, when there is just one, or relatively few ways to express an idea, those expressions will not be afforded protection.²²

very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book.”); *see also* *Mazer v. Stein*, 347 U.S. 201, 217 (1954) (“Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea -- not the idea itself.”)

21 *See Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 556 (1985) (“The Second Circuit noted, correctly, that copyright's idea/expression dichotomy “[strikes] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression.””).

22 *See Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967). The First Circuit declared that when a particular uncopyrightable subject matter only allows for a limited number of possible expressions, to permit persons to copyright some of them, could in fact exhaust all possibilities of future use of that subject matter. In those cases, a subject matter would be appropriated by permitting the copyrighting of its expression. Such outcome is detrimental to the public. *Id.* at 678-679. *But cf.* *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977). The Ninth Circuit reasoned: “When idea and expression coincide, there will be protection against nothing other than identical copying of the work.” The court held liable defendants who made jeweled bees from the

Also relevant is the doctrine of “scenes a faire”,²³ this doctrine recognizes the repetition of elements natural to some forms of expression, which become standard in that field, and that some themes are bound to flow from certain selected topics.²⁴ Important to our subsequent analysis of the DMCA is the fact that this doctrine precludes protection to elements of a work that come as a result of external considerations and constraints.²⁵ Typically, external factor to be considered in the context of software protection are: hardware specifications and standards, like the internal method of navigation of the screen displays; software standards and compatibility

same molds as plaintiffs, although it clarified that the scope of copyright protection would increase depending on the extent the expression differs from the idea. *Id.* at 1168.

23 *See* Gates Rubber Co. v. Bando Chem. Indus., 9 F.3d 823, (10th Cir. 1993) (“Under the scenes a faire doctrine, we deny protection to those expressions that are standard, stock, or common to a particular topic or that necessarily follow from a common theme or setting”).

24 *See* 4-13 Nimmer on Copyright § 13.03. The commentator summarizes that the doctrine is often invoked as a defense when accused similarity between the works can be attributed to the common setting or theme shared by both, and such similarities necessarily flow from that common theme. As an example, once one chooses to write about vampires, this topic leads to exploring choices of good and evil, macabre settings, killings, etc. Nimmer notes that the scene a faire doctrine is available beyond works of fiction, to other types of copyrightable works. *Id.* at [B][4].

25 *See* Lexmark Int'l, Inc. v. Static Control Components, Inc., 387 F.3d 522, 535 (6th Cir. 2004) (“...[W]hen external factors constrain the choice of expressive vehicle, the doctrine of "scenes a faire" -- "scenes," in other words, "that must be done" -- precludes copyright protection.”).

requirements; computer manufacturer design standards, target industry practices and demands, and computer industry programming practices.²⁶ Section 106 enumerates the rights of the copyright holder, these include, the exclusive right to copy, distribute, display and/or perform publicly, and make or authorize derivative works.²⁷

26 *See* *Manufacturers Technologies, Inc. v. Cams, Inc.*, 706 F. Supp. 984 (D. Conn. 1989), The court found that the internal method of navigation of the screen displays was limited by the hardware available and the software used to control it. *Id.* at 995; *see also* *Sega Enterprises Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1514-15,1525-27 (9th Cir. 1993) (where reverse engineering and copying of code in Sega's video game programs was only way to discover the requirements for compatibility with the Genesis console); *see also* *Plains Cotton Coop. Ass'n v. Goodpasture Computer Serv., Inc.*, 807 F.2d 1256 (5th Cir. 1987). In this case the court relied on evidence that many of the similarities between the two programs were dictated by the externalities of the cotton market. *Id.* at 1262; *see also* *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 708 (2d Cir. 1992) (“Efficiency is an industry-wide goal. Since... there may be only a limited number of efficient implementations for any given program task, it is quite possible that multiple programmers, working independently, will design the identical method employed in the allegedly infringed work... [I]f this is the case, there is no copyright infringement”); *see also* *Apple Computer v. Microsoft Corp.*, 799 F. Supp. 1006, 1034 (D. Cal. 1992) (Court relied on exhibits of the defendant to find that certain programmed behavior of the mouse icon and the windows on the screen were common occurrence in similar systems).

27 *See* 17 U.S.C. § 106 (2000). Exclusive rights in copyrighted works. Which provides:

i. Elements of a Copyright Infringement Claim

The basic anatomy of a prima facie case of copyright infringement can be reduced to two steps. The plaintiff must establish: (1) ownership of a valid copyright; and (2) that the defendant copied constituent parts of the plaintiff's work that are original.²⁸ The first element of the test is typically satisfied with by presenting a certificate of registration.²⁹ The second element can be subdivided

Subject to sections 107 through 122 [17 U.S.C. § § 107 through 122], the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies or phonorecords;

(2) to prepare derivative works based upon the copyrighted work;

(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

(4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and

(6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

28 Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991).

29 See 17 U.S.C. § 410 (c) (2000). Which provides: "In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall

into two new parts: a) copying as a matter of fact, or actual copying; and b) copying as a matter of law, or actionable copying or appropriation.³⁰ Copying as a matter of fact inquires whether the defendant actually copied some parts of the plaintiff's work, irrespective of the fact that those parts be unoriginal, and therefore unprotectable.³¹ Copying as a matter of law then inquires whether the act of copying by the defendant is actionable.³²

a) Copying as a Matter of Fact Deals with Probative Similarity, Not to Be Confused with the Substantial Similarity Test

Copying as a matter of fact can be established by direct evidence, or more frequently, by circumstantial evidence, which requires that plaintiff shows both adequate access by defendant to the protected work, and substantial similarity between both.³³ Some cases and commentators

constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.”

30 See 4-13 Nimmer on Copyright § 13.01[B] (where the commentator clarifies the different nuances and requirements for establishing copying as a factual matter, and copying as a legal matter).

31 *Id.*

32 *Id.*

33 See 4-13 Nimmer on Copyright § 13.01[B] (explaining the reasons for different formulations between probative and substantial similarity); see also *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 139 (2d Cir. 1992) (“It is now an axiom of copyright law that actionable copying

prefer the term “probative similarity”, so as to not confuse this step with the “substantial similarity” test, the key to determine copying as a matter of law.³⁴

b) Copying as a Matter of Law Can Be Established by the Substantial Similarity Test

A frequently used test for determining substantial similarity in the context of computer programs is the so-called successive filtering method.³⁵ It involves three steps: 1) the computer program is

can be inferred from the defendant's access to the copyrighted work and substantial similarity between the copyrighted work and the alleged infringement.”).

34 *Id.*; *see also* Laureyssens v. Idea Group, Inc., 964 F.2d 131 (2d Cir. 1992). The court explains that a common indirect way to prove copying is by showing, first, that defendant had the opportunity to come in contact with the work, and second, that the similarities between both works, even if not substantial, make it unlikely that the allegedly infringing work was created independently. This method of proof is not to establish that what the defendant took a substantial amount of protectable elements of the work, it serves simply to establish that the work was in fact copied. Thus it should be referred to as "probative similarity". *Id.* at 139-41; *see also* Nimmer. *supra* note 33.

35 *See* 4-13 Nimmer on Copyright § 13.03[F] (proposing a successive filtration method to extract from a computer program those elements that are unprotectable and then consider the similarities with the allegedly infringer's software); *see also* Computer Assocs. Int'l, Inc. v. Altai, Inc., 982 F.2d 693, 707 (2d Cir. 1992) (endorsing and applying Nimmer's "successive filtering method" for separating protectable expression from non-protectable material).

dissected into its constituent parts, at various levels of abstraction; 2) those parts are inspected in search of its underlying ideas, and the expressions necessarily incidental to those ideas, material taken from the public domain, and all other non-protectable elements; and 3) the remaining substance is compared to the program of the claimant, to determine whether there is substantial similarity.³⁶ Other courts have combined the first and second steps, thus reducing the test to only two steps.³⁷

**B. The Rationale for Copyright Protection is the Dissemination of Knowledge,
Although its Immediate Effect is a Monopoly**

The Copyright Act is enacted pursuant to the power of Congress to promote the progress of

36 See *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706 (2d Cir. 1992). (where the court delineates its filtering test for separating ideas and from protectable expression in computer software); see also *Auto Inspection Services, Inc. v. Flint Auto Auctions, Inc.*, No. 06-15100, 2006 US Dist. LEXIS 87366 at *17-21 (E.D. Mich. Dec. 4, 2006) (where the Court discusses the filtering test of *Altai* and applied the scenes a faire doctrine to determine that the similarity between the two programs was due to external factors of efficiency and compatibility requirements).

37 See *Kohus v. Mariol*, 328 F.3d 848, 853-58 (6th Cir. 2003) (Combining Judge Learned Hand's "abstractions test" in *Nichols*, with *Feist's* originality inquiry, merger and scenes a faire inquiry, as the first prong, to filter out the protectable elements, admitting expert testimony, and then using *Monogram Models* case as the second prong, to determine substantial similarity from a viewpoint of an ordinary observer).

science and useful arts, conferred by the Intellectual Property Clause.³⁸ The monopoly created by the Copyright Act is thus justified by the need to encourage authors to produce intellectual works, so the ultimate goal of furthering the progress and dissemination of knowledge can be obtained.³⁹ Courts, particularly in recent years, have been especially cautious not to second-guess Congress as to the proper statutory scheme to further this constitutional goal.⁴⁰

38 *See* U.S. Const., art. I, § 8, cl. 8. Which provides that Congress shall have 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.”

39 *See* *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151,156 (1975) (“The immediate effect of our copyright law is to secure a fair return for an ‘author’s’ creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good. ‘The sole interest of the United States and the primary object in conferring the monopoly,’ this Court has said, ‘lie in the general benefits derived by the public from the labors of authors.’”).

40 *See* *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985). The Supreme Court warns: “In our haste to disseminate news, it should not be forgotten that the Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one’s expression, copyright supplies the economic incentive to create and disseminate ideas.” *Id.* at 558; *see also* *Eldred v. Ashcroft*, 537 U.S. 186 (2003). Where the Court reiterates that it is for Congress, not for the courts, to decide how to implement the language of the Copyright Clause. *Id.* at 212-13.

III. The DMCA

A. History and Background of the DMCA: It Was Enacted to Comply with WIPO

Long before the enactment of the DMCA on 1998, Congress made various hearings examining how to enforce copyrights in the digital world. The Commissions of the Judiciary of both House and Senate, gave attention to this issue.⁴¹ Ultimately, pursuant to the obligations of the U.S. as a member of the World Intellectual Property Organization Treaty (WIPO Treaty), the DMCA was enacted. As part of the obligations under that Treaty, the U.S. was required to provide protection and legal remedies against circumvention of technological measures that copyright owners might put in place in order to protect the rights recognized under WIPO or the Berne Convention.⁴²

41 *See* Universal City Studios, Inc. v. Corley, 273 F.3d 429, 440 (2d Cir. 2001) (Congress was looking into the issue of the digital age, even before the WIPO treaty).

42 S. REP. NO.105-190, at 1-2 (1998); *see also* Universal City Studios v. Reimerdes, 111 F. Supp. 2d 294 (S.D.N.Y. 2000). The court summarized the reasons for enacting the DMCA in this manner: "In December 1996, the World Intellectual Property Organization ("WIPO"), held a diplomatic conference in Geneva that led to the adoption of two treaties. Article 11 of the relevant treaty, the WIPO Copyright Treaty, provides in relevant part that contracting states "shall provide adequate legal protection and effective legal remedies against the circumvention of effective technological measures that are used by authors in connection with the exercise of their rights under this Treaty or the Berne Convention and that restrict acts, in respect of their works, which are not authorized by the authors concerned or

This act was justified as a way to deal with the challenges posed by the incoming of the digital age.⁴³ As the legislative record reveals, the DMCA was not intended at bringing startling change to the way things were before its inception. It only addressed a new problem, providing for new tools.⁴⁴ The text of the statute seems to suggest that the structure of the copyright law system won't be affected by enactment of the DMCA.⁴⁵ As enacted, the DMCA does not create any new

permitted by law.”. *Id.* at 315-16.

43 *See In re Aimster Copyright Litigation*, 334 F.3d 643, 655 (7th Cir. 2003) (where the Court, in reference to the problem faced by Internet service providers because of the infringing activities of its subscribers, stated that the DMCA is an attempt to deal with special problems created by the so-called “digital revolution”).

44 *See H.R. REP. NO. 105-551*, pt 1(1998). The House Report declared that: “[t]he treaties do not require any change in the substance of copyright rights or exceptions in U.S. law. They do, however, require two technological adjuncts to the copyright law, intended to ensure a thriving electronic marketplace for copyrighted works on the Internet.” *Id.* at 9-10.

45 *See 17 U.S.C. § 1201(c)(1)-(4)* (2000). Which provides:

Other rights, etc., not affected,

(1) Nothing in this section shall affect rights, remedies, limitations, or defenses to copyright infringement, including fair use, under this title.

(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.

(3) Nothing in this section shall require that the design of, or design and selection of parts and components for, a consumer electronics, telecommunications, or computing product provide for a response to any

property right not already recognized by Title 17.⁴⁶ Circumvention is not characterized by courts as an act of infringement, but merely a new cause of action available to the copyright holder.⁴⁷

B. Should we erase the C from DMCA?

One of the most consistent complaints about the DMCA is the accuracy of its name. Although called Digital Millennium Copyright Act, the statute keeps little resemblance to the known doctrines and figures of the general copyright law.⁴⁸ Even more, Sections 1201(c)(1)-(2) can be read as stressing a certain separation between what is plain-vanilla copyright law, and what the statute provides, so an argument can be made that the Digital Millennium Copyright Act is a different animal from the Copyright Act and copyright law in general.⁴⁹ It has been interpreted

particular technological measure, so long as such part or component, or the product in which such part or component is integrated, does not otherwise fall within the prohibitions of subsection (a)(2) or (b)(1).

(4) Nothing in this section shall enlarge or diminish any rights of free speech or the press for activities using consumer electronics, telecommunications, or computing products.

46 *See* Chamberlain Group, INC., v. Skylink Technologies, Inc., 381 F.3d 1178, 1192-93 (Fed. Cir. 2004) (where the court discusses the difference between property and liability).

47 *See id.* (where the court, after citing Section 1201(c)(1), concludes that circumvention is not infringement).

48 *See* Dan L. Burk, *Anticircumvention Misuse*, 50 UCLA L. REV. 1095 (2003). Arguing that the DMCA creates a right to control access, unprecedented in copyright law. *Id.* at 1103; *see also* H.R. REP. NO. 105-551, pt. 2, at 86 (1998); *see also* Nimmer, *supra* note 4.

49 *See* Universal City Studios, Inc. v. Corley, 273 F.3d 429 (2d Cir. 2001). The court concludes

that the DMCA was enacted under Congress authority under the Commerce Clause, not the Copyright Clause.⁵⁰ It has further been interpreted that the enactment of the DMCA is not unconstitutional use of federal power, and that it does not interfere with the copyright law.⁵¹

i. Anti-circumvention under the DMCA Consists of Three Key Provisions

The DMCA incorporated various causes of action for liability, namely Section 1201(a)(1) (the anti-circumvention provision), Section 1201(a)(2) and Section 1201(b)(1) (the anti-trafficking

that DMCA targets the circumvention of digital walls guarding copyrighted material, but does not concern itself with the use of those materials after circumvention has occurred. *Id.* at 443; *see also* Universal City Studios v. Reimerdes, 111 F. Supp. 2d 294 (S.D.N.Y. 2000). The court found that DMCA fundamentally altered the landscape, referring to the application of fair use as a defense to trafficking. A technology might have substantial noninfringing uses, but nonetheless still be subject to a charge under Section 1201. *Id.* at 323-24.

50 U.S. Const. art. 1, § 8, cl. 3 (Commerce Clause). Which provides that Congress shall have power: “To regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes;”; *see also* United States v. Elcom, Ltd., 203 F.Supp.2d 1111, (N.D. Cal. 2002). The courts finds that DMCA was enacted under the power of Congress under the Commerce Clause. *Id.* at 1137-39.

51 *See Elcom*, 203 F.Supp.2d at 1111. The courts concludes that the enactment of the DMCA by Congress pursuant to its power under the Commerce Clause is not an exercise fundamentally inconsistent with the Intellectual Property Clause, thus, it does not exceed its authority. *Id.* at 1139-42.

provisions) to facilitate the protection of works that fall under Title 17.⁵² The anti-circumvention provision prohibits a practice that up to that point was legal, within the framework of the Copyright Act,⁵³ the circumvention of a technological measure that effectively controls access to a work under Title 17.⁵⁴ In brief synthesis, the prohibition encompasses from decrypting to merely avoiding or bypassing, a certain technological measure, that ordinarily would control the access to a work protected by Title 17, without the authorization of the copyright owner of that work.⁵⁵ The first of the two anti-trafficking provisions, Section 1201(a)(2), generally prohibits

52 *See* Chamberlain Group, INC., v. Skylink Technologies, Inc., 381 F.3d 1178, 1196 (Fed. Cir. 2004). The Court stated: “... the DMCA created circumvention liability for "digital trespass" under § 1201(a)(1). It also created trafficking liability under § 1201(a)(2) for facilitating such circumvention and under § 1201(b) for facilitating infringement (both subject to the numerous limitations and exceptions outlined throughout the DMCA).” *Id.* at 1196; *see also* Universal City Studios, Inc. v. Corley, 273 F.3d 429, 440-41 (2d Cir. 2001) (summarizing the three provisions targeted at the circumvention of technological protections).

53 *See* Chamberlain Group, INC., v. Skylink Technologies, Inc., 381 F.3d 1178 (Fed. Cir. 2004). The court notes that: “Prior to the **DMCA**, a copyright owner would have had no cause of action against anyone who circumvented any sort of technological control, but did not infringe”. *Id.* at 1195-96.

54 *See* 17 U.S.C. § 1201(a)(1)(A) (2000). Which provides, in the pertinent part: “No person shall circumvent a technological measure that effectively controls access to a work protected under this title.”.

55 *See* 17 U.S.C. § 1201(a)(3) (2000), which provides:

the trafficking of devices or technologies that facilitate circumvention, as established in Section 1201(a)(1).⁵⁶ The second of the two the anti-trafficking provisions, Section 1201(b)(1), generally prohibits the trafficking of devices or technologies that facilitate the infringement of rights protected by technological measures.⁵⁷ This prohibition is different from the one codified

As used in this subsection--

(A) to "circumvent a technological measure" means to descramble a scrambled work, to decrypt an encrypted work, or otherwise to avoid, bypass, remove, deactivate, or impair a technological measure, without the authority of the copyright owner; and

(B) a technological measure "effectively controls access to a work" if the measure, in the ordinary course of its operation, requires the application of information, or a process or a treatment, with the authority of the copyright owner, to gain access to the work.

56 See 17 U.S.C. § 1201(a)(2) (2000). Which provides:

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 a technological measure that effectively controls access to a work protected under this title;

(B) has only limited commercially significant purpose or use other than to circumvent a technological measure that effectively controls access to a work protected under this title [17 U.S.C. § 101 et seq.]; or

(C) is marketed by that person or another acting in concert with that person with that person's knowledge for use in circumventing a technological measure that effectively controls access to a work protected under this title.

57 See 17 U.S.C. § 1201(b)(1) (2000). Which provides:

in Section 1201(a)(2), in that it is directed at protecting technological measures that may grant access to a work, but still control the exercise of some right, like the right to make copies of that work.⁵⁸ Congress made clear that these prohibitions are not interchangeable, and may not apply to the same devices.⁵⁹ Different prohibitions suggest different concerns on part of Congress, as to what circumstances afford stronger protection to owners, and what circumstances weaken this

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 a right of a copyright owner under this title [17 U.S.C. § 101 et seq.] in a work or a portion thereof;

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

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

58 See S. REP. NO. 105-190 (1998). The Committee on the Judiciary described that a measure that does nothing to control access to the plain text of a work, but protects against copying, displaying, performing or distributing the work, would be protected under Section 1201(b) from a device that facilitates its circumvention. *Id.* at 12.

59 See S. REP. NO. 105-190 (1998). The Committee on the Judiciary clarifies that although sections 1201(a)(2) and 1201(b) are worded similarly and employ similar tests, they are designed to protect two distinct rights and to target two distinct classes of devices. *Id.* at 12.

protection in favor of users.⁶⁰ Mainly, there is no prohibition against the circumvention of technological measures that protect the exercise of rights of the copyright owner, only a prohibition to trafficking, there is no equivalent to Section 1201(a)(1)(A) to address this conduct.⁶¹ According to the congressional record, the prohibition in Section 1201(a)(1) “is necessary because prior to this Act, the conduct of circumvention was never before made unlawful.”⁶² According to Congress, “[t]he device limitation in 1201(a)(2) enforces this new prohibition on conduct”, (circumvention).⁶³ On the other hand, “[t]he copyright law has long forbidden copyright infringements, so no new prohibition was necessary.”⁶⁴ Section 1201(b), the second anti-trafficking prohibition, or in words of Congress, the “device limitation”, only “enforces the longstanding prohibitions on infringements.”⁶⁵

60 See Jane C. Ginsburg, *Copyright Legislation for the “Digital Millennium,”* 23 COLUM.-VLA J.L. & ARTS 137 (1999). Where the commentator argues that the contrast between protection afforded to access-control measures versus use-control measures indicates that the DMCA “tolerates direct end-user circumvention of post-access anticopying measures, to a far greater extent than it does circumvention of access controls.” *Id.* at 139.

61 See S. REP NO. 105-190 (1998). The Committee on the Judiciary declared that there is “no prohibition on conduct in 1201(b) akin to the prohibition on circumvention conduct in 1201(a)(1)”. *Id.* at 12.

62 *Id.*

63 *Id.*

64 *Id.*

65 *Id.*

ii. Access-control and Use-control Technologies Might Be Another Way to Look at These Provisions

Another way to characterize the difference between the definitions set out in Section 1201(a)(3)(B) and Section 1201(b)(2)(B), is to consider the former as referring to access-control technologies, and the latter to use-control technologies.⁶⁶

iii. Some Examples of Both Types of Technological Control Measures

a) An Example of an Access-Control Measure

We can envision a straightforward access-control measure in the form of a specific medium (CD, DVD, floppy, hard disk, etc.) containing a work of authorship in digital format (a text file containing 2001:Space Odyssey, for example), guarded by a password. Assume a law student acquires a copy of a CD containing review materials for the patent bar, which include plain text copies of Supreme Court decisions about patents, as well as summaries and checklists prepared by recognized commentators. The files, once accessed, can be easily read, copied into the

⁶⁶ See Peter K. Yu, *Anticircumvention and Anti-anticircumvention*, 84 DENV. U. L. REV. 13 (2006). Professor Yu recognizes the different treatment given by the statute to two distinct technologies, the so-called access-control and use-control technologies, and the reasons for such a distinction. *Id* at 36.

computer of the student, or printed in paper. Yet, before granting access to browse the files inside it, the CD requires the user to enter a password. The CD may allow the user to browse its content right away, but the content may be simply a folder named “lock.” That folder, on the other hand, will not let the user browse its content unless the user, the student, enters the correct password. The student may have bought the CD from the publisher, so we can assume she possesses the “key”, or she may have bought the CD from a recently graduated fellow student, and that fellow student might have provided her with the password.⁶⁷ As described, the password feature in the CD works as an access-control measure, as defined by Section 1201(a)(2). The capacity to either copy the content, or to do any of the other actions listed in Section 106, is not limited or controlled by this particular measure; once accessed, the files can be copied, altered or printed without restrictions.⁶⁸

b) An Example of a Use-Control Measure

A scenario can be described for the use-control provision: We take the same CD and the same student. Now, instead of being controlled by a password, the content of the CD is accessible to the student. He can access all the files in the CD and can open them and read them in order to prepare for the bar. Yet, as in the previous example, there is an obstacle. Now the files are not in

67 For simplicity, the publisher in this example does not regulate the use of its CD through a license agreement or other kind of contract.

68 This example is loosely based on the facts of *Universal City Studios v. Reimerdes*, 111 F. Supp. 2d, 294 (S.D. N.Y. 2000), and *RealNetworks, Inc. v. Streambox, Inc.*, 2000 U.S. Dist. LEXIS 1889, (W.D. Wash. 2000).

plain text format, but in more restrictive PDF format. Although the student can easily open and read the files with the appropriate viewer application, when he tries to copy the files to the hard disk of his computer, he receives an error message from his machine, and the copying operation is aborted. The files in this format contain a certain internal “flag,” or instruction, that prevents the host computer from copying them. Minutes later, when the student tries to print one of the cases in paper form to facilitate its reading and to make notes, he receives yet another error message, and the printing process is aborted. The files in this format also contain another internal “flag” that prevents the host computer from printing them. This last description is a good example of a use-control (or copy-control) measure, as defined in Section 1201(b)(1).⁶⁹

iv. Some Examples Taken From Actual Cases

The technology used for controlling content within a DVD-formatted disc, which was the subject of the *Reimerdes/Corley* litigation,⁷⁰ was litigated as a Section 1201(a)(2) access-control measure. The content on the DVD, the movie, is recorded in digital format on a DVD disk.⁷¹ Content stored digitally, in and of itself, requires the translation of whatever was the original embodiment of the work (perceivable signs, like text, or perceivable images and sound like in the

69 This example is loosely based on the facts of *United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111 (N.D. Cal. 2002), and the technology known as the Adobe Acrobat eBook Reader. *Id.* at 117-119.

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

71 *Id.* at 305-307.

case of a movie) into bits (ones and zeros), a language understandable by machines such as computers. Those machines can then read the ones and zeros and reproduce the work in a perceivable way (like playing images and sound on a TV monitor).⁷² DVD is one of such technologies, comprising a certain format to translate the original work into certain media to hold the work once translated to that format, and certain devices, such as the DVD players, that read and reproduce that format into images and sounds.⁷³ CSS, or Content Scramble System, is the access-control system for DVDs developed by the motion picture companies. With the use of the CSS technology, as in *Reimerdes*, that digital format containing the copyrighted movie is not readable right away by a non-CSS DVD player. The data that forms the movie is scrambled and encrypted. Thus, a consumer who tries to play the movie's DVD with his non-CSS DVD drive on his computer, will get no images or sounds out of his monitor and speakers. On the other hand, if he tries to play it on a CSS-licensed DVD drive, that device will be able to decrypt and unscramble the data contained on the DVD, so then he will perceive images and sound from his monitor and speakers.⁷⁴

The technology used by Adobe, as resolved in *US v. Elcom, Ltd.*,⁷⁵ was recognized as a Section

72 *Id.*

73 *Id.*

74 *See Universal City Studios v. Reimerdes*, 111 F. Supp. 2d, 294 (S.D.N.Y. 2000). Where the court discusses the how the CSS technology works to control access to copyrighted material contained on a DVD disk. *Id.* at 308.

75 *United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111 (N.D. Cal. 2002).

1201(b)(1) technological measure for protecting rights.⁷⁶ The publisher would convert his digital book to Acrobat eBook Reader, and would make it available for consumers on the internet through an Acrobat Content Server. The publisher is capable of choosing what the consumer of the book will be allowed to do with it. For example, the publisher may choose that the copy of the eBook, once downloaded by the consumer, cannot be copied to other computers. Or he can choose that no pages can be printed from the digital copy, or the text cannot be read audibly by the computer.⁷⁷ This eBook, once downloaded by the consumer, would be played in Acrobat eBook Reader application installed in his computer. The downloaded eBook would include a kind of a digital “voucher” that will tell the application what kind of behaviors it can allow from this consumer, based on the choices done by the publisher.⁷⁸ Of importance to our analysis is that this technology works as a control measure to the exercise of one or various rights of the copyright owner, like reproduction, without necessarily controlling some others, like public performance.⁷⁹

v. How the Examples Relate to the Statutory Definitions

Before comparing how the examples just elaborated fit into the statutory language, it is necessary to revisit the anti-circumvention provisions and how they define the regulated conduct. As

76 See *United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111, (N.D. Cal. 2002). Where the court describes the scheme of the Adobe Acrobat eBook Reader. *Id.* at 1117-119.

77 *Id.*

78 *Id.*

79 *Id.*

previously mentioned, the first two provisions prohibit specific conduct related to access-control measures, while the third provision prohibits conduct related to use-control measures.⁸⁰ But does the statute directly mention access-control measures or use-control measures? It does not. Then, what does the statute refer to, and how it relates to the concepts we have been using?

a) Access-Control Measures in Section 1201(a)(3)

First, let's cover where the so-called access-control measures come from. Sections 1201(a)(1)(A) and 1201(a)(2), respectively, regulate the direct circumvention, and the trafficking of circumventing devices or technologies.⁸¹ Yet, the definition for the key elements of both sections is contained in Section 1201(a)(3).⁸² That section does not include the term access-control measure, however, it does make reference to technological measures that effectively control access. Then how a technological measure is defined by Section 1201(a)(3)? It is not.⁸³ How about access, is it defined by Section 1201(a)(3)? Again, no.⁸⁴ Neither of these two terms is directly defined by the Section 1203(a)(3), or by any other section in Chapter 12. They are,

⁸⁰ See *supra* text accompanying notes 52-65.

⁸¹ *Id.*

⁸² See 17 U.S.C. § 1201(a)(3) (2000).

⁸³ *Cf.* *Universal City Studios v. Reimerdes*, 111 F. Supp. 2d 294 (S.D.N.Y. 2000). The court describes how the Statute does define the function a technological measure is intended to do, and that supplies sufficient basis for clear interpretation. *Id.* at 317-18.

⁸⁴ See *Lexmark Int'l, Inc.*, 253 F. Supp. 2d 943, 967 (where the court acknowledges the lack of a definition for "access" in the statute).

nonetheless, indirectly defined, by reference to two other concepts, effective control, and circumvention. This is done by way of two definitional phrases. The first of these phrases is defined in Section 1201(a)(3)(A). It does not define a technological measure, but it does define how that technological measure, whatever it is, is circumvented. Thus, to “circumvent a technological measure” means to descramble a scrambled work, to decrypt an encrypted work, or otherwise to avoid, bypass, remove, deactivate, or impair a technological measure, without the authority of the copyright owner.⁸⁵ The previous statutory definition is good at defining “circumvention”, more so than to actually define “technological measure”, although it can be inferred that it may include processes such as encryption and scrambling of the work. The second phrase also refers to a technological measure, but this time, it defines how that technological measure, whatever it is, holds effective control of access to a work. Thus, a technological measure “effectively controls access to a work” if the measure, in the ordinary course of its operation, requires the application of information, or a process or a treatment, with the authority of the copyright owner, to gain access to the work.⁸⁶ Once again, this definitional phrase gives us an idea of what the statute considers as effective control, but is not so helpful at defining “technological measure”, although, once again, we can infer that such measure will have to require the user to provide some information or apply some process, in order to allow access to the work. And what is access? It remains undefined.⁸⁷ Although the statute tells us something

85 See 17 U.S.C. § 1201(a)(3)(A) (2000).

86 See 17 U.S.C. § 1201(a)(3)(B) (2000).

87 See Zohar Efroni, *A Momentary Lapse of Reason: Digital Copyright, the DMCA and a Dose of Common Sense*, 28 COLUM. J.L. & ARTS 249 (2005). The author points out that the

about access. The statute tells us how access is gained by prohibited means, or circumvention. The district court in *Lexmark*,⁸⁸ recognizing the lack of a definition for the term "access" in the DMCA, proceeded to give the term its ordinary, customary meaning, which according to the dictionary definition, was "the ability to enter, to obtain, or to make use of."⁸⁹ Therefore, it found that the plaintiff's authentication sequence effectively "controls access" to its two copyrighted programs "because it controls the consumer's ability to make use of these programs."⁹⁰ On appeal, the Sixth Circuit adopted this very definition, although it reached a different conclusion when it applied it to the facts of the case.⁹¹ In fact, the Sixth Circuit centered its analysis on a concept that is better addressed by Section 1201(a)(3) than access, namely the phrase

DMCA, although for the first time in U.S. Copyright history established the foundations for a right of access, it did not define access. *Id.* at 300-01.

88 *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 253 F. Supp. 2d 943 (E.D. Ky. 2003) *vacated*, 387 F.3d 522 (6th Cir. 2004).

89 *See Lexmark Int'l, Inc.*, 253 F. Supp. 2d at 967 (where the court uses the Merriam-Webster's Collegiate Dictionary to define access").

90 *Lexmark Int'l, Inc.*, 253 F. Supp. 2d at 968.

91 *See Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522 (6th Cir. 2004).

The court finds that anyone who buys a Lexmark printer may read the literal code of the Printer Engine Program, which includes a copy of the Toner Loading Program, directly from the printer memory, without the need of the authentication sequence, and then copy and distribute it, therefore, Lexmark's access-control measure does not in fact control access to these programs. *Id.* at 546-50.

"effectively controls". The appellate court analyzed the control scheme created by Lexmark, and found that neither of the two computer programs was really guarded from access by this scheme. The court used the analogy of the front door and the back door of a house.⁹² The court understood it is unlikely to believe that a locked back door would control access into the house while the front door has no lock. Similarly the court concluded that Lexmark's technological measures did not control "effectively" access to its programs, when they were open for copying from the printer's memory.⁹³

Access-control measure has been the term used by courts and law professors to refer to the type of technological measure defined in Section 1201(a)(3), which underlies the prohibitions in Sections 1201(a)(1)(A) and 1201 (a)(2).⁹⁴

b) The Example Compared to Section 1201(a)(3)

Now its time to go back to our previous example of the law student with the CD containing various review materials for the patent bar. In the scenario where the CD contains a password

92 *See* Lexmark Int'l, Inc. v. Static Control Components, Inc., 387 F.3d 522, 547 (6th Cir. 2004).

93 *Id.*

94 *See* Lexmark Int'l, Inc. v. Static Control Components, Inc., 387 F.3d 522, 531, 545 (6th Cir. 2004) (referring to access control measures); *see also* Universal City Studios v. Reimerdes, 111 F. Supp. 2d 294, 304 (S.D.N.Y. 2000) (referring to access controls); *see also* Peter K. Yu, *Anticircumvention and Anti-anticircumvention*, 84 DENV. U. L. REV. 13, 35-38 (2006) (discussing the differences between access-controls and use-controls).

feature, that precludes all access to its contents, the password feature would be the so-called technological measure. This password controls all access to the review materials on the CD, although once the password is provided by the user, any kind of copying, viewing and editing of the materials is allowed, therefore, the password or technological feature effectively controls access to the work, because in the ordinary course of operation, it requires the user to apply some information, in this case a password, to access such content. All it controls is access, as the files inside the CD will pose no new obstacle for the student if she tried to copy them.⁹⁵ Also, the contents of the CD includes, in addition to case law, review materials written by known commentators, materials that are most likely subject to copyright protection, so for purposes of this example, the technological measure controls access to a work protected under Title 17. In brief, we have a technological measure (the password feature) that effectively controls (requires the user to provide a password) access (before the user can perceive and use the materials) to a work protected by "this Title"(which include copyrighted reviews). In the *Reimerdes/Corley* litigation, the district court found that the CSS was an effective technological measure, because in the ordinary course of operation, only allowed access to the work contained in the DVD by using (applying a process) a DVD player or drive licensed (authorized) by the copyright owner.⁹⁶

95 *See* S. REP. NO. 105-190 (1998). The Committee on the Judiciary described that a measure that controls access to a the plain text of a work but does nothing to prevent copying, displaying, performing or distributing the work, would be covered under Section 1201(a)(2) from a device that facilitates its circumvention. *Id.* at 12.

96 *See* *Universal City Studios v. Reimerdes*, 111 F. Supp. 2d 294, 317-18 (S.D.N.Y. 2000) (discussing how the CSS-protected DVD can only be accesses when using a CSS-licensed

c) Section 1201(a)(3) Does Not Define “Work Protected By This Title”

A noteworthy omission in Section 1201(a)(3) and in all of Chapter 12 is the lack of a definition of “work” or more precisely, “work protected by this Title”. We may look for guidance in the language of Section 102(a) of the Copyright Act, and its reference to the original works of authorship.⁹⁷ Although no direct definition of works of authorship appears on the Copyright Act,⁹⁸ some specific categories are included as part of Section 102, and definitions for some of those works are included in Section 101.⁹⁹ This omission on the DMCA might acquire relevance, as we will discuss in a subsequent section.

d) Use-Control Measures in Section 1201(b)(2)

Similar to the definition of access control measure, the definition of use-control measures is indirect. Section 1201(b)(2) defines when a technological measure effectively protects a right of the copyright owner over the work.¹⁰⁰ This definition underlies the prohibition codified in

player or drive).

97 See 17 U.S.C. § 102(a) (2000). Which provides in relevant part: “Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression...”.

98 See 1-2 Nimmer on Copyright § 2.03.

99 See 17 U.S.C. § 102 (2000), quoted *supra* note 12; see also 17 U.S.C. § 101 (2000).

100 See 17 U.S.C. § 1201(b)(2) (2000). Which provides:

Section 1201(b)(1), against the trafficking of devices or technologies for circumvention.¹⁰¹ The phrasing of Section 1201(b)(2) is similar to the one used in Section 1201(a)(3), with the subtle difference of the change in syntax. The first definitional phrase now reads "to circumvent protection afforded by a technological measure", instead of the previous "to circumvent a technological measure", in Section 1201(a)(3)(A). Now, such action is defined as "avoiding, bypassing, removing, deactivating, or otherwise impairing a technological measure".¹⁰² A few missing words on this particular definition further mark the distinction. No reference is made this time about descrambling, decrypting, and maybe more importantly, about the authorization by the owner. Similarly, the second definitional phrase reads "a technological measure effectively protects a right of a copyright owner under this title", instead of "a technological measure effectively controls access to a work", under Section 1201(a)(3)(B).¹⁰³ The protection is considered to be afforded by the technological measure, if the measure, "in the ordinary course of its operation, prevents, restricts, or otherwise limits the exercise of a right of a copyright

(2) As used in this subsection--

(A) to "circumvent protection afforded by a technological measure" means avoiding, bypassing, removing, deactivating, or otherwise impairing a technological measure; and

(B) a technological measure "effectively protects a right of a copyright owner under this title" if the measure, in the ordinary course of its operation, prevents, restricts, or otherwise limits the exercise of a right of a copyright owner under this title.

101 See 17 U.S.C. § 1201(b)(1) (2000).

102 See 17 U.S.C. § 1201(b)(2)(A) (2000).

103 Compare 17 U.S.C. § 1201(b)(2)(B) (2000) with 17 U.S.C. § 1201(a)(3)(B) (2000).

owner under this title.¹⁰⁴ Unlike the access-control measures, this definition does not contemplate the possibility that the user might apply some information or process in order to go beyond whatever limitation the measure imposes on his use of the work. In that sense, access-control measures work like doors, where the user without a key will be left out, while the user with a key will be allowed to enter.¹⁰⁵ In contrast, use-control measures work like a watermarked sheet of paper, that might allow the user to read its content, but makes it impossible for him to photocopy it, and there is no authorized "key" that would otherwise allow him to photocopy.¹⁰⁶

e) The Example Compared to Section 1201(b)(2)

Back to the example of the law student. In the second scenario, the CD is accessible right away, and the files can be opened on the appropriate viewer software, but not much more can be done

104 See 17 U.S.C. § 1201(b)(2)(B).

105 Cf. H.R. REP. NO. 105-551, pt 1(1998). The Committee on the Judiciary views the circumvention of the access-control measures as "the electronic equivalent of breaking into a locked room in order to obtain a copy of a book." *Id.* at 17; cf. H.R. REP. NO. 105-551, pt 2 (1998). The Committee on Commerce considers as "effective" those technological measures that require the use of a "key" provided by a copyright owner to gain access to a work. *Id.* at 39.

106 See *United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111, (N.D. Cal. 2002). The court compared the use-control measures to "what is now commonly done on bank checks, so that the photocopy revealed printing that is otherwise unnoticeable on the original, perhaps rendering the text difficult to read on the photocopy." *Id.* at 1131.

with them. The "flags" embedded in the files' code, probably along with the viewing software that recognizes these flags, would be the technological measure.¹⁰⁷ The limitation to printing or copying these files would be protection afforded by a technological measure. The right of the copyright owner under Title 17, in this particular example, would be the right to reproduce.¹⁰⁸ The already mentioned protection would be "effective", because although the user can read the files, there is no way, in the ordinary operation of the viewer software, in which the user might overcome that limitation or obstacle to reproducing the files, there is no key that would allow him to.

So in this scenario we have protection afforded (the inability to copy the files) by a technological measure (by way of tags in the files, in conjunction with the viewer program) that effectively protects (that in the ordinary operation cannot be overcome) a right of a copyright owner under this title (the right of reproduction). In *Elcom, Ltd.*,¹⁰⁹ the court found that the digital "voucher" embedded in the eBook, in conjunction with the Acrobat eBook Reader application, was a technological measure, because in the ordinary course of operation, impeded (protected) the copying or printing (a right of the copyright owner under Title 17) of the contents of the eBook

107 See S. REP. NO. 105-190 (1998). The Committee on the Judiciary described that a measure that does nothing to control access to the plain text of a work, but protects against copying, displaying, performing or distributing the work, would be covered under Section 1201(b) from a device that facilitates its circumvention. *Id.* at 12.

108 See 17 U.S.C. § 106 (1) (2000).

109 See *United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111 (N.D. Cal. 2002). Where the court describes the scheme of the Adobe Acrobat eBook Reader. *Id.* at 1117-1119.

(a work or portion thereof).¹¹⁰

f) Section 1201(b)(2) Does Not Define “Right of A Copyright Owner”

Similar to the term “work protected under this Title”, the term “a right of a copyright owner under this Title” is not particularly defined by the DMCA. Is not hard to conclude that such a term needed no definition by the DMCA, as it is well described in the Copyright Act itself.¹¹¹ Yet, at least one court has tried to construe the extent of these rights in the context of the protection given by Section 1201(b), and the result was not entirely identical to what traditional copyright provides.¹¹² Along with the term “work protected”, the definition of rights under this legislation might acquire some relevance in a subsequent section.

vi. Merged Use and Copy Controls Might Make All This Discussion Irrelevant

The interpretations that the courts have given to the two types control measures covered by the anti-trafficking provisions are not without criticism.¹¹³ The main attack is that these

110 *Id.*

111 *See* 17 U.S.C. § 106 (2000).

112 *See infra* text accompanying notes 225-236.

113 *See* R. Anthony Reese, *Will Merging Access Controls and Rights Controls Undermine the Structure of Anticircumvention Law?*, 18 BERKELEY TECH. L.J. 619, 650-52 (2003) (criticizing how affording both statutory protections to a single technological measure will in fact impede the users from doing noninfringing uses of lawfully acquired works).

interpretations erase any real distinction between the two types of protection.¹¹⁴ The key distinction being referred to is that the DMCA bans the circumvention of access-control measures, but does not ban the circumvention of use-control measures.¹¹⁵ Cases like *RealNetworks, Inc. v. Streambox, Inc.*,¹¹⁶ recognized the protection of both access-control and use-control provisions to different features of the same software designed to control the distribution of copyrighted material on the Internet.¹¹⁷ A quintessential technological “merged” measure would be the CSS, as resolved in *Reimerdes/Corley*.¹¹⁸ Although CSS controlled access

114 *See id.* The author cites cases where courts have recognized overlapping protection of Sections 1201(a)(2) and 1201(b)(1), to technological measures that merge access-control with use-control. *Id.* at 621.

115 *See id.* The author notes that Congress expressly provided less protection for rights controls so that consumers could make noninfringing uses of works in protected digital format, the same way it has been for centuries with analog copies. *Id.* at 621.

116 *RealNetworks, Inc. v. Streambox, Inc.*, No. C99-2070P, 2000 U.S. Dist. LEXIS 1889 (W.D. Wash. Jan. 18, 2000).

117 *See RealNetworks, Inc. v. Streambox, Inc.*, 2000 U.S. Dist. LEXIS 1889, (W.D. Wash. 2000). Where the courts found that the “secret handshake” feature protected access to the works, while the “copy switch” feature protected rights over a work, like the right to copy it. Thus, it concluded that Section 1201(a)(2) afforded protection to the former, and Section 1201(b)(1) afforded protection to the latter. *Id.* at page 18-20.

118 *See Reese, supra* note 113. Where the author discusses how the ultimate goal of CSS was not access control, but copy control, although the scheme selected did control access,

to a work through the requirement of a specifically licensed DVD player, the implementation of that control mechanism was mainly for the purpose of forbidding the copying of the movies stored on the DVD.¹¹⁹ The CSS-licensed DVD player would not provide a digital output that may enable the user to copy the movie. It is unlikely that the reason motivating the movie studios was to sell their own DVD players. It seems more likely that the requirement responded to a more specific concern of precluding copying, and thus piracy.¹²⁰ This raises the question of whether the balance struck by Congress can easily be subverted by technologies that “naturally” implement features that control both access to the work and the use of said work.¹²¹ The congressional record seems to provide conflicting views in this regard. On one hand, the Senate Report declared that the prohibitions against circumvention of access and use controls “are designed to protect two distinct rights and to target two distinct classes of devices”.¹²² This language might be interpreted as precluding the application of both statutory protections to a single device.¹²³ Yet, the House of Report declared that Section 1201(a)(1)(A) “does not apply to

and thus was decided under the provision in Section 1201(a)(2). *Id.* at 643-646.

119 *Id.*

120 *Id.*

121 *See* Reese, *supra* note 113. The author argues that owners might be freed from the need to choose between one statutory provision or the other by simply implementing technologies that incorporate both access- control and use-control features. *Id.* at 641.

122 *See* S. REP. NO. 105-190, at 12 (1998).

123 *See* Reese, *supra* note 113. Arguing that Congress enacted two types of measure protections “to ensure that users would continue to enjoy a wide range of noninfringing uses

the subsequent actions of a person once he or she has obtained authorized access to a copy of a work protected under Title 17, even if such actions involve circumvention of additional forms of technological protection measures.”¹²⁴ This language presumes the possible coexistence of two forms of technological protection measures over one work.

C. The Elements of a Trafficking Claim Include an Inquiry of Infringement

The Federal Circuit took the task of defining the boundaries of a cause of action under Section 1201(a)(2).¹²⁵ As formulated by the Federal Circuit, the elements of a DMCA cause of action under Section 1201(a)(2) are as follows: First, the plaintiff must prove its ownership of a valid copyright (typically the registration of such right will do). Second, the plaintiff must prove that such work was effectively controlled by a technological measure that later was circumvented. Third, due to that circumvention, others have gained access to that work. Fourth, that access was not authorized by the copyright owner. And fifth, because of that access, others have infringed or

of copyrighted works”. *Id.* at 650.

124 See H.R. REP. NO. 105-551, pt 1, at 18 (1998).

125 See *Chamberlain Group, INC., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004), *cert. denied*, 544 U.S. 923 (2005). The Federal Circuit found that, just like in *Corley*, the DMCA provision at issue was Section 1201(a)(2) of the DMCA. But unlike the Second Circuit in *Corley*, the Federal Circuit noted, their task for this case went beyond the constitutional challenge to the DMCA, and required them to delineate the full boundaries of anti-circumvention and anti-trafficking liability under the DMCA, taking into account the intent of Congress. *Id.* at 1195.

are allowed to infringe a right protected by the Copyright Act. After these five elements have been proved, the plaintiff has still one final burden. It has to prove that such circumvention occurred by means of a product that either: a) was designed by the defendant primarily for circumvention, b) the defendant made available despite the fact that it had little economical use other than to circumvent, or c) was marketed by the defendant as a method to circumvent.¹²⁶ The Federal Circuit later made it even clearer that the fifth element required not only a showing of copyright infringement, but infringement because of the facilitated access.¹²⁷

126 *See id.* When discussing the elements of anti-trafficking liability, the court declared that:

A plaintiff alleging a violation of § 1201(a)(2) must prove: (1) ownership of a valid copyright on a work, (2) effectively controlled by a technological measure, which has been circumvented, (3) that third parties can now access (4) without authorization, in a manner that (5) infringes or facilitates infringing a right protected by the Copyright Act, because of a product that (6) the defendant either (i) designed or produced primarily for circumvention; (ii) made available despite only limited commercial significance other than circumvention; or (iii) marketed for use in circumvention of the controlling technological measure. A plaintiff incapable of establishing any one of elements (1) through (5) will have failed to prove a prima facie case. A plaintiff capable of proving elements (1) through (5) need prove only one of (6)(i), (ii), or (iii) to shift the burden back to the defendant. At that point, the various affirmative defenses enumerated throughout § 1201 become relevant.

Id. at 1203.

127 *See Storage Tech. Corp. v. Custom Hardware Eng'g & Consulting, Inc.*, 421 F.3d 1307 (Fed. Cir. 2005). Where the court determined that even if plaintiff were able to prove that the automatic copying of the software into RAM constituted copyright infringement, however, it would still have to show that the defendant's technology facilitated that infringement. *Id.* at 1318-1319.

D. Remedies and Criminal Penalties Under the DMCA Anti-Circumvention

Provisions

Section 1203, titled Civil Remedies, provides a civil cause of action for violation of Sections 1201 and 1202.¹²⁸ Section 1203 (b) provides courts with the power to grant injunctions, both preliminary and permanent, to award damages, attorney's fees, costs, and to impound, as well as destroy, any device involved in the violation of the provisions against circumvention (Sections 1201 and 1202).¹²⁹ While Section 1204 provides for criminal sanctions.¹³⁰

128 *See* 17 U.S.C. § 1203(a) (2000) Civil actions. Which provides: “Any person injured by a violation of section 1201 or 1202 [17 U.S.C. § 1201 or § 1202] may bring a civil action in an appropriate United States district court for such violation.”.

129 *See* 17 U.S.C. § 1203(b) (2000). Which provides:

In an action brought under subsection (a), the court--

(1) may grant temporary and permanent injunctions on such terms as it deems reasonable to prevent or restrain a violation, but in no event shall impose a prior restraint on free speech or the press protected under the 1st amendment to the Constitution;

(2) at any time while an action is pending, may order the impounding, on such terms as it deems reasonable, of any device or product that is in the custody or control of the alleged violator and that the court has reasonable cause to believe was involved in a violation;

(3) may award damages under subsection (c);

(4) in its discretion may allow the recovery of costs by or against any party other than the United States or an officer thereof;

E. Preliminary Injunction Elements under DMCA Are Similar to Injunction for Copyright Infringement

The four general factors used by courts for determining whether to enter a preliminary injunction are applied similarly for injunctions under the DMCA. Namely, the plaintiff have to show likelihood of success on the merits, irreparable harm to him if the injunction is not granted,¹³¹ that it will not cause substantial harm to others, and that the public interest will be served. As with previous cases of injunctions for copyright infringement, courts have relied more heavily on

(5) in its discretion may award reasonable attorney's fees to the prevailing party; and

(6) may, as part of a final judgment or decree finding a violation, order the remedial modification or the destruction of any device or product involved in the violation that is in the custody or control of the violator or has been impounded under paragraph (2).

130 See 17 U.S.C. § 1204 (a) (2000). Which provides:

Any person who violates section 1201 or 1202 willfully and for purposes of commercial advantage or private financial gain--

(1) shall be fined not more than \$ 500,000 or imprisoned for not more than 5 years, or both, for the first offense; and

(2) shall be fined not more than \$ 1,000,000 or imprisoned for not more than 10 years, or both, for any subsequent offense.

131 Cf. *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 532 (6th Cir. 2004) (where the court enumerates, as the second factor for determining the adequacy of a preliminary injunction, the “possibility of irreparable harm”).

the first element, than on the rest, as the irreparable harm and the benefit to the public interest are presumed once likelihood of success on the merits has been established.¹³²

F. The Criminal Procedures under DMCA Have Already Produced Noteworthy Consequences

As previously mentioned, the DMCA also provides for criminal actions.¹³³ For a defendant to be subjected to the criminal sanctions of the statute, he must violate either Section 1201 or 1202, and do so willfully, an element not required for a common copyright infringement case.¹³⁴ His

132 *See id.* When deciding to apply in a DMCA context the same presumption previously applied to copyright cases, the court declared: “In the copyright context, much rests on the first factor because irreparable harm is presumed once a likelihood of success has been established, and because an injunction likely will serve the public interest once a claimant has demonstrated a likelihood of success in this setting.” *Id.* at 532-33; *see also* *Goldman v. Healthcare Mgmt. Sys.*, No. 1:05-CV-35, 2006 U.S. Dist. LEXIS 89001, at *9-10 (W.D. Mich. Dec. 8, 2004) (where the court, after finding that the plaintiff have failed to prove likelihood of success on the merits, which also worked against him in proving other two factors of irreparable injury and public interest, denied his request for preliminary injunction).

133 *See* 17 U.S.C. § 1204 (2000).

134 *See* *Buck v. Jewell-La Salle Realty Co.*, 283 U.S. 191, 198-99 (1931) (where the Court found that intention to infringe is not required under the Copyright Act, for a finding of infringement).

actions must also be for purposes of commercial advantage or private financial gain, similarly, an element removed from the copyright infringement cause of action long ago.¹³⁵ Although, both elements are present in Section 506 of the Copyright Act.¹³⁶ The possible sanctions are up to \$500,000 in fines or imprisonment for up to 5 years, or both, for the first offense, and up to the double of previous numbers for subsequent offenses.¹³⁷ The case of *Elcom, Ltd.*,¹³⁸ was brought under the criminal provisions of the DMCA, against Russian cryptographer Dmitry Sklyarov, and his employer, the Russian company ElcomSoft Co., Ltd.¹³⁹ The charges included violations to Section 1201(b)(1)(C), and Section 1201(b)(1)(A). Dmitry Sklyarov faced up to 25 years of imprisonment and a fine of up to \$2,250,000, and ElcomSoft, a penalty of \$2,500,000.¹⁴⁰ The

135 See H.R. REP. NO. 94-1476 (1976). The House Judiciary Committee discusses the deletion of the “for profit” limitation from Sections 106(4) and 106(5) in the Copyright Act of 1976. *Id.* at 64-63.

136 See 17 U.S.C. § 506(a) (2000). Which reads in relevant part:

Any person who willfully infringes a copyright shall be punished as provided under section 2319 of title 18, if the infringement was committed--

(A) for purposes of commercial advantage or private financial gain;...

137 See 17 U.S.C. § 1204 (2000).

138 United States v. Elcom, Ltd., 203 F. Supp. 2d 1111 (N.D. Cal. 2002).

139 *Id.*

140 See http://www.eff.org/IP/DMCA/US_v_Elcomsoft/us_v_elcomsoft_faq.html

(frequently asked questions about the US v. Elcom, Ltd. case and the corresponding

charges against Dmitry Sklyarov were dropped in exchange for his testimony against his employer.¹⁴¹ Eventually, after a jury trial, the company was acquitted of all charges.¹⁴²

G. Who can seek the remedies of the DMCA?

At first reading, Section 1203(a) seems to suggest a lax standing requirement, by reference to any person injured by a violation of Sections 1201 and 1202, the anti-circumvention and anti-trafficking provisions.¹⁴³ Yet, as read by the Federal Circuit, a closer look at the DMCA cause of action under 1201(a)(2), would not reveal such laxity.¹⁴⁴ The first of the five mandatory

answers).

141 See Wikipedia, *Dmitry Sklyarov*, http://en.wikipedia.org/wiki/Dmitri_Sklyarov (as of Mar. 5, 2007, 02:58 GMT) (including dates of relevant events in the US v Elcom, Ltd. prosecution).

142 See Wikipedia, *The case of Sklyarov, ElcomSoft, Adobe, and the DMCA*, http://en.wikipedia.org/wiki/The_case_of_Sklyarov%2C_ElcomSoft%2C_Adobe%2C_and_the_DMCA (as of Feb. 26, 2007, 05:31 GMT) (summarizing the events of the prosecution).

143 See 17 U.S.C. § 1203(a) (2000); see also *Macrovision v. Sima Prods. Corp.*, No. 05 Civ. 5587, 2006 U.S. Dist. LEXIS 22106, at *4-11 (S.D.N.Y. Apr. 20, 2006) (where court granted preliminary injunction to a patent holder of certain types of “Analog Copy Protection”, to enjoin defendant from selling products capable of circumventing said protection, without reference to any ownership by plaintiff of content or valid copyright in any work of authorship).

144 See *Chamberlain Group, INC., v. Skylink Technologies, Inc.*, 381 F.3d 1178, 1203 (Fed.

elements of the cited cause of action that a plaintiff has to satisfy is proof of a valid copyright. Under this construction, it seems, only the copyright owner may have standing to seek remedies under Section 1201(a)(2). Yet some other courts don't seem to have a problem with making these remedies available to other type of claimant, namely the providers of “technological measures”.¹⁴⁵ This raises an interesting question: if no new right was created by the enactment of the DMCA, what right are these providers of “encryption technologies” alleging have been “damaged”. The Federal Circuit was quite explicit as to where the source of protection emanated and to whom it extended.¹⁴⁶ In *RealNetworks*, the court had before it declarations from the

Cir. 2004).

145 See *RealNetworks, Inc. v. Streambox, Inc.*, No. C99-2070P, 2000 U.S. Dist. LEXIS 1889 (W.D. Wash. Jan. 18, 2000). Where the court granted preliminary injunction in favor of Internet content distribution service that allowed for streaming of its costumer's content, yet impeded copying, from a defendant who circumvented plaintiff service's capacity to impede such copying. *Id.* at *30-35.

146 See *Chamberlain Group, Inc. v. Skylink Techs., Inc.*, 381 F.3d 1178 (Fed. Cir. 2004). The court found that: “Chamberlain's proposed severance of "access" from "protection" is entirely inconsistent with the context defined by the total statutory structure of the Copyright Act, other simultaneously enacted provisions of the DMCA, and clear Congressional intent. It "would lead to a result so bizarre that Congress could not have intended it””. The court also found that “DMCA granted copyright holders additional legal protections, but neither rescinded the basic bargain granting the public noninfringing and fair uses of copyrighted materials, nor prohibited various beneficial uses of circumvention technology”, for example,

content owners provided by the plaintiff in the case, the developer of the technological measure, that asserted both owners' practice of using the technological measure to protect their works, and their fear that their works might otherwise be subject to infringement.¹⁴⁷ While it is not clear from the finding of fact, if the declarations provided evidence enough of ownership in specific works, like certificates of registration, the court seems to have relied on these declarations, not for determining ownership of a valid copyright, but for rejecting defendant's *Sony/Betamax* argument.¹⁴⁸ The standing issue was disposed of by merely citing Section 1203.¹⁴⁹ In

those exempted under Sections 1201(d),(f),(g) and (j). The court concluded that Section 1201 "...prohibits only forms of access that bear a reasonable relationship to the protections that the Copyright Act otherwise affords copyright owners....[I]t is the only meaningful reading of the statute.". *Id.* at 1202-1203.

147 See *RealNetworks, Inc. v. Streambox, Inc.*, No. C99-2070P, 2000 U.S. Dist. LEXIS 1889 (W.D. Wash. Jan. 18, 2000). The finding of fact number 15, with respect to this topic is illustrative of the kind of evidence that might be necessary to overcome the standing issue:

“Content owners who choose to use the security measures described above are likely to be seeking to prevent their works from being copied without their authorization. RealNetworks has proffered declarations from copyright owners that they rely on RealNetworks security measures to protect their copyrighted works on the Internet. Many of these copyright owners further state that if users could circumvent the security measures and make unauthorized copies of the content, they likely would not put their content up on the Internet for end-users.”. *Id.* at 7.

148 See *RealNetworks, Inc. v. Streambox, Inc.*, No. C99-2070P, 2000 U.S. Dist. LEXIS 1889 (W.D. Wash. Jan. 18, 2000). In Conclusion of Law number 15 the court differentiates the facts on this case from the ones in *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S.

Macrovision, no copyright ownership is even suggested in the discussion of the court, as plaintiff is the owner of a patent on a copy protection technology. In other words, the only ownership of Macrovision is over the “lock”, the technological measure, and not the “treasure”, the work.¹⁵⁰ As the court disposed of the standing issue by citing Section 1203, just as in *RealNetwork*, it may be inferred that any injury plaintiff might have suffered necessarily relates to that patent right.¹⁵¹

IV. Defenses under the DMCA

A. Fair Use under the DMCA

When faced with fair use defenses, courts have typically rejected them as defenses to

417 (1984) (*Sony/Betamax* case) by stating that many content owners in *Sony* had no objection to the time-shifting of their works, while the content owners in this case have expressly prohibited a similar conduct by consumers. *Id.* at 22.

149 *See RealNetworks, Inc. v. Streambox, Inc.*, No. C99-2070P, 2000 U.S. Dist. LEXIS 1889 (W.D. Wash. Jan. 18, 2000), In conclusion of law number 2 the court finds that *RealNetworks* has standing to pursue DMCA claims under Section 1203, which affords standing to any person allegedly injured by a violation of sections 1201 and 1202 of the DMCA. *Id.* at 15-16.

150 *See Macrovision*, 2006 U.S. Dist. LEXIS 22106 at *4-11.

151 *See id.* at *5 (reciting the statutory language).

circumvention.¹⁵² Some courts and commentators, without referring to Section 107, have determined that Congress put specific provisions in the DMCA to insure that fair uses were not hindered by the strict application of the statute, like the so-called "fail-safe" provision, by which the Librarian of Congress can determine whether certain users should be exempted from the anti-circumvention provision.¹⁵³ Although, that mechanism is not provided under Section 1201(a)(2)

152 See *Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2d Cir. 2001). When deciding if the DMCA is unconstitutional for restricting fair use, the Second Circuit stated that no constitutional requirement to fair use has ever been found by the Supreme Court, and that the DMCA targets the circumvention of digital walls guarding copyrighted material, but does not concern itself with the use of those materials after circumvention has occurred. *Id.* at 443-44, 458-59.

153 See 17 USC § 1201(a)(1)(B)-(E). Which provides:

(B) The prohibition contained in subparagraph (A) shall not apply to persons who are users of a copyrighted work which is in a particular class of works, if such persons are, or are likely to be in the succeeding 3-year period, adversely affected by virtue of such prohibition in their ability to make noninfringing uses of that particular class of works under this title, as determined under subparagraph (C).

(C) During the 2-year period described in subparagraph (A), and during each succeeding 3-year period, the Librarian of Congress, upon the recommendation of the Register of Copyrights, who shall consult with the Assistant Secretary for Communications and Information of the Department of Commerce and report and comment on his or her views in making such recommendation, shall make the determination in a rulemaking proceeding for purposes of subparagraph (B) of whether persons who are users of a copyrighted work are, or are likely to be in the succeeding 3-year period, adversely affected by the prohibition under subparagraph (A) in their ability to make noninfringing uses under this title of a particular class of copyrighted works. In conducting such

rulemaking, the Librarian shall examine--

(i) the availability for use of copyrighted works;

(ii) the availability for use of works for nonprofit archival, preservation, and educational purposes;

(iii) the impact that the prohibition on the circumvention of technological measures applied to copyrighted works has on criticism, comment, news reporting, teaching, scholarship, or research;

(iv) the effect of circumvention of technological measures on the market for or value of copyrighted works; and

(v) such other factors as the Librarian considers appropriate.

(D) The Librarian shall publish any class of copyrighted works for which the Librarian has determined, pursuant to the rulemaking conducted under subparagraph (C), that noninfringing uses by persons who are users of a copyrighted work are, or are likely to be, adversely affected, and the prohibition contained in subparagraph (A) shall not apply to such users with respect to such class of works for the ensuing 3-year period.

(E) Neither the exception under subparagraph (B) from the applicability of the prohibition contained in subparagraph (A), nor any determination made in a rulemaking conducted under subparagraph (C), may be used as a defense in any action to enforce any provision of this title other than this paragraph.

See also Universal City Studios, Inc. v. Corley, 273 F.3d 429 (2d Cir. 2001). The Court explained the "fail-safe" provision in the statute, which authorizes the Librarian of Congress to "exempt certain users from the anti-circumvention provision when it becomes evident that in practice, the statute is adversely affecting certain kinds of fair use." *Id.* at 444; *see also* David Nimmer, *A Riff on Fair Use in the Digital Millennium Copyright Act*, 148 U. PA. L. REV. 673 (2000). Professor Nimmer narrates that the WIPO Treaties Act did not amend the fair use doctrine as applied to copyright infringement, and that Congress determined that no change to Section 107 was required. Section 107 was considered technologically neutral, and therefore, fully applicable in the digital world as in the analog world. Nimmer concludes

or Section 1201(b)(1), the anti-trafficking provisions, and courts have closed that “fair use” door for defendants under that premise.¹⁵⁴ Other such “fair use” provision is Section 1201 (d), which expressly provides for libraries and educational institutions to circumvent when in the process of determining whether to buy a copy of a work.¹⁵⁵ Although Section 1201(c) makes clear that fair use shall not be affected by effect of the circumvention provisions, courts and commentators have read Section 1201(c) to support the rationale that circumvention is a different figure from infringement,¹⁵⁶ and a defense against infringement is therefore irrelevant before a charge of

from this legislative history that “[i]n other words, there is no such thing as a section 107 fair use defense to a charge of a section 1201 violation; rather, section 1201 itself includes provisions designed to aid the interests of users.”. *Id.* at 722-23.

154 *See* *Macrovision v. Sima Prods. Corp.*, No. 05 Civ. 5587, 2006 U.S. Dist. LEXIS 22106, at *6 (S.D.N.Y. Apr. 20, 2006) (“The DMCA does provide for a limited “fair use” exception for certain users of copyrighted works, see 17 U.S.C. § 1201(a)(2)(B), but this exception does not apply to manufacturers or traffickers of the devices prohibited by 17 U.S.C. § 1201(a)(2).”).

155 *See* 17 U.S.C. § 1201 (d)(1) (2000). Which provides: “A nonprofit library, archives, or educational institution which gains access to a commercially exploited copyrighted work solely in order to make a good faith determination of whether to acquire a copy of that work for the sole purpose of engaging in conduct permitted under this title shall not be in violation of subsection (a)(1)(A).”.

156 *See* *Chamberlain Group, INC., v. Skylink Technologies, Inc.*, 381 F.3d 1178, 1192 (Fed. Cir. 2004), *cert. denied*, 544 U.S. 923 (2005) (“The essence of the DMCA’s

circumvention and vice versa.¹⁵⁷

i. Is There Fair Use Within the DMCA After All?

Recognized scholar Jane Ginsburg has advanced the theory that fair use is available under the DMCA.¹⁵⁸ The key to this proposition is that fair use, although codified in Section 107, is in fact a judge-made rule, a general equitable defense.¹⁵⁹ Other authors have found some support for the idea of an equitable defense to Section 1201(a) in the language of Federal Circuit in

anticircumvention provisions is that §§ 1201(a),(b) establish causes of action for liability. They do not establish a new property right. The DMCA's text indicates that circumvention is not infringement, and the statute's structure makes the point even clearer.”).

157 *See* 17 U.S.C. § 1201 (a)(1)(B)-(E) (2000). Where it refers to the exception for the use of a particular class of work as determined by the Librarian of Congress, or the "fail-safe" provision, and makes clear that such provision will work only as a defense to circumvention under Section 1201 (a)(1)(A). *Id.* at subparagraph (E); *see also* Nimmer, *supra* note 153, at 698-99.

158 *See* Jane C. Ginsburg, *Copyright Use and Excuse on the Internet*, 24 COLUM.-VLA J.L. & ARTS 1, at 8-9 (2000) (arguing that courts can use the fair use on specific facts involving Section 1201(a) and articulate additional limitations to the circumvention prohibition).

159 *Id.* at 9 (the commentator argues that fair use is a judge-made rule that applies to rights within the penumbra of copyright, and other intellectual property rights, and Congress disavowed any intent to freeze the doctrine).

*Chamberlain*¹⁶⁰ and *Storage Tech.*¹⁶¹ Whether or not these rulings support such a proposition, the Federal Circuit is clear in its position that infringement of rights, as facilitated by the defendant's technology, is indispensable to establish a cause of action under 1201(a).¹⁶²

B. The Merger Doctrine Can Provide Some Defense Against the DMCA

Fair use and the idea/expression dichotomy, from which the merger doctrine is a corollary, have been equated in the past, at least in their role of accommodating First Amendment concerns within the copyright scheme.¹⁶³ When taken into account, as mentioned above, that no Section 107 fair use defense has yet been recognized against liability for circumvention or trafficking in circumventing technology under Section 1201,¹⁶⁴ the merger and scenes a faire doctrines gain

160 *Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004).

161 *Storage Tech. Corp. v. Custom Hardware Eng'g & Consulting, Inc.*, 421 F.3d 1307 (Fed. Cir. 2005); *see also* Zohar Efroni, *Towards a Doctrine of "Fair Access" in Copyright: The Federal Circuit's Accord*, 46 IDEA 99, 136-41 (2005) (arguing that the Federal Circuit is in fact constructing a doctrine of fair access).

162 *See Storage Tech. Corp. v. Custom Hardware Eng'g & Consulting, Inc.*, 421 F.3d 1307, 1318-1319 (Fed. Cir. 2005) (reaffirming the ruling in *Chamberlain*).

163 *See Eldred v. Ashcroft*, 537 U.S. 186, 220 (2003) (where the court determined that the Copyright Act contains built-in First Amendment accommodations, namely, the fair use doctrine and the idea/expression dichotomy).

164 *See Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2d Cir. 2001); *see also* Nimmer, *supra* note 153.

greater importance in the context of a DMCA cause of action.¹⁶⁵

i. The Divisive Issue of Merger and Its Place in the World

Yet there is conflict among the circuits as to the proper place of the merger inquiry. Whether the merger doctrine acts as a bar to copyrightability, or simply as a defense to particular types of infringement.¹⁶⁶ The Fifth Circuit adopted the position that merger goes to the question of determining copyrightability.¹⁶⁷ The Second and Ninth Circuits promote that merger operates only as a defense to infringement.¹⁶⁸ The Sixth Circuit criticized the proposition that the

165 *See* Lexmark Int'l, Inc. v. Static Control Components, Inc., 387 F.3d 522, 557 (6th Cir. 2004) (Feikens, J., dissenting in part) (Where the dissenting judge argues it is essential to assume a position as to whether merger is a bar on copyrightability or a defense against infringement, before the Court can determine the issue of liability under the DMCA. He criticizes the majority decision for allegedly not assuming a position on the split).

166 *See* Mason v. Montgomery Data, Inc., 967 F.2d 135, 138, n.5 (5th Cir. 1992) (where the Court recognizes the split among the Circuits); *see also* Lexmark Int'l, Inc. v. Static Control Components, Inc., 387 F.3d 522, 557 (6th Cir. 2004) (Feikens, J., dissenting in part).

167 *See* Kern River Gas Transmission Co. v. Coastal Corp., 899 F.2d 1458, 1463-1465 (5th Cir. 1990) (court found that the idea of the location of the pipeline and its expression embodied in maps in a scale of 1:24,000 and 1:250,000 are inseparable and not subject to protection, the district court erred in finding the 1:24,000 maps copyrightable and then moving to examine the fair use defense).

168 *See* Kregos v. Associated Press, 937 F.2d 700, 705 (2d Cir. 1991); *see also* Ets-Hokin v.

idea/expression dichotomy is not a measure of copyrightability, on the ground that such conclusion conflicted with *Feist*.¹⁶⁹ There is also a split among the circuits regarding the proper place of the scenes a faire doctrine.¹⁷⁰ As discussed by the dissenting opinion in *Lexmark*, to align with one or the other camp might represent whether the court recognizes merger as a viable defense against a circumvention claim, or not.¹⁷¹

Skyy Spirits, Inc., 225 F.3d 1068, 1082 (9th Cir. 2000) (“Although there is some disagreement among courts as to whether these two doctrines figure into the issue of copyrightability or are more properly defenses to infringement, we hold that they are defenses to infringement”).

169 *See Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522 (6th Cir. 2004). Citing cases from other circuits to support its conclusion that copyrightability is present in both prongs of the infringement analysis, and vacating district court's decision. *Id.* at 537-39.

170 *See Nimmer on Copyright* § 13.03[B][4]. Where the author comments about questions raised by courts as to the doctrine of scenes a faire, analogous to the ones raised for merger. *Id.* at text accompanying n.182.1-182.7.

171 *See Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522 (6th Cir. 2004) (Feikens, J., dissenting in part). The judge notes that the DMCA anti-circumvention provisions are only available to works that are protected by Title 17. Therefore, if the merger doctrine is considered an inquiry of copyrightability, and merger is found to have occurred, Plaintiff will have failed to state a claim on which relief can be granted under the DMCA. On the other hand, Judge Feikens argues, if merger is not considered to be an inquiry of copyrightability, then plaintiff may establish his claim under DMCA, merger

ii. The Issue Might Be Relevant After All for a DMCA Defendant

Therefore, the unsettled issue of whether a defendant of a DMCA claim might have a defense taken from traditional copyright law, could ultimately be dependent, not on the language of the DMCA essentially, but on a long unsettled issue of copyright law, whether merger and scenes a faire doctrines work as a challenge to the copyrightability of a work. This newly found relevance of the merger and scenes a faire doctrines in the DMCA analysis has already been argued as an additional reason why the courts should favor applying these doctrines as bars to copyrightability.¹⁷² Yet, this approach is only available if the courts, as the court in *Lexmark*, recognize that no DMCA liability can arise if there is no copyrighted work.¹⁷³ Unfortunately,

notwithstanding, and an evaluation of the scope of DMCA protection over the work is adequate. Therefore, the effect of a finding if merger can have very different results in a DMCA litigation if the merger doctrine is treated either as a question of copyrightability of the work, or as a defense to infringement. *Id.* at 557.

172 See Sandro Ocasio, *Pruning Paracopyright Protections: Why Courts Should Apply the Merger and Scènes à Faire Doctrines at the Copyrightability Stage of the Copyright Infringement Analysis*, 3 SETON HALL CIRCUIT REV. 303, 331 (2006) (arguing that the harsh liability imposed by the DMCA should move courts to use these doctrines to deny copyright protection in marginal cases).

173 See *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522 (6th Cir. 2004). The court found that the Toner Loading Program was not covered under the DMCA because it was not copyrightable, in other words, not a work protected under Title 17. *Id.* at 550.

not all courts seem so clear on that point. In *Elcom, Ltd.*, the court concluded that DMCA liability subsisted even against circumvention of a technological measure applied to a work in the public domain.¹⁷⁴ This is the same court that found that the DMCA was not an unconstitutional exercise of the power of Congress under the Commerce Clause, as long as it did not conflict with the limitations imposed by the Copyright Clause.¹⁷⁵

iii. How Would the Case Have to Look Like?

The Lexmark case presented an uncommon set of facts. First of all, it dealt with software embedded in a piece of hardware supply, a printer cartridge.¹⁷⁶ Second, it involved a very small piece of software (55 bytes), something that in the eyes of the court limited its expressive potential, and therefore its level of copyright protection.¹⁷⁷ Third, no other piece of software was

174 *See* *United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111 (N.D. Cal. 2002). The Court concludes that the DMCA does not grant any intellectual property right to anyone over a work in the public domain, only a technological protection for that particular copy of the work, because the work is still available in the public domain in the form of other available versions. *Id.* at 1131.

175 *See* *United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111, at 1139-42 (N.D. Cal. 2002).

176 *See* *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 539-40 (6th Cir. 2004) (explaining the scheme of Lexmark's prebate cartridges, and its authentication sequence) .

177 *See id.* at 530 (Discussing the limited expression of a “55 bytes” program and the constraints imposed by the functions it must fulfill).

included within the same technological measure.¹⁷⁸ Fourth and most important, the little software was not really protected by the technological measure, but was part of the lock-out measure, to exert control over the aftermarket of printer cartridges.¹⁷⁹ Taking all this into consideration, any defendant who might try to use the merger doctrine as a defense will surely have to conform to very similar facts.

a) **A Single Simple Work, Within An Access-Control Technological Measure**

The more complex the work, the easier for the courts to find elements of original expression in the software of the plaintiff. For this reason, this defense is more suited for simple or smaller programs. Defendant's facts must surely involve software, and not any other type of digital work that might typically be deemed more original, like a movie or a book.¹⁸⁰ The technological measure should not protect more than the one simple program, otherwise, it might not matter that the defense can convince the court that the allegedly infringed work is uncopyrightable. As long as there is another program, or work, worthy of copyright protection, the DMCA will likely be triggered. This analysis considers the defense of merger in isolation. No other possible arguments, like the applicability of DMCA liability only to acts related to infringement, are

178 *See id.* The court concluded that the access-control measure never controlled access to one of the programs, and that program held a copy of said program embedded in the printer cartridge. *Id.* at 594.

179 *See id.*

180 *See supra* text accompanying notes 35-37.

considered. The availability of such an argument will be examined subsequently.¹⁸¹ If such a defense is possible, it can complement a defense of merger and broaden the number of scenarios were it might be applicable successfully.

V. The Missing Definition

A. What Lexmark Stands? What Does “Protected Under This Title” Mean?

The Sixth Circuit in *Lexmark*, cited Professor Jane Ginsburg's testimony before the Copyright Office, in attention to the Anticircumvention Hearings held by this agency, to point out that Section 1201(a) does not cover the circumvention of a technological measure that controls access to a work not protected under Title 17.¹⁸² Professor Ginsburg's remarks were that when we talk about ball point pen cartridges, printer cartridges, garage doors and so forth, we talk about works not protected under Title 17.¹⁸³ But, is that remark an entirely accurate characterization of

181 *See infra* text accompanying notes 265-284.

182 *See Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522 (6th Cir. 2004).

The courts quotes with approval the remarks of Prof. Jane Ginsburg on the Anticircumvention Hearings held by the Copyright Office. *Id.* at 549.

183 *See* Jane Ginsburg: Copyright Office Anti-Circumvention Rulemaking Hearing Testimony at 44-56 (May 9, 2003), <http://www.copyright.gov/1201/2003/hearings/transcript-may9.pdf> (last visited April 18, 2007). Where Prof. Ginsburg declared:

aftermarket goods? Is a printer cartridge a work not protected under Title 17? Or is more accurate to say that a printer cartridge is “not” a work, period?¹⁸⁴ Is not a printer cartridge a useful article instead? In other parts of her testimony Prof. Ginsburg referred to noncopyrightable replacement parts as goods, instead of works not protected, but those portions were not quoted on the text of the decision by the Sixth Circuit, although they are included within the same citation.¹⁸⁵ Some revisiting of general copyright principles is necessary at this point. If printer cartridges were works, they will most likely be categorized as sculptural works. The Copyright Act defines sculptural works, along with pictorial and graphic works, basically as including two-dimensional and three-dimensional works of fine, graphic, and applied art, such as photographs, maps, models, including works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned.¹⁸⁶ More importantly, the design of a useful

First, with respect to 1201(a). I do not believe that it covers the circumvention of a technological measure that controls access to a work not protected under this title. And if we're talking about ball point pen cartridges, printer cartridges, garage doors and so forth, we're talking about works not protected under this title. *Id.* at 46.

184 Cf. 17 U.S.C. § 102(a) (2000), quoted *supra* note 12.

185 See Ginsburg, Copyright Office Anti-Circumvention Rulemaking Hearing Testimony, *supra* note 183, at 45, 47.

186 See 17 U.S.C. § 101 (2000). Which reads in relevant part:

"Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design

article is considered a work only to the extent that such design incorporates sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.¹⁸⁷ Then, there is the definition of useful articles, which defines them as articles having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.¹⁸⁸ It can be inferred that printer cartridges are useful articles, they serve an utilitarian purpose, supplying the printer with the necessary toner. Their design does not incorporate any graphical, pictorial or sculptural features that can be separated from the its utilitarian aspects.¹⁸⁹

Does this particular use of copyright concepts by the Sixth Circuit affect in some way our discussion about possible Copyright defenses under the DMCA? First, let's decompose the logic underlying the language used by the Court. The general proposition is that the DMCA does not extend to works not protected by Title 17. Then it is found that printer cartridges are works not protected by Title 17. Therefore, it can be inferred that the DMCA does not extend to printer cartridges. So far so good.

incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

187 *Id.*

188 *See* 17 U.S.C. § 101 (2000). Which reads in relevant part: "A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article"".

189 *Id.*

The problem is that this language allows for two quite different readings. A narrow reading of this decision would lead us to the conclusion that DMCA was not meant to extend to aftermarket goods.¹⁹⁰ Ultimately, Lexmark tried to convince the court that in fact the DMCA gave them exactly that kind of protection, a notion that was rejected by the court.¹⁹¹ Therefore, when we say that the DMCA does not extend to works not protected by Title 17, we can either mean that it does not extend to subject matters that are not “original works of authorship” (or subject matter of copyright), as provided by Section 102 of the Copyright Act, or we can mean that it does not extend to subject matters, even original works of authorship, that due to the effect of some other section of the Copyright Act fail to receive its protection.¹⁹² The Sixth Circuit answered this question quite briefly when it concluded that “[a]ll three liability provisions of...the DMCA require the claimant to show that the “technological measure” at issue “controls access to a work protected under this title,”...which is to say a work protected under the general copyright

190 See Marcus Howell, *The Misapplication of the DMCA to the Aftermarket* 11 B.U. J. SCI. & TECH. L. 128, 128-29 (2005) (DMCA was enacted for controlling piracy).

191 See *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 552 (6th Cir. 2004) (Merritt, J., concurring) (concluding that Lexmark's reading of the statute would allow manufacturers to create monopolies for replacement parts by using similar lock-out codes).

192 See 17 U. S.C. § 102 (2000). Section 102(a) provides: “Copyright *protection* subsists, *in accordance with this title*, in original works of authorship fixed in any tangible medium of expression,...”. *Id.* at Section 102(a) (emphasis added). This language suggests that, even if something can be characterized as an original work of authorship, or “work”, the determination of copyright “protection” is dependent on an analysis of the rest of Title 17.

statute....”¹⁹³

B. What Does “Protection” Really Means?

The purpose of discussing the use of the phrase “work not protected under this Title” by the Sixth Circuit is to point out what seems to go unnoticed in the general discussion of *Lexmark’s* ruling. To consider something a work, for purposes of copyright law, and to consider it protected under the Copyright Act, are two different determinations. A more thorough look at the statutory language would reveal how the terms “work and “protected” refer to two separate inquiries within the Copyright Act.¹⁹⁴ Yet that seemingly unnoticed distinction is central in determining how the Copyright Act relates, if at all, with the anti-circumvention provisions of the DMCA.

VI. The Circuits Are in Dispute as to What Role Does Copyright Law Play in the DMCA Analysis

At present, the DMCA anti-circumvention provisions have received at least two notably different interpretations. These interpretation are advanced by the Second Circuit, in the *Reimerdes/Corley* litigation, and by the Federal Circuit, in *Chamberlain*,¹⁹⁵ and reaffirmed in *Storage Tech*.¹⁹⁶

193 *Lexmark*, 387 F.3d at 550.

194 *See supra* note 192.

195 *Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004).

196 *Storage Tech. Corp. v. Custom Hardware Eng'g & Consulting, Inc.*, 421 F.3d 1307 (Fed. Cir. 2005).

These interpretations, as we will discuss, represent two different conceptions of the interaction of the DMCA with the Copyright Act. We will cover the basic facts of *Corley*, along with a brief review of *Elcom, Ltd.* After that, we will cover *Chamberlain* and its interpretation of the DMCA, along with its application in *Storage Tech.* Then we will continue to a more detailed analysis of the consequences of these cases.

A. *Reimerdes/Corley*

i. Basic facts of *Reimerdes/Corley*

In *Universal City Studios v. Reimerdes*, the defendant, Eric C. Corley, publisher of the magazine “2600: The Hacker Quarterly”, was brought to court by the plaintiffs, for distributing on its web site, 2600.com, a copy of the software called DeCSS, capable of circumventing the CSS technology, used by the plaintiffs, movie studios, to encrypt movies recorded in DVDs.¹⁹⁷ CSS controlled access to the movie in DVD format, by restricting the DVD players that could be used to play the movie to only CSS-licensed players. These players also precluded the copying of the movie in the DVD, by requiring as part of the CSS license that the DVD player would not allow data to be transmitted from the player to “internal recording devices”, such as the computer's hard drive.¹⁹⁸ Corley did not create DeCSS, it was invented by a Norwegian teenager, Jon Johansen, to develop a DVD player for computers running on the Linux operating system,

197 See *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 436-40 (2d Cir. 2001).

198 See *id.* at 437.

something that did not exist at that time.¹⁹⁹ The district court preliminarily enjoined the defendant from posting the DeCSS software on its webpage. The defendant, then placed links on its webpage to other webpages that contained the software, in a campaign of electronic civil disobedience, inviting people to distribute the DeCSS code.²⁰⁰

ii. The Ruling By the District Court (*Reimerdes*)

The district court found defendants liable under 1201(a)(2), trafficking in devices that enable circumvention of technological measures that control access to a work.²⁰¹ Defendants argued before the district court that activities that were traditionally regarded as fair uses were impeded by the CSS system, and that only by circumventing the CSS were these uses possible. Therefore, defendants alleged that their conduct, which was merely facilitating the exercise of fair use, should not be penalized by the DMCA liability.²⁰² The district court rejected that argument by pointing out that fair use is a defense against infringement, and defendants were not charged with infringement but with trafficking in circumvention devices, so fair use was immaterial for the issue of DMCA liability.²⁰³ Another argument by defendants rejected by the court was that their conduct was allowed by *Sony/Betamax*. The court explained that *Sony* applied to infringement,

199 *See id.* at 438.

200 *See id.* at 441.

201 *See id.* at 441.

202 *See Universal City Studios v. Reimerdes*, 111 F. Supp. 2d 294, 322 (S.D.N.Y. 2000).

203 *See id.* at 322-23.

not circumvention, and that Congress chose not to incorporate Sony into the DMCA.²⁰⁴

a) **The Sony/Betamax Defense and How the DMCA Fundamentally Altered the Landscape**

As part of its reasoning the court declared that the question in this case was “whether the possibility of noninfringing fair use by someone who gains access to a protected copyrighted work through a circumvention technology distributed by the defendants saves the defendants from liability under Section 1201.”²⁰⁵ The answer of the court to this question was that “nothing in Section 1201 so suggests.”²⁰⁶ Then the court concluded that by virtue of the circumvention prohibition, “the DMCA fundamentally altered the landscape.”²⁰⁷ For the court, this supports the proposition that a device that has “a substantial noninfringing use” and may be saved from liability by *Sony*, will still offend Section 1201.²⁰⁸ The court also rejected the defendant's arguments on First Amendment.²⁰⁹

204 *See id. at* 323-24.

205 *See id.*

206 *See id.*

207 *See id.*

208 *See id.*

209 *See id.*

iii. The Ruling of the Second Circuit (*Corley*)

a) Section 1201(c)(1) Means That the DMCA Does Not Concern Itself With What Happens After Circumvention

On appeal the Second Circuit affirmed the ruling of the district court. As part of its discussion, the Second Circuit rejected to read Section 1201(c)(1) as exempting from liability circumvention done to allow fair use. Instead the court read it as to establish that the statute “targets the circumvention of digital walls guarding copyrighted material (and trafficking in circumvention tools), but does not concern itself with the use of those materials after circumvention has occurred.”²¹⁰ The court argued that the balance set by Congress “leaves little limited areas of breathing space for fair use”, referring to the areas where Congress carved out exceptions to liability in the DMCA.²¹¹ According to the Second Circuit, it seems unlikely for Congress to carve out small exceptions, to permit fair use, if it meant Section (c)(1) to exempt all circumvention related to fair uses.²¹² Another argument by defendants was that under the

210 *See* Universal City Studios, Inc. v. Corley, 273 F.3d 429, 443-44 (2d Cir. 2001).

211 *See id.* at 444 n.13.

212 *See id.* In this instance the court seems to be using the term “fair use” in the same context used by the House Report, to refer generally to any statutorily permitted use of a copyrighted work to persons other than the copyright owner, and not specifically to the doctrine of fair use, as codified in Section 107 of the Copyright Act; *see generally* H.R. REP. NO. 105-551, pt. 2, at 25-26 (1998).

definition set out in Section 1201(a)(3)(A), buyers of the DVDs were “authorized” by the plaintiffs to view the movie on the DVD, therefore no liability shall arise when these buyers try to view it in a competing platform. The Court answered by clarifying that Section 1201(a)(3)(A) refers to authorization to decrypt the encrypted DVD, not to view it.²¹³ More interesting than this conclusion, is the court's alternate argument. The court finds that in any event, defendants have not presented evidence of any kind of authorization by plaintiffs to DVD buyers to circumvent the technological measures in order to permit “use” in other platforms. Then the court goes on to declare that even if the defendants can prove that DeCSS is primarily designed for multiple platform viewing, it merely relieves them of the liability under Section 1201(a)(2)(A) (a device primarily designed to circumvent), and they will still be liable under Section (a)(2)(C), (a device marketed for circumvention), because they marketed DeCSS as good for copying DVDs, and not simply viewing them.²¹⁴ In this last remark, done in a footnote, it is not clear whether the court is referring Section 1201(a)(2)(C) or to Section 1201(b)(1)(C). The former is the section banning trafficking of devices marketed for circumvention access-control measures,²¹⁵ the latter is the equivalent section, banning trafficking of devices marketed for circumvention use-control measures.²¹⁶ If anything, copying of the DVD would be a violation of a copyright owner's right, therefore, to market DeCSS for copying DVDs, would be a conduct considered as marketing a device for circumventing the “protection afforded by a technological measure” to “rights of a

213 *See Corley*, 273 F.3d at 444 n. 16.

214 *Id.*

215 *See* 17 U.S.C. § 1201(a)(2)(C) (2000).

216 *See* 17 U.S.C. § 1201(b)(1)(C) (2000).

copyright owner.”²¹⁷ As we already mentioned, *Corley* was decided as an access-control circumvention case, not as a use-control circumvention one.²¹⁸

b) Whether the DMCA Violates the “Limited Times” Language on the Copyrights Clause

The court followed the example of the district court, and declined to evaluate whether the DMCA violates the “limited times” language on the Copyrights Clause, by allowing copyright owners to lock up public domain works along with copyrighted works, to trigger anti-circumvention protection.²¹⁹

c) Whether Fair Use is Unconstitutionally Eliminated by The Anti-circumvention Provisions of the DMCA. An Extravagant Proposition?

In one of the most noteworthy passages of the decision, the Second Circuit rejects defendant's proposition that fair use is unconstitutionally eliminated of copyrighted materials by virtue of the

217 *See id.*

218 *See Universal City Studios v. Reimerdes*, 111 F. Supp. 2d 294 (S.D.N.Y. 2000). The district court clarified that the issue in this case involves “principally the second of the anticircumvention provisions” because defendants are accused “only of posting and linking to other sites posting DeCSS, and not of using it themselves to bypass plaintiffs' access controls”. *Id.* at 316.

219 *See Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 445 (2d Cir. 2001).

DMCA. The court considered the proposition extravagant, and replied that “the Supreme Court has never held that fair use is constitutionally required.”²²⁰ The court quickly softened this posture by clarifying it needs not to explore the validity of the claim that fair use is constitutionally protected, simply because it was outside the scope of this case.²²¹

d) Fair Use Has Never Guaranteed Copying “In the Preferred Technique” of the User, or “In the Format of the Original.”

To support this last conclusion, the court makes another noteworthy remark, that fair use does not guarantee the consumer the ability to copy the original work in the original format. The court states: “We know of no authority for the proposition that fair use as protected by the Copyright Act, much less the Constitution, guarantees copying by the optimum method or in the identical format of the original.”²²² The court noted that the DMCA does not limit the possibility of somebody making “traditional” fair uses of DVD movies, such as taping images directly from the screen by using a video camera, or taking notes from the movie to quote some passages in a review.²²³ The court insists that fair use has never been held to guarantee access to the original,

220 *See id.* at 458.

221 *See id.*

222 *See id.* at 460.

223 *See id.* Here again the Court seems to be talking about use-control measures. Access-control measures, by definition, only allow for authorized access, and fair use, also by definition, presumes unauthorized conduct by the alleged infringer. *Id.* at 460.

for copying “in the preferred technique” of the user, or “in the format of the original.”²²⁴

iv. Elcom, Ltd.

After *Corley*, a case from a California district court, *Elcom, Ltd.*,²²⁵ considered the constitutionality of the DMCA in the context of a criminal prosecution.²²⁶ At issue in this case was Section 1201(b), dealing with trafficking of devices that circumvent use-control measures, namely the circumvention of the Adobe eBook Reader and the eBook format.²²⁷ The court in this case concluded that the DMCA bans all circumventing technologies, not only those that allow

224 *See id.* at 460. An argument can be formulated that fair use always deals with the copying method preferred by the defendant. Being an affirmative defense, fair use is only argued after the fact, after the copying has been made, in the way the defendant “preferred”, or at least was capable of. When considering defenses of fair use, courts look at the four statutory factors. None of these factors reject the notion of a perfect copy in the format of the original, although it might weight against a finding of fair use when evaluating some of the factors. In cases involving works in digital format, perfect, direct copying of all or part of the work is common, and not necessary found to be unfair. *See Sega Enterprises Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1993) (copying of console code); *see also Kelly v. Arriba Soft Corp.* 77 F. Supp. 2d 1116 (S.D. Cal. 1999) (copying of digital pictures).

225 *United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111 (N.D. Cal. 2002).

226 *See supra* text accompanying notes 76-79, 133-142.

227 *Id.*

infringing uses, in response to a challenge of vagueness by the defendant.²²⁸

According to the court, the rights addressed by Section 1201(b) were those protected by Section 106 of the Copyright Act.²²⁹ The court combined Section 1201(b)(2)(B) and Section 106, to produce a mixed definition:

[A] technological measure 'effectively protects the right of a copyright owner' if, in the ordinary course of its operation, it prevents, restricts or otherwise limits the exercise of any of the rights set forth in Section 106, such as the rights to reproduce the work, prepare derivative works, distribute copies of the work, perform the work publicly or by digital audio transmission, or display the work publicly.²³⁰

Yet, the court closed the door for defendant to allege any of the statutory exceptions to infringement that condition Section 106, including fair use, as a defense against a claim of

228 *See* United States v. Elcom, Ltd., 203 F. Supp. 2d 1111 (N.D. Cal. 2002). The court declared that “the statute also prohibits tools that circumvent usage controls for the purpose of enabling fair use.” The statute cannot be said to be impermissibly vague, because “all tools that are primarily designed or produced for the purpose of circumventing protections afforded by technological measures are banned.” *Id.* at 1123.

229 *See id.* at 1124 (The court combined Section 1201(b)(2)(B) and Section 106 to produce a mixed definition that incorporates the language of both sections, in order to define what is protected by a use-control measure).

230 *See* United States v. Elcom, Ltd., 203 F. Supp. 2d 1111, 1124 (N.D. Cal. 2002).

Section 1201(b) violation.²³¹ Note that in the combined definition drafted by the court, there is no mention of the starting phrase of Section 106, “Subject to sections 107 through 122,...”²³² For this court, Section 1201(b) of the DMCA does not recognize those limitations as defenses to trafficking,²³³ and “imposes a blanket ban on trafficking in or the marketing of any device that circumvents use restrictions.”²³⁴ That reading of Section 1201(b) seems hard to reconcile with the congressional record, where it declares that “[t]he device limitation in [Section] 1201(b) enforces the longstanding prohibitions on infringements.”²³⁵ If Section 1201(b) enforces the

231 *Id.*

232 *See* 17 U.S.C. § 106 (2000), quoted *supra* note 27; *see also* H.R. REP. NO. 94-1476 (1976). Section 106 states the rights in broad terms, and subsequent Sections 107 through 122 add limitations to those rights. *Id.* at 61-65.

233 *See* *United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111 (N.D. Cal. 2002). The court is convinced that: “[n]othing within the express language would permit trafficking in devices designed to bypass use restrictions in order to enable a fair use, as opposed to an infringing use. The statute does not distinguish between devices based on the uses to which the device will be put.” *Id.* at 1124.

234 *Id.*

235 *See* S. Rep No. 105-190 (1998). The Senate Committee on the Judiciary explains why the use prohibition exists:

This, in turn, is the reason there is no prohibition on conduct in 1201(b) akin to the prohibition on circumvention conduct in 1201(a)(1). The prohibition in 1201(a)(1) is necessary because prior to this Act, the

prohibition against infringement, how can it preclude conduct that is statutorily exempted from infringement liability?²³⁶

a) **Publishers Can Put Technological Measures Over Works Already in the Public Domain, As Long As There Are Analog Copies.**

Consistent with the courts' overall reading of Section 1201(b), it finds that the DMCA allows a technological measure to validly enclose works that are in the public domain, because these works are still considered public domain, and are available elsewhere, in non-encrypted formats.²³⁷ Under the court's rationale, the DMCA does not confer to publishers any claim of ownership over these works, so any person can still make use of the work and not be liable of

conduct of circumvention was never before made unlawful. The device limitation in 1201(a)(2) enforces this new prohibition on conduct. The copyright law has long forbidden copyright infringements, so no new prohibition was necessary. The device limitation in 1201(b) enforces the longstanding prohibitions on infringements. *Id.* at 12.

236 *Id.* The court later noted that Congress was aware that most acts of circumvention would involve infringement. *Id.* at 1124-25.

237 *See* United States v. Elcom, Ltd., 203 F. Supp. 2d 1111 (N.D. Cal. 2002). The court declares that “the DMCA does not 'prevent access to matters in the public domain' or allow any publisher to remove from the public domain and acquire rights in any public domain work.” That is, in part because the digital copy is not the only copy available. For the court “[t]he publisher has only gained a technological protection against copying that particular electronic version of the work.” *Id.* at 1131.

copyright infringement, but the publisher can “protect” a digital copy of that work with a technological measure, and exclude others from using that particular copy of the work, using the DMCA. In other words, publishers can legitimately go against people who circumvent (or enable the circumvention) of a technological measure, even though they will not be able to sue them for copyright infringement.²³⁸ It is not immediately evident how this pronouncement by the court conforms to the Supreme Court ruling in *Feist*,²³⁹ where the Court allowed a competitor publisher of telephone directories to copy the entries from the plaintiff’s directory, because those entries were facts in the public domain.²⁴⁰ How it can be reconciled with the precedent on the Fifth Circuit in *Miller v. Universal City Studios*,²⁴¹ where the court allowed a film studio to copy from the plaintiff’s book the facts product of the research done by the plaintiff, even though the defendant was capable of using the same public domain sources the plaintiff used for his research?²⁴² A more basic question would be, can a publisher of a work claim protection of

238 *Id.*

239 *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

240 *See id.* The Court declares that the proscription against the copyright of ideas and facts was designed to prevent precisely the waste of time and effort that represents not allowing subsequent authors to rely upon the facts contained in prior works. *Id.* at 374. If that is the rationale behind such a practice, will it not be a similar waste of time and effort for an author to be forced to rely on an analog copy of the same work, even though a digital copy may be more readily available and easier to use, once circumvented?

241 *Miller v. Universal City Studios, Inc.*, 650 F. 2d 1365 (5th Cir. 1981).

242 *See id.* In the context of facts from research done by the plaintiff, the Fifth Circuit found

Section 1201(b) for protecting her rights, if she has no rights over the work in question?²⁴³ Remember that the language of Section 1201(b)(1) and the definition in Section 1201(b)(2)(B) refer in every occasion to a “right of a copyright owner under this title”.²⁴⁴ The court relied on *Corley* to dismiss the fair use arguments raised by the defendants.²⁴⁵

This is the court that articulated that the DMCA was enacted under the power of Congress under the Commerce Clause, and that such exercise does not conflict with the limitations set out in the Copyright Clause.²⁴⁶

B. Chamberlain

that the defendant was entitled to copy those facts from plaintiff's work, without need to conduct its own research to find the original sources. The court concluded that: “...since facts do not owe their origin to any individual, they may not be copyrighted and are part of the public domain available to every person.” *Id.* at 1369.

243 *See* 17 U.S.C. § 1201(b)(2)(C) (2000), quoted *supra* note 100.

244 *Id.*; *see also* 17 U.S.C. § 1201(b)(1) (2000), quoted *supra* note 57.

245 *See* *United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111 (N.D. Cal. 2002). The court quotes *Corley* for support for the notion that fair use is still available, although the technological measures might make it more difficult to exercise, and for the idea that there is no fair use guarantee for the most technologically-convenient use. *Id.* at 1131.

246 *See supra* text accompanying notes 48-51.

i. Basic Facts of Chamberlain

The facts of *Chamberlain* case, involved two competing manufacturers.²⁴⁷ The plaintiff, Chamberlain, manufactured garage door openers (GDO), that consist of a motor to open and close the garage door, a receiver, that contain copyrighted software responsible receiving and recognizing the opening signal, and directing the motor to open the garage door, and a remote transmitter that sends the open signal to the transmitter.²⁴⁸ The plaintiff's receiver used copyrighted "rolling code" software, that changes the code for opening the door on a constant basis,²⁴⁹ as a measure to prevent burglars from "grabbing" or recording a specific code, then use it to open the garage door, and enter the property.²⁵⁰ Apart from the remote transmitter that comes as part of the GDO, homeowners can acquire spare ones in the aftermarket.²⁵¹ Chamberlain and the defendant, Skylink, are the main manufacturers of "universal transmitters,"

247 *See* Chamberlain Group, Inc., v. Skylink Technologies, Inc., 381 F.3d 1178 (Fed. Cir. 2004). The court noted that plaintiff and defendant are the only significant distributors of universal transmitters for garage door openers. *Id.* at 1183.

248 *See id.* (describing the basic elements that make up a garage door opener or GDO).

249 *See id.* at 1184 (describing how the rolling code technology works).

250 *See* Chamberlain Group, Inc., v. Skylink Technologies, Inc., 381 F.3d 1178 (Fed. Cir. 2004). The court notes that this alleged threat of code-grabbers is "more theoretical than practical, as plaintiff showed no evidence of a single actual incident of attempted access by this method. *Id.* at 1183.

251 *Id.*

capable of operating GDOs from any competing brand.²⁵² Defendant's Model 39 transmitter has the capacity to operate plaintiff's GDO, without using "rolling code" software itself, but by mimicking its "resynchronization" sequence. Chamberlain's DMCA argument was that defendant's transmitter allowed unauthorized users to circumvent the "rolling code" system.²⁵³ In essence the plaintiff alleged that their software was copyrighted, and that the rolling codes were a technological measure that controlled access to this software.²⁵⁴ *Chamberlain* was litigated as a Section 1201(a)(2) violation, trafficking in devices that circumvent a technological measure that controls access to a work.²⁵⁵

a) The Task of Federal Circuit Was to "Construe the Full Boundaries of Circumvention and Antitrafficking Liability Under the DMCA"

The Federal Circuit noted that no other circuit, other than the Second Circuit in *Corley*, had

252 *Id.*

253 *See Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004). The court discusses how Chamberlain system incorporates a resynchronization sequence, in case the use by the homeowner of the transmitter reaches a point where it exhaust all the predetermined accepted codes the receiver will recognize at a certain time.

Then it discusses how Model 39 exploits that feature to operate the garage door. *Id.* at 1183.

254 *See Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004). The plaintiff provided the Copyright Office registration numbers for the software on the transmitter and the software in the receiver. *Id.* at 1185.

255 *Id.*

construed the Section 1201(a)(2) of the DMCA. It observed that said construction “focused on First Amendment issues rather than on an application of the statute to case-specific facts,”²⁵⁶ thus justifying the district court's detailed analysis of the facts and the defenses proffered.²⁵⁷ The Federal Circuit used this same rationale to justify its own statutory construction of the DMCA and of what Section 1201(a)(2) prohibits, by “construing the full boundaries of circumvention and antitrafficking liability under the DMCA.”²⁵⁸

**b) Disagreement with *Reimerdes/Corley*. Copyright Owners Are Still Bound
by All Other Relevant Bodies of Law.**

Plaintiff's argument, supported by the *Reimerdes/Corley* precedent, stood for the proposition that the DMCA “fundamentally altered the legal landscape,” by empowering manufacturers to prohibit the public to make use of protected software along with competing products,²⁵⁹ because

256 *See* Chamberlain Group, Inc., v. Skylink Technologies, Inc., 381 F.3d 1178 (Fed. Cir. 2004). The Federal Circuit considered that the Second Circuit in *Corley* provided only enough statutory construction to address the constitutional challenge. *Id.* at 1185, 1195.

257 *See* Chamberlain Group, Inc., v. Skylink Technologies, Inc., 381 F.3d 1178 (Fed. Cir. 2004). The Federal Circuit concludes that the district court correctly analyzed the case as a matter of first impression, since the only previous case dealing with the DMCA in the Seventh Circuit dealt with a different section. *Id.* at 1185, 1191-92 (citing *In re Aimster Copyright Litigation*, 334 F.3d 643, 655 (7th Cir. 2003)).

258 *See id.* at 1191-92, 1195.

259 *See* Chamberlain Group, Inc., v. Skylink Technologies, Inc., 381 F.3d 1178 (Fed. Cir.

as long as the software is protected by technological measures, that type of use is “per se illegal,” unless expressly authorized by the copyright owner.²⁶⁰ Chamberlain's argument clearly points out that all preceding expectations on the part of consumers and courts as to what were legitimate uses and industry practices were destroyed by the enactment of the DMCA.²⁶¹ The Federal Circuit rejected the idea that the DMCA “fundamentally altered the legal landscape” of what was considered legitimate uses and practices before the DMCA, and concludes that the copyright owners who rely on DMCA protection are still bound by all other relevant bodies of law, such as

2004). Plaintiff refers to Section 1201(a)(1)(A) liability for circumvention, and quotes *Reimerdes. Id.* at 1193.

260 *Id.*

261 *See* Chamberlain Group, Inc., v. Skylink Technologies, Inc., 381 F.3d 1178 (Fed. Cir. 2004). Plaintiff's position also crystallizes one of the key concerns underlying the discussion in *Corley*, the capacity of the copyright owner of prohibiting certain uses by merely controlling access, that is, making other people liable for unauthorized uses and facilitating unauthorized uses, without needing to conform to Section 1201(b)(1), which prohibits use-controls circumvention, or worrying about whether those uses are infringing or not. They may simply rely on Section 1201(a)(1)(A) or Section (a)(2), which prohibits access-controls circumvention. In this manner, copyright owners get the extra capacity of suing direct circumventors under Section (a)(1)(A), something impossible with Section 1201(b). *Id.* at 1193; *cf.* R. Anthony Reese, *Will Merging Access Controls and Rights Controls Undermine the Structure of Anticircumvention Law?*, 18 BERKELEY TECH. L.J. 619, 650-52 (2003) (“merged measures” defeat congressional intent).

antitrust laws and copyright law itself.²⁶²

c) **The Anti-circumvention Provisions of the DMCA Convey No Additional Property Rights, Only New Causes of Liability.**

The above-mentioned pronouncement by the court relies on a more basic, yet consequential conclusion about the DMCA: that “the anticircumvention provisions convey no additional property rights in and of themselves; they simply provide property owners with new ways to secure their property.”²⁶³ According to the Federal Circuit, Congress did provide new grounds for liability when unauthorized access occurs.²⁶⁴

d) **Direct Clash with Reimerdes/Corley. The Core of the Federal Circuit's**

262 See *Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004). The court is convinced that the plaintiff's proposed reading of the DMCA will exempt them from “antitrust laws and the doctrine of copyright misuse.” The court, incidentally, rejected the general conception expressed by the district court in *Reimerdes* and supported by the Second Circuit in *Corley*. *Id.* at 1193.

263 See *Chamberlain Group, Inc.*, 381 F.3d at 1193-94. *But see* Zohar Efroni, *Towards a Doctrine of “Fair Access” in Copyright: The Federal Circuit's Accord*, 46 IDEA 99, 99-101 (2005) (criticizing the Federal Circuit's grounds for affirming that the DMCA created no new property rights).

264 See *Chamberlain*, 381 F.3d at 1194.

**Rationale is That Section 1201 Applies Only to Circumvention
Reasonably Related To Protected Rights.**

This previous conclusion seems hard to reconcile with the results from the previous cases. But even harder to reconcile, particularly with *Corley*, is the court's argument that Section 1201 “applies only to circumvention reasonably related to protected rights.”²⁶⁵ The court responds to the plaintiff's proposed theory that Congress created, with the DMCA, new protection for copyrighted works, but that such protection makes no reference to the existing protections under the Copyright Act, or the rights conferred to the public over those works.²⁶⁶ By alleging that the defendant was liable for facilitating access to the software of the plaintiff, without claiming that any copyright infringement was either committed or facilitated, Chamberlain was proposing that access holds no connection to copyright.²⁶⁷ The court distinguished the previous cases used by the plaintiff for support (*Lexmark* on district court, *Sony v. Gamemaster*, *RealNetworks*),²⁶⁸ in essence, by noting that in all those cases infringement was either found to have occurred, or the devices in question had little purpose other than circumvent to later infringe.²⁶⁹ The court

265 *See id.* at 1195.

266 *See id.* at 1197.

267 *See id.*

268 *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 253 F. Supp. 2d 943, 969 (E.D. Ky. 2003); *Sony Computer Entertainment America, Inc. v. Gamemasters*, 87 F. Supp. 2d 976 (N.D. Cal. 1999); *RealNetworks, Inc. v. Streambox, Inc.*, No. C99-2070P, 2000 U.S. Dist. LEXIS 1889 (W.D. Wash. Jan. 18, 2000).

269 *See Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir.

recognized that the statute can be read to support the idea that access can be severed from protection, and that the Second Circuit in *Corley* further supports that reading. The Federal Circuit attributes this seeming plausibility to the fact that Section 1201(a) can be seen as straightening the owners' ability to protect their rights under the Copyright Act, while Section 1201(b) can be seen as allowing owners to protect access to their works without regards to whether the action enabled by the circumvention is legitimate or not.²⁷⁰ Yet, the court rejects to read the Second Circuit as promoting an interpretation of the term access completely divorced from its context within copyright law.²⁷¹

e) **The Plaintiff's Reading of the DMCA Has the Effect of Creating Two Distinct Copyright Regimes**

As a consequence of this reading of the DMCA, as promoted by the plaintiff, Chamberlain, the

2004). The court distinguished *Lexmark* (district court decision), *Sony v. Gamemaster*, and *RealNetworks* by concluding that in all three cases the access alleged “was intertwined with a protected right.” *Id.* at 1198-99.

270 See *Chamberlain*, 381 F.3d at 1199. The court refers to the following language from the Second Circuit in *Corley*:

The focus of subsection 1201(a)(2) is circumvention of technologies designed to prevent access to a work, and the focus of subsection 1201(b)(1) is circumvention of technologies designed to permit access to a work but prevent copying of the work or some other act that infringes a copyright.

See *Corley*, 273 F.3d at 440-41.

271 *Id.*

Federal Circuit concludes, we would be creating “two distinct copyright regimes.”²⁷² According to the Federal Circuit, in the first regime, owners of traditional copyrighted works will enjoy the rights recognized by Section 106 of the Copyright Act, as altered by the various additions, exceptions, and limitations present throughout the rest of the Copyright Act, including fair use in Section 107.²⁷³ Those owners who feel worried that their rights might be infringed with the help the new technologies, and who put use-control measures to protect those right, gain the additional legal ability of holding liable under Section 1201(b) the traffickers in circumvention devises that provide the tools to those circumventors who would use them to infringe the rights of the owner, thus defeating the goal that motivated the use controls.²⁷⁴ In the second regime, as described by the court, the owners of works protected by copyright, and guarded under access-control measures, will gain unlimited rights to hold circumventors liable under § 1201(a) merely for accessing that work, even if that access enabled only rights that the Copyright Act grants to the public.”²⁷⁵ The Court labels this perceived outcome as an irrational exercise of the authority of Congress under the Copyright Clause.²⁷⁶

272 See *Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004). The court declares that to allow copyright owners to use Section 1201(a) to block all access to their works, will in fact create two distinct copyright regimes. *Id.* at 1199-200.

273 *Id.*

274 *Id.*

275 *Id.*

276 See *Chamberlain*, 381 F.3d at 1200. The Court quotes the language of the Supreme Court in *Eldred*, that “Congress’ exercise of its Copyright Clause authority must be rational.”

f) **Further Disagreement With *Reimerdes/Corley*. Section 1201(c)(1) Prohibits the DMCA to Affect Rights and Limitations Established By the Copyright Act.**

Finally, to further the distinction between this case and *Corley*, the Federal Circuit declares that to permit a provision of the DMCA to prohibit access irrespective of the rest of the Copyright Act runs contrary to the language of Section 1201(c)(1), because such a prohibition will definitively affect rights and limitations, if not remedies and defenses.²⁷⁷ Although the Federal Circuit avoided deciding the matter of fair use as a defense in the context of a Section 1201 violation,²⁷⁸ it reached the conclusion that the DMCA did not “rescind[] the basic bargain” that grants fair use to the public.²⁷⁹

Id. at 1200 (citing *Eldred v. Ashcroft*, 537 U.S. 186, 205 n.10 (2003)).

277 *See Chamberlain*, 381 F.3d at 1200. Compare this reading of Section 1201(c)(1) with the reading by the Second Circuit. *See supra* text accompanying notes 210-212.

278 *See Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004). The court noted the ruling in *Reimerdes* against the availability of fair use as a defense to a Section 1201(a) claim, yet, it clarified: “We do not reach the relationship between § 107 fair use and violations of § 1201....We leave open the question as to when § 107 might serve as an affirmative defense to a prima facie violation of § 1201.” *Id.* at 1199 n.14.

279 *See Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004). The court, when referring to the inconsistency of the “severance of access from protection” proposition, found that:

g) The Elements of a Section 1201(a)(2) Claim and Its Effect on the Plaintiff's Case

Finally, the Federal Circuit formulated the elements necessary proving a violation of Section (a)(2)(trafficking of devices that circumvent access-control measures). As already described,²⁸⁰ the plaintiff must prove she owns a valid copyright over a work; that such work was effectively controlled by a technological measure that later was circumvented; that because of such circumvention, other individuals have gained access to that work; that said access was not authorized by the owner; and because of that access, others were allowed to infringe or infringed one of the owner's rights protected by the Copyright Act. All of these five elements must be met. Then, the plaintiff has to prove one of these remaining three elements, that the circumvention occurred by means of a device that the defendant: designed primarily for circumvention; or made available despite the fact that it had little economical use other than to circumvent; or marketed as a method to circumvent.²⁸¹ Only after these elements are met, will the court entertain the

The statutory structure and the legislative history both make it clear that the **DMCA** granted copyright holders additional legal protections, but neither rescinded the basic bargain granting the public noninfringing and fair uses of copyrighted materials, § 1201(c), nor prohibited various beneficial uses of circumvention technology, such as those exempted under § § 1201(d),(f),(g),(j). *Id.* at 1202.

280 *See supra* text accompanying notes 125-126.

281 *See supra* text accompanying notes 125-126.

specific defenses listed on Section 1201.²⁸² The Federal Circuit found that the plaintiff failed to prove element 4, the lack of authorization, because all of Chamberlain's costumers were authorized to access the software embedded in their GDO's in order to make use of them. Also, the plaintiff failed to prove element 5, the nexus between access and protection, because Chamberlain did not allege copyright violation, actual or facilitated, by defendant's conduct.²⁸³ The “fifth element” is the final result of the court's central proposition in this case, that no anti-circumvention claim can be brought without alleging some form infringement, in synthesis, access cannot be severed from protection.²⁸⁴ The Supreme Court denied certiorari in this case.²⁸⁵

C. Storage Tech.

i. Basic Facts of Storage Tech.

The Federal Circuit also had the opportunity to apply its ruling of *Chamberlain* to a case dealing

282 See *Chamberlain*, 381 F.3d at 1203.

283 See *Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004). The failure to prove “lack of authorization” was the basis the district court used to dismiss plaintiff's claims. *Id.* at 1204.

284 See *Chamberlain*, 381 F.3d at 1201-02. The court concludes that Section 1201 “prohibits only forms of access that bear a reasonable relationship to the protections that the Copyright Act otherwise affords copyright owners.” *Id.* at 1201-02.

285 See *Chamberlain Group, Inc. v. Skylink Technologies, Inc.*, 544 U.S. 923 (2005).

with Section 1201(a)(1) (direct circumvention). *Storage Technology Corporation v. Custom Hardware Engineering*,²⁸⁶ involved a company dedicated to the repair of data libraries.²⁸⁷ These libraries consist of modules containing numerous tape drives and tape cartridges along with a robot arm that moves the cartridges.²⁸⁸ These modules are connected to a Control Unit that controls the robotic arm and monitors the process. These are all connected to a computer that is the Management Unit.²⁸⁹ When booted, the Management Unit automatically loads into its RAM and that of the Control Unit a copy of copyrighted software provided by the manufacturer, which allows the machines to operate, and to perform maintenance functions.²⁹⁰ To monitor and maintain these machines, defendant connected a device in between the Management Unit and the Control Unit, to intercept the error messages that one unit sent to the other.²⁹¹ In order to do so, defendant's device circumvented the access-control measure put in place by the plaintiff, to impede the reconfiguring of that software. Plaintiff sued the defendant for copyright infringement and DMCA violation. The alleged copyright infringement involved the loading into RAM of the portion of the software that provided maintenance to the Control Unit and

286 *Storage Tech. Corp. v. Custom Hardware Eng'g & Consulting, Inc.*, 421 F.3d 1307 (2005).

287 *See id.* The Data Libraries devices are automated tape cartridge libraries capable of storing massive amounts of computer data. *Id.* at 1309-11.

288 *Id.*

289 *Id.*

290 *Id.*

291 *Id.*

Management Unit, while the defendant monitored these devices. The DMCA claim involved the circumvention of the access-control measure already mentioned, to get access to said software, in order to use it to maintain the machines.²⁹² The district court conceded a preliminary injunction in favor of plaintiff.²⁹³

a) **A Matter of First Impression, the Application of the Language of Section 117(c)**

As opposed to *Chamberlain*, this case involved an allegation of copyright infringement. The court applied for the first time the language of Section 117(c),²⁹⁴ a new amendment to the Copyright Act, enacted as part of the DMCA, which created an exception from copyright

292 *Id.*

293 *Id.*

294 *See* 17 U.S.C. § 117(c)(2000). Which provides in relevant part:

Notwithstanding the provisions of section 106..., it is not an infringement for the owner or lessee of a machine to make or authorize the making of a copy of a computer program if such copy is made solely by virtue of the activation of a machine that lawfully contains an authorized copy of the computer program, for purposes only of maintenance or repair of that machine, if--

(1) such new copy is used in no other manner and is destroyed immediately after the maintenance or repair is completed; and

(2) with respect to any computer program or part thereof that is not necessary for that machine to be activated, such program or part thereof is not accessed or used other than to make such new copy by virtue of the activation of the machine.

infringement in favor of services in the business of computer repair and maintenance.²⁹⁵ After determining that the new exception covered the activity of the defendant, and that it was unlikely that plaintiff could prove infringement, the Federal Circuit applied its recent ruling in *Chamberlain*, and concluded that because the conduct of the defendant did not constitute infringement and or facilitate infringement, plaintiff could not maintain a DMCA action against it.²⁹⁶ Here the Federal Circuit applied the fifth element of its newly constructed Section 1201 Claim, this element requires a nexus between the circumvention alleged and traditional copyright infringement.²⁹⁷ The Federal Circuit further explained, that even if the loading into RAM of the copyrighted software was found to be infringement, it happened automatically, irrespective of whether the circumventing device was in place or not, so no nexus existed between that act of circumvention, and the allegedly infringing copying into RAM.²⁹⁸ Here the court made an

295 *See* Storage Tech. Corp. v. Custom Hardware Eng'g & Consulting, Inc., 421 F.3d 1307, 1312-13 (2005) (narrating the legislative history and rationale behind the exception).

296 *See id.* at 1318. The court reaffirmed that the DMCA “must be read in the context of the Copyright Act”. *Id.* at 1318.

297 *See* Chamberlain Group, Inc., v. Skylink Technologies, Inc., 381 F.3d 1178 (Fed. Cir. 2004). The court found that the plaintiff had failed to prove the fifth element of the cause of action under Section 1201(a)(2) because the “necessary nexus” between access and protection was missing. *Id.* at 1204.

298 *See* Storage Tech. Corp. v. Custom Hardware Eng'g & Consulting, Inc., 421 F.3d 1307 (2005). The circumventing device in this case was not used to acquire a copy of the software but to use the maintenance portion of said software in diagnosing problems with the hardware

interesting refining of its fifth element. It is not enough, for the fifth element to be satisfied, that infringement have occurred, that infringement must have occurred (or must have been facilitated) because of the circumvention.²⁹⁹ *Storage Tech* is also noteworthy because is the first time, after *Chamberlain* set the stage with its “fifth element”, that a defendant alleging the protection of one of the enumerated exceptions to infringement of the Copyright Act (Section 117(c)) is able to escape liability from a claim for circumvention under the DMCA.³⁰⁰

and its operation. The loading into RAM occurred every time the machines were rebooted.

The court found that the using of the software was not something the plaintiff could control under the copyright law. *Id.* at 1319.

299 *Id.*

300 *Chamberlain* itself did not involve an allegation of infringement, and the court relied more generally on the rights recognized to the public by the Copyright Act, among them, the statutory exceptions, but without relying on any specific exception. *See Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178, 1200,1204 (Fed. Cir. 2004). *Lexmark* relied on various grounds to dismiss the DMCA claim, like the finding that the technological measure did not in fact effectively control access to the copyrighted programs, but none of the grounds included a statutory exception. *See Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 549-50 (6th Cir. 2004). *Reimerdes/Corley, RealNetworks, Elcom, Ltd., In re Aimster*, all ruled in favor of plaintiffs. *See Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2d Cir. 2001); *see also RealNetworks, Inc. v. Streambox, Inc.*, No. C99-2070P, 2000 U.S. Dist. LEXIS 1889 (W.D. Wash. Jan. 18, 2000); *see also United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111 (N.D. Cal. 2002); *see also In re Aimster Copyright*

D. The Claim Construction of the Federal Circuit Provides Various Avenues of Defense Against a DMCA Claim.

The five elements delineated by the Federal Circuit provide more than one alternative to a defendant who faces a claim of DMCA violation. The first element, ownership of a valid copyright, although seems straightforward enough, could be of crucial importance, for a defendant with a good case of merger defense, or some other argument based on the idea/expression dichotomy. This is also a good ground to challenge the standing of the plaintiff. This analysis may have made the difference for the defendant in *Macrovision*.³⁰¹ The plaintiff in that case was not the owner of any copyright, but the patentee of the access-control measure.³⁰² the second element (effectively controlled by a technological measure) is the precise point to challenge the protection scheme, in facts similar to *Lexmark*. The third element (third parties can now access the work) must be argued to require of the plaintiff evidence of actual unauthorized access, that is the consequence of defendants' circumventing device, and challenge the

Litigation, 334 F.3d 643 (7th Cir. 2003).

301 *Macrovision v. Sima Prods. Corp.*, No. 05 Civ. 5587, 2006 U.S. Dist. LEXIS 22106 (S.D.N.Y. Apr. 20, 2006).

302 *See Macrovision v. Sima Prods. Corp.*, No. 05 Civ. 5587, 2006 U.S. Dist. LEXIS 22106 (S.D.N.Y. Apr. 20, 2006). The court did not analyze the validity of plaintiff's rights, it simply determined that the plaintiff was likely to succeed on the merits, and that *Macrovision* lacked an adequate remedy at law because "its business model rests upon its being able to prevent the copying of copyrighted works." *Id.* at *1, 4, 8.

sufficiency of a mere probability. Cases that fit into the facts of *Lexmark*, and *Storage Tech*, can benefit from this. The fourth element (unauthorized access) allows defendant to bring before the court evidence of implied authorization given to costumers by plaintiff, like the implied license of printer owners to access and use the software embedded in the printer and the cartridges. The silence of a license agreement can serve as a ground for alleging an implied authorization to the defendant or the consumers.³⁰³ And the fifth element (nexus between the circumvention and infringement) serves to open the doors of the DMCA to most of the defenses already recognized in copyright law for infringement.³⁰⁴ Defendant can allege any of the statutory exceptions to copyright infringement codified in Sections 107 to 122.³⁰⁵ If a defendant cannot defeat a charge of infringement, he can at least allege that although infringement occurred, it was not related to its circumvention, and avoid liability for the circumvention.³⁰⁶

303 See *Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178, 1183 (Fed. Cir. 2004)(“Chamberlain places no explicit restrictions on the types of transmitter that the homeowner may use with its system at the time of purchase”).

304 See Zohar Efroni, *Towards a Doctrine of “Fair Access” in Copyright: The Federal Circuit's Accord*, 46 IDEA 99, 101 (2005) (exposing the consequences of the Federal Circuit's decision in *Chamberlain*).

305 *But see Chamberlain*, 381 F.3d at 1199 n.14 (leaving open the question as to when Section 107 might serve as an affirmative defense to a prima facie violation of Section 1201).

306 See *Storage Tech. Corp. v. Custom Hardware Eng'g & Consulting, Inc.*, 421 F.3d 1307 (2005). The court declared that even if the infringement occurred, plaintiff had to prove it occurred because of the circumvention. *Id.* at 1319.

E. Limitations of the Chamberlain Ruling as a Defense.

The Federal Circuit fell short of saying that fair use available to claims of DMCA violation.³⁰⁷

Also, a defense under *Chamberlain* is more likely to be successful if all the people that circumvent by cause of the defendant's device, can fall under one of the statutory exceptions, as a class, that is, all are libraries or archives that fall under the exception of Section 108.³⁰⁸ In the

307 See *Chamberlain*, 381 F.3d at 1199 n.14. The court clarified: “We do not reach the relationship between § 107 fair use and violations of § 1201....We leave open the question as to when § 107 might serve as an affirmative defense to a prima facie violation of § 1201. *Id.* at 1199 n.14.

308 See 17 U.S.C. § 108 (2000). Which provides in relevant part:

(a) Except as otherwise provided in this title and notwithstanding the provisions of section 106 [17 U.S.C. § 106], it is not an infringement of copyright for a library or archives, or any of its employees acting within the scope of their employment, to reproduce no more than one copy or phonorecord of a work, except as provided in subsections (b) and (c), or to distribute such copy or phonorecord, under the conditions specified by this section, if--

(1) the reproduction or distribution is made without any purpose of direct or indirect commercial advantage;

(2) the collections of the library or archives are (i) open to the public, or (ii) available not only to researchers affiliated with the library or archives or with the institution of which it is a part, but also to other persons doing research in a specialized field; and

(3) the reproduction or distribution of the work includes a notice of copyright that appears on the copy or phonorecord that is reproduced under the provisions of this section, or includes a legend stating that the

facts of *Chamberlain* the people to which defendant provided circumventing devices were by definition legitimate owners of the plaintiff's product, with implied license to access and use the embedded software.³⁰⁹ The Federal Circuit did not say how the three remaining elements of the Section 1201 claim (a device primarily designed for, with little commercial significance other than, or marketed for, circumvention) are to be established by the plaintiff. It is not clear what amount of commercial significance might be considered little enough, or if just one instance of marketing is evidence enough.

VII. The “Dual System” Approach Versus the “Unified System” Approach

As previously mentioned, the views of the Second and the Federal Circuit are notably different.³¹⁰ Those differences can be attributable to the different way in which each circuit perceives the interaction between the DMCA and the Copyright Act. The *Reimerdes/Corley* “party” sees the DMCA as a statute that is insulated from the Copyright Act.³¹¹ The

work may be protected by copyright if no such notice can be found on the copy or phonorecord that is reproduced under the provisions of this section.

309 See *Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004). The court narrated, and latter affirmed, the district court's conclusion that because Chamberlain never restricted its customers' use of competing transmitters with its product, those customers had implicit authorization to use the defendant's transmitter. *Id.* at 1187.

310 See *supra* text accompanying notes 195-300.

311 See *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 443-44 (2d Cir. 2001) (DMCA does not concern itself of what happens after circumvention); see also *supra* text accompanying notes 210-218.

Chamberlain “party” sees the DMCA not as a separate set of rules, completely divorced from the pre-existing bodies of law, particularly, copyright law, but as an integrated piece of the copyright legislation that “must be read in the context of the Copyright Act.”³¹² This difference might allow us to characterize them as the “dual system” approach, and the “unified system” approach, respectively.

A. The *Corley* “Dual System” Approach

The name “dual system” approach is inspired by the criticism of the “two distinct copyright regimes” announced by the Federal Circuit, but is not an exact match.³¹³ The main difference is that this “dual system” approach incorporates the ruling of *Elcom, Ltd.*, a case that followed *Corley*, but applying it to a Section 1201(b) violation, something not entirely covered in *Corley*. The way the Federal Circuit envisioned it, the first regime consisted of those copyright owners protected by traditional copyright law, and those that, taking advantage of the DMCA protection for use-control measures, protected their rights from circumventing devices. In this first regime, those copyright owners were still subject to the same limitations and duties imposed by the

312 See *Storage Tech. Corp. v. Custom Hardware Eng'g & Consulting, Inc.*, 421 F.3d 1307, 1318 (2005) (“DMCA must be read in the context of the Copyright Act, which balances the rights of copyright owners against the public's interest in having appropriate access to the work.”).

313 See *Chamberlain*, 381 F.3d at 1198-1200. The court declares that to allow copyright owners to use Section 1201(a) to block all access to their works, will in fact create two distinct copyright regimes. *Id.* at 1199-200.

Copyright Act and other laws, just as with their non-encrypted works. The key characteristic here is that those copyright owners were subject to the statutory limitations contained in Sections 107-122, as well as the idea/expression dichotomy. On the second regime where the copyright owners that, taking advantage of the DMCA protection for access-control measures, were able to limit access to their works without regard to copyright law or any other limitation imposed by other bodies of law.

The “dual system” approach refers to the world of works outside a technological measure on one side or system, and the world of works inside a technological measure on the other. Although not completely dictated by the decision in *Corley*, is undoubtedly a consequence of the interpretation of its ruling by lower courts, particularly *Elcom. Ltd.*, and latter plaintiffs. In essence, with the mantra that circumvention is not infringement, plaintiffs have promoted the argument that they can hold people liable of circumvention, even if they don't infringe.³¹⁴ The key underlying premise to this argument is that the DMCA somewhat insulates them from the Copyright Act.³¹⁵ This approach views the DMCA and the Copyright Act as two independent statutes, one enacted by Congress under the power of to Commerce Clause, and one enacted by Congress under the power of the Copyright Clause.³¹⁶ The liabilities arising from each of the two statutes,

314 *See Universal City Studios v. Reimerdes*, 111 F. Supp. 2d 294 (S.D.N.Y. 2000). The court found that DMCA fundamentally altered the landscape, referring to the application of fair use as a defense to trafficking. A technology might have substantial noninfringing uses, but nonetheless still be subject to a charge under Section 1201. *Id.* at 323-24.

315 *See supra* text accompanying notes 210-218.

316 *See United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111, 1137-39 (N.D. Cal. 2002)

circumvention and infringement respectively, are divorced from one another.³¹⁷ Therefore it is possible to talk about two systems of protection for works, a notion that has triggered criticism from the academy.³¹⁸ It is also possible to talk about circumvention without implying infringement.³¹⁹ It is even possible to recognize DMCA protection even for things that are not subject of protection from the Copyright Act, like works in the public domain.³²⁰ Under this dual system approach, the imposition of impediments and restrictions to the noninfringing use of copyrighted materials in a digital format does not subvert the balance of the copyright act, because the works are not equally restricted from use in the analog world.³²¹ The idea expression/dichotomy is not disturbed, as long as we refer to works outside the cover of a technological measure.³²² The fair use doctrine is not disturbed, as long as it stays out of

(DMCA was enacted under the Commerce Clause).

317 *See Reimerdes*, 111 F. Supp. 2d at 322-23.

318 *See* Peter K. Yu, *Anticircumvention and Anti-anticircumvention*, 84 DENV. U. L. REV. 13, 34-40 (2006) (overview of the criticism to the DMCA).

319 *See Reimerdes*, 111 F. Supp. 2d at 323-24 (A technology is liable although substantially noninfringing).

320 *See* *United States v. Elcom, Ltd.*, 203 F. Supp. 2d 1111, 1131 (N.D. Cal. 2002) (DMCA do not take a work from the public domain, publisher only can limit access over the digital copy).

321 *See supra* text accompanying note 219.

322 *See Elcom*, 203 F. Supp. 2d at 1131.

encrypted content.³²³ The “limited times” limitation on the Constitution is not violated, at least not in the analog copies.³²⁴

B. The Chamberlain “Unified System” Approach

This is the approach promoted by the Federal Circuit in *Chamberlain*. The ruling in *Lexmark* is included in this approach. This approach views the DMCA as unified with the Copyright Act.³²⁵ Under this approach the rights of a copyright owner are identical whether her work is protected or not by a technological measure, although her legal options to exercise those rights can vary.³²⁶ Under this approach, the copyright owners can get protection against acts of circumvention that expose them to infringement, but not protection to their monopolies, or protection that insulates them against competitors.³²⁷ Under this approach, no protection is given to works that are not subject to copyright protection in the first place, or that ceased to be protected.³²⁸ Under this

323 *See supra* text accompanying notes 222-224.

324 *See supra* text accompanying note 219.

325 *See Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004). The court notes that Section 1201 only applies to cases of circumvention reasonably related to protected rights. *Id.* at 1195.

326 *See Chamberlain*, 381 F.3d at 1193-94 (DMCA only creates new grounds for liability).

327 *See id.* The court noted the plaintiff’s attempt to use the DMCA to exempt him from antitrust liability or a claim of copyright misuse. *Id.* at 1201.

328 *See Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522 (6th Cir. 2004)

The court rejects extending DMCA protection to a software that does not meet the

system, developers of new technologies can be free from legal threats when their devices are directed at allowing legitimate uses.³²⁹

**C. Consequences of Each Approach in the Prospects of A Defense to Circumvention
Based on Copyright Principles.**

Under the precedents of *Corley* and *Elcom, Ltd.*, the options are very limited for a defendant. DMCA liability has its own limited exceptions and no more. On the other hand, the precedent of the Federal Circuit opens the door of the DMCA to numerous defenses that previously were reserved to a traditional copyright case.

**D. How does each system interpret the terms “Work Protected Under This Title”
And “Right of the Copyright Owner”**

There is a common thread between *Lexmark* and *Chamberlain*. Both cases looked for guidance in the copyright law, when faced with questions about the DMCA. This is a sharp departure from the approach taken by the Second Circuit and other district courts. Both the Sixth and Federal Circuit focused on the undefined terms in the DMCA, and brought meaning and context for those

requirements for protection under the Copyright Act. *Id.* at 550.

329 *See* *Chamberlain Group, Inc., v. Skylink Technologies, Inc.*, 381 F.3d 1178 (Fed. Cir. 2004). The court recognizes the significant differences between defendants whose accused products enable copying and those, whose accused products enable only legitimate uses of copyrighted software. *id.* at 1198.

terms from the traditional copyright law. The terms that proved most pivotal were “access” and “work protected under this Title.” The Sixth Circuit used the plain definition of access to call into question the effectiveness of the technological measure put in place by the plaintiff. The Sixth Circuit used the term “works protected” to deny DMCA protection to a program too small to contain any protectible expression. The Federal Circuit interpreted access in the context of the existing rights, limitations and remedies, to articulate the privilege of the public to access the copyrighted works for legitimate purposes, and the absurdity of permitting owners control that access when the activities related to it are not illegitimate.³³⁰ The Federal Circuit used the term “work protected”, particularly in combination with access, to bring into consideration the whole of the Copyright Act, when dealing with a claim under the DMCA.³³¹ In fact, the fifth element of the Section 1201 cause of action is sustained by the necessary relation between access and protection that the Federal Circuit identified.³³² The ruling of Second Circuit in *Corley* can be

330 *See id.* The court concludes that the plaintiff's proposed formulation of Section 1201(a) “implies that in enacting the DMCA, Congress attempted to “give the public appropriate access” to copyrighted works by allowing copyright owners to deny all access to the public. Even under the substantial deference due Congress, such a redefinition borders on the irrational.” *Id.* at 1200.

331 *See Storage Tech. Corp. v. Custom Hardware Eng'g & Consulting, Inc.*, 421 F.3d 1307 (2005). The court explains why the need to read the DMCA in the context of the Copyright Act, to balance the interest of copyright owners against the public's interest. *Id.* at 1318.

332 *See Chamberlain*, 381 F.3d at 1204. The court found no nexus between access and protection as part of the fifth element analysis of the cause of action under Section

said to represent an interpretation of the term “work protected”. In that case, “work protected” means work as defined by Section 102, not necessarily including the rest of the Copyright Act. Likewise, *Elcom. Ltd.*, did provide some meaning to the term “a right of a copyright owner”. It meant rights as enumerated in Section 106 minus the limitations of Sections 107 to 122.

E. Outside-in Versus Inside-out approaches.

It might also be said that the Second Circuit took an outside-in approach, when evaluating a claim of DMCA violation. The phrase that best characterizes this approach by the Court is its reading of Section 1201(c)(1). For the Second Circuit, Section 1201(c)(1) “...simply clarifies that the DMCA targets the *circumvention* of digital walls guarding copyrighted material (and trafficking in circumvention tools), but does not concern itself with the *use* of those materials after circumvention has occurred.”³³³ Under that approach, the Court looks at the technological measure as if it was a safe box. The court inquires whether it is a safe box or just a cardboard box (if it controls the access). Then it inquires if the conduct of the defendant in opening the box is authorized or not (with an authorized password or with a circumvention device). If the court finds that the conduct of the defendant is unauthorized, then circumvention has occurred and the defendant is liable. No inquiry is made as to the contents of the box, or whether the defendant had some legitimate reason for opening the box.

On the other hand, the Federal Circuit and the Sixth Circuit took an inside-out approach, when faced with claims of DMCA violation. The court under this approach first inquires about the

1201(a)(2). *Id.* at 1204.

333 *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 443 (2d Cir. 2001)

contents of the box (whether is a work protected under the Copyright Act). If for some reason the contents does not belong in the box (is not a protected work, or right, or some exception under copyright law exists), then the box is just a cardboard, and no protection is recognized for it, so no liability follows. If the contents is supposed to be there (protectible work, to be infringed), then the box is a safe box, and the conduct of the defendant is examined to determine if it constitutes a breaking of that safe box (circumvention).

This inside-out approach is a consequence of the attention given by the Federal Circuit to the term “work protected” within the anti-circumvention provisions. Close examination of Section 1201(a)(1)(A) reveals that this term is central to understanding the rest of the statutory language. Section 1201(a)(1)(A) reads: “No person shall circumvent a technological measure that effectively controls access to a work protected under this title.”³³⁴ The way the sentence is constructed conditions the whole fate of the section. There has to be a work protected, before there can be access to it, and before there can be effective control of that access, and before that effective control can be circumvented. It can be said that the term “work protected is at the “center” of the section. Without it the whole structure crumbles. In practically all sentences of Section 1201 the words “work protected” or “right of a copyright owner” are mentioned at least once. In almost all of those mentions the role of the term is central to the understanding of the rest of the sentence.

F. Possible Defenses as a Result of the Inside-Out Approach

Defendants might not end up being revised by the Federal Circuit, where they may allege their

334 17 U.S.C. § 1201(a)(1)(A) (2000).

actions do not meet the fifth element of the Section 1201 claim (no nexus between the circumvention and infringement). So defendants may have to convince the court to do a similar analysis as the Federal Circuit did, which might not adopt that precedent. No matter what line of argument a defendant takes, the main feature should be the centrality of terms “works protected” and “right of a copyright owner” in the statutory language of the DMCA. This might reach the same results as the ruling of *Chamberlain*, prevent the court from looking at circumvention divorced from the general copyright protection. If the court is willing to entertain that notion, then any statutory exception to infringement, including fair use, might prove useful. This way, the defense of merger will be more effective, because defendant will not have to worry about works that might be included within the same technological measure, but he does not infringe with his conduct. He can concentrate his merger defense on that work he allegedly infringes.

VIII. Conclusion: We Should Not Erase the C from the DMCA

The DMCA will surely continue to be the kind of law that law professors “love to hate”.³³⁵ Most of that criticism is unquestionably well deserved. Yet, no new legislative initiatives seem to be expected in the near future, that can amend this statute and clear most of the doubts and concerns this law generates.³³⁶ All the while, many individuals face threats of legal action by industry

335 See R. Polk Wagner, *Reconsidering the DMCA*, 42 HOUS. L. REV. 1107 , 1108 (2005)

(“The Digital Millennium Copyright Act (DMCA) is a law that nearly all legal scholars love to hate”).

336 *But see* Digital Media Consumers' Rights Act of 2003, H.R. 107, 108th Cong. § 5 (2003).

competitors, or simply back away from promising technologies, in fear of stepping on the content owners' toes. Copyright law historically has provided statutory exceptions and judiciary doctrines that allowed certain industries to build around them, avoiding liability, and benefiting the general public in the process. The DMCA, as read by some courts, had the effect of altering that which most took for granted, and in so doing, hindered many legal and beneficiary activities. Approaches like the ones of the Federal Circuit and the Sixth Circuit have the capacity of alleviate, although not eradicate, these outcomes. To read the DMCA together with the Copyright Act, and to give meaning to the legislation as part of a system, might not be the most elegant endeavor, but seems as the one with the most chances to succeed in the face of the DMCA's unflinching provisions.