UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF KENTUCKY
AT LEXINGTON
CIVIL ACTION NO. 02-571-KSF

LEXMARK INTERNATIONAL, INC. PLAINTIFF

vs. **BRIEF AMICUS CURIAE OF LAW PROFESSORS**

STATIC CONTROL COMPONENTS, INC. DEFENDANT

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on behalf of Amici Law Professors

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IDENTITY AND INTEREST OF AMICI

The undersigned are law professors specializing in the field of copyright, cyberspace law, intellectual property and antitrust law. Since the passage of the Digital Millennium Copyright Act in 1998, many of us have expressed concerns that the anticircumvention provisions of that law, and particularly the new right with respect to circumvention of access controls in Section 1201(a), 17 U.S.C. § 1201(a) (2002), might be invoked to thwart activities that otherwise are and should be deemed legitimate conduct. It is our view that the above-captioned case presents an instance of such potential misuse. We have moved herewith for leave to file this brief amicus curiae.

ARGUMENT

Before and since its enactment, Section 1201(a) has been the subject of close scrutiny and intense controversy. Congress' express purpose in adopting Section 1201(a), as all the anticircumvention provisions of the DMCA, was to promote electronic commerce in copyrighted works as distributed in digital format, by protecting copyrighted works against acts of piracy – i.e., the use and distribution of "black boxes" that undo certain types of technological protection measures and enable the infringing commercial distribution and duplication of copyrighted works in an unprotected form.

The impetus for the DMCA arose initially from a Report by the Information Infrastructure Task Force Working Group on Intellectual Property Rights, which had recommended adoption of a like provision as 17 U.S.C. § 1201:

> No person shall import, manufacture or distribute any device, product, or component incorporated into a device or product, or offer or perform any service, the primary purpose or effect of which is to avoid, bypass, remove, deactivate, or otherwise circumvent, without the authority of the copyright owner or the law,

> any process, treatment, mechanism or system which prevents or inhibits the violation of any of the exclusive rights of the copyright owner under section 106.

"Intellectual Property and the National Information Infrastructure," the Report of the Working Group on Intellectual Property Rights, Appendix 1 at 6 (Sept. 1995). The United States advocated adoption of such protections against circumvention of technological protection measures during the then-ongoing treaty negotiations before the World Intellectual Property Organization ("WIPO"). In December 1996, the WIPO Copyright Treaty incorporated as Article 11 a provision entitled "Obligations concerning Protection Measures":

> Contracting Parties 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 permitted by law.

Beginning in 1997, Congress began to consider legislation to implement in our domestic law this provision of the WIPO Copyright Treaty. Over the nearly two-year course of its deliberations, Congress received thousands of pages of testimony from copyright industries, educational and library institutions, public interests and private industries concerning the bills that would come to be known as the Digital Millennium Copyright Act. Positions for and against the DMCA were equally passionate, reflecting the unprecedented nature of the protections being sought, and the uncertain potential consequences of such provisions upon technological progress and the public good. The Commerce Committee of the House of Representatives recognized the potential for the abuse of Section 1201(a) to thwart lawful activities. In response, Congress delayed for

two years the effective date of Section 1201(a), and adopted in Section 1201(a)(1)(B) an additional safeguard procedure whereby the Copyright Office, pursuant to a triennial review, could exempt from the anticircumvention proscriptions of Section 1201(a)(1) certain classes of works where technological protection measures had impeded lawful uses.[1] Congress further exempted certain specific categories of circumvention activities from the Section 1201(a) prohibitions, including in Section 1201(f) reverse engineering activities for the purpose of facilitating interoperability between computer programs.

Notably, throughout these deliberations over the DMCA, the focus of Congress and all witnesses before it was upon use of Section 1201(a) and the DMCA as a whole to promote electronic commerce in copyrighted works.[2] We find no suggestion anywhere in the legislative history that Congress considered, no less intended, Section 1201(a) to apply to the type of computer program at issue in the Lexmark complaint.

The few cases brought to date under the DMCA have produced mixed results. But however controversial these cases have been, the claims have borne some relationship to the typical scenario envisioned under the DMCA. Each involved the circumvention of a technological protection measure applied to prevent the reproduction and redistribution of an

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1 See Notice of Inquiry, Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies, 67 Fed. Reg. 63578 (October 15, 2002).

2 "[The treaties] require two technological adjuncts to the copyright law, intended to ensure a thriving electronic marketplace for copyrighted works on the Internet." Report of the Committee on the Judiciary, H.R. Rep. No. 105-551 Part 1, 105th Cong. 2d Sess. at 10-11 (May 22, 1998); "H.R. 2281 is one of the most important pieces of legislation affecting electronic commerce that the 105th Congress will consider. It establishes a wide range of rules that will govern not only copyright owners in the marketplace for electronic commerce, but also consumers, manufacturers, libraries, educators, and on-line service providers. … It defines whether consumers may engage in certain conduct, or use certain devices, in the course of transacting electronic commerce." Report of the Committee on Commerce, H.R. Rep. No. 105-551 Part 2, 105th Cong. 2d Sess. at 22 (July 22, 1998); "The legislation implementing the treaties, Title I of this bill, provides this protection and creates the legal platform for launching the global digital online marketplace for copyrighted works." S. Rep. No. 105-190, 105th Cong. 2d Sess. at 2 (May 11, 1998).

independently marketed, non-functional copyrighted work, e.g., streamed sound recordings in Real Networks v. Streambox,[3] motion pictures distributed on DVD in Universal Studios v. Reimerdes,[4] computer games in Sony Computer Entertainment v. Gamemasters[5] and electronic books in United States v. Elcomsoft.[6]

From the face of the Lexmark Complaint, it appears that the allegations in this case are novel, to say the least, and lie beyond the scope of the scenario envisioned by Congress under the DMCA. Here, the object of the technological protection measure is not to prevent piracy of copyrighted works, but instead to protect a market for noncopyrighted consumable goods (lower-priced toner cartridges). Thus, this case presents an important policy question heretofore not addressed by any court, concerning the purpose and application of the DMCA. In our view, application of the DMCA to a claim of this nature would constitute a startling and unwarranted expansion of the scope of the DMCA and Section 1201(a). If Section 1201(a) could be applied to such functional software, Section 1201(a) could be susceptible to widespread abuses across a plethora of industries. For example, could not Section 1201(a), so interpreted, enable automobile manufacturers to prevent competitors from selling replacement oil filters, or tires, that did not have a compatible semiconductor chip? Or photocopy machine manufacturers to prevent use of paper that does not bear the correct watermark? Or computer floppy disks that do not have an authenticating chip indicating that it was made by the manufacturer of the floppy drive? In the context of traditional copyright law, such efforts to extend the reach of the copyright to protect non-copyrighted articles would most assuredly be deemed copyright misuse,

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3 2000 U.S. Dist. LEXIS 1889 (W.D. Wash. 2000).
4 273 F.3d 429 (2d Cir. 2001).
5 87 F. Supp. 2d 976 (N.D. Cal. 1999)
6 See Lisa Bowman, "ElcomSoft verdict: Not guilty," http://news.com.com/2100-1023-978176.html (Dec.

and it simply cannot be that Congress intended to condone similar claims under Section 1201(a).[7] We therefore respectfully submit that the allegations of the complaint merit careful scrutiny as to whether the potent proscriptions of the DMCA should be applied to the claims at issue in this case.

The issues presented in this case are novel and important in another sense. Until now, no cases under the DMCA have interpreted the scope of permissible reverse engineering activities for the purpose of achieving interoperability under section 1201(f). Reverse engineering activities are central to the research and development of virtually all modern industries, from "after-market" replacement auto parts manufacturers to computer software and game developers, and are economically vital to the advancement of technology and the promotion of competition.[8] Court decisions, such as the Ninth Circuit cases of Sega v. Accolade[9] and Sony Computer Entertainment v. Connectix,[10] consistently have upheld reverse engineering as lawful under copyright law and the fair use doctrine. Any decision applying the DMCA in this case could have a substantial and chilling effect on reverse engineering across a broad spectrum of industries, encouraging litigation under the DMCA to prevent competition, and thus discouraging innovation.

17, 2002).

7 See Dan L. Burk, *AntiCircumvention Misuse*, 48 UCLA L. Rev. __ (forthcoming 2003), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=320961

8 See Pamela Samuelson & Suzanne Scothmer, *The Law and Economics of Reverse Engineering*, 111 Yale L.J. 1575, 1630-49 (2002).

9 977 F.2d 1510 (9th Cir. 1993).

10 203 F.3d 596 (9th Cir. 2000).

We therefore respectfully ask this Court to consider very carefully the potential ramifications of applying the DMCA to a case of this nature. In our view, on its face the Complaint does not present the type of case envisioned by Congress to be covered by the DMCA. Should the Court nevertheless determine to address the DMCA claims, we would ask the Court to be mindful of the potential consequences of any decision in this matter for a variety of industries and the public good.

January 30, 2003

Respectfully submitted,

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