

THE SUBPOENA PROVISION OF THE DIGITAL MILLENNIUM COPYRIGHT ACT: A
LEGAL PARADIGM FOR SHIFTING COPYRIGHT JURISPRUDENCE IN RESPONSE TO
AN EVOLVING TECHNOLOGICAL LANDSCAPE

Jude A. Thomas

TABLE OF CONTENTS

INTRODUCTION 2

I. HISTORICAL BACKGROUND 6

 A. *Copyright Law* 6

 B. *The Internet* 14

II. THE DIGITAL MILLENNIUM COPYRIGHT ACT 17

 A. *Overview* 17

 B. *The Subpoena Provision* 21

III. CASES 23

 A. *Printed Advertisements: Fat Wallet v. Best Buy* 24

 1. *Overview* 24

 2. *FatWallet’s Test Case* 27

 B. *File Sharing: RIAA v. Verizon* 29

 1. *The Evolution of File Sharing* 29

 2. *The RIAA’s Test Cases* 31

 3. *File-sharing Cases after Verizon* 37

CONCLUSION 38

APPENDIX A: THE SUBPOENA PROVISION OF THE DIGITAL MILLENNIUM COPYRIGHT ACT 41

APPENDIX B: VERIZON-RIAA TIMELINE 42

THE SUBPOENA PROVISION OF THE DIGITAL MILLENNIUM COPYRIGHT ACT: A
LEGAL PARADIGM FOR SHIFTING COPYRIGHT JURISPRUDENCE IN RESPONSE
TO AN EVOLVING TECHNOLOGICAL LANDSCAPE

Jude A. Thomas

Notions of security and control that may have been exercisable in the non-networked, analog world cannot be effectively transferred to a realm where even a single digital copy can propagate millions of perfect clones, world-wide, almost instantaneously, and where control over the quantity and destiny of the bits that comprise digital media will be imperfect at best.¹

INTRODUCTION

Historically, the American legal system has evolved in response to the growth of technology. A familiar example of this occurrence can be found in the transformation of American jurisprudence that occurred in response to the spread of the Industrial Revolution in the United States during the late nineteenth and early twentieth centuries. The impact of this period of industrialization was reflected in the laws of torts, contracts, property, corporations, labor relations, taxation, and civil procedure, among others.² These changes are illustrated archetypically in the nearly-ubiquitous presence of the railroad industry as an advocate in the prominent legal disputes that characterized this period.³

The significance of the railroad during the Industrial Revolution may be attributed principally to its usefulness as a tool for commerce. Industrialization required a transportation system to exchange property, including raw materials and finished goods, and

1. Letter from Philip S. Corwin, legal counsel for the owner of KaZaA peer-to-peer software, to Senator Joseph R. Biden, Jr. (Feb. 26, 2002), *available at* <http://www.ipuf.org/ipuf/BidenReportLetterBA.htm> (last visited Feb. 12, 2005) (also on file with the author).

2. See JAMES W. ELY, *RAILROADS & AMERICAN LAW* vii (2001).

3. See, e.g., *Palsgraf v. Long Island R.R. Co.*, 248 N.Y. 339 (1928); *Erie R.R. v. Tompkins*, 304 U.S. 64 (1938); *United States v. Pacific Railroad*, 120 U.S. 227 (1887); *Texas and Pacific Railway Company v. Behymer*, 189 U.S. 468 (1903).

the railroad fulfilled this need.⁴ Those who were able utilize the railways in this manner profited substantially, and the magnates of the industry developed considerable political power, which was influential in shaping the legal system.⁵ By the start of the twentieth century, judicial dockets were inundated with cases concerning railroads.⁶

A parallel may be seen in the emergence and spread of the internet over the course of the last twenty-five years.⁷ Just as the railroad served both legally and literally as a vehicle for change during the Industrial Revolution, the internet serves a similar purpose in bringing about changes to our current jurisprudence, in what has been described by some as the Digital Revolution.⁸ In providing a new medium for commercial activity, the internet connects markets and raises unprecedented legal issues in much the same way that the railroad did one hundred years ago.

At its core, the internet is fundamentally a means for the exchange of information, and consequently it is not surprising that one of the areas of law most affected by its growth has been intellectual property law. Patent, trademark, and trade secret laws have all undergone some degree of evolution in response to the emergence and global expansion of

4. See Arthur Donovan, *Intermodal Transportation in Historical Perspective*, 27 *TRANSP. L.J.* 317, 322-25 (2000).

5. See ELY, *supra* note 2, at vii.

6. *Id.* at viii.

7. In accordance with progressive trends, the word “internet” will not be capitalized throughout this work except where it occurs as part of a quotation or a title, e.g., Verizon Internet Services. See, e.g., Tony Long, *It's Just the 'internet' Now*, WIRED NEWS, Aug. 16, 2004, <http://www.wired.com/news/culture/0,1284,64596,00.html> (noting that “Wired News will no longer capitalize the ‘I’ in internet [because] a change . . . was necessary to put into perspective what the internet is: another medium for delivering and receiving information. That it transformed human communication is beyond dispute. But no more so than moveable type did in its day. Or the radio. Or television.”) *Id.*

8. The moniker “Digital Revolution” has been adopted by a host of a scholars and commentators. Louis Rosetto, founder of Wired Magazine, helped to popularize the phrase in 1993 when he observed that “the Digital Revolution is whipping through our lives like a Bengali typhoon [bringing with it] social changes so profound their only parallel is probably the discovery of fire.” Louis Rosetto, WIRED, Mar./Apr. 1993, at 10. See also JACK CHALLONER & JOHN GRIBBIN, *THE DIGITAL REVOLUTION (ESSENTIAL SCIENCE SERIES)* (2002); THOMAS W. KEENAN & WENDY HUI KYONG CHUN, *NEW MEDIA, OLD MEDIA: INTERROGATING THE DIGITAL REVOLUTION* (2003).

the internet, but it may be argued that copyright jurisprudence has felt the strongest growing pains in adapting to this technology. This is largely attributable to the ease with which protected works may be reproduced and distributed via the internet, and the soft jurisdictional boundaries that the internet has created. Lawrence Lessig summarizes this dilemma well: “[f]or the holder of the copyright, cyberspace appears to be the worst of both worlds—a place where the ability to copy could not be better, and where the protection of law could not be worse.”⁹

The evolution of copyright law in the United States has largely been the product of the conflict between those who seek to protect their rights under the law, and those who wish to make the broadest use of the new technologies that have the potential to impact these rights. Most often, the former group is comprised of the creators and distributors of artistic works, and the latter consists of consumers and other end-users of those works. One of the most prominent contemporary legislative enactments that has resulted from this conflict is the Digital Millennium Copyright Act of 1998 (DMCA).¹⁰ In drafting the DMCA, “Congress [sought] to implement United States treaty obligations and to move the nation's copyright law into the digital age.”¹¹ In order to achieve these objectives, Congress attempted to strike a balance that would protect the rights of content owners within the framework of the emerging technological environment without inhibiting the growth of the internet, or, as a California district court noted, “to protect against unlawful piracy and promote the development of electronic commerce and the availability of copyrighted material

9. LAWRENCE LESSIG, CODE AND OTHER LAWS OF CYBERSPACE 125 (1999).

10. Digital Millennium Copyright Act of 1998, Pub. L. No. 105-304, 112 Stat. 2860 (codified as amended in scattered sections of 5, 17, 28, and 35 U.S.C. (2000)) [hereinafter DMCA].

11. United States Copyright Office, Executive Summary Digital Millennium Copyright Act Section 104 Report, para. 1, at http://www.loc.gov/copyright/reports/studies/dmca/dmca_executive.html (last visited Feb. 12, 2005) [hereinafter DMCA Executive Summary].

on the Internet.”¹² The DMCA is framed to meet these goals by providing strong protection for electronic intellectual property rights and by offsetting this protection through the use of several safe harbor provisions broadly defined in 17 U.S.C. § 512 as “Limitations on liability relating to material online.”¹³ These safe harbor provisions essentially serve to immunize online service providers (OSP’s)¹⁴ from liability for copyright violations that occur via their services, providing that these OSP’s meet several delineated obligations.¹⁵

The preponderance of issues that have emerged as the DMCA has been tested in the judiciary are the product of litigation propelled by content owners of entertainment media, particularly the music industry and the motion picture industry. To a lesser extent, the software industry has also been active in this regard. However, the potential reach of the DMCA is broad and it has already been tested in a variety of settings. Particularly illustrative of the DMCA’s potential reach is the subpoena provision, found in 17 U.S.C. § 512(h).¹⁶ This provision provides a judicial shortcut that permits a copyright content owner to secure a subpoena in order to compel an OSP to reveal the identity of an alleged copyright infringer whose purported violations are facilitated through the OSP’s services. The

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

13. 17 U.S.C. § 512(a)-(d) (2000).

14. The phrase “online service provider” is sometimes used interchangeably with the phrase “internet service provider,” or ISP. However, there is a subtle but important distinction between the two. An ISP may be regarded as “[a] business that offers Internet access through a subscriber’s phone line, usually charging the user for the time spent connected to the business’s server.” BLACK’S LAW DICTIONARY 836 (8th ed. 2004). By contrast, an online service provider, or OSP, may be regarded more broadly as “an entity which provides a service online [that] can include ISPs and web sites . . . or message board operators.” WORDIQ.COM, at [http://www.wordiq.com/definition/ Online_service_provider](http://www.wordiq.com/definition/Online_service_provider) (last visited Feb. 12, 2005). Thus, OSP’s are not limited to those providers which offer simply internet access per se. The framers of the DMCA apparently anticipated this: the general term “service provider,” which is used throughout the text of the DMCA, is defined broadly in section 512(k) to include any “entity offering the transmission, routing, or providing of connections for digital online communications, between or among points specified by a user, of material of the user’s choosing, without modification to the content of the material as sent or received” and alternately as “a provider of online services or network access, or the operator of facilities therefor . . .” 17 U.S.C. § 512(k).

15. 17 U.S.C. § 512(a)-(d).

16. *Id.* at § 512(h). The text of the subpoena provision is reproduced in Appendix A, *infra*.

interpretation and constitutionality of this provision has been the subject of significant debate, culminating in several test cases which have recently emerged in the federal courts.

More broadly, the subpoena provision of the DMCA may be viewed as a paradigmatic example of the efforts of a legal system to respond to technological change. As the internet expands, so too will legislation promulgated to address its legal consequences. Correspondingly, as legislation expands, so too will litigation that serves to test, interpret, and refine that legislation. This paper will examine the subpoena provision and the accompanying safe harbor provisions of the DMCA in the broader context of the evolution of copyright law in response to technological change.

I. HISTORICAL BACKGROUND

A. Copyright Law

Copyright law in the United States is substantially based in English law, and hence an overview of the foundations of the English system is necessary to appreciate the principles of American copyright law. The origins of English copyright law extend as far back as the sixteenth century,¹⁷ and the most significant proliferation of this body of law coincided with the introduction of the printing press in England in 1476.¹⁸ Here again, a system of jurisprudence evolved and expanded in response to the emergence of new technology. During this period and up until the late eighteenth century, four embodiments of protection

17. EDWARD C. WALTERSCHEID, *THE NATURE OF THE INTELLECTUAL PROPERTY CLAUSE: A STUDY IN HISTORICAL PERSPECTIVE* 31 n. 3 (2002).

18. 1 HERBERT BROOM & EDWARD A. HADLEY, *COMMENTARIES ON THE LAWS OF ENGLAND* 794 (1875) (noting that prior to the era of printing the necessity for copyright protection "was less, if at all, felt").

for works of authorship emerged, each of which contributed to the formation of the roots of modern English copyright law.¹⁹

In the early sixteenth century, the use of printing patents served as the first such embodiment. These patents were essentially royal grants of the privilege to print designated works or classes of works, and they were issued to printers and booksellers, as well as to private individuals who profited by licensing the grants to others for a fee.²⁰ Such monopolies were often granted by the Crown to reward favored subjects.²¹ Also during this part of the sixteenth century, craft guilds began to emerge, and these were eventually granted the supervision of printing, publishing, binding, and dealing in books.²² This supervisory authority formed the second embodiment of copyright protection during this period. The most prominent of these guilds merged to form the Stationers' Company, which kept a log of works that were protected by copyright.²³ Those who wished to print a work were required to register in the Stationers' log.²⁴ Although segments of the public benefited from the protections inherent in these monopolies, the Crown's underlying purpose in granting them was not to protect property rights, but rather to censor the dissemination of those writings that were considered seditious or heretical.²⁵

19. WALTERSCHEID, *supra* note 17, at 59.

20. *Id.* at 59-60.

21. *Id.*

22. *Id.* at 60.

23. *Id.* at 61. The Stationers' Company has been described as "[a]n association of stationers and their successors, established in London in 1557 and entrusted, by order of the Privy Council, with censorship of the press. This company was the holder of the first rights we associate today with copyright." BLACK'S LAW DICTIONARY 1447 (8th ed. 2004). The general term "stationers" is defined as "[a] person engaged in the book trade as [a] bookseller [or a] publisher." WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 2229 (1986).

24. WALTERSCHEID, *supra* note 17, at 61.

25. GILLIAN DAVIES, COPYRIGHT AND THE PUBLIC INTEREST 10 (Sweet & Maxwell Limited 2d ed. 2002) (1994). The practice of controlling new technology by governments that wish to censor the dissemination of information pervades even today. Both China and Germany have erected national internet firewalls which serve to limit the access of their nationals to certain information that is otherwise available on the internet. China, for example, prohibits access to those materials on the internet which may be characterized as: "subversive of state power or the socialist system; damaging to national unity; inciting discrimination

In 1710, the English Parliament enacted the Statute of Anne,²⁶ the third incarnation of protection for works of authorship to emerge during this period, and the first true statutory embodiment of English copyright law. The Statute of Anne would eventually serve as the basis for modern copyright law.²⁷ The enactment of this Statute may be regarded as a turning point in copyright law because it signified a reallocation of the rights that are protected under copyrights. Prior to the Statute of Anne, the aim of copyright was principally to protect printers and publishers who invested their labors in reproducing valuable manuscripts, and to control the dissemination of writings, as noted above. However, under the Statute, this focus was shifted to protecting the rights of the authors who actually created these works. In part, this was the result of a change in philosophy about the purpose of copyright protection, which is evident in the full title of the Statute itself, the *Act for the Encouragement of Learning*. This title suggests that the Statute of Anne was created not only to prevent piracy and to provide incentives for publishers as earlier forms of copyright law had; it was also designed to protect the rights of authors and to encourage them to invest their talents in the production of useful works.²⁸ Notably, this shift from protecting the rights of the reproducers and distributors of authored works to protecting the rights of the

between nationalities; disturbing to social order; propagating feudal superstition; pornography, gambling or violence; insulting or libelous; or violating the constitution or other laws.” Lawrence B. Solum & Minn Chung, *The Layers Principle: Internet Architecture and the Law*, 79 NOTRE DAME L. REV. 815, 897 (2004). See also Kristina M. Reed, *From the Great Firewall of China to the Berlin Firewall: The Cost of Content Regulation on Internet Commerce*, 12 TRANSNAT’L LAW 543, 546-48 (1999).

26. Act for the Encouragement of Learning, 1710, 8 Ann., c. 19 (Eng.) [hereinafter Statute of Anne]. Although many sources designate the date of enactment of the Statute of Anne as 1709, it has been noted that:

There is frequent confusion as to the date of this statute. It was enacted in the calendar year 1709 and became effective April 10, 1710. But at this time the beginning of the year in England was March 25.

It was not until 1752 that the first of January was designated as the beginning of the year in England [and therefore] [b]y modern usage, the statute was both enacted and became effective in 1710.

WALTERSCHEID, *supra* note 17, at 62 n.121 (citing LYMAN RAY PATTERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE 3 n.3 (1968)).

27. WALTERSCHEID, *supra* note 17, at 62; MARGARET C. JASPER, THE LAW OF COPYRIGHT 1 (2d ed. 2000).

28. See DAVIES, *supra* note 25, at 4-5.

authors themselves was not purely ideological; it may also be attributed to a practical response to the technological changes of the day. In particular, the arrival of the printing press in the fifteenth century significantly diminished the cost of reproducing works of authorship, and for the first time, the value of an author's efforts were measurably greater than the expense of reproducing his work.²⁹ Consequently, the protection of authors' rights became increasingly important. This shift in value of creation over dissemination was likely even more evident following the emergence of the highly-efficient steam-powered printing press during the Industrial Revolution, as this device contributed substantially to the growth of mass-produced printed works.³⁰

Although the Statute of Anne favored authors' rights, it also set forth provisions to prevent the creation of perpetual monopolies in works of authorship so that such works would eventually enter the public domain. This was accomplished by limiting the term of such rights. New works were protected for an initial period of fourteen years, and this could be renewed for an additional fourteen years or the remaining life of the author, whichever was shorter.³¹ Existing works received twenty-one years of protection with no option for renewal.³² Thus, under the Statute of Anne, the maximum term for an author's rights to his work was twenty-eight years.

These limitations conflicted with the view held by some that perpetual copyrights existed under common law, a potential fourth embodiment of protection for works of authorship. Those who favored perpetual copyrights, particularly stationers, asserted that

29. PAUL GOLDSTEIN, *COPYRIGHT'S HIGHWAY* 39 (1994).

30. See Robert Corn-Revere, *New Technology and the First Amendment: Breaking the Cycle of Repression*, 17 HASTINGS COMM. & ENT. L.J. 247, 263 (1994) (noting that the "introduction of steam-powered presses and inexpensive pulp paper in the mid-nineteenth century made possible book and newspaper publication on a mass scale.") *Id.*

31. WALTERSCHEID, *supra* note 17, at 63.

32. *Id.*

common law rights to works of authorship had long existed and continued to exist in spite of the impositions of the Statute of Anne. This view was eventually tested in the celebrated *Millar v. Taylor* case in 1768.³³ Writing for the King’s Bench, Lord Mansfield declared that perpetual property rights in works of authorship based in common law did exist, and that such works would never enter the public domain.³⁴ Lord Mansfield’s rationale lay in the belief that authors “should reap the pecuniary profits of [their] own ingenuity and labor” and “another should not use [the author’s] name without his consent.”³⁵ This decision proved to be ephemeral, however, as it was overruled only five years later by the House of Lords in *Donaldson v. Becker*.³⁶ Following *Donaldson*, the belief was that there was a common law right in works of authorship, but this right was limited by terms defined in the Statute of Anne.³⁷

Copyright protection within the United States dates back to the period immediately following the American Revolution.³⁸ Prior to the ratification of the U.S. Constitution, no federal copyright law existed.³⁹ In 1783, while the Articles of Confederation were still in force, Congress recommended that the states enact copyright laws granting authors and publishers of new books a term of protection of not less than fourteen years.⁴⁰ Twelve of the thirteen states soon did so, and although the substantive aspects of these individual state laws varied, they were all based upon the Statute of Anne.⁴¹ This led to the inclusion of the

33. 98 Eng. Rep. 201 (K.B. 1768) (Mansfield, L.J.), *overruled by* *Donaldson v. Beckett*, 1 Eng. Rep. 837 (H.L. 1774).

34. 98 Eng. Rep. at 252.

35. *Id.*

36. 1 Eng. Rep. 837 (H.L. 1774).

37. WALTERSCHEID, *supra* note 17, at 71 (citing MARK ROSE, *AUTHORS AND OWNERS, THE INVENTION OF COPYRIGHT* 108-110 (Cambridge 1993)).

38. *See* DAVIES, *supra* note 25, at 76.

39. WALTERSCHEID, *supra* note 17, at 31.

40. DAVIES, *supra* note 25, at 76.

41. *Id.*

intellectual property clause in the Constitution four years later, which states: “The Congress shall have power . . . [t]o 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”⁴² Having thus granted Congress the authority to create legislation protective of the works of authors, the Copyright Act of 1790 soon followed.⁴³ The 1790 Act was also modeled after the Statute of Anne, and it provided protection for charts and maps as well as books.⁴⁴ Similarly, it provided the same fourteen-year renewable term granted by the Statute of Anne.⁴⁵ Although the inclusion of a limited term within the 1790 Act was consistent with the language of the intellectual property clause of the Constitution (*supra*), there remained some consensus at this time that a common law right to copyright protection existed in perpetuity.⁴⁶ However, this notion was dismissed by the United States Supreme Court in 1834, in *Wheaton v. Peters*.⁴⁷ Writing for the Court, Justice McLean noted:

[t]hat an author at common law has a property in his manuscript, and may obtain redress against any one who deprives him of it, or by obtaining a copy endeavours to realize a profit by its publication, cannot be doubted; but this is a very different right from that which asserts a perpetual and exclusive property in the future publication of the work, after the author shall have published it to the world.⁴⁸

To the extent that U.S. copyright law was simplified and narrowed by the 1790 Act and the *Wheaton* decision, it was broadened almost continuously thereafter. Following the 1790 Act, copyright law in the United States evolved through numerous amendments that expanded the scope of protection to include prints, musical compositions, public

42. U.S. CONST. art. I, § 8, cl. 8.

43. See Act of May 31, 1790, ch. 15, 1 Stat. 124.

44. DAVIES, *supra* note 25, at 77. See Act of May 31, 1790, ch. 15, 1 Stat. 124 [hereinafter 1790 Act].

45. WALTERSCHEID, *supra* note 17, at 289.

46. *Id.* at 210-09, 231-34.

47. 33 U.S. (8 Pet.) 591 (1834).

48. *Wheaton*, 33 U.S. at 657.

performances of dramatic compositions, photographs, negatives, paintings, drawings, and statues, inter alia.⁴⁹ In addition, the initial term of fourteen years was extended to twenty-eight years with the same fourteen-year renewal term.⁵⁰ These amendments were followed by the enactment of the Copyright Act of 1909,⁵¹ which was largely a codification of these developments.⁵²

The next major revision to copyright law in the United States took place in 1976 with the ratification of a new Copyright Act, which became effective in 1978.⁵³ The 1976 Act was designed to bring U.S. copyright law into conformity with international copyright agreements and to once again expand the subject matter of copyright protection.⁵⁴ Now codified at 17 U.S.C. § 102, the 1976 Act provides protection for a broad array of works, including:

- (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.⁵⁵

Also under the 1976 Act, Congress specifically prohibited state and common law copyrights, making U.S. copyright law purely the subject of federal law.⁵⁶ Furthermore,

49. DAVIES, *supra* note 25, at 81-82.

50. *Id.*

51. Copyright Act of 1909, Pub. L. No. 349, 35 Stat. 1075.

52. DAVIES, *supra* note 25, at 82.

53. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2451 (codified at 17 U.S.C. §§101-801).

54. *See* DAVIES, *supra* note 25, at 83.

55. 17 U.S.C. § 102 (2000).

56. *Id.* at § 301(a). This section states:

On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as

under the new Act, the term of protection was significantly increased, and then further extended by amendment through the Sonny Bono Copyright Term Extension Act of 1998 (CTEA).⁵⁷ Under the CTEA, which is the current law, copyrights exist for the life of the author plus seventy years following the author's death.⁵⁸ Joint works are given protection for the life of the longest surviving author plus seventy years,⁵⁹ and anonymous works, pseudonymous works, and works made for hire are awarded protection for ninety-five years from the year of first publication, or one hundred twenty years from the year of creation, whichever expires first.⁶⁰ Lastly, copyrights already in force prior to 1978 are given twenty-eight years of protection from the date that they were originally secured.⁶¹

In the last twenty-five years, legislators have largely sought to modernize the framework of American copyright law in order to keep pace with technological developments by superimposing new legislation on the 1976 Act.⁶² Recent legislative

specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

Id.

57. Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified as amended at 17 U.S.C. § 302 (2000)).

58. 17 U.S.C. § 302(a).

59. *Id.* at § 302(b).

60. *Id.* at § 302(c). A "work made for hire" is defined as:

- (1) a work prepared by an employee within the scope of his or her employment; or
- (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire. For the purpose of the foregoing sentence, a "supplementary work" is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes, and an "instructional text" is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.

Id. at § 101.

61. *Id.* at § 304(a).

62. The 1976 Act remains the core of U.S. copyright law, but it has been amended numerous times, often through provisions commensurate with technological changes. For a comprehensive description of congressional amendments to the 1976 Act, see 1 WILLIAM F. PATRY, COPYRIGHT LAW AND PRACTICE 89-120 (1994 & Supp. 2000).

enactments include the Audio Home Recording Act of 1992,⁶³ the Digital Performance Rights in Sound Recordings Act of 1995,⁶⁴ the Fairness in Music Licensing Act of 1998,⁶⁵ the Digital Millennium Copyright Act of 1998,⁶⁶ the Intellectual Property and Communications Omnibus Reform Act of 1999 (contained in the Consolidated Appropriations Act of 2000),⁶⁷ the Small Webcaster Settlement Act of 2002,⁶⁸ and the Satellite Home Viewer Extension and Reauthorization Act of 2004 (contained in the Consolidated Appropriations Act of 2005).⁶⁹

B. The Internet

It is evident from the forgoing that historic changes in copyright law may be largely attributed to three factors: first, the desire of copyright-holders to increase their property rights through extended terms of protection; second, the need to expand the scope of copyright protection to account for additional forms of artistic content not previously protected; and third, the necessary evolution of intellectual property law in response to the impact of emerging technology. To a certain extent, these three factors may overlap; for example, the desire to expand both the permissible term and the scope of protection of copyright law is commonly voiced by right-holders and their lobbyists. Similarly, unprecedented forms of artistic content are commonly the products of new technologies, and thus the latter two factors are often synonymous.

63. Pub. L. No. 102-563, 106 Stat. 4242 (codified as amended at 17 U.S.C. §§ 1001-1010 (1994)).

64. Pub. L. No. 104-39, 109 Stat. 336 (1995) (codified as amended in scattered sections of 17 U.S.C. (2000)).

65. Pub. L. No. 105-298, 112 Stat. 2827 (codified as amended in scattered sections of 17 U.S.C. (2000)).

66. DMCA, *supra* note 10.

67. Pub. L. No. 106-113, 113 Stat. 1501 (to be codified in scattered sections of 17 U.S.C.).

68. Pub. L. No. 107-321, 116 Stat. 2780 (to be codified at 17 U.S.C. § 114(f), (g)).

69. Pub. L. No. 108-447, 118 Stat. 2809 (to be codified in scattered sections of 17 and 47 U.S.C.)

Presently, the most significant of these factors is the third. Technology in developed and developing nations is expanding rapidly, and copyright law is expanding with it. Justice Stevens recognized this principle in the seminal 1984 case *Sony Corp. of America v. Universal Studios, Inc.*, in which he stated:

[f]rom its beginning, the law of copyright has developed in response to significant changes in technology. Indeed, it was the invention of a new form of copying equipment—the printing press—that gave rise to the original need for copyright protection. Repeatedly, as new developments have occurred in this country, it has been the Congress that has fashioned the new rules that new technology made necessary.⁷⁰

Today, this is largely illustrated by the legislature’s attempt to remodel copyright law specifically to adapt to the rapid expansion of digital technology.⁷¹ This is evident from the nature of the recent amendments to the 1976 Act which are noted above. Digital technology is integral to the operation of everything from satellite communications to CD players. Absent this technology, there would be no DVD’s, no digital cameras, no satellite radio, and no high-definition television signals, to name a few. Perhaps most significantly, digital technology is the technology that drives the internet.

The internet has its roots in a United States government defense project known as the Advanced Research Agency Project Network (ARAPNET), which began in 1969.⁷² ARAPNET was designed to create an expansive computer network consisting of a series of decentralized computer hubs that would be immune to outside attack, functioning on the principle that if one hub went down, information could be re-routed through the other

70. 464 U.S. 417, 430-31 (1984) (footnotes omitted).

71. Digital technology is “any technology that breaks information down into tiny parts, representing each part as a series of zeroes and ones. Information in a digital format can be transmitted much more quickly and cheaply, copied much more accurately, and manipulated much more easily than analog data.” WHY? Learning Lab, What is Digital Technology?, available at <http://www.why.org/learninglab/digitaltech.htm> (last visited Feb. 12, 2005).

72. GERALD R. FERRERA ET AL., CYBERLAW: TEXT AND CASES 3 (2001).

hubs.⁷³ By the mid-1970's, the internet had expanded to include many additional networks and several other countries, and by the late 1980's ARPANET was phased out and the internet became a tool for public use.⁷⁴ A new program for the exchange of information on the internet known as the WorldWideWeb Project was first proposed in 1990 by Tim Berners-Lee, a computer scientist who worked at CERN (the European Laboratory for Particle Physics).⁷⁵ Berners-Lee's work led to the development of the first graphical browser designed to interface with the World Wide Web in 1991, and in 1992 commercial activity on the internet was authorized for the first time.⁷⁶ The latter two developments vastly expanded the amount and variety of content that could be exchanged on the internet—including copyright-protected content.

The modern internet consists of a plethora of individual networks linked via fiber optic telephone lines, cable lines, wireless networks, and satellites.⁷⁷ Like all digital technology, the internet operates through digital transmissions represented by ones and zeros, which form strings of data.⁷⁸ This data is broken up and travels through the internet in small packets, a technique which serves to reduce the quantity of data which must be re-sent if a network error occurs.⁷⁹ Upon arrival at its destination, the data is reassembled to its intended form, which may be the content of a website, an email message, or a file such as an image, an audio recording, a video, or a piece of software.

73. SCOTT W. PINK, *THE INTERNET & E-COMMERCE LEGAL HANDBOOK* 14 (2001).

74. FERRERA ET AL., *supra* note 72, at 3.

75. PINK, *supra* note 73, at 16. Berners-Lee's proposal has been preserved, at <http://groups-beta.google.com/group/alt.hypertext/msg/395f282a67a1916c> (last visited Feb. 12, 2005).

76. PINK, *supra* note 73, at 16; FERRERA ET AL., *supra* note 72, at 4.

77. FERRERA ET AL., *supra* note 72, at 4. Presently, it is estimated that over 817 million people have access to the internet worldwide, an increase of 126.4% in the last five years. Internet World Stats, World Internet Usage and Population Statistics, at <http://www.internetworldstats.com/stats.htm> (last visited Feb. 12, 2005).

78. FERRERA ET AL., *supra* note 72, at 6.

79. *Id.* at 7.

In order for such data to reach its intended destination, it must be assigned a header, which is a short string of data that contains source and destination address information.⁸⁰ In turn, every computer on the internet is assigned a unique numerical identifier known as an internet protocol (IP) address.⁸¹ IP addresses serve to identify individual computers and make it possible for computers to locate one another on the internet. These addresses consist of four numeric strings ranging from 0 to 255, separated by periods, for example, 66.12.65.30. A portion of each IP address represents the network which the computer utilizes, and the remaining portion identifies the individual machine. In the above example, the first three numerals, 66.12.65, represent the company which provides the network (in this case, Verizon Internet Services), and the final number, 30, represents the individual computer. In relation to copyright law, this can be very significant because often the only way for a copyright holder to identify a potential infringer is through that user's IP address.⁸²

II. THE DIGITAL MILLENNIUM COPYRIGHT ACT

A. Overview

80. *See Id.* at 6.

81. *Id.* at 4.

82. Generally, internet service providers assign IP addresses to their individual subscribers, and these addresses may be assigned either permanently as static IP addresses or transiently as dynamic IP addresses. In the latter case, a user's IP address may change (be reassigned) every time the user disconnects from the internet, e.g., by shutting down his or her computer. Service providers can determine which IP address is assigned to an individual user on the provider's network at any time, but this information is typically not available to the public. Thus, a third party could determine that 66.12.65 is part of a block of Verizon IP addresses, but the party would not be able to determine which subscriber was specifically assigned the individual IP address 66.12.65.30. In this sense, users of the internet are anonymous.

The DMCA has been described as “undoubtedly the most important and far-reaching legislation to be adopted since the 1976 Act.”⁸³ As previously noted, Congress drafted the DMCA with two goals in mind: first, to bring the United States into compliance with international treaty obligations; and second, to amend domestic copyright law to better suit the changing landscape of technology.⁸⁴ Specifically, the DMCA was enacted in order to “make the necessary changes to the U.S. copyright law to enable the United States of America to ratify the WIPO Copyright Treaty and the WIPO Performers and Phonograms Treaty and to update the law to meet the needs of the Internet era.”⁸⁵

The DMCA was first introduced by the U.S. House of Representatives in July 1997 as the WIPO Copyright Treaty Implementation Act (WIPOCTIA),⁸⁶ and later reintroduced in its expanded form as the DMCA, in June 1998.⁸⁷ The bill was passed by the House in August 1998 and the Senate passed a substitute bill in September 1998.⁸⁸ The final joint version of the bill was passed and signed into law by President Clinton on October 28, 1998.⁸⁹

The DMCA is divided into five titles: Titles I and II make up the bulk of the DMCA and they are the most relevant to the discussion that follows; Title III is a short section dedicated to copyright issues that arise during the repair or maintenance of a computer; Title IV contains miscellaneous housekeeping and modernization provisions; and Title V is

83. DAVIES, *supra* note 25, at 94.

84. See DMCA Executive Summary, *supra* note 11, at para. 1.

85. DAVIES, *supra* note 25, at 91.

86. H.R. 2281, 105th Cong. (1997).

87. H.R. 2281, 105th Cong. (1998) (enacted).

88. S. 2307, 105th Cong. (1998).

89. A detailed legislative history of the DMCA may be found on the Library of Congress’ Thomas website, at <http://thomas.loc.gov/cgi-bin/bdquery/z?d105:HR02281:@@L|TOM:/bss/d105query.html> (last visited Feb. 12, 2005).

dedicated to unrelated measures that were pending before the House Judiciary Committee at the time the DMCA was proposed in the House.⁹⁰

Title I, known as the “WIPO Copyright and Performances and Phonograms Treaties Implementation Act of 1998,” serves to implement the WIPO copyright treaties. The most significant section of Title I contains the anti-circumvention provisions, now codified under new chapter twelve of Title 17.⁹¹ These provisions prohibit the circumvention of technological measures employed to prevent unauthorized access to and copying of copyrighted works. For example, DVD movies contain encryption software designed to prevent the copying of motion pictures and other media contained on DVD’s. This software essentially transforms the media content (e.g., motion picture) that is stored on a DVD into gibberish, which can only be decrypted by electronic devices that contain the proper software decryption keys. The unauthorized act of unraveling this encryption software in order to copy a DVD is a circumvention technique prohibited under Title I.

Title II contains the aforementioned safe harbor provisions of the DMCA, codified in amendments to chapter five of Title 17.⁹² These provisions create four broad limitations on liability for copyright infringement by OSP’s.⁹³ The first of these provisions, which falls under section 512(a), limits the liability of an OSP in circumstances where communications through the provider’s server are merely transitory; that is, where the OSP simply acts as a conduit of data, transmitting digital information from one point to another at a user’s request.⁹⁴ Instant messages exchanged between users of programs like AOL Instant

90. See generally THE DIGITAL MILLENNIUM COPYRIGHT ACT OF 1998, U.S. COPYRIGHT OFFICE SUMMARY (1998), available at <http://www.copyright.gov/legislation/dmca.pdf> (last visited Feb. 12, 2005) [hereinafter DMCA COPYRIGHT OFFICE SUMMARY].

91. 17 U.S.C. § 1201 (2000).

92. *Id.* at § 512(a), (b), (c), and (d).

93. *Id.*

94. DMCA COPYRIGHT OFFICE SUMMARY, *supra* note 90, at 10.

Messenger, Microsoft Windows Messenger, and Yahoo! Messenger are simple examples of this activity; messages are routed through OSPs from one user to another, but are not stored on any OSP's server.

The second safe harbor provision, contained in section 512(b), provides an exception for system caching. When employed by an OSP, system caching is the practice of storing frequently-accessed content on an OSP's server for a limited time, in order to facilitate more rapid transmission to users.⁹⁵ For example, an OSP might store the images and text that comprise a popular website's start page, e.g., www.amazon.com, so that users can access this information directly from their OSP's server, rather than being routed to Amazon's server to obtain this data.

The third safe harbor provision, contained in section 512(c), provides limitations to OSP liability in the event that infringing material is stored on an OSP's server at the direction of a user and without the knowledge of the OSP.⁹⁶ This provision immunizes the OSP, but only if that provider: (1) is not aware of the infringing material; (2) is not benefiting financially from the existence of the infringing material on its server, and (3) promptly removes or blocks access to the infringing material when properly notified of its existence.⁹⁷

The last safe harbor provision, contained in section 512(d), provides liability limitations for hyperlinks, online directories, and search engines.⁹⁸ Essentially, this provision insulates an OSP from liability when it hosts information that directs users to other sites that contain infringing material. For example, when a website served by an OSP contains a link to another website where a copy of a protected work is located, such as an

95. *Id.*

96. *Id.* at 11.

97. *Id.* at 12.

98. *Id.* at 12-13.

audio or movie file, the OSP will not be liable for providing links to the infringing work. This safe harbor provision is limited according to rules similar to those found in 512(c).⁹⁹ Thus, in order to escape liability, an OSP must not be aware that a hosted link, directory, or search engine is pointing to work that is infringing, it must not profit from the existence of the infringing item to the extent that it has control of the infringing item, and it must promptly block access to that item once it has been properly made aware of the infringing material.¹⁰⁰

With the exception of 512(a), all of the safe harbor provisions contain an identical “takedown and notice” clause, which serves to immunizes OSPs from liability, providing that they “remove, or disable access to, the material that is claimed to be infringing.”¹⁰¹ Thus, when a copyright holder makes a good faith assertion objecting to the presence of purportedly infringing material that is hosted by an OSP, the OSP can escape liability by simply removing or blocking access to the material. This safety-valve clause is apparently absent from 512(a) for practical reasons: it would not be possible for an OSP to block or remove access to infringing information that is only moving transitorily through its servers.

B. The Subpoena Provision

In addition to the safe harbor provisions, Title II contains the subpoena provision of the DMCA, attached *infra* as Appendix A.¹⁰² This provision sets forth a procedure through which the owner of a copyright can request a federal court to issue a subpoena to an OSP to

99. DMCA COPYRIGHT OFFICE SUMMARY, *supra* note 90, at 12-13.

100. *Id.*

101. 17 U.S.C. § 512(b)(2)(E), (c)(1)(C), (d)(3).

102. *Id.* at § 512(h).

reveal the identity of an allegedly infringing user of that service.¹⁰³ Although the subpoena provision was ostensibly included in the DMCA to protect OSP's from liability when their users misbehave, it also has the effect of providing an abbreviated process for the issuance of a subpoena with minimal judicial oversight, which some OSP's find objectionable. Absent the subpoena provision, copyright owners and their agents who wish to ascertain the identity of an alleged anonymous infringer must follow the arguably more-cumbersome procedural approach of first filing a traditional lawsuit against the alleged infringer before they can seek a subpoena to identify that alleged infringer. In order to withstand a challenge to standing, a complainant filing a suit in this manner must substantiate its case before a judge before the subpoena can be issued, a process which requires more time and expense than the approach offered under section 512(h). Further, when confronted with subpoenas issued under section 512(h), OSP's may find themselves pressured to reveal the personal information of their users, based upon little more than a claim by the party seeking the subpoena that infringement is occurring.

The requirements to obtain a subpoena under section 512(h) are minimal; the copyright owner or its agent need only file: (1) a request to the clerk of any federal district court to issue the subpoena; (2) a notice describing the claimed infringement; (3) a proposed subpoena directed to the OSP; and (4) a sworn declaration "that the purpose for which the subpoena is sought is to obtain the identity of an alleged infringer and that such information will only be used for the purpose of protecting rights under..." Title 17.¹⁰⁴ If these

103. *Id.*

104. *Id.* Provisions regarding the form which the notice describing the claimed infringement must take are particularized in 17 U.S.C. § 512(c)(3)(A).

requirements are met, “the clerk shall expeditiously issue and sign the proposed subpoena and return it to the requester for delivery to the service provider.”¹⁰⁵

Although the requirements to obtain a subpoena under section 512(h) are diminutive, they are significant in disputes which arise over subpoenas issued in this manner. A defendant OSP served with such a subpoena has essentially two options: it may either claim immunity through the safe harbor provisions of sections 512(a)-(d), or challenge the validity of the subpoena by asserting that the requirements were not properly met. For example, the fourth requirement, described in section 512(h)(2)(c), states that the subpoena must be sought for the purpose of protecting copyrights.¹⁰⁶ If a defendant OSP can demonstrate that the allegedly infringing material does not meet the requirements of the 1976 Act to qualify as copyrightable subject matter, the complainant’s subpoena may be quashed.

III. CASES

A substantial number of cases have emerged in the judiciary to question the reach, application, and constitutionality of the various provisions of the DMCA.¹⁰⁷ Where issues concerning the subpoena provision have been the subject of such disputes, the cases have largely involved the exchange of copyright-protected music on the internet via file-sharing software, and thus the music industry has been the focus of the media’s attention in these matters. However, not all disputes concerning section 512(h) have been the product of disagreements involving the entertainment industry. The wide breadth of subject matter

105. *Id* at § 512(h)(4).

106. *Id* at § 512(h)(2)(c).

107. *E.g.*, *Lexmark Intern., Inc. v. Static Control Components, Inc.*, 387 F.3d 522 (6th Cir. 2004); *321 Studios v. Metro Goldwyn Mayer Studios, Inc.*, 307 F. Supp. 2d 1085 (N.D. Cal. 2004); *United States v. Elcom Ltd.*, 203 F. Supp. 2d 1111 (N.D. Cal. 2002); *Davidson & Associates, Inc. v. Internet Gateway, Inc.*, 334 F. Supp. 2d 1164 (E.D. Mo. 2004).

which may be protected by copyright has lead other content owners to test the subpoena provision as well.

A. Printed Advertisements: Fat Wallet v. Best Buy

1. Overview. – In 2002, a David and Goliath-style dispute arose between several large, national retailers and an OSP with a substantial presence on the internet, known as FatWallet, Inc.¹⁰⁸. FatWallet is a venue for consumer-to-consumer communication and business-to-consumer communication, and it provides a variety of online services serving the interests of bargain-hunting shoppers, including information about rebates, coupons, and sale items.¹⁰⁹ One of the most popular of these services is FatWallet’s forums, which allow users of the service to post information about deals that they have discovered, so that other users can take advantage of the same deals. This posted content is hosted on FatWallet’s servers, and in this sense, FatWallet operates as an OSP under the definitions provided in section 512(k) of the DMCA.¹¹⁰

In November 2002, FatWallet ran afoul of several retailers including Wal-Mart, Best Buy, Kmart, Target, and Jo-Ann Stores, when users of the FatWallet forums posted leaked information about upcoming “Black Friday”¹¹¹ sales advertisements, prior to the official

108. FatWallet (www.fatwallet.com) is a privately held corporation founded and solely-owned by Tim Storm, who reports that the company’s users have earned millions of dollars in cash back through its services. The company began in December 1999 as Mr. Storm’s part-time hobby, and it has grown to twenty-five employees. Email from Tim Storm, Owner, FatWallet, Inc., to the author (Feb. 13, 2005, 17:56 EST) (on file with the author).

109. See Press Release, Megan E. Gray et al., FatWallet Challenges Abusive DMCA Claims and Protects Users’ Privacy Rights (Dec. 2, 2003), available at http://www.law.berkeley.edu/cenpro/samuels/papers/pressreleases/FatWallet_PR_120202.pdf (last visited Feb. 12, 2005) (on file with the author). FatWallet states that its “mission is to serve consumers with knowledge, value and guidance. It’s like having a QUARTER MILLION friends to ask advice from, and all the rebates and coupons to make it happen at the lowest possible price.” FatWallet, General F.A.Q., available at <http://www.fatwallet.com/support/faqs.php#faq24> (last visited Feb. 12, 2005).

110. 17 U.S.C. § 512(k)(1). See also *supra* note 14 and accompanying text.

111. “Black Friday” is the popular name for the day after Thanksgiving in the United States, which is typically one of the busiest retail shopping days of the year. It is regarded by many as the official beginning of the Christmas shopping season. The term “black” in the name derives from the idea that it is the day when

release of those advertisements by the retailers.¹¹² The retailers served FatWallet with takedown notices pursuant to section 512(c), which requires that “upon notification of claimed infringement [the OSP must] respond . . . expeditiously to remove, or disable access to, the material that is claimed to be infringing or to be the subject of infringing activity” if the OSP wishes to claim the benefit of the safe harbor provisions within this section.¹¹³ In addition, Wal-Mart served FatWallet with a DMCA subpoena issued by an Illinois district court, commanding FatWallet to produce “information sufficient to identify the alleged infringer who posted the material described in the notification attached hereto, including for example that person’s name, address, telephone number, and email address.”¹¹⁴ FatWallet complied with the takedown notice, “even though it vehemently disputed the retailers’ claim that such factual information is protected by the Copyright Act.”¹¹⁵

In addition, FatWallet demanded that Wal-Mart withdraw its subpoena, and further sought damages for Wal-Mart’s knowingly false assertion of copyright under section 512(f) of the DMCA.¹¹⁶ Section 512(f) provides remedies for users and OSP’s accused of infringement when copyright holders materially misrepresent facts in their infringement claims.¹¹⁷ If the defendant OSP or user can demonstrate that such misrepresentation exists,

retailers traditionally get back “in the black” after operating “in the red” during the previous months. See WIKIPEDIA, at [http://en.wikipedia.org/wiki/Black_Friday_\(shopping\)](http://en.wikipedia.org/wiki/Black_Friday_(shopping)) (last visited Feb. 12, 2005).

112. Complaint for Declaratory Relief at para. 16, *FatWallet, Inc. v. Best Buy*, 2004 WL 793548 (N.D. Ill. 2004) (No. 03C50508), available at 2003 WL 23472176 [hereinafter *FatWallet Complaint*].

113. 17 U.S.C. § 512(c)(1)(C).

114. Copies of the subpoena and related correspondence are available at <http://www.fatwallet.com/forums/messageview.php?start=0&catid=18&threadid=129657> (last visited Feb. 12, 2005) (on file with author) [hereinafter subpoena materials].

115. *FatWallet Complaint* at para. 17.

116. *FatWallet Victorious in Challenge to Wal-Mart’s Frivolous Digital Millennium Copyright Act Subpoena*, ASCRIBE, Dec. 5, 2002, available at <http://www.nyfairuse.org/dmca/walmart.fw.xhtml>. See also subpoena materials, *supra* note 114 (containing correspondence by FatWallet’s attorney requesting that Wal-Mart withdraw its subpoena).

117. 17 U.S.C. 512(f).

the copyright holder may be held liable for “damages, including costs and attorney’s fees.”¹¹⁸

As previously noted, the subpoena provision requires the party seeking the subpoena to provide a bona fide assertion that the information demanded therein is sought only to protect legitimate copyright interests.¹¹⁹ FatWallet informed Wal-Mart that the information posted on its servers did not constitute material subject to copyright, citing the celebrated United States Supreme Court case *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*¹²⁰. *Feist* stands for the proposition that factual information, absent any original, creative arrangement, cannot constitute the subject matter of copyright.¹²¹ Since the posted information about which the retailers complained did not “constitute virtual verbatim reproductions of [the] advertising circulars . . .” and did not “contain any of the formatting, arrangement, or other content of the advertising circulars,” FatWallet argued that it was not protected by copyright law.¹²² Had the FatWallet users posted actual copies of the advertisements, their acts might have constituted infringement. However, the anonymous users had merely posted price lists for items that would purportedly be on sale on Black Friday, and these lists constituted merely factual information. If FatWallet could prove this in a court of law, it could also claim damages for Wal-Mart’s misrepresentation under 512(f). Faced with these assertions and with threats by FatWallet to file a motion to quash the subpoena, Wal-Mart withdrew its subpoena.¹²³

118. *Id.*

119. *Id.* at 512(h)(2).

120. 499 U.S. 340 (1991).

121. *Id.* at 364-65.

122. FatWallet Complaint, *supra* note 112, at para. 29.

123. *Id.* at para. 17.

2. *FatWallet's Test Case.* - One year later, the cycle repeated itself. Following the appearance of more Black Friday sales information in FatWallet's forums in November 2003, Best Buy sent a takedown notice to FatWallet and obtained a subpoena under 512(h) to compel FatWallet to reveal the identities of the allegedly infringing users who had posted the information in FatWallet's forums.¹²⁴ FatWallet objected to both the takedown notices and to the subpoena and it soon received additional takedown notices from two other retailers, Kohl's and Target.¹²⁵ Once again, FatWallet complied with the takedown notices, but disputed the claims.¹²⁶ While the subpoena was still pending, however, FatWallet filed an action against the retailers in a federal court, asserting that their repeated threats and misuse of the DMCA violated the statutory rights of FatWallet and its anonymous users.¹²⁷ Anticipating that the annual cycle would continue repeatedly, FatWallet sought a declaratory judgment that the materials posted in its forums were "not protected by copyright law and/or [were] not infringing, and that the takedown notices and related subpoena were and are invalid and void."¹²⁸ FatWallet further sought a declaration that: (1) the DMCA provisions authorizing the takedown notices were violative of Article III and the First and Fifth Amendments of the U.S. Constitution; and (2) the subpoenas issued were violative of the DMCA and Federal Rules of Civil Procedure as well as the Due Process Clause of the Fifth Amendment.¹²⁹

While FatWallet's complaint was pending before the court, Best Buy withdrew its subpoena. At the same time, the three retailers filed motions with the court to dismiss

124. *Id.* at para. 19.

125. *Id.* at paras. 21-23.

126. *Id.* at para. 24.

127. FatWallet Complaint, *supra* note 112, at para. 1.

128. *Id.* at para. 3.

129. *Id.*

FatWallet's complaint for lack of standing under Federal Rule of Civil Procedure 12(b)(1).¹³⁰ This proved to be fatal to FatWallet's case, which was dismissed in a memorandum opinion by the court.¹³¹ Writing for the court, Judge Reinhard noted that under the case or controversy clause of the United States Constitution,¹³² a plaintiff will not be awarded standing to litigate a case unless that plaintiff can allege a personal stake in the outcome of that case.¹³³ Because FatWallet had complied with the takedown notices, it had availed itself of the safe harbor provisions of the DMCA, and it was no longer in jeopardy.¹³⁴ Additionally, Best Buy had withdrawn its 512(h) subpoena, and thus the court found no injury which it was capable of redressing.¹³⁵ In regard to FatWallet's concerns about the likelihood of being served with future takedown notices from retailers, Judge Reinhard commented:

An [OSP] suffers no adverse consequences under the DMCA for its failure to abide by the [takedown] notice. It is free to thumb its nose at the notice and it will suffer no penalty nor increased risk of copyright liability. Thus, plaintiff was in no worse a position regarding potential copyright liability for the postings of its subscribers whether it responded to the notice or not . . .¹³⁶

Although Judge Reinhard's decision was unfortunate for FatWallet and it puts FatWallet in the difficult position of having to put itself in harm's way before it can test the

130. FatWallet, Inc. v. Best Buy, 2004 WL 793548, at *1 (N.D. Ill. 2004).

131. *Id.*

132. The case or controversy clause of Article III states:

The judicial power shall extend to all cases, in law and equity, arising under this Constitution, the laws of the United States, and treaties made, or which shall be made, under their authority;--to all cases affecting ambassadors, other public ministers and consuls;--to all cases of admiralty and maritime jurisdiction;--to controversies to which the United States shall be a party;--to controversies between two or more states;--between a state and citizens of another state;-- between citizens of different states;--between citizens of the same state claiming lands under grants of different states, and between a state, or the citizens thereof, and foreign states, citizens or subjects.

U.S. CONST. art. III., § 2, cl. 1.

133. *Id.* (citing Discovery House, Inc. v. Consolidated City of Indianapolis, 319 F.3d 277, 279 (7th Circ. 2003)).

134. *FatWallet*, 2004 WL 793548, at *2.

135. *Id.* at *3.

136. *Id.* at *2.

retailers' claims, it is logical. If, in fact, the material posted in FatWallet's forums was not capable of protection under copyright law, then the retailers' DMCA claims, and for that matter, all of their copyright claims, would collapse. However, FatWallet's real burden is that it will have to seek legal counsel every time it receives a takedown notice in order to weigh the risk that the DMCA claims are bona fide, and if litigation results and the trier of fact reaches an untoward decision, FatWallet and its users would be liable for potentially substantial damages.

FatWallet also leaves unresolved the constitutional challenges that were raised in the case, a theme common to other DMCA cases, discussed in part below. Although the *FatWallet* case was ultimately dismissed for lack of standing, it does demonstrate the usefulness of the subpoena provision to an OSP accused of contributing to infringement by its users. Had Best Buy not withdrawn its subpoena, it is likely that the retailer would have been forced to litigate the case on the merits, and it is quite possible that FatWallet would have prevailed on its misrepresentation claim, if nothing else.

B. File Sharing: RIAA v. Verizon

1. The Evolution of File Sharing. – The activity of offering digital copies of sound recordings, software, and other media—also known as file sharing—first became popular in the late 1990's.¹³⁷ This was largely facilitated by the emergence of a piece of software known as Napster, designed for this purpose and created by a college student named Shawn Fanning.¹³⁸ Napster was an early peer-to-peer (P2P) program, which functioned by allowing

137. See Recording Indus. Ass'n of Am., Inc. v. Verizon Internet Servs., Inc., 351 F.3d 1229, 1231 (D.C. Cir. 2003), *cert. denied*, 125 S. Ct. 309 (2004).

138. See Maggie A. Lange, *Digital Music Distribution Technologies Challenge Copyright Law: A Review of RIAA v. MP3.com and RIAA v. Napster*, 45 BOSTON BAR J. 14 (2001). Lange sets the record straight, noting:

users to peer into one another's hard drives to locate and obtain music files.¹³⁹ The growth of Napster was extraordinary: the program became available to the online public in 1999 and quickly grew to 200,000 users.¹⁴⁰ Within a year, Napster had accumulated a stunning 40 million subscribers.¹⁴¹ This growth quickly gained the interest of record companies and music publishers, particularly because the Napster software was designed specifically to share music files.¹⁴² Threatened with the mass duplication of its copyrighted music files, members of the music industry launched a suit against Napster, eventually obtaining an injunction which shut down the service.¹⁴³ Napster's "Achilles heal" lay in the fact that although no files were located on its central server, users were routed through its server where it kept a directory of the files that existed on the hard drives of other users.¹⁴⁴ The Ninth Circuit held that this constituted contributory and vicarious copyright infringement, and it upheld the lower court's order to shut down Napster.¹⁴⁵

The file-sharing community soon responded by producing a second and third generation of P2P applications, which did not rely on centralized servers.¹⁴⁶ The music industry quickly turned its attention to the producers of these applications, but the

"Shawn's software was actually developed with the help of others. It was not created in his dorm room at one sitting, but over a period of time in many places, including his uncle's software company." *Id.*

139. SIVA VAIDHYANATHAN, COPYRIGHTS AND COPYWRONGS 179 (2001).

140. *Id.*

141. JESSICA LITMAN, DIGITAL COPYRIGHT 104 (2001).

142. See VAIDHYANATHAN, *supra* note 139, at 179.

143. See *A&M Records, Inc. v. Napster, Inc.*, 284 F.3d 1091 (9th Cir. 2002); *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004 (9th Cir. 2001).

144. Garrett Friedman, *P2P: Then, Now and the Future*, SLYCK NEWS, at para. 3-4 (Feb. 23, 2004), at <http://www.slyck.com/news.php?story=407> (last visited Feb. 12, 2005).

145. *A&M Records, Inc. v. Napster, Inc.*, 284 F.3d at 1095. Notably, Napster was later purchased by a member of the music industry and it has reemerged as "Napster 2.0," a fee-based music download service, which "has extensive content agreements with the five major record labels, as well as hundreds of independents." See Napster Company Information, About Napster, at http://www.napster.com/about_napster.html (last visited Feb. 12, 2005).

146. A program known as Gnutella was the most well-known among the second generation of P2P software, but it was slow and had several security issues, hence it was quickly replaced by third generation P2P programs that were more secure and more efficient. Friedman, *supra* note 144, at para. 4.

decentralized design proved to immunize the designers of the new P2P programs from liability. Such was the case in *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, in which a district court granted summary judgment to two defendant P2P companies that had been sued by the music and movie industries for direct, vicarious, and contributory copyright infringement resulting from the use of their software.¹⁴⁷ The *Grokster* court noted:

unlike in *Napster*, there is no admissible evidence before the Court indicating that Defendants have the ability to supervise and control the infringing conduct (all of which occurs after the product has passed to end-users). The doctrine of vicarious infringement does not contemplate liability based upon the fact that a product could be made such that it is less susceptible to unlawful use, where no control over the user of the product exists. Accordingly, there are no genuine issues of fact material to this claim, and summary judgment is appropriate.¹⁴⁸

Following the dissolution of *Napster* in 2001 and the subsequent emergence of decentralized P2P applications, the music industry, lead by the Recording Industry Association of America (RIAA),¹⁴⁹ changed tactics and began looking for a new tool to protect copyrighted music from the file-sharing public. The RIAA found this tool in the previously-untested subpoena provision of the DMCA, which, ostensibly, would permit the music industry to target individual users in a quick, inexpensive manner characterized by minimal judicial oversight.

2. *The RIAA's Test Cases.* – The RIAA launched its opening salvo in July 2002,¹⁵⁰ when it issued its first subpoena to Verizon Internet Services, a subsidiary of the

147. 259 F. Supp. 2d 1029, 1045 (C.D. Cal. 2003), *cert. granted*, 125 S. Ct. 686 (2004).

148. *Id.* Notably, in December 2004, the United States Supreme Court granted certiorari in this case. In doing so, the Court stands poised to reconsider its twenty-one year old decision in the celebrated case *Sony Corp. of America v. Universal Studios, Inc.*, 464 U.S. 417 (1984). In *Sony*, the Supreme Court held that Sony was not responsible for copyright violations committed by users of its Betamax video recorders, noting that the technology had significant noninfringing uses. *Id.*

149. The RIAA is “the industry trade association for sound and music recordings, whose members create and distribute the overwhelming majority of all music sold in the United States. [The] RIAA is authorized to enforce the copyrights of its members.” *In re Verizon Internet Servs., Inc.*, 240 F. Supp. 2d 24, 26 (D.D.C. 2003) [hereinafter *Verizon I*].

150. For a summary of the Verizon-RIAA timeline, refer to Appendix B at the conclusion of this work.

telecommunications giant Verizon Communications, Inc.¹⁵¹. The subpoena relied upon section 512(h) of the DMCA, and through it the RIAA sought to obtain the identity of an anonymous, alleged copyright infringer who was a subscriber to Verizon's service.¹⁵² The subscriber, who utilized third generation P2P software known as KaZaA, had drawn the attention of the RIAA by allegedly making more than six hundred songs available to other internet users in a single day.¹⁵³ The RIAA provided Verizon with the subscriber's IP address, a list of the files which the subscriber had made available, and the time and date when those files were downloaded by other internet users.¹⁵⁴

Verizon refused to comply with the subpoena.¹⁵⁵ As a major online service provider, Verizon had much to lose if it established itself as a provider that would perfunctorily reveal the identity of any subscriber to its service who had been accused of copyright infringement. In a letter in response to the subpoena, Verizon asserted its view that the subpoena provision was only applicable in cases where infringing materials were actually *stored* on the server or network of the provider.¹⁵⁶ In support of this view, Verizon cited the first of the safe harbor provisions of the DMCA, which states, in part:

Transitory digital network communications. -- A service provider shall not be liable . . . for infringement of copyright by reason of the provider's transmitting, routing, or providing [Internet] connections for, material through a system or network controlled or operated by or for the service provider, or by reason of the *intermediate and transient* storage of that material in the course of such transmitting, routing, or providing connections . . .¹⁵⁷

151. Verizon Communications and its subsidiaries are the largest wireline and wireless communications providers in the United States. See Verizon Communications company profile, at <http://investor.verizon.com/profile/>. Further, Verizon is one of the ten largest internet service providers in the United States, accounting for over 2.9 million subscribers. Alex Goldman, *Top 23 U.S. ISPs by Subscriber: Q2 2004*, ISP PLANET, Sept. 2, 2004, at <http://www.isp-planet.com/research/rankings/usa.html>.

152. *Verizon I*, 240 F. Supp. 2d at 26.

153. *Id.* at 28.

154. *Id.*

155. *Id.*

156. *Id.* at 29 (emphasis added).

157. *Id.* at 27 (citing 17 U.S.C. § 512(a)(2000) (alteration in original) (emphasis added)).

Verizon noted that because KaZaA was a decentralized P2P program, the allegedly-shared music files were stored entirely on the hardware of the anonymous user, and therefore no copy or list of the files existed at any central location associated with Verizon.¹⁵⁸ Verizon argued that any files which might have been shared by the user had passed only transiently through its own network, and such acts did not render Verizon vulnerable to the subpoena provision.¹⁵⁹ Further, Verizon maintained that the RIAA need not rely on the subpoena provision to obtain relief because they had an alternative remedy available in their ability to institute a “John Doe” suit, which would serve the same purpose while providing greater judicial oversight.¹⁶⁰

Undaunted, the RIAA moved to enforce the subpoena,¹⁶¹ and in a memorandum opinion (*Verizon I*) the United States District Court for the District of Columbia granted the motion and ordered Verizon to comply with the subpoena.¹⁶² In reaching this decision, the district court approached the issue solely as one of statutory interpretation: it sought to determine whether the scope of the subpoena provision was broad enough to reach all online service providers, including those providers that did not actually store any files on their networks.¹⁶³ Writing for the court, Judge Bates analyzed the statutory construction of the subpoena provision in light of Congress’ legislative intent in drafting the DMCA, and found

158. See *Verizon I*, 240 F. Supp 2d at 28-29.

159. See *Id.*

160. *Id.* at 39-40. For purposes of copyright infringement, a John Doe suit is an action in which: (1) a complaint is filed in a federal court against a “John Doe” (an alleged, anonymous infringer); (2) the court serves a third-party subpoena on the internet service provider under the Federal Rules of Civil Procedure Rule 45; and (3) the internet service provider notifies its customer of the lawsuit. *Id.* For an analysis of the third-party reach of Rule 45, see *Linder v. Calero-Portocarrero*, 251 F. 3d 178 (D.C. Cir. 2001) (which states: “[i]n authorizing parties to serve subpoenas on ‘persons’ who are not parties to litigation, Rule 45 states: ‘Every subpoena shall . . . command each person to whom it is directed to attend and give testimony or to produce and permit inspection and copying’ of documents or tangible things.” *Id.* (citing Fed. R. Civ. P. 45(a)(1)(C)).

161. Subpoena Enforcement Matter, *Verizon I*, 240 F. Supp 2d 24 (No. 1:02MS00323).

162. *Verizon I*, 240 F. Supp 2d at 26.

163. *Id.*

Verizon’s reading of the statute to be “strained” and “at odds with the design of Congress,” which had “peppered [language] throughout subsection (h) indicating that the subpoena process should be ‘expeditious.’”¹⁶⁴ Further, Judge Bates noted that the John Doe approach would be far more complex and burdensome to copyright holders than filing “occasional enforcement actions for DMCA subpoenas,” in light of the additional “effort and expense associated with pursuing such John Doe suits in court.”¹⁶⁵

Although constitutional challenges to section 512(h) had also been asserted in briefs by amici curiae, Verizon did not develop these issues and hence the court did not reach them.¹⁶⁶ However, Judge Bates did note that he could not detect any “obviously fatal constitutional flaw . . .” in the exercise of the subpoena provision of the DMCA.¹⁶⁷

Verizon quickly appealed the district court’s decision, and simultaneously moved to stay the court’s order to reveal the identity of the subscriber, pending the resolution of the appeal. Only four days later, the RIAA kept Verizon on its toes by issuing a second subpoena pursuant to section 512(h), seeking the identity of yet another alleged infringer.¹⁶⁸ Verizon filed a motion to quash this subpoena as well, this time properly raising constitutional issues.¹⁶⁹ In this second case (*Verizon II*), Verizon argued that the district court lacked jurisdiction to issue the subpoena under the case or controversy requirement of Article III, because the formulaic requirements of section 512(h) of the DMCA permitted the issuance of judicial process, yet did not require that any elements of a legal cause of action be

164. *Id.* at 32, 35.

165. *Id.* at 40. Despite this apparent burden, it is notable that as of this writing, the RIAA has filed over 8,000 John Doe law suits against individuals since it began doing so in 2003. *RIAA Nails More People*, P2PNET, at <http://p2pnet.net/story/3708> (Jan. 29, 2005) (last visited Feb. 12, 2005).

166. *Verizon I*, 240 F. Supp 2d at 41-42.

167. *Id.* at 45.

168. *See Id.*

169. Verizon Internet Services Inc.'s Brief In Support Of Its Motion To Quash at 13, In re Verizon Internet Servs., Inc., 257 F. Supp. 2d 244 (D.D.C. 2003) (No. 1:03MS00040), *available at* http://www.eff.org/legal/cases/RIAA_v_Verizon (last visited Feb. 12, 2005).

alleged.¹⁷⁰ Verizon also argued that section 512(h) was violative of the First Amendment because it provided “insufficient procedural protection for expressive and associational rights and because it [was] vastly overbroad as interpreted by the RIAA.”¹⁷¹ The district court rejected both of these arguments and once again ordered Verizon to reveal the identity of the alleged copyright infringer.¹⁷² Verizon appealed this decision as well, and the Court of Appeals for the District of Columbia consolidated the two cases stemming from the subpoenas.¹⁷³

In December 2003, the D.C. Court of Appeals reversed in favor of Verizon solely on the basis of statutory interpretation, without reaching the constitutional issues that Verizon had raised.¹⁷⁴ The court held that the statute was clear in establishing that a subpoena may *not* be issued to an OSP that serves only as a conduit for data sent to others.¹⁷⁵ Further, the court noted that the legislative history of the DMCA demonstrated no anticipation by its framers that internet users might be able to exchange files directly, since P2P software did not exist when the DMCA was drafted.¹⁷⁶ The court concluded: “[w]e are not unsympathetic either to the RIAA's concern regarding the widespread infringement of its members' copyrights, or to the need for legal tools to protect those rights. It is not the province of the courts, however, to rewrite the DMCA in order to make it fit a new and unforeseen internet architecture, no matter how damaging that development has been to the music industry.”¹⁷⁷

170. *Id.*

171. *Id.* at 19.

172. *See In re Verizon Internet Servs., Inc.*, 257 F. Supp. 2d 244 (D.D.C. 2003) [hereinafter *Verizon II*].

173. *RIAA v. Verizon*, 351 F.3d at 1233.

174. *Id.* at 1231.

175. *Id.* at 1237.

176. *Id.* at 1238. *But see* RAYMOND T. NIMMER & HOLLY K. TOWLE, *THE LAW OF ELECTRONIC COMMERCIAL TRANSACTIONS* § 8.04[6] (2004) (stating that this “is true, but Congress did know about e-mails and files that could be transmitted containing infringing material, so the reasoning is not persuasive as to what Congress intended as to transmitted materials”).

177. *RIAA v. Verizon*, 351 F.3d at 1238.

The court also noted that since it had accepted Verizon's interpretation of the DMCA, it need not reach the constitutional issues raised under Article III or the First Amendment.¹⁷⁸

In May 2004, the RIAA filed a petition for writ of certiorari in the United States Supreme Court.¹⁷⁹ Subsequently, Verizon filed its opposition to the petition and simultaneously filed a conditional cross-petition for certiorari, requesting that the Supreme Court also consider the constitutional issues that Verizon had raised in the lower court, if the Court granted RIAA's petition for certiorari to address the issue of statutory interpretation.¹⁸⁰ Amicus briefs were filed by numerous public and private interests for both sides, and on October 12th, 2004, the Supreme Court denied the RIAA's petition.¹⁸¹

Ultimately, the Supreme Court's decision may be at best a minor victory for Verizon and its subscribers. Though favorable to Verizon, the decision holds only persuasive value for other circuits in suggesting that the subpoena provision is to be applied narrowly. If the RIAA continues to use John Doe suits to discover the names of alleged infringers, Verizon's subscribers may gain the benefit of greater legal protection in the form of the judicial oversight incumbent upon this approach. However, the RIAA's widespread use of John Doe suits would seem to indicate that this approach has been deemed successful by the RIAA, albeit probably more expensive than utilizing the subpoena provision, and there are indications that the RIAA will continue to rely on this approach at least until a new legislative tool emerges.¹⁸² Whether the John Doe suits are actually effective in deterring

178. *Id.* at 1231.

179. *RIAA v. Verizon*, No. 03-1579, 2004 WL 1175134.

180. *RIAA v. Verizon*, No. 03-1579, 2004 WL 1466645.

181. 125 S. Ct. 309 (2004).

182. Following the Supreme Court's decision, RIAA senior vice president of legal affairs Stanley Pierre-Louis stated: "[t]oday's decision will not deter our ongoing anti-piracy efforts. The 'John Doe' litigation process we have successfully utilized this year continues to be an effective legal tool." Roy Mark, *High Court Bounces Latest RIAA Effort*, INTERNETNEWS.COM, Oct. 12, 2004, at <http://www.internetnews.com/bus-news/article.php/>. The RIAA reiterated this sentiment in January 2005, stating "[f]or the past year, we have successfully utilized

would-be copyright infringers is arguable. In a recent study conducted at the University of California, researchers noted:

reports in the popular media suggest a significant decrease in peer-to-peer (P2P) file-sharing traffic, attributed to the public's response to legal threats . . . [however, w]e find that, if measured accurately, P2P traffic has never declined; indeed we have never seen the proportion of p2p traffic decrease over time (any change is an increase) in any of our data sources.¹⁸³

In addition, a new generation of P2P applications have begun to appear that implement file encryption that prevents third parties from ascertaining the nature of the file that is being transferred, and some of these newer applications are also capable of concealing the user's IP address.¹⁸⁴ If these applications prove to be successful, the RIAA will have to change tactics yet again, although it is difficult to imagine how the RIAA might succeed if it is able prove neither the identity of an alleged infringer nor the nature of the files shared by that user.

3. *File-sharing Cases after Verizon*. – Since the D.C. Court of Appeals' decision in favor of Verizon and the Supreme Court's denial of certiorari, the RIAA has filed motions to enforce subpoenas in other jurisdictions. In January 2005, the United States Court of Appeals for the Eighth Circuit became the first Circuit Court since *RIAA v. Verizon* to render a decision on a DMCA subpoena.¹⁸⁵ The court's decision involved a subpoena enforcement matter between the RIAA and Charter Communications, Inc., a major telecommunications company and OSP.¹⁸⁶ The Eight Circuit held simply: "[w]e agree with and adopt the

the 'John Doe' litigation process to sue thousands of illegal file sharers . . . [o]ur enforcement efforts won't miss a beat." *U.S. Appeals Court Quashes Subpoenas for Charter Subscribers*, BLOOMBERG NEWS, Jan. 4, 2005, available at http://www.bloomberg.com/apps/news?pid=10000103&sid=a0sCSInA_RrA&refer=us.

183. Thomas Karagiannis, et al., *Is P2P Dying or Just Hiding?* Nov. 2004, available at <http://www.caida.org/outreach/papers/2004/p2p-dying/p2p-dying.pdf> (last visited Feb. 12, 2005).

184. Friedman, *supra* note 144, at para. 8.

185. *In re: Charter Communications, Inc., Subpoena Enforcement Matter (Appeal of Charter Communications, Inc.)*, 393 F.3d 771 (8th Cir. 2005).

186. *In re: Charter Communications, Inc.*, 393 F.3d 771.

reasoning of the United States Court of Appeals for the District of Columbia Circuit in *Verizon* as it pertains to this statutory issue.” Like the *Verizon* court, the Eighth Circuit reversed a lower court’s decision to enforce a DMCA subpoena on the grounds of statutory construction, but declined to reach the constitutional issues raised by the parties.¹⁸⁷

CONCLUSION

One of the constants of copyright law is the reality that new technology increasingly facilitates the free exchange of information, and this exchange threatens copyrights. Because of this, copyright law must evolve with technology, and to do so, legislation that can bridge the gap must be periodically enacted. Inevitably, such legislation will lead to disagreement among those whose rights are likely to be altered by the emerging technology and by the subsequent legislation, and in some cases these disagreements will result in legal disputes.

Perhaps the broader view is to regard skirmishes over new legislation such as the subpoena provision as the natural distillation that must occur in the judiciary, in order to cultivate a stable system of jurisprudence in response to societal changes, including those changes that are the products of emerging technology. It has been argued that this system is flawed, however, because the lobbying power of entities like the RIAA tip the legislative balance in favor of the copyright content owners at the expense of the public:

“[n]o solution will seriously address the public’s interests unless the public sits at the negotiating table and insists that it do so. That is supposed to be Congress’s job, of course. Congress is the public’s copyright lawyer. Yet . . . Congress lacks the interest, expertise, and institutional money to represent the public . . . and [it] has found significant political benefits in deferring to the interests the legislation affects.”¹⁸⁸

187. *Id.* at 777.

188. LITMAN, *supra* note 141, at 74.

To an extent, it is true that the public gets left out of the equation in the legislative-drafting phase. Even in the judiciary, the public's interest may not be the force that compels litigants to take sides. Certainly in *FatWallet* and *Verizon*, it is likely that the public's interest was more of a legal justification than a motivation for the actions of the OSP's. *FatWallet* and *Verizon* may genuinely respect the rights of their customers, but both have substantial financial interests to protect as well, and alienating their customers would not serve these interests. It is far more likely that the private interests of the OSP's were the incentive for their zealous advocacy on behalf of the consumer public.

Despite this, the interests of the public are ultimately protected in the judicial phase. In *FatWallet*, the court dismissed the OSP's suit as non-justiciable for lack of standing. In doing so, the court served the public interest by permitting the issue to further percolate in the judiciary and in the legislature. A decision on the merits with no immediate injury to redress would be nothing more than an advisory opinion, and this is not the role of the judiciary. Although no precedent was established in the case, the parties on both sides had the opportunity to test the law, and if they return to court, it will be with sharper focus and greater certainty.

In *Verizon*, the OSP successfully defended a costly suit against the very powerful RIAA, an act very likely beyond the means of the average file-sharing member of the public. Although the court never reached the constitutional issues, the effect of its decision was largely the same as what it would have been *had* it reached those issues: the public was protected from the "expeditious" subpoena provision under circumstances where its application might well have trampled upon the protections afforded under the case or controversy clause of Article III of the Constitution.

The DMCA is still a relatively young piece of legislation, and it is certainly not perfect. A court may well decide one day that the procedural shortcuts inherent in the subpoena provision, though efficient and drafted in good faith, also violate the constitutional rights of defendants subjected to claims filed under the DMCA. In the meantime, a body of judicial precedent is developing and the legislature has been granted a certain degree of perspective which it was not afforded when the DMCA was drafted.

APPENDICES

APPENDIX A: THE SUBPOENA PROVISION OF THE DIGITAL MILLENNIUM COPYRIGHT ACT 17 U.S.C. §512(h)(2000)

(h) SUBPOENA TO IDENTIFY INFRINGER

- (1) REQUEST.—A copyright owner or a person authorized to act on the owner’s behalf may request the clerk of any United States district court to issue a subpoena to a service provider for identification of an alleged infringer in accordance with this subsection.
- (2) CONTENTS OF REQUEST.—The request may be made by filing with the clerk—
 - a. a copy of a notification described in subsection (c)(3)(A);
 - b. a proposed subpoena; and
 - c. a sworn declaration to the effect that the purpose for which the subpoena is sought is to obtain the identity of an alleged infringer and that such information will only be used for the purpose of protecting rights under this title.
- (3) CONTENTS OF SUBPOENA.—The subpoena shall authorize and order the service provider receiving the notification and the subpoena to expeditiously disclose to the copyright owner or person authorized by the copyright owner information sufficient to identify the alleged infringer of the material described in the notification to the extent such information is available to the service provider.
- (4) BASIS FOR GRANTING SUBPOENA.—If the notification filed satisfies the provisions of subsection (c)(3)(A), the proposed subpoena is in proper form, and the accompanying declaration is properly executed, the clerk shall expeditiously issue and sign the proposed subpoena and return it to the requester for delivery to the service provider.
- (5) ACTIONS OF SERVICE PROVIDER RECEIVING SUBPOENA.— Upon receipt of the issued subpoena, either accompanying or subsequent to the receipt of a notification described in subsection (c)(3)(A), the service provider shall expeditiously disclose to the copyright owner or person authorized by the copyright owner the information required by the subpoena, notwithstanding any other provision of law and regardless of whether the service provider responds to the notification.
- (6) RULES APPLICABLE TO SUBPOENA.—Unless otherwise provided by this section or by applicable rules of the court, the procedure for issuance and delivery of the subpoena, and the remedies for noncompliance with the subpoena, shall be governed to the greatest extent practicable by those provisions of the Federal Rules of Civil Procedure governing the issuance, service, and enforcement of a subpoena duces tecum.

APPENDIX B: VERIZON-RIAA TIMELINE



