

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

United States District Court
Northern District of California

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

IN RE DMCA SUBPOENA TO REDDIT,
INC.

Case No. 19-mc-80005-SK (JD)

ORDER RE MOTION TO QUASH

Darkspilver, a pseudonymous user of Reddit, the online social media and discussion site, seeks review of a magistrate judge’s decision denying a motion to quash a subpoena issued under the Digital Millennium Copyright Act (“DMCA”), 17 U.S.C. § 512(h). The Watch Tower Bible and Tract Society of Pennsylvania (“Watch Tower”) served the subpoena on Reddit to uncover Darkspilver’s identity after he posted images of Watch Tower documents to criticize its fundraising and data collection practices. The Electronic Frontier Foundation (“EFF”) filed a motion to quash the subpoena on Darkspilver’s behalf, which Reddit joined. Dkt. Nos. 8, 14. A magistrate judge denied the motion, with the qualification that Reddit produce the identifying information on an attorney’s eyes-only basis. Dkt. No. 18.

Darkspilver did not consent to the magistrate judge’s jurisdiction, and so the decision is a non-final report and recommendation subject to a de novo review. The Court concludes that the Reddit postings were a non-infringing fair use of copyrighted works. Consequently, the Court declines to adopt the recommendation, and grants the motion to quash.

BACKGROUND

The salient facts are largely undisputed. Watch Tower is the headquarters of the Jehovah’s Witnesses. It publishes and widely distributes religious periodicals such as “The Watchtower” magazine to disseminate its teachings and interpretations of the Bible. As the Supreme Court has

1 observed, Jehovah’s Witnesses “take literally the mandate of the Scriptures, ‘Go ye into all the
2 world, and preach the gospel to every creature,’” *Murdock v. Pennsylvania*, 319 U.S. 105, 108
3 (1943) (quoting Mark 16:15), and have prosecuted a number of landmark cases championing the
4 First Amendment rights of freedom of expression, association, and religion. *See Watchtower*
5 *Bible & Tract Society of New York, Inc. v. Village of Stratton*, 536 U.S. 150, 160-63 (2002).

6 Darkspilver is a “foreign citizen” who lives outside of the United States. *See* Dkt. No. 8-1
7 ¶ 6. Although Darkspilver’s gender is not in evidence, the prior proceedings used “he” as the
8 applicable pronoun, and the Court will do the same. Darkspilver states that he was raised as a
9 Jehovah’s Witness and is a practitioner today, but has “issues” with “aspects of the organization’s
10 teachings and practices.” *Id.* ¶ 3. To explore those concerns, he participated in a Reddit
11 discussion forum directed to former Jehovah’s Witnesses. *Id.* ¶ 5. Although he does not consider
12 himself a former member, he joined the forum for the freedom to “discuss and debate matters
13 related to the Jehovah’s Witnesses” without exposing his true identity. *Id.* He valued the
14 anonymity because he was deeply concerned about being ostracized, shunned, or disfellowshipped
15 by the Jehovah’s Witness community for voicing criticisms or doubts about the organization. *Id.*
16 ¶ 4; *see also Paul v. Watchtower Bible & Tract Society of New York, Inc.*, 819 F.2d 875, 876-77
17 (9th Cir. 1987) (detailing the Jehovah’s Witnesses’ rules and practices of disfellowship and
18 shunning).

19 In August 2018, Darkspilver posted two items that triggered the subpoena. One item was
20 an image of a solicitation for donations on the back cover of the November 2018 edition of “The
21 Watchtower” magazine. Dkt. No. 8-2. The solicitation -- which was captioned “What Gift Can
22 We Give to Jehovah?” -- quoted Scripture on making contributions and described how to donate
23 online. *Id.* Darkspilver believed the solicitation was an advertisement that represented a
24 commercialized approach to fundraising at odds with traditional teachings of the Jehovah’s
25 Witnesses. Dkt. No. 8-1 ¶ 9. He posted the image “to spark discussion about the organization’s
26 tone, message, and fundraising practices.” *Id.* He states that he did not receive any money or
27 realize any commercial gain from this posting. *Id.*

28

1 The second item was a screenshot of a chart describing the types of information Watch
2 Tower collected, along with citations to the European Union data privacy laws. Dkt. No. 8-4. The
3 apparent purpose of the chart was to summarize how European data collection and disclosure
4 requirements applied to personal information, advance medical directives, recordings of meetings,
5 judicial committee proceedings, and other Watch Tower records. *Id.* No actual names or other
6 personally identifying information were disclosed in the chart. *Id.* Darkspilver reformatted and
7 edited the chart to make it more readable in the post. Dkt. No. 8-1 ¶ 10; Dkt. Nos. 8-4
8 (reformatted chart), 8-5 (original chart).

9 Darkspilver states that he posted the chart out of concerns about the scope of the personal
10 and other data maintained by Watch Tower. Dkt. No. 8-1 ¶ 11. He wanted to alert members to
11 the wide range of information Watch Tower collected, and how Watch Tower stored those
12 records. *Id.* He was particularly concerned about the treatment of abuse complaints, and worried
13 that too many of those records were being deleted. *Id.* Darkspilver did not expressly state that he
14 did not receive money or commercial gain from this posting, but Watch Tower does not contend
15 that he did, and nothing in the record shows otherwise.

16 In December 2018, Watch Tower launched proceedings under the DMCA to obtain
17 Darkspilver's identity. It sent a "take down" notice to Reddit under Section 512(c)(3) of the
18 DMCA, which allows a copyright holder to notify an internet service provider of an unauthorized
19 use of protected material, and to request that it be removed from the website. Dkt. No. 2, Exh. 1.
20 Reddit removed the solicitation ad in response to the letter, and Darkspilver voluntarily took down
21 the chart. Dkt. No. 27 (Aug. 1, 2019 Hearing Tr.) at 28:4-12. Darkspilver states that he has
22 stopped posting on the Reddit forum. Dkt. No. 8-1 ¶ 12.

23 In January 2019, Watch Tower requested a subpoena to Reddit under the DMCA. Dkt.
24 No. 1. Section 512(h) allows a copyright holder to "request the clerk of any United States district
25 court to issue a subpoena to a service provider for identification of an alleged infringer in
26 accordance with this subsection." 17 U.S.C. § 512(h)(1). Watch Tower represented that it had
27 satisfied all the subsection's requirements and held copyrights for the solicitation ad and chart.
28 Dkt. No. 1. At that time, Watch Tower held a Certificate of Registration issued by the United

1 States Copyright Office in October 2018 for the November 2018 magazine as a collective work.
2 U.S. Copyright Reg. No. TX0008614505 (filed Oct. 10, 2018). But Watch Tower did not have a
3 Certificate of Registration for the chart, and did not get one until July 2019. *See* U.S. Copyright
4 Reg. No. TX0008747858 (filed July 17, 2019). It obtained this certificate while the motion for
5 review was pending. *Id.*; *see also* Dkt. No. 27 (Aug. 1, 2019 Hearing Tr.) at 14:17-19.

6 The subpoena request was filed on its own and not in conjunction with a lawsuit. Watch
7 Tower has not sued Darkspilver for copyright infringement or any other claim. Under our
8 district's operating procedures, the freestanding subpoena request was designated a miscellaneous
9 or "mc" action, and randomly assigned to a magistrate judge. The Clerk served on Watch Tower a
10 standard form requiring it to consent to or decline magistrate judge jurisdiction for all purposes,
11 including the entry of a final judgment directly appealable to the Ninth Circuit. Watch Tower
12 filed a response consenting to have a magistrate judge handle all proceedings in the case. Dkt. No.
13 5. The Clerk issued the subpoena. Dkt. No. 7; *see also* 17 U.S.C. § 512(h)(4) (directing clerk of
14 court to issue DMCA subpoena).

15 All of these events happened while Watch Tower was the sole party of record. Darkspilver
16 did not appear until after Reddit advised him that it had received the subpoena and EFF filed the
17 motion to quash on his behalf. Dkt. No. 8. The docket does not indicate that Darkspilver or his
18 counsel at EFF were given the consent-or-declination form for magistrate judge jurisdiction, and
19 the record as a whole does not show that they did, in fact, ever expressly consent. The question of
20 consent was not discussed at the motion to quash hearing before the magistrate judge, or in the
21 ensuing written order. *See* Dkt. Nos. 17 (May 5, 2019 recorded hearing), 18 (Order).

22 The magistrate judge declined to quash the subpoena. Dkt. No. 18. Although the
23 subpoena request was issued for copyright purposes under the DMCA, the magistrate judge
24 framed the issue as a matter of First Amendment rights for anonymous online speech. The
25 magistrate judge applied a two-part test developed in anonymous speech cases. *Id.* at 9 (citing
26 *Highfields Capital Management L.P. v. Doe*, 385 F. Supp. 2d 969, 975-76 (N.D. Cal. 2005), and
27 *Art of Living Foundation v. Does 1-10*, No. 10-cv-05022-LHK, 2011 WL 5444622, at *7 (N.D.
28 Cal. Nov. 9, 2011)). Under this approach, the court determines whether the subpoenaing party has

1 made a prima facie showing of the claim for which disclosure is sought, and if so, the balance of
2 harms to the competing interests caused by granting or denying the subpoena. *Id.*

3 The magistrate judge found that Watch Tower had made a prima facie case for copyright
4 infringement of the solicitation page because it held a copyright registration for the magazine and
5 Darkspilver had copied it. *Id.* at 10. The magistrate judge found no prima facie case for the chart
6 because it was not registered, and questioned whether “the chart meets the minimum standards of
7 originality required for copyright protection.” *Id.* at 11. For the balance of harms, the magistrate
8 judge determined that Darkspilver had established a likelihood that disclosing his identity would
9 chill his speech and expose him to ostracism by other Jehovah’s Witnesses. *Id.* at 12-13. In
10 weighing possible harm to Watch Tower, the magistrate judge turned to copyright law to
11 determine that Darkspilver had made fair use of the ad, and that Watch Tower faced no likelihood
12 of harm as a result. *Id.* at 16-17. The magistrate judge concluded that the balance of harms tips
13 “sharply in Darkspilver’s favor.” *Id.* at 17.

14 Even so, the magistrate judge let the subpoena go forward. The magistrate judge noted
15 that Watch Tower might have been harmed by loss of visitors to its website after the Reddit
16 postings. *Id.* The magistrate judge was “hesitant” to terminate the subpoena before Watch Tower
17 had an opportunity to develop this element, and so enforced the subpoena subject to the
18 qualification that access to the information identifying Darkspilver would be limited to the
19 “attorneys of record.” *Id.* This provision was intended to alleviate Darkspilver’s fear of
20 ostracism. *Id.*

21 Darkspilver filed a motion seeking de novo review of the magistrate judge’s decision. Dkt.
22 No. 20. Watch Tower opposes any review of the decision by the Court. Dkt. No. 21. Both sides
23 briefed the copyright issues and other merits of the motion to quash, and orally argued their cause
24 to the Court. Dkt. Nos. 20, 21, 23, 25.

25 DISCUSSION

26 I. JURISDICTION AND STANDARD OF REVIEW

27 A threshold question is whether this Court should review the magistrate judge’s decision,
28 or whether Darkspilver should have appealed to the Ninth Circuit. The first step in answering this

1 question is to determine whether the motion to quash was a dispositive or non-dispositive motion.

2 A motion to quash typically involves a subpoena for discovery in connection with a
3 pending lawsuit. In that situation, the motion is non-dispositive because it disposes of an ancillary
4 discovery issue, and not a party's claim or defense. *See Flam v. Flam*, 788 F.3d 1043, 1046 (9th
5 Cir. 2015).

6 This case is different. Watch Tower obtained the subpoena on a freestanding basis
7 independent of a complaint or litigation. In effect, the subpoena is its own civil case, and the
8 motion to quash is dispositive of the sole issue presented in the case -- whether the subpoena
9 should be enforced or not. Once that question is answered, the dispute between the parties is fully
10 decided. Darkspilver agrees that the motion to quash was a dispositive motion. *See* Dkt. No. 20 at
11 2-3; Dkt. No. 23 at 2-3. Watch Tower does not meaningfully contest this point. *See* Dkt. No. 21
12 at 7-8. The Court's independent evaluation of the functional effect of the motion confirms that it
13 is dispositive of the only issue in this litigation. *See Flam*, 788 F.3d at 1046.

14 This determination matters because the procedures for reviewing a magistrate judge's
15 decision depend on whether the parties consented to entry of a dispositive order. Magistrate judge
16 jurisdiction is set by statute. With consent of all of the parties, a magistrate judge may "conduct
17 any or all proceedings in a jury or nonjury civil matter and order the entry of judgment in the
18 case." 28 U.S.C. § 636(c)(1). In that situation, the magistrate judge files dispositive orders that
19 may be appealed directly to the court of appeals upon entry of final judgment. *Id.* § 636(c)(3). In
20 the absence of consent by all the parties, a magistrate judge may hear all pretrial matters but may
21 address dispositive issues only in the form of a report and recommendation to a district judge, and
22 not in a final order or judgment. 28 U.S.C. § 636(b)(1)(B)-(C). In this circumstance, the parties
23 may challenge the report and recommendation before a district judge. *Id.* § 636(b)(1). The district
24 judge then makes a de novo determination about the report and recommendation, and "may accept,
25 reject, or modify, in whole or in part," the magistrate judge's proposed disposition. *Id.*

26 Consent is disputed here. The record shows that Watch Tower expressly consented to
27 magistrate judge jurisdiction for all purposes, and that Darkspilver never expressly gave his
28 consent. That might seem to be the end of the matter because the magistrate judge's jurisdiction to

1 enter a dispositive order under Section 636(c) depends on consent from all the parties. *See*
2 *Anderson v. Woodcreek Venture Ltd.*, 351 F.3d 911, 914 (9th Cir. 2003). But Watch Tower raises
3 the wrinkle of implied consent to Section 636(c) jurisdiction under *Roell v. Withrow*, 538 U.S. 580
4 (2003). The Supreme Court found that consent to magistrate judge jurisdiction may be established
5 “through actions rather than words” when “the litigant or counsel was made aware of the need for
6 consent and the right to refuse it, and still voluntarily appeared to try the case before the
7 Magistrate Judge.” *Roell*, 538 U.S. at 589-90.

8 Watch Tower reads *Roell* broadly, but our circuit has construed it to mean “that voluntary
9 consent could be implied in limited, exceptional circumstances.” *Anderson*, 351 F.3d at 915.
10 *Roell* did not displace the “stringent requirement” that a “clear and unambiguous expression of
11 consent is required to vest the magistrate with authority under subsection (c)” of Section 636. *Id.*
12 (quoting *Alaniz v. Cal. Processors, Inc.*, 690 F.2d 717, 720 (9th Cir. 1982)). Darkspilver did not
13 make that clear expression. To the contrary, he has consistently denied giving consent. *See, e.g.*,
14 Dkt. No. 23 at 4; Dkt. No. 27 (Aug. 1, 2019 Hearing Tr.) at 5:7.

15 This case does not have any of the extraordinary circumstances that established implied
16 consent in *Roell*. The Supreme Court found implied consent because the defendants had been
17 advised of their right to proceed before a district judge, had “stood silent” when the magistrate
18 judge repeatedly stated her understanding that all the parties had consented to her jurisdiction, and
19 remained without protest before the magistrate judge through a jury verdict in their favor. *Roell*,
20 538 U.S. at 583-84 and n.1.

21 None of that happened here. The record shows that Darkspilver’s consent was never
22 confirmed or explored by the magistrate judge, and the docket does not indicate that he was ever
23 advised of the right to appear before a district judge via a consent-or-declination form, or any
24 other means. *See Roell*, 538 U.S. at 591 and n.7. The record is also devoid of any evidence that
25 might support an inference of consent on the basis of gamesmanship in “waiting for the outcome”
26 before contesting the magistrate judge’s authority. *Id.* at 590.

1 Consequently, in the absence of express or implied consent by Darkspilver, magistrate
2 judge jurisdiction was never created under Section 636(c). As a result, the order on the motion to
3 quash is best treated as a report and recommendation under 28 U.S.C. § 636(b)(1)(B). *See Flam*,
4 788 F.3d at 1046-47; *Allen v. Meyer*, 755 F.3d 866, 869 (9th Cir. 2014). The Court will review it
5 de novo, 28 U.S.C. § 636(b)(1), but would reach the same conclusions under the more deferential
6 review for a non-dispositive order, *id.* § 636(b)(1)(A). The parties have had a full and fair
7 opportunity to file objections to, and argue for and against, the order. *See id.* § 636(b)(1).

8 **II. THE MOTION TO QUASH**

9 This case is all about copyright law rights and privileges. The parties and the magistrate
10 judge gave substantial attention to Watch Tower’s copyrights and fair use, but took on additional
11 complications raised by the application of the First Amendment to anonymous online speech.
12 This was not really necessary to address freedom of expression concerns because “copyright law
13 contains built-in First Amendment accommodations.” *Eldred v. Ashcroft*, 537 U.S. 186, 219-20
14 (2003). The doctrine of fair use provides everything needed to balance the competing interests of
15 the First Amendment and the copyright laws. *See L.A. News Serv. v. Tullo*, 973 F.2d 791, 795 (9th
16 Cir. 1992) (noting that “First Amendment concerns are . . . addressed in the copyright field
17 through the ‘fair use’ doctrine”); *Sarl Louis Feraud Int’l v. Viewfinder, Inc.*, 489 F.3d 474, 482
18 (2d Cir. 2007) (“[T]he fair use doctrine encompasses all claims of first amendment in the
19 copyright field.” (internal quotation omitted)). There is no need to go further afield, or to treat fair
20 use as an element in a broader First Amendment inquiry.

21 The anonymous speech approach was problematic for other reasons, too. It is a developing
22 area where the standards are far from settled. *See In re Anonymous Online Speakers*, 661 F.3d
23 1168, 1175-76 (9th Cir. 2011) (noting courts have “employed a variety of standards to benchmark
24 whether an anonymous speaker’s identity should be revealed”). And the two-part test the
25 magistrate judge used was created in a context that did not involve the key elements of copyright
26 or the DMCA. *See* Dkt. No. 18 at 8-9. *Highfields*, the source of the test, involved claims
27 sounding in trademark and unfair competition, but not copyright law or fair use. *See Highfields*,
28 385 F. Supp. 2d at 972. *Art of Living Foundation*, which the magistrate judge also cited, had a

1 copyright infringement claim among others, but the district court expressly declined to make a fair
 2 use determination. *Art of Living Foundation*, 2011 WL 5444622 at *6. The district court
 3 followed *Highfields* instead, although it acknowledged that a court “might consider fair use
 4 arguments raised in a motion to quash.” *Id.* at *7, *8 n.6.

5 While the *Highfields* test certainly has a role in some online speech cases, it is not well
 6 suited for a copyright dispute. It begs the question to a degree because the First Amendment does
 7 not protect anonymous speech that infringes copyright. *See Arista Records, LLC v. Doe 3*, 604
 8 F.3d 110, 118 (2d Cir. 2010) (“[T]o the extent that anonymity is used to mask copyright
 9 infringement or to facilitate such infringement by other persons, it is unprotected by the First
 10 Amendment.”). In addition, the test has no obvious place for the fair use inquiry. The parties and
 11 the magistrate judge considered fair use in the context of balancing the harms, but a good
 12 argument can be made that it fits much better in determining whether there was a prima facie case
 13 of copyright infringement. There is also the prudential consideration that courts should not pass
 14 on constitutional questions in the first instance when a case may be resolved on other grounds.
 15 *See Slack v. McDaniel*, 529 U.S. 473, 485 (2000).

16 Consequently, the Court sees no reason to tackle broad online speech issues when an
 17 analysis under copyright law and fair use will do. Fair use “allows the public to use not only facts
 18 and ideas contained in a copyrighted work, but also expression itself in certain circumstances.”
 19 *Eldred*, 537 U.S. at 219; *see also Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S.
 20 417, 432-33 (1984) (copyright law “has never accorded the copyright owner complete control over
 21 all possible uses of his work”). Congress codified four factors in the Copyright Act to guide the
 22 determination of fair use of copyrighted works. In pertinent part:

23 Notwithstanding the provisions of sections 106 and 106A, *the fair use of a*
 24 *copyrighted work*, including such work by reproduction in copies . . . *for purposes*
 25 *such as criticism, comment, news reporting, teaching (including multiple copies*
 26 *for classroom use), scholarship, or research, is not an infringement of copyright.*
 In determining whether the use made of a work in any particular case is fair use
 the factors to be considered shall include --

27 (1) the purpose and character of the use, including whether such
 28 use is of a commercial nature or is for nonprofit educational
 purposes;

1 (2) the nature of the copyrighted work;

2 (3) the amount and substantiality of the portion used in relation to
the copyrighted work as a whole; and

3 (4) the effect of the use upon the potential market for or value of
4 the copyrighted work.

5 17 U.S.C. § 107 (emphasis added).

6 The key principle here is Congress’s determination that fair use is not a mere defense to
7 copyright infringement, but rather is a use that is not infringing at all. As our circuit has
8 concluded, the plain language of Section 107 means that “[f]air use is not just excused by the law,
9 it is wholly authorized by the law.” *Lenz v. Universal Music Corp.*, 815 F.3d 1145, 1151 (9th Cir.
10 2016). “[A]nyone who . . . makes a fair use of the work is not an infringer of the copyright with
11 respect to such use.” *Id.* at 1152 (alterations in original) (quoting *Sony Corp.*, 464 U.S. at 433).
12 Fair use “is a non-infringing use.” *Id.*

13 Consequently, if the fair use inquiry demonstrates that Darkspilver is not an infringer of
14 Watch Tower’s copyrighted works, the subpoena must be quashed. The only authorized purpose
15 for the subpoena under the DMCA was to discover his identity as an alleged copyright infringer to
16 protect Watch Tower’s copyrights. *See* 15 U.S.C. § 512(h)(2)(C) (requiring “a sworn declaration
17 to the effect that the purpose for which the subpoena is sought is to obtain the identity of an
18 alleged infringer and that such information will only be used for the purpose of protecting rights
19 under this title”). If Darkspilver establishes that he made fair use of the copyrighted works, no
20 claim of copyright infringement could plausibly be alleged against him, and the subpoena would
21 not be authorized under the DMCA.

22 The magistrate judge analyzed the fair use factors in Section 107, albeit in a balance of
23 hardships context, and found that they all weighed in favor of fair use. Dkt. No. 18 at 13-17.
24 Because no copyright had been registered for the chart at the time of the subpoena, and other
25 factors made its copyright status doubtful, the magistrate judge focused on the solicitation ad. *Id.*
26 at 11. Among other determinations, the magistrate judge found that: (1) Darkspilver used the
27 solicitation ad for the purposes of criticism and critical discussion, without profit or commercial
28 gain; (2) the ad was an informational and functional, as opposed to creative, work that focused on

1 giving instructions on how to donate online; (3) it was a single page from the November 2018
2 Watchtower magazine, and thus a small portion of that copyrighted collective work; and (4)
3 Watch Tower had not shown a meaningful likelihood of harm to the value of its work. *Id.* at 13-
4 17.

5 After a de novo review of the record and the parties' arguments, the Court concludes that
6 Darkspilver made fair use of the Watch Tower documents. This review was facilitated by the fact
7 that the salient evidence is not meaningfully disputed. The record is well developed, and neither
8 side contends that any evidence material to the fair use inquiry is missing. To streamline the
9 analysis, the Court has assumed that Watch Tower perfected a copyright for the ad and chart
10 before it requested the subpoena. This arguably spots Watch Tower more than it is entitled to,
11 given the questions about the copyright status of the chart, *see* Dkt. No. 18 at 11, but the
12 assumption clears the deck of collateral technical issues in favor of the party opposing fair use.

13 The fair use factors in Section 107 are not intended to be applied in an isolated and
14 mechanical way. They should be explored and weighed together in light of copyright's purpose.
15 *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994). Every application of fair use is
16 different, and the inquiry must be made on the specific facts before the Court on a case-by-case
17 basis. *Id.* at 577. The doctrine "permits [and requires] courts to avoid rigid application of the
18 copyright statute when, on occasion, it would stifle the very creativity which that law is designed
19 to foster." *Id.* (internal quotation omitted) (alteration in original).

20 With respect to the first factor of the purpose and character of the use, the key question is
21 whether the new use was "transformative," that is, whether the use added some new purpose or
22 meaning to the original. *Campbell*, 510 U.S. at 579. There is no material dispute that Darkspilver
23 used the ad and chart for criticism and commentary in a manner fundamentally at odds with Watch
24 Tower's original purposes. He put them on a forum expressly dedicated to criticism of Watch
25 Tower by former members, succeeded in generating a number of comments from other users
26 critical of Watch Tower, *see* Dkt. No. 8-3, and declared that his sole purpose was to criticize the
27 organization and spark discussion about it, Dkt. No. 8-1 ¶ 9.

28

1 This was a transformative use. It is true that he copied the solicitation ad and chart largely
2 in their original and unaltered states, but physical changes are not required for a new use to be
3 transformative. *See, e.g., Katz v. Google, Inc.*, 802 F.3d 1178, 1183 (11th Cir. 2015) (“The use of
4 a copyrighted work need not alter or augment the work to be transformative in nature.”) (quoting
5 *A.V. ex rel. Vanderhye v. iParadigms, LLC*, 562 F.3d 630, 639 (4th Cir. 2009)); *Seltzer v. Green*
6 *Day, Inc.*, 725 F.3d 1170, 1177 (9th Cir. 2013) (work can be transformative with few physical
7 changes to or comments on the original). What matters is that Darkspilver used the ad and chart to
8 express “something new, with a further purpose or different character, altering the first with new
9 expression, meaning, or message.” *Campbell*, 510 U.S. at 579. The “something new” was
10 criticism of Watch Tower’s fundraising and data collection practices, a quintessential fair use right
11 expressly protected by Section 107. That use completely transformed the purpose and expressive
12 content of the ad and chart, regardless of whether their physical text was changed. *See Swatch*
13 *Grp. Mgmt. Servs. Ltd. v. Bloomberg L.P.*, 756 F.3d 73, 83 (2d Cir. 2014) (“Courts often find such
14 uses [of unaltered reproduction] transformative by emphasizing the altered purpose or context of
15 the work, as evidenced by the surrounding commentary or criticism.”); *Kelly v. Arriba Soft Corp.*,
16 336 F.3d 811, 818-20 (9th Cir. 2003) (use of exact copies of photographs as search engine
17 thumbnail images transformative because original use as fine art was altered).

18 There is also no serious dispute that Darkspilver did not use Watch Tower’s works for a
19 commercial purpose. He expressly declared that to be true, Dkt. No. 8-1 ¶ 9, and Watch Tower
20 has not proffered any evidence to the contrary. Watch Tower makes a passing comment that the
21 Reddit posts might have boosted Darkspilver’s status in social media, Dkt. No. 21 at 19, but that
22 suggestion is entirely conclusory, and Watch Tower never explains how posting some criticisms
23 of the Jehovah’s Witnesses on a Reddit forum directed to former members could ever translate
24 into a profit-making enterprise for Darkspilver.

25 For the second factor, a plain reading of the ad and chart show that they were strongly in
26 the nature of functional and instructive documents. They were factual works -- instructions on
27 how to donate online and a summary of potentially applicable European data laws -- that are light-
28 years away from the creative works at the core of copyright protection. *Campbell*, 510 U.S. at

1 586; *Stewart v. Abend*, 495 U.S. 207, 237 (1990) (“In general, fair use is more likely to be found
2 in factual works than in fictional works.”); *Harper & Row Publishers, Inc. v. Nation Enters.*, 471
3 U.S. 539, 563-64 (1985). In addition, the solicitation ad had been published before Darkspilver
4 used it, which also weighs in favor of fair use under this factor. *See Kelly*, 336 F.3d at 820.

5 Under the third inquiry, the record shows that Darkspilver used a quantitative and
6 qualitative amount of the documents proportionate to his message. *See Campbell*, 510 U.S. at
7 586-87 (“[T]he extent of permissible copying varies with the purpose and character of the use.”);
8 *Kelly*, 336 F.3d at 820-21 (9th Cir. 2003) (purpose of claimed fair use made it necessary to copy
9 entire work, as copying less would reduce its usefulness). Whether the solicitation ad should be
10 treated as a separate work, as Watch Tower now suggests, or as one page of a collected work, as it
11 was copyrighted, Darkspilver copied what was reasonably necessary from it, and the chart, to
12 make his criticisms and comments understandable. He did not help himself to an oversized
13 portion of Watch Tower’s works *vis-à-vis* his critical message.

14 The fourth factor looks at whether the new use has an effect on the potential market for or
15 value of the copyrighted works. *See Seltzer*, 725 F.3d at 1179. This factor has been called the
16 most important fair use element because it protects the incentive to create. *See Harper & Row*,
17 471 U.S. at 566; *Sony Corp.*, 464 U.S. at 450-51. Even so, a “use that has no demonstrable effect
18 upon the potential market for, or the value of, a copyrighted work need not be prohibited” to
19 protect that incentive. *Sony Corp.*, 464 U.S. at 450.

20 That is the situation here. To start, Watch Tower did not present any evidence to establish
21 a potential market or value for the ad or chart. There is no dispute that the Watch Tower magazine
22 is distributed to readers without charge, and that the chart was not published or distributed
23 externally. In addition, Darkspilver’s use of the ad and chart for criticism was fundamentally
24 contrary to Watch Tower’s purposes. There is no likelihood that this critical use could substitute
25 for the originals and thereby harm their potential market or value. Watch Tower was not in the
26 business of publishing or licensing its works to criticize its fundraising and data collection
27 practices, which effectively removes “the very notion” of potential harm here. *Campbell*, 510
28 U.S. at 592. Watch Tower no doubt disliked, and was possibly offended by, Darkspilver’s use of

1 its works, but that does not satisfy the loss of value inquiry. *Seltzer*, 725 F.3d at 1179. The chart
2 has the additional factor that Watch Tower did not obtain a certificate of copyright for it until after
3 challenging Darkspilver’s use. That further undercuts any possibility of loss of value for the chart.
4 *See Katz*, 802 F.3d at 1184 (“Due to [plaintiff’s] attempt to utilize copyright as an instrument of
5 censorship against unwanted criticism, there is no potential market for his work.”).

6 Rather than establishing a potential copyright market or value, Watch Tower speculates
7 that the Reddit postings might have diverted visitors away from its website. Dkt. No. 18 at 17;
8 Dkt. No. 21 at 22-23. That was the primary reason why the magistrate judge let the subpoena go
9 forward. Dkt. No. 18 at 17.

10 The point is not well taken. To start, it runs counter to the principle of law that a diversion
11 or suppression of demand from criticism is not a cognizable copyright harm. There is a crucial
12 difference between “[b]iting criticism [that merely] suppresses demand [and] copyright
13 infringement[, which] usurps it.” *Campbell*, 510 U.S. at 592 (brackets in original and quoting
14 *Fisher v. Dees*, 794 F.2d 432, 438 (9th Cir. 1986)). A parody, for example, can “kill[] demand for
15 the original” without causing a copyright injury. *Id.* at 591-92.

16 This makes the premise of Watch Tower’s theory of harm doubtful as a matter of law.
17 Watch Tower also made no effort to adduce any facts that might have made its theory less
18 speculative, such as evidence of reduced or changed website traffic after the Reddit posts were
19 made. Nor does Watch Tower explain how the posts were even capable of usurping copyright
20 value. This not a case where a bootleg copy of a work was pirated to capture sales the original
21 creator should have made. To the contrary, Darkspilver used the Watch Tower documents in a
22 way entirely different from, and critical of, Watch Tower’s use.

23 Overall, Watch Tower does not meaningfully dispute any of the fair use evidence in the
24 record. Instead, it offers the general challenge that the inquiry is “woefully premature” because
25 fair use is an affirmative defense that can’t be considered unless and until a complaint is on file.
26 Dkt. No. 21 at 18. This is a surprising proposition given that Watch Tower was required to
27 evaluate fair use before sending its take-down notice to Reddit, *Lenz*, 815 F.3d at 1153, and that
28 Watch Tower and its attorney represented they had done that, *see* Dkt. No. 21 at 5; Dkt. No. 12

1 ¶ 3. They are not well situated to say now that the inquiry should wait. In addition, Watch Tower
2 has not demonstrated that it is missing any material evidence for the fair use analysis, or that it has
3 been disadvantaged in any way by examining fair use for the motion to quash.

4 Watch Tower's position is also contrary to the law. Our circuit has expressly held that
5 calling fair use an affirmative defense "is a misnomer." *Lenz*, 815 F.3d at 1152. Fair use is an
6 authorized use, and consequently is "distinct from affirmative defenses where a use infringes a
7 copyright, but there is no liability due to a valid excuse, e.g., misuse of a copyright." *Id.* at 1153.
8 Curiously, although these holdings are plain as day in *Lenz*, Watch Tower failed to acknowledge
9 them in its briefs, even though it cited *Lenz* for other uses. *See, e.g.*, Dkt. 21 at 5, 23.

10 Watch Tower also suggests that Darkspilver has turned the motion to quash into an
11 improper "religious inquiry" by referring to potential sanctions of shunning and disfellowship.
12 Dkt. No. 21 at 17. Not so. Watch Tower is perfectly free to organize its internal disciplinary
13 practices as it sees fit, without interference from the courts. *See Paul*, 819 F.2d at 879-80. As this
14 order makes clear, those considerations play no role whatsoever in the fair use analysis, and the
15 Court has not relied on them for any of the findings here. They are a non-event for purposes of
16 this order.

17 For the sake of completeness, the Court also rejects Watch Tower's suggestion that
18 Darkspilver waited too long to oppose the subpoena. Watch Tower refers to a deadline for
19 objections under Rule 45, *see* Dkt. No. 21 at 9, but that applies only to the person commanded to
20 respond to the subpoena. Fed. R. Civ. P. 45(d)(2)(B). That was Reddit, to whom the subpoena
21 was directed. Darkspilver was permitted to move to quash in a "timely" fashion, *id.* 45(d)(3),
22 which he did.

23 CONCLUSION

24 The record establishes that Darkspilver made fair use of the Watch Tower ad and chart.
25 Consequently, he did not infringe Watch Tower's copyrighted works, and there is no basis in the
26 DMCA for a subpoena to compel disclosure of his identity. This is not a matter of limiting
27 disclosure to outside counsel only, but that disclosure is not permitted at all under the law. The
28

1 motion to quash is granted.

2 **IT IS SO ORDERED.**

3 Dated: March 2, 2020



JAMES DONATO
United States District Judge

United States District Court
Northern District of California

4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28