

IN THE UNITED STATES COURT OF APPEALS  
FOR THE EIGHTH CIRCUIT

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RECORDING INDUSTRY ASSOCIATION OF AMERICA,

Appellee,

v.

CHARTER COMMUNICATIONS, INC.,

Appellant.

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ON APPEAL FROM THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF MISSOURI

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BRIEF FOR THE UNITED STATES  
AS INTERVENOR AND *AMICUS CURIAE*

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**BRIEF FOR THE UNITED STATES  
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The United States, appearing as an intervenor under 28 U.S.C. § 2403(a) and as an *amicus curiae* under 28 U.S.C. § 517 and Rule 29(a) of the Federal Rules of Appellate Procedure, submits this brief to address the meaning and constitutionality of 17 U.S.C. § 517(h), the provision of the Digital Millennium Copyright Act at issue in this case.



## **STATEMENT OF JURISDICTION**

This appeal arises out of a motion to quash subpoenas issued under Title II of the Digital Millennium Copyright Act (DMCA). The motion presents questions of federal law under the DMCA and the Constitution. The district court was vested with subject matter jurisdiction by 17 U.S.C. § 512(h)(6) and 28 U.S.C. §§ 1331, 1337(a), and 1338(a).

The district court issued an order enforcing the subpoenas and denying the motion to quash on November 17, 2003. The appellant filed a notice of appeal on November 21, 2003, within the time allowed by Rule 4(a)(1) of the Federal Rules of Appellate Procedure. The district court's order constitutes the final decision of the district court and is within this Court's appellate jurisdiction under 28 U.S.C. § 1291.

## **STATEMENT OF ISSUES**

17 U.S.C. § 512(h) authorizes clerks of district courts to issue a subpoena directing an Internet service provider to identify a customer who allegedly is using the provider's service to engage in copyright infringement. The questions to be addressed by the United States are:

1. Whether Section 512(h) applies to Internet service providers who are engaged in transmission, rather than storage, of allegedly infringing material.

*RIAA v. Verizon Internet Services, Inc.*, 351 F.3d 1229 (D.C. Cir. 2003),  
*petition for rehearing filed* (Feb. 2, 2004)

*In re Verizon Internet Services, Inc.*, 240 F. Supp. 2d 24 (D.D.C.), *rev'd*,  
351 F.2d 1229 (D.C. Cir. 2003)

2. Whether, in the absence of a pending complaint for copyright infringement, the issuance of a subpoena under Section 512(h) violates Article III of the Constitution.

*Nashville, Chattanooga & St. Louis Ry. v. Wallace*, 288 U.S. 249 (1933)

*In re Verizon Internet Services, Inc.*, 257 F. Supp. 2d 244 (D.D.C.), *rev'd on other grounds sub nom. RIAA v. Verizon Internet Services, Inc.*, 351 F.3d 1229 (D.C. Cir. 2003)

3. Whether Section 512(h) is unconstitutional under the First Amendment.

*Virginia v. Hicks*, 123 S. Ct. 2191 (2003)

*In re Verizon Internet Services, Inc.*, 257 F. Supp. 2d 244 (D.D.C.), *rev'd on other grounds sub nom. RIAA v. Verizon Internet Services, Inc.*, 351 F.3d 1229 (D.C. Cir. 2003)

## STATEMENT OF THE CASE

### I. Statutory Background

The past decade has witnessed the explosive growth of electronic commerce and the accompanying rise of digital networks that facilitate the reproduction and distribution, both authorized and unauthorized, of copyrighted works in electronic form. The Digital Millennium Copyright Act (DMCA) represents Congress's

principal legislative response to these changes. The DMCA is designed to advance "two important priorities: promoting the continued growth and development of electronic commerce[] and protecting intellectual property rights." H. Rep. No. 105-551(II), at 23 (1998) ("House Report").

Among the issues addressed by the DMCA is the role of Internet service providers (ISPs) in the electronic dissemination of copyrighted works. ISPs are instrumental in "provid[ing] new and powerful ways for the creators of intellectual property to make their works available to legitimate consumers in the digital environment." House Report at 23. At the same time, the services provided by ISPs may also be misused by persons engaged in the unauthorized reproduction and distribution of copyrighted works. Because copyrighted works in digital form "can be copied and distributed worldwide virtually instantaneously" via the Internet, copyright owners require assurance that their works will be protected against piracy when they are made available on the Internet. S. Rep. No. 105-190, at 8 (1998) ("Senate Report"). But if ISPs providers face potential derivative liability for infringing uses of their services, they may be unwilling to develop new services and capabilities that will facilitate legitimate electronic commerce. *Id.*

The role of ISPs is addressed in Title II of the DMCA, which amends the Copyright Act, 17 U.S.C. §§ 501 *et seq.* Title II was the product of lengthy nego-

tiations between copyright owners and Internet service providers. See Senate Report at 9 ("Title II \* \* \* reflects 3 months of negotiations \* \* \* among the major copyright owners and the major OSP's and ISP's"). It was designed to strike a balance between the interest of ISPs in avoiding liability for infringing uses of their services and the interest of copyright owners in protecting their intellectual property and minimizing online piracy. See Pub. L. No. 105-304, §§ 201-203, 112 Stat. 2877-2886, codified at 17 U.S.C. § 512.

Title II offers protection to ISPs by creating statutory "safe harbors" that limit potential liability for monetary and injunctive relief under the copyright laws. See 17 U.S.C. § 512(a)-(d). For present purposes, two of these safe harbor provisions are particularly important. The first, found in subsection (a) of section 512, provides a safe harbor for the *transmission* of infringing material. The second, found in subsection (c), provides a safe harbor for the *storage* of infringing material. The remaining safe harbors apply to system caching (subsection (b)) and information location tools (subsection (d)).

In order to qualify for the safe harbor for data storage under subsection (c) , an ISP must expeditiously "remove, or disable access to, the material" if it receives notification of the infringing activity from the copyright owner. 17 U.S.C. § 512(c)(1)(C). Similar "takedown" obligations apply to the safe harbors for system

caching and information location tools. *Id.* §§ 512(b)(2)(E), 512(d)(3). In contrast, the safe harbor provision for data transmission in subsection (a) is not subject to a similar takedown obligation.<sup>1</sup>

Subsection (c)(3)(A) of Section 512 specifies the information that must be included in a notification in order to trigger the takedown obligation. The notification must identify the copyrighted work (or a "representative list" of multiple works) alleged to have been infringed. *Id.* § 512(c)(3)(A)(ii). The notification must also provide "[i]dentification of the material that is claimed to be infringing and that is to be removed or access to which is to be disabled, and information reasonably sufficient to permit the service provider to locate the material." *Id.* § 512(c)(3)(A)(iii). Finally, the notification must state that the information contained in it is accurate, that the party providing the notice "has a good faith belief that use of the material in the manner complained of is not authorized," and that the

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<sup>1</sup> All ISPs that wish to receive safe-harbor immunity, including ISPs engaged in data transmission, must "adopt[] and reasonably implement[]" a policy that "provides for the termination in appropriate circumstances of subscribers and account holders of the service provider's system or network who are repeat infringers." 17 U.S.C. § 512(i)(1)(A); see generally *Ellison v. Robertson*, 2004 WL 235466 (9th Cir. Feb. 10, 2004). By its terms, this provision only requires ISPs to terminate the accounts of "repeat infringers," and even then, only in "appropriate circumstances" – a term that the statute leaves undefined. It thus stops short of subjecting ISPs engaged in data transmission to the categorical takedown requirements applicable to other ISPs.

complaining party is authorized to act on behalf of the copyright owner. *Id.* § 512(c)(3)(A)(v)-(vi).

In exchange for the protection that the statutory safe harbors offer to ISPs, Title II seeks to provide "strong incentives for service providers and copyright owners to cooperate to detect and deal with copyright infringements that take place in the digital networked environment." H. Conf. Rep. No. 105-796, at 72 (1998) ("Conference Report"). The takedown obligation represents one such form of cooperation. In addition, Title II obligates ISPs to assist copyright owners by providing information about the identity of subscribers who are engaged in copyright infringement. Title II implements this obligation through 17 U.S.C. § 512(h), the provision at issue in this case.

Section 512(h) authorizes a copyright owner or its representative to "request the clerk of any United States district court to issue a subpoena to a service provider for identification of an alleged infringer \* \* \* ." 17 U.S.C. § 512(h)(1). In order to obtain a subpoena under Section 512(h), the requester must present the clerk with a sworn declaration that the subpoena is being sought "to obtain the identity of [the] alleged infringer and that such information will only be used for the purpose of protecting rights" under Title 17. *Id.* § 512(h)(2)(B)-(C). In addition, the requester must give the clerk "a copy of a notification described in subsection (c)(3)(A)." *Id.*

§ 512(h)(2)(A). Finally, the requester must present the clerk with a proposed subpoena that "authorize[s] and order[s] the service provider \* \* \* to expeditiously disclose \* \* \* information sufficient to identify the alleged infringer \* \* \* to the extent such information is available to the service provider." *Id.* § 512(h)(2)(B), 512(h)(3).

If the notification satisfies the provisions of subsection (c)(3)(A), the proposed subpoena is in proper form, and the declaration is properly executed, the clerk must "expeditiously issue and sign" the proposed subpoena for delivery to the ISP. *Id.* § 512(h)(4). Upon receipt of the subpoena, the ISP is obligated to "expeditiously disclose \* \* \* the information required by the subpoena, notwithstanding any other provision of law." *Id.* § 512(h)(5).

Except as otherwise provided by Section 512 itself, the procedure for issuance and delivery of the subpoena and the remedies for noncompliance are governed "to the greatest extent practicable" by the provisions of the Federal Rules of Civil Procedure governing issuance, service, and enforcement of subpoenas duces tecum. *Id.* § 512(h)(6). Those provisions are found primarily in Rule 45. Rule 45 provides for subpoenas to be issued in the name of the court, and the failure "without adequate excuse" to obey a subpoena may be deemed a contempt of court. *Id.* Rule 45(a)(1)(A), 45(e). A person subject to a subpoena may move to quash or modify it,

and if he serves timely written objection to disclosure of the materials designated by the subpoena, the serving party is not entitled to inspect the materials "except pursuant to an order of the court by which the subpoena was issued." *Id.* Rule 45(c)(2)(B), 45(c).

## **II. The Present Litigation**

The most pervasive form of online copyright infringement today involves the use of "peer-to-peer" network software. Peer-to-peer software permits users to exchange files with each other without having to use a centralized network server as a storage device. Using peer-to-peer software, files residing on one user's computer can be identified and transferred over the Internet to another user's computer. The transferred files are not stored on the computers of the ISP that provides the peer-to-peer users with Internet access; the ISP's role is confined to transmitting the files through its network. Although peer-to-peer software can be used to exchange any kind of computer file, it is widely used today for the unlawful exchange of copyrighted sound recordings. The phenomenon of illegal peer-to-peer music file transfers has grown with the increased availability of high-speed "broadband" Internet access, which allows large files to be transferred in a brief time.

As a practical matter, copyright owners cannot seek to deter unlawful peer-to-peer file transfers unless they can learn the identities of persons engaged in that



activity. As a technical matter, copyright owners can readily determine the Internet address of a peer-to-peer user's computer and the files that he is making available for downloading, but the identity of the user himself is known only to the ISP that provides him with Internet access. Accordingly, appellee RIAA has applied for subpoenas under Section 512(h) to compel ISPs to disclose the identities of subscribers who are using peer-to-peer software to illegally disseminate copyrighted sound recordings.

This case involves Section 512(h) subpoenas directed at appellant Charter Communications, Inc. (Charter). Charter is a cable company that serves markets throughout the United States. In addition to offering traditional cable television service, Charter offers broadband Internet access. See generally <http://www.charter.com/products/internet/internet.asp> (describing broadband service). By monitoring files being offered for public downloading via peer-to-peer network software, RIAA determined that over two hundred of Charter's Internet subscribers were engaged in illegal peer-to-peer file transfers. RIAA therefore applied to the District Court for the Eastern District of Missouri for subpoenas requiring the disclosure of identifying information regarding the infringing subscribers.

Charter filed a motion to quash the subpoenas. The motion asserted that the subpoenas did not conform to various requirements of the Federal Rules of Civil Procedure and the DMCA. Separate Appendix (SA) 298A-290A. In addition, the motion asserted that Section 512(h) does not apply to service providers who are engaged solely in the transmission of infringing material and that, if it does, it violates Article III and the First Amendment. *Id.* at 290A.<sup>2</sup>

The district court denied the motion to quash and, with exceptions not relevant here, ordered Charter to comply with the subpoenas. Charter filed a notice of appeal and unsuccessfully sought a stay of the order pending appeal. Following the denial of its stay request, Charter complied with the subpoenas and provided RIAA with the information required by the subpoenas and the district court's order.<sup>3</sup>

The United States is entitled by 28 U.S.C. § 2403(a) to intervene as of right when the constitutionality of an Act of Congress is called into question. Because Charter is asking this Court to declare Section 512(h) unconstitutional, the United

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<sup>2</sup> The motion informed the district court that "it may not be necessary to address these additional grounds, and accordingly Charter does not address them in its Memorandum but fully reserves them." *Ibid.*

<sup>3</sup>Charter's compliance with the subpoenas raises a potential question of mootness. See generally *Church of Scientology v. United States*, 506 U.S. 9 (1992); *In re Security Life Ins. Co. of America*, 228 F.3d 865, 869-70 (8th Cir. 2000) (distinguishing for mootness purposes between subpoenas *duces tecum* and testimonial subpoenas).

States has filed a motion to intervene as of right in this appeal. The United States is also participating as an *amicus curiae*, pursuant to Rule 29(a) of the Federal Rules of Appellate Procedure, to present the views of the federal government regarding the proper construction of Section 512(h).

### **SUMMARY OF ARGUMENT**

1. The threshold issue in this appeal is whether the subpoena mechanism created by 17 U.S.C. § 512(h) applies to ISPs that are engaged in data transmission – so-called "conduit" ISPs. The only other Court of Appeals to address that issue, the D.C. Circuit in *RIAA v. Verizon Internet Services, Inc.*, 351 F.3d 1229 (2003), has concluded that it does not. The United States believes that the D.C. Circuit's statutory ruling in *Verizon* is inconsistent with the text of Section 512(h) and the legislative policies that underlie it.

As a textual matter, Section 512(h) states in unqualified terms that "service providers" – a term whose statutory definition incontestably encompasses conduit ISPs – may be subpoenaed to identify infringing subscribers. If Congress had actually intended to exclude conduit ISPs from the scope of Section 512(h), it would have been a trivial matter to say so expressly, and the fact that Congress did *not* say so is compelling evidence that Congress did not intend that result. The D.C. Circuit concluded that Congress accomplished the same result more elliptically, by requiring

the requester to identify (among other things) infringing materials "access to which is to be disabled." The D.C. Circuit concluded that conduit ISPs cannot disable access to infringing material, and hence that the identification requirement implicitly excuses them from the operation of Section 512(h). But the D.C. Circuit was wrong: conduit ISPs *can* disable access to infringing material. Once that is recognized, the D.C. Circuit's textual analysis unravels.

The D.C. Circuit's decision is equally at odds with the legislative policies underlying Section 512 and with the policies of federal copyright law in general. Section 512 was intended to embody a basic *quid pro quo*: in return for safe-harbor protection against copyright infringement liability, ISPs would cooperate with copyright owners in combating infringing activities by their subscribers. The D.C. Circuit's reading of Section 512(h) upends that *quid pro quo* by allowing conduit ISPs to claim the benefit of Section 512's safe harbor without having to give copyright owners the critical information they need to pursue their rights against infringing subscribers – the subscribers' identities. In so doing, the D.C. Circuit has impaired the Copyright Act's basic mechanisms for protecting intellectual property rights. Although Congress may not have foreseen the specific problem of illegal peer-to-peer file transfers, it manifestly did anticipate the general problem of which peer-to-peer transfers are simply one instance – the problem of online copyright infringement in

which an ISP serves solely as a conduit. Section 512 was designed to deal with that problem in its entirety, and the D.C. Circuit's decision directly frustrates Congress's intent.

2. If this Court agrees that Section 512(h) applies to conduit ISPs, it must then take up Charter's claim that the application of Section 512(h) in this case violates Article III of the Constitution. Charter argues that while Section 512(h) may be freely used to obtain the identity of an alleged infringer after the copyright owner has filed a complaint against the infringer, Article III precludes the use of Section 512(h) in situations where no infringement action is pending. In so arguing, Charter confuses the existence of an Article III controversy with the pendency of a complaint. The exercise of judicial power under Article III is dependent only on the former, not on the latter. As long as an Article III controversy is present, Congress is free to authorize federal courts to issue discovery orders relating to the controversy without insisting on the filing of a complaint. That is precisely what Congress has done here. When a subpoena is sought under Section 512(h), the requirements of the statute itself ensure that the subpoena is tied to an actual controversy under the copyright laws between a copyright owner and an alleged infringer. In addition, the subpoenas in this case are supported by the existence of an additional controversy – the controversy between the copyright owner and the service provider over access to the

alleged infringers' identities. Either of these controversies is sufficient to bring Section 512(h) within the ambit of Article III.

3. Finally, Charter claims that Section 512(h) lacks sufficient procedural safeguards to protect the First Amendment interests of subscribers who are using the Internet to engage in protected expression rather than unprotected copyright infringement. This argument is fundamentally misconceived. First, Section 512(h) does not impose the kind of restriction on speech that has been held to require procedural safeguards. Second, the procedural requirements of Section 512(h) are easily sufficient to minimize the risk that anonymous speakers will have their identities improperly disclosed. Finally, even if Section 512(h) could not constitutionally be applied with respect to subscribers engaged in protected expression, Charter would not be entitled to avoid compliance with Section 512(h) on an across-the-board basis unless it could meet the requirements of the overbreadth doctrine. The overbreadth doctrine requires Charter to demonstrate that the law impermissibly burdens a substantial amount of protected speech, both in absolute terms and in relation to the legitimate scope of the statute, and Charter has wholly failed to carry that burden.

## ARGUMENT

### I. 17 U.S.C. § 512(h) Applies to All Internet Service Providers, Regardless of Whether They Are Engaged in Data Transmission or Data Storage

#### A. Introduction

The Copyright Act vests copyright owners with, *inter alia*, the exclusive rights to reproduce their copyrighted works and to distribute copies of those works to the public. 17 U.S.C. § 106(1), (3). The advent of the Internet has placed these rights in jeopardy, not only by facilitating the wholesale copying and distribution of copyrighted works without authorization of the copyright owner, but also by permitting infringers to conceal their identities behind the anonymity of an IP address. If a copyright owner cannot discover the identities of individuals who are engaged in illegal file transfers, the owner's ability to vindicate his rights under the Copyright Act is fatally compromised.

Section 512(h) is the mechanism chosen by Congress to enable copyright owners "to obtain the identity of an alleged infringer \* \* \* for the purpose of protecting [the owners'] rights" under the Copyright Act. 17 U.S.C. § 512(h)(2)(C). It forms an central part of the basic *quid pro quo* embodied in Title II of the DMCA. As explained above, in exchange for limiting the liability of ISPs for their role in the dissemination of stolen intellectual property, Congress obligated ISPs to assist

copyright owners in protecting their rights against the infringing subscribers themselves. Copyright owners cannot enforce their rights against infringers unless they can identify them, and they cannot identify them without the assistance of service providers like Charter who provide the infringers with Internet access. Section 512(h) is thus critical to the DMCA's basic strategy of enlisting the assistance of ISPs in exchange for limiting their copyright liability, thereby allowing copyright owners to pursue relief against infringing subscribers in return for surrendering their right to seek relief against ISPs.

In this appeal, Charter contends that Section 512(h) applies only to ISPs that provide storage for illegally copied materials on their own computers. In Charter's view, Section 512(h) is inapplicable to ISPs that transmit illegally copied materials from one private computer to another. Charter thus contends that Section 512(h) places ISPs under no obligation to identify subscribers who are engaged in illegal peer-to-peer file transfers, regardless of how extensive the file transfers are and how manifest it may be that the activity violates the Copyright Act.

The interpretation that Charter is urging this Court is one that would drastically limit Section 512(h)'s scope and would fundamentally alter the *quid pro quo* embodied in Title II of the DMCA. As a practical matter, peer-to-peer file transfers account for the overwhelming majority of copyrighted music files that are illegally



traded over the Internet. Charter's view of the statute places this vast volume of infringing activity wholly beyond the reach of Section 512(h). At the same time, ISPs engaged in the transmission of infringing materials are not subject to the same takedown obligation that applies to ISPs engaged in data storage. See pp. 5-6 *supra*; compare 17 U.S.C. § 512(a)(1)-(5) with *id.* § 512(c)(1)(A)(iii), (C). Because Title II does not obligate ISPs to disable access to infringing materials as a condition for copyright immunity for data transmission, it is all the more important for ISPs to identify infringing subscribers so that copyright owners can pursue recourse against the infringers themselves. Charter's proffered interpretation thus has the perverse effect of denying recourse to Section 512(h) precisely where the need for it is greatest. And Charter's position means that ISPs engaged in data transmission are under no obligation to do *anything* in exchange for the safe-harbor immunity provided by Title II. In Charter's account, the *quid pro quo* exacted by Congress in return for immunity thus turns out to be . . . nothing.

Relying on the D.C. Circuit's recent decision in *RIAA v. Verizon Internet Services, Inc.*, 351 F.3d 1229 (D.C. Cir. 2003), Charter argues that these perverse results are compelled by the text of Section 512(h) and related provisions. As we now show, the D.C. Circuit's analysis of the statutory language is incorrect. Properly read, Section 512(h) applies to ISPs engaged in data transmission as well as to ISPs

engaged in data storage and other activities. And only that reading vindicates the policies underlying Title II of the DMCA and the underlying policies of federal copyright law. This Court therefore should hold that Section 512(h) applies equally to all ISPs, regardless of whether they are engaged in data transmission or data storage.

**B. The Language of Section 512(h) Does Not Exclude ISPs Engaged In Data Transmission**

1. As discussed above, Section 512(h) provides that 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." 17 U.S.C. § 512(h)(1)(A). If the statutory prerequisites are met, "the clerk shall expeditiously issue and sign the proposed subpoena and return it to the requester for delivery to the service provider." *Id.* § 512(h)(4). Upon receipt of the subpoena, "the service provider shall expeditiously disclose to the copyright owner or person authorized by the copyright owner the information required by the subpoena \* \* \* ." *Id.* § 512(h)(5).

If Congress had intended to exclude ISPs engaged in data transmission from the operation of these provisions, it would have been a trivial matter to say so. For example, Congress could simply have stated that a copyright owner may request "a

subpoena to a service provider other than one acting within the scope of subsection (a)," Section 512's safe-harbor provision for data transmission. Or, borrowing the language used in the safe-harbor provision itself, Congress could have stated that "[t]his subsection shall not apply to a service provider that is engaged in transmitting, routing, or providing connections for, material through a system or network controlled or operated by or for the service provider." *Cf.* 17 U.S.C. § 512(a). Or, using similar language, Congress could have modified Section 512's general statutory definition of "service provider" to exclude ISPs engaged in data transmission for purposes of the subpoena provision.

As the text shows, however, Congress did none of these things. Nowhere does the language of Section 512(h) expressly distinguish between ISPs engaged in data transmission and ISPs engaged in data storage. To the contrary, the text refers throughout to "service providers" without drawing any distinction between one class of ISP and another. In turn, the applicable statutory definition of "service provider" encompasses all "provider[s] of online services or network access," once again without exception. 17 U.S.C. § 512(k)(1)(B). In short, when Congress identified the entities that are subject to subpoenas under Section 512(h), it used unqualified language that encompasses all ISPs and embraces, rather than excludes, ISPs engaged in data transmission. See *In re Verizon Internet Services*, 240 F. Supp. 2d 24, 30-31

(D.D.C.), *rev'd*, 351 F.2d 1229 (D.C. Cir. 2003) ("[T]he definition of 'service provider' \* \* \* applicable to the subpoena authority under subsection (h) squarely includes subsection (a) [*i.e.*, conduit] entities \* \* \* "). Congress simply did not say that ISPs engaged in data transmission are beyond the scope of Section 512(h) – and the fact that Congress did not say it is compelling evidence that it did not intend it. See *id.* at 33 ("If Congress intended to restrict or limit the subsection (h) subpoena authority based on where the infringing material resides, one would expect to see that limitation spelled out in subsection (h)").

2. In *Verizon*, the D.C. Circuit nevertheless concluded that Section 512(h) draws a categorical distinction between ISPs that are engaged in data transmission – whom the D.C. Circuit referred to as "conduit" ISPs – and ISPs that are not. It based this conclusion on Section 512(h)'s designation of the materials that must be presented to the clerk to obtain a subpoena. See 17 U.S.C. § 512(h)(2). In particular, the D.C. Circuit relied on Section 512(h)(2)(A), which requires the requester to provide the clerk with "a copy of a notification described in subsection (c)(3)(A)."

As explained above, subsection (c)(3)(A) lists information that must be provided to trigger the "takedown" obligation of ISPs engaged in activities other than data transmission. See pp. 6-7 *supra*. Among other things, it requires the copyright holder to identify "the material that is claimed to be infringing or to be the subject of

infringing activity and that is to be removed or access to which is to be disabled, and information reasonably sufficient to permit the service provider to locate the material." 17 U.S.C. § 512(c)(3)(A)(iii). The D.C. Circuit concluded that when an ISP is engaged in transmitting infringing material from one private computer to another, rather than allowing infringing material to be stored on its own computers, it is impossible for "access [to the infringing material] \* \* \* to be disabled" by the ISP. Based on that premise, the court reasoned that a copyright owner cannot submit a notification in a conduit case that satisfies the requirements of subsection (c)(3)(A), and hence that Congress intended for subpoenas to be unavailable under Section 512(h) for conduit ISPs.

As we now show, the underlying premise of this reasoning is incorrect: an ISP *can* deny access to infringing material that resides on a subscriber's computer, and hence a copyright owner *can* present a notification that conforms to the requirements of subsection (c)(3)(A) when the ISP is engaged in data transmission. But before we do so, it is worth pausing to note how circuitous the D.C. Circuit's reading of Section 512(h) is. As shown above, Congress had any number of ways to say directly that Section 512(h) does not apply to ISPs engaged in data transmission. Yet rather than avail itself of any of them, Congress instead chose to exclude conduit ISPs (according to the D.C. Circuit) by cross-referencing a provision that itself refers solely to

infringing material and does not expressly distinguish among categories of ISPs. That is a remarkably obscure and roundabout way of accomplishing the goal attributed to Congress by the D.C. Circuit, and its very circuitousness provides further reason to doubt that it is what Congress actually intended.

In any event, as the district court in *Verizon* recognized, it is simply incorrect that "access" to infringing material cannot "be disabled" (17 U.S.C. § 512(c)(3)(A)(iii)) by a conduit ISP. While the ISP cannot physically remove the infringing files from a subscriber's computer, it can nevertheless disable access to them simply by terminating or suspending the subscriber's Internet account, thereby preventing other peer-to-peer users from reaching the infringing files. See *Verizon*, 240 F. Supp. 2d at 33 n.5 (a conduit ISP "certainly can disable access to the material by terminating the account altogether"). Because conduit ISPs *can* disable access to infringing materials in this fashion, a copyright owner can easily satisfy the requirements of subsection (c)(3)(A) in conduit cases, and hence Congress's incorporation of that provision into Section 512(h) in no way operates to exclude conduit ISPs.

Whether a conduit ISP actually *will* disable access is irrelevant to the operation of Section 512(h). By its terms, Section 512(h) provides that an ISP served with a subpoena "shall expeditiously disclose \* \* \* the information required by the

subpoena, notwithstanding any other provision of law *and regardless of whether the service provider responds to the notification.*" 17 U.S.C. § 512(h)(5) (emphasis added). It is therefore immaterial that Section 512 does not place conduit ISPs under a categorical obligation to disable access to infringing files on a subscriber's computer. See *Verizon*, 240 F. Supp. 2d at 33 n.5.<sup>4</sup>

Presented with this reasoning, the D.C. Circuit in *Verizon* resorted to yet another part of Section 512 – subsection (j), which prescribes the limited kinds of injunctive relief that can be entered against ISPs that qualify for Section 512's safe harbors. Subsection (j) has distinct provisions for injunctions that require an ISP to restrict "access to infringing material or activity" and injunctions that require an ISP to restrict "access to a subscriber \* \* \* by terminating the accounts of the subscriber." Compare *id.* § 512(j)(1)(A)(i) with *id.* § 512(j)(1)(A)(ii). The D.C. Circuit regarded the existence of these distinct provisions as proof that Congress could not have been

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<sup>4</sup> Indeed, even an ISP engaged in data storage is not legally obligated to respond to a notification under subsection (c)(3)(A). Denying access is a prerequisite for safe-harbor immunity under subsection (c), but if an ISP is unconcerned about immunity (because, for example, it believes that its actions do not expose it to copyright liability in the first instance), it is free simply to disregard the notice. See House Report at 54 ("[T]he service provider is free to refuse to 'take down' the material \* \* \* even after receiving a notification of claimed infringement from the copyright owner").

referring to account termination when it referred in subsection (c)(3)(A)(iii) of "material \* \* \* access to which is to be disabled." See 351 F.3d at 1235.

There are two problems with the D.C. Circuit's reasoning, each of which is independently fatal. First, the separate references in subsection (j) to restrictions on "access to infringing material" and restrictions on "access to a subscriber" mean only that the two categories are not *identical*. It simply does not follow, as the D.C. Circuit thought, that the two categories are therefore *mutually exclusive*. It is routine for Congress to identify discrete categories of conduct that are not identical but that nevertheless overlap with one another. That is commonplace, for example, in the context of federal criminal law, where the fact that two criminal offenses are separately defined in Title 18 does not mean that one of the offenses is not included within the other. See, *e.g.*, *Schmuck v. United States*, 489 U.S. 705 (1989). Here, in like fashion, one kind of access restriction (restrictions on "access to the infringing subscriber") can readily be included in the other (restrictions on "access to infringing materials"), notwithstanding the fact that the two kinds of restriction are separately prescribed. Thus, nothing in subsection (j) suggests that an ISP that terminates a subscriber's account is failing to disable "access to infringing materials."

Second, at a more fundamental level, the D.C. Circuit's reasoning loses sight of the actual *function* of notification under Section 512(h). When Section 512(h)



provides for a subpoena requester to submit a notification conforming to subsection (c)(3)(A), it is not doing so in order to force the ISP to disable access to the infringing material; as explained above, Section 512(h) expressly recognizes that an ISP may choose not to do so, and makes the duty to comply with the subpoena independent of whether the ISP responds to the notice by disabling access. Instead, as the district court in *Verizon* recognized, the function of the notification requirement in Section 512(h) is purely informational: it identifies both the copyrighted materials that have been infringed and the materials that infringe those copyrights. See *Verizon*, 240 F. Supp. 2d at 33 n.5. As discussed further below, it thus serves to demonstrate that the copyright owner has a *prima facie* claim for copyright infringement, and hence ensures that subpoenas are issued only when a genuine controversy exists between the copyright holder and the subscriber. See pp. 35-36 *infra*.

Because the notification provision of Section 512(h) is designed solely to provide information about the subscriber's infringing conduct, not to compel the ISP to disable access to the subscriber's infringing materials, it therefore is ultimately irrelevant not only whether the ISP will disable access, but even whether it can do so.

A copyright owner who applies for a subpoena under Section 512(h) is seeking to pursue copyright relief directly against the subscriber, not to pursue relief indirectly by forcing the ISP to disable access to the subscriber's infringing material. It

therefore would have made no sense for Congress to condition the availability of a subpoena, as the D.C. Circuit concluded that it did, on whether an ISP that concededly has no duty to disable access is nevertheless able to do so.

Charter suggests (Br. 40) that Congress incorporated the notification requirement into Section 512(h) for another reason: so that an ISP could access allegedly infringing material and verify for itself that the information is, in fact, infringing. But if that had been Congress's purpose, then Congress would have excused an ISP from complying with a subpoena if it determined that the materials in question are not infringing. In fact, Section 512(h) does nothing of the kind. To the contrary, it places an ISP under a disclosure obligation that is both immediate and unqualified: "Upon receipt of the issued subpoena, \* \* \* the service provider shall expeditiously disclose [the identifying information]." 17 U.S.C. § 512(h)(5). Section 512(h) thus makes clear that Congress did *not* intend to condition the availability of subpoenas on an ISP's independent judgment about whether the materials in question are actually infringing.

### **C. Immunizing Conduit ISPs from Having to Identify Infringing Subscribers Undermines the Goals of Section 512 and Federal Copyright Law**

1. As the foregoing discussion demonstrates, nothing in the text of Section 512(h) or any other provision of Section 512 suggests that Congress meant to

immunize conduit ISPs from having to identify their infringing subscribers. To the contrary, there is no textual basis for doubting that Congress meant what it actually said in Section 512(h): namely, that subpoenas may be issued to any "online provider," without regard to whether the ISP's role in the dissemination of infringing material involves data transmission or some other function.

Because the language of the statute is clear, there is no need to go beyond the statutory text itself to consider the legislative history and policies underlying the statute. See, e.g., *Ratzlaf v. United States*, 510 U.S. 135, 147-48 (1994); *Barnhill v. Johnson*, 503 U.S. 393, 401 (1992); *Coplin v. Fairfield Public Access Television Committee*, 111 F.3d 1395, 1407-1408 (8th Cir. 1997). In any event, nothing in the legislative history and policies of Section 512 undermines the foregoing statutory analysis. To the contrary, those factors reinforce the message of the statutory text.

As explained above, the legislative history of the DMCA demonstrates that Congress meant for Section 512 to embody a basic *quid pro quo*. In return for limiting the liability of ISPs for their role in the online dissemination of infringing materials, Congress sought to encourage ISPs "to cooperate [with copyright owners] to detect and deal with copyright infringements that take place in the digital networked environment." Conference Report at 72; *Ellison*, 2004 WL 235466 at \*3; see p. 7 *supra*. Congress thus sought to ensure that copyright owners would be able

to protect themselves against online infringement by enlisting the assistance of ISPs in proceeding against the infringers themselves.

Construing Section 512(h) to encompass all ISPs, regardless of whether they are engaged in data transmission or data storage, directly furthers these legislative goals. In contrast, reading Section 512(h) to exclude conduit ISPs undermines those goals. Doing so eviscerates the basic statutory *quid pro quo*, for it allows conduit ISPs to claim the safe-harbor benefits of Title II without offering any assistance to copyright owners in return. Rather than providing "strong incentives" for conduit ISPs "to cooperate to detect and deal with [online] copyright infringements" (Conference Report at 72), it gives them no incentive at all. And it leaves copyright owners without the one piece of information that is essential for them to enforce their legal rights against an anonymous online infringer – the infringer's identity. It does so, moreover, with respect to a class of online activity (peer-to-peer file transfers) that is one of the most serious sources of digital copyright infringement today.

By denying copyright owners recourse to Section 512(h) with respect to conduit ISPs, Charter's reading undermines not only the legislative goals of Section 512 itself, but also the underlying legislative goals of the Copyright Act, the statute of which Section 512 is a part. The Copyright Act vests copyright owners with, *inter alia*, exclusive rights to reproduce and distribute copyrighted works (17 U.S.C. §

106(1), (3)), and it entitles them to seek redress for copyright infringement against "[a]nyone who violates" those rights (*id.* § 501(a)). If a conduit ISP is free to withhold the identity of a subscriber who is engaged in online infringement, both the exclusive rights of reproduction and distribution and the right to seek redress for infringement are directly impaired. And while a copyright owner may be able to pursue the identity of an infringing subscriber by other means, such as filing a "John Doe" complaint against an unknown infringer and then seeking a subpoena against the infringer's ISP under Rule 45 of the Federal Rules of Civil Procedure, those alternatives lack the expedition that Congress rightly regarded as a critical feature of Section 512(h). See House Report at 61 (Congress "intends that such [subpoena] orders be expeditiously issued" and that "[t]he issuing of the order should be \* \* \* performed quickly for this provision to have its intended effect"). The network records that allow ISPs to determine which subscriber was using a particular IP address at a particular time are not maintained indefinitely, and if an ISP cannot be compelled to identify infringing subscribers promptly, the necessary information may be irretrievably lost.

2. For its part, the D.C. Circuit in *Verizon* did not identify anything in the legislative history to suggest that the goals of Section 512, or those of federal copyright law more generally, would be furthered by excusing conduit ISPs from

having to identify infringing subscribers. Instead, it relied chiefly on what it regarded as a *lacuna* – the supposed absence of any evidence in the legislative history that Congress was aware that Internet users "might be able directly to exchange files containing copyrighted material." 351 F.3d at 1238. The court reasoned that peer-to-peer software "was not even a glimmer in anyone's eye when the DMCA was enacted" in 1998 and that "[i]t is not the province of the courts \* \* \* to rewrite the DMCA in order to make it fit a new and unforeseen [I]nternet architecture." *Ibid.* (internal quotation marks omitted).

This reasoning is misconceived in three respects. First, as shown above, the text of Section 512(h) includes, rather than excludes, conduit ISPs. Accordingly, courts need not "rewrite the DMCA" in order to make it fit the phenomenon of peer-to-peer file transfers; it already does so.

Second, contrary to the D.C. Circuit's assumption, Congress was fully aware that Internet users "might be able directly to exchange files containing copyrighted material" (351 F.3d at 1238). While peer-to-peer services were not available in 1998, other forms of software that allowed direct user-to-user file transfers were both well known and widely used. The most obvious example was electronic mail, which was specifically discussed in the legislative history of Section 512. See, *e.g.*, House Report at 51 (discussing "e-mail transmission" as an example of an activity "in which

a service provider plays the role of a 'conduit'"). Another commonly used example was so-called File Transfer Protocol (FTP) software, which allows a computer user to make files on his own computer available for downloading to other computers. See, e.g., *Shea ex rel. American Reporter v. Reno*, 930 F. Supp. 916, 928 (S.D.N.Y.1996) (summarizing FTP technology), *aff'd sub nom. Reno v. Shea*, 521 U.S. 1113 (1997). Congress included a safe harbor for conduit ISPs in Section 512 precisely because it knew that online copyright infringement takes forms in which an ISP's only role is data transmission. Thus, while the specific phenomenon of peer-to-peer file transfers may not have been within Congress's contemplation, peer-to-peer file transfer is simply a specific instance of a more general problem that Congress manifestly *was* aware of when it drafted Section 512.

Finally, at a more general level, the D.C. Circuit's insistence on evidence that Congress anticipated peer-to-peer file transfers and meant to bring them within the scope of Section 512(h) misconceives the respective roles of Congress and the courts. The general goals of Section 512 are abundantly clear, and subjecting conduit ISPs to subpoenas directly furthers those goals. In these circumstances, it will not do for a court to insist that the legislature say in so many words what is otherwise evident from the statutory text and legislative history. As the Supreme Court has observed, "[t]he Legislature has the power to decide what the policy of the law shall be, and

\* \* \* it is not an adequate discharge of duty for courts to say: We see what you are driving at, but you have not said it, and therefore we shall go on as before.'" *United States v. Hutchinson*, 312 U.S. 219, 235 (1941) (quoting *Johnson v. United States*, 163 Fed. 30, 32 (1st Cir. 1908) (Holmes, J.)). That, in substance, is the approach taken by the D.C. Circuit in *Verizon*. It would disserve both the text of Section 512 and the Congressional policies behind it if this Court were to follow suit.

## **II. Section 512(h) Does Not Exceed the Limits of the Judicial Power Under Article III**

### **A. Section 512(h)'s Requirements Ensure That an Article III Controversy Exists Between the Copyright Owner and the Alleged Infringer**

1. It is a commonplace that the "judicial Power of the United States" is confined to cases and controversies within the ambit of Article III. The heart of Charter's Article III argument (Br. 22-27) is that Section 512(h) authorizes district courts to issue subpoenas in the absence of a pending case or controversy and, in so doing, necessarily crosses the boundaries of Article III. Charter does not deny that when Section 512(h) is employed after a copyright owner has filed a complaint against an alleged infringer, the controversy between the copyright owner and the infringer suffices to meet the demands of Article III. But Charter insists that Section



512(h) is categorically unconstitutional under Article III whenever it is employed before the filing of a complaint against the infringer.

The central fallacy of this argument is that it confuses the *existence of an Article III controversy* with the *pendency of a complaint*. It can be assumed for present purposes that the judicial power may be exercised only in the context of an actual controversy under Article III. But it is a *non sequitur* that the judicial power is confined to situations in which a lawsuit is pending. The filing of a complaint does not create a controversy under Article III; it is simply a procedural mechanism for bringing an existing controversy before the court. As long as an actual controversy in the Article III sense exists, a federal court is free to exercise judicial power within the limits imposed by Congress, and Congress in turn is free to prescribe whatever procedural mechanisms it thinks most appropriate for the invocation and exercise of judicial power. As the Supreme Court explained in *Nashville, Chattanooga & St. Louis Ry. v. Wallace*, 288 U.S. 249, 264 (1933):

[T]he Constitution does not require that [a] case or controversy should be presented by traditional forms of procedure, invoking only traditional remedies. The judiciary clause of the Constitution defined and limited judicial power, not the particular method by which that power might be invoked. It did not crystallize into changeless form the procedure of 1789 as the only possible means for presenting a case or controversy otherwise cognizable by the federal courts.

In this case, Congress has chosen to allow a copyright owner to seek a subpoena without first filing a complaint against the alleged infringer. Once it is recognized that the existence of an Article III controversy does not turn on the pendency of a complaint, the only question is whether the provisions of Section 512(h) are sufficient to confine the operation of this subpoena mechanism to settings in which an actual Article III controversy is present. As the district court in *Verizon* recognized, the answer to that question is affirmative. The statutory prerequisites for the issuance of a subpoena under Section 512(h) ensure that there is a genuine controversy arising under federal law between the copyright owner and the alleged infringer, and the existence of that controversy empowers the district court to issue a subpoena in aid of the copyright owner's efforts to vindicate his federal rights.

As discussed above, a requester who seeks a subpoena under Section 512(h) must present a notification that lays out the essential facts of the claimed infringement. The notification must identify both the work claimed to have been infringed and the material claimed to be infringing, and the requester must state that it "has a good faith belief that the use of the material in the manner complained of is not authorized" and that the information in the notification is accurate. 17 U.S.C. § 512(c)(3)(A)(ii)-(iii), (v)-(vi). Section 512(h) thus requires the requester to set forth the substantial equivalent of a *prima facie* claim of copyright infringement. See *Feist*

*Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 361 (1991); *Stenograph L.L.C. v. Bossard Associates, Inc.*, 144 F.3d 96, 99 (D.C. Cir. 1998). Whether the requester is correct that the alleged infringer has committed copyright infringement is, of course, a separate question. But the existence of an Article III controversy does not depend on whether the complaining party is ultimately entitled to prevail. *Cf. Bell v. Hood*, 327 U.S. 678, 682 (1946) (jurisdiction over claims arising under federal law "is not defeated \* \* \* by the possibility that the averments might fail to state a [valid] cause of action").

Contrary to Charter's suggestion, there is no tension between the district court's holding that Section 512(h) may be invoked outside the confines of pending lawsuits and the D.C. Circuit's decision in *Houston Business Journal v. Office of the Comptroller of the Currency*, 86 F.3d 1208 (1996). In *Houston Business Journal*, the D.C. Circuit held that a federal court lacks power to issue a subpoena in connection with an underlying legal controversy that "is not even asserted to be within federal-court jurisdiction." 86 F.3d at 1213. In so holding, the court did not suggest that Article III confines the subpoena power to pending federal suits. To the contrary, the court recognized that "the discovery devices in federal court stand available to facilitate the resolution of actions cognizable in federal court," and that Article III permits a federal court to exercise the subpoena power not only when it "has subject-

matter jurisdiction over the underlying action," but also "in certain circumstances where an action is cognizable in federal court." *Ibid.* The touchstone of constitutionality under *Houston Business Journal* is thus whether a subpoena is being sought in connection with a controversy that is *cognizable* in federal court. That is manifestly true of Section 512(h), both as a general matter and in the specific circumstances of this case.

2. The subpoena mechanism employed by Section 512(h) is hardly a radical innovation in federal judicial practice. See *In re Verizon Internet Services, Inc.*, 257 F. Supp. 2d 244, 251-54 (D.D.C.), *rev'd on other grounds sub nom. RIAA v. Verizon Internet Services, Inc.*, 351 F.2d 1229 (D.C. Cir. 2003). A variety of statutes and rules permit federal courts to issue discovery orders in connection with controversies that are not the subject of pending litigation in federal court. See Fed. R. Civ. P. 27; 2 U.S.C. § 388 (subpoena for election contests before House of Representatives); 7 U.S.C. § 2354(a) (subpoena for administrative claims under Plant Variety Protection Act); 9 U.S.C. § 7 (subpoena for arbitration proceedings under Federal Arbitration Act); 28 U.S.C. § 1782 (order compelling testimony and document production "for use in a proceeding in a foreign or international tribunal"); 35 U.S.C. § 24 (subpoena for administrative claims before Patent and Trademark Office); 45 U.S.C. § 157(h) (subpoena for arbitration proceedings under Railway Labor Act).

None of these provisions involves proceedings pending in federal courts. Indeed, two of them involve controversies that are beyond the cognizance of the federal courts altogether. 2 U.S.C. § 388 authorizes district courts to issue subpoenas in connection with election contests before the House of Representatives even though the Constitution makes each House the exclusive "Judge of the Elections, Returns and Qualifications of its own Members" (Art. I, § 5, cl. 1), and 28 U.S.C. § 1782 authorizes district courts to compel testimony for use in "foreign and international tribunals" even though the controversies heard by such tribunals will characteristically arise under foreign rather than federal law and will ordinarily be outside the scope of Article III. Moreover, 28 U.S.C. § 1782 authorizes a district court to compel the production of evidence even when no proceeding is pending in the foreign tribunal itself. See, *e.g.*, *In re Letter Rogatory*, 42 F.3d 308, 310 (5th Cir. 1995).

For present purposes, perhaps the most significant of these provisions is Rule 27, which authorizes district courts to issue orders compelling depositions "to perpetuate testimony regarding any matter that may be cognizable in any court of the United States." Like Section 512(h), Rule 27 permits a federal court to compel the giving of testimony with respect to controversies that "may be cognizable" in federal court but that are not the subject of pending federal litigation. The constitutionality

of Rule 27 has never been questioned, and for Article III purposes, the subpoena mechanism created by Section 512(h) is indistinguishable from Rule 27. See *Verizon*, 257 F. Supp. 2d at 252-54.

Although Charter itself makes no reference to Rule 27, the ISP *amici* point to three features of the rule that supposedly distinguish it from Section 512(h). However, the distinctions identified by the *amici* are neither fundamental nor constitutional in dimension.

The *amici* first note that Rule 27 requires the person seeking to conduct the deposition to aver that he "expects to be a party to an action cognizable in a court of the United States" in the future. But a bare averment under Rule 27(a) that the party expects to engage in future litigation offers no assurance that a cognizable suit will actually be commenced. See *Verizon*, 257 F. Supp. 2d at 253. And even if litigation *does* subsequently occur, there is no assurance that the court will ever adjudicate the merits of the controversy. It is routine for suits to be terminated prior to judgment, whether through settlement or otherwise. As a result, a federal court that is called on to order a deposition under Rule 27 may well never adjudicate the underlying controversy even if a complaint is filed. Yet the real and substantial possibility that the controversy will be resolved without any judicial determination of the parties' rights and liabilities in no way divests the court of the constitutional power to issue

compulsory process under Rule 27. For the same reason, the possibility that the genuine controversy between the copyright owner and the alleged infringer may be resolved without further litigation does not affect the constitutional power of the court to issue a subpoena under Section 512(h).

It is also noteworthy that the federal predecessors to Rule 27, which go back to the founding of the Republic, required no averment regarding the likelihood of future litigation. Rule 27 has its origins in the Judiciary Act of 1789, which provided that a federal circuit court "may, according to the usages in chancery[,] direct" the taking of depositions *in perpetuam rei memoriam* "if they relate to matters that may be cognizable in any court of the United States." 1 Stat. 88, 90; Rev. Stat. § 866 (same). In contrast to Rule 27, the Judiciary Act of 1789 did not require the party seeking the testimony to aver that he expected to be party to a future suit cognizable in federal court. The First Congress thus does not appear to have understood Article III to condition the issuance of compulsory process on the probability of future litigation – and the First Congress's understanding has special weight in resolving constitutional questions. See *Marsh v. Chambers*, 463 U.S. 783, 790 (1983).

The *amici's* second suggested distinction is that Rule 27 is designed to preserve known testimony from loss rather than serve as a discovery device. That is indeed a distinction – but the *amici* offer no explanation of why it is significant for Article

III purposes, and we are aware of none. In practice, moreover, Section 512(h) often will perform precisely the same preservation function as does Rule 27, since as noted above, the ISP records that link IP addresses with subscribers are often discarded within a relatively short period of time. See *Verizon*, 257 F. Supp. 2d at 253-54.

The *amici's* final purported distinction is that Rule 27 provides for adversarial proceedings before any judicial process issues, while subpoenas are issued under Section 512(h) on an *ex parte* basis (as, of course, are conventional subpoenas issued under Rule 45). But nothing in Article III confines the exercise of judicial power to proceedings conducted on an adversarial rather than *ex parte* basis. For example, federal courts have the unquestioned authority to issue temporary restraining orders – a vastly more serious and invasive exercise of judicial power than the issuance of a subpoena – on an *ex parte* basis. See Fed. R. Civ. P. 65(b). The *ex parte* character of a proceeding may (or may not) implicate the demands of the Due Process Clause, but it has no bearing on the operation of Article III.

Thus, in the end, there are no constitutionally significant differences between Rule 27 and Section 512(h). If the latter provision is constitutional, the former provision is constitutional as well.

**3.** In addition to arguing that Section 512(h) authorizes the issuance of subpoenas in the absence of any Article III controversy, Charter suggests that Section



512(h) violates Article III by converting the federal courts into "free floating investigative bodies" (Br. 23). However, when a clerk issues a subpoena under Section 512(h), he is performing precisely the kind of routine function that he performs whenever he is called on to issue a garden-variety subpoena *duces tecum* under Rule 45. Section 512(h) does not transform the clerk, and through him the court, into a "free floating investigative body." The initiative for the issuance of a subpoena under Section 512(h) rests exclusively with the copyright owner, not the clerk, and the copyright owner must be able to identify specific past acts of copyright infringement before Section 512(h) can be invoked. Moreover, when the copyright owner properly invokes Section 512(h), the clerk has no power to conduct an open-ended inquiry into potential copyright infringement. Instead, the subject matter of a subpoena under Section 512(h) is limited to a single, narrowly defined subject: the identity of the alleged infringer. When a clerk issues such a subpoena, his function does not differ in any material respect from the functions routinely – and constitutionally – performed by him under provisions like Rule 45.

**B. An Article III Controversy Exists Between the Copyright Owner and the Internet Service Provider**

As the foregoing discussion demonstrates, the subpoena mechanism created by Section 512(h) satisfies the requirements of Article III because it is tied to the

existence of an actual controversy between the copyright owner and the alleged infringer. In addition, Section 512(h) is tethered to another Article III controversy – the controversy between the copyright owner and the online service provider over disclosure of the identity of the infringing subscriber. Section 512(h) subjects online subscribers to an obligation under federal law to disclose specified information to copyright owners and establishes a mechanism for copyright owners to enforce that disclosure obligation in federal court. The adversity between the copyright owner and the online subscriber regarding disclosure of the subscriber's identity constitutes an independent Article III controversy sufficient to sustain resort to the subpoena power under Section 512(h).

There is nothing either novel or constitutionally doubtful about an Act of Congress that requires a private party to disclose specified information and permits the beneficiary of the disclosure obligation to compel disclosure in federal court. For example, the Employee Retirement Income Security Act (ERISA) obligates pension plan administrators to make specified information available to plan beneficiaries, and an administrator who fails to disclose requested information is subject to suit by the beneficiary in federal court. 29 U.S.C. § 1132(a)(1)(A), (c)(1). The Emergency Planning and Community Right-to-Know Act, 42 U.S.C. §§ 11001 *et seq.*, requires owners and operators of industrial facilities to disclose specified information about

hazardous chemicals used in those facilities, and any person may bring a civil suit in federal court against an owner or operator who fails to make the required disclosures. 42 U.S.C. §§ 11021(a), 11046(a)(1), (b). Similarly, Title X of the Toxic Substances Control Act obligates sellers of residential property to disclose the presence of lead-based paint to purchasers, and the failure to comply with that disclosure obligation subjects the seller to, *inter alia*, a private suit to enforce the disclosure obligation. *Id.* § 4582d(a)(1)(B) (disclosure); *id.* §§ 2619, 2689, 4582d(d)(5) (enforcement).

The only distinction between Title II of the DMCA and these statutes is that Section 512(h) provides for the copyright owner to invoke the court's assistance by applying for a subpoena rather than filing a complaint. But that is a distinction without a difference for Article III purposes, for Congress has the authority to "provid[e] remedies and defin[e] procedure in relation to cases and controversies in the constitutional sense," and in "[e]xercising this control of practice and procedure the Congress is not confined to traditional forms or traditional remedies." *Aetna Life Ins. Co. of Hartford v. Haworth*, 300 U.S. 227, 240 (1937) (internal quotation marks omitted).

## **II. Section 512(h) Does Not Violate The First Amendment**

### **A. The Procedures for Obtaining a Subpoena under Section 512(h) Satisfy the First Amendment**

The subpoenas at issue in this case involve individuals who are alleged to have engaged in wholesale violations of the Copyright Act by illegally offering hundreds of copyrighted sound recordings for downloading over the Internet. It is undisputed that the First Amendment offers no protection for copyright infringement. *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 568 (1985); *Zacchini v. Scripps-Howard*, 433 U.S. 562, 574-78 (1977). Moreover, the subpoenas impose no legal disability whatsoever on the subscribers themselves; only a separate suit for copyright infringement can do that.

Accordingly, Charter does not contend that these subpoenas violate the First Amendment rights of subscribers who are engaged in the unauthorized distribution of copyrighted materials, much less Charter's own First Amendment rights. Instead, Charter asserts that Section 512(h) is unconstitutional as applied to subscribers who are *not* engaged in copyright infringement, but rather are engaged in non-infringing expression. Charter argues that persons who engage in expression over the Internet have a First Amendment interest in anonymity and that Section 512(h) lacks the procedural safeguards required to protect that interest.

This procedural objection to Section 512(h) is without merit for two basic reasons. First, the First Amendment does not impose any procedural preconditions on the disclosure of subscriber identities under Section 512(h). Second, even if it did, Section 512(h)'s procedures would be sufficient to pass constitutional muster.

With respect to the first of these points, Charter's procedural claim is predicated on Supreme Court decisions involving statutes that are specifically intended to suppress speech. For example, in *Blount v. Rizzi*, 400 U.S. 410 (1971), the case on which Charter places principal reliance, the Supreme Court was presented with statutes that permitted the Postmaster General to exclude allegedly obscene materials from the public mail. The Supreme Court held that the statutes, as an "administrative censorship scheme," were unconstitutional because they lacked procedural safeguards to minimize the risk that non-obscene materials would be improperly suppressed. 400 U.S. at 417. In contrast to the statutes at issue in *Hicks* and other cases relied on by Charter, Section 512(h) imposes *no* restraint on speech and is not intended to prohibit expression in any way. See *Verizon*, 257 F. Supp. 2d at 261-62. Nothing in *Blount* suggests that such a law must have particular procedural safeguards in order to pass muster under the First Amendment.

In any event, as pointed out by the district court in *Verizon*, Section 512(h) possesses ample procedural safeguards to minimize the risk that persons who are

engaged in protected speech over the Internet will have their identities improperly disclosed. See *Verizon*, 257 F. Supp. 2d at 262-64. As explained above, a party requesting a subpoena under Section 512(h) must identify the infringing material, assert a good faith belief that the use of the material unauthorized, and swear under oath that the information will only be used to protect rights under the Copyright Act. Any person who knowingly misrepresents that the material or activity underlying a subpoena is infringing is liable for damages, costs, and attorney's fees. 17 U.S.C. § 512(f). And an online service provider that believes a subpoena is unfounded may make a timely objection to compliance and, by so doing, shift to the requester the burden of obtaining a judicial order compelling disclosure of the information. These safeguards "are precisely the type of procedural requirements other courts have imposed" in non-copyright cases "to compel a service provider to reveal the identity of anonymous Internet users." *Verizon*, 257 F. Supp. 2d at 264 n.23. The First Amendment demands nothing more here.

**B. Section 512(h) Is Not Unconstitutionally Overbroad**

Charter argues that the district court should have quashed RIAA's subpoenas with respect to every one of the more than two hundred subscribers whose identities are at issue in this case, regardless of whether any of them – much less all of them – were actually engaged in protected expression. Charter is thus contending that since

Section 512(h) is unconstitutional (in Charter's view) as applied to subscribers who are not infringers, it may not be applied to any subscriber, even those who are infringers and who hence have no conceivable First Amendment claim of their own.

As we have just shown, Section 512(h) satisfies the requirements of the First Amendment even with respect to subscribers who are engaged in protected expression rather than unprotected copyright infringement. But even if Section 512(h) were unconstitutional as applied to those subscribers, Charter would not be entitled to the kind of wholesale invalidation of the statute that it now seeks. To invalidate Section 512(h) on an across-the-board basis, Charter would have to demonstrate that the statute is unconstitutionally overbroad – and that Charter cannot possibly do.

The overbreadth doctrine "is, manifestly, strong medicine," to be employed "sparingly and only as a last resort." *Broadrick v. Oklahoma*, 413 U.S. 601, 613 (1973). "Rarely, if ever, will an overbreadth challenge succeed against a law or regulation that is not specifically addressed to speech or to conduct necessarily associated with speech \* \* \* ." *Virginia v. Hicks*, 123 S. Ct. 2191, 2199 (2003); *Broadrick*, 413 U.S. at 612-13. Even when a statute *is* "specifically addressed to speech" or expressive conduct, the party seeking to invalidate the law on overbreadth grounds must "show[] that [the] law punishes a 'substantial' amount of protected free speech," "not only in an absolute sense, but also relative to the scope of the law's

plainly legitimate applications \* \* \* ." *Hicks*, 123 S. Ct. at 2196, 2197 (quoting *Broadrick*, 413 U.S. at 615). Moreover, mere speculation about potentially unconstitutional applications will not suffice. Instead, "[t]he overbreadth claimant bears the burden of demonstrating, from the text of [the law] and from actual fact, that substantial overbreadth exists." *Id.* at 2198 (internal quotation marks omitted; bracketed text added by Court).

Section 512(h) is manifestly constitutional under these standards. As a threshold matter, Section 512(h) "is not specifically addressed to speech or to conduct necessarily associated with speech \* \* \* ." *Hicks*, 123 S. Ct. at 2199. The conduct at which Section 512(h) is directed is the unlawful reproduction and distribution of copyrighted works over the Internet. When a subscriber illegally distributes computer files containing someone else's performance of copyrighted music, he himself is not engaging in expression of any sort. Because the conduct at which Section 512(h) is directed does not involve expression at all, the overbreadth doctrine simply does not come into play.

Moreover, even if the transmission of illegally copied sound recordings could somehow be regarded as expressive conduct, Charter has utterly failed to carry its "burden of demonstrating, from the text of [the law] and from actual fact, that substantial overbreadth exists." *Hicks*, 123 S. Ct. at 2198. Section 512(h) is, on its



face, directed exclusively at copyright infringement – an activity that is wholly unprotected by the First Amendment. The statute cannot lawfully be invoked unless the requester identifies the work claimed to have been infringed and the material claimed to be infringing, has a good faith belief that the use of the material in the manner complained of is not authorized, and makes a sworn declaration that the subpoena is being sought to obtain the identity of an alleged infringer and that such information will only be used for the purpose of protecting rights under the Copyright Act. 17 U.S.C. §§ 512(c)(3)(A), 512(h)(2)(C).

Given these statutory prerequisites, there is nothing on the face of the statute to suggest that persons who are engaged in protected expression, rather than copyright infringement, will routinely have their identities disclosed pursuant to subpoenas issued under Section 512(h). Nor has Charter offered any evidence that Section 512(h) is in fact being used or abused in a significant number of cases to obtain information that falls outside the intended scope of the provision. Instead, it simply asserts (Br. 40) that peer-to-peer software *can* be put to non-infringing uses. That is true as a theoretical matter, but when subscribers use peer-to-peer software to disseminate scores of files bearing the titles of copyrighted songs, there is no reason to infer that they are doing anything other than what they appear to be doing – engaging in wholesale copyright infringement. See, *e.g.*, SA105A, 107A, 109A,

111A, 113A (lists of files bearing titles of copyrighted songs). Unsupported speculation about how peer-to-peer software *could* be used, and hence how Section 512(h) subpoenas *could* result in the disclosure of anonymous speakers' identities, falls far short of "demonstrating, from the text of [the law] and from actual fact, that substantial overbreadth exists." *Hicks*, 123 S. Ct. at 2198. Charter's implicit overbreadth claim may therefore be rejected out of hand.

### CONCLUSION

For the foregoing reason, the judgment of the district court should be affirmed.

Respectfully submitted,

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February 24, 2004

## **CERTIFICATE OF COMPLIANCE**

I hereby certify that this brief complies with the type-volume limitation in Rule 32(a)(7)(B) of the Federal Rules of Civil Procedure. The brief contains 11,847 words, as determined by Corel WordPerfect 9.

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## CERTIFICATE OF SERVICE

I hereby certify that on February 24, 2004, I filed and served the foregoing BRIEF FOR THE UNITED STATES AS INTERVENOR AND *AMICUS CURIAE* by causing the required number of copies of the brief to be filed with clerk of the court and served on the following counsel by first-class mail:

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