

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

A HOLISTIC APPROACH TO THE DIGITAL MILLENNIUM

COPYRIGHT ACT

Ryan Mitchell

**ABSTRACT**

This article takes a multi-pronged approach to a single problem: reconciling the watershed Digital Millennium Copyright Act (DMCA) with copyright proper. In the past decade or so, litigants and courts have sought to define just what sort of rights the DMCA creates. Plaintiffs have emphasized technical interpretations of the statute where it purported to create a cause of action and brought suits to vindicate interests that often had little to do with their copyrighted works; on the other hand, defendants have sought to shield themselves with standard copyright defenses such as fair use and ignore the reality that the DMCA makes illicit different conduct and creates new rights for the copyright holder. There is a middle-ground between creation of a “supercopyright” on one side, and a superfluous statute on the other. That said, I advocate an approach utilizing statutory interpretation and a judicial rule of reason to focus on whether a plaintiff is seeking to protect the value of their copyrighted work, or is merely using the copyrighted work as a necessary technicality in a DMCA claim to enforce some other non-copyright interest. In addition, other judicial doctrines, including standing and copyright misuse have a role to play in weeding out DMCA claims premised on hypothetical injuries and oppressive uses of the copyright grant respectively. Given the increasing importance of consumer electronics and digital information in our world, a multitude of approaches is appropriate to carry out Congress’s intention that the careful balance in our copyright law continues in the digital age.

**TABLE OF CONTENTS**

I.	INTRODUCTION .....	1
II.	WAS IT CONGRESS’S INTENTION TO CREATE A NEW INTELLECTUAL PROPERTY REGIME?.....	3
	A. <i>A Quick Overview of the DMCA’s Anticircumvention Provisions.</i> .....	4
	B. <i>Congressional Cognitive Dissonance: Textualist Readings of the DMCA are at Odds with Congressional Intent</i> .....	11
III.	JUDICIAL REACTIONS TO OVERREACHING WITH THE DCMA.....	29
	A. <i>Throwing Down the Gauntlet: The Judicial Response to Novel Uses of the DMCA</i> .....	30
	B. <i>Could Federal Standing Jurisprudence Weed Out Improper DMCA Claims?</i> .....	44
	C. <i>Reflections of DMCA Caselaw in the § 1201(a)(1) Rulemaking Procedure.</i> .....	47
	D. <i>A Word on Copyright Misuse</i> .....	52
IV.	CONCLUSION .....	60

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

**I. INTRODUCTION**

Film director Spike Jonze, in a telephone interview with the New York Times, recalled how he felt about the leak onto the Internet of a short film he had recently completed, and had planned to sell online: “This is the first time it’s happened to me, and it is a weird feeling, like: ‘Wait a second — I wasn’t ready to put that out! That’s mine. Uh, no, I guess its not mine anymore.’”<sup>1</sup> According to the news report, the film had been viewed more than 172,369 times, and perhaps millions of times. On the idea of still putting the film up for sale on Apple’s online music store, iTunes, Jonze said, “I don’t know if that makes any business sense at all, because once it’s out there, it’s out there.”<sup>2</sup> Such is the conundrum of the creative copyright owner. Digital distribution allows for easy access to an audience, and easy access by the audience—sometimes to the dismay of the artist or author seeking control over their work. Congress’ solution was the byzantine Digital Millennium Copyright Act.

The Digital Millennium Copyright Act of 1998 (DMCA)<sup>3</sup> represents a significant shift in the paradigm for protection of copyright owners’ rights. This article advocates a holistic approach to interpreting and applying what are known as the “anticircumvention provisions” of the Digital Millennium Copyright Act. This approach rests on several premises that will be elaborated on: first, the Digital Millennium Copyright Act, despite its elaborate structure and accompanying legislative history, does not, at least by its plain language, create protection for

---

<sup>1</sup> David Itzkoff, *Spike Jonze’s Kanye West Film Is Leaked*, N.Y. TIMES, Oct. 24, 2009, at C1.

<sup>2</sup> *Id.*

<sup>3</sup> Pub. L. No. 105-304, 112 Stat. 2360 (1998) (codified in scattered sections of 17 U.S.C.; 17 U.S.C. §§ 1201-1205, the “anticircumvention provisions,” are the focus of this paper).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

digital works that comports with traditional copyright principles. Second, Congress is unlikely to amend the DMCA anytime in the near future. Third, the courts have traditionally played an active role in shaping the contours of copyright protection and this active role is more important than ever in an area of the law highly susceptible to technological change. The protection given copyrighted works is more than the product of legislative fiat—it is also the result of judicially created doctrines such as fair use and misuse. The new statutory structure created by Congress needs to incorporate these doctrines if the DMCA is to stand with copyright, not apart from it. Finally, any approach to drawing the scope of the DMCA’s protection must recognize that there is no quick fix, no single doctrine, that will definitively demarcate the outer bounds of DMCA protection for works.

Taking these premises together, this paper seeks to set forth a holistic approach to harmonizing the DMCA with copyright proper. The purpose of harmonizing the DMCA with the Copyright Act of 1976 is to utilize the DMCA to protect the copyrightable elements of digital works, and scrupulously avoid creating a *sui generis* regime—paracopyright—that is related to copyright in name only. The DMCA is nearly as broad in scope as the Copyright Act itself, and as enacted shows far less restraint in its protection of copyright owners' works. For instance, the DMCA's protective embrace potentially expands far beyond the traditional subject matter of copyright: recent cases highlight attempts by durable goods manufacturers—makers of printers and garage door openers—to protect their handiwork under the DMCA.<sup>4</sup> No magic bullet theory can realistically be expected to solve the courts' dilemma in applying a statute that

---

<sup>4</sup> Chamberlain Group, Inc. v. Skylink Techs., Inc. (Chamberlain III), 381 F.3d 1178(Fed. Cir. 2004); Lexmark Int’l, Inc. v. Static Control Components, Inc. (*Lexmark*), 387 F.3d 522 (6th Cir. 2004).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

threatens to supplant copyright in the name of protecting it. Instead, statutory interpretation, importation of the copyright misuse doctrine, and scrutiny of the uses to which plaintiffs are putting their rights under the DMCA, are the core of a holistic approach to harmonizing the DMCA with the rest of copyright. Only by recognizing that statutory interpretation and the judicial policy levers each have a role to play can the courts shape a coherent DMCA congruent with copyright law.

II. WAS IT CONGRESS’S INTENTION TO CREATE A NEW INTELLECTUAL PROPERTY REGIME?

For the impatient reader, the answer is “no.” For those unwilling to take my conclusion on faith alone however, this section attempts to explain how that answer is divined from reading the tea leaves of legislative history. The question of whether the DMCA is an intellectual property regime unto itself—“paracopyright”— is the most fundamental determination to be made before drawing any other conclusions about how the statute should be applied in a given case.<sup>5</sup> In a sentence, characterizing the DMCA as paracopyright is to brand it as a regime “designed to strengthen copyright protection by regulating conduct which traditionally has fallen outside the regulatory sphere of intellectual property law.”<sup>6</sup> Whether or not the DMCA is a *sui generis* regime is more than a question of regulating new kinds of conduct; treating the DMCA as *sui generis* intellectual property protection frees it from the moors of the Copyright Act of 1976 and important doctrines such as the idea/expression dichotomy, fair use, misuse, and the temporal limitation on protection of works. A Digital Millennium Copyright Act that stands alone is an

---

<sup>5</sup> See H.R. REP. No. 105-551, pt. 2, at 24 (1998) [hereinafter *H. Commerce Report*] (quoting a 1997 letter endorsed by sixty-two copyright law professors characterizing the DMCA’s anticircumvention provisions as “paracopyright”).

<sup>6</sup> *Id.*

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

attractive alternative to traditional copyright protection, and as more works move into the digital domain, copyright owners and content providers will increasingly turn to the statute that is unburdened by the traditional limitations on their exclusive rights.

*A. A Quick Overview of the DMCA's Anticircumvention Provisions.*

Any discussion of the DMCA requires a brief introduction to its idiosyncratic structure. This section does not attempt to decode a definitive meaning of the statute for the reader—that task is beyond the scope of this paper—so much as present the relevant portions that will be poured over in later sections. The language of the DMCA has been called “impenetrable”<sup>7</sup> and there is significant disagreement at times among courts and academics over the obtuse terminology Congress employed in the statute. Nevertheless, any discussion of the statute must start with an overview of Congress’s structuring of what are known as the “anticircumvention provisions.”<sup>8</sup> The DMCA’s often impenetrable and inconsistent language makes an examination of its overall structure particularly important. By looking at the DMCA’s structure, one can transcend the strange legislative lexicon, determine what the aim of the statute is, and avoid the interpretative disconnect that occurs when one merely seeks to apply sections of the statute without reference to the whole or what Congress said it was trying to accomplish.

With the anticircumvention provisions of the DMCA, Congress sought to protect digital works by prohibiting the circumvention of “technological measures.” Technological measures are electronic systems used by copyright owners to control access to and use of works embodied

---

<sup>7</sup> David Nimmer, *Appreciating Legislative History: The Sweet and Sour Spots of the DMCA's Commentary*, 23 CARDOZO L. REV. 909, 964 (2002).

<sup>8</sup> 17 U.S.C. §§ 1201 *et seq.* (2006).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

in a digital form. Congress delineated two different types of technological measures to be protected. First, Congress outlawed the circumvention of “a technological measure that *effectively controls access* to a work protected under this title.”<sup>9</sup> Congress also made illegal the trafficking of devices that circumvent “protection afforded by a technological measure that *effectively protects a right* of a copyright owner under this title.”<sup>10</sup> This distinction, between technological measures that control access (access controls), and technological measures that “protect[] a right of a copyright owner” (rights controls) is an important nuance in the statute’s structure and language. For Part II of this paper, then, a central question to be addressed is why Congress would choose to differentiate among technological measures when other signatories to the WIPO treaties<sup>11</sup> such as the European Union have created uniform protection for all technological measures protecting copyrighted content.<sup>12</sup>

Congress did more than place access controls and rights controls in separate subsections within the statute, it also gave access controls more protection than it gave rights controls. Specifically, both access controls and rights controls are protected against the manufacture or

---

<sup>9</sup> *Id.* § 1201(a)(1)(A) (emphasis added).

<sup>10</sup> *Id.* § 1201(b)(1)(A) (emphasis added).

<sup>11</sup> WIPO Copyright Treaty art. 11, Apr. 12, 1997, S. TREATY Doc. No. 105-17 (1997); WIPO Performances and Phonograms Treaty art. 18, Apr. 12, 1997, S. TREATY DOC. 105-17 (1997).

<sup>12</sup> Maria Martin-Prat, *The Relationship Between Protection and Exceptions in the EU “Information Society” Directive*, in *ADJUNCTS AND ALTERNATIVES TO COPYRIGHT* 466 (Jane C. Ginsburg & June M. Besek eds., 2002) (noting that in the European Union “the same protection is granted to technologies controlling access and to technologies protecting rights (e.g. copy control technology).”).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

trafficking of devices that circumvent those types of technological measures.<sup>1314</sup> Only access controls, however, are protected under the law against the act of circumvention itself (as opposed to trafficking in devices that facilitate circumvention).<sup>15</sup> There is no corresponding ban against individual acts of circumvention of rights-controls; though, as noted before, there is a ban against manufacturing or trafficking in devices or services that facilitate such circumvention. Although exactly what Congress meant when it created the distinction between access controls and rights controls is discussed in the remainder of this paper, at least some nominal differentiation between the two can now be made for the reader without wading too deep into the interpretative milieu. Specifically, circumvention of access-controls has been described by Congress as “the electronic equivalent of breaking into a locked room in order to obtain a copy of a book.”<sup>16</sup> As will be shown later this definition is something of an oversimplification – a better definition is given by Professor R. Anthony Reese: “The term access is never defined, but is likely to be read broadly, probably extending to any act by which the work is made perceptible. Thus, any

---

<sup>13</sup> 17 U.S.C. § 1201(a)(2) (“No person shall ... otherwise traffic in any technology ... that — (A) is primarily designed or produced for the purpose of circumventing a technological measure that effectively controls access to a work protected under this title; [or] (B) has only limited commercially significant purpose or use other than circumventing a technological measure...”).

<sup>14</sup> 17 U.S.C. § 1201(b)(1) (“No person shall ... otherwise traffic in any technology ... that—(A) is primarily designed or produced for the purpose of circumventing protection afforded by a technological measure that effectively protects a right of a copyright owner under this title in a work or a portion thereof; [or] (B) has only limited commercially significant purpose or use other than to circumvent protection afforded by a technological measure that effectively protects a right of a copyright owner under this title in a work or a portion thereof.”).

<sup>15</sup> 17 U.S.C. § 1201(a)(1) (“No person shall circumvention a technological measure that effectively controls access to a work protected under this title.”).

<sup>16</sup> H.R. REP. No. 105-551, pt. 1, at 17 (1998) [hereinafter *H. Judiciary Report*].



**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

measure that controls a user’s ability to perceive a work will likely qualify for protection under § 1201(a).<sup>17</sup> The other type of technological controls, rights controls, are those controls that protect the copyright owner’s section 106 exclusive rights. Unlike the anticircumvention protections for access controls, which are defined by the ephemeral notion of “access,” section 1201(b)(1)’s protection of rights-controls is defined by reference to the copyright owner’s exclusive rights under § 106 of the Copyright Act of 1976, and applicable limitations and exceptions.<sup>18</sup> Rights-controls are also commonly referred to as “copy controls” because in their most widespread incarnations, e.g. DVD encryption technology, the primary exclusive right protected is the right of reproduction.<sup>19</sup> In sum, there are three core anticircumvention provisions: § 1201(a)(1)(A), barring circumvention of access controls; § 1201(a)(2), prohibiting trafficking in devices that facilitate circumvention of access controls; and § 1201(b)(1) prohibiting trafficking in devices that facilitate the circumvention of rights controls.

The DMCA is littered with narrow exemptions to liability, but because they are so narrow in effect their significance in the overall statutory scheme is limited. For instance, the Librarian of Congress has the power to create exemptions to access circumvention liability for classes of works where circumvention liability has a negative impact on noninfringing uses of a class of

---

<sup>17</sup> R. Anthony Reese, *Will Merging Access Controls and Rights Controls Undermine the Structure of Anticircumvention Law?* 18 BERKELEY TECH. L.J. 620, 627-28 (2003).

<sup>18</sup> 17 U.S.C. § 1201(b)(2)(B) (“a technological measure ‘effectively protects a right of a copyright owner under this title’ if the measure, in the ordinary course of its operation, prevents, restricts, or otherwise limits the exercise of a right of a copyright owner under this title.”); *See also*, Reese, *supra* note 17, at 628; Nimmer, *supra* note 7, at 949-50.

<sup>19</sup> *See, e.g.*, S. REP. No. 105-190 at 29 (1998) (referring to technological measures protecting right of reproduction as “copy controls”).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

works.<sup>20</sup> Although such a procedure might ostensibly result in the preservation of fair uses of works, because the Librarian’s authority is limited to exemptions for “particular classes of works,” the exemptions produced through the rulemaking process have been narrow and technical in scope.<sup>21</sup> Furthermore, the exemptions do not affect liability under the circumvention trafficking provisions—leaving providers of circumvention technology liable for facilitating access by individuals who were exempted from liability by the Librarian of Congress.<sup>22</sup>

At the time of this writing, the Librarian of Congress recently promulgated six new classes of works exempted from § 1201(a)(1)’s prohibition of circumvention of access controls.<sup>23</sup> Among the six new categories of exemptions is one allowing for circumvention of “wireless telephone handsets”—e.g., the Apple iPhone— for purposes of enabling “interoperability of ... applications” with the phones.<sup>24</sup> The explanation accompanying the final rule summarized the situation as follows:

[A]ny software or application to be used on the iPhone must be validated with the firmware that controls the iPhone’s operation. This validation process is intended to make it impossible for an owner of an iPhone to install and use third-

---

<sup>20</sup> 17 U.S.C. § 1201(a)(1)(B)-(D) (2006).

<sup>21</sup> See Robert C. Denicola, *Access Controls, Rights Protection, and Circumvention: Interpreting the Digital Millennium Copyright Act to Preserve Noninfringing Use*, 31 COLUM. J.L. & ARTS 209, 213, 213 n. 24 (2007-2008)

<sup>22</sup> 17 U.S.C. § 1201(a)(1)(E) (2006).

<sup>23</sup> Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies, 75 Fed. Reg. 43, 825 (July 27 2010) (to be codified at 37 C.F.R. pt. 201).

<sup>24</sup> *Id.* at 43, 828.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

party applications on the iPhone that have not been approved for distribution through Apple’s iTunes App Store.<sup>25</sup>

The purpose of this validation process is to maintain a closed iPhone “ecosystem” consisting only of iPhone software approved by Apple. Apple maintained that retaining say-so over the applications run on iPhones was necessary to protect consumers and Apple from harm. That argument was rejected by the Librarian of Congress, who noted that circumvention of Apple’s validation process for purposes of running third-party applications on the iPhone was likely fair use (and therefore an activity within the Librarian’s power to exempt from § 1201(a)(1)).<sup>26</sup> Just how meaningful this ruling is from a liability standpoint is not entirely clear. Apple was not going after individual iPhone owners for circumventing the access controls on their own phones, and neither does this ruling address the liability of those who facilitate the circumvention by individual iPhone users by providing the know-how or necessary code—trafficking in circumvention devices. The Librarian of Congress’s statement accompanying the final rule points this up: “Nor is this rulemaking about the ability to make or distribute products or services for purposes of circumventing access controls ... .”<sup>27</sup> Despite the chatter of commentators and parties regarding the legality of “jailbreaking”<sup>28</sup> the reality remains that the

---

<sup>25</sup> *Id.*

<sup>26</sup> *Id.* at 43, 830

<sup>27</sup> UNITED STATES COPYRIGHT OFFICE, STATEMENT OF THE LIBRARIAN OF CONGRESS RELATING TO SECTION 1201 RULEMAKING (July 26, 2010), <http://www.copyright.gov/1201/2010/Librarian-of-Congress-1201-Statement.html>.

<sup>28</sup> *See, e.g.*, Jenna Wortham, *In Ruling on iPhones, Apple Loses a Bit of Its Grip*, N.Y. TIMES, July 27, 2010, at B3.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

circumvention exception applies only to individual acts of circumvention, and does not absolve facilitators of circumvention from liability. This fact was not entirely lost on an Apple spokeswoman who, responding to a query whether “Apple will sue companies that publish or market jailbreaking software? ... [W]ould only say ... that Apple hasn’t *in the past* prosecuted such companies or individuals.”<sup>29</sup> Providers of circumvention technology remain at the mercy of the individual copyright-holder’s propensity to sue.<sup>30</sup>

One other noteworthy exemption is the exemption for reverse engineering of computer programs for the purpose of enabling interoperability between software.<sup>31</sup> The reverse engineering exemption is noteworthy because it sheds light on how Congress perceived (or failed to perceive) the DMCA would affect current fair use law. At the time the DMCA was drafted, there was a substantive body of case law dealing with reverse engineering of software as a fair use,<sup>32</sup> and yet the DMCA’s exemption is narrowly confined to reverse engineering only for “interoperability” of programs.<sup>33</sup>

Our overview of the statute’s structure ends with a somewhat enigmatic provision—section 1201(c). In section 1201(c) Congress disclaimed that anything in the DMCA affected the

---

<sup>29</sup> Cult of Mac, Apple’s Official Response to DMCA Jailbreak Exemption: It Voids Your Warranty, <http://www.cultofmac.com/apples-official-response-to-dmca-jailbreak-exemption-it-voids-your-warranty/52463> (last visited Aug. 13, 2010).

<sup>30</sup> For a more in-depth discussion of the final promulgated rule *see* discussion *infra* Part. II.C.

<sup>31</sup> 17 U.S.C § 1201(f).

<sup>32</sup> *See, e.g.,* Sega Enterprises Ltd. v. Accolade, Inc. 977 F.2d 1510 (9th Cir. 1992).

<sup>33</sup> *See generally* Craig Zieminski, *Game Over for Reverse Engineering?: How the DMCA and Contracts Have Affected Innovation*, 13 J. TECH. L. & POL’Y 289 (2008).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

“rights, remedies, limitations, or defenses to copyright infringement, including fair use, under this title.”<sup>34</sup> We are back where we began. If the DMCA creates a *sui generis* form of protection, then 1201(c)’s disclaimer is but hollow rhetoric for the circumventer facing suit—circumvention of access controls, or trafficking in circumvention devices would be a separate basis for liability apart from copyright infringement. The fact that the DMCA claims not to affect fair use—a defense to copyright infringement—does not mean that a DMCA defendant may raise fair use as a defense to a totally new form of liability imposed under the DMCA. Is section 1201(c) superfluous? Did Congress intend to create new rights without any of the limitations placed on traditional copyright? Answering these questions starts with an examination of early cases decided under the DMCA, and a comparison of the courts’ conclusions with Congress’s own in the legislative history.

*B. Congressional Cognitive Dissonance: Textualist Readings of the DMCA  
are at Odds with Congressional Intent*

They select out the people who create the literature of the land. Always talk handsomely about the literature of the land. Always say what a fine, a great monumental thing a great literature is. In the midst of their enthusiasm they turn around and do what they can to crush it, discourage it, and put it out of existence.<sup>35</sup>

---

<sup>34</sup> 17 U.S.C. § 1201(c).

<sup>35</sup> *Arguments Before the Comms. on Patents of the Senate and House of Representatives, conjointly, on S. 6330 and H.R. 19853*, 59th Cong. 116-21 (1906) (statement of Samuel L. Clemens). Clemens was certainly prescient in his belief that Congress has the tendency to say one thing, and do another. In the case of the DMCA, the legislative history often points towards the importance of balance between the copyright owner’s rights and those of the public,

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

Although at first glance it may seem hard to imagine Congress set out to create a wholly new intellectual property regime largely unconnected with copyright, after reviewing the language of the statute, some courts and commentators have come to just such a conclusion. The seminal case recognizing a strong distinction between traditional copyright protection and the remedies available to the copyright owner under the DMCA, is *Universal City Studios, Inc. v. Reimerdes*.<sup>36</sup> In *Reimerdes*, eight major motion picture studios brought suit under the DMCA against persons who had posted on their website a computer program known as “DeCSS” that allowed people who downloaded it to circumvent the electronic protection system studios used to protect the contents of their DVDs—mainly from copying.<sup>37</sup>

The DVDs distributed by the major motion picture studios are protected by a technological protection measure known as the “Content Scramble System” (CSS). As the district court characterized it, CSS “is an access control and copy prevention system for DVDs... .”<sup>38</sup> CSS is

---

including fair use, whereas the operative language of the DMCA does not inexorably lead to the conclusion that Congress desired let alone directed the courts to give any consideration to doctrines such as fair use in determining issues of liability under the DMCA. *See* Part I.B. In fairness to the reader and Clemens, the context of Clemens’s quotation is an argument for an increase in the length of the copyright protection term for authors. Clemens argued for a longer term of protection in the debates that lead to passage of the 1909 Copyright Act. Assuming one buys the argument that balance between freedom of information and incentive to create works through limited exclusive rights secured to authors results in progress in the arts and sciences, Clemens’s criticism is equally applicable to acts of Congress that result in overprotection as it was to his main concern—under-protection of authors’ exclusive rights from too short a copyright term.

<sup>36</sup> *Universal City Studios, Inc. v. Reimerdes (Reimerdes)*, 111 F.Supp. 2d 294 (S.D.N.Y. 2000), *aff’d sub nom. Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2d Cir. 2001).

<sup>37</sup> *Reimerdes*, 111 F.Supp. at 303.

<sup>38</sup> *Id.* at 308.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

an encryption system that scrambles the movie on a DVD and makes it playable only on compliant DVD players that contain the necessary “keys” to unscramble it.<sup>39</sup> The CSS technology is licensed by the “DVD Copy Control Association” (of which the major motion picture studios are members)<sup>40</sup> to the manufacturers of DVD players based on licensing agreements requiring them to maintain strict security over the CSS technology.<sup>41</sup> Manufacturers are also required to configure their DVD players in such a way so that they do not produce copyable output.<sup>42</sup> The motion picture studios maintained that the purpose of CSS was to prevent digital copying of their movies, and the availability of DeCSS undermined their ability to protect their DVDs from unauthorized reproduction. The studios alleged that the defendants were in violation of the DMCA’s anti-trafficking provisions—§§ 1201(a)(2) and 1201(b).<sup>43</sup> The district court agreed, and determined, probably correctly, that DeCSS allowed for the quick copying of movies that could then be distributed either over the internet or by hard copy.<sup>44</sup> Although the plaintiff motion picture studios were unable to provide evidence of a movie that had been decrypted specifically with DeCSS and then distributed, they were nevertheless able to

---

<sup>39</sup> *Reimerdes*, 111 F.Supp. at 309-10.

<sup>40</sup> Notice Pursuant to National Cooperative Research and Production Act of 1993; DVD Copy Control Association (“DVD CCA”), 66 Fed. Reg. 150, 40727-29, (Dep’t of Justice Aug. 3, 2001) (notice filed with DOJ Antitrust Division and FTC disclosing the membership of the DVD Copy Control Association).

<sup>41</sup> *Reimerdes*, 111 F.Supp at 310.

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at 316.

<sup>44</sup> *Id.* at 315.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

provide the court with convincing evidence of the distribution of decrypted copies of their copyrighted movies.<sup>45</sup> According to the district court, “The net of all this is reasonably plain ... the availability of DeCSS on the Internet effectively has compromised plaintiffs’ system of copyright protection for DVDs, requiring them to either tolerate increased piracy or to expend resources to develop and implement a replacement system unless the availability of DeCSS is terminated.”<sup>46</sup> The district court granted a permanent injunction enjoining the defendants from disseminating the DeCSS software on their websites.<sup>47</sup>

The heart of the discussion focuses around whether there need be any link between copyright liability, and DMCA liability. *Reimerdes*, and the appeal that followed, *Corley*, are worth discussing not because of their easy conclusion that the defendants were trafficking in unlawful circumvention technology; rather, it is the district and circuit courts’ summary negation of any link between a right in copyright, and a remedy under the DMCA that merits discussion. Relevant here are the defendants’ defenses which called on the courts (unsuccessfully) to interpret the statute in such a way so as to tie copyright infringement and circumvention liability under the DMCA.<sup>48</sup> We start in the district court.

---

<sup>45</sup> *Reimerdes*, 111 F.Supp. at 314-15.

<sup>46</sup> *Id.* at 315.

<sup>47</sup> *Universal City Studios, Inc. v. Reimerdes*, 111 F.Supp. 2d 346, 346-47 (2000).

<sup>48</sup> *Id.* (Defendants also made several constitutional arguments, but because the courts have held firm in defending the constitutionality of the DMCA, those defenses are beyond the scope of this paper.); *See, e.g., Corley*, 273 F.3d at 453-59; *321 Studios v. Metro Goldwyn Mayer Studios, Inc.*, 307 F. Supp. 2d 1085 1098-1104 (N.D. Cal. 2004); *United States v. Elcom*, 203 F. Supp. 2d 1111, 1122-42 (N.D. Cal. 2002).



**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

In the Southern District of New York the defendants argued that because their trafficking of DeCSS enabled fair uses of the plaintiffs' works they could not be contributorily liable as set out in *Sony Corp. of America v. Universal City Studios*.<sup>49</sup> Unlike the *Sony* defendants, the *Reimerdes* defendants were not being sued on a theory of contributory copyright infringement. The defendants' argument depended on the premise that contributory liability under the *Sony* doctrine was a necessary predicate to liability under the DMCA's anti-trafficking provisions. To be absolved of liability for contributory copyright infringement under *Sony*, the manufacturer of a device which facilitates infringing uses of works must show that the device in question nevertheless has "a substantial noninfringing use."<sup>50</sup> Analogously, the *Reimerdes* defendants argued that DeCSS was capable of substantial noninfringing use; therefore, they were not committing contributory copyright infringement by distributing it, and consequently could not be liable for trafficking in unlawful circumvention technology either.<sup>51</sup> The court found the contributory infringement argument "entirely without merit."<sup>52</sup> Before proceeding any further it should be noted that the *Reimerdes* decision's value is somewhat limited because the court's analysis revolves exclusively around the defendants' liability under § 1201(a)(2) for trafficking in devices that circumvent access controls, despite the plaintiffs' complaint including violation of

---

<sup>49</sup> 464 U.S. 417 (1984).

<sup>50</sup> *Id.* at 442.

<sup>51</sup> *Reimerdes*, 111 F.Supp. at 323.

<sup>52</sup> *Id.* at 324

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

§ 1201(b),<sup>53</sup> for whatever reason, neither the district court nor the court of appeals explicitly addressed defendants’ liability under that section.

The district court was on solid ground when it held that Congress did not intend to incorporate *Sony*’s “substantial noninfringing use” defense to contributory infringement into the DMCA’s anti-trafficking provisions. The statute itself is written in the language of vicarious liability set forth in *Sony*—albeit using a much stricter standard. Whereas *Sony* speaks of “substantial noninfringing use,” the DMCA imposes liability on traffickers of devices with “only limited commercially significant purpose or use other than” circumventing a rights or access control.<sup>54</sup> In the alternative, the DMCA also bans devices “primarily designed or produced for the purpose of” unlawful circumvention.<sup>55</sup> If one imagines trafficking in circumvention devices as the functional equivalent of contributory copyright infringement, then this language is an implicit lowering of the contributory infringement liability boom by Congress on the heads of circumvention device traffickers with a force that *Sony* did not countenance. Put another way, liability for contributory copyright infringement already reached the same conduct complained of in the *Reimerdes/Corley* litigation: if DeCSS was not capable of substantial noninfringing use, (and there is significant doubt that it was) then the defendants could just as easily have found themselves liable under *Sony*. Under the DMCA a finding of liability against the DeCSS defendants was more easily reached under the standard of “limited commercially significant purpose or use [other than circumvention]” compared to the *Sony* standard of no contributory

---

<sup>53</sup> See *Id.* at 316, n. 133.

<sup>54</sup> 17 U.S.C. §§ 1201(a)(2)(B), (b)(1)(B).

<sup>55</sup> 17 U.S.C. §§ 1201(a)(2)(A), (b)(1)(A).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

liability where there is a “substantial noninfringing use.”<sup>56</sup> Whereas the *Sony* contributory infringement standard requires a showing that copyright infringement would be enabled or induced by a defendant’s circumvention device, and conversely would absolve a defendant of liability where the device was capable of substantial noninfringing use, the DMCA presupposes that trafficking in circumvention devices is an unacceptable enablement of copyright infringement. Accordingly, the DMCA frames liability in terms of *circumventing* uses and *noncircumventing* uses, in comparison to *Sony* liability turning on *infringing* uses and *noninfringing* uses. DMCA access control circumvention liability is merely a proxy for copyright infringement, and trafficking liability an expansion of *Sony*’s contributory infringement standard.<sup>57</sup> It is recognized by Congress that in order to prevent copyright infringement in the digital age, it is sometimes necessary to prevent “fair uses as well as foul.”<sup>58</sup> An argument such as that advanced by the *Reimerdes/Corley* defendants for the transposition of the *Sony* contributory infringement scheme on top of the DMCA thus ignores that Congress has already rearranged the fair use field, albeit using the terminology of “circumvention.” The *Reimerdes* court recognized as much.<sup>59</sup> At least some of the legislative history also points to a

---

<sup>56</sup> Compare 17 U.S.C. §§ 1201(a)(2)(B), (b)(1)(B) and *Reimerdes*, 111 F.Supp. 294, with *Sony*, 464 U.S. at 442.

<sup>57</sup> See S. Rep. No. 105-190 at 29 (1998) (“Paralleling paragraph (a)(2), above, paragraph (b)(1) seeks to provide meaningful protection and enforcement of copyright owners’ use of technological protection measures to protect their rights under title 17 by prohibiting the act of making or selling the technological means to overcome these protections and *thereby facilitate copyright infringement.*”) (emphasis added).

<sup>58</sup> *Reimerdes*, 111 F.Supp. at 304.

<sup>59</sup> See *Id.* at 323.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

rejection of the *Sony* doctrine as the touchstone for liability under the DMCA,<sup>60</sup> and the district court noted this.<sup>61</sup>

Where the courts have gone astray is in failing to recognize that DMCA liability is nothing more than a proxy for copyright infringement liability. The legislative history bears out that Congress was thinking at least rudimentarily along this line. For instance, the purpose of § 1201(b)(1)'s protection of rights control measures was characterized by Congress as providing:

meaningful protection and enforcement of copyright owner's use of technological protection measures to protect *their rights under Title 17* by prohibiting the act of making or selling the technological means to overcome these protections and *facilitate copyright infringement*.<sup>62</sup>

In other words, § 1201(b) is invariably aimed at copyright infringement. The *Reimerdes* court framed the question posed by the defendants' defense as "whether the possibility of noninfringing fair use by someone who gains access to a protected copyrighted work through a

---

<sup>60</sup> See H. COMM. ON THE JUDICIARY, 105TH CONG., SECTION-BY-SECTION ANALYSIS OF H.R. 2281 AS PASSED BY THE UNITED STATES HOUSE OF REPRESENTATIVES ON AUGUST 4., 1998 9 (Comm. Print 1998) [hereinafter *Manager's Section-by-Section Analysis*] ("The *Sony* test of 'capab[ility] of substantial non-infringing uses,' while still operative in cases claiming contributory infringement of copyright, is not part of this legislation.").

<sup>61</sup> *Reimerdes*, 111 F.Supp. at 324 n.170 (citing HOUSE COMM. ON JUDICIARY, SECTION-BY-SECTION ANALYSIS OF H.R.2281 AS PASSED BY THE UNITED STATES HOUSE OF REPRESENTATIVES ON AUGUST 4, 1998 9 (Comm. Print 1998)). The district court's heavy reliance on the House Manager's Report for the "crystal clear" proposition that fair use has no place in the DMCA is not without its problems. As David Nimmer has noted, the manager's report represents the viewpoint of but one representative, is rife with argumentative statements directed at the committee reports, and contains numerous factual errors irreconcilably at odds with the bill as passed. See Nimmer, *supra* note 7, at 934-939 ("the Manager's report should not be considered authoritative on disputed portions of the Digital Millennium Copyright Act.").

<sup>62</sup> *H. Judiciary Report*, *supra* note 16, at 19 (emphasis added).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

circumvention technology distributed by the defendants saves the defendants from liability under Section 1201.”<sup>63</sup> The court answered in the negative: “nothing in § 1201 so suggests.”<sup>64</sup> This is overly simplistic. The court conducted its analysis of the defendants’ liability only under § 1201(a)(2), and accordingly used the term “access” as it framed the issue, but remember that in the case before it plaintiffs had alleged liability under § 1201(b) as well, so when the court alludes to deciding whether fair use negates “liability under Section 1201” as a whole it is inviting conflation of the two distinct sections. Confusing § 1201(a)(2) and § 1201(b) is a fundamental error in reading the DMCA, and it is impossible to determine how both sections protect the copyright owner’s interest using an analysis that refers to the sections interchangeably.<sup>65</sup>

Regarding § 1201(b)(1), Congress clearly struck a different balance than existed under *Sony v. Universal City Studios*, but it nevertheless made clear that its intention with § 1201(b) was solely to protect the exclusive rights of copyright holders.<sup>66</sup> The danger of the *Reimerdes* court’s disassociation of the DMCA from copyright is illustrated by a hypothetical case where a technological protection measure, which is a rights control within the letter of the statute, is

---

<sup>63</sup> *Reimerdes*, 111 F.Supp. at 323. Although the court used the phrase “access,” perhaps indicating that it was only concerned with § 1201(a) liability for circumvention of an access control, the defendants were a

<sup>64</sup> *Id.*

<sup>65</sup> See S. Rep. No. 105-190 at 12 (1998) (“The two sections are not interchangeable and many devices will be subject to challenge only under one of the sections.”).

<sup>66</sup> See *Id.* (“Section 1201(b) is designed to protect the traditional copyright rights of the copyright owner.”).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

circumvented, but that circumvention does not facilitate copyright infringement in any meaningful way.

Imagine, for instance, a forward thinking law school that imported all of its ancient documents currently stored on microfiche into a common, but proprietary, electronic file format, which we'll call "Abode." Unbeknownst to the law school, Abode includes a rights control that does not allow for the electronic copying of text from these ancient documents into new electronic formats of any kind. The original microfiche was used by the dean of the law school as kindling for his office fireplace. A few years later the law school decides it no longer wishes to license Abode's software, and decides to transfer all of the archived material into a new electronic format. Unfortunately, the transition to a new storage format is impossible due to the rights control restricting the reproduction of the archived material. In response, the law school's technical office hires an outside firm to create a "patch" or "hack" that allows for the reproduction of the archived documents in a different file format. The patch will operate only in conjunction with the particular licensed copies of "Abode" installed on the law school library's computer system, and will cease functioning after 30 days (the library believes the transition will be finished by then).<sup>67</sup> Has the contractor hired by the law school violated § 1201(b)(1) by creating and distributing the software patch to the law school?

---

<sup>67</sup> David Nimmer posits a somewhat similar thought exercise, although I use a different example that I believe to be less of an artificial abstraction. More importantly, Professor Nimmer's example is one that involves a circumvention which clearly does not facilitate copyright infringement under any circumstances. Nimmer is clear that the circumvention device cannot be used to disable a "general protection" scheme. By contrast, our hypothetical at least implies the threat of circumvention of a measure which actually protects copyrighted works. As explained above, the circumvention hack developed by the contractor, though limited in operation to a period of thirty days, and ostensibly useable only on the law school's copies of "Abode"

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

Our imaginary file format, Abode, uses a technological measure that meets the definition of a rights control. Although the technological measure on the copies of Abode circumvented by the law school only protects century-old public domain documents, on other copies of Abode that same measure protects all manner of copyrighted works of others also stored in the Abode format. Abode embodies a technological measure that “in the ordinary course of its operation, prevents restricts, or otherwise limits the exercise of a right of a copyright owner under this title”—a rights control.<sup>68</sup> Since the statute defines a rights control in terms of a technological measure that protects “a” right of “a” copyright owner, not protection of a right in any particular work (such as the one targeted by the circumvention), it does not seem material whether or not a copyrighted work is the target of the circumvention, so long as the technological measure, “in the ordinary course of operation” is protecting a copyrighted work somewhere.<sup>69</sup> This is the crux of the problem. Taking a strictly textualist approach to reading the statute allows for large swaths of uncopyrightable material or fair uses to be locked up behind rights controls (or access controls) backed by the legal force of the DMCA. As portrayed by the *Reimerdes* court, Congress and the DMCA are indifferent to this problem: “The fact that Congress elected to leave

---

nevertheless presents a circumvention threat in that the contractor’s knowhow could readily be utilized towards the creation of a circumvention device not so limited—rendering Abode’s rights control measures protecting other works useless. See David Nimmer, *A Riff on Fair Use in the Digital Millennium Copyright Act*, 148 U. PA. L. REV. 673, 737 (1999-2000) (positing an imaginary “JazzExtract” device designed specifically for the purpose of extracting electronically encrypted 1920s jazz recordings, and which is *not* “a machine that could be used generally for the nefarious goal of disabling general protections....”).

<sup>68</sup> 17 U.S.C. § 1201(b)(2)(B)

<sup>69</sup> See Denicola, *supra* note 21, at 229 (writing that the “case-by-case approach to rights controls ... seems incompatible with the language of the statute.”).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

technologically unsophisticated persons who wish to make fair use of encrypted copyrighted works without the means of doing so is a matter for Congress.”<sup>70</sup> An earlier decision, *RealNetworks, Inc. v. Streambox, Inc.*, endorsed a similarly broad view of the DCMA’s reach: “Equipment manufacturers in the twenty-first century will need to vet their products for compliance with § 1201 in order to avoid a circumvention claim, rather than *Sony* to negate a copyright claim.”<sup>71</sup> A distinction that *Reimerdes* and other early decisions were able to avoid was the difference between a rebalancing of the interests furthered by copyright in the digital context—and the creation of a new entitlement that renders copyright protection superfluous.

One of the first cases decided after the DMCA’s passage, *Sony Computer Entertainment America v. Gamemasters*,<sup>72</sup> illustrates the new protection paradigm the DMCA can create if its anticircumvention provisions are not read in conjunction with their purpose—to protect copyrighted digital works.<sup>73</sup> A comparison between *Gamemasters* and its pre-DMCA “counterpart,” *Lewis Galoob Toys, Inc. v. Nintendo of America*,<sup>74</sup> a case with nearly identical facts where no copyright infringement was found, points to the DMCA as the new demarcator

---

<sup>70</sup> *Reimerdes*, 111 F.Supp. at 324.

<sup>71</sup> *RealNetworks, Inc. v. Streambox, Inc.*, No. 2:99CV02070, 2000 WL 127311, \*8 (W.D. Wash. Jan. 18, 2000) (unpublished) (quoting 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 12A.18[B] (2009)).

<sup>72</sup> *Sony Computer Entertainment America v. Gamemasters*, (*Gamemasters*) 87 F. Supp. 2d 976 (N.D. Cal. 1999).

<sup>73</sup> See, e.g., *H. Judiciary Report*, *supra* note 16, at 10 (“When copyrighted material is adequately protected in the digital environment, a plethora of works will be distributed and performed over the internet.”)

<sup>74</sup> *Lewis Galoob Toys, Inc. v. Nintendo of America, Inc. (Galoob)*, 964 F.2d 965 (9th Cir. 1992).



**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

between liability and absolution—not a showing of copyright infringement.<sup>75</sup> In short, both *Galoob* and *Gamemasters* revolved around the defendants’ sale of a hardware accessory for the plaintiffs’ video game consoles. Defendant Galoob sold the “Game Genie” for the Nintendo Entertainment System, and defendant Gamemasters the “Game Enhancer” for Sony’s Playstation video game console. Both enabled users to cheat or use a handicap in the games they were playing by the addition of extra “lives” or modification of the games’ rules.<sup>76</sup> In addition, the “Game Enhancer” allowed for the play of so-called “import” games, that is, games legitimately sold in non-domestic markets such as Japan, but not normally sold for, or playable on, domestic (U.S.) versions of Sony’s video game console. In *Galoob* the Ninth Circuit affirmed the district court’s finding that the Game Genie did not constitute a derivative work, and more importantly, that the “slight alterations” worked by the Game Genie upon the individual user’s game experience were fair use of the copyrighted elements of Nintendo’s video games.<sup>77</sup> On a motion for a preliminary injunction, under virtually identical facts, the district court in *Gamemasters*, acknowledged the weakness of Sony’s copyright claim<sup>78</sup> but explicitly determined that it need not measure the strength of that claim because Sony was likely to succeed on its action under the DMCA.<sup>79</sup> The “access” control the Game Enhancer circumvented was Sony’s region coding

---

<sup>75</sup> See also Steve P. Calandrillo & Ewa M. Davison, *The Dangers of the Digital Millennium Copyright Act: Much Ado About Nothing?* 50 WM. & MARY L. REV. 349, 371 (2008) (making the comparison between *Galoob* and *Gamemasters*).

<sup>76</sup> *Galoob*, 964 F.2d at 967; *Gamemasters*, 87 F. Supp. at 981.

<sup>77</sup> *Galoob*, 964 F.2d at 971.

<sup>78</sup> *Gamemasters*, 87 F. Supp. 2d at 987.

<sup>79</sup> *Id.*

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

system (akin to the region codes on DVDs that make them playable only in certain geographic markets with the matching players). Commentators have forcefully argued that regional coding systems do not protect any of the exclusive rights of a copyright owner, including the right of distribution under § 106, due to the operation of the first sale doctrine in § 109 of the Copyright Act.<sup>80</sup> Consequently it is further argued that regional coding systems are neither access nor rights controls.<sup>81</sup> *Gamemasters* presents us, then, with a dubious “access control” which allows the copyright owner to capture a secondary market for add-on hardware accessories (such as the Game Enhancer which competed with Sony’s own “GameShark”) and make an end-run around the first sale doctrine.<sup>82</sup> The DMCA “violation” is the circumvention of a technological protection measure that protects not a copyrighted work, but the video game redistribution market which would normally operate unfettered due to the first sale doctrine, but instead is subjugated by Sony’s use of a nominal technological protection measure backed by the force of the DMCA.

One might object to the critique of *Reimerdes* and *Gamemasters* by pointing out that the courts were merely following Congress’s lead—after all, whatever Congress said about rights controls only being used to protect rights granted by copyright law, it was far less clear about what it believed the purpose of protecting “access controls” was to be. Nevertheless, the

---

<sup>80</sup> See Denicola, *supra* note 21, at 224-225.

<sup>81</sup> *Id.*

<sup>82</sup> See *Gamemasters*, 87 F. Supp. 2d at 988-989 (discussing defendant’s copyright misuse defense); See also discussion *infra* Parts II.A., B., & C. for judicial remedies available to prevent the use of copyright for the capture of secondary markets, as opposed to the market for the copyrighted work and any derivative works.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

legislative history, taken as a whole, shows a congressional conception of the DMCA not as a regime bent on preventing the circumvention of technological measures no matter what they might actually be protecting, but as new legal protections governing conduct hitherto not codified in Title 17, and yet still designed to serve the ends of traditional copyright protection. Nothing in the legislative history suggests that Congress conceived of the requirements that an access control “control access to a work protected under this title” and that a rights control “effectively protect[] a right of a copyright owner” as mere formalities for obtaining legal protection against circumvention. So our question is, how do we interpret a legislative history that paints Congress as Janus, declaring confidently on one side “that the digital environment poses a unique threat to the rights of copyright owners, and as such necessitates protection against devices that undermine those interests”,<sup>83</sup> and on the other, a legislature that readily admits “these regulatory provisions have little, if anything, to do with copyright law.”<sup>84</sup>

We’ve already touched on Congress’s intentions with rights controls to an extent, but the real question revolves around whether access controls must be tied to copyright. Access controls are, in a way, the heart of what the DMCA adds to existing copyright protection. Before the DMCA, there was no such thing as gaining unauthorized access to a work under copyright law. Certain rights of the copyright holder, such as the rights of distribution or reproduction, implicated notions of “access” to a work, but only indirectly.<sup>85</sup> One way of thinking about violations of those exclusive rights is as subsets of the broader activity of providing others

---

<sup>83</sup> *H. Commerce Report*, *supra* note 5, at 25.

<sup>84</sup> *Id.* at 24.

<sup>85</sup> *See* 17 U.S.C. § 106 (2006).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

unauthorized access to copyrighted material. One result of this conceptualization of access and the § 106 exclusive rights is the merger of access and rights controls, and the breakdown of the careful congressional distinction between §§ 1201(a) and 1201(b).<sup>86</sup> For present purposes, because the legal protection for access controls is not necessarily dependent on rights already enumerated in the 1976 Copyright Act, and possibly subsumes them, discussions of it in the legislative history are the natural place to look for Congress's expression, one way or the other, as to whether it indeed was seeking to prevent copyright infringement, or whether it was creating a sui-generis protection only tangentially related to copyright.

The House Commerce Committee's statement that "these regulatory provisions have little, if anything to do with copyright law" is certainly strong evidence that Congress intended to create a protection regime apart from copyright; so was the committee's attempt to move the anticircumvention provisions out of Title 17 and establish them as "free-standing provisions of law."<sup>87</sup> Yet ultimately this suggestion was not adopted, and the anticircumvention provisions of the DMCA remained in Title 17. However, even the Commerce Committee's own statements indicate an intention to protect copyrighted works, not to create new legal entitlements against the circumvention of technological measures generally regardless of what they are protecting. For instance, in discussing the definitions of certain terms used in what would become section 1201(a), the committee characterized access controls as "protections against unauthorized initial access to a copyrighted work."<sup>88</sup> This provision makes it clear that the committee was concerned

---

<sup>86</sup> See Reese, *supra* note 17.

<sup>87</sup> See H. Commerce Report, *supra* note 5, at 23-4.

<sup>88</sup> *Id.* at 39.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

with unauthorized access to *copyrighted* works, not merely the circumvention of technological protection measures generally. From this, one could argue that circumvention of an access control which protects a copyrighted work somewhere, but that in the particular act of circumvention under scrutiny, is not actually protecting a copyrighted work from unauthorized access, (similar to our ABODE example), does not implicate the committee’s concerns, and should not result in liability under the DMCA. This is the problem raised by the use of technological protection measures that nominally control access to copyrighted material, but in reality are being utilized to protect something other than the copyright holder’s interest in controlling “initial access” to the copyrighted elements of his work. The range of responses to this activity is addressed in Part II, *infra*.

The other committees that considered the DMCA also evinced indications that §§ 1201(a)(1) and (a)(2)’s protections were a means for protecting access to copyrighted works, not new rights worthy of protection in and of themselves. The Senate Judiciary Committee made plain that “sub-section 1201(a)(2) is designed to protect access to a copyrighted work.”<sup>89</sup> It probably isn’t unfair to say that the Senate Judiciary Committee’s understanding of the access control provisions is encapsulated by the following statement: “This is roughly analogous to making it illegal to break into a house using a tool, the primary purpose of which is breaking into houses.”<sup>90</sup> The statement is revealing in that mere possession of the burglary tools is not enough for a violation, the burglar must also use them for the illicit purpose—breaking into the house. Analogizing, the “house” element of access-control circumvention could be either a

---

<sup>89</sup> See S. Rep. No. 105-190 at 12 (1998).

<sup>90</sup> *Id.* at 11.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

technological protection measure that protects any copyrighted work, or it could be a technological protection measure that protects a copyrighted work which is the target of the circumvention. Luckily the House Judiciary Committee was also enamored with the burglary analogy and seems to have favored the latter interpretation: “the act of circumventing a technological protection measure put in place by a copyright owner to control access to a copyrighted work is the electronic equivalent of breaking into a locked room *in order to obtain a copy of a book*.”<sup>91</sup> The House Judiciary Committee’s commentary provides further evidence that circumvention of an access control is unlawful under § 1201(a) only when that technological protection measure actually protects a copyrighted work the circumventer has sought to access: “Subsection (a) applies when a person has not obtained authorized access to a copy ... of a work for which the copyright owner has put in place a technological measure that effectively controls access to his or her work.”<sup>92</sup> Although the statute itself may seem clear enough on this point, by its plain text it does not attempt to distinguish between circumvention to access uncopyrightable material and circumvention to access a copyrighted work; instead it distinguishes between technological measures that protect copyrighted works, and those that don’t. Consequently, commentators and courts have called for recognition of a judicial exception for circumvention, or

---

<sup>91</sup> *H. Judiciary Report, supra* note 16, at 17 (emphasis added).

<sup>92</sup> *Id.* (emphasis added); *but cf.* 17 U.S.C. § 1201(a)(1)(A) (“No person shall circumvent a technological measure that effectively controls access to *a* work protected under this title”). Circumvention as defined in that section does not depend on the nature of the material being accessed, whether it is copyrighted or not; rather it depends on the nature of the technological protection measure itself (does it protect some copyrighted material?). By contrast, the House Judiciary Committee’s definition defines circumvention in terms of the nature of the work being accessed by the circumventer.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

trafficking in circumvention devices, when it does not implicate the interests of copyright owners in protecting their copyrighted works from unauthorized access.<sup>93</sup>

The House Commerce Committee also recognized that the prohibition against circumvention of access controls might need to be modified in the future if “marketplace realities ... dictate a different outcome, resulting in less access, rather than more, to copyrighted materials”<sup>94</sup> That day came sooner than the committee expected, and the problem wasn’t so much access to copyrighted materials as the committee had been warned by numerous entities,<sup>95</sup> as it was a diminishment of access to uncopyrightable materials, and the novel uses to which plaintiffs were putting the anticircumvention provisions.

### III. JUDICIAL REACTIONS TO OVERREACHING WITH THE DCMA

While early cases such as *Reimerdes/Corley* and *RealNetworks Inc. v. Streambox, Inc.*<sup>96</sup> were able to avoid the negative implications of the DMCA’s sweeping language, two cases involving durable goods—printer toner cartridges and garage doors—forced the Sixth and Federal Circuits to grapple with the implications of the über right of access the DMCA

---

<sup>93</sup> See, e.g., Denicola, *supra* note 21, at 231 (“In the admittedly rare case in which circumvention of an access control measure neither substitutes for purchase of the protected work nor creates risk of copyright infringement, the circumvention, and the devices that makes it possible, should be beyond the reach of the DMCA.”); *Chamberlain Group, Inc. v. Skylink Techs., Inc. (Chamberlain)*, 381 F.3d 1178 (Fed. Cir. 2004); discussion *infra* Part II.

<sup>94</sup> *H. Commerce Report*, *supra* note 5, at 36.

<sup>95</sup> *Id.* at 24-25 (quoting *Fair Use*, RICHMOND TIMES-DISPATCH, July 13, 1998, at A-6).

<sup>96</sup> *RealNetworks Inc. v. Streambox, Inc.*, No. 2:99CV02070, 2000 WL 127311, \*8 (W.D. Wash. Jan. 18, 2000) (unpublished).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

supposedly granted copyright owners.<sup>97</sup> This part proceeds in four sections: first, it examines the reasoning of those courts that have directly addressed the question of whether a nexus between copyright and the DMCA is necessary for liability. In the second section, I address whether or not concepts from federal standing jurisprudence might provide a meaningful limitation on the reach of the DMCA. Section three addresses the Librarian of Congress’s recent encounter with DMCA overreaching in the rulemaking context, and the fourth section addresses the use of the “copyright misuse” defense against DMCA claims.

*A. Throwing Down the Gauntlet: The Judicial Response to Novel Uses of the DMCA*

Lexmark is a manufacturer of printers. Lexmark’s business model is premised on the selling of its printers at a discount to customers, and then turning a profit by selling more profitable printer toner cartridges for those printers. The business model only works if Lexmark is able to control the market for toner cartridges compatible with its printers, and thus the price of the cartridges themselves.<sup>98</sup> This business model is probably familiar to the reader, as it is found not only in printers, but in other guises such as reusable razors. To Lexmark’s dismay, there was demand for discounted generic printer cartridges to match customers’ discounted printers, and this demand was met by Static Control Components, Inc. (SCC)—the defendant to Lexmark’s action under the DMCA to enjoin the sale of the discounted cartridges.<sup>99</sup>

---

<sup>97</sup> Chamberlain Group, Inc. v. Skylink Techs., Inc. (Chamberlain), 381 F.3d 1178 (Fed. Cir. 2004); Lexmark Int’l, Inc. v. Static Control Components, Inc. (*Lexmark*), 387 F.3d 522 (6th Cir. 2004).

<sup>98</sup> *Lexmark*, 387 F.3d at 529.

<sup>99</sup> *Id.*



**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

From the facts presented, it hardly seems intuitive that Lexmark would have a remedy lying in an action whose *raison-d'être* is the protection of copyrighted works. Unfortunately for SCC, however, Lexmark enforced its printer cartridge monopoly by using an electronic authentication sequence, or “secret handshake” between the toner cartridge, and the printer itself necessary for operation of a cartridge with the printer.<sup>100</sup> Lexmark could not premise a DMCA claim on unwanted competition in the secondary market for printer cartridges; instead, it maintained that the purpose of its secret handshake protocol was to control access to its purportedly copyrighted “Printer Engine Program,” located on the printer, and the “Toner Loading Program” found on the toner cartridge. Lexmark alleged two violations of § 1201(a)(2). According to Lexmark, the “SMARTEK” chip found on SCC’s competing printer cartridges circumvented two access controls each protecting a copyrighted work: one protecting the Printer Engine Program, and another protecting the Toner Loading Program.<sup>101</sup> It is not at all clear on what basis Lexmark alleged two separate violations of the DMCA: Lexmark’s printers only utilized a single technological protection measure. That measure, the secret handshake, restricted operation of both the printer loading program *and* the Toner Loading Program. There was not actually a separate technological protection measure protecting each program, and the court addressed this point obliquely in denying that Lexmark had a viable claim with regard to its Toner Loading Program.<sup>102</sup>

---

<sup>100</sup> *Lexmark*, 387 F.3d at 530.

<sup>101</sup> *Id.*

<sup>102</sup> *See* discussion *infra*; *see also Lexmark* 387 F.3d at 550 (“The SCC chip does not provide ‘access’ to the Toner Loading program but replaces the program.”)

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

The Printer Engine program controlled various basic functions of the printer, whereas the Toner Loading Program, a miniscule program consisting of no more than a sentence's worth of computer code, assessed the amount of toner left in the cartridge and also operated as one hand in the secret handshake.<sup>103</sup> As an initial matter, the court of appeals decided that the Toner Loading Program was not copyrightable.<sup>104</sup> On that score, the Sixth Circuit came to the unassailable conclusion that the DMCA claim premised on circumvention of an "access control," which as Lexmark had drawn the complaint, undeniably only protected the uncopyrightable Toner Loading Program, did not control access to "a work protected under this title" and therefore failed.<sup>105</sup>

SCC's alleged violation of § 1201(a)(2) with regard to the Printer Engine Program required a more nuanced analysis from the Sixth Circuit. The court of appeals focused on defining the element "effectively controls access to a work." This element of liability under §§ 1201(a)(1) and (a)(2) tells the the court what sort of technological protection measures it is unlawful to circumvent (one that effectively controls access to a work). That element is in turn defined in § 1201(a)(3)(B).<sup>106</sup> Congress's definition turns out to be something of a non-definition however, as § 1201(a)(3)(B) essentially defines an access control as something with which the consumer must interact with the consent of the copyright owner in order to "gain access to the work."<sup>107</sup>

---

<sup>103</sup> *Lexmark*, 387 F.3d at 529-30.

<sup>104</sup> *Id.* at 544.

<sup>105</sup> *Id.* at 550.

<sup>106</sup> 17 U.S.C. § 1201(a)(3)(B).

<sup>107</sup> *See, e.g., Reese supra* note 17, at 627 ("The term access is never defined....").

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

The Sixth Circuit plainly understood this, and noted that “Congress did not explain what it means to ‘gain access to the work.’”<sup>108</sup>

Relying on the dictionary definition of “access,” the district court had found the secret-handshake to control access because it controlled the consumer’s ability “to make use of” the copyrighted Printer Engine Program.<sup>109</sup> The Sixth Circuit disagreed that controlling the ability to make use of the Printer Engine Program meant Lexmark’s authentication sequence controlled access to the copyrighted material. The court of appeals found that the consumer gained access to the code upon purchasing the printer because “anyone who buys a Lexmark printer may read the literal code of the Printer Engine Program directly from the printer memory, with or without the benefit of the authentication sequence.”<sup>110</sup> Although Lexmark prevented one form of access—making use of the Printer Engine Program with unauthorized printer cartridges—it had failed to prevent other forms of access such as reading the code itself:

Add to this fact that the DMCA not only requires the technological measure to ‘control access’ but also requires the measure to control that access ‘effectively,’ and it seems clear that this provision does not naturally extend to a technological measure that restricts one form of access but leaves another route wide open.<sup>111</sup>

Although the court explicitly denied that it was doing so, this passage has been misunderstood by some commentators as requiring copyright owners to impose a certain level of

---

<sup>108</sup> *Lexmark*, 387 F.3d at 546.

<sup>109</sup> *Id.*

<sup>110</sup> *Id.*

<sup>111</sup> *Id.* at 547.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

protection before their works are protected under the DMCA, or to block “all forms of access.”<sup>112</sup> The Sixth Circuit’s opinion rests not on the *degree* of protection, but on the *target* of the copyright owner’s protective efforts; i.e., the court examined what Lexmark was trying to do with its technological protection measure, not how much it was doing.<sup>113</sup>

The Sixth Circuit’s opinion makes it clear, from beginning to end, that it knew Lexmark’s secret handshake was designed to protect its monopoly on toner cartridges for its printers—not to protect its copyright interests: “Lexmark’s market for its toner cartridges and the profitability of its prebate program may well be diminished by the SMARTEK chip, but that is not the sort of market or value that copyright law protects.”<sup>114</sup> Lexmark argued that “several cases have embraced a ‘to make use of’ definition of ‘access’ in applying the DMCA.”<sup>115</sup> The court dispatched this argument by noting that “copyright protection operates on two planes: in the literal code governing the work and in the visual or audio manifestation generated by the code’s execution.”<sup>116</sup> Those cases holding that mere control of the consumer’s ability “to make use of” the copyrighted material established “effectively controls access” under the statute, such as *Reimerdes*, all involved copyrighted works where preventing a user from making use of a

---

<sup>112</sup> See, e.g., Calindrillo & Davison, *supra* note 75, at 396; Timothy K. Armstrong, *Fair Circumvention*, 74 BROOK. L. REV. 1, 25 (2008-2009) (“*Lexmark*—while denying that it was doing so—applied an understanding of ‘effectively controls access’ that expressly made the extent of statutory protection dependent upon the relative strength of the plaintiff’s technological protection measure.”).

<sup>113</sup> *Lexmark*, 387 F.3d at 549.

<sup>114</sup> *Id.* at 545.

<sup>115</sup> *Id.* at 548.

<sup>116</sup> *Id.*

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

bootleg DVD for instance, protected at least one of the planes of copyright protection (the audiovisual manifestation of the movie). By contrast, Lexmark’s control over the consumer’s ability to make use of its copyrighted Printer Engine Program did not protect anything in the second plane of copyright protection, there was no copyrightable audio or visual manifestation, only the uncopyrightable printing process the consumer could not execute. This left the first plane—protection of the literal code—something Lexmark’s authentication sequence failed to do at all.<sup>117</sup>

The holding of *Lexmark* can be boiled down to this: courts should examine what it is the plaintiff’s technological protection measure is actually protecting. Where the technological protection measure does not protect the copyright holder’s work, but instead protects a non-copyright interest, a court should not find “effective control of access” where the technological protection measure’s failure to effectively control access is a result of the fact that it was designed to protect not a copyrighted work, but a non-copyright interest.<sup>118</sup> Similarly, where a plaintiff’s measure only protects the copyrighted work in a clearly inadequate way, as an afterthought, or the protection is merely ancillary, a court might infer that the technological protection measure’s true purpose is not to protect the copyrighted work, but to do something else. In short, courts should exercise a modicum of common sense and not suffer a plaintiff claiming as an access control a technological protection measure that is obviously a fine fortress

---

<sup>117</sup> *Lexmark*, 387 F.3d 522.

<sup>118</sup> *See Id.* at 549 (“Because Lexmark has not directed any of its security efforts, through its authentication sequence or otherwise, to ensuring that its copyrighted work (the Printer Engine Program) cannot be read and copied, it cannot lay claim to having put in place a ‘technological measure that effectively controls access to a work protected under the copyright statute.’”).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

guarding its non-copyright interests, but is only a soggy sandcastle when it comes to protecting the copyrighted work.<sup>119</sup>

If the Sixth Circuit's *Lexmark* opinion is to be faulted, it is for failing to rest its decision more explicitly on its rejection of Lexmark's claim that the secret handshake protected a copyrighted work. *Lexmark* is best interpreted as but one approach to limiting the scope of the DMCA. However, one important question was left unanswered: What if the plaintiff has actually built a technological citadel around both his non-copyright interests *and* copyrightable material?<sup>120</sup> The Federal Circuit would supply an answer.

What the Sixth Circuit started with *Lexmark*, the Federal Circuit continued in *Chamberlain Group, Inc. v. Skylink Techs., Inc.*<sup>121</sup> The suit involved garage door opener systems, manufactured by plaintiff Chamberlain Group. Garage door opener systems comprise the following components: a portable transmitter (remote control) and garage door opening device mounted in the owner's garage; the garage door opening device is itself composed of a receiver with signal processing software for reception of signals from the portable transmitter, and a

---

<sup>119</sup> See *Lexmark*, 387 F.3d 522 ("Nowhere in its deliberations over the DMCA did Congress express an interest in creating liability for the circumvention of technological measures designed to prevent consumers from using consumer goods while leaving the copyrightable content of a work unprotected.")

<sup>120</sup> In a separate opinion, Circuit Judge Merritt expressed this concern: "We should make clear that in the future companies like Lexmark cannot use the DMCA in conjunction with copyright law to create monopolies of manufactured goods for themselves just by tweaking the facts of this case: by, for example ... cutting off other access to the Printer Engine Program. *Id.* at 551 (Merritt, J., concurring).

<sup>121</sup> *Chamberlain Group, Inc. v. Skylink Techs., Inc.* (Chamberlain), 381 F.3d 1178 (Fed. Cir. 2004).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

motor to open and close the garage door.<sup>122</sup> Chamberlain utilized what is called a rolling code system for signals sent from the transmitter to the receiver to activate the garage door motor. The specifics are neither interesting, nor important, but what is necessary to know is that the communication between transmitter and receiver involved a sort of rudimentary digital scrambling, and that the rolling code system was embodied in software found on Chamberlain’s garage door receiver. Defendant Skylink manufactured universal aftermarket remotes for garage door openers, including Chamberlain’s. Skylink’s remotes were not compliant with Chamberlain’s rolling code system per se. Rather than use the code, Skylink’s remotes tricked the garage door opener’s receiver unit into entering a “resynchronization sequence,” accepting the signal from Skylink’s remote, and thus operating the garage door.<sup>123</sup>

Chamberlain alleged a violation of § 1201(a)(2) in that Skylink’s transmitter constituted a circumvention device allowed purchasers to “circumvent” Chamberlain’s rolling code protection and access the copyrighted software on the garage door opening device when they opened or closed their garage door. Immediately one should notice two unusual features of Chamberlain’s claim: first, the copyrighted software Chamberlain claimed it was protecting was also the technological protection measure—in essence Chamberlain claimed Skylink was circumventing an access control protecting itself.<sup>124</sup> Second, the persons whom Chamberlain alleged would

---

<sup>122</sup> *Chamberlain*, 381 F.3d at 1183.

<sup>123</sup> *Id.* at 1184. It is noteworthy that a purchaser of the Skylink remote was still required to program their garage door receiver to operate with the remote—one skylink remote could not open any Chamberlain garage door—only those which had been programmed by the owner to respond to that remote.

<sup>124</sup> *Id.* at 1185. (“Thus, only one computer program is at work here, but it has two functions: (1) to verify the rolling code; and (2) once the rolling code is verified, to activate the GDO motor...”)

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

gain unauthorized access to its garage door opener software were the very owners of Chamberlain’s garage door openers.<sup>125</sup> Both points were red flags for the Federal Circuit that Chamberlain’s rolling code system wasn’t designed to protect copyrighted code, but instead fulfilled another purpose (such as preventing accidental activation due to radio interference, or preventing burglars from learning the code necessary to open the door).<sup>126</sup> It was equally clear that Skylink’s circumvention did not put Chamberlain’s software at risk for piracy or unauthorized access, rather, it only put Chamberlain at risk of losing control over the market for aftermarket transmitters for its garage door line.<sup>127</sup> The court noted that use of the DMCA to control a secondary market is “a practice that both the antitrust laws and the doctrine of copyright misuse normally prohibit.”<sup>128</sup>

Satisfied that Chamberlain’s “rolling code” did not protect a copyrighted work, the question for the Federal Circuit was on what basis could it limit liability under the DMCA, as Congress had intended, to protection of copyrighted works. After all, Chamberlain contended, “the only way for the [Skylink transmitter] to interoperate with [Chamberlain’s garage door opener] is by ‘accessing’ copyrighted software. Skylink has therefore committed a per se violation of the DMCA.”<sup>129</sup> Chamberlain’s appeal to the “plain language” of the statute was deceptive: the term “access” has a different meaning depending on the context. One could take

---

<sup>125</sup> *Chamberlain*, 381 F.3d at 1202.

<sup>126</sup> *Id.* at 1184.

<sup>127</sup> *Id.* at 1204.

<sup>128</sup> *Id.* at 1201.

<sup>129</sup> *Id.* at 1197.



**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

the Sixth Circuit’s approach and ask “exactly what sort of ‘access’ is Chamberlain talking about?” If Chamberlain means access to the literal code embodied in the garage door receiver, then every owner of their garage door system probably has relatively easy access to the memory where the program is stored in their garage—Chamberlain did not encrypt the literal code or store it on a secure network. On the other hand, if Chamberlain is talking about access in the “to make use of” sense, it seems clear that preventing users from making use of Chamberlain’s program does not protect anything on the “manifestation” plane of copyright protection either. Chamberlain’s rolling code system only prevents users from making a use of the copyrighted code which manifests itself in the form of an uncopyrightable process—the opening and closing of a garage door.

The Federal Circuit did not attempt to parse out “effectively controls access to a work protected under this title” in the same way the *Lexmark* court did. Instead the Federal Circuit rested its decision not on a construction of the statute, but a rule of reason: “We conclude that 17 U.S.C. § 1201 prohibits only forms of access that bear a reasonable relationship to the protections that the Copyright Act otherwise affords copyright owners.”<sup>130</sup> According to the court of appeals, showing that the circumvention device enables copyright infringement is one way of making a prima facie showing of a violation of § 1201(a)(2), in the alternative, a plaintiff must show enablement of a prohibited circumvention, specifically, a circumvention with a “reasonable relationship ... to a property right for which the Copyright Act permits the copyright owner to withhold authorization—as well as notice that authorization was withheld.”<sup>131</sup>

---

<sup>130</sup> *Chamberlain*, 381 F.3d at 1202.

<sup>131</sup> *Chamberlain*, 381 F.3d at 1204.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

Ultimately, Chamberlain Group’s twisted logic that owners were not “authorized” to access copyrighted software they owned and physically possessed if they were using a Skylink transmitter also proved too much for the court: “Copyright law itself authorizes the public to make certain uses of copyrighted materials. Consumers who purchase a product containing a copy of embedded software have the inherent legal right to use that copy of the software. What the law authorizes, Chamberlain cannot revoke.”<sup>132</sup> Whereas the Sixth Circuit rested its decision of no liability on lack of protection against access to the copyrighted work, the Federal Circuit’s decision says in part that even if a technological protection protects a copyrighted work, the element of “without the authority of the copyright owner” cannot be met, and liability attach, if the Copyright Act already grants the purchaser authorization to access the work.

In a way, the *Chamberlain* court’s holding that there must be a “reasonable relationship” between liability under the DMCA, and a property right recognized by the 1976 Copyright Act, is the first principle we’ve been building towards throughout this paper, and will continue to build upon in the remainder.<sup>133</sup> As noted before, the *Lexmark* approach of looking at whether the copyrighted work is indeed “effectively protected,” is but one approach to reaching what the Federal Circuit explicitly held in *Chamberlain*: that there must be a nexus between liability under the DMCA, and protection of rights already granted under the Copyright Act of 1976. So far we’ve looked at two approaches to defining that nexus: the *Lexmark* “effective protection” approach, and the Federal Circuit’s “rule of reason;” we’ll address one more case utilizing the

---

<sup>132</sup> *Id.* at 1202.

<sup>133</sup> *Id.* at 1204.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

rule of reason approach before examining other means of ensuring the presence of that nebulous nexus between the DMCA and copyright.

The Federal Circuit reiterated its stance in *Storage Technology Corp. v. Custom Hardware Engineering & Consulting, Inc.*<sup>134</sup> Plaintiff (d/b/a StorageTek) sold data storage systems, one part of which was copyrighted software licensed to the “purchaser.” Defendant Custom Hardware Engineering & Consulting (CHE), repaired the storage systems sold by plaintiff. In order to carry out the repairs, CHE had to access the plaintiff’s copyrighted, and password protected, maintenance software. In order to access that software, CHE circumvented the password protection. Part of the process of circumvention also involved a rebooting of the storage system’s electronics, which caused copies of the maintenance code software to be made in the storage system’s random access memory (RAM)—possibly a copyright infringement. Storage Technology sued CHE under both a straight copyright infringement theory of unauthorized reproduction of copies of its software, and a DMCA access-control circumvention claim under § 1201(a)(1).<sup>135</sup>

First the Federal Circuit disposed of the copyright infringement claim, holding that the copies made in the computer system’s RAM during the circumvention and maintenance process were within the Copyright Act’s § 117(c) computer maintenance safe harbor.<sup>136</sup> The court then turned to the DMCA claim, which it had gutted with the dismissal of the underlying copyright

---

<sup>134</sup> *Storage Technology, Corp. v. Custom Hardware Eng’g & Consulting Inc.* (Storage Technology Corp.), 421 F.3d 1307 (Fed. Cir. 2005).

<sup>135</sup> *Id.* at 1310.

<sup>136</sup> *Storage Technology Corp.*, 421 F.3d at 1317.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

infringement claim: “To the extent that CHE’s activities do not constitute copyright infringement or facilitate copyright infringement, StorageTek is foreclosed from maintaining an action under the DMCA.”<sup>137</sup> This passage does seem to be something of an oversimplification of the Federal Circuit’s own test in *Chamberlain*, which, recall, held there were two ways to show a trafficking violation under § 1201(a)(2): proof of enablement of a “prohibited circumvention” (a § 1201(a)(1) violation) *or* proof of enablement of copyright infringement.<sup>138</sup> Therefore, it is not strictly accurate under the Federal Circuit’s reasoning in *Chamberlain*, or Congress’s when it passed the legislation, to say that copyright infringement is a necessary predicate to a claim for access control circumvention under § 1201(a)(1). After all, Congress created an individual violation for gaining unauthorized access in § 1201(a)(1), but not a corresponding individual violation for circumvention of a rights control under § 1201(b) because before the DMCA, gaining unauthorized access to a work did not implicate any of the copyright owner’s exclusive rights. Section 1201(b) only addresses trafficking because it is specifically addressed to those devices that facilitate an existing individual violation—copyright infringement.<sup>139</sup> In any event, the court reverted back to its former definition before it finished addressing the DMCA claim, writing “We conclude that it is unlikely that StorageTek will prevail on its claim under § 1201(a) ... because the ... devices are not reasonably related to any violation of the rights created by the Copyright Act.”<sup>140</sup>

---

<sup>137</sup> *Id.* at 1318.

<sup>138</sup> *Chamberlain*, 381 F.3d at 1204.

<sup>139</sup> S. Rep. No. 105-190 at 12 (1998).

<sup>140</sup> *Storage Technology Corp.*, 421 F.3d at 1319.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

On plain reading, the DMCA’s right to control access appears to subsume the Copyright Act’s more specific § 106 exclusive rights, and render them superfluous for digital works. The underlying principle in the Federal Circuit’s rule of reason approach to the DMCA was that reading the right to control access as a super-copyright would be an “irrational” exercise of congressional power.<sup>141</sup> This principle was enunciated in a different context by the Supreme Court when it considered the extent of trademark protection for a television program in *Dastar Corp. v. 20th Century Fox Film Corp.*<sup>142</sup> In *Dastar*, the Court refused to recognize a theory of trademark protection that extended the concept of “false designation of origin” to prevent the unaccredited copying of an uncopyrighted television series. The Court held that copyright’s

[E]xpress right of attribution is carefully limited and focused ... . Recognizing in § 43(a) [of the Lanham Act] a cause of action for misrepresentation of authorship of noncopyrighted works (visual or otherwise) would render these limitations superfluous. A statutory interpretation that renders another statute superfluous is of course to be avoided.<sup>143</sup>

The Federal Circuit’s *Chamberlain* and *Storage Tech* opinions serve a similar coordination function, only instead of harmonizing two property regimes—trademark and copyright—by maintaining a subject matter distinction, the harmonization of the DMCA with the Copyright Act works an integration. Also, in both *Dastar* and *Chamberlain*, the offending statutory

---

<sup>141</sup> *Chamberlain*, 381 F.3d at 1200.

<sup>142</sup> *Dastar Corp. v. 20th Century Fox Film Corp.*, 539 U.S. 23 (2003).

<sup>143</sup> *Id.* at 35.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

interpretation is one that results in the copyright regime in danger of being made irrelevant by a broader right fabricated by the plaintiff.

*B. Could Federal Standing Jurisprudence Weed Out Improper DMCA Claims?*

Justiciability doctrines such as standing often possess a quality of uncertainty all their own, and accusations of courts deciding the merits of cases under cover of a decision on a party's standing are nothing new.<sup>144</sup> Yet, the analogy between this area of the law, and the most intractable problem under the DMCA—defining the nexus between the copyright property right and DMCA liability—is an interesting one. One doctrine from standing in particular may inform the DMCA nexus question: the requirement of “injury in fact.” The injury in fact requirement is part of the doctrine of constitutional standing enforcing the Article III “case and controversy” condition necessary for the exercise of the federal judicial power.<sup>145</sup> A plaintiff, to establish an injury in fact, and thus Article III standing, must show he has suffered a harm that is “[1](a) concrete and particularized and (b) actual or imminent, not conjectural or hypothetical; (2) the injury is fairly traceable to the challenged action of the defendant; and (3) it is likely, as opposed to merely speculative, that the injury will be redressed by a favorable decision.”<sup>146</sup>

The Federal Circuit's requirement of a “reasonable relationship” between DMCA liability, and a property right in copyright, is analogous to the “injury-in-fact” requirement. The plaintiffs in *Gamemasters*, *Lexmark*, *Chamberlain*, and *Storage Technology Corp.* all share one common

---

<sup>144</sup> See 13A RICHARD D. FREER & EDWARD H. COOPER, FEDERAL PRACTICE AND PROCEDURE § 3531 (3d ed. 2009).

<sup>145</sup> U.S. CONST. art. III, § 2.

<sup>146</sup> *Friends of the Earth, Inc. v. Laidlaw Envtl. Servs. (TOC), Inc.*, 528 U.S. 167, 179 (2000).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

thread: none of them could show any injury to any of their exclusive rights, or a harm to the market for their works from the circumvention of their access controls. The integrity and value of their intellectual property remained intact. The harm suffered was not any blow to the value of their *copyrighted* works on the market, but the value of their uncopyrightable products, be it a competing video game cheating device, printer cartridges, a garage door opener, or a monopoly on repairing data storage systems. True, this may tangentially affect the value of the copyrighted work, but competition in the market for uncopyrighted products does not constitute the “invasion of a legally protected interest” necessary for an injury in fact.<sup>147</sup>

The rule against standing based on mere hypothetical, or conjectural harms is justified precisely by the type of “harm” alleged in *Chamberlain*. Chamberlain Group alleged that the Skylink garage door transmitter’s circumvention of its rolling code system made its garage door opener system vulnerable to burglarizing “code-grabbers” although it conceded that it they are “more theoretical than practical burgling devices; none of its witnesses had either firsthand knowledge of a single code grabbing problem or familiarity with data demonstrating the existence of a problem.”<sup>148</sup>

Yet another case involving cheating devices for video games illustrates the tension between the DMCA and copyright protection that might be resolved by proper application of standing principles. *MDY Industries, LLC v. Blizzard Entertainment, Inc.* involved two different software applications that ran on a personal computer. One was counterclaimant Blizzard’s video game, *World of Warcraft*, and the other was claimant MDY’s “Glider” program that allowed players of

---

<sup>147</sup> *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560-61 (1992).

<sup>148</sup> *Chamberlain*, 381 F.3d at 1183-84.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

World of Warcraft to accumulate points at an unnaturally high rate.<sup>149</sup> Blizzard alleged violations of both §§ 1201(a)(2) and 1201(b)(1). In a positive development, the district court adopted the Federal Circuit’s six-part test for § 1201(a)(2) liability,<sup>150</sup> but when it came time to apply the fifth element, enablement of circumvention that “infringes or facilitates infringing a right *protected* by the copyright act,” the court was willing to treat the “reasonable relationship” between copyright and DMCA liability as a pro forma hurdle. The court accepted Blizzard’s assertions that “once players obtain access to these elements of the game, they may copy those elements as they are displayed.”<sup>151</sup> The court came to this conclusion despite the fact that the danger of copying was completely hypothetical in nature, with Blizzard only showing that it is possible, and neither Blizzard nor the court providing any explanation as to why someone would want to record “the sights and sounds of the game as it is being played.”<sup>152</sup> Furthermore, the technological protection measure at issue did not normally prevent players who did not use MDY’s cheating device from also recording the game during play, nor did MDY’s cheating device itself record or copy the game. It is hard to understand how MDY’s software facilitated copying just as easily carried out without it.<sup>153</sup> Setting aside how this case would fare under the

---

<sup>149</sup> MDY Industries, LLC v. Blizzard Entertainment, Inc., 616 F. Supp.2d 958, 962-63 (D. Arizona 2009)

<sup>150</sup> *Id.* (citing *Chamberlain*, 381 F.3d at 1203).

<sup>151</sup> *Id.* at 968 (emphasis added).

<sup>152</sup> *Id.* at 968 n.2.

<sup>153</sup> *Cf. Storage Technology Corp.*, 421 F.3d at 1319 (copies of program created as a result of computer reboot during circumvention activity did not mean circumvention enabled infringement because the same copies were also created as a matter of course every time computer was restarted).



**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

*Lexmark* approach, or the Federal Circuit’s rule of reason approach, Blizzard’s unsubstantiated allegation that MDY’s circumvention of its technological protection measure enabled copying, (which was “enabled” anytime one used the game normally), does not fare well at all from a standing perspective. It is about as speculative, and conjectural an injury as can be, and it is not at all clear what the concrete and particularized impact on Blizzard would be even if persons did record themselves playing the video game.

The reference to the law of standing is one of *analogy*—I do not suggest that Courts might dismiss claims for lack of standing because circumvention of a protection measure does not bear a reasonable relationship to a copyright interest. This is more properly a question for the merits of the claim.<sup>154</sup> A question of standing with a DMCA claim probably looks more generally at whether a plaintiff has actually been injured somehow by a violation of the DMCA involving a copyrighted work.<sup>155</sup> Nevertheless, looking briefly outside the DMCA to an area of the law such as standing, provides some perspective on how courts might differentiate between the truly injured plaintiff with an invaded copyright interest, and the guy with the imaginary neck brace.

*C. Reflections of DMCA Caselaw in the § 1201(a)(1) Rulemaking Procedure.*

Under § 1201(a)(1)(b)-(d) of the DMCA, the Librarian of Congress is authorized to promulgate rules designating classes of works which may be exempted from § 1201(a)(1)’s ban

---

<sup>154</sup> See FREER & COOPER, *supra* note 144, § 3531 (warning of the dangers of conflating the standing inquiry with the question of whether an adequate claim has been stated).

<sup>155</sup> See, e.g., *Comcast of Illinois, X, LLC., v. Hightech Electronics, Inc.*, No. 03 C 3231 2004 WL 1718522, \*6 (N.D. Ill. July 29, 2004) (unpublished) (holding Comcast had standing to bring a DMCA claim because despite the fact that it was not the copyright holder, it had alleged sufficient harm from unlawful access to the market for copyrighted works it disseminated over its cable system).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

on the circumvention of access controls. As was mentioned earlier, the importance of these exemptions may be of limited significance due to the lack of any corresponding power of exemption for the trafficking or facilitation of circumvention of access controls, and the limited and technical nature of the exemptions.<sup>156</sup> This section does not seek to address the rulemaking process generally; while it undoubtedly has a role to play in maintaining the balance inherent in our copyright law, its ad-hoc nature makes it less susceptible, at least this early in its existence, to providing any sort of rule of decision or underlying principle for courts to apply in construing the DMCA's anticircumvention provisions. Instead, I address one of the six most recent exempted classes of works, and use it as an illustration of how the principles enunciated in the *Lexmark* and *Chamberlain* cases have been applied, perhaps unwittingly, to totally different technologies by another decisional body—the Librarian of Congress.

In July of 2010, the Librarian of Congress made another rule designating six classes of works exempted from the prohibition on individual circumvention of access controls, among them was an exemption for “Computer programs that enable wireless communication handsets to execute software applications, where circumvention is accomplished for the sole purpose of enabling interoperability of such applications, when they have been lawfully obtained, with computer programs on the telephone handset.”<sup>157</sup> The central target of the rule was Apple's iPhone and Apple's attempt to maintain absolute control over the types of applications run on the phone. The similarity between Apple's opposition to the proposed rule and the positions of the

---

<sup>156</sup> See discussion *supra* pp. 5-7

<sup>157</sup> Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies, 75 Fed. Reg. 43,825, 43,830 (July 27 2010) (to be codified at 37 C.F.R. pt. 201); see also discussion *supra* p. 6.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

copyright-holders in *Lexmark* and *Chamberlain* are striking. In all three cases, a company sought control over the aftermarket for a product. For Lexmark it was the aftermarket for printer cartridges for its printers; for Chamberlain it was the remotes for its garage door openers; and for Apple it was the software applications—“apps”—for its wireless phones. Another parallel is the product integrity argument made by both Chamberlain before the Federal Circuit, and Apple to the Librarian of Congress. Both companies argued that the presence of a third party in the aftermarket would harm the integrity of their product, with Chamberlain arguing that the aftermarket garage door openers compromised the security of their garage doors by potential burglars, and Apple arguing that circumvention of its validation process resulted in both a decrease in security for iPhone users, and reliability issues that could harm Apple’s reputation and the consumer.<sup>158</sup> The Librarian of Congress wisely rejected these arguments in granting an exemption over Apple’s objection. The posture of the decision is somewhat different from that in both *Lexmark* and *Chamberlain* in that the courts of appeals were bound by, and interpreting, the DMCA’s substantive anticircumvention provisions. By contrast, the rulemaking proceeding charged to the Librarian of Congress allows for an exemption to be made when persons using “a particular class of works ... are, or are likely to be affected by virtue of [the prohibition on individual circumvention of access controls] in their ability to make noninfringing uses of that particular class of works under this title ... .”<sup>159</sup> In other words, for an exemption, the Librarian

---

<sup>158</sup> Cf. *Chamberlain*, 381 F.3d at 1184, with Responsive Comment of Apple Inc. In Opposition to Proposed Exemption 5A and 11A (Class #1) (responses to comments) (U.S. Copyright Office) <http://www.copyright.gov/1201/2008/responses/apple-inc-31.pdf> at p. 26 (last visited Aug. 13, 2010).

<sup>159</sup> 17 U.S.C. § 1201(a)(1)(b) (2006)

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

of Congress need only determine that there is a likely adverse effect on a noninfringing use (or a fair use) which an exemption will remedy. Despite a different analytical framework vis-a-vis the decisions of the courts of appeals, in reaching its decision that the proposed exemption would allow for fair use of the iPhone, the Librarian of Congress made the same key observations that the Sixth and Federal Circuits made when those courts determined that DMCA liability did not attach. Namely, that what Apple sought to protect was not a property interest in its copyrighted work:

Apple’s objections to installation and use of “unapproved” applications appears to have nothing to do with its interests as the owner of copyrights in the computer programs embodied in the iPhone, and running the unapproved applications has no adverse effect on those interests. Rather, Apple’s objections relate to its interests as a manufacturer and distributor of a device, the iPhone.<sup>160</sup>

The distinction between Apple’s interest as “owner of copyrights in the computer programs embodied in the iPhone”, and Apple’s interests as “a manufacturer and distributor of a device, the iPhone” is a subtle one—perhaps too subtle—as the software at issue, the firmware and operating system of the phone, is as integral a part of the device as the shiny stainless steel case and touch screen enclosing it. Instead, the solid footing for the Librarian’s distinction is not whether something is a “device” or “software,” rather, the availability of copyright protection should turn ultimately on what it is the copyright holder-manufacturer is seeking to protect. In the case of Apple’s iPhone, the Librarian correctly discerned that Apple was not interested in

---

<sup>160</sup> Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies, 75 Fed. Reg. at 43, 829.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

protecting any incentive flowing from the inherent value of its firmware and operating system, instead it was seeking to maintain a closed ecosystem of software and hardware through its validation process—this aim was too tangential to the value of the actual copyrighted works to serve as the basis for protection of the firmware and operating system. Put another way, the alleged copyright infringement is purely incidental to the interest Apple sought to protect; it was the business model of total control requiring validation of programs for the iPhone that the company sought to guard, not the value inherent in the operating system for its phones. In determining that any modification of the operating system was fair use, the Librarian of Congress said as much: “Thus if Apple sought to restrict the computer programs that could be run on its computers, there would be no basis for copyright law to assist Apple in protecting its restrictive business model.”<sup>161</sup>

Just as the Sixth Circuit read Lexmark’s complaints of circumvention of its printer toner loading program as a pretext for protecting Lexmark’s monopoly of its printer cartridge aftermarket, so too an exemption to DMCA protection for iPhones and other telephones was warranted as the complaints of circumvention were not premised on the protection of the underlying copyrighted work. Given the similarities between the *Lexmark* and *Chamberlain* cases, and the positions of the wireless telephone manufacturers in opposition to the recently crafted exemption, it would be earthshaking, but not necessarily surprising, to see a court deny DMCA protection outright in cases alleging circumvention of technological protection measures of the sort and purpose as that used by Apple for its iPhone.

---

<sup>161</sup> Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies, 75 Fed. Reg. at 43, 829.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

*D. A Word on Copyright Misuse*

Copyright misuse has emerged from obscurity with the advent of the DMCA.<sup>162</sup> By its plain text, the DMCA appears to create a super-copyright, that is, control over “access” supersedes any of the other exclusive rights granted to the copyright owner and consequently, the potential for anticompetitive behavior, and the temptation to extend one’s monopoly in copyright to other realms are that much greater.<sup>163</sup>

We’ve already covered cases where companies overstepped the bounds of the DMCA with potentially anticompetitive behavior. *Lexmark* and *Chamberlain* quickly come to mind. In *Chamberlain*, the Federal Circuit said this of Chamberlain’s argument for protection:

In a similar vein, Chamberlain’s proposed construction would allow any manufacturer of any product to add a single copyrighted sentence or software fragment to its product, wrap the copyrighted material in a trivial “encryption” scheme, and thereby gain the right to restrict consumers’ rights to use its product in conjunction with competing products. In other words, Chamberlain’s construction of the DMCA would allow virtually any company to leverage its sales into aftermarket monopolies—a practice that both the antitrust laws, and the doctrine of copyright misuse, normally prohibit.<sup>164</sup>

---

<sup>162</sup> See, e.g., Neal Hartzog, *Gaining Momentum: A Review of Recent Developments Surrounding the Expansion of the Copyright Misuse Doctrine and Analysis of the Doctrine in its Current Form*, 10 MICH. TELECOMM. & TECH. L. REV. 373, 376 (2004); Dan L. Burk, *Anticircumvention Misuse*, 50 UCLA L. REV. 1095 (2002-3003).

<sup>163</sup> See Dan L. Burk, *Anticircumvention Misuse*, 50 UCLA L. REV. 1095, 1139 (2002-2003).

<sup>164</sup> *Chamberlain*, 381 F.3d at 1201.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

Although this passage was not directly addressed to Chamberlain’s own behavior, the court was certainly aware that Chamberlain’s statutory construction would serve it well in the competition for aftermarket universal garage remotes.

A brief overview of copyright misuse is in order. First, copyright misuse is an equitable defense premised on the notion of unclean hands: a plaintiff who has done wrong, may not seek the aid of the court until he has purged himself of the offending conduct; even if the wrong did no harm to the defendant asserting misuse.<sup>165</sup> Although its primary use is curtailing anticompetitive intellectual property licensing behavior, copyright misuse is a defense to a copyright infringement claim, not a contract claim. The equitable remedy provided by the court in response to a copyright misuse defense is a refusal to enforce the copyright.<sup>166</sup> Although misuse doctrine has been around for some time in patent law, in the copyright realm, it is still “in its infancy”<sup>167</sup> though it is growing in stature compared to patent misuse. Copyright misuse has been recognized by district courts within every circuit, although not all of the courts of appeals have addressed the defense themselves.<sup>168</sup>

---

<sup>165</sup> Burk, *supra* note 163, at 1114-15.

<sup>166</sup> RAYMOND T. NIMMER, *LAW OF COMPUTER TECHNOLOGY*, § 7:35 (2008).

<sup>167</sup> Viva R. Moffat, *Super-Copyright: Contracts, Preemption, and the Structure of Copyright Policymaking*, 41 U.C. DAVIS L. REV. 45, 103, n.257 (2007) (writing that it is “primarily direct at combating particularly egregious contracts,” and probably not up to the task of regulating copyright licensing generally).

<sup>168</sup> *See* 2 HOWARD B. ABRAMS, *LAW OF COPYRIGHT*, § 16:4 (2009) (collecting cases).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

The progenitor of copyright misuse, *Lasercomb America, Inc. v. Reynolds*,<sup>169</sup> is a useful illustration of the basic purpose animating the copyright misuse defense. Plaintiff Lasercomb had licensed four copies of a die-cutting computer program to the defendant. Among the terms in the licensing agreement was a clause purporting to limit the defendant from developing its own die-cutting software for ninety-nine years.<sup>170</sup> Defendants circumvented the software's protective measures, created three unauthorized copies of the program, and Lasercomb sued for copyright infringement.<sup>171</sup> Defendants invoked the copyright misuse defense, alleging that Lasercomb's ninety-nine year license was an abuse of its copyright. The Fourth Circuit entertained the argument, holding that Lasercomb had indeed tried to secure a monopoly where the copyright law did not grant it—over the very idea of die-cutting software itself.<sup>172</sup> There is no principled reason why the misuse doctrine should not apply to DMCA claims. One commentator has succinctly summed up the need for a DMCA misuse doctrine:

[P]rotection of copyrighted content, not maintenance of market dominance, was the stated legislative intent behind granting the anticircumvention right. This suggests that sooner or later, the leveraging of "paracopyright" will cross the line into the realm of antitrust violation. Stated differently, there will inevitably arise some friction between exercise of anticircumvention rights legitimately granted by Congress and the restrictions on anticompetitive behavior imposed by

---

<sup>169</sup> *Lasercomb America, Inc. v. Reynolds*, 911 F.2d 970 (4th Cir. 1990).

<sup>170</sup> *Id.* at 972-73.

<sup>171</sup> *Id.*

<sup>172</sup> *See Id.* at 979.



**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

antitrust law. As it has in patent and copyright law, misuse doctrine may serve to coordinate anticircumvention with antitrust, helping to reconcile the requirements of the two bodies of law.<sup>173</sup>

Professor Burk wrote that phrase before the Sixth and Federal Circuits confronted the potentially anticompetitive behavior at issue in *Lexmark* and *Chamberlain*. The lack of an offending licensing agreement in either of those cases does not necessarily matter in his construction of the doctrine; license or no license, such DMCA claims are fodder for the misuse cannon: “Such overreaching is equivalent, whether as text [a license] backed by law or as software [a technological protection measure] backed by law.”<sup>174</sup> Nevertheless, both cases were resolved without importing the misuse doctrine, leading one to believe that although misuse doctrine may have a role to play in limiting the reach of the DMCA, it may not be a catch-all for claims that do not bear a reasonable relationship to a copyright right.

The first DMCA case to explicitly address the copyright misuse defense, *Sony v. Gamemasters*, did not make the connection between the copyright misuse defense and the DMCA. In its brief exposition on the subject, the district court only superficially addressed the merits of the copyright misuse claim, but held that the defense did not apply since “[Sony’s] targeting of the GameEnhancer is based upon a sound construction of the Digital Millennium Copyright Act ... .”<sup>175</sup> The district court treated liability under the DMCA as separate from any

---

<sup>173</sup> Burk, *supra* note 163, at 1139.

<sup>174</sup> *Id.*

<sup>175</sup> *Gamemasters*, 87 F. Supp. 2d at 989.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

possible misuse of a copyright grant. The misuse analysis should not turn simply on the cause of action when the use of the same legal monopoly is at issue, albeit made stronger by the DMCA.

The only other case to explicitly touch on the connection between the DMCA and copyright misuse, *Apple, Inc. v. Psystar Corp.*,<sup>176</sup> hints that misuse of the DMCA will merely be treated as “copyright misuse” as opposed to “anticircumvention misuse” or some third type of misuse separate from both patent and copyright misuse. In *Psystar*, among many issues before the court, was defendant’s argument that Apple had repeatedly made bogus DMCA claims against it and that this legal harassment constituted copyright misuse. Rather than holding that abuse of the DMCA had no part in a copyright misuse defense, the court dismissed Psystar’s argument by upholding Apple’s DMCA claims. This is a subtle change from *Gamemasters*, where that court’s line of thinking boiled down to: What cannot be done under copyright may be accomplished with the DMCA. *Psystar* may solve not only the decidedly pedestrian argument over what to call misuse of the DMCA, (it will likely continue to be called “copyright misuse”), but presents as well a neat logical connection between the DMCA and copyright—namely, that if misuse of the DMCA is essentially a misuse of the copyright grant, then conversely, a misused copyright grant cannot serve as the basis for a DMCA claim. Support for this concept is found in the statute itself— § 1201(a) creates a right to control access only to “a work protected under this title.”<sup>177</sup> Similarly, § 1201(b) only covers rights controls “that effectively protect[] a right of a

---

<sup>176</sup> *Apple, Inc. v. Psystar Corp.*, No. C. 08-03251 WHA, 2009 WL 3809798 (N.D. Cal. Nov. 13, 2009) (slip copy).

<sup>177</sup> 17 U.S.C. § 1201(a)(1)(A).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

copyright owner under this title in a work ... .”<sup>178</sup> If the copyright is unenforceable due to misuse, then the work is not “protected under this title” nor is there a “right of a copyright owner” for a rights control to defend.

From the limited precedent and commentary available, we might pose some possible permutations of the DMCA-misuse defense. The two fundamental categories of DMCA misuse would be (1) misuse of technological controls, or (2) misuse of a licensing scheme to extend one’s rights under the DMCA. These two variations of misuse were introduced above with Professor Burk’s observation that overreaching via technological protection measures, or by license are fundamentally equivalent.<sup>179</sup> The scope of the second variation, misuse in licensing, (such as withholding “authorization” in certain circumstances where the courts would normally presume it so as to trigger DMCA circumvention liability where it would otherwise not exist) was alluded to by the Federal Circuit in *Chamberlain*. There the court said “it is not clear whether a consumer who circumvents a technological measure controlling access to a copyrighted work in a manner that enables uses permitted under the Copyright Act but prohibited by contract can be subject to liability under the DMCA.”<sup>180</sup> Whether or not licenses may modify the default positions established by the DMCA in tandem with the Copyright Act, and what the

---

<sup>178</sup> 17 U.S.C. §§ 1201(b)(1)(A)-(C).

<sup>179</sup> Burk, *supra* note 163, at 1134-1135.

<sup>180</sup> *Chamberlain*, 381 F.3d at 1202 n.17.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

role for copyright misuse in dealing with any such licenses would be, is an open question at this time.<sup>181</sup>

From those two types of copyright-DMCA misuse, there are two further variations: misuse of the copyright monopoly that is anticompetitive in nature, and misuse not for gaining an advantage in business, but to stifle creativity.<sup>182</sup> With the convergence of the traditional creative works and the protection of works of a more utilitarian nature, such as software and architectural plans, it may be difficult to determine whether a licensing or technological protection scheme is aimed at stifling creativity or competition. In any event, attempts to do either form an adequate foundation for the copyright misuse defense.

One major uncertainty looms over the horizon for the doctrine of misuse: What is the relationship between copyright misuse and antitrust law, specifically, should a showing of an antitrust violation be necessary to make out a defense of copyright misuse? For the moment, it appears that despite some protest to the contrary, copyright misuse will follow the traditional misuse model: that is, the doctrine as it existed in patent misuse before Congress passed the Patent Misuse Reform Act requiring courts to use the “market power” antitrust analysis in

---

<sup>181</sup> An alternative approach to overbroad licensing schemes is federal preemption of state contract law. See Christina Bohannon, *Copyright Preemption of Contracts*, 67 MD. L.R. 616 (2008) (proposing a statutory waiver analysis of contract preemption); Viva R. Moffat, *Super-Copyright: Contracts, Preemption, and the Structure of Copyright Policymaking*, 41 U.C. DAVIS L.R. 405 (2007).

<sup>182</sup> See *Video Pipeline v. Buena Vista Home Entertainment, Inc.*, 342 F.3d 191, 204-206 (3rd Cir. 2003) (recognizing that copyright misuse is also applicable in situations not involving competitive advantage, such as systematic licensing schemes purporting to limit the licensee’s right to publicly comment or criticize the licensed work).

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

resolving many patent misuse claims.<sup>183</sup> Thus, a defendant may show copyright misuse either by establishing sufficiently anticompetitive conduct (an antitrust violation) from the plaintiff's use of the copyright grant beyond its scope, or, by showing that the plaintiff is otherwise attempting to use the copyright monopoly to restrain creative activity.<sup>184</sup>

If copyright misuse indeed “suffers from wild incompleteness,”<sup>185</sup> it is perhaps best reserved for the more egregious cases of affirmative anticompetitive conduct, such as a license or technological control rising to the level of an antitrust violation. Alternatively, misuse might be found from clear suppression of creative expression creating constitutional tension between the DCMA and the First Amendment, exceeding the extent of Congressional power under the Patent and Copyright Clause, or, in the case of licensing, necessitating federal preemption of state contract law. Regardless of whether one uses copyright misuse doctrine or one of the other foregoing approaches, they all share a common focus on what the copyright owner is attempting to do with the technological protection measure. Copyright misuse doctrine's explicit focus on the market effects of the plaintiff's use of the monopoly (either in business or the market for

---

<sup>183</sup> Act of Nov. 19, 1988, Pub. L. No. 100-703, § 201, 102 Stat. 4674, 4676 (1988); NIMMER *supra* note 165 at § 7:35 (maintaining that because Congress's reformation of patent misuse requires exclusive application of the market power analysis in copyright misuse claims, and the *Lasercomb* court's failure to also apply the market power test exclusively in its copyright misuse analysis “was a mistake.”) *contra* Practice Mgmt. Information Corp. v. American Medical Ass'n 121 F.3d 516 (9th Cir. 1997) (“a defendant in a copyright infringement suit need not prove an antitrust violation to prevail on a copyright misuse defense.”(citing *Lasercomb* 911 F.2d at 978)); *Video Pipeline*, 342 F.3d at 206 (we extend the patent misuse doctrine to copyright, and recognize that it might operate beyond its traditional anticompetition context....”).

<sup>184</sup> *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster*, 454 F. Supp.2d at 995-996 (C.D. Cal. 2006) (citing *Video Pipeline*, 342 F.3d at 204-205).

<sup>185</sup> NIMMER, *supra* note 166, at § 7:35.

**SYRACUSE SCIENCE & TECHNOLOGY  
LAW REPORTER**

---

VOLUME 23

FALL 2010

ARTICLE , PAGE

---

ideas) refines the analysis from a mere look and feel test of “nexus” to an examination of the copyright owner’s purpose in implementing the technological protection measure for congruence with Congress’s purpose in granting the right to control access. In a sentence, “this access right allows owners to market their works in a digital environment by securing the opportunity to exclude users who have not paid the agreed price.”<sup>186</sup> Copyright owners using their access controls (or rights controls) for other ends, such as the capture of secondary markets and uncopyrightable material, or the extension of an expired copyright, should not find comfort in a DMCA claim.

#### **IV. CONCLUSION**

The “new” problems posed by the DMCA are, for all their statutory circumlocution, merely an extension of the game of cat-and-mouse between copyright owners and consumers that has played out before the courts in years past. Before the advent of the DMCA, the Supreme Court, in *Sony v. Universal City Studios*, expressed the same concern reiterated throughout this paper: “if affirmed [the finding of contributory copyright infringement], would enlarge the scope of respondents’ statutory monopolies to encompass control over an article of commerce that is not the subject of copyright protection.”<sup>187</sup> The DMCA has merely changed the venue, from the analog to the digital realm, and the relevant action from contributory copyright infringement to trafficking in circumvention devices. The need for the courts to remain vigilant in policing the extent of copyright protection remains.

---

<sup>186</sup> Denicola, *supra* note 21, at 230.

<sup>187</sup> *Sony v. Universal City Studios*, 464 U.S. 417, 421 (1984).