

Abstract

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Shifting the Burden to Internet Service Providers: The Validity of Subpoena Power Under the Digital Millennium Copyright Act

Matt Sellers

I. Introduction

The illegal distribution of copyrighted material over the Internet is a widespread practice in America today, due in large part to peer-to-peer software.¹ This type of software provides Internet users with a means to search other users' computers for material to download. The search capability of this software is completely passive and innocuous from a theoretical perspective, while in practice allowing for the widespread illegal transfer of copyrighted materials such as digital music and motion picture files. The question posed to copyright holders seeking to put an end to this practice is whether copyright litigation should be targeted at the peer-to-peer companies or the individual copyright infringers.

In April 2003, the motion picture and music recording industries lost in a critical case to the peer-to-peer software corporation named Grokster.² However, in the same month a different district court upheld the constitutionality of the subpoena power under the Digital Millennium

¹ The most popular brands of peer-to-peer software include KaZaA, Grokster, eDonkey, and Morpheus.

² Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd., 259 F. Supp. 2d 1029 (C.D. Cal. 2003) (holding that distributors of peer-to-peer software are not vicariously liable for the copyright violations of users).

Copyright Act (DMCA)³ which grants a copyright holder the authority to issue a subpoena to an Internet Service Provider (ISP) in order to obtain the identity of subscribers suspected of infringing upon its copyrights.⁴ The district court ruled on the constitutionality of the DMCA's subpoena provision notwithstanding the argument that such subpoena power violates Article III of the U.S. Constitution's case and controversy requirement and allegedly abridges the First and Fifth Amendment rights of Internet users.⁵ In an earlier case heard by this same district court, Verizon Internet Services rigorously argued that the subpoena power did not apply to its corporation simply because Verizon provides a passive forum for users to download and share copyrighted music.⁶ The prevailing party in both cases, Recording Industry Association of America (RIAA), represents the five largest record companies in the world. RIAA claimed that subscribers on Verizon's network were offering music files to others using peer-to-peer software in violation of RIAA's copyrighted interest in these songs.⁷ Collectively, the two *Verizon* decisions have persuaded ISPs across the nation to disclose the identity of specified users who RIAA claims are infringing on its copyrighted songs.

On September 8, 2003, RIAA filed copyright infringement lawsuits against 261 individual Internet subscribers.⁸ After RIAA's sweeping win in *Verizon*, many more lawsuits against alleged copyright infringers are expected.⁹ Despite RIAA's win on the constitutionality of the subpoena power granted to copyright owners under the DMCA, other litigation is pending

³ 17 U.S.C. § 512(h) (2000).

⁴ *In re Verizon Internet Services, Inc.*, 257 F. Supp. 2d 244, 275 (D.D.C. 2003).

⁵ *Id.*

⁶ *In re Verizon Internet Services, Inc.*, 240 F. Supp. 2d 24, 29 (D.D.C. 2003).

⁷ *Id.* at 28.

⁸ Paul R. La Monica, *Music Industry Sues Swappers*, CNN, Sept. 8, 2003, available at http://money.cnn.com/2003/09/08/technology/riaa_suits/ (last visited Nov. 29, 2003).

⁹ Cynthia L. Webb, *Settling in With the RIAA*, WASH. POST, Sept. 30, 2003, available at <http://www.washingtonpost.com/wp-dyn/articles/A21601-2003Sep30.html> (last visited Nov. 29, 2003).

with similar constitutional challenges. The most serious challenge to the Act is the broad power proscribed to court clerks, power which appears to transcend the authority of the judiciary under Article III of the U.S. Constitution. Other constitutional concerns involve potential First and Fifth Amendment violations.

II. The Digital Millennium Copyright Act of 1998

The DMCA amended the Copyright Act¹⁰ to limit the liability of ISPs for copyright violations by its users. Four levels of liability are covered by the Act; the level of liability an ISP may be subject to depends on the type of service the ISP provides.¹¹ The ISPs least liable are those that merely act as a passive conduit for communications created, controlled, and stored by others.¹² Verizon and Pacific Bell, two companies currently involved in litigation with RIAA, fall within this category.

In order to subpoena an ISP for the identities of alleged copyright infringers, a copyright holder must file a proposed subpoena, a sworn declaration of purpose, and a notification with the clerk of a district court.¹³ The notification of claimed infringement must be signed, include a description of the copyrighted work and the infringing material, as well as an accompanying statement that the requesting party has a good faith belief that use of the material is not authorized, under penalty of perjury.¹⁴ The notification requirements are described within the same section of the Act which outlines the liability for service providers who actually store information. Since passive ISPs are covered in a different section altogether,¹⁵ Verizon and

¹⁰ 17 U.S.C. § 501 (2000).

¹¹ 17 U.S.C. § 512(a)-(d) (2000).

¹² 17 U.S.C. § 512(a) (2000).

¹³ 17 U.S.C. § 512(h) (2000).

¹⁴ 17 U.S.C. § 512(c)(3) (2000).

¹⁵ 17 U.S.C. § 512(a) (2000).

Pacific Bell claim that the subpoena power was not intended to apply to them.¹⁶ Furthermore, since peer-to-peer software did not exist in 1998, the year in which the Act took effect, these ISPs argued that Congress did not contemplate the idea of imposing such liability on passive ISPs when it enacted the DMCA. However, RIAA countered this argument in the first *Verizon* decision by pointing out that the clear language of the statute provides that the subpoena power grants the authority to issue subpoenas to “service providers,” defined as being applicable to any provider of online services or network access, and not specific to any particular category of service providers defined under the Act.¹⁷ Passive ISPs were strong advocates of the DMCA at its inception, so it follows that they had ample opportunity to voice these concerns at that time.¹⁸ Sarah B. Deutsch, Verizon’s associate general counsel, later stated, “In hindsight, it was a mistake to agree to [the subpoena provision of the DMCA]. We thought it would be rarely used.”¹⁹

Another point of contention centering on the statutory language of the subpoena provision concerns its similarity with Federal Rule of Civil Procedure (FRCP) 45. One clause in the DMCA states that “the procedure for issuance and delivery of the subpoena...shall be governed to the greatest extent practicable” by the handling of a subpoena duces tecum under the Federal Rules of Civil Procedure (FRCP).²⁰ However, under FRCP 45 the proponent of a subpoena duces tecum must reasonably compensate the recipient for some expenses incurred in

¹⁶ Complaint For Declaratory Relief, available at http://www.eff.org/IP/P2P/PacBell_v_RIAA.pdf (last visited Nov. 29, 2003).

¹⁷ *Verizon*, 240 F. Supp. 2d at 32. See also 17 U.S.C. § 512(k)(1)(B) (2000).

¹⁸ Brief of Amici Curiae in Support of the Recording Industry Association of America and Urging Affirmance, available at <http://www.riaa.com/news/newsletter/pdf/amicusBriefSupportRIAA.pdf> (last visited Nov. 29, 2003).

¹⁹ Frank Ahrens, *Use of Subpoena to Name File Sharers Criticized*, WASH. POST, available at <http://www.washingtonpost.com/ac2/wp-dyn/A19721-2003Sep29> (last visited Nov. 29, 2003).

²⁰ 17 U.S.C. § 512(h)(6) (2000).

complying with the subpoena provisions.²¹ RIAA has completely failed to provide reasonable compensation to any ISP that produces user identities. As for now, it is far from clear how strictly the analogy to FRCP 45 will be constructed since this issue was not addressed by the district court in either of the *Verizon* decisions.

III. Judicial Power Under Article III

The second key issue in the debate between the RIAA and ISPs rests on the constitutionality of the subpoena power of the DMCA under Article III of the U.S. Constitution. The exercise of judicial power is limited to “cases or controversies,”²² yet subpoena power under the DMCA calls upon the clerk of the court to issue subpoenas to ISPs without any pending case requirement.²³ This subpoena is issued in the name of the district court and carries the enforcement authority of the court. A violation of the order could also provide a basis for contempt proceedings; a basis that implies the order is of a judicial nature.

In the second *Verizon* decision, the district court nevertheless upheld the constitutionality of the DMCA under Article III, reasoning that by issuing a subpoena under the DMCA, the clerk is performing a “quintessentially ministerial duty” which involves no discretion and thereby does not constitute an exercise of judicial power.²⁴ This ministerial duty was, in fact, specifically intended by the legislature when it enacted the DMCA.²⁵ The U.S. Supreme Court has repeatedly upheld the use of ministerial duties as being independent of the judiciary,²⁶ but it is

²¹ FED. R. CIV. P. 45(c)(3)(B)(iii) (2003).

²² U.S. CONST. art. III, § 2.

²³ 17 U.S.C. § 512(h)(1) (2000).

²⁴ *Verizon*, 257 F. Supp. 2d at 250. In so holding, the *Verizon* court relied largely on Chief Justice Marshall’s comments in *Custiss v. Georgetown & Alexandria Turnpike Co.*, 6 Cranch 233 (1810). In *Custiss*, Marshall stated that “the legislature may direct the clerk of a court to perform a specified service, without making his act the act of the court.” *Id.*

²⁵ S. REP. NO. 105-190, at 51 (1998).

²⁶ *Verizon*, 257 F. Supp. 2d at 250.

not certain whether this justification can be used for the issuance of a subpoena.²⁷ Congress has enacted several statutes that purport to provide this power to court clerks with respect to FRCP 45, but few court cases have dealt with this issue.²⁸

Another significant challenge to the Article III holding is the notion that the subpoena power could place a substantial burden on the judiciary's ability to perform by inundating the court system with subpoena requests. Although the district court in the second *Verizon* decision dismissed this claim with the rationale that it "is entirely speculative, as no such barrage of requests has occurred,"²⁹ the Federal District courthouse in Washington, D.C., has hired extra clerks to deal with litigation from the music industry in the months that have followed.³⁰ As RIAA gears up for another round of lawsuits, this burden on the court system may become an even stronger argument in favor of ISPs.

IV. First Amendment and Procedural Due Process

ISPs have also argued that the subpoena power under the DMCA is overbroad, allowing a copyright owner to obtain the identities of Internet users who are not violating any of its copyrights. Because of the lack of judicial scrutiny, ISPs argue that the subpoena power could be used by anyone that claims to have a copyright, including "cyberstalkers," in order to obtain the identity of users from Internet protocol (IP) addresses, which are generally not difficult to determine. As one representative of the American Civil Liberties Union (ACLU) pointed out, "[T]here is nothing to stop a vindictive business or individual from claiming copyright to acquire

²⁷ *Id.* at 251.

²⁸ *Id.*

²⁹ *Id.* at 256.

³⁰ Chris Taylor, *Downloader Dragnet*, TIME MAGAZINE, Aug. 04, 2003, available at http://affiliate.timeincmags.com/time/archive/preview/from_search/0,10987,1101030804-471178,00.html (last visited Nov. 29, 2003).

the identity of critics."³¹ Normally, a subpoena of this nature requires some underlying crime and must be approved and signed by a judge. Under the DMCA, the notification requirement is the only evidence that needs to be submitted to the court, and such requirements are not subject to any immediate judicial scrutiny.

In the second *Verizon* decision, the court held that the ISP did not have any evidence that DMCA subpoenas had been used by RIAA to identify anyone other than Internet users engaging in copyright infringement.³² But since the case has been decided, charges have been dropped against several Internet users incorrectly identified as copyright infringers, including a high-profile case in which RIAA wrongly obtained the identity of an elderly schoolteacher who did not even possess the correct computer with which to run peer-to-peer software.³³

ISPs and civil liberties groups argue that the relative ease with which a DMCA subpoena can be obtained violates Internet users' fundamental right to anonymity³⁴ and, as a result, will have a "chilling effect" on free speech and expression of Internet users. Both ISPs and civil liberties groups claim that Internet users are denied procedural due process³⁵ when copyright holders are able to remove users' anonymity without providing notice or opportunity to be heard, effectively shifting the burden to the ISP to protect its users' Fifth Amendment rights.³⁶

³¹ Declan McCullagh, *RIAA Draws Civil Liberties Opposition*, CNET News.com, Sept. 30, 2003, available at <http://news.zdnet.co.uk/business/legal/0,39020651,39116777,00.htm> (last visited Nov. 29, 2003).

³² *Verizon*, 257 F. Supp. 2d at 264.

³³ Joe D' Angelo, *RIAA Drops Privacy Suit Against 66-Year-Old Grandmother*, MTV NEWS, available at <http://www.mtv.com/news/articles/1479303/20030925/index.jhtml> (last visited Dec. 3, 2003).

³⁴ See *Buckley v. Am. Constitutional Law Found., Inc.*, 525 U.S. 182 (1999). See also *NAACP v. Alabama ex rel. Patterson*, 357 U.S. 449 (1958).

³⁵ According to the court in the second *Verizon* decision, ISPs have standing to challenge the DMCA on behalf of Internet users whose First Amendment rights may be affected by the outcome. See *In re Verizon Internet Services, Inc.*, 257 F. Supp. 2d 257 (D.D.C. 2003).

³⁶ Brief in Support of Motion to Quash, available at <http://www.aclu.org/Privacy/Privacy.cfm?ID=13791&c=251> (last visited Nov. 29, 2003).

RIAA contends that the notification requirements, which include a sworn declaration of purpose and statement of good faith under penalty of perjury, provide sufficient procedural safeguards to prevent substantial denial of First and Fifth Amendment rights.³⁷ The court in the second *Verizon* decision agreed, adding that the First Amendment does offer some protection to anonymous expression on the Internet, but the degree of protection is minimal where alleged copyright infringement is the expression at issue.³⁸ Implicit in this holding is the presumption that users of peer-to-peer software are engaging in copyright infringement. While in practice this is usually correct, peer-to-peer software can be used to transfer noncopyrighted files as well.³⁹ If peer-to-peer software users are not presumed to be engaging in copyright infringement, then why should the mere allegation of copyright infringement be sufficient to abridge users' First Amendment rights? On the other hand, if the presumption does exist, then how can peer-to-peer software companies continue to avoid liability for contributory infringement? After all, these companies have created a forum with the express purpose of expediting the transfer of digital files, and they are also aware that users engage in illegal practices using this software.⁴⁰ Nevertheless, these peer-to-peer software companies have failed to provide any safeguards against copyright infringement by users who are anonymous. Thus, since software companies

³⁷ Brief of Amici Curiae in Support of the Recording Industry Association of America and Urging Affirmance, available at <http://www.riaa.com/news/newsletter/pdf/amicusBriefSupportRIAA.pdf> (last visited Nov. 29, 2003).

³⁸ *Verizon*, 257 F. Supp. 2d at 260.

³⁹ See *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 259 F. Supp. 2d 1029 (C.D. Cal. 2003). "Plaintiffs do not dispute that Defendants' software is being used, and could be used, for substantial noninfringing purposes." *Id.* at 1036.

⁴⁰ See *id.* at 1038. "Here, it is undisputed that Defendants are generally aware that many of their users employ Defendants' software to infringe copyrighted works...The question, however, is whether actual knowledge of specific infringement accrues at a time when either Defendant materially contributes to the alleged infringement, and can therefore do something about it." *Id.*

acknowledge these general practices on their networks and still choose to remain neutral, the presumption of copyright infringement must exist, rendering the *Verizon* court correct in reducing First and Fifth Amendment protection accordingly.

V. Conclusion

Irrespective of the holding in the *Verizon* decisions, the broad authority granted to court clerks acting outside of the scope of the judiciary may well be unconstitutional as violative of Article III's case or controversy limitation. The idea that a court clerk has the authority to issue a subpoena that is considered to be outside the scope of the judicial branch appears to be an illogical stretch rationalized under the theory of ministerial duties. Yet the fact that the clerk exercises no discretion in the matter makes the position seem more like a function of the legislative branch. At the same time, this lack of discretion raises substantial concerns regarding the relative ease that a copyright holder has in obtaining a subpoena and thus the identity of any Internet user suspected of copyright infringement. One compromise that should be reconsidered is allowing a DMCA subpoena to be issued only in connection with a pending copyright lawsuit.⁴¹

While subpoena power under the DMCA is overbroad to some extent, the court in *Verizon* correctly concluded that the risk of widespread "cyberstalking" is minimal. The fact that one can conceive of a manner in which a statute can be abused should not create a significant challenge to its constitutionality. However, an IP address is not a very reliable way of obtaining a user's identity. There will undoubtedly be a number of users that are incorrectly identified using this method. For example, malicious computer experts are sometimes able to compromise

⁴¹ Brief As Amici Curiae In Support of Appellant Verizon Internet Services and Urging Reversal, *available at* http://www.epic.org/privacy/copyright/verizon/Appeal_1_amicus.pdf (last visited Nov. 29, 2003).

the security of unsuspecting systems in order to utilize an IP address as their own, and the rapidly emerging technology of wireless Internet could allow individuals to covertly take advantage of another user's broadband Internet account from a nearby location.

Even mistaken identification will probably not have the "chilling effect" on freedom of speech and expression on the Internet that the ACLU and ISPs contemplate. Since Americans have a right to anonymity over the Internet, they should not expect their identities to be revealed to a copyright holder unless they have actually been engaging in copyright infringement. Users who are not aware that they have the right to anonymity will have no reason to change their Internet-related expression once they discover that they might be mistakenly identified. Due to the low frequency of mistaken identification, users who are aware that they have a right to anonymity but are not violating copyright laws should not fear that they might be identified under the DMCA, and therefore should have no reason to refrain from speech or expression. Hence, the only group of users whose First Amendment rights would be affected by these lawsuits would be those engaging in copyright infringement, unless the subpoena power is thoroughly abused.

Those interested in preventing the widespread distribution of copyrighted files will have to find a way to target peer-to-peer software companies if the subpoena power under the DMCA is held on appeal as unconstitutional. The strongest post-*Verizon* arguments for ISPs to make will focus on the lack of reliability and overbreadth associated with determining users' identities based upon IP addresses, the absence of reasonable monetary compensation for compliance with the subpoenas, and the substantial burden placed on the judiciary in connection with subpoena requests. These arguments, in combination with the argument that the DMCA violates the case or controversy limitation of Article III, will likely result in the ISPs winning on appeal. When

1 OKLA. J. L. & TECH. 8 (2003)
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they do prevail, RIAA will be powerless to prevent the unauthorized and illegal transfer of its copyrighted material over the Internet with the use of peer-to-peer software, and the music and motion picture industries will continue to suffer accordingly until Congress develops new legislation to address this issue.