

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF NORTH CAROLINA
GREENSBORO DIVISION

IN RE SUBPOENA TO UNIVERSITY OF
NORTH CAROLINA AT CHAPEL HILL

**BRIEF OF *AMICI CURIAE* IN SUPPORT
OF JOHN DOE'S MOTION TO QUASH
THE SUBPOENA ISSUED BY RIAA TO
UNC**

RECORDING INDUSTRY ASSOCIATION
OF AMERICA,

Case No. 1:03MC138

v.

UNIVERSITY OF NORTH CAROLINA AT
CHAPEL HILL.

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INTRODUCTION¹

John Doe, a student at the University of North Carolina, Chapel Hill (“UNC”), is the actual target of a subpoena issued by the clerk of the United States District Court for the Middle District of North Carolina at the request of the Recording Industry Association of America (“RIAA”). However, unlike other federal subpoena provisions, this subpoena provides the target with no right to challenge its validity. Indeed, the subpoena in question – authorized by Section 512(h) of the Digital Millennium Copyright Act, 17 U.S.C. § 512(h) – has no mechanism for the actual target to obtain any judicial review of its legitimacy.

The subpoena, seeking highly personal information about John Doe, is nominally directed at UNC because the University is the Internet Service Provider (“ISP”) for John Doe. UNC does not have the same interest in protecting John Doe’s information from public disclosure as he does, but under the Section 512(h) statutory scheme, Internet users have neither the right to be notified that a subpoena was issued nor the right to move the court to quash it. It was only through UNC that John Doe was even notified of the subpoena.

The subpoena at issue is based on an unsworn and unsubstantiated allegation that John Doe has made copyrighted music available for downloading on his personal computer. The RIAA does not allege that there has been unlawful copying of music or that the music was not lawfully acquired by John Doe. *See* Subpoena RIAA served on UNC on Nov. 12, 2003 (“Subpoena”). Rather, the papers underlying the subpoena simply assert there is a “good faith” belief that Mr. Doe “offered for download through the online media distribution system known

¹ American University, Washington College of Law, Glushko-Samuelson Intellectual Property Law Clinic Students Elena K. Chan and Myriah Habeeb prepared this work under the supervision of Professors Peter Jaszi and Richard S. Ugelow.

as MP2P copyrighted sound recordings owned by RIAA member record companies.” Subpoena at 4. Section 512(h) does not provide any independent means of verifying the basis of this assertion. Nor does the statute provide effective means of policing how the personal and private information, once obtained from the ISP, is used.

This Court must decide whether to enforce a pre-litigation subpoena issued by a court clerk, without any review by a judge, at the request of a copyright owner pursuant to Section 512(h) ordering a university in its capacity as an ISP to disclose the private identifying information of one of its student-subscribers based solely on the copyright owner’s unsupported and unverified allegations that the student-subscriber “offered for download” certain copyrighted files. Subpoena at 4. Thus, there are several fundamental interests at stake in this proceeding. As fully briefed in John Doe’s Motion to Quash, Internet users’ fundamental rights to privacy and anonymity in their online communications are threatened. *See* John Doe’s Motion to Quash filed on Nov. 21, 2003 (“Motion to Quash”), at 13. The RIAA’s use of Section 512(h) impermissibly impinges on both of these fundamental rights, and they have not come close to establishing an interest in disclosure so compelling to warrant disregarding constitutional due process guarantees.

In *Theofel v. Farey Jones*, 341 F.3d 978, 984 (9th Cir. 2003), the court had occasion to review the propriety of a private subpoena for electronic records. There, the court stated:

The subpoena power is a substantial delegation of authority to private parties, and those who invoke it have a grave responsibility to ensure it is not abused. Informing the person served of his right to object is a good start, *see* Fed. R. Civ. P. 45(a)(1)(D), but it is no substitute for the

exercise of independent judgment about the subpoena's reasonableness.

Fighting a subpoena in court is not cheap, and many may be cowed into compliance with even overbroad subpoenas, especially if they are not represented by counsel or have no personal interest at stake.

Clearly, the Section 512(h) subpoena process is a powerful tool and its use should not go unchecked. Mr. Doe should have the opportunity to protect his privacy interests because once those interests have been invaded and compromised he is without recourse.

This is a case of first impression. While similar cases have been brought by the RIAA, they have been settled or are likely to be settled.² However, there are two cases pending before the Court of Appeals for the District of Columbia Circuit that address issues similar to those in this case. In those cases, *In re Verizon Internet Servs., Inc.*, 240 F. Supp. 2d 24 (D.D.C. 2003), *appeal pending*, No. 03-7015 (D.C. Cir. argued Sept. 16, 2003) (“Verizon I”); *In re Verizon Internet Servs., Inc.*, 257 F. Supp. 2d 244 (D.D.C.), *appeal pending*, No. 03-7053 (D.C. Cir. argued Sept. 16, 2003) (“Verizon II”), at issue are whether actions such as this one raise an Article III case or controversy and whether Section 512(h) authorizes copyright holders to require ISP’s to identify their subscribers.³

² *Amici* are aware of two *attempts* by Internet users to assert their rights in proceedings seeking to enforce Section 512(h) subpoenas for their identities. A Boston College student sought to intervene in a proceeding in U.S. District Court for the District of Massachusetts in October 2003, but the matter settled before the court considered the merits. *RIAA v. Boston College*, No. 03-MC-10256-WGY (D. Mass. filed Sept. 26, 2003) (Exhibit A to Appendix). A Verizon Internet subscriber petitioned to intervene in a Section 512(h) enforcement proceeding in U.S. District Court for the District of Columbia in August 2003, but the court has not granted or denied the petition. *RIAA v. Verizon Internet Services*, No. 03-804 (HHK/JMF) (D.D.C. filed Aug. 21, 2003) (Exhibit B to Appendix).

³ *Amici* are aware of two proceedings where ISPs have challenged the RIAA’s use of Section 512(h) to discover the identities of their subscribers. *Pacific Bell Internet v. RIAA*, No. C 03-03560 SI (N.D. Cal.

ARGUMENT

Amici support Intervenor John Doe's Motion to Quash the subpoena issued by the clerk of the United States District Court for the Middle District of North Carolina pursuant to 17 U.S.C. § 512(h) at the request of the RIAA. The subpoena seeks to require UNC, Mr. Doe's university, which provides him with Internet services, to disclose his identifying information.

This Court should grant John Doe's Motion to Quash because the issuance of the subpoena violates the due process clause of the Fifth Amendment. U.S. CONST. amend. V. The Supreme Court has held that "in procedural due process claims, the deprivation by state action of a constitutionally protected interest . . . is not in itself unconstitutional; what is unconstitutional is the deprivation of such an interest *without due process of law.*" *Zinermon v. Burch*, 494 U.S. 113, 125, 110 S. Ct. 975, 983, 108 L. Ed. 2d 100, 114 (1990). Procedural due process is implicated when, as here, a cognizable liberty or property interest is at risk from governmental action. *Mallette v. Arlington County Employees Supplemental Ret. Sys. II*, 91 F.3d 630, 634 (4th Cir. 1996); *Bd. of Regents v. Roth*, 408 U.S. 564, 569-70, 92 S. Ct. 2701, 2705, 33 L. Ed. 2d 548, 556 (1972). Here, John Doe's privacy interest in communicating anonymously over the Internet is threatened.

Procedural due process prescribes the minimum standards with which the government must comply prior to the deprivation of a cognizable interest. *Cleveland Bd. of Educ. v. Loudermill*, 470 U.S. 535, 541, 105 S. Ct. 1487, 1493, 84 L. Ed. 2d 494, 503 (1985). When due

process is implicated, notice and hearing before an impartial decision-maker are ordinarily required. *See Mullane v. Cent. Hanover Bank & Trust Co.*, 339 U.S. 306, 70 S. Ct. 652, 94 L. Ed. 865 (1950) (discussing notice as a requirement of due process). Just as Section 512(h) fails to provide for notice to the actual target of a subpoena, it is devoid of any provisions providing for a hearing either before or after the issuance of a subpoena calling for the release of personal information.

In Part I of this brief, *amici* demonstrate that Section 512(h) lacks any meaningful safeguards against error and abuse, and therefore disempowers courts from fulfilling their judicial function. Part II will show that, at the very minimum, Section 512(h) requires a copyright owner to make an *allegation* of copyright infringement. Here, RIAA fails to even make such an averment.

I. 17 U.S.C. § 512(h), AN UNPRECEDENTED MECHANISM FOR INVADING THE PROTECTED INTERESTS OF INDIVIDUAL INTERNET USERS, INCORPORATES NO MEANINGFUL SAFEGUARDS AGAINST ERROR AND ABUSE.

A. THE THRESHOLD REQUIREMENTS OF 17 U.S.C. § 512(h) ARE NOT PROTECTIVE OF INTERNET USERS' RIGHTS.

Section 512(h) allows any person purporting to be a copyright owner or acting on behalf of a copyright owner to obtain “expeditiously” a subpoena ordering, under threat of court sanctions, an ISP to disclose the personal identifying information of its subscribers. To obtain a subpoena, the requester need only submit to the clerk of a United States District Court: (1) a copy of a Section 512(c)(3)(A) notification, (2) a proposed subpoena, and (3) a declaration wherein the requester swears that the subpoena is sought to acquire the identity of an alleged

copyright infringer and that the identifying information will only be used to protect the copyright owner's rights. 17 U.S.C. § 512(h)(1), (2).

Among the elements of this “package,” the only requisite substantive allegation about the subpoena target's conduct is a “statement that the complaining party has a good faith belief that the use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law.” 17 U.S.C. § 512(c)(3)(A) . A Section 512(c)(3)(A) notification, to which Section 512(h)(2)(A) refers, must be in writing and contain six unsupported and unverified items of information: (i) a physical or electronic signature of a person authorized to act on the copyright owner's behalf, (ii) an identification or representative list of copyrighted works that are allegedly infringed, (iii) information sufficient to enable the ISP to locate the allegedly infringing material, (iv) petitioner's contact information, (v) a statement that petitioner has “a good faith belief that use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law,” and (vi) a statement indicating that the notification is accurate, “and under penalty of perjury, that the complaining party is authorized to act on behalf of the owner of an exclusive right that is allegedly infringed.” 17 U.S.C. § 512(c)(3)(A). None of these six elements is subject to independent verification, and only the assertion referred to in the second part of Section 512(c)(3)(A)(vi) – that the applicant “is authorized to act on behalf of the owner of an exclusive right that is allegedly infringed” – is made under penalty of perjury, leaving the veracity of five and one-half of six items effectively unchecked.

B. 17 U.S.C. § 512(h) DOES NOT PROVIDE INTERNET USERS WITH NOTICE OR HEARING, AND THEREBY PRECLUDES A COURT FROM STEPPING IN TO PROTECT THE RIGHTS OF INTERNET USERS.

The clerk of a U.S. District Court who issues a Section 512(h) subpoena performs a ministerial duty. If all elements of Section 512(h)(2) are present in proper form, the clerk must issue the requested subpoena – without exercising any discretion. 17 U.S.C. § 512(h)(4); *Verizon II*, 257 F. Supp. 2d at 249-250. Upon presentment of this “rubber stamped” subpoena, the ISP to whom the subpoena is directed must “expeditiously” respond.⁴ The statute does not require and the ISP is not obligated to notify the subscriber that his or her sensitive and highly personal information is sought by a third party.

A copyright owner seeking a Section 512(h) subpoena need not make any showing that copyright infringement has occurred. Moreover, Section 512(h) also does not contemplate notice to the individual whose identifying information is sought, nor is there any provision allowing a person who is merely alleged to be a copyright infringer to oppose the subpoena ordering the disclosure of his or her private identifying information.⁵ As a result, there is a substantial risk that an Internet user’s identity would be revealed without his or her knowledge and without an opportunity to challenge the disclosed grounds on which the subpoena is sought. Significantly,

⁴ Procedures pertaining only to issuance, delivery, and remedies for noncompliance with the subpoena are governed “to the greatest extent practicable” by the Federal Rules of Civil Procedure. 17 U.S.C. § 512(h)(6).

⁵ In *Verizon II*, the district court recognized that Section 512(h) does not provide for notice to the subscriber whose identity stands to be revealed through a subpoena served on the ISP, but suggested that this deficiency is cured because the *ISP* has an opportunity to contest the subpoena prior to revealing the identity of its subscriber. 257 F. Supp. 2d at 254, 258. In the text, *amici* disagrees with the *Verizon II* district court.

RIAA has served thousands of subpoenas on various ISPs. *See* Motion to Quash at 5. To date, Mr. Doe is one of only three Internet subscribers who have sought to challenge a Section 512(h) subpoena ordering the disclosure of his or her private information. It is likely that more targets would have challenged the legitimacy of the subpoenas had they actually known of them.

In addition, Section 512(h) provides for no discretionary review of the subpoena application prior to issuance -- even on an *ex parte* basis.⁶ Providing the actual target of a Section 512(h) subpoena with a meaningful opportunity to be heard is important because it would give the court an opportunity to protect the interests of the Internet user, as justice may require, prior to the disclosure of his or her personal identifying information.

Although Section 512(h) requires ISPs, the custodians of their subscribers' private identifying information, to reveal this information, ISPs are not in a good position to represent adequately the interests of individual subscribers. As ISPs provide Internet services to thousands of individual subscribers, ISPs lack the fundamental particularized knowledge relating to each individual subscriber's circumstances to represent effectively any one subscriber's interests. In particular, an ISP would not be well-positioned to know the contents of the applicant's crucial "good faith" statement relating to alleged infringement, or to attempt to rebut it, and *amici* are not aware that any ISP has done so.

⁶ By contrast, Fed. R. Civ. P. 65 grants district courts the authority to issue temporary restraining orders on an *ex parte* basis, but only for limited periods of time, upon a sufficient bond, and within the sound discretion of the judicial officer to whom the application is made.

C. 17 U.S.C. § 512(h) FAILS TO PROVIDE THE COURT WITH AN OPPORTUNITY TO SET LIMITATIONS ON DISCLOSURE.

While the statute anticipates that identifying information obtained through a Section 512(h) subpoena will “only be used for the purpose of protecting rights under this title,” 17 U.S.C. § 512(h)(2)(C), the statute neither makes clear what constitutes “protecting rights,” nor imposes any meaningful restrictions on downstream use of such private and sensitive identifying information. “[P]rotecting [a copyright owner’s] rights” may be broadly interpreted by copyright owners to extend beyond the filing of a lawsuit to include such activities as use of subscribers’ names as part of “education” campaigns to deter others from similar allegedly infringing acts, communicating with individuals directly by e-mail or otherwise, and sharing information about subscribers with law enforcement authorities.⁷

Section 512(h) puts into the hands of copyright owners, who are motivated by private interests, the unilateral and unchecked power to order an ISP to unmask, under the authority of a court, the identity of an Internet user who is merely suspected of making available files for download. Section 512(h) neither contemplates nor provides any role for a judge to exercise discretion, as justice may require,⁸ to deny the issuance of a subpoena despite technical

⁷ RIAA President, Cary Sherman, has said that “[RIAA] lawyers will pursue downloaders regardless of personal circumstances because it would deter other Internet users.” RIAA’s strategy is “not to be selective, to let people know that if they’re offering a substantial number of files for others to copy, they are at risk.” Ted Bridis, “Everyone Is a Target in Music Subpoenas” THE ASSOCIATED PRESS ONLINE, Jul. 25, 2003, *available at* <http://www.phillyburbs.com/pb-dyn/news/95-07262003-130712.html> (last visited Nov. 23, 2003) (Exhibit C to Appendix).

⁸ For example, a copyright owner could use Section 512(h) in bad faith for the purpose of annoying or harassing an Internet user. A hearing would also allow an Internet subscriber to request the court, in its discretion, to limit the use to which his/her personal information could be put to prevent the potential negative repercussions of disclosure. Such procedures would not frustrate the purpose of the Section 512(h) subpoena provision by still allowing for an expeditious remedy to *alleged* wrongful acts, however, John Doe would be able to exercise his constitutional guarantee to due process. Such judicial power to

compliance with Section 512(h). Rather, because Section 512(h) does not provide for notice to the party whose information is being sought, a court may not have the opportunity to step in to prevent the deprivation of an Internet user's rights to privacy and anonymity. Thus, the procedural deficiencies of Section 512(h) function to disempower courts of their ability to fulfill their judicial function of addressing instances of error and abuse, as justice may require, before innocent Internet users are irreparably harmed.

D. THE DUE PROCESS DEFICIENCIES OF SECTION 512(h) ARE CLEAR WHEN COMPARED TO OTHER SUBPOENA PROVISIONS IN FEDERAL LAW.

The due process deficiencies are even more apparent, and the need for judicial oversight even more evident, when Section 512(h) is compared to other federal subpoena laws. Section 512(h) represents an extreme departure from other federal subpoena laws. Unlike those provisions, Section 512(h) grants virtually unfettered and unsupervised subpoena power to the applicant, while offering absolutely no protection to the target of the subpoena. As described earlier, the procedure for obtaining an investigative subpoena provided in Section 512(h) has a number of characteristics that give rise to the concern that it may be employed to unjustifiably or unnecessarily impinge on individuals' protected right to communicate anonymously over the Internet. In particular, Section 512(h) subpoenas routinely are issued by the clerk of court on a *pro forma* basis (1) at the request of a private party to civil litigation, (2) on an *ex parte* basis, (3) without review by a judge or magistrate, (4) outside the context of any pending action and

intervene to prevent unwarranted or unrestricted disclosure of an Internet user's identity is important because once the information has been disclosed, it cannot be recalled – and, as a practical matter, the “cat is out of the bag,” and the Internet subscriber's right to speak anonymously is lost. *See generally In re Sealed Case 00-5116*, 237 F.3d 657 (D.C. Cir. 2001).

without any concrete showing that an actual wrong has occurred, (5) exclusively for the purpose of obtaining sensitive information about third parties, and (6) with no meaningful restrictions on the uses that may be made of that information after it is obtained. Among the mechanisms of which *amici* are aware, none besides Section 512(h) possess all of the characteristics just mentioned -- all other subpoena provisions incorporate one or more meaningful safeguards to protect the interests of investigative targets. Thus, for example:

- The pre-filing deposition subpoena authorized in FED. R. CIV. P. 27(a) is issued after judicial scrutiny only when it is shown that the applicant expects to bring a suit cognizable in federal court but, for some reason, is currently unable to do so, and that there is a substantial danger that testimony sought to be preserved by deposition would otherwise become unavailable before a complaint could be filed. FED. R. CIV. P. 27(a)(1), (a)(3); see *In re Deiulemar Compagnia di Navigazione S.P.A. v. M/V Allegra*, 198 F.3d 473, 484 (4th Cir. 1999). As a part of the judicial oversight provided under Rule 27(a), a judge selects the witnesses the petitioner will depose and defines the subject matter of the deposition. FED. R. CIV. P. 27(a)(3).
- Likewise, letters rogatory under 28 U.S.C. § 1782, compelling testimony and the production of documents for use in a foreign or international tribunal, are authorized only at the discretion of a federal judge, and not as a ministerial act of the clerk of a federal court. See *United States v. Mason*, 919 F.2d 139, 139 (4th Cir. 1990) (“The decision to issue letters rogatory lies within the discretion of the district court.”).

- Grand jury subpoenas are issued *pro forma*, but not at the request of private persons acting out of self-interest; rather, grand jurors are sworn to act only in the public interest. Even more crucially, the results of their investigations are subject to strict confidentiality requirements. *See* FED. R. CRIM. P. 6(e)(2)(B)(i) – (vi) (Supp. 2003); Administrative Office of the United States Courts, Handbook for Federal Grand Jurors, at 6, *available at* <http://www.fletc.gov/legal/handbook.pdf> (last visited Nov. 20, 2003) (Exhibit D to Appendix).
- Under the Railway Labor Act, subpoenas may be issued by the clerks of federal district courts to compel the attendance of witnesses and production of documents before arbitration boards. 45 U.S.C. § 157(h). However, by their nature, these are not investigative subpoenas, and are available only in connection with pending arbitration proceedings. In fact, they are not requested directly by parties to an arbitration, but by the board or any member thereof – in the discretion, that is, of a quasi-judicial officer. Moreover, *amici* are aware of no instance in which subpoenas of this type have been issued to third parties, rather than to companies participating in an arbitration proceeding or persons under their control. *See also* 9 U.S.C. § 7 (listing general provisions for subpoenas in arbitration proceedings under the Federal Arbitration Act).
- The subpoena provisions of 35 U.S.C. § 24 authorize clerks of court to issue subpoenas in connection with contested cases actually pending before the Patent and Trademark Office -- not in connection with pre-filing investigations. *See generally Brown v. Braddick*, 595 F. 2d 961, 964 (5th Cir. 1979). As an additional check in these cases, courts have held

that court-ordered discovery is available only to the extent permitted by the Commissioner of Patents. *See Sheehan v. Doyle*, 529 F.2d 38 (1st Cir. 1976); *see also* Note, Discovery in Patent Interference Proceedings, 89 HARV. L. REV. 573 (1976) (Exhibit E to Appendix).

- Similarly, substantial protections against abuse, overreaching, or error are in place in connection with subpoenas in aid of contested proceedings under the Plant Variety Protection Act, 7 U.S.C. § 2354. The provision requires implementing regulations, and the only ones applicable are the Department Rules of Practice Governing Formal Adjudicatory Proceedings Instituted by the Secretary Under Various Statutes (7 C.F.R. § 1.130 - 1.151), which would require a determination by an administrative law judge or hearing examiner before a subpoena could be sought.

In sum, Section 512(h) lacks any, even remotely close, parallel in the whole array of federal legislation and judicial practice relating to subpoenas.

II. THE SUBPOENA RIAA SERVED ON UNC DOES NOT ALLEGE COPYRIGHT INFRINGEMENT, AND THUS FAILS TO MEET THE MINIMAL REQUIREMENTS OF SECTION 512(h).

As Intervenor has documented, the emerging view in the courts is that the disclosure of a person's private identifying information that might compromise his or her rights to privacy and anonymity should be made only on some factual demonstration that the assertions are meritorious. *See* Motion to Quash at 18. By contrast, Section 512(h) does not require a subpoena applicant to make any type of factual showing – rather, it requires only *allegations* of

actionable misconduct. In this proceeding, RIAA has failed to meet even this flaccid and inadequate standard.

Section 512(h) merely requires a petitioner to allege a *prima facie* claim of copyright infringement. The statute requires that the Section 512(c)(3)(A) notice include assertions that the applicant “has a good faith belief that use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law,” 17 U.S.C. § 512(c)(3)(A)(v) , and that the applicant “is authorized to act on behalf of the owner of an exclusive work that is allegedly infringed.” 17 U.S.C. § 512(c)(3)(A)(vi). These two provisions must be read together, so that the first assertion comprises an allegation of infringement -- not merely of an otherwise lawful but unauthorized use. Any other interpretation would lead to the anomalous result that Section 512(h) subpoenas could be routinely demanded even where, for example, a copyright owner concedes that an anonymous user’s activities fall within the ambit of “fair use.” That Congress cannot have intended such an absurd outcome is further reinforced by the wording of Section 512(h)(1), which states that the clerk of the district court may be asked to issue a subpoena to an ISP “for the identification of an alleged infringer.” 17 U.S.C. § 512(h)(1).

A *prima facie* claim of copyright infringement includes at least two elements: (1) that a copyright subsists in the allegedly infringed material, and (2) that the alleged infringer violated at least one of the six exclusive rights granted to copyright owners under 17 U.S.C. § 106. *See* 17 U.S.C. § 501(a) (infringement occurs when alleged infringer engages in activity listed in Section 106). Even assuming that RIAA was able to show that one of its member recording companies owned the copyright to a sound recording alleged to reside on Mr. Doe’s computer, RIAA has failed to allege that Mr. Doe has violated any of these exclusive rights.

The Copyright Act does not give a copyright owner exclusive control over every possible use of his or her work. Rather, the Copyright Act limits a copyright owner's control to the six exclusive rights specifically enumerated in Section 106: (1) to reproduce, (2) to prepare derivative works, (3) to distribute copies of, (4) to perform publicly literary, musical, dramatic, and choreographic works; pantomimes, motion pictures, and other audiovisual works, (5) to display publicly; and (6) to perform publicly sound recordings. 17 U.S.C. § 106(1) – (6). The subpoena RIAA served on UNC alleges that “[t]he user at the above-identified IP address, using the screen name hulk, has *offered for download*, through the online media distribution system known as MP2P, copyrighted sound recordings owned by RIAA member record companies.” Subpoena at 4 (emphasis added). Notably, the subpoena does not assert that this “offer” was ever consummated when another user of file-sharing software downloaded the musical selections John Doe allegedly made available.

The only right that could conceivably be implicated by the act described in the subpoena is Section 106(3), which reserves to the copyright owner the authority “to distribute copies or phonorecords of the copyrighted work to the public...” However, an unauthorized “offer[] for download,” in itself, does not constitute infringement by distribution. The general rule on this point, as stated by the two leading copyright treatises, could not be more clear: “[i]nfringement of [the distribution] right requires *an actual dissemination* of either copies or phonorecords,” not a mere offering. NIMMER ON COPYRIGHT, § 8.11[a], at 8-137 (emphasis added); Goldstein, 2 Copyright § 5.5.1 at 5:102 (to “violate the distribution right ... an actual transfer must take place;

a mere offer of sale will not violate the right”) (Exhibit F to Appendix).⁹ Here, no “actual dissemination” or “actual transfer” is alleged.

This general rule is widely supported by a range of circuit and district court decisions. In *Nat’l Car Rental Sys., Inc. v. Computer Assocs. Int’l, Inc.*, the Eighth Circuit held that no distribution occurred when the defendant, without the copyright owner’s permission, permitted third parties to use a copyrighted computer program. 991 F.2d 426, 434 (8th Cir. 1993). Similarly, in *Paramount Pictures Corp. v. Labus*, a district court held that an offer to distribute videotapes to members of the public did not constitute infringement – copyright infringement occurs only upon an actual rental of the videotapes. 16 U.S.P.Q.2d (BNA) 1142 (W.D. Wis. 1990) (Exhibit H to Appendix). Likewise, in *Obolensky v. G.P. Putnam’s Sons*, a district court in New York held no infringement occurs where “defendant offers to sell copyrighted materials but does not consummate a sale; equally, there is no infringement of the [distribution] right where there is copying, but no sale of the material copied.” 628 F.Supp. 1552, 1554 (S.D.N.Y.), *aff’d* 795 F.2d 1005 (2d Cir. 1986).¹⁰

⁹ This understanding of “distribution” is consistent with the meaning assigned to that term in the World Intellectual Property treaties that the Digital Millennium Copyright Act was intended to implement in U.S. law. *See, e.g.* World Intellectual Property Organization Copyright Treaty, Dec. 20, 1996, art. 6(1) (“Authors of literary and artistic works shall enjoy the exclusive right of authorizing the making available to the public of the original and copies of their *works through sale or other transfer of ownership.*”) (emphasis added); Jörg Reinbothe and Silke von Lewinski, *THE WIPO TREATIES – 1996* at 86 ¶ 12 (2002) (stating that “[n]on-permanent distribution in the form of rental or other transfer of possession, which constitutes temporary distribution, without assigning the property, does not qualify”) (Exhibit G to Appendix).

¹⁰ It is important to note that neither of the two cases dealing with online file sharing, *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004 (9th Cir. 2001), and *In re Aimster Copyright Litigation*, 334 F.3d 643 (7th Cir. 2003), addresses the question of whether “uploading” that does not result in any actual subsequent downloading, in itself, constitutes a completed act of infringement. Rather the *Napster* court assumes consummated transactions between uploaders and downloaders without analyzing if such acts indeed occurred. 239 F.3d at 1014 (“Napster users who upload file names to the search index for others to copy

In the special context of library circulation of collection items, in a 2-1 decision the Fourth Circuit was willing to presume that an actual distribution of copies had occurred when a public institution “places an unauthorized copy of the work in its collection, includes the copy in its catalog or index system, and makes the copy available to the public.” *Hotaling v. Church of Jesus Christ of Latter-Day Saints*, 118 F.3d 199, 201 (4th Cir. 1997).¹¹ Evidently, the court was concerned that to hold otherwise might permit irresponsible libraries, acting in bad faith, to evade copyright responsibility by failing to maintain circulation records. Specifically underpinning the Fourth Circuit’s opinion in *Hotaling* is not only that the unauthorized copy of the work was purloined, but also that the library maintained no record of who had had access to that copy.

Hotaling has been criticized, *see* NIMMER ON COPYRIGHT, § 8.13[A], at 8-184 - 8-185 (noting that the *dissent* in *Hotaling* “disagreed that such conduct fit the statutory definition of distribution”) (Exhibit I to Appendix), and reconsideration of the decision may well be in order. In any event, however, the logic of *Hotaling* is doubly inapplicable to the issue before this court. First, the Fourth Circuit considered what constituted adequate *proof* of infringement on the basis of a developed summary judgment record, not whether a party submission that failed even to *allege* violation of the distribution right was legally sufficient. Second, the highly specialized factual context in which *Hotaling* arose is distinct and distinguishable from the one at hand. There is no reason why general principles relating to the infringement of the distribution right

violate plaintiffs' distribution rights. Napster users who download files containing copyrighted music violate plaintiffs' reproduction rights.”).

¹¹ The limited nature of *Hotaling* is supported by the fact that no other court that has had occasion to address facts similar to those at issue here, has followed *Hotaling*.

should not apply here. In particular, there is no concern that John Doe engaged in manipulating records of his activities so as to conceal actual file-sharing transactions, nor is such manipulation possible in the context of peer-to-peer file sharing. The on-line activities of participants in file-sharing leaves traces which the RIAA has elsewhere claimed to be able to track with accuracy. *See Declaration of Jonathan Whitehead in Support of Motion to Enforce a Subpoena Issued to Verizon Internet Services, Inc. Pursuant to 17 U.S.C. § 512(h), filed on Aug. 6, 2003 in RIAA v. Verizon Internet Services, No. 03-804 (HHK/JMF), at 6 – 7 (Exhibit J to Appendix).*

Because, the application fails even to identify any prohibited conduct,¹² the request for a subpoena should now be quashed. To do otherwise would be to deny John Doe of even the very modest level of procedural protection that Section 512(h) confers upon him.

¹² Likewise, an allegation of an “offer[] for download” does not aver infringement by reproduction or any other rights under Section 106.

CONCLUSION

For the foregoing reasons, this Court should grant Mr. Doe's motion to quash the Section 512(h) subpoena RIAA served on UNC seeking to obtain his identity.

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Dated: November 25, 2003

CERTIFICATE OF SERVICE

I certify that I have served the foregoing **BRIEF OF AMICI PARTIES IN SUPPORT OF JOHN DOE’S MOTION TO QUASH THE SUBPOENA ISSUED BY RIAA TO UNC** on the 25th of November, 2003, in the manner and upon the persons indicated below.

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