

APPEAL NO. 03-55894 AND 03-55901

IN THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

METRO-GOLDWYN-MAYER STUDIOS, INC., et al.,
Appellants,

v.

GROKSTER, LTD., et al.
Appellees.

JERRY LEIBER, et al.,
Appellants,

v.

MUSICCITY.COM, INC., et al.
Appellees.

On Appeal from UNITED STATES DISTRICT COURT, CENTRAL
DISTRICT OF CALIFORNIA, METRO-GOLDWYN-MAYER STUDIOS
INC., et al. v. GROKSTER, LTD., et al., Case No. 01-08541 SVW (PJWx)
(Consolidated with CV 01-09923 SVW (PJWx))
HONORABLE STEPHEN V. WILSON

**BRIEF AMICI CURIAE OF 40 INTELLECTUAL PROPERTY AND
TECHNOLOGY LAW PROFESSORS SUPPORTING AFFIRMANCE**

SAMUELSON LAW, TECHNOLOGY
AND PUBLIC POLICY CLINIC
UNIVERSITY OF CALIFORNIA AT BERKELEY
SCHOOL OF LAW (BOALT HALL)
JENNIFER M. URBAN (209845)
DEIRDRE K. MULLIGAN (218804)
396 Simon Hall
Berkeley, CA 94720-7200
Telephone: (510) 642-0499
Facsimile: (510) 643-4625
Counsel for Amici Curiae

On the Brief:
Pamela Samuelson
Chancellor's Professor of Law
University of California at Berkeley
School of Law (Boalt Hall)

Laura Quilter
Samuelson Law, Technology and
Public Policy Clinic

Intellectual Property Law Professors

I. Statement of Interest

Amici, listed in Appendix A, are forty (40) full-time tenured or tenure-track faculty members who research, teach and write scholarly articles and books about intellectual property and technology law. None has received any compensation for participating in this brief. Our sole interest in this case is in the evolution of sound and balanced legal rules for copyright law. We are gravely concerned that the rule promulgated by the Supreme Court in *Sony Corp. v. Universal Studios* will be undermined if Plaintiffs' alternative interpretations of *Sony* are accepted. We believe that this brief will assist the Court in its consideration of the legal standards advanced in this case. We file this brief with the consent of all parties.

II. Summary of Discussion

Amici express no views about the application of *Sony* to the facts of this case, but we respectfully urge this Court to reject Plaintiffs'¹ attempts to rewrite the standard set by the Supreme Court in *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984), which shields those who develop technologies that have or are capable of substantial noninfringing uses from secondary liability for copyright infringement. The *Sony* rule provides a sound, clear, and objective standard upon which copyright owners and technology developers, alike, can rely. The alternative standards for which Plaintiffs and their amici argue are inconsistent with the *Sony* rule. Each alternative would fundamentally change the balance that the Supreme Court crafted in *Sony*, create uncertainty and ambiguity in the law,

¹ For the Court's convenience and clarity, we refer throughout this brief to Plaintiff-Appellant copyright owners as "Plaintiffs."

and likely have a chilling effect on technology development and public access to new technologies. Additionally, this Court is not the appropriate forum in which to change the *Sony* rule. The Supreme Court in *Sony* directed courts to leave to Congress decisions extending secondary copyright liability. Congress may choose to regulate peer-to-peer technologies, or it may not, but it alone has the institutional competence necessary for a broad inquiry into the benefits and detriments of these technologies. We believe that the District Court’s conclusions of law should be affirmed.

III. Legal Discussion

A. The Supreme Court’s Ruling in *Sony* Is Sound Law and Policy.

It has been nearly twenty years since the Supreme Court issued its landmark ruling in *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984), holding that copyright owners have no legal right to stop the manufacture and distribution of technologies that have or are capable of substantial noninfringing uses. *Id.* at 442. The Court so ruled even though Sony knew that consumers were widely using VTR’s to arguably infringe copyrighted works; for example, by creating “libraries” of movies taped from television. *Id.* at 423-24. The Court was convinced that copyright liability should not extend so far without guidance from Congress. *Id.* at 431-32, 456; *see also infra* Sec. III.A.

The secondary liability rule announced in *Sony* has been followed in subsequent decisions.² *See, e.g., A&M Records, Inc. v. Napster, Inc.*, 239 F.3d

² Amici agree with Judge Posner that the Supreme Court used contributory infringement and vicarious liability interchangeably in *Sony* and hence, that the *Sony* rule should be understood to apply to both forms of secondary liability. *See*

1004, 1020-21 (9th Cir. 2001); *Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc.*, 964 F.2d 965, 971 (9th Cir. 1992); *Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255, 262 (5th Cir. 1988). Until the Supreme Court or Congress overturns the *Sony* rule that immunizes the manufacture and distribution of technologies with substantial noninfringing uses, we believe the courts should follow it. For reasons discussed below, we believe that the *Sony* rule is not only the law of the land,³ but

In re Aimster Litigation, 334 F.3d 643, 654 (7th Cir. 2003). Not only did the *Sony* District Court separately analyze contributory infringement and vicarious liability issues, *Universal City Studios, Inc. v. Sony Corp. of America*, 480 F. Supp. 429, 459-62 (C.D. Cal. 1979), but the Court was well aware that both theories were propounded, and discussed them both under the rubric of “liab[ility] for infringement committed by another.” *Sony*, 464 U.S. at 434-35. Nor did Congress distinguish between these forms of secondary liability when creating safe harbors for online service providers. See 17 U.S.C. §§ 512(a)-(d) (the only provisions in U.S. copyright law setting forth standards for secondary liability). We are aware that the Ninth Circuit in *Napster* concluded that the *Sony* rule did not apply to vicarious liability. *Napster*, 239 F.3d at 1022. However, we find this conclusion unsupported. The Nimmer treatise cited in *Napster* does not, in fact, endorse this limit on *Sony*, and although the PLI/Pat tutorial cited does, it lacks independent authority because the only citation was to the appended *Napster* plaintiffs’ brief. See *id.* at 1022-23 (citing David Nimmer, *Nimmer on Copyright* §§ 12.04[A][2] & [A][2][b] (2000) and Anne Haring, “Copyright Infringement Issues on the Internet,” 617 *PLI/Pat* 455, 528 (Sept. 2, 2000)).

³ Contrary to contentions in the International Rights Owners (“IRO”) Brief, the *Sony* rule comports fully with the United States’ international treaty obligations. Neither the Berne Convention for the Protection of Literary and Artistic Works, the Agreement on Trade-Related Aspects of Intellectual Property Rights, nor the WIPO Copyright Treaty contains any provision requiring countries to adopt secondary liability rules in their copyright laws. Nor, as the IRO amici admit, is there anything even approaching a uniform consensus among signatory countries that secondary liability should apply to suppliers of multi-use goods and technologies used to infringe. Indeed, the laws of the United Kingdom, Germany, and the Netherlands, among other countries, appear to be consistent with the *Sony* rule: they do not impose secondary liability on suppliers of multi-use goods absent the supplier’s actual knowledge of a specific infringement at the time when the supplier could take action to prevent it. See 1 K. Garnett et al., *Copinger & Skone James on Copyright* 469-72, 486 (14th ed. 1999) (U.K.); Paul Goldstein, *International Copyright* 272 (2001) (Germany); *Kazaa v. Buma/Stemra*, No.

sound policy as well.

1. The Court in *Sony* Used Appropriate Caution in Deciding that Copyright Owners Should Not Have Control over Technologies with Substantial Noninfringing Uses.

In *Sony*, Universal and Disney claimed that under existing caselaw, “supplying the ‘means’ to accomplish an infringing activity and encouraging that activity through advertisement” sufficed to establish secondary liability for the direct copyright infringement of another. *Sony*, 464 U.S. at 436.⁴ The Court characterized this as an “unprecedented attempt to impose copyright liability upon the distributors of copying equipment.” *Id.* at 420-21.

Finding no precedent in copyright law to support the imposition of secondary liability on a technology provider under this or any other theory, the Court turned for guidance to patent law, where Congress *had* articulated a secondary liability standard. *Id.* at 439-40. Section 271(c) of U.S. patent law immunizes makers of multiple use technologies (so-called “staple articles of commerce”) from secondary liability for patent infringement. Only technologies “especially made or adapted for use in an infringement of [a] patent” which are not “suitable for substantial noninfringing use” can be challenged under this provision. 35 U.S.C. § 271(c). This rule ensures that patentees cannot leverage their patent monopolies to obtain undue market advantage in unpatented goods. “[A] sale of

1370/01 (Amsterdam Ct. of Appeal, 28 Mar. 2002) (Netherlands).

⁴ Universal relied on *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911) to support its “supplying means” theory. The Court stated that the plaintiffs’ theory “rested on a gross generalization that cannot withstand scrutiny . . . *Kalem* does not support respondents’ novel theory of liability.” *Sony*, 464 U.S. at 436-437. The Boorstyn amici’s reliance on *Kalem* is therefore incorrect. *See* Boorstyn et al. Br. at 17-18.

an article which though adapted to an infringing use is also adapted to other and lawful uses, is not enough to make the seller a contributory infringer. Such a rule would block the wheels of commerce.” *Sony*, 464 U.S. at 441 (citations omitted). If the sale of technologies suitable for substantial noninfringing uses is lawful under patent law, then sale of copying equipment “capable of substantial noninfringing uses,” *id.* at 442, should, the Court decided, also be lawful under copyright law, particularly in view of the statutory silence on secondary liability standards for copyright infringement.⁵ A leading copyright treatise author offers another policy reason for limiting secondary copyright liability: “By giving copyright owners part of the value of the innovations in equipment and material, contributory liability may reduce producers' incentives to invest in these innovations.” 2 Paul Goldstein, *Copyright* § 6.1.2 (2d ed. 2002).

The Court concluded that contributory infringement should not lie if the product is “merely...capable of substantial noninfringing uses,” and then addressed “whether the Betamax is capable of commercially significant noninfringing uses.”⁶

⁵ Since *Sony*, Congress *has* spoken on secondary liability standards in the Digital Millennium Copyright Act. See 17 U.S.C. § 512. That section provides a safe harbor against secondary liability for online service providers for user infringement, but it expressly does not affect other defenses to secondary liability, such as the existing *Sony* standard. *Id.* § 512(l).

⁶ Plaintiffs erroneously assert that substantial noninfringing uses must be commercial uses. MGM Br. at 41. While *Sony* refers to both “substantial noninfringing uses” and “commercially significant noninfringing uses,” it expressly held that “private, *noncommercial* time-shifting” was a “commercially significant” use. *Sony*, 464 U.S. at 442 (emphasis added). Thus, “commercially significant” means only that a significant number of consumers might wish to obtain the product for its noninfringing uses.

Sony, 464 U.S. at 442. Resolving that question did not require “explor[ing] *all* the different potential uses of the machine and determin[ing] whether or not they would constitute infringement ... [because] one potential use of the Betamax plainly satisfie[d] this standard....” *Id.* at 442 (emphasis in original).

Although we agree with the Boorstyn et al. amici that secondary liability rules contribute to efficient control of infringement, Boorstyn Br. at 5-13, their brief focuses on only one side of the equation. *Sony* teaches that the interests of copyright holders must be balanced with those of technology innovators and the public. *Sony*, 464 U.S. at 442. As the Court observed, “[w]hen a charge of contributory infringement is predicated entirely on the sale of an article of commerce that is used by the purchaser to infringe a patent, the public interest in access to that article of commerce is necessarily implicated.” *Id.* at 440. Giving rights holders “effective control over the sale” of a technology should be done only where doing so does not extend the rights holder’s control “beyond the limits of his specific grant.” *Id.* at 441.

2. *Sony*’s “Mere Capability” Rule Is Sound Law and Policy.

The *Sony* test for the capability for substantial noninfringing uses of a technology is sound from both legal and policy perspectives. First, it is consistent with the contributory infringement rule of patent law, which exempts from liability technologies “suitable for substantial noninfringing uses.” 35 U.S.C. § 271(c). As Professor Goldstein has explained:

Congress passed section 271(c) for the specific purpose of clarifying the long-troubled boundary between actions for contributory infringement and patent misuse. By drawing the line at the sale of a “staple article or

commodity of commerce, ” section 271(c) validated prior case law—the decision, for example, that the sale of dry ice for use in a patented refrigerator would not constitute contributory infringement, and that the patent owner's attempt to tie authorized use of the refrigerator to purchases of dry ice would therefore constitute patent misuse.

Goldstein, *supra*, § 6.1.2. The *Sony* rule similarly clarifies the boundary between contributory infringement and the evolving doctrine of copyright misuse, which limits the power of copyright owners to obtain an unjustified monopoly over technologies. *See, e.g., Alcatel U.S.A., Inc. v. DGI Techs., Inc.*, 166 F.3d 772, 793 (5th Cir. 1999); *DSC Communications Corp. v. DGI Techs.*, 81 F.3d 597, 601 (5th Cir. 1996).⁷ The Copyright Act does not grant exclusive rights to copyright owners to control the manufacture and distribution of reprography technologies. *See Sony*, 464 U.S. at 440-41, 441, n.21.

Second, a capability rule accommodates the fact that uses of a technology may evolve significantly over time.⁸ A common use of video tape recorders (VTR's) today is to watch prerecorded videocassettes, a market that didn't exist

⁷ The competition- and innovation-promoting principles of *Sony* have also been important in resolving other disputes between technology developers and copyright owners. *See, e.g., Sony Computer Entertainment, Inc. v. Connectix Corp.*, 203 F.3d 596, 603 (9th Cir. 2000); *Recording Industry Ass'n of Am. v. Diamond Multimedia Systems, Inc.*, 180 F.3d 1072, 1074-75 (9th Cir. 1999); *Sega Enterp. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1523 (9th Cir. 1992); *Computer Associates Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 696 (2d Cir. 1992).

⁸ We agree with Judge Posner that unlikely hypothetical uses should not be given much weight, *Aimster*, 334 F.3d at 653, but the capability of technologies is an objective and useful criterion for determining which technologies should be free of copyright owner control. We agree with this Court that future potential uses, as well as existing uses, should be taken into account. *Napster*, 239 F.3d at 1021; *Sony*, 464 U.S. at 442.

when VTR's were introduced. Legal challenges may well be brought before users have had a chance to experiment with the technologies and decide on optimal uses. Peer-to-peer technologies, which promise numerous benefits, e.g., relieving network congestion and increasing security and fault tolerance, are still in early development. Uses of these technologies will not evolve over time if progress in this field is stymied by expansive secondary liability.

3. *Sony* Provides a Simple, Clear, Predictable, and Objective Rule that Fosters Investment and Innovation.

Among the important virtues of the *Sony* rule for technologies are its simplicity, clarity, predictability, and objectivity. It does not require delving into technology developers' states of mind; it does not require extensive evidence or speculation about current and future uses of technologies and in what proportion each use exists or is likely to evolve; and it does not require courts to consider what other kinds of technologies might have been developed instead. *Sony* simply asks courts to determine whether the technology has or is capable of substantial noninfringing uses.

Without such a bright line rule, innovators would be wary of developing transformative new technologies because copyright owners might perceive them as disruptive to current business models. Under the *Sony* rule, both technology developers and potential funders can readily determine whether such a potentially disruptive technology is capable of substantial noninfringing uses, and invest accordingly. Should a dispute arise, the bright line *Sony* rule lends itself to speedy adjudication through motions for summary judgment, thereby averting the risk and expense of lengthy trials that would drain innovators' resources and deter

investments in innovative technologies.

The *Sony* rule also ensures that copyright industries cannot control the evolution or entry into the market of new technologies. We note that, interestingly, leaving technology development in the hands of technology developers can benefit copyright owners as well as the public. As the aftermath of *Sony* demonstrates, limiting secondary liability can spur complementary market building. Not only were Sony and its competitors free to compete and innovate, offering improved products at lower costs, but a large installed base of VTR's gave rise to the home video market—greatly enriching the motion picture industry. See James Lardner, *Fast Forward* 297-300 (1987).

Sony's clear, objective, predictable bright line rule has endured for nearly twenty years. It balances the interests of copyright holders and technologists, and has come to be relied upon by technology developers as a clear “rule of the road” that establishes limits to contributory liability and creates a defined space within which to innovate and create.

B. Plaintiffs Are in Essence Asking This Court to Overturn *Sony*.

Plaintiffs propose several new standards for secondary liability for copyright infringement. Each is inconsistent with *Sony* and would, in effect, overturn the principal rule in that case—in fact, under each of Plaintiffs' proposed new rules, Sony itself would have been held liable.

Much as we empathize with Plaintiffs' difficulties with widespread unauthorized copying of their works via global digital networks, and with other economic, social, cultural, and technological changes brought about by the

Internet, we cannot endorse their proposals to expand the scope of secondary liability for copyright infringement.

1. Plaintiffs' Proposed Knowledge of Infringement Standard Is Inconsistent with *Sony*.

Plaintiffs argue that a developer's knowledge that its technology will be widely used for infringement, coupled with its knowledge of user infringements after the fact constitutes actual and specific knowledge of infringement for purposes of contributory infringement liability, and that such knowledge disqualifies the defendants from raising a *Sony* defense. MGM Br. at 39-40. Plaintiffs and amici also argue that constructive knowledge of infringing uses suffices. MGM Br. at 25, 35; Boorstyn Br. at 13-15. These propositions are inconsistent with both *Sony* and the Ninth Circuit's ruling in *Napster*.

Years before Sony began commercially distributing Betamax machines, it was aware not only that the machines would be widely used to infringe, but also that copyright owners claimed that selling technologies such as the Betamax would constitute contributory copyright infringement. *See Fast Forward, supra*, at 20, 94, 104. Yet, Sony developed and marketed the Betamax, with advertisements that actively encouraged purchasers to tape their favorite shows and classic movies. *Sony*, 464 U.S. at 489-90. Sony may not have known exactly which movies purchasers were taping, or when the taping occurred, but it had general knowledge that its users were infringing copyrights. After Universal commenced its lawsuit, Sony attained more specific knowledge of the quantity and proportion of copying through discovery, but this more specific knowledge was after the fact, when Sony was in no position to prevent those infringements. Even ceasing to sell Betamax

machines would not stop user infringements with machines already sold. Yet, both Justice Blackmun in dissent and the Ninth Circuit stated that Sony's general knowledge of user infringement justified a finding of liability. *Id.* at 489 (dissenting opinion); *Universal City Studios, Inc. v. Sony Corp. of Am.*, 659 F.2d 963, 975 (9th Cir. 1981). "Surely," said Justice Blackmun, "Congress desired to prevent the sale of products that are used almost exclusively to infringe copyrights." *Sony*, 464 U.S. at 498-99 (dissenting opinion). However, the majority noted that where "Congress has not plainly marked our course, we must be circumspect in construing the scope of rights created by a legislative enactment which never contemplated such a calculus of interests." *Id.* at 431. Reading contributory liability "circumspectly," therefore, a *majority* of the Supreme Court characterized Sony's level of knowledge as at most "constructive knowledge" of user infringements, *id.* at 439, and decided that contributory infringement liability was unwarranted.

In the ordinary contributory infringement case (e.g., where a producer of a film materially and knowingly contributes to copyright infringement by the director of the film), courts must determine, first, that there is an underlying act of copyright infringement; second, that the person charged with contributory infringement materially contributed to that infringement; and third, that the alleged contributory infringer knew or had reason to know of that infringement. Willfully blinding oneself to another's infringement does not preclude a finding of the requisite knowledge in such cases.

In cases involving technology developers, however, *Sony* requires a more

complex inquiry. The first inquiry is the same: finding proof of underlying acts of infringements, such as infringing uses of the challenged technology. However, the next step is to inquire whether the technology has or is capable of substantial noninfringing uses. Merely hypothesizing implausible uses should not satisfy this standard, yet the inquiry “should not be confined to current uses,” but take into account “the system’s capabilities.” *Napster*, 439 F.3d at 1021. If a technology does not have and is not capable of substantial noninfringing uses, then a technology developer could perhaps be held liable for contributory copyright infringement based on constructive knowledge of user infringements to which it materially contributed.

If a technology has or is capable of substantial noninfringing uses, however, both *Sony* and *Napster*, properly construed, require first, that the technology’s developer have actual and specific knowledge of underlying acts of infringements to which it contributed, and second, that the developer must do something more than provide and advertise the technology used for infringement, to be considered a material contributor to user infringement.⁹

For example, Sony did not have the requisite knowledge, nor had it done anything but distribute and advertise Betamax machines that contributed to user infringements. In *Napster*, the Ninth Circuit similarly refused to “impute the requisite level of knowledge to Napster merely because peer-to-peer file sharing

⁹ Surely a five-year warranty plan for Betamax machines that included replacements for broken parts would not have materially contributed to user infringements, even though fewer infringements might have occurred if the machines remained broken.

technology may be used to infringe Plaintiffs' copyrights." *Napster*, 239 F.3d at 1021. However, it was persuaded that Napster had "actual knowledge of specific acts of infringement."¹⁰ *Id.* Napster also did more to contribute materially to user infringements than supply software used to share files: it provided a server and website containing centralized index, search, and directory functions and other support services. *Id.* at 1022-24.

We agree with Professor Goldstein that "[t]he substantial noninfringing use doctrine serves a purpose entirely separate from the knowledge requirement," Goldstein, Supplement, § 6.1.2, and that to the extent the Ninth Circuit "subordinat[ed]" the substantial noninfringing use requirement "to the knowledge requirement, the *Napster* court necessarily undermined the object of the doctrine: to ensure that consumers not be required to pay monopoly tribute for unpatented or otherwise unprotected goods or equipment." *Id.* Cf. *Aimster*, 334 F.3d at 649 (agreeing with Goldstein on this point); *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 259 F. Supp.2d 1029, 1035-38 (C.D. Cal. 2003) (analyzing capability of substantial noninfringing uses as part of knowledge of infringement). We respectfully urge the Court to separate the substantial noninfringing use inquiry from the knowledge inquiry in this and similar cases.

¹⁰ Plaintiffs suggest that the Ninth Circuit in *Napster* relied on recording industry notices to Napster about user infringements and a document by Napster co-founders about remaining ignorant of user identities to protect against infringement claims as establishing actual knowledge of infringement. MGM Br. at 27 (citing *Napster*, 239 F.3d at 1020 n.5). This note summarized the trial court's conclusions, and not the Ninth Circuit's.

2. Plaintiffs' Proposed Primary Use Rule Is Inconsistent with *Sony*.

Plaintiffs propose that technologies be deemed illegal if their “primary use” infringes copyright. MGM Br. at 42; Leiber Br. at 20-23. This rule is plainly inconsistent with the Supreme Court’s holding in *Sony*. The very decision that the *Sony* Court reversed had embraced a primary use standard. The Court of Appeals thought “Sony was chargeable with knowledge of the homeowner’s infringing activity because the reproduction of copyrighted materials was either ‘the most conspicuous use’ or ‘the major use’ of the Betamax product.” *Universal*, 659 F.2d at 975. While the *Sony* majority agreed that Sony had such constructive knowledge, 464 U.S. at 439, it nonetheless held that Sony was not liable for user conduct.

The dissent in *Sony* proposed a proportionality-based primary use standard; the majority of the Court rejected it. Justice Blackmun’s dissent advocated a remand instructing the District Court “to make findings on the percentage of legal versus illegal home-use recording.” *Id.* at 492-493 (Blackmun, J., dissenting). Justice Blackmun, like Plaintiffs here, regarded Sony’s permissive uses as unproven and other proposed uses as either hypothetical or minor (e.g., the 7.3% of Betamax users who recorded sports programs). *Id.* at 494 n.45 (Blackmun, J., dissenting). But according to the majority, holding up the development of a technology, and its potential noninfringing uses, based on users’ current usages, would “stop the wheels of commerce.” *Id.* at 428. The majority rejected testing whether “infringing uses outweigh noninfringing uses” or trying to predict “the future percentage of legal versus illegal home-use recording.” *Id.* at 444 (citing

Universal, 480 F.Supp. at 468). To do otherwise would contravene both *Sony*'s holding and a major policy underlying the decision: protecting the public's access to the *potential* of technologies.

The *Sony* rule also protects developers from being subjected to secondary liability based on consumer uses of the technology, rather than on what the developers themselves have done. To hold developers of multi-use technologies liable for their customers' infringing uses—even if those uses are the “primary use” at a particular moment in the technology's life cycle—would disserve the public interest in encouraging development of technologies with noninfringing uses.

3. Plaintiffs' Proposed Intentional Design Rule Is Inconsistent with *Sony*.

Sony intentionally designed the Betamax to allow consumers to make unauthorized copies of broadcast television programming. *Sony*, 464 U.S. at 490. Universal sought to stop distribution of the Betamax precisely because of the technology's design. *See id.* at 420. Yet, the Supreme Court ruled that Sony could sell VTR's free from copyright owner control. It would be plainly inconsistent with *Sony* for this Court to adopt, as Plaintiffs and their amici propose, MGM Br. at 28, Boorstyn Br. at 21, a rule that intentionally designing a technology to enable infringement constitutes secondary copyright infringement.

A key disadvantage of an intentional design standard is that it is far less amenable than the *Sony* rule to rapid dispute resolution. Inevitably, it presents factual issues for the court to weigh, precluding summary judgment. Determining the subjective states of mind of a technology's developers and funders may be

difficult, time-consuming, and ultimately inconclusive. Since developers often fail to anticipate the most significant uses of their technologies, their subjective intents, plans, or desires may be irrelevant to the actual uses. Moreover, an intentional design standard is prone to erosion. Copyright owners may focus on the infringing capabilities of a technology (say, CD burners) and then claim that, if the technology is being used for that purpose, it must have been designed for that purpose—no matter how much the developer denies it.

No court has abandoned the *Sony* rule for this subjective standard. The assertion that the court in *A&M Records, Inc. v. Abdallah*, 948 F. Supp. 1449 (C.D. Cal. 1996), “ruled that the protection of *Sony-Betamax* protection [sic] could not extend to products specifically manufactured for counterfeiting activity, even if such products have substantial noninfringing uses,” Boorstyn Br. at 21, is incorrect. While *Abdallah* did raise questions about whether specifically designed products could qualify as staple commodities under *Sony*, *Abdallah*’s liability rested on the fact that that he was directly involved in specific counterfeiting operations and that the time-loaded cassette tapes at issue had no substantial noninfringing uses. *Abdallah*, 948 F. Supp. at 1456-58.

4. Plaintiffs’ Proposed Alternative Design Rule Is Inconsistent with *Sony*.

Sony could have designed a technology with functionality different from its Betamax. Universal actually proposed alternate design features for video players, including selling a VTR without a tuner, *Sony*, 464 U.S. at 493 n.42, or including a feature disallowing the copying of specified broadcast programming. *Id.* at 494. The Court in *Sony*, however, discussed neither these nor other alternative designs,

but rather evaluated the technology that was before it. Because that technology had and was capable of substantial noninfringing uses, the Court ruled that Sony could continue to manufacture and distribute it free from copyright owner control. Thus, the alternative design rule that Plaintiffs urge the Court to adopt in this case, MGM Br. at 58-61, is inconsistent with *Sony*.

To the extent design considerations are taken into account at all under *Sony*, they are taken into account by the objective requirement that a product be capable of commercially significant noninfringing uses, that is, of noninfringing uses that create a market for the product. *Sony*, 464 U.S. at 442. Defendants bear the burden of demonstrating that their product could be used for commercially significant noninfringing uses. The *Sony* test does not ask whether an alternative design would have avoided the infringement, but rather whether the design before it is capable of meaningful noninfringing uses.

The Seventh Circuit's suggestion in dicta that liability should be imposed where a product is substantially used for infringing purposes and the product was not designed to eliminate or reduce such uses, unless the developer can show the alternative design would have been "disproportionately costly," is not consistent with *Sony*. See *Aimster*, 334 F.3d at 653. The Supreme Court pointedly did not inquire as to the costs (or benefits) of eliminating or reducing infringing uses once a developer had demonstrated that its product was capable of commercially significant noninfringing uses. See *Sony*, 464 U.S. at 442; *supra*, I.A.

There are several reasons why an alternative design test for assessing liability of technology providers to copyright owners would be unwise. First, it

would put courts in the position of becoming deeply mired in the fine details of technology development, and deciding by judicial fiat whether certain technologies can be built or not. A test that requires establishing that an alternative design was not feasible would be difficult to apply and is not susceptible to summary adjudication. It would require that courts consider whether developers could have developed or anticipated development by others of technologies that could be integrated into their own offerings to eliminate or reduce infringing uses. Courts would be required to determine whether such technologies were ready for commercial implementation, were cost-effective to implement, and whether any adverse technical effects they might impose on the product outweighed their benefits. We question whether federal judges should have to do this on a routine basis.

Second, technology mandates about product design should emanate, if at all, from Congress. Technology mandates by Congress are rare. We observe that in the most recent legislation to consider copyright-related technology mandates, the Digital Millennium Copyright Act, Congress affirmed that technology firms are not obliged to develop technologies to respond to technical measures copyright owners might use to protect their works. *See* 17 U.S.C. § 1201(c)(3).

Third, an alternative design rule would give copyright owners a right of control over the future of particular technologies, and likely inhibit progress in the affected fields. Under an alternative design standard, copyright owners would be inclined to hypothesize alternatives that would require much time, effort, and expense by litigants and courts to assess the technological feasibility and cost of

each alternative.

Fourth, such a standard raises questions of whether developers can be held liable if they had generalized knowledge that their design would enable infringement, even though their intent was to design the product for noninfringing purposes. For example, email and instant messaging applications are designed for a noninfringing purpose, sending and receiving electronic communications. Their designers cannot have been unaware that people would send some messages that contained infringing materials; in fact, they intentionally selected a design that enabled both infringing and noninfringing uses, because such a design best achieved the intended purpose. No email or instant message product developer has attempted to design its application to filter out infringing materials. Under Plaintiffs' proposed standard, the failure to do so could expose them to liability.

Neither federal judges nor copyright owners should be in charge of industrial design policy for the United States. Yet, that is what Plaintiffs' proposed alternative design rule would accomplish.

C. Congress Is the Appropriate Forum in Which to Argue for Changes to the *Sony* Rule.

Sections I and II have explained why we are convinced that technologies with substantial noninfringing uses are beyond copyright owner control under *Sony* and why, as a matter of law and sound policy, the Ninth Circuit should not erode that rule in this case. We understand why copyright owners have reservations about the *Sony* rule and are seeking to revise it in legal challenges to peer-to-peer technologies. However, we strongly agree with Judge Posner's response to the very same proposed revisions to the *Sony* rule in *Aimster*, namely, that they are

addressed to the wrong audience. *See Aimster*, 334 F.3d at 649. The appropriate audience for arguments for revisions to the *Sony* rule is the U.S. Congress. *See id. and Grokster*, 259 F. Supp.2d at 1046.

1. *Sony* Directs Courts to Defer to Congress Regarding the Regulation of Technologies that Have Substantial Noninfringing Uses.

The Supreme Court in *Sony* examined the history of copyright litigation and observed that “[t]he judiciary’s reluctance to expand the protections afforded by the copyright law without explicit legislative guidance is a recurring theme.” *Sony*, 464 U.S. at 431. The Court “search[ed] the Copyright Act in vain” to find any indication that Congress had intended “a flat prohibition against the sale of machines” that make private noncommercial copying possible. *Id.* at 456. A key reason the Court was willing to embrace the substantial noninfringing use test for contributory infringement when applying copyright law to new technologies was that Congress had expressly adopted a nearly identical test when addressing a kindred problem in patent law. *Id.* at 440. The Court recognized that “it may well be that Congress will take a fresh look at this new technology, just as it so often has examined other innovations in the past.” *Id.* When “major technological innovations alter the market for copyrighted materials,” *id.* at 431, Congress has the institutional competence to identify the affected stakeholders, gather facts about matters arguably calling for a policy response, assess the costs and benefits of various proposed solutions, and craft rules that balance competing interests. As the Court recognized in *Sony*, “it is not our job to apply laws that have not yet been written.” *Id.* at 440.

2. Congress Has Sometimes Chosen to Regulate Disruptive Technologies, So Deference to Congress Is a Reasonable Judicial Response.

Peer-to-peer software is far from the first disruptive technology to be perceived as threatening to copyright owners. It is also not the first technology to pose challenging questions about the application of existing copyright law. In the early 20th century, the sound recording industry got its start by manufacturing piano rolls of music, without permission from composers. In *White-Smith Music Pub. Co. v. Apollo Co.*, 209 U.S. 1 (1908), the Supreme Court rejected claims that unauthorized sound recordings infringed copyright, in part because Congress had not addressed this new technology issue. Shortly thereafter, Congress amended copyright law to give composers the right to control mechanical reproductions of their works. See 17 U.S.C. § 1(e) (now superseded). However, Congress significantly limited the scope of copyright owners' rights as to mechanical reproductions by imposing a compulsory license so that once a musical composition had been recorded, others could record the same song as long as they paid a statutory license fee to the copyright owners. See 17 U.S.C. § 115.

Cable television was another disruptive technology. This industry got its start by retransmitting programming obtained from broadcast television signals without authorization from copyright owners. Neither of the two legal challenges mounted against cable television providers by copyright owners in broadcast programming was successful. See *Fortnightly Corp. v. United Artists Television, Inc.*, 392 U.S. 390 (1968); *Columbia Broadcasting System, Inc. v. Teleprompter Corp.*, 415 U.S. 394 (1974). Congress eventually regulated the retransmission of

copyrighted programming by cable television systems, but as with the sound recordings, imposed a compulsory license on copyright owners. *See* 17 U.S.C. § 111.

Digital audio tape (DAT) recorders were also perceived as deeply threatening to copyright owners. Because DAT machines were capable of substantial noninfringing uses, a contributory copyright infringement lawsuit to challenge this technology was unlikely to succeed after *Sony*. However, the sound recording industry persuaded Congress that DAT machines should be regulated. *See* Audio Home Recording Act (AHRA), 17 U.S.C. §§ 1001-1010. In passing the AHRA, Congress engaged in the very balancing of complex interests that *Sony* recognized as Congress's province. In so doing, Congress respected the principles established by *Sony* by expressly permitting noncommercial copies of both DAT and analog recordings. *Id.* § 1008. To compensate copyright owners for unauthorized personal use copies of copyrighted recordings made with DAT machines, the AHRA imposed a compulsory license fee on the sale of DAT machines and tapes. *See id.* § 1004. Computer technology, which could also be used to reproduce copyrighted digital music, was entirely excluded from the scope of the Act. *See Diamond Multimedia*, 180 F.3d at 1076.

These examples demonstrate that, when necessary, Congress regulates technologies that threaten to undermine incentives to invest in the creation and dissemination of copyrighted works. If the balance between copyright owners and technology developers needs adjustment, Congress can adjust it.

3. Congress Is Aware of the Peer-to-Peer File Sharing Phenomenon.

Congress has been aware of the peer-to-peer file sharing phenomenon, including its implications for the recording industry, for some time. Congress has not only heard the copyright industry's complaints about file sharing and file sharing technologies (*see, e.g.*, Peer-to-Peer Piracy on University Campuses, Hearing Before the Subcommittee on Courts, the Internet, and Intellectual Property of the House Judiciary Committee, 108th Cong., 1st Sess., Feb. 26, 2003; Piracy of Intellectual Property on Peer-to-Peer Networks, Hearing Before the Subcommittee on Courts, the Internet, and Intellectual Property of the House Judiciary Committee, 107th Cong., 2d Sess., Sept. 26, 2002 ("Piracy, House Jud. Hrg., Sept. 26, 2002")), but also expressions of concern from performing artists and composers of music about inequities in recording industry royalties (*see* Piracy, House Jud. Hrg., Sept. 26, 2002; Music on the Internet, Hearing Before the Subcommittee on Courts, the Internet, and Intellectual Property of the House Judiciary Committee, 107th Cong., 1st Sess., May 17, 2001; from new entrants to the digital music business about the difficulty of licensing content from the major labels (*see* Online Entertainment: Coming Soon to a Digital Device Near You, Hearing Before the Senate Judiciary Committee, 107th Cong., 1st Sess., Apr. 3, 2001 ("Online Entertainment, Sen. Jud. Hrg., Apr. 3, 2001")); *see also* Piracy, House Jud. Hrg., Sept. 26, 2002); from public interest advocates about excessive pricing of CDs and the recording industry's tardiness in rolling out electronic delivery musical services for consumers (*see* Online Entertainment, Sen. Jud. Hrg., Apr. 3, 2001) and from technology developers about many socially beneficial uses of peer-to-peer

technologies (*see* Piracy, House Jud. Hrg., Sept. 26, 2002). Through such hearings, Congress can see that no simple “quick fix” is available to resolve the challenges that the Internet in general, and peer-to-peer file sharing technologies in particular, have posed.

Congressional concern about personal use copying of music is not new. In the late 1980’s, Congress asked its Office of Technology Assessment (OTA) to report on policy options regarding personal use copying. OTA’s 1988 survey showed that 4 out of 10 Americans over the age of ten had copied music in the previous year, that “Americans tape-record individual musical pieces over one billion times per year,” and that “the public—those who had taped and those who had not—believe that it is acceptable to copy recorded music for one’s own use or to give it to a friend as long as the copies are not sold.” U.S. Congress, Office of Technology Assessment, *Copyright and Home Copying: Technology Challenges the Law* 3 (Oct. 1989). In 1992, moreover, Congress granted some immunity to those who made noncommercial copies of music as part of the AHRA. *See* 17 U.S.C. § 1008; *see also* *Diamond Multimedia*, 180 F.3d at 1079 (opining that space-shifting of music is “paradigmatic” fair use). In short, members of the public may be confused about how much personal use copying is acceptable. Congress is aware of this situation, and has the institutional competence to address it.

Given the tens of millions of people who file share, the economic efficiencies of peer-to-peer distribution, and imperfections in the market for digital music, it is not surprising that some commentators have proposed compulsory

licensing regimes to enable peer-to-peer file sharing to continue while compensating copyright owners. See, e.g., William Fisher, *Chapter 6, "An Alternative Compensation System," Promises to Keep: Technology, Law and the Future of Entertainment* (forthcoming 2004 Stanford University Press), chapter at <http://www.tfisher.org/>; Neil Weinstock Netanel, *Impose a Noncommercial Use Levy to Allow Free Peer-to-Peer File Sharing*, 17 *Harvard J. Law & Tech.* (forthcoming 2003), available at http://www.utexas.edu/law/faculty/nnetanel/Levies_chapter.pdf.¹¹ Congress has the institutional competence to explore the pros and cons of these and other proposals for responding to the peer-to-peer file sharing phenomenon, just as it did when adopting compulsory license regimes in response to disruptive technologies in the past.

Crafting the best policy response to peer-to-peer file sharing, whether by revising the *Sony* rule, creating a compulsory license, or providing another solution, is a job for Congress, not the courts.

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¹¹ One of the Boorstyn amici similarly proposed copyright immunity for individual file sharing and a compensation scheme to allow firms such as Grokster to continue to operate. See Douglas Lichtman, *KaZaa and Punishment*, *Wall St. J.*, Sept. 10, 2003, A24. Both rules are more appropriately the domain of Congress than of the courts.

IV. Conclusion

For the foregoing reasons, amici respectfully submit that the District Court used the correct legal standard in its analysis.

Respectfully submitted,

Dated: September 26, 2003

Jennifer M. Urban (#209845)
Samuelson Law, Technology
and Public Policy Clinic
University of California at Berkeley
School of Law (Boalt Hall)
396 Simon Hall
Berkeley, CA 94720-7200
Telephone: (510) 643-4800
Facsimile: (510) 643-4625
*Counsel for Amici Curiae Intellectual
Property Law Professors*

APPENDIX A

AMICI CURIAE

Amici file this brief in their individual capacities, and not as representatives of the institutions with which they are affiliated.

1. Keith Aoki
Professor of Law
University of Oregon School of Law
2. Margreth Barrett
Professor of Law
Hastings College of Law
3. Ann Bartow
Assistant Professor of Law
University of South Carolina School of Law
4. Yochai Benkler
Professor of Law
Yale Law School
5. James Boyle
William Neal Reynolds Professor of Law and Faculty Co-Director of
the Center for the Study of the Public Domain
Duke University School of Law
6. Dan L. Burk
Oppenheimer, Wolff & Donnelly Professor of Law
University of Minnesota Law School
7. Julie E. Cohen
Professor of Law
Georgetown University Law Center
8. Susan P. Crawford
Assistant Professor of Law
Benjamin N. Cardozo School of Law
Yeshiva University
9. Christine Haight Farley
Associate Professor of Law
Washington College of Law
American University

10. William W. Fisher III
Professor of Law and
Director of the Berkman Center for Internet and Society
Harvard Law School
11. Brett M. Frischmann
Assistant Professor of Law
Loyola University of Chicago
School of Law
12. Laura N. Gasaway
Director of the Law Library and Professor of Law
University of North Carolina at Chapel Hill School of Law
13. Shubha Ghosh
Professor of Law
University at Buffalo Law School
State University of New York
14. Llewellyn Joseph Gibbons
Associate Professor
College of Law
University of Toledo
15. Eric Goldman
Assistant Professor of Law
Marquette University Law School
16. Peter Jaszi
Professor of Law
Washington College of Law
American University
17. Dennis S. Karjala
Jack E. Brown Professor of Law
Arizona State University
18. Leslie A. Kurtz
Professor of Law
University of California, Davis
19. David Lange
Professor of Law
Duke University School of Law

20. Edward Lee
Assistant Professor of Law
Moritz College of Law
Ohio State University
21. Jessica Litman
Professor of Law
Wayne State University
22. Joseph P. Liu
Assistant Professor
Boston College Law School
23. Glynn S. Lunney, Jr.
Professor of Law
Tulane University School of Law
24. Michael J. Madison
Assistant Professor of Law
University of Pittsburgh School of Law
25. Peter W. Martin
Jane M. G. Foster Professor of Law
Cornell University
26. Charles R. McManis
Thomas & Karole Green Professor of Law
Washington University in St. Louis
27. Joseph Scott Miller
Assistant Professor
Lewis & Clark Law School
28. Neil Weinstock Netanel
Arnold, White & Durkee Centennial Professor of Law
University of Texas School of Law
29. Tyler T. Ochoa
Professor of Law
Santa Clara University School of Law
30. L. Ray Patterson
Pope Brock Professor of Law
University of Georgia

31. David G. Post
Professor of Law
Beasley School of Law
Temple University
32. Margaret Jane Radin
William Benjamin Scott & Luna M. Scott Professor of Law
Director, Program in Law, Science & Technology
Stanford University
33. R. Anthony Reese
Thomas W. Gregory Professor
School of Law
The University of Texas at Austin
34. Pamela Samuelson
Chancellor's Professor of Law
University of California, Berkeley
35. Sharon K. Sandeen
Associate Professor of Law
Hamline University School of Law
36. Niels B. Schaumann
Professor of Law
William Mitchell College of Law
37. David Welkowitz
Professor of Law and Co-Director
Center for Intellectual Property Law
Whittier Law School
38. Alfred C. Yen
Professor of Law
Boston College Law School
39. Peter K. Yu
Assistant Professor of Law & Director, Intellectual Property &
Communications Law Program
Adjunct Professor of Telecommunication, Information Studies and Media
Michigan State University - DCL College of Law
40. Diane Leenheer Zimmerman
Samuel Tilden Professor of Law
New York University School of Law

PROOF OF SERVICE

I am employed in the City and County of San Francisco, State of California in the office of a member of the bar of this court at whose direction the following service was made. I am over the age of eighteen years and not a party to the within action. My business address is Kecker & Van Nest, LLP, 710 Sansome Street, San Francisco, California 94111.

On September 26, 2003, I served the following document(s):

BRIEF AMICI CURIAE OF 40 INTELLECTUAL PROPERTY AND TECHNOLOGY LAW PROFESSORS SUPPORTING AFFIRMANCE

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Russell J. Frackman
George M. Borkowski
Mitchell Silberberg & Knupp LLP

David E. Kendall
Robert J. Shaughnessy
Williams & Connolly LLP

11377 West Olympic Boulevard
Los Angeles, CA 90064
Telephone: 310/312-2000
Facsimile: 310/312-3100
*Attorneys for the Record Company
Plaintiffs/Appellants (Other than the Time
Warner record company Plaintiffs-Appellants)*

725 Twelfth Street, N.W.
Washington, DC 20005
Telephone: 202/434-5000
Facsimile: 202/434-5029
*Attorneys for the Motion Picture Studio
Plaintiffs/Appellants (Other than the Time
Warner Studio Plaintiffs-Appellants)*

Robert M. Schwartz
O'Melveny & Myers, LLP
1999 Avenue of the Stars, Suite 700
Los Angeles, CA 90067-6035
Telephone: 310/553-6700
Facsimile: 310/246-6779
*Attorneys for the Time Warner
Plaintiffs/Appellants*

Steven B. Fabrizio
Jenner & Block, LLC
601 Thirteenth Street, NW, Suite 1200 South
Washington, DC 20005
Telephone: 202/639-6040
Facsimile: 202/661-4823
*Attorneys for the Record Company Plaintiffs-
Appellants (Other than the Time Warner
record company Plaintiffs- Appellants)*

Matthew J. Oppenheim
Dean Garfield
Recording Industry Association of America,
Inc.
1330 Connecticut Avenue, N.W., Suite 300
Washington, DC 20036
Telephone: 202/775-0101
Facsimile: 202/775-7253
*Attorneys for the Record Company Plaintiffs-
Appellants*

Gregory P. Goeckner
Mark D. Litvack
15503 Ventura Boulevard
Encino, CA 91436-3103
Telephone: 818/995-6600
Facsimile: 818/382-1797
*Attorneys for the Motion Picture Studio
Plaintiffs-Appellants*

Charles S. Baker
Munsch Hardt Koph & Harr, P.C.
600 Congress Avenue, Suite 2900
Austin, TX 78701
Telephone: 512/391-6115
Facsimile: 512/391-6149
*Attorneys for MusicCity.com, Inc. (now known
as StreamCast Networks, Inc.) and MusicCity
Networks, Inc.*

David B. Casselman
Wasserman Comden Casselman & Pearson
LLP
5567 Reseda Boulevard, Suite 330
Tarzana, CA 91357-7033
Telephone: 818/705-6800
Facsimile: 818/705-8147
*Attorneys for LEF Interactive Pty Ltd. and
Sharman Networks Ltd.*

Cindy A. Cohn
Electronic Frontier Foundation
454 Shotwell Street

Lawrence M. Hadley
Hennigan, Bennett & Dorman LLP
601 South Figueroa Street, Suite 3300

San Francisco, CA 94110
Telephone: 415/436-9333 x 123
Facsimile: 415/436-9993
*Attorneys for MusicCity.com, Inc. (now known
as StreamCast Networks, Inc.) and MusicCity
Networks, Inc.*

Los Angeles, CA 90017
Telephone: 213/694-1200
Facsimile: 213/694-1234
*Attorneys for LEF Interactive Pty Ltd. and
Sharman Networks Ltd.*

Jerry Leiber, et al. v. Grokster, Ltd., et al.

Carey R. Ramos
Paul, Weiss, Rifkind, Wharton & Garrison
1285 Avenue of the Americas
New York, NY 10019-6064
Telephone: 212/373-3000
Facsimile: 212/757-3990
Attorneys for Plaintiffs/Appellants

Kelli L. Sager
Davis Wright Tremaine LLP
865 S. Figueroa Street, Suite 2400
Los Angeles, CA 90017-2566
Telephone: 213/633-6800
Facsimile: 213/633-6899
Attorneys for Plaintiffs/Appellants

Executed on September 26, 2003, at San Francisco, California.

I declare under penalty of perjury under the laws of the United States of America that the above is true and correct and that I am employed in the office of a member of the bar of this Court at whose direction this service was made.

PATTY LEMOS

TABLE OF CONTENTS

	<u>Page</u>
I. Statement of Interest	1
II. Summary of Discussion	1
III. Legal Discussion	2
A. The Supreme Court’s Ruling in <i>Sony</i> Is Sound Law and Policy.	2
1. The Court in <i>Sony</i> Used Appropriate Caution in Deciding that Copyright Owners Should Not Have Control over Technologies with Substantial Noninfringing Uses.	4
2. <i>Sony</i> ’s “Mere Capability” Rule Is Sound Law and Policy.	6
3. <i>Sony</i> Provides a Simple, Clear, Predictable, and Objective Rule that Fosters Investment and Innovation.	8
B. Plaintiffs Are in Essence Asking This Court to Overturn <i>Sony</i>	9
1. Plaintiffs’ Proposed Knowledge of Infringement Standard Is Inconsistent with <i>Sony</i>	10
2. Plaintiffs’ Proposed Primary Use Rule Is Inconsistent with <i>Sony</i>	14
3. Plaintiffs’ Proposed Intentional Design Rule Is Inconsistent with <i>Sony</i>	15
4. Plaintiffs’ Proposed Alternative Design Rule Is Inconsistent with <i>Sony</i>	16
C. Congress Is the Appropriate Forum in Which to Argue for Changes to the <i>Sony</i> Rule.	19
1. <i>Sony</i> Directs Courts to Defer to Congress Regarding the Regulation of Technologies that Have Substantial Noninfringing Uses.	20
2. Congress Has Sometimes Chosen to Regulate Disruptive Technologies, So Deference to Congress Is a Reasonable Judicial Response.	21

TABLE OF CONTENTS
(cont'd)

	<u>Page</u>
3. Congress Is Aware of the Peer-to-Peer File Sharing Phenomenon.....	23
IV. Conclusion.....	26
APPENDIX A: AMICI CURIAE.....	27

TABLE OF AUTHORITIES

	<u>Page(s)</u>
Cases	
<i>A&M Records, Inc. v. Napster, Inc.</i> , 239 F.3d 1004, 1020-21 (9th Cir. 2001) passim	
<i>Abdallah</i> , 948 F. Supp. at 1456-58	16
<i>Alcatel U.S.A., Inc. v. DGI Technologies, Inc.</i> , 166 F.3d 772, 793 (5th Cir. 1999)..	7
<i>Columbia Broadcasting System, Inc. v. Teleprompter Corp.</i> , 415 U.S. 394 (1974)	21
<i>Computer Associates Int’l, Inc. v. Altai, Inc.</i> , 982 F.2d 693, 696 (2d Cir. 1992).....	7
<i>Diamond Multimedia</i> , 180 F.3d at 1076	22, 24
<i>DSC Communications Corp. v. DGI Technologies</i> , 81 F.3d 597, 601 (5th Cir. 1996).....	7
<i>Fortnightly Corp. v. United Artists Television, Inc.</i> , 392 U.S. 390 (1968)	21
<i>In re Aimster Litigation</i> , 334 F.3d 643, 654 (7th Cir. 2003)	passim
<i>Kalem Co. v. Harper Bros.</i> , 222 U.S. 55 (1911)	4
<i>Kazaa v. Buma/Stemra</i> , No. 1370/01 (Amsterdam Ct. of Appeal, 28 Mar. 2002) (Netherlands)	4
<i>Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc.</i> , 964 F.2d 965, 971 (9th Cir. 1992).....	3
<i>Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.</i> , 259 F. Supp.2d 1029, 1035- 38 (C.D. Cal. 2003)	13, 20
<i>Pub. Co. v. Apollo Co.</i> , 209 U.S. 1 (1908)	21
<i>Recording Industry Ass’n of Am. v. Diamond Multimedia Systems, Inc.</i> , 180 F.3d 1072, 1074-75 (9th Cir. 1999).....	7
<i>Sega Enterp. Ltd. v. Accolade, Inc.</i> , 977 F.2d 1510, 1523 (9th Cir. 1992)	7
<i>Sony Computer Entertainment, Inc. v. Connectix Corp.</i> , 203 F.3d 596, 603 (9th Cir. 2000).....	7
<i>Sony Corp. of America v. Universal City Studios, Inc.</i> , 464 U.S. 417 (1984). passim	
<i>Universal City Studios, Inc. v. Sony Corp. of Am.</i> , 659 F.2d 963, 975 (9th Cir. 1981).....	11, 14
<i>Universal City Studios, Inc. v. Sony Corp. of America</i> , 480 F. Supp. 429, 459-62 (C.D. Cal. 1979)	3, 15
<i>Vault Corp. v. Quaid Software Ltd.</i> , 847 F.2d 255, 262 (5th Cir. 1988).....	3

TABLE OF AUTHORITIES
(cont'd)

	<u>Page(s)</u>
<i>White-Smith Music Pub. Co. v. Apollo Co.</i> , 209 U.S. 1 (1908).....	21
Statutes	
17 U.S.C. § 1(e)	21
17 U.S.C. § 1008	24
17 U.S.C. § 111	22
17 U.S.C. § 115	21
17 U.S.C. § 1201(c)(3).....	18
17 U.S.C. §§ 1001-1010	22
17 U.S.C. §§ 512(a)-(d)	3, 5
35 U.S.C. § 271(c)	4, 6
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1 K. Garnett et al., <i>Copinger & Skone James on Copyright</i> 469-72, 486 (14th ed. 1999) (U.K.)	3
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David Nimmer, <i>Nimmer on Copyright</i> §§ 12.04[A][2] & [A][2][b] (2000)	3
Douglas Lichtman, <i>KaZaa and Punishment</i> , <i>Wall St. J.</i> , Sept. 10, 2003, A24	25
James Lardner, <i>Fast Forward</i> 297-300 (1987).....	9, 10
Neil Weinstock Netanel, <i>Impose a Noncommercial Use Levy to Allow Free Peer-to-Peer File Sharing</i> , 17 <i>Harvard J. Law & Tech.</i> (forthcoming 2003), available at http://www.utexas.edu/law/faculty/nnetanel/Levies_chapter.pdf	25
Online Entertainment, Sen. Jud. Hrg., Apr. 3, 2001	23
Online Entertainment: Coming Soon to a Digital Device Near You, Hearing Before the Senate Judiciary Committee, 107th Cong., 1st Sess., Apr. 3, 2001 (“Online Entertainment, Sen. Jud. Hrg., Apr. 3, 2001”)	23
P. Goldstein, <i>International Copyright</i> 272 (2001) (Germany)	3

TABLE OF AUTHORITIES
(cont'd)

	<u>Page(s)</u>
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Piracy, House Jud. Hrg., Sept. 26, 2002	23, 24
Piracy, House Jud. Hrg., Sept. 26, 2002; Music on the Internet, Hearing Before the Subcommittee on Courts, the Internet, and Intellectual Property of the House Judiciary Committee, 107th Cong., 1st Sess., May 17, 2001	23
U.S. Congress, Office of Technology Assessment, <i>Copyright and Home Copying: Technology Challenges the Law 3</i> (Oct. 1989)	24
William Fisher, <i>Chapter 6, “An Alternative Compensation System,” Promises to Keep: Technology, Law and the Future of Entertainment</i> (forthcoming 2004 Stanford University Press), chapter <i>at</i> http://www.tfisher.org/	25