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NOTES

GARAGE DOOR OPENERS AND TONER CARTRIDGES: WHY CONGRESS SHOULD REVISIT THE ANTI-CIRCUMVENTION PROVISIONS OF THE DMCA

HEATHER A. SAPP

Technology drives innovation, both in the marketplace and in the law. Copyright law, in particular, is driven by technological change, as each major overhaul of the Copyright Act has been the result of advances in technology disturbing the equilibrium between the rights of authors and the dissemination of expression to the general public. In fact, the latest major enactment of copyright law was driven by increased usage of the Internet and emerging digital media and the impact these new technologies would have on the ease of pirating creative works.

Congress passed the Digital Millennium Copyright Act (DMCA) to "ensure a thriving electronic marketplace for copyrighted works on the Internet." The centerpiece of this sweeping legislation is a prohibition on

1 The copyright law of the United States is contained in Title 17 of the United States Code, chapters 1 through 9 and 10 through 13. The Copyright Act of 1976, which provides the basic framework for the current copyright law, was enacted on October 19, 1976 and has been amended several times.


5 H.R. REP. No. 105-551, at 9 (1998). One commentator points out, however, that "although the legislative history refers repeatedly to the 'Internet,' it is noteworthy, for a law designated to confront head-on the emigration of works of authorship from their traditional domains to the new-fangled world of cyberspace, that the Digital Millennium Copyright Act
the circumvention of technological measures that control access to copyrighted works.\(^6\) However, the DMCA's language is not limited to situations involving the distribution of underlying copyrighted works with an independent economic significance through means of the Internet and digital media.\(^7\) As a result, the DMCA also applies in many situations not contemplated by its drafters.\(^8\) In particular, the plain meaning of statute's anti-circumvention provisions\(^9\) suggests that it is germane to situations other than digital piracy of creative works and may be used to extend copyright protection to functional applications traditionally protected by patent, such as the durable goods replacement part markets.\(^10\)

Part I of this paper discusses the rationale behind the DMCA, provides a history of its enactment, and analyzes some previous case law interpreting the anti-circumvention provisions in the context of digital piracy. Part II analyzes two cases that inconsistently apply the anti-circumvention provisions to functional applications of copyrighted software embedded in durable goods. Finally, Part III discusses the legislative intent behind the DMCA, examines the copyright misuse doctrine, and concludes that Congress should revisit the Act to stop courts from being forced to arrive at decisions that restrain competition in aftermarket for functional, durable goods.

I.

THE DIGITAL MILLENNIUM COPYRIGHT ACT

The DMCA, hailed by supporters and widely criticized by detractors, is the most significant development in copyright law of the past decade.\(^11\) Among its sweeping changes, the legislation added a new Chapter 12 to the Copyright Act. This new chapter, entitled “Copyright Protection and Management Systems,” makes it a violation, among other things, to circumvent copyright protection systems or to traffic in devices designed to

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\(^6\) 17 U.S.C. § 1201(a)(1)(A) (1998). These provisions, commonly referred to as the "anti-circumvention provisions," are also known as the "black box" provisions. See Nimmer, Sweet and Sour, supra note 5, at 915.


\(^10\) See generally Higgs, supra note 8.

\(^11\) See Nimmer, Sweet and Sour, supra note 5, at 912.
circumvent such systems.  

A. The DMCA’s anti-circumvention provisions

In 1996, in part due to the efforts of the collective lobbying juggernaut of the American and European content industry and the efforts of the U.S. and European governments at the World Intellectual Property Organization (WIPO), WIPO adopted, and the member-states ratified, two new internet treaties—the WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty. The treaties obligated member states to provide:

... adequate legal protection and effective legal remedies against the circumvention of effective technological measures that are used by authors in connection with the exercise of their rights...and that restrict acts, in respect of their works, which are not authorized by the authors concerned or permitted by law.

Generally, U.S. copyright laws already complied with the terms of the WIPO treaties’ obligations. However, some modifications were necessary to comply with the new standards. Although some scholars argue that U.S. law already provided adequate protection against digital piracy sufficient to meet the general norms of the WIPO treaties, copyright holders lobbied Congress for stronger language and greater protection.

In response to the treaties and the content industry’s desire for greater

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13 The phrases “content industry” or “content industries,” as discussed in this paper, are used to refer collectively to those who create, produce, manage, or distribute art, such as Hollywood, the recording industry, songwriters, performers, dancers, the television production industry, the publishing industry, novelists, sculptors, graphic artists, etc.
16 WIPO Copyright Treaty, art. 11; see also WIPO Performances and Phonograms Treaty, art. 18.
19 See Nimmer, Sweet and Sour, *supra* note 5, at 916; see also Higgs, *supra* note 8, at 62; Samuelson, *supra* note 18, at 533-34.
protection, Congress enacted the DMCA in 1998. Congress' stated rationale for passing the legislation was to "facilitate the robust development and world-wide expansion of electronic commerce, communications, research, development, and education in the digital age." The DMCA creates an unprecedented set of rights wholly separate from traditional copyright. The new anti-circumvention rights, referred to by some commentators as "paracopyright," "allow control of uncopyrighted materials, and confer upon content owners a new exclusive right to control not only access to technologically protected works, but also ancillary technologies related to content protection." Some commentators have argued that the provisions create a right of access, in which the alleged circumventor of a technological measure need not engage in any of the traditional acts of infringement to violate the anti-circumvention provisions. Whereas the constitutional basis for copyright states that it must exist only for a limited time, the DMCA's grant of paracopyright includes no such limitation. Among other things, the new Chapter 12 sanctions the right of copyright holders to employ technological measures to protect access to their copyrighted work. It is a violation of the legislation to break the access controls to gain entry to a copyrighted work. Further, it is also a violation to traffic in devices designed for the primary purpose of

22 See 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT 12A.18[b] (2003); see also Burk, supra note 2, at 1096.
23 H.R. REP. NO. 105-551, at 24 (July 1998) (quoting a letter endorsed by copyright law professors characterizing the anti-circumvention provisions as "paracopyright.").
24 Burk, supra note 2, at 1096.
26 The prohibition is tied to measures protecting works under copyright. Therefore, when the work comes into the public domain, the prohibition on circumventing the access controls would end. Nevertheless, the copyright holder is free to put technological protection measures (TPMs) on works for as long as they want. Although the general public is free to circumvent TPMs measures of public domain works, the reality is that the prohibitions on trafficking in devices used to circumvent TPMs make it practically impossible for most laypeople to be able to access public domain works that are protected by TPMs. Likewise, it is not difficult to imagine a scenario in which a copyright holder may combine a minute amount of new copyrighted material with a public domain work, thus creating a new work protected under copyright (and thus protected under §1201).
27 The DMCA does not define the term "access." When a term is undefined, it should be given its ordinary, customary meaning. See FDIC v. Meyer, 510 U.S. 471, 476 (1994). One court defined "access" as the "ability to enter, to obtain, or to make use of." Lexmark Int'l, Inc. v. Static Control Components, Inc., 253 F. Supp. 2d 943 (E.D.Ky. 2003) [hereinafter Lexmark I].
circumventing access control measures.\textsuperscript{29} Congress felt that the anti-circumvention measures would encourage copyright owners to make digital works more readily available online.\textsuperscript{30}

In order to address concerns that fair use might be adversely affected, Congress authorized the Librarian of Congress to create exemptions to the prohibition for certain classes of copyrighted works.\textsuperscript{31} The Copyright Office engages in a rulemaking every three years to determine whether any exemptions are warranted based on the evidence received in the rulemaking proceeding. The first such exemptions were promulgated on October 28, 2000, with the latest round on October 27, 2003, after an almost year-long comment period.

Whereas nowhere in the plain language of the statute does it state that § 1201 was intended to apply only to copyrighted works with an independent economic significance,\textsuperscript{32} the legislative history suggests that it was Congress' intention that the legislation be limited to the digital distribution of creative works such as movies and music.\textsuperscript{33}

\textbf{B. Cases Interpreting § 1201}

Most of the early cases interpreting the anti-circumvention provisions involved the content industries and traditional copyrighted works.\textsuperscript{34} As such, these cases were of the type to which the DMCA was intended to apply.

In \textit{Sony Computer Entertainment America, Inc. v. Gamemasters},\textsuperscript{35} the Northern District of California determined that Gamemaster's "Game Enhancer" product, which allowed PlayStation owners to bypass Sony's authentication procedure and play import game cartridges that were not licensed for the particular geographical region,\textsuperscript{36} circumvented a technological measure intended to control access to copyrighted works.\textsuperscript{37}

\footnotesize
\begin{itemize}
\item \textsuperscript{29} 17 U.S.C. §1201(a)(2) (1998). Obviously, the liability for trafficking cannot exist without a violation of §1201(a)(1).
\item \textsuperscript{30} S. REP. NO. 105-190, at 8.
\item \textsuperscript{32} Copyrighted works with an independence economic significance are creative works produced by members of the content industry. Unless they have reverse engineering aspirations, most consumers do not purchase garage door openers or toner cartridges for the purpose of accessing the underlying computer program itself.
\item \textsuperscript{33} See infra Part IIIA.
\item \textsuperscript{34} See Higgs, supra note 8 at 65 (noting that the only previous case not involving a content industry was PortionPac Chem. Corp. v. Sanitech Sys., Inc., 210 F. Supp. 2d 1302 (M.D.Fla. 2002), in which the court stated that "the DMCA was enacted...to preserve copyright enforcement in [sic] the Internet.").
\item \textsuperscript{35} 87 F. Supp. 2d 976 (N.D.Cal. 1999).
\item \textsuperscript{36} Id. at 987.
\item \textsuperscript{37} Id.
\end{itemize}
The court found that because the Game Enhancer seemed to have a primary purpose of circumventing access controls, it was likely that the plaintiff would prevail on its trafficking claim under § 1201(a)(2)(A).\(^{38}\)

In *RealNetworks, Inc. v. Streambox, Inc.*\(^{39}\) the plaintiff sought a preliminary injunction to stop Streambox from distributing and marketing products (the Streambox VCR, the Ripper, and the Ferret) which allowed consumers to stream specially encoded digital audio and video files from the Internet.\(^{40}\) RealNetworks alleged that the products violated the DMCA’s anti-circumvention provisions.\(^{41}\) Specifically, the software bypassed the authentication sequence required for accessing the files and allowed consumers to make unauthorized modifications of RealNetworks’ copyrighted software programs in order to access encoded RealAudio and RealVideo files.\(^{42}\) Streambox argued that its product allowed consumers to make fair use of works and non-infringing uses of works. The court found that the Streambox VCR was likely to be a violation of both the “access” and “copy” control anti-circumvention provisions (sections 1201(a)(2) and (b)), which prohibit developers from distributing products that circumvent technological measures that prevent consumers from obtaining unauthorized access to or making copies of copyrighted works.\(^{43}\) The court enjoined distribution of the Streambox VCR. However, the court found that the Ripper file conversion application has legitimate and commercially significant uses, making it unlikely for RealNetworks to succeed on its 1201(b)(1)(A) or (B) claims.\(^{44}\)

The next case focusing on the anti-circumvention provisions was *Universal City Studios, Inc. v. Corley,*\(^{45}\) in which a group of movie studios requested an injunction against the posting on the Internet of the DeCSS computer program, which circumvented the CSS encryption system that protects access to motion pictures on DVDs, allowing Linux OS users to play DVDs without an authorized device driver.\(^{46}\) The Second Circuit upheld the lower court’s injunction, finding that the distribution of DeCSS violated § 1201(a)(2)(A).\(^{47}\)

The first criminal case brought under the DMCA was *United States v.*

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\(^{38}\) Id. at 989-991.


\(^{40}\) Id. at *1.

\(^{41}\) Id.

\(^{42}\) Id. at *4.

\(^{43}\) Id. at *8.

\(^{44}\) Id. at *10.

\(^{45}\) 273 F.3d 429 (2d Cir. 2001).

\(^{46}\) Id. at 435-440.

\(^{47}\) Id. at 441.
Elcom, Ltd. Willful violations of the anti-circumvention provisions "for purposes of commercial advantage or private financial gain" give rise to criminal liability. In this case, the defendant sold software that eliminated restrictions on copying and distribution from digitally formatted "ebooks." The defendant was indicted by the grand jury on five counts, including "four counts alleging circumvention offenses and aiding and abetting circumvention offenses, under the DMCA, and a charge of conspiracy to traffic in a circumvention program." Although the government maintained that distribution of the software violated the ban on trafficking under § 1201(b), the jury acquitted the defendant.

These cases all dealt with access controls that protect "goods whose value lies in the copyrighted content they contain." Given that the DMCA was enacted to "make available via the Internet the movies, music, software, and literary works that are the fruit of American creative genius," these are the types of cases that Congress envisioned would be brought under the legislation. Even so, potential plaintiffs who hold a copyright in a software program embedded in a functional object may attempt to exploit the language of the DMCA to extend their monopoly.

II. EXPANDING THE SCOPE OF THE DMCA

Recently, durable goods manufacturers have attempted to extend the anti-circumvention provisions from the digital piracy solutions envisioned by Congress to grant a monopoly in the aftermarket parts industry. A pair

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48 203 F. Supp. 2d 1111 (N.D.Cal. 2002).
52 Elcom, 203 F. Supp. 2d at 1119.
53 See Electronic Frontier Foundation, supra note 51; see also Higgs, supra note 8, at 67.
54 Higgs, supra note 8, at 67.
56 The phrase "durable goods" refers to "products that 'yield at flow of services into the future' or that 'can be used over and over again.'" Higgs, supra note 8 at 67-8; accord Micheal S. Jacobs, Market Power Through Imperfect Information: The Staggering Implications of Eastman Kodak Co. v. Image Technical Services and a Modest Proposal for Limiting Them, 52 Md. L. Rev. 336, 364 (1993).
of cases resulted in conflicting decisions at the district court level after construction of the statute’s language, clarifying a need for Congress to intervene to avoid this problem. Specifically, in the case that denied extension of the DMCA to durable goods at both the district and appellate court levels, an amicus curiae argued that a finding in favor of the plaintiff would extend the DMCA and eventually put an end to the “aftermarket” remote controls industry, effectively stifling innovation and raising prices for consumers. While a different appellate court ultimately reversed one lower court’s finding of a DMCA violation, the fact that an injunction resulted in anti-competitive behavior for approximately 18 months demonstrates the court’s relative difficulty in interpreting an allegedly “clear” statute. Unless Congress revisits the anti-circumvention provisions, courts applying strict construction of the statute may be forced to extend application of the DMCA into areas unforeseen by the drafters of the Act, resulting in an anti-competitive environment hostile to consumers.

A. Chamberlain Group, Inc. v. Skylink Technologies, Inc.

1. Background

Chamberlain Group, Inc. (Chamberlain) is the largest manufacturer of garage door openers (GDOs) in the United States. Skylink Technologies, Inc. (Skylink) manufactures and distributes a universal remote transmitter (“universal remote”) capable of activating GDOs manufactured and sold by Chamberlain and other manufacturers, including Chamberlain’s Security+ opener. Chamberlain sued Skylink, alleging inter alia that Skylink’s distribution of the universal remote provided unauthorized access to its Security+ line in violation of § 1201(a)(2).

The Security+ GDO utilized a “rolling code” to engage the opener’s motor. Chamberlain alleged that the Security+ was more secure than standard GDOs because it utilized computer programs in both the remote

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61 Chamberlain I, 292 F. Supp. 2d at 1030.
62 Id. at 1031.
64 Chamberlain I, 292 F. Supp. 2d at 1026.
transmitter and the receiver. To sync with the program that engaged the GDO's motor, the program on the remote transmitter generated both a fixed identification number and a variable number. These numbers were compared with numbers generated by the receiving program. If the numbers generated by the transmitter fell within the acceptable range of values as determined by the receiving program, access to the program that engaged the motor was granted, otherwise, access was denied.

If a user were to inadvertently advance the rolling code past the upper range of acceptable values, a foolproof measure known as "resynchronization" would still allow the GDO to function properly. The user simply had to push the transmitter button twice and the receiver software would compare the two signals and operate the GDO if the variable values were separated by a factor of three. Skylink's universal transmitter took advantage of the resynchronization process to operate the Security+ GDOs.

In its DMCA action against Skylink, Chamberlain claimed that the "rolling code" was a technological measure that "effectively controls access to a work," and that Skylink's universal remote circumvents the access control mechanism. Chamberlain requested summary judgment based on its DMCA claims.

2. District Court

Because neither the Seventh Circuit nor any district court in the Seventh Circuit had ever considered 17 U.S.C. § 1201(a)(2), the District Court treated the matter as one of first impression and underwent a detailed analysis of Chamberlain's arguments and Skylink's defenses.

The District Court began by examining the purpose behind Skylink's universal remote. Skylink argued that it was not liable under § 1201(a)(2) because the remote was not manufactured for the sole purpose of utilizing the rolling code to operate Chamberlain's Security+ GDO, even though

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65 Id. at 1027.
66 Id.
67 Id. at 1027-28.
68 Id. at 1028.
70 Id.
71 Id. at 1032.
72 Id. at 1035.
73 Id.
74 Chamberlain III, 381 F.3d at 1185. In fact, as of the date of both the district court case and the appeal, only the Second Circuit had construed §1201(a)(2), a construction that focused on First Amendment issues rather than an application of the statute to case-specific facts. See Universal City Studios, Inc. v. Corley, 273 F.3d 429 (2d Cir. 2001).
75 Chamberlain I, 292 F. Supp. 2d at 1036.
Skylink further argued that a product that serves a legitimate purpose does not violate sections 1201(a)(2)(A) or (B) of the DMCA. The court rejected Skylink's argument, citing two cases applying the DMCA to digital piracy in the content industry, stating that because one of the settings of Skylink's transmitter served only the purpose of operating Chamberlain's rolling code GDO, the fact that the remote serves more than one purpose is not enough to defeat summary judgment.

Amicus curiae Computer and Communications Industry Association (CCIA) advocated that the court employ § 1201(f), the DMCA's reverse engineering provision, as a basis for finding in favor of Skylink. Specifically, CCIA argued that Skylink did not violate the DMCA because its actions fell within the safe harbor provision for reverse engineering for the purpose of achieving interoperability. The District Court commented briefly on this argument but found an alternative basis on which to base a finding for Skylink.

The issue on which the summary judgment motion was ultimately decided was whether a consumer's use of Skylink's transmitter was an "authorized" act for purposes of the DMCA. The DMCA defines "circumvention of a technological measure" as "...avoid[ing], bypass[ing], remov[ing], deactivat[ing], or impair[ing] a technological measure, without the authority of the copyright owner." As such, whether the circumvention was without the consent of the copyright owner constitutes a separate element of the summary judgment motion. Because consumers' aftermarket options were not restricted by means of a shrinkwrap agreement, as well as the long history of the universal replacement transmitter market, Chamberlain implicitly gave its authority to consumers to use any replacement transmitter. In doing so, Chamberlain gave both

76 Id.
77 Id. at 1037.
78 Id.; citing Universal City Studios, Inc. v. Reimerdes, 111 F. Supp. 2d 294 (S.D.N.Y. 2000), aff'd sub nom Universal City Studios, Inc. v. Corley, 273 F.3d 429 (2d Cir. 2001) (posting computer source code on the Internet that circumvents DVD access control technology is a violation of section 1201 of the DMCA); RealNetworks, Inc. v. Streambox, Inc., No. 2:99CN02070, 2000 WL 127311 (W.D. Wash. 2000) (distributing software that circumvents plaintiff's "secret handshake" process that controls access to copyrighted materials is a violation of section 1201 of the DMCA).
79 Chamberlain I, 292 F. Supp. 2d at 1037-38.
80 Chamberlain III, 381 F.3d at 1186 n5.
81 Id. at 1186.
82 Chamberlain I, 292 F. Supp. 2d at 1035-36.
83 Id. at 1038-40.
85 Chamberlain I, 292 F. Supp. 2d at 1038.
86 Id. at 1038-40.
consumers and competitors permission to circumvent access controls to gain access to its copyrighted software.\textsuperscript{87}

The District Court further noted that under Chamberlain’s literal interpretation of the DMCA, a consumer would violate the anti-circumvention provisions if he lost the transmitter and found some other way to sidestep the rolling code to open his garage.\textsuperscript{88} The court stated that “the DMCA does not require such a conclusion.”\textsuperscript{89}

The District Court denied Chamberlain’s motion for summary judgment on August 29, 2003, inviting Skylink to file for summary judgment.\textsuperscript{90} The court granted Skylink’s motion on November 13, 2003,\textsuperscript{91} prompting Chamberlain’s appeal to the Federal Circuit.\textsuperscript{92}

3. Federal Circuit

Chamberlain did not appeal the denial of its summary judgment motion on its DMCA claims.\textsuperscript{93} Rather, Chamberlain’s appeal stemmed “from its allegations that the District Court incorrectly construed the DMCA as placing a burden upon Chamberlain to prove that the circumvention of its technological measures enabled access to its copyrighted software.”\textsuperscript{94} Applying Seventh Circuit law,\textsuperscript{95} the Federal Circuit affirmed the lower court’s summary judgment in favor of Skylink, concluding that because Skylink’s transmitter enables only uses that copyright law authorizes, “Chamberlain has neither proved nor alleged a connection between Skylink’s accused circumvention device and the protections that the copyright laws afford Chamberlain capable of overcoming [the] presumption” that Skylink’s device is legal.\textsuperscript{96}

\textsuperscript{87} Id.
\textsuperscript{88} Id.
\textsuperscript{89} Id. at 1040. The district court failed to pinpoint where in the text of the DMCA it found support for this conclusion.
\textsuperscript{90} Chamberlain I, 292 F. Supp. 2d at 1040.
\textsuperscript{91} Chamberlain II, 292 F. Supp. 2d at 1046.
\textsuperscript{92} Chamberlain III, 381 F.3d at 1182. Although copyright law is not traditionally within its jurisdiction, the Federal Circuit properly heard the case because both as filed and as amended, the District Court’s jurisdiction at least partly “arose under” patent laws. Id. at 1188.
\textsuperscript{93} Id. at 1181.
\textsuperscript{94} Id. at 1182.
\textsuperscript{95} Id. at 1191. As copyright law is not traditionally within its jurisdiction, to resolve issues of substantive copyright law, the Federal Circuit applies the law as interpreted by the regional circuit in which the case arose. See Atari Games Corp. v. Nintendo of Am., Inc., 975 F.2d 832, 837 (Fed. Cir. 1992). The Chamberlain case was essentially a matter of first impression, as the Seventh Circuit had considered the DMCA only once, in In re Aimster Copyright Litig., 334 F.3d 643, 655 (7th Cir. 2003), although that case involved different provisions of the DMCA than those at issue in Chamberlain.
\textsuperscript{96} Chamberlain III. 381 F.3d at 1191.
The court began by noting that it must "first determine precisely what § 1201(a)(2) prohibits" in order to determine whether Skylink was entitled to summary judgment. To interpret a statute, the court begins with the language of the statute. If the statute is unambiguous, the court simply "enforces the congressional intent embodied in that plain wording." However, if the words of the statute are ambiguous or "do not yield at satisfactory answer with respect to the intent of the congress, [the court] must employ other less satisfactory means to ascertain, as best [they] can, the legislative will."

The Federal Circuit noted that the DMCA's anti-circumvention provisions establish new causes of action for liability, not a new property right. Circumvention is not infringement, a point made clear by the statute's structure. The Federal Circuit stated that the distinction between property and liability "goes straight to the issue of authorization." Whereas under copyright law, after a plaintiff shows that the defendant has used his property, the burden is on the defendant to prove that the use was authorized, the DMCA defines circumvention as activity undertaken "without the authority of the copyright owner." "The plain language of the statute therefore requires a plaintiff alleging circumvention (...) to prove that the defendant's access was unauthorized." The court noted that this was a "significant burden" where the copyright laws allow consumers to use a copy of software embedded in a product they have purchased.

The court next noted that the divide between property and liability is relevant to an important policy issue, namely antitrust and the doctrine of copyright misuse. Chamberlain argued that the DMCA superseded existing consumer beliefs about uses of products containing embedded software and that in enacting the DMCA Congress empowered

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97 Id.
98 Id. at 1192 (citing Gwaltney of Smithfield, Ltd. v. Chesapeake Bay Found., 484 U.S. 49, 56 (1987)).
99 Chamberlain III, 381 F.3d at 1192 (citing United States v. Clark, 454 U.S. 555, 560 (1982)).
100 Chamberlain III, 381 F.3d at 1192 (citing Bethlehem Steel Corp. v. Bush, 918 F.2d 1323, 1327 (7th Cir. 1990)).
101 Chamberlain III, 381 F.3d at 1192.
102 Id.; 17 U.S.C. § 1201(c)(1) (1998) ("Nothing in this section shall affect right, remedies, limitations, or defenses to copyright infringement, including fair use, under this title.").
103 Chamberlain III, 381 F.3d at 1193.
104 Id.
106 Chamberlain III, 381 F.3d at 1193.
107 Id.
108 Id.
manufacturers to prohibit consumers from using embedded software products in connection with competing products.\textsuperscript{109} The court stated that such an interpretation of the DMCA would grant manufacturers broad exemptions from antitrust laws and the doctrine of copyright misuse, an interpretation that would only be reasonable if § 1201 recognized a "new property right capable of conflicting with the copyright owner's other legal responsibilities."\textsuperscript{110} The DMCA's anti-circumvention provisions do not establish a new property right, but rather "provide property owners with new ways to secure their property."\textsuperscript{111} Regarding the issue of implied repeal of the antitrust laws, the court stated:

The court stated that "no such 'plain repugnancy' separates the DMCA from the antitrust laws."\textsuperscript{112} Therefore, the DMCA does not limit the scope of antitrust laws, either explicitly or implicitly.\textsuperscript{113}

As to Chamberlain's DMCA claim, to prove a violation of §1201(a)(2), the court stated that a plaintiff must prove:

(1) ownership of a valid copyright on a work, (2) effectively controlled by a technological measure, which has been circumvented, (3) that third parties can now access (4) without authorization, in a manner that (5) infringes or facilitates infringing a right protected by the Copyright Act, because of a product that (6) the defendant either (i) designed or produced primarily for circumvention; (ii) made available despite only limited commercial significance other than circumvention; or (iii) marketed for use in circumvention of the controlling technological measure.\textsuperscript{114}

Not only did Chamberlain fail to show that Skylink's access was not authorized, but they also failed to show the fifth element of the DMCA claim, "a critical nexus between access and protection."\textsuperscript{115} Chamberlain never showed how Skylink's access "facilitates the infringement of any

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\textsuperscript{109} Id.  
\textsuperscript{109} Id.  
\textsuperscript{111} Chamberlain III, 381 F.3d at 1193-94.  
\textsuperscript{112} Id. at 1201-02 (quoting Gordon v. N.Y. Stock Exch., Inc., 422 U.S. 659, 682 (1975)).  
\textsuperscript{113} Chamberlain III, 381 F.3d at 1202.  
\textsuperscript{114} Id.  
\textsuperscript{115} Id. at 1203.  
\textsuperscript{116} Id. at 1204.
right that the Copyright Act protects.\textsuperscript{117} Because Chamberlain’s customers are authorized by the Copyright Act to use the copy of copyrighted software embedded in the GDO, the customers are protected from circumvention liability.\textsuperscript{118} If there is no copyright infringement and no prohibited circumvention, then Skylink cannot possibly be liable for trafficking under §1201(a)(2).\textsuperscript{119} Therefore, Chamberlain cannot utilize §1201 to restrict aftermarket options.\textsuperscript{120}


Whereas the Federal Circuit in Chamberlain affirmed the lower court’s finding, that the defendant’s garage door opener did not violate the anti-circumvention provisions of the DMCA, the Lexmark appellate court vacated the lower court’s decision for the plaintiff. That decision stated...That the two district courts reached conflicting conclusions demonstrates that the statutory language of the DMCA is ambiguous and may have potentially anticompetitive results, as courts find it difficult to parse the language and apply it to fact-specific situations. What are the conflicting conclusions?

1. Background

Lexmark International, Inc, (Lexmark) is one of the largest players in the laser printer market.\textsuperscript{121} Lexmark offers consumers two choices—a full price printer cartridge, and a discounted printer cartridge, whereby consumers agree to return used cartridges to Lexmark for remanufacturing.\textsuperscript{122} The latter “Prebate” cartridge, which is used in two models of Lexmark T-Series printers, contains a microchip containing a copyrighted computer program,\textsuperscript{123} the Toner Loading Program.\textsuperscript{124} That program monitors the amount of toner left in the cartridge.\textsuperscript{125} The Printer Engine Program, which resides in the printer itself, controls such operations

\textsuperscript{117} Id.
\textsuperscript{118} Chamberlain III, 381 F.3d at 1204.
\textsuperscript{119} Id.
\textsuperscript{120} Id.
\textsuperscript{121} Lexmark I, 253 F. Supp. 2d at 946.
\textsuperscript{122} Id. at 947.
\textsuperscript{123} Id.
\textsuperscript{124} The Sixth Circuit demonstrates the modest size of the program by indicating that the phrase “Lexmark International, Inc. v. Static Control Components, Inc.” in ASCII format would occupy more memory than the Toner Loading Program. Lexmark II, 387 F.3d at 529-30. In this case, the Toner Loading Program is the “technological measure” that controls access to the Printer Engine Program (the “copyrighted work”).
\textsuperscript{125} Lexmark I, 253 F. Supp. 2d at 949.
as paper feed, motor control, and paper movement. When a toner cartridge is inserted in the printer, an authentication sequence is activated. If the code in the printer matches the code on the toner cartridge microchip, the Printer Engine Program will work. The terms of the Prebate agreement are thus enforced, because cartridges refurbished by competitors do not contain the microchip, or the copyright-protected software, and will cause the printer to malfunction.

Static Control Components, Inc. (SCC) developed its SMART EK microchip to replace Lexmark’s chip in the used Prebate cartridges. The SMART EK chip was sold to Lexmark’s competitors in the aftermarket printer supply business for use in refurbishing Prebate cartridges. By circumventing the authentication sequence in the Lexmark printers, the SMART EK chip enabled the use of unauthorized cartridges. To ensure that the SMART EK chip would in fact enable unauthorized refurbished cartridges to work in Lexmark printers, SCC copied the Toner Loading Program “in exact format and order.”

On December 20, 2002, Lexmark brought suit in the Eastern District of Kentucky, and moved for a preliminary injunction against the making, selling, and distribution of the SMART EK chips. The complaint contained three theories of liability: 1) “SCC violated the copyright statute . . . by reproducing the Toner Loading Program on its SMART EK chip;” 2) “SCC violated the DMCA by selling a product that circumvents access controls on the Toner Loading Program;” and 3) “SCC violated the DMCA by selling a product that circumvents access controls on the Printer Engine Program.”

2. District Court’s analysis

The district court first determined that Lexmark was likely to succeed

[References and footnotes]

126 Id. at 948.
127 Id. at 948-52.
128 Id.
129 Id. at 952.
130 Defendant’s Memorandum in Opposition to Motion for Preliminary Injunction at 4, Lexmark (No. 02-571-KSF) [“SCC Opposition”].
131 Lexmark I, 253 F. Supp. 2d at 955.
132 Id.
133 Id. Although the District Court determined that SCC engaged in wholesale copying of Lexmark’s copyrighted program, the Copyright Office’s recent rulemaking on exemptions from the DMCA suggests that this crucial fact is still in dispute. See Marybeth Peters, Recommendation of the Register of Copyrights in RM 2002-04: Rulemaking on Exemptions from Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies 176 (Oct. 27, 2003), available at http://www.copyright.gov/1201/docs/registers-recommendation.pdf; see also Higgs, supra note 8, at n.86.
134 Lexmark II, 387 F.3d 522, 531(6th Cir. 2004).
on the merits of its copyright infringement claim. SCC admitted that it had engaged in literal copying of the Toner Loading Program when it developed its SMARTeK microchip. SCC argued that the Toner Loading Program was a "lock-out code," thus rendering it uncopyrightable because elements were dictated by functional compatibility constraints. This argument was rejected because "the use of any Toner Loading Program could still result in a valid authentication sequence and a valid checksum." Next, SCC raised the defense of copyright misuse, alleging that Lexmark was attempting "to secure an exclusive right or limited monopoly not expressly granted by copyright law." The court rejected this defense, finding that Lexmark was merely protecting the right of access, a legitimate right under the copyright law after the enactment of the DMCA.

The court next determined that the DMCA claim was also likely to prevail on the merits. The court stated that the plain meaning of the statute was clear and unambiguous, thus rendering a resort to legislative history unnecessary. Specifically, the court concluded that the authentication sequence constituted a "technological measure" of the type proscribed in § 1201(a) that "controls access" to the copyrighted Toner Loading Program and Printer Engine Program. The authentication sequence "effectively" controlled access because it controlled "the consumer's ability to make use of these programs." Finally, the SMARTeK microchip circumvented Lexmark's access controls by tricking the printers into thinking that SCC's chips were actually those contained on Lexmark's authorized cartridges. The court thus concluded that the SMARTeK chips' sole purpose was circumvention of technological measures implemented to control access to copyrighted works.

The court then turned to SCC's defense that congressional intent was for the DMCA to apply only to digital piracy rather than such an expansive application of the statute. The court rejected this argument, stating again that because the language of the statute was clear, an examination of the

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135 Lexmark I, 253 F. Supp. 2d at 957.
136 Id. at 955.
137 Lexmark II, 387 F.3d at 531.
138 Id.
139 Lexmark I, 253 F. Supp. 2d. at 966.
140 Id.
141 Id. at 966-71.
142 Id. at 967.
143 Id. at 967-68.
144 Lexmark I, 253 F. Supp. 2d at 968.
145 Id.
146 Id.
147 Id. at 969-70.
The court felt that the ban on trafficking in anti-circumvention tools contained in §1201(b) was sufficient to prevent digital piracy and that SCC's suggested reading would cause the language in §1201(a)(2) to be "mere surplusage."

The court went on to point out that, as enacted, Congress did not limit application of the DMCA to copyrighted works with independent market value. Specifically, the DMCA's anti-circumvention provisions, as drafted, apply to all copyrighted works, regardless of the subject matter of the work.

The district court next dismissed SCC's claim that its actions fell under the reverse engineering exception contained in section 1201(f) of the statute because the SMARTEK chips contained literal copies of the Toner Loading Program. Although SCC had engaged in time-consuming, expensive efforts to reverse engineer the Toner Loading Program and had ultimately developed independently created software mimicking the authentication sequence, SCC resorted to slavish copying of the Toner Loading Program. The district court stated that "SCC's SMARTEK microchips cannot be considered independently created computer programs. [They] serve no legitimate purpose other than to circumvent Lexmark's authentication sequence and . . . cannot qualify as independently created when they contain exact copies of Lexmark's Toner Loading Program."

Thus, the Toner Loading Program did not fall within the reverse engineering exception.

The district court granted the preliminary injunction on February 27, 2003. SCC appealed the decision to the Sixth Circuit. However, before the appeal was heard, SCC participated in the Copyright Office's anti-circumvention rulemaking.

3. SCC petition for exemption in § 1201 rulemaking

Taking advantage of the fact that the Copyright Office was in the process of reviewing petitions for exemptions of copyrighted works from the anti-circumvention provisions, SCC submitted a late comment proposing an exemption from liability for the following classes of works:

1. Computer programs embedded in computer printers and toner

148 Id.
149 *Lexmark I*, 253 F. Supp. 2d at 969.
150 Id.
151 Id. at 969-70.
152 Id. at 970 ("Sections 1201(f)(2) and (3) of the DMCA are not broad exceptions that can be employed to excuse any behavior that makes some device 'interoperable' with some other device.").
153 Id. at 971.
cartridges and that control the interoperation and functions of the printer and toner cartridge;

2. Computer programs embedded in a machine or product which cannot be copied during the ordinary operation or use of the machine or product; and

3. Computer programs embedded in a machine or product and that control the operation of a machine or product connected thereto, but that do not otherwise control the performance, display or reproduction of copyrighted works that have an independent economic significance.\(^{155}\)

It was probably not SCC's hope that an exemption from liability might render the litigation moot, but more likely to have additional ammunition to use in court. Any possible exemption would not address the claims in the suit.

The Register of Copyrights did not recommend exemptions from liability for any of SCC's proposed classes of works.\(^{156}\) The Register concluded that achieving interoperability of remanufactured printer cartridges with Lexmark's printers could have been lawfully achieved by taking advantage of the defense found in §1201(f), the reverse engineering provision,\(^{157}\) as it was intended "to avoid hindering competition and innovation in the computer and software industry."\(^{158}\) "Interoperability necessarily includes . . . concerns for functionality and use, and not only of individual use, but for enabling competitive choices in the marketplace."\(^{159}\) In fact, the Register went on to state:

Taking advantage of the statutory exemption found in §1201(f) provides far greater relief to a competitor than could any recommended exemption by the Librarian. An exemption for a particular class of works in this rulemaking is limited to the prohibition in §1201(a)(1)(A). Pursuant to §1201(a)(1)(E), neither an exemption nor "any determination" made in this rulemaking "may be used as a defense in any action to enforce any provision of this title other than this paragraph." In sharp contrast, the statutory exemption found in §1201(f) not only permits circumvention of technological measures to


\(^{157}\) Id. at 176.

\(^{158}\) Id. at 178 (quoting Staff of House Committee on the Judiciary, 105th Cong., Section-by-Section Analysis of H.R. 2281 as Passed by the United States House of Representatives on Aug. 4. 1998 (Comm. Print 1998)).

\(^{159}\) Id.
analyze and identify interoperable elements of a protected computer program, but also provides exemptions to the trafficking provisions in §1201(a)(2) and 1201(b). Even if the Register had found a factual basis for an exemption, it would only exempt the act of circumvention. It would not exempt the creation and distribution of the means to circumvent or the distribution of interoperable computer programs embedded in devices. Since it is clear that Static Control’s goal was not merely to privately circumvent, but rather to facilitate the distribution of competitive toner cartridges to others, a recommendation for an exemption in this rulemaking would have had little effect on the intended use. On the other hand, if reverse engineering to achieve interoperability is conducted under the statutory exemption, a competitor may not only reverse engineer a computer program in order to create an independently interoperable computer program, but may also make the information or means of interoperability available to others if the sole purpose is the enabling of interoperability of an independently created computer program with other programs, to the extent that doing so is a noninfringing use. Taking advantage of the statutory exemption is, therefore, a far more robust remedy for insuring competitive activity in the marketplace.'

The Copyright Office denied SCC’s petition, but took no position on whether SCC did in fact circumvent.

4. Sixth Circuit

On October 26, 2004, the Sixth Circuit vacated and remanded the district court decision. The court held that the district court committed three errors in determining that Lexmark had a likelihood of success on the copyright infringement claim: (1) in concluding that “because the Toner Loading Program could be written in a number of different ways,” it was copyrightable; (2) in deducing that the toner control program had sufficient originality to obtain copyright protection; and (3) “in assessing whether the Toner Loading Program functioned as a lock-out code.” Further, the court disagreed with the district court’s conclusion on the DMCA claim.

With respect to the infringement claim, the court stated that infringement is established when the plaintiff shows “(1) ownership of a valid copyright in the computer program at issue . . . and (2) that the defendant copied protectable elements of the work.” The first prong of the analysis “tests originality and non-functionality.” The Supreme Court has indicated that “[o]riginal...means only that the work was independently

160 Id. at 180-81 (footnote omitted).
161 Lexmark II, 387 F.3d at 529-41.
162 Id. at 537-541.
163 Id. at 534 (citing Feist Publ’ns v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991)).
164 Lexmark II, 387 F.3d at 534.
created by the author...and that it possesses at least some minimal degree of creativity;" the work need not be novel. Even if the work is original, it may not be copyrightable because "[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery . . . ." The second prong tests whether any copying occurred (a factual matter) and whether the portions of the work copied were entitled to copyright protection (a legal matter).

The Sixth Circuit felt that it was error for the district court to conclude that, because it could be written in different ways, the Toner Loading Program was entitled to copyright protection. Failing to consider whether "external factors such as compatibility requirements, industry standards, and efficiency" dictated the number of structures the Toner Loading Program could take conflicts with Feist. "[T]he court must ask whether the alternative ways of putting together the competing work are feasible in that setting." Next, with respect to the originality standard, "the court should ask whether the ideas, methods of operation and facts of the program could have been expressed in any form other than that chosen by the programmer, taking into consideration the functionality, compatibility and efficiency demanded of the program." Lexmark's expert testified that there were several possible alternatives. SCC's expert, however, "concluded that functionality and efficiency considerations precluded any material changes to the Toner Loading Program." Further, the court contended, the alternatives proposed by Lexmark's expert amounted to different ideas or methods, rather than means of expressing ideas or methods. Methods and ideas are not protectable by copyright.

Finally, "the district court erred in assessing whether the Toner Loading Program functions as a lock-out code." The court indicated that even if "the programming language, program size, and efficiency concerns did not dictate the content of the Toner Loading Program, the fact that it

165 Feist Publ'ns v. Rural Tel. Serv. Co., 499 U.S. at 345 (citing M. Nimmer & D. Nimmer, Copyright §§ 2.01[A], [B] (1990)).
166 17 U.S.C. §102(b).
167 Lexmark II, 387 F.3d at 534.
168 Id. at 538.
169 Id. at 537-38.
170 Id.
171 Id. at 539.
172 Lexmark II, 387 F.3d at 539.
173 Id. at 540.
174 Id. (citing Bateman v. Mneumonics, Inc., 79 F.3d 1532, 1546 n.29 (11th Cir. 1996)).
175 Id. at *541.
also functions as a lock-out code’ makes it difficult for Lexmark to succeed on its infringement claim. The court further indicated that the unchallenged testimony [of SCC’s expert] that it would be “computationally impossible” to modify the checksum value without contextual information suffices to establish that the checksum operation imposes a compatibility constraint in the most literal sense possible: if any single byte of the Toner Loading Program is altered, the printer will not function.

Thus, the Sixth Circuit concluded that compatibility alone justified SCC’s literal copying.

The Sixth Circuit also disagreed with the district court’s conclusion on the DMCA claim. The district court employed the “ordinary, customary meaning” of “access (‘the ability to enter, to obtain, or to make use of’)” to find that “Lexmark’s authentication sequence effectively ‘controls access’ to the Printer Engine Program because it controls the consumer’s ability to make use of these programs.” The Sixth Circuit, on the other hand, stated that it is the purchase of a Lexmark printer, rather than the authentication sequence, that allows “access” because the literal code of the Printer Engine Program may be read directly from the memory and the data may be translated into source code. Thus, “[n]o security device . . . protects access to the Printer Engine Program Code and no security device accordingly must be circumvented to obtain access to that program code.” The court pointed out that the authentication sequence may control the consumer’s ability to “make use of” the work but it does not prevent the consumer from “obtaining” (which is another “conventional meaning” of the word “access”) a copy of the work. The DMCA requires that access to a copyrighted work not only be controlled but controlled “effectively.” The court states that “it seems clear that this [anti-circumvention] provision does not naturally extend to a technological measure that restricts one form of access but leaves another route wide open.”

Due to an inability of Lexmark to establish of its likelihood of success on its infringement or DMCA claims, the Sixth Circuit vacated the lower court’s preliminary injunction and remanded the case for further

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176 Id.
177 Lexmark II, 387 F.3d at *542.
178 Id. at 546 (quoting MERRIAM-WEBSTER’S COLLEGIATE DICTIONARY 6 (10th ed. 1999)).
179 Id. (citing D. Ct. Op. at 41).
180 Id.
181 Id. at 547.
183 Lexmark II, 387 F.3d at 547.
proceedings consistent with the appellate opinion.\textsuperscript{184}

III. DISCUSSION

The Sixth Circuit reversed the \textit{Lexmark} lower court's disposition of the DMCA claim based on a different definition of the word "access." The \textit{Chamberlain} court, on the other hand, based its reasoning on an analysis of "authorization." Both courts engaged in complicated legal and linguistic gymnastics to arrive at their results, demonstrating that a DMCA analysis, which should be straightforward based on the statute, is complicated and fact-intensive. Strict adherence to the language of the DMCA can potentially result in enlarging the scope of copyright to gain a monopoly in functional products, anti-competitive behavior dangerous to consumers. Therefore, Congress should clarify the language to avoid future complications.

\textit{A. Legislative Intent}

The proper starting place for statutory analysis is the text itself.\textsuperscript{185} "When a statute is unambiguous, resort to legislative history and policy considerations is improper."\textsuperscript{186} However, when the statute is unclear or its strict adherence produces absurd results, consulting the legislative history can be invaluable in determining the intent of Congress in enacting the legislation.\textsuperscript{187}

The driving force behind passage of the DMCA was the lobbying efforts of the content industries. The DMCA's legislative history reflects Congress' focus on the digital distribution of creative works traditionally covered by copyright.\textsuperscript{188} Specifically,

\begin{quote}
the law must adapt in order to make digital networks safe places to disseminate and exploit copyrighted materials . . . \[T]\text{his bill . . .}
\end{quote}

\textsuperscript{184} \textit{Id.} at 551.


\textsuperscript{186} \textit{In re} Koenig Sporting Goods, Inc., 203 F.3d 986, 988 (6th Cir. 2000). Those in the "textualist school" favored by strict constructionists such as Justice Scalia hold that the role of courts in interpreting statutes necessitates that legislative history must be ignored in determining the intent of Congress; the meaning of the statute can be found in the text alone. See generally \textit{William N. Eskridge, Jr., Dynamic Statutory Interpretation} (1994).


\textsuperscript{188} See generally Bajalcaliev, \textit{supra} note 8.
provides this protection and creates the legal platform for launching the
global digital online marketplace for copyrighted works. It will also
make available via the Internet the movies, music, software, and
literary works that are the fruit of American creative genius.\textsuperscript{189}

The record in the Senate and the House of Representatives provides the
following general motivations for the DMCA's enactment: to encourage
trade in copyrighted works via the Internet; to make safe the dissemination
of copyrighted materials in the digital marketplace; to update American
copyright law to reflect the realities of the digital world; and the bring the
United States into compliance with the WIPO treaties.\textsuperscript{190}

In both houses of Congress, the legislators were concerned about the
implications of the digital revolution on the content industry.\textsuperscript{191}
Specifically, there was a concern that the threat of piracy of copyrighted
works in digital format might cause many copyright holders to limit
availability of their works. Because of the ease of making a perfect copy of
a work in digital format, many copyright holders were reluctant to engage
in electronic commerce and digital reproductions. While the legislative
history is full of references to making the digital marketplace safe for the
distribution of music, movies, books, and software, nowhere does Congress
express a desire to protect durable goods manufacturers and give them the
ability to obtain a monopoly in aftermarket replacement parts. However,
the language of the statute itself is not explicitly limited to digital piracy of
works with independent market value.\textsuperscript{192}

\textbf{B. Evaluating DMCA Legislation}

At least one commentator has argued that the DMCA does not meet
the "four primary axioms of the ingredients that combine to form 'good'
laws."\textsuperscript{193} The four criteria are: (1) coherence; (2) transparency; (3) reality;
and (4) breadth.\textsuperscript{194}

\textit{1. Coherence}

In order for a law to be coherent, "its pieces should fit together, so that
it inclines in a unified direction."\textsuperscript{195} Coherence demands consistency and

\textsuperscript{190} See generally Bajalcaliev, supra note 8.
\textsuperscript{191} Id.
\textsuperscript{192} Id.; 17 U.S.C. \textsection 1201(a) (1998).
\textsuperscript{193} David Nimmer, \textit{Codifying Copyright Comprehensibly}, 51 UCLA L. REV. 1233,
1270 (2004) [hereinafter Nimmer, Codifying]. Professor Nimmer goes so far as to compare
the DMCA to "Jeremy Bentham's "nonsense on stilts." \textit{Id.} at 1342.
\textsuperscript{194} Id. at 1270-1277.
\textsuperscript{195} Id. at 1270.
that all provisions of a law "fit together to form a seamless whole."\textsuperscript{196}

The DMCA does not meet the requirement of coherence. "It is subject to endless contradictions and interpretive dead ends."\textsuperscript{197} The massive legislation fails "to embody the chief goal that its congressional architects ceaselessly proclaimed; namely, saving the country from the specter of a pay-per-use world."\textsuperscript{198}

2. Transparency

Legislation should be transparent, so that citizens are able to reasonably comprehend what is required or prohibited.\textsuperscript{199} "A transparent law clearly signals its readers to the domains of its application."\textsuperscript{200}

The Chamberlain and Skylink cases suggest that the language of the DMCA is not transparent. Although ultimately the Sixth Circuit and the Federal Circuit both arrived at the conclusion that the DMCA did not apply, these results were reached after a complicated, fact-intensive parsing of words in the statute, "[dispelling] any impression that [the DMCA] succeeds at being transparent."\textsuperscript{201}

3. Reality

Good legislation should "provide guidance as to real-world concerns, not airy, speculative, and contingent phenomena."\textsuperscript{202} It should be apparent how the law applies to contemporary occurrences.\textsuperscript{203}

The DMCA as a whole fails to meet the test of reality. It is "unique by regulating in 1998 activities that not only had no existence then but which still continue to have no reality today."\textsuperscript{204}

4. Breadth

Broadly responsible legislation serves the community as a whole rather than the narrow concerns of organized special interests. The requirement of breadth "posits that Title 17 of the United States Code should regulate affairs across the country. It condemns special-interest legislation undertaken for the benefit of a privileged few rather than along

\textsuperscript{196} Id.
\textsuperscript{197} Id. at 1343.
\textsuperscript{198} Nimmer, Codifying, supra note 193, at 1343.
\textsuperscript{199} Id. at 1271.
\textsuperscript{200} Id. at 1343.
\textsuperscript{201} Id.
\textsuperscript{202} Id. at 1275.
\textsuperscript{203} Nimmer, Codifying, supra note 193, at 1275.
\textsuperscript{204} Id. at 1343.
neutral lines for the citizenry as a whole.”

Entire portions of the DMCA were “crafted for the particular benefit of named entities, with no pretense of serving the commonweal generally.” Congress granted special dispensations to various groups throughout the sweeping legislation. In fact, “Congress inserted the longest portion of section 1201 for the specific benefit of Macrovision Corporation.”

C. § 1201 Rulemaking for exemptions from liability

While the bill was being debated in Congress, the Commerce Committee was afraid that the anti-circumvention provision of the DMCA might have a potential negative effect on fair use. As a result, Congress adopted several fair use exceptions and enacted a “fail-safe” provision, §1201(a)(1)(D), which grants the Librarian of Congress, with the assistance of a recommendation of the Register of Copyrights based upon the record of a triennial rulemaking proceeding, the power to grant three year exemptions for “non-infringing uses by persons who are users of a copyrighted work [and] are, or likely to be, adversely affected by . . .” the prohibitions of section 1201(a)(1)(A).

The Librarian of Congress

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205 Id. at 1276.
206 Id. at 1343.
207 Id.
210 17 U.S.C. §1201(c)(1) (1998) (“Nothing in this section shall affect rights, remedies, limitations, or defenses to copyright infringement, including fair use, under this title); (c)(4) (“Nothing in this section shall enlarge or diminish any rights of free speech or the press for activities using consumer electronics, telecommunications, or computing products”); (d)(1) (“A nonprofit library, archives, or education institution which gains access to a commercially exploited copyrighted work solely in order to make a good faith determination of whether to acquire a copy of that work for the sole purpose of engaging in conduct permitted under this title shall not be in violation of subsection (a)(1)(A) . . . ”); (e) (" . . . This section does not prohibit any lawfully authorized investigative, protective, information security, or intelligence activity of an officer, agent, or employee of the United States. . ."); (f)(1) (“Notwithstanding the provisions of subsection (a)(1)(A), a person who has lawfully obtained the right to use a copy of a computer program may circumvent a technological measure that effectively controls access to a particular portion of that program for the sole purpose of identifying and analyzing those elements of the program that are necessary to achieve interoperability of an independently created computer program with other programs, and that have not previously been readily available to the person engaging in the circumvention, to the extent any such acts of identification and analysis do not constitute infringement under this title.”). However, the fair use exceptions delineated in the statute have been criticized as shortsighted and narrow. See Samuelson, supra note 18, at 543.
211 Section 1201(a)(1)(A) (1998) only applies to individual acts of infringement. It does not include the anti-trafficking provision, which is set out in section 1201(a)(2).
publishes any class of copyrighted works it feels should be exempted from 1201(a)(1)(A) protections. The anti-circumvention provisions do not apply to that class of works for the following three-year period.212

However, this is a limited remedy as exemptions are only granted every three years.213 Technology rapidly changes; the latest generation laptop computer is often obsolete six months after it was released. It is therefore likely that advances in technology will outpace such infrequently granted exemptions. Further, the parties seeking an exemption must affirmatively petition; exemptions are not granted sua sponte. Also, the decision that a “class of copyrighted works” is not covered still leaves the issue as to whether the work involved in the litigation is part of the exempted class to be resolved by the courts. Finally, because exemptions necessarily refer to a class of works rather than actions, it is clear that the rulemaking authority might not be the best means for clarifying statutory ambiguity and avoiding anticompetitive results.

D. Copyright Misuse

Untrammeled use of technological access controls by durable goods manufacturers readily morphs into anticompetitive abusive behavior. The doctrine of misuse was developed by courts to curb inappropriate uses of intellectual property.214

Misuse is an equitable doctrine, with roots in the patent world, in which a defendant in an infringement action may prevail if he can show, as a defense, that the patent owner has attempted to extended his patent into areas not protected by the governmental grant.215 Such conduct in early cases often involved illegal tying arrangements, in which a patent holder required consumers to purchase an unpatented good in connection with the purchase or license of the patented product.216 Congress has since statutorily scaled back some of the doctrine by including language directly in the Patent Act itself,217 and has prohibited tying only where the tying arrangement “meets the antitrust test of market power in the tying item.”218

214 See Burk, supra note 2, at 1114.
215 See generally 6-19 DONALD S. CHISUM, CHISUM ON PATENTS § 19.04 (2001); see also Burk, supra note 2, at 1114.
218 Burk, supra note 2, at 1117.
One scholar points out that although the misuse doctrine has been less successful in recent years as a defense to patent infringement, "it has experienced a somewhat surprising renaissance within the law of copyright" and argues that this may be due to the increased use of copyright to protect software, as software has functional aspects that are not present in most works traditionally covered by copyright. The seminal case in the development of application of the misuse doctrine to copyright law is *Laserscomb America, Inc. v. Reynolds*. There, the Fourth Circuit held that it was copyright misuse for a software company to include terms in a license that restricted licensees from independently developing a competing product. In *Practice Management Information Corporation v. American Medical Association*, the Ninth Circuit followed the Fourth Circuit, holding that the American Medical Association offended public policy by licensing its medical coding system in exchange for an agreement not to use a competing system. Several other circuit courts have also accepted the copyright misuse doctrine. Some commentators argue that extending the anti-circumvention provisions into the area of products where copyrighted software is ancillary to the desirability of the product itself constitutes misuse. However, this judicially created doctrine’s boundaries remain blurred and the “exact border between copyright misuse and antitrust remains particularly vague and controversial," which may lead to some courts’ reluctance to extend misuse to circumvention.

### E. Conclusion: Congress Should Revisit the DMCA

Despite the Sixth Circuit’s recent decision vacating the lower court’s decision in *Lexmark*, Congress should revisit the anti-circumvention provisions to clarify language that may potentially be used to stifle competition. That the lower court had allowed the use of the DMCA to protect a copyrighted work that was wholly functional and not separately marketed based on the “plain meaning” of the statute demonstrates the

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219 Id. at 1124.
220 Id.
221 911 F.2d 970 (4th Cir. 1990).
222 Id. at 979.
223 121 F.3d 516 (9th Cir. 1997).
224 Id.
225 See e.g., DSC Communications Corp. v. DGI Tech., Inc., 81 F.3d 597 (5th Cir. 1996); Bateman v. Mneumonics Inc., 79 F.3d 1532 (11th Cir. 1996); Data General Corp. v. Grumman Systems Support Corp., 36 F.3d 1147 (1st Cir. 1994); Qad inc. v. ALN Assocs. Inc., 974 F.2d 834 (7th Cir. 1992).
226 Burk, supra note 2, at 1135-36; Higgs, supra note 8, at 83.
227 Burk, supra note 2, at 1126.
difficulty in employing traditional tools of construction in interpreting this sweeping legislation. Although two circuits have now ruled against the creeping extension of the DMCA into the durable goods aftermarkets, one can foresee a future in which manufacturers include a small amount of ancillary copyrighted software that prevents interoperability of replacement parts or peripheral products in virtually every product, from “refrigerators to carburetors to lathes to audio speakers,” thereby enlarging the scope of the copyright. Such a scenario would result in restrictions on consumers’ ability to choose aftermarket replacement parts for their durable goods.

As early as 1979, concurring in the recommendations made by the National Commission on New Technological Uses of Copyrighted Works (CONTU), the commission charged with studying the efficacy of extending copyright protection to computer programs, copyright expert Professor Melville B. Nimmer expressed concern for “open-ended copyright protection for all computer software.” He suggested “a possible line of demarcation which would distinguish between protectible and nonprotectible software in a manner more consistent with limiting such protection to the conventional copyright arena.” Professor Nimmer “drew the distinction between purely utilitarian works, such as ‘programs which control the heating and air-conditioning in a building, or which determine the flow of fuel in an engine, or which control traffic signals’ as being potentially beyond the scope of copyright protection.” Professor Nimmer suggested that protection should be limited to “those computer programs which produce works which themselves qualify for copyright protection.”

One expert suggests that the “roots for that situation [of copyright holders obtaining effective control over the aftermarket for their products] trace back ultimately to Congress’ decision to embody CONTU’s recommendation that all computer code be subject to copyright protection.” Professor Nimmer’s 1979 suggestion of “drawing a distinction between software that controls mechanical processes—the flow of fuel in an engine” as he invoked or, one might safely add, the opening of

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229 Nimmer, Codifying, supra note 193, at 1373. Professor Nimmer goes on to say that the products that “adventitiously happen to include computer chips...tomorrow will undoubtedly embrace everything from dog food to facial tissues.” Id.


231 CONTU Report, supra note 230, at 27.


233 CONTU Report, supra note 230.

234 Nimmer, Codifying, supra note 193, at 1373.
a garage door—as opposed to use of a copyrighted work such as a database or videogame might have avoided any attempt to expand copyright protection into protecting aftermarket. Congress should take Professor Nimmer’s earlier suggestions to heart and limit the provisions concerning technological protection measures to those that protect copyrighted works with underlying independent value, a DVD containing a motion picture or a CD containing sound recordings.

Despite the powerful lobby of the content industry, some in Congress may already be ready to clarify the DMCA’s language. In particular, Representative Zoe Lofgren (D. Cal.) has stated that “[w]hen Congress enacted the DMCA in 1998, it never intended to prohibit all users – even lawful ones – from circumventing technical restrictions to make non-infringing uses of purchased content.”

Congress will eventually need to revise the law, thereby narrowing its application to those situations for which it was first intended, namely digital piracy of creative works. Congress should insert language requiring the underlying copyrighted works to have independent market value and that the circumvention present a substantial threat that the underlying work will be distributed in digital form without authorization of the copyright owner. Finally, Congress could create an exemption for legitimate uses, including those that would fall within the fair use defense. Amendment of the statute would provide specific guidance to the courts and companies while promoting competition in the marketplace. The limiting language would bring the DMCA more in line with the stated objectives for its passage.

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235 Id. at 1373-1374.
237 See generally Samuelson, supra note 18.
238 See Samuelson, supra note 18, at 537-38.