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STATEMENT OF INTEREST OF *AMICI*

Pursuant to Federal Rule of Appellate Procedure 29, this brief is submitted by Americans for Fair Electronic Commerce Transactions, The Digital Future Coalition, The American Library Association, The Association of Research Libraries, The Computer & Communications Industry Association, The Music Library Association, The National Writers Union and intellectual property law professors Dan L. Burk, David A. Rice and Pamela Samuelson (collectively, the "*amici*"). Both parties have consented to the filing of this brief *amici curiae*.

Amici submit this brief urging that this Court reverse the decision of the trial court which effectively prohibits the copying of facts from a publicly accessible website. *Amici* represent the interests of many sectors of the computer, software, Internet

telecommunications, and information services industries, as well as users of digital information. Common among all amici is a commitment to encouraging authorship and innovation by maintaining free and open access to information that properly belongs in the public domain. In this case, amici are concerned about the far-reaching consequences of the district court's decision which has expanded a database publisher's right to restrict use of publicly available information.

Americans for Fair Electronic Commerce Transactions (AFFECT) is a broad-based national coalition of business, professional, and consumer organizations dedicated to educating the public and policy makers about the danger of the Uniform Computer Information Transactions Act (UCITA), a proposed state contract law designed to standardize the licensing of software and all other forms of digital information. AFFECT supports improvements in high-quality computer and information technology and the growth of fair and competitive markets in the United States.

The Digital Future Coalition (DFC) is committed to striking an appropriate balance in law and public policy between protecting intellectual property and affording public access to it. The DFC is the result of a unique collaboration of many of the nation's leading non-profit educational, scholarly, library, and consumer groups, together with major commercial trade associations representing leaders in the consumer electronics, telecommunications, computer, and network access industries. Since its inception in 1995, the DFC has played a major role in the ongoing debate regarding the appropriate application of intellectual property law to the emerging digital network environment.

The American Library Association (ALA), founded in 1876, is the oldest and largest national library association in the world. It has 2,933 organization members and 52,502 personal members. Its concerns span all types of libraries: state, public, school, and academic libraries; special libraries serving persons in government, commerce, and industry, the arts, the armed services, hospitals, prisons, and other institutions. With a membership of libraries, librarians, library trustees, and other interested persons from every state and many countries of the world, the association is the chief advocate for the people of the United States in their search for the highest quality of information services.

The Association of Research Libraries (ARL) is a not-for-profit membership organization comprising over 120 of the leading university research libraries in North America. Its mission is to shape and influence forces affecting the future of research libraries in the process of scholarly communication. ARL is committed to promoting equitable access to and effective use of recorded knowledge in support of teaching, research, scholarship, and community service.

The Computer & Communications Industry Association

(CCIA) is an international, nonprofit association of computer and communications firms. Small, medium and large in size, CCIA's members include equipment manufacturers, software developers, telecommunications and online service providers, re-sellers, systems integrators, third-party vendors and other related business ventures. CCIA's mission is to further its members' business interests by promoting open, barrier-free competition in the offering of computer and communications products and services worldwide. CCIA's motto is "Open Markets, Open Systems, Open Networks, and Full, Fair and Open Competition."

The Music Library Association (MLA) is the professional organization in the United States devoted to music librarianship and to all aspects of music materials in libraries. Founded in 1931, MLA provides a forum for study and action on issues that affect music libraries and their users. MLA and its members make significant contributions to librarianship, publishing, standards and scholarship, and the development of new information technologies. In the forefront of contemporary librarianship, MLA assures that users of music materials will be well served by their libraries.

The National Writers Union (NWU) is the trade union for freelance writers of all genres who work for American publishers or employers. NWU is committed to improving the economic and working conditions of freelance writers.

Professors Dan L. Burk (University of Minnesota Law School), David A. Rice (Roger Williams School of Law) and Pamela Samuelson (Boalt Hall, University of California, Berkeley) are intellectual property law professors whose scholarship focuses, in large part, on the intersection of intellectual property and digital technologies.

ARGUMENT

In issuing the preliminary injunction, the district court effectively has ruled that the raw facts in a database may not be copied. The district court's decision conflicts directly with the U.S. Supreme Court's unanimous holding in *Feist Publications, Inc. v. Rural Telephone Serv. Co., Inc.*, 499 U.S. 340, 353 (1991) that "no one may copyright facts or ideas." In that landmark decision, the Supreme Court held that the Copyright Clause protects only original works of authorship and prohibits protection for factual information. The Court rejected the "sweat of the brow" doctrine, under which the copyright in a database extended to the facts it contained. The Court stated that the sweat of the brow doctrine "flouted basic copyright principles," *id.* at 354, and concluded that "only the compiler's selection and arrangement may be protected; the raw facts may be copied at will." *Id.* at 350.

Significantly, the Feist Court based its ruling not on the Copyright

Act, but on the Intellectual Property Clause of the U.S. Constitution. Article I, Section 8, cl. 8 authorizes Congress "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors ... the exclusive Right to their Respective Writings..." From this clause, the Court inferred that "[o]riginality is a constitutional requirement" for copyright protection, Feist, 499 U.S. at 346, and held that facts by definition are not original. They are discovered rather than created. Id. at 347.

The Feist Court's frequent invocations of the Constitution are not merely rhetorical flourishes; they implement a federal policy favoring free access to facts. Consonant with this federal policy, Verio copied raw facts from Register.com's WHOIS database. Register.com sought to prevent that copying by claiming that Verio breached the term of service agreement posted on the Register.com home page. Register.com also claimed that Verio was liable under the federal Computer Fraud and Abuse Act (CFAA) and the state common law of trespass to chattels. Ignoring well-settled policies underlying the federal intellectual property system and the First Amendment, the district court issued the preliminary injunction, and thereby conferred upon Register.com property-like rights in the unprotectable components of its WHOIS database - raw facts.

If constitutionally imposed limitations on copyright are to continue to have any meaning in the digital age, the district court's decision must be reversed. Otherwise, this Court in effect will be saying that a publisher can prohibit unilaterally the copying of facts from its publicly available website simply by posting a terms of service agreement forbidding such copying on the home page. Likewise, this Court will be saying that a publisher can restrict the use of information contained in its website by informing the user that the use is not authorized, and then making unsubstantiated claims that its system might crash if others made similar uses. This Court should not sanction such a dramatic -and unconstitutional-expansion of publishers' rights.

I. THE FEDERAL INTELLECTUAL PROPERTY SYSTEM PREEMPTS THE STATE LAW CLAIMS

There is a clear constitutional directive to "promote national uniformity in the realm of intellectual property." *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 162 (1989). Federal preemption of state law occurs where there is a conflict between state law and the federal intellectual property system. The most fundamental source of federal intellectual property law preemption is rooted in the U.S. Constitution's Supremacy Clause, Article VI, and its Intellectual Property Clause, Article I, Section 8. This conflict preemption poses the question as to whether enforcement of a state claim would make "compliance with ... federal ... regulations ... a physical impossibility," or stand as an "obstacle to the accomplishment and execution of the full purposes and objectives of Congress," so as to render the claim invalid by operation of the Constitution's Supremacy Clause. *Ray v. Atlantic*

Richfield Co., 435 U.S. 151, 158 (1978); *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941); *Association of Am. Med. Colleges v. Cuomo*, 928 F.2d 519, 522-23 (2d Cir.), cert. denied, 502 U.S. 862 (1991).

Conflict preemption rests upon the precept that the states may not override federal copyright or patent law objectives by seeking to "protect that which Congress intended to be free from restraint or to free that which Congress ha[s] protected." *Goldstein v. California*, 412 U.S. 546, 559 (1973). This is because "[t]he offer of federal protection from competitive exploitation of intellectual property would be rendered meaningless in a world where substantially similar state law protections were readily available." *Bonito Boats*, 489 U.S. at 151 (1989).

Reflecting a constitutional balance between the encouragement of authorship and invention and the furtherance of a "strong federal policy favoring free competition in ideas," *Lear, Inc. v. Adkins*, 395 U.S. 653, 656 (1969), the copyright and patent laws define not only the contours of intellectual property protection, but also its limits. *Bonito Boats*, 489 U.S. at 151, 153 (1989); *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984). Constitutional preemption precludes the states from upsetting this balance by "interfer[ing] with the federal policy ... of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain." *Bonito Boats*, 489 U.S. at 153.

As interpreted by the Supreme Court in *Feist*, the Intellectual Property Clause denies protection to raw facts precisely so that they may remain in the public domain, available to all comers. Accordingly, the federal intellectual property system preempts state law claims that frustrate this well settled constitutional policy.

It must be stressed that the Constitutional preemption analysis here - federal preemption under the Supremacy Clause - is entirely separate and distinct from the preemption analysis under § 301(a) of the Copyright Act. See 3 PAUL GOLDSTEIN, *COPYRIGHT*, § 15.3.3 at 15:36-37 (2nd ed. 2001). Section 301(a) preempts state laws creating "rights that are equivalent to any of the exclusive rights within the general scope of copyright ... in works of authorship" Courts have interpreted Section 301(a) as not preempting a state cause of action which requires proof of "extra elements" not present in a copyright claim. Thus, in *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447 (7th Cir. 1996), the Seventh Circuit held that Section 301(a) of the Copyright Act did not preempt enforcement of a shrink-wrap license prohibiting the copying of telephone listings because the contract claim required proof of an extra element - the existence of an enforceable contract. The ProCD court, however, did not consider preemption of state law causes of action under the Supremacy Clause, which is the argument amici advance in this brief.

A. The Breach of Contract Claim is Preempted

Until recently, federal copyright law and state contract law co-existed in relative harmony. Copyright law governed works generally distributed to the public, while works with limited distribution could receive both copyright and contract protection. Books sold to the public, for example, were not subject to contract restrictions, and the purchasers of the books were free to resell them under copyright's first sale doctrine or to copy from them to the extent permitted by copyright's fair use, idea/expression, and fact/expression doctrines. Conversely, a company like Dun & Bradstreet distributed its credit reports to business customers subject to a license agreement prohibiting these businesses from redistributing the reports or their contents. In other words, when copyrighted works were distributed to the mass market, the copies were sold, not licensed, and the terms of use after sale were governed exclusively by the federal copyright law.

More recently, however, software companies began distributing their products to the general public subject to "shrink-wrap" licenses - licenses printed on or within the plastic enclosing a software product. According to the shrink-wrap license, the licensee agreed to its terms by tearing the plastic shrink-wrap, which the licensee had to do to use the product.

This practice spread to other types of digital content, such as databases. In the online environment, publishers began to use "click-on" licenses, where the user had to click on an "I agree" icon in order to access the website, or "browse-wrap" licenses, where the publisher posted a license on the home page which stated that the licensee agreed to the license's terms if she proceeded beyond that first page into the website. In this case, Register.com appears to have used a browse-wrap license.

But it must be noted that it remains unclear as a matter of law whether clicking on an "I agree" icon even creates a binding contract. Courts around the country have just begun to consider the enforceability of click-on and browse-wrap licenses, and a consensus has not yet emerged. Moreover, numerous commentators have questioned the enforceability of such contracts. Thus, it is unsettled whether making a query which took Verio beyond the home page can be considered a manifestation of assent by Verio, thereby forming an enforceable contract with Register.com.

Even assuming that the contract at issue here is valid, the question of whether its terms may be enforced hinges, in large part, upon a federal preemption analysis that gives due weight to the constitutional and legislative purposes underlying the federal intellectual property system. The Constitution's Intellectual Property Clause empowers Congress to establish the copyright regime; the district court's ruling conflicts with it.

The leading case treating Constitutional preemption under the copyright laws is *Goldstein v. California*, 412 U.S. 546 (1973). In

that case, the Supreme Court considered whether the Copyright Act of 1909, then in force, preempted state protection for subject matter not included within that Act. In deciding that such state copyright rules were not preempted, the Court distinguished three types of situations - areas in which federal law mandated protection, areas in which federal law mandated no protection, and areas in which federal law was silent:

Where the need for free and unrestricted distribution of a writing is thought to be required by the national interest, the Copyright Clause and the Commerce Clause would allow Congress to eschew all protection. In such cases, a conflict would develop if a State attempted to protect that which Congress intended to be free from restraint or to free that which Congress had protected. However, where Congress determines that neither federal protection nor freedom from restraint is required by the national interest, it is at liberty to stay its hand entirely. *Goldstein*, 412 U.S. at 559.

In resolving the Constitutional preemption question at issue here, this Court must decide whether allowing a term of service prohibition on the use of raw facts would have the effect of protecting that which the copyright laws intended to be free from restraint. It clearly would. The Supreme Court in *Feist* explained the centrality of excluding facts from protection to the federal copyright system:

It may seem unfair that much of the fruit of the compiler's labor may be used by others without compensation. As Justice Brennan has correctly observed, however, this is not 'some unforeseen byproduct of a statutory scheme.' It is, rather, 'the essence of copyright,' and a constitutional requirement. The primary objective of copyright is not to reward the labor of authors, but 'to promote the Progress of Science and useful Arts.' To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.... This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art. *Feist*, 499 U.S. at 349-50 (emphasis added; citations omitted).

The fact that the offensive term is found in a license enforced under state contract law, rather than in a state statute, does not affect the preemption analysis: [A]t times a breach of contract cause of action can serve as a subterfuge to control nothing other than the reproduction, adaptation, public distribution, etc. of works within the subject matter of copyright. That situation typically unfolds when the "contract" at issue consists of a "shrinkwrap license" to which the copyright owner demands adherence as a

condition to licensing its materials. To the extent that such a contract is determined to be binding under state law, then that law may be attempting to vindicate rights indistinguishable from those accorded by the Copyright Act. Under that scenario, the subject contract cause of action should be deemed pre-empted. NIMMER ON COPYRIGHT, ¶ 1.01[B][1][a] at 1-19 (citations omitted).

Restrictive shrink-wrap license terms forsake the "carefully crafted bargain" by which the federal patent and copyright laws secure the public's right to exploit ideas and discoveries embodied in publicly disseminated works. See Feist, 499 U.S. at 350; Bonito Boats, 489 U.S. at 150-51. By extending license terms to mass market products, shrink-wrap and browse-wrap licenses invade the space historically occupied by the copyright law, and threaten to disrupt the careful balance established by Congress in the Copyright Act between the interests of authors and users with respect to published works. The use restrictions at issue in this case lend themselves all too readily to the unraveling of this constitutional bargain, by prescribing a copyright-like monopoly that embraces rights, remedies and restraints that extend well beyond those contemplated by federal law.

Moreover, employing state contract law to enforce shrink-wrap license terms which prohibit the use of facts in publicly accessible websites would frustrate the policy of encouraging one "to build freely on the ideas and information conveyed by a work." Feist at 349. Not surprisingly, the only reported decision to consider squarely the issue of Constitutional preemption of shrink-wrap terms limiting copyright privileges found that the Constitution prevailed over the contract. *Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255 (5th Cir. 1988), examined the enforceability of a state statute which expressly validated shrink-wrap license terms precluding users from reverse engineering computer programs. Relying on the Constitutional preemption cases, the Fifth Circuit refused to enforce the term because it "conflicts with the rights of computer program owners under [17 U.S.C.] ¶ 117 and clearly 'touches upon an area' of federal copyright law." *Vault Corp.*, 847 F.2d at 270; see also ROGER M. MILGRIM, *MILGRIM ON TRADE SECRETS* ¶ 1.05[5], 1-247-248 (2000).

Similarly, this Court in *Wright v. Warner Books, Inc.*, 953 F.2d 731, 741 (2d Cir. 1991), ruled that a contractual restriction on a biographer's use of a manuscript in a library would offend the fair use privilege of the Copyright Act. The court found that "[t]o read [the restriction] as absolutely forbidding any quotation, no matter how limited or appropriate, would severely inhibit proper, lawful scholarly use and place an arbitrary power in the hands of the copyright owner going far beyond the protection provided by law." By the same token, permitting a browse-wrap license to prohibit copying would place an arbitrary power in the hands of the database publisher.

Amici emphasize that we are not arguing that license restrictions

on copyright privileges are always preempted. When a publisher distributes a limited number of copies of a work, or truly restricts access to a website, trade secret principles should apply and courts should enforce reasonable contract terms. However, the Intellectual Property Clause, read together with the Supremacy Clause, works to preempt browse-wrap terms which prohibit the use of facts in publicly accessible websites. Enforcing such contractual restrictions would place an arbitrary power in the hands of the database providers going far beyond the protections already provided by federal law.

B. The Trespass to Chattels Claim is Preempted

In issuing the preliminary injunction, the district court also held that Register.com was likely to prevail on its trespass to chattels claim. Just as the contract claim conflicts with the federal intellectual property system, so too does the trespass claim.

Register.com maintains a publicly available website. It does not restrict access by means of a password or any of the other security measures commonly used on the Internet. Moreover, Register.com has not demonstrated any actual harm to its system by virtue of Verio's actions. Rather, it speculates that it may be harmed in the future if others engage in similar activity.

Thus, although Register.com has tried to dress up its claim to meet the elements of trespass to chattels, all it really has proved is that Verio copied facts from its publicly accessible website. As such, the trespass claim is nothing more than another attempt to evade the Supreme Court's injunction against the copying of facts. See *Feist*, 499 U.S. 340. Thus, under the facts here, the Intellectual Property Clause and the Supremacy Clause preempt the trespass claim.

II. THE COMPUTER FRAUD AND ABUSE ACT CLAIM IS UNCONSTITUTIONAL AS APPLIED IN THIS CASE

As its title suggests, the Computer Fraud and Abuse Act (CFAA), 18 U.S.C. Section 1030, targets cybercrime. Although it contains a private cause of action, it is primarily a criminal statute used by federal prosecutors to combat hacking, denial of service attacks, and other forms of cybercrime. The few CFAA cases to date suggest that the district court erroneously interpreted the phrase "access a computer without authorization or exceeds authorized access" to include use of a publicly available website in a manner prohibited by the terms of service agreement.

In *America Online v. LCGM, Inc.*, 46 F.Supp.2d 444, 448 (E.D. Va. 1998), for example, the defendant harvested email addresses from chatroom participants by "using [] software to evade AOL's filtering mechanisms." Similarly, in *Shurgard Storage Centers Inc. v. Safeguard Self Storage Inc.*, 119 F.Supp.2d 1121 (W.D. Wash. 2000), the plaintiff's employee was authorized to use the computer, but he emailed proprietary information from the computer to a

competitor. The court reasoned that the employee's authorization ended when he began to act as the defendant's agent. In both these cases, the unauthorized access involved far more than disregarding a statement posted on a publicly available website.

But even if Verio's conduct does satisfy the requirements of the CFAA, applying the CFAA to the facts of this case is unconstitutional. As noted above, Verio did not evade any security measures, nor did it burden Register.com's computer system. It simply copied facts from Register.com's database. Register.com is attempting to use the CFAA to prohibit activity clearly permitted by the Intellectual Property Clause as interpreted by the Supreme Court in *Feist*. The Supreme Court's decision in *Railway Labor Executives' Assn. v. Gibbons*, 455 U.S. 457 (1982), prevents such an end-run. *Railway Labor* concerned a statute enacted by Congress pursuant to the Commerce Clause which provided protection to employees of a railroad in bankruptcy. The Court held that the statute was inconsistent with the uniformity requirement of the Bankruptcy Clause. The Court further held that Congress cannot avoid the particular requirements of one enumerated power by relying on the generality of the Commerce Clause; Congress cannot avoid the uniformity requirement of the Bankruptcy Clause by relying on the generality of the Commerce Clause.

Likewise, in the instant case, Congress enacted the CFAA pursuant to its power under the Commerce Clause. But Congress may not invoke the commerce power to do what the Intellectual Property Clause bars it from doing: granting "exclusive Right[s]" in uncopyrightable subject matter. To be sure, the commerce power is plenary, but only up to a certain point. The commerce power may not be exercised such that other, more specific constitutional constraints are ignored. Congress cannot avoid the originality requirement of the Intellectual Property Clause by relying on the general powers of the Commerce Clause.

Indeed, the Intellectual Property Clause constitutes not only a grant of power to Congress but also a limitation on Congress. Cf. *Bonito Boat*, 489 U.S. at 146 (1989) (discussing scope of federal preemption of state intellectual property law and stating that "[a]s we have noted in the past, the [Intellectual Property] Clause contains both a grant of power and certain limitations upon the exercise of that power"); *Graham v. John Deere Co.*, 383 U.S. 1, 5-6 (1966) (explaining, again with reference to federal preemption of state law, that "[t]he clause is both a grant of power and a limitation. . . . Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available."); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964) (discussing scope of federal preemption of state law and explaining that "[t]o forbid copying [under state law] would interfere with the federal policy, found in [Article] I, [section] 8, [clause] 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal

patent and copyright laws leave in the public domain."). The Intellectual Property Clause precludes Congress from providing protection against the copying of facts, and Congress cannot use the Commerce Clause to avoid the implicit strictures of the Intellectual Property Clause, as interpreted by the Supreme Court in *Feist*. Congress's reliance on the commerce power would not obviate any of the constitutional problems concerning the exercise of congressional power under the Intellectual Property Clause. Of course, the reasoning of *Railway Labor* does not invalidate the CFAA per se; it just precludes its application to this case. In a case involving real hacking or damage to a computer system, the CFAA would protect interests different from those addressed by the Intellectual Property Clause, i.e., computer security. In this case however, the interests are identical -- the copying of facts.

III. THE DISTRICT COURT'S DECISION SIGNIFICANTLY UNDERMINES FIRST AMENDMENT GUARANTEES

The district court decision, by providing protection for uncopyrightable facts, also raises serious First Amendment concerns. It is well settled that copyright's abhorrence of protection for facts has a clear First Amendment dimension. As the Supreme Court stated in *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 582 (1985): Our profound national commitment to the principle that debate on public issues should be uninhibited, robust, and wide-open leaves no room for a statutory monopoly over information and ideas. The arena of public debate would be quiet, indeed, if a politician could copyright his speeches or a philosopher his treatises and thus obtain a monopoly of the ideas they contain. A broad dissemination of principles, ideas, and factual information is crucial to the robust public debate and informed citizenry that are the essence of self-government. And every citizen must be permitted freely to marshal ideas and facts in the advocacy of particular political choices.

(Citations and quotation omitted.) Traditional copyright protection does not clash with the First Amendment because copyright protects the "expression" of information, rather than the information itself. The Court's holding in *Feist* that facts must be free is a corollary to the First Amendment doctrine that fosters a free marketplace of ideas. Indeed, one of the principal aims of the First Amendment is to "secure the 'widest possible dissemination of information from diverse and antagonistic sources.'" *New York Times Co. v. Sullivan*, 376 U.S. 254, 266 (1964) (quoting *Associated Press v. United States*, 326 U.S. 1, 20 (1945)). Were individuals and corporations capable of limiting access to facts otherwise available, the uninhibited, robust, and wide-open marketplace of expression would be harmed.

Here, the district court's decision undermines these basic First Amendment principles by impeding access to the facts contained in the WHOIS database. The First Amendment problem is particularly acute in this case because the preliminary injunction

restricts Verio from copying public domain facts whose free dissemination are constitutionally protected. Thus, the preliminary injunction - which limits Verio's ability to access, use, and disseminate uncopyrightable facts - is inconsistent with the First Amendment, which requires that facts remain open, accessible, and in the public domain.

IV. CONCLUSION

Technological innovation has forever changed the way people access information. Increasingly, the information available in the Digital Age involves computer databases. In the future, more facts will be available to the public only via the Internet. The district court's decision in this case would allow a database publisher unilaterally to restrict what others can do with these facts. This contravenes the nation's fundamental information policy: "all facts -- scientific, historical, biographical, and news of the day are part of the public domain available to every person." Feist, 499 U.S. at 348 (citations and quotations omitted). There should be no misunderstanding concerning what is at stake in this case. Even in the digital environment, copyright law permits users of publicly accessible online databases to utilize freely the raw factual data gleaned from the databases. Because the district court's decision undermines this fundamental guarantee, it must be reversed.

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Footnotes

2 More information about DFC can be found at www.DFC.org.

3 More information about ALA can be found at www.ala.org.

4 More information about ARL can be found at <http://arl.cni.org>.

5 More information about CCIA can be found at www.ccianet.org.

6 More information about MLA can be found at www.musiclibraryassoc.org.

7 More information about NWU can be found at www.nwu.org.

8 Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information after Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 339 (1992)

9 Amici in this brief take no position on whether personally identifiable information should be made publicly available through the WHOIS database, or whether any entity, including the domain name registrar, should be permitted to use registrants' information for any commercial purpose. This brief addresses only the narrow issue of whether a publisher of directory information on a publicly accessible website can unilaterally restrict the use of that information by means of a statement in a terms of service agreement.

10 In addition, *amici* disagree with the *ProCD* decision, which significantly expanded the enforceability of shrink-wrap contracts and constricted Section 301(a) preemption. Underlying the Seventh Circuit's analysis was the assumption that the extra element of bargain inherent in contract rights renders contract rights different from copyright rights. This reasoning does not withstand scrutiny in the mass-market shrink-wrap license context. As discussed below in greater detail, in a shrink-wrap license situation, the parties do not negotiate and come to an agreement on the terms of the contract limiting use rights. Rather, the licensor unilaterally imposes terms on the licensee. Allowing such a license to satisfy the extra element test constitutes a triumph of form over substance. *See* GOLDSTEIN ¶ 15.2.1 at 15:13 ("Courts applying the extra element test have consistently looked to the substance rather than the form of the state law claim at issue.") Section 301(a) would be rendered a nullity by publishers distributing all their products subject to shrink-wrap licenses. For criticism of *ProCD*'s Section 301(a) analysis, *see* DAVID NIMMER & MELVILLE B. NIMMER, NIMMER ON COPYRIGHT, ¶ 1.01[B][1][a] at 1-19 - 1-22 (2000).

11 Amici stress that under the typical shrink-wrap/click-on/browse-wrap arrangement, the user cannot access the content without doing whatever the license states is assent to its terms, *e.g.*, opening the package or going beyond the

home page. Moreover, the content often is not available elsewhere. (For instance, only Register.com has the information contained in the Register.com WHOIS database.) This means that users must "agree" to license terms which typically prohibit fair use copying, or the copying of material not protected by copyright, such as facts.

12 *Compare Novell, Inc. v. Network Trade Ctr., Inc.*, 187 F.R.D. 657 (D. Utah 1997); *Morgan Labs., Inc. v. Micro Data Base Sys., Inc.* 41 U.S.P.Q.2d 1850 (N.D. Cal. 1997); *Arizona Retail Sys., Inc. v. The Software Link, Inc.*, 831 F. Supp. 759, 764-66 (D. Ariz. 1993); *Step-Saver Data Sys. v. Wyse Tech.*, 939 F.2d 91, 98-100 (3d Cir. 1991); and *Foresight Resources Corp. v. Pfortmiller*, 719 F. Supp. 1006, 1010 (D. Kan. 1989); with *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447, 1449 (7th Cir. 1996); cf. *Hill v. Gateway 2000, Inc.*, 105 F.3d 1147, 1150 (7th Cir. 1997), *cert. denied.*, 522 U.S. 808 (1997).

13 *E.g.*, Michael J. Madison, "Legal Ware": *Contract and Copyright in the Digital Age*, 67 *FORDHAM L. REV.* 1025 (Dec. 1998); Robert J. Morrill, Comment, *Contract Formation and the Shrink Wrap License: A Case Comment on ProCD, Inc. v. Zeidenberg*, 32 *NEW ENG. L. REV.* 513, 537-50 (1998); Apik Minassian, *The Death of Copyright: Enforceability of Shrinkwrap Licensing Agreements*, 45 *UCLA L. REV.* 569 (1997); Jason Kuchmay, Note, *ProCD, Inc. v. Zeidenberg: Section 301 Copyright Preemption of Shrinkwrap Licenses - A Real Bargain for Consumers?*, 29 *U. TOL. L. REV.* 117 (1997); Kell Corrigan Mercer, Note, *Consumer Shrink-Wrap Licenses and Public Domain Materials: Copyright Preemption and Uniform Commercial Code Validity in ProCD v. Zeidenberg*, 30 *CREIGHTON L. REV.* 1287 (1997); Christopher L. Pitet, Comment, *The Problem With "Money Now, Terms Later": ProCD, Inc. v. Zeidenberg and the Enforceability of "Shrinkwrap" Software Licenses*, 31 *LOY. L.A. L. REV.* 325 (1997); Stephen P. Tarolli, Comment, *The Future of Information Commerce Under Contemporary Contract and Copyright Principles*, 46 *AM. U. L. REV.* 1639 (1997); Mark A. Lemley, *Intellectual Property and Shrinkwrap Licenses*, 68 *S. CAL. L. REV.* 1239 (1995), *supra* note 10, at 1248-59; L. Ray Patterson & Stanley W. Lindberg, *The Nature of Copyright: A Law of Users' Rights*, 220 (1991).

14 Register.com might argue that the terms of service agreement does not prohibit the *copying* of the information, but just certain uses of the information, thus escaping preemption. This is a distinction without a difference. As the quoted passage from *Feist* indicates, the Constitution requires "that much of the fruit of the compiler's labor may be *used* by others without compensation" (Emphasis supplied.) For the Constitution to preempt a restriction on the copying of facts, but not on the use of those facts, would defeat the Constitution's clear objective of a federal intellectual property system. It would be akin to permitting a student to photocopy a page from an encyclopedia under the fair use

doctrine, 17 U.S.C. §107, but then prohibiting the student from reading the photocopy. The right to use a fact is implicit in the right to copy and distribute it.

15 Mark A. Lemley, *Beyond Preemption: The Law and Policy of Intellectual Property*, 87 CALIF. L. REV. 111 (1999); Maureen A. O'Rourke, *Rethinking Remedies at the Intersection of Intellectual Property and Contract: Toward a Unified Body of Law*, 82 IOWA L. REV. 1137 (1997).

16 Julie Cohen, *Copyright and the Jurisprudence of Self-Help*, 13 BERKELEY TECH. L.J. 1089, 1131-32 (1998).

17 Yochai Benkler, *Constitutional Bounds of Database Protection: The Role of Judicial Review in the Creation and Definition of Private Rights in Information*, 15 BERKELEY TECH. L.J. 535 (2000); *Collections of Information Antipiracy Act, H.R. 2652, Hearing Before the Subcomm. on Courts and Intellectual Property of the Comm. on the Judiciary, 105th Cong.* 28-31 (1998) (statement of dissenting views of Rep. Zoe Lofgren, Member, House Comm. on the Judiciary)

18 Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause and the First Amendment*, 17 CARDOZO ARTS & ENT. L.J. 47 (1999).

19 See Philip H. Miller, *Life After Feist: The First Amendment, and the Copyright Status of Automated Databases*, 60 FORDHAM L. REV. 507, 507 (1991); See Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1591-95, 1601-06 (1993); Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information after Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 340 (1992); Rochelle C. Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397 (1990); Michael J. Haungs, *Copyright of Factual Compilations: Public Policy and the First Amendment*, 23 COLUM. J.L. & SOC. PROBS. 347, 364 (1990); Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CAL. L. REV. 283 (1979) and Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983 (1970).

20 See *Feist*, 499 U.S. at 344-45 ("The most fundamental axiom of copyright law is that '[n]o author may copyright his ideas or the facts he narrates.'") (citation omitted); *Harper & Row v. Nation Enterprises*, 471 U.S. 539 (1985) (stressing First Amendment interest in unrestricted availability of facts); *Financial Information, Inc. v. Moody's Investors Service, Inc.*, 808 F.2d 204, 207 (2d Cir.1986) (stressing "risk [of] putting large areas of factual research material off limits and threaten[ing] the Public's unrestrained access to information").

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