No. 04-3654

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# In The
# United States Court of Appeals
# For The Eighth Circuit

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**DAVIDSON & ASSOCIATES, INC., ET AL.,**
***Plaintiffs-Appellees,***

**v.**

**INTERNET GATEWAY, ET AL.,**
***Defendants-Appellants.***

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Appeal from the United States District Court
for the Eastern District of Missouri
(No. 4:02-CV-498 CAS)

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## BRIEF OF *AMICI CURIAE* COMPUTER & COMMUNICATIONS INDUSTRY ASSOCIATION AND OPEN SOURCE & INDUSTRY ALLIANCE IN SUPPORT OF INTERNET GATEWAY, ET AL. AND URGING REVERSAL

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January 24, 2005

# CORPORATE DISCLOSURE STATEMENT

1. Pursuant to Federal Rule of Appellate Procedure 26.1 and Eighth Circuit Rule 26.1A, *amicus curiae* Computer & Communications Industry Association ("CCIA") states that it is a non-profit trade association and as such has no parent corporation nor any issued stock or partnership shares.

2. Pursuant to Federal Rule of Appellate Procedure 26.1 and Eighth Circuit Rule 26.1A, *amicus curiae* Open Source & Industry Alliance ("OSAIA") states that it is a non-profit trade association which is a fully independent subsidiary of CCIA. OSAIA has no issued stock or partnership shares.

/s/ Jonathan Band
Jonathan Band
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Date: January 24, 2005

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## INTEREST OF AMICI

Computer & Communications Industry Association (CCIA) members participate in many sectors of the computer and telecommunications industry and range in size from small entrepreneurial firms to the largest in the industry.[1] CCIA members believe that computer programs deserve effective intellectual property protection to give developers sufficient incentive to create new programs. At the same time, CCIA is concerned that improper extension of intellectual property law will impede innovation and inhibit fair competition in the computer industry.

CCIA has long supported interpreting the intellectual property laws to permit the development of interoperable products. CCIA filed an *amicus* brief with the U.S. Court of Appeals for the Ninth Circuit in *Sega Enterprises, Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1992), which held that the reverse engineering technique known as disassembly was a fair use as a matter of law when it was the only way to obtain functional elements such as the information necessary for achieving interoperability. CCIA also filed an *amicus* brief with that court in *Sony Computer Entertainment, Inc. v. Connectix Corp.*, 203 F.3d 596 (9th Cir.), *cert. denied*, 531 U.S. 831 (2000), which affirmed its earlier holding in *Sega*. Additionally, when Congress was considering the Digital Millennium Copyright

[1] CCIA's current roster of members is available at www.ccianet.org/modules.php?op=modload&name=Members_List&file=index

Act (DMCA), CCIA advocated the inclusion of an exception permitting circumvention of technological protection measures for the purpose of achieving interoperability. Finally, CCIA filed *amicus* briefs in *Chamberlain Group, Inc. v. Skylink Technologies., Inc.*, 381 F.3d 1178 (Fed. Cir. 2004) and *Lexmark International, Inc. v. Static Control Components, Inc.*, 387 F.3d 522 (6th Cir. 2004), arguing that the DMCA's interoperability exception, 17 U.S.C. § 1201(f), permitted the circumvention at issue in both cases.

Open Source & Industry Alliance (OSAIA) members are dedicated to the creation, use and sustainability of open source software.[2] OSAIA members believe that open source software fosters competition and expands user choice, which is vitally important to innovation. CCIA, OSAIA, and their members do not have a direct financial interest in the outcome of this litigation. However, in rejecting the application of the interoperability exception to Appellants' circumvention of Blizzard's technological protections for the purpose of developing a competing open source program, the district court improperly applied Section 1201(f). This improper application, if repeated by other courts, could have serious anticompetitive consequences for CCIA and OSAIA members and the information technology industry as a whole.

[2] OSAIA's current roster of members is available at www.osaia.org/members/OSAIAmembers.html

*Amici* respectfully submit that correctly understood, Section 1201(f) offers a defense to Blizzard's DMCA claims.

Filed concurrently with this brief, pursuant to Fed. R. App. P. 29(b), is a Motion for Leave to File Brief of *Amici Curiae* CCIA and OSAIA in Support of Internet Gateway et al. and Urging Reversal.

## ARGUMENT

This case concerns computer games. But computer games are computer programs, and the interoperability and DMCA issues here are no different from those that arise with software that perform critical business and governmental functions.

In this case, Blizzard attempts to use Section 1201 of the DMCA to thwart competition between its Battle.net online gaming service and Appellants' open source bnetd project. Blizzard argues that in order to permit Blizzard games to interact with the bnetd program, Appellants programmed the bnetd program to circumvent a technological protection measure in the Blizzard games that allowed Blizzard game owners to access their games' Battle.net mode only in conjunction with the Blizzard Battle.net server. Blizzard asserts that by developing, operating, and distributing the bnetd program, Appellants violated 17 U.S.C. §§ 1201(a)(1) and (2).

Congress anticipated that companies would attempt to employ the DMCA in the anticompetitive manner that Blizzard proposes. Accordingly, Congress crafted an exception in Section 1201(f) for the express purpose of permitting the circumvention necessary to achieve interoperability between two software components. The district court rejected the defense on the grounds that "defendants' actions extended into the realm of copyright infringement ...." *Davidson & Assocs., v. Internet Gateway, Inc.*, 334 F. Supp. 2d 1164, 1185 (E.D. Mo. 2004). However, the district court failed to identify any infringing acts by the Appellants.

Moreover, the district court stated that the bnetd program was not "an independently created computer program" eligible for the Section 1201(f) defense because it "was intended as a functional alternative to the Battle.net service." *Id.* at 32. The district court erred in finding that the bnetd program was not an independently created computer program simply because it served as a functional alternative to Battle.net.

This brief first addresses the importance of interoperability to the computer industry. It then explains how jurisdictions throughout the United States and around the world have specifically permitted reverse engineering, a process essential to the development of interoperable products. Next, the brief discusses the Section 1201(f) exception inserted by Congress into the DMCA to promote

interoperability. Finally, the brief demonstrates that the district court misapplied Section 1201(f) to the facts of this case.

CCIA and OSAIA appreciate that Blizzard is concerned that the bnetd program, by bypassing the CD Key authentication system in Blizzard games, might encourage the infringement of Blizzard games by providing a forum for gamers with infringing games to play in the Battle.net mode. But from a policy perspective, this risk of infringement must be weighed against the social utility of providing competitive choices to owners of legitimate copies of Blizzard games. As the district court found, Appellants created the bnetd program out of frustration with the Battle.net server, including its insufficient capacity and the presence of cheating gamers, user profanity, and advertising. Section 1201(f) reflects the balance Congress struck between the risk of infringement and the value of interoperability. The district court's decision upset this balance, which should be restored by this Court.

## I. INTEROPERABILITY IS CRITICAL TO COMPETITION AND INNOVATION IN THE COMPUTER INDUSTRY

In most copyright industries, there is little relation between intellectual property protection and competition. A legitimate film producer, for example, has no justification and little motivation for copying from another film (except in certain special cases, such as parody).

Computer products, however, are different. Unlike a film or novel, which stands by itself, a computer product can function only in conjunction with hardware and other software. For example, an application program, such as a word processor, must work together with an operating system in order to perform its task; otherwise, it is a useless set of magnetic impulses. Two computer products can work together—*interoperate*—only if they conform to the same set of rules, or *interface specifications*.

If a company could exercise proprietary control over the interface specifications implemented by its products, that company could determine which products made by other firms – if any – could interoperate with its software. And should that company have a dominant position in a particular market, it could use its control over interoperability to expand its dominant position into adjacent markets.[3] Moreover, such authority would extend the rights under copyright beyond what is necessary to protect the original expressive elements that have traditionally been offered protection under American copyright law, and it would override limitations on copyright crafted to protect the public good.

[3] Dan L. Burk, *Anticircumvention Misuse*, 50 UCLA L. Rev. 1095, 1113, 1133 (2003).

Such a broad monopoly would have serious implications for consumer welfare.[4] In the absence of competition during the effective lifespan of the product, the first developer would have little incentive to develop more innovative and less costly products. These negative consequences would be compounded by the fact that the personal computer revolution and the emergence of the Internet have produced an overwhelming need for interconnection between different elements of computer systems. Within a given large corporation, literally thousands of personal computers and workstations scattered across the globe need to interact with each other and with the company's mainframes. Moreover, with the advent of the Internet, users around the world need to exchange vast quantities of data through their computers.[5] Prohibiting competitors from accessing the *de facto* standard interface specifications would lock users into a particular operating system or network software environment, and would inhibit the transfer of data between users with different computing environments. *See Lotus Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 807, 821 (1st Cir. 1995), *aff'd by an equally divided Court*, 516 U.S. 233 (1996)(J. Boudin, concurring).

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[4] *See, e.g.*, Peter S. Menell, *An Analysis of the Scope of Copyright Protection for Application Programs*, 41 Stan. L. Rev. 1045, 1082, 1097 n.281 (1989).

[5] *See* President's Information Infrastructure Task Force, *Global Information Infrastructure: Agenda for Cooperation* (U.S. Government Printing Office, Washington, D.C., Feb. 1995) at 14-16.

It should be stressed that interoperable products often are *not* mere "clones" that offer only the same functionality as the products of the first comer, but at a lower price. Even interoperable products that offer similar functionality as the original product typically offer additional features not found in the first comer's products. Thus, they compete with the first comer's products not only in terms of price (indeed, sometimes the interoperable products may be more expensive), but also in terms of innovation. Furthermore, many products that interoperate with other computer products do not mimic the functionality of the original product at all, but fulfill entirely different purposes or needs. In many cases – such as with a computer operating system and applications – these new products rely on the underlying program as a platform. In these respects, interoperable developers' use of preexisting interface specifications is a transformative use of the sort accredited by the Supreme Court in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

In short, in the computer industry, overly broad intellectual property protection directly restricts competition and innovation. For this reason, U.S. courts in recent years have held that interface specifications fall on the idea (or unprotected) side of copyright's idea/expression dichotomy.[6] Significantly, the U.S. government took this position in its case against Microsoft.[7]

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[6] *See, e.g.*, *Computer Assocs. Int'l v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992); *Sega*, 977 F.2d at 1524-25; *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 807 (1st Cir. 1995), *aff'd by an equally divided Court*, 516 U.S. 233 (1996); *Mitel, Inc.*

But even though the interface specifications are not protected by copyright, a company seeking to interoperate must still learn what those interface specifications are. Because computer programs typically are distributed to the public in a form readable only by computers, a program's interface specifications usually are not readily apparent. In some instances, the developer of the program may be willing to provide the interface information to other companies. All too often, however, developers are not willing to provide the information, or the information they provide is tardy or incomplete.[8]

In these cases, the companies seeking to develop interoperable products have no choice but to perform painstaking research on the original program to discern the interface specifications. This research, known as *reverse engineering*, is a

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*v. Iqtel, Inc.*, 124 F.3d 1366 (10th Cir. 1997); *Lexmark Int'l, Inc. v. Static Control Components Inc.*, 387 F.3d 522, 536 (6th Cir. 2004); Jonathan Band & Masanobu Katoh, *Interfaces on Trial*, 131-146 (1995); 1 Paul Goldstein, *Copyright* § 2.15.2.1-2.15.2.2 (2d ed. 1998).

[7] Jonathan Band & Taro Isshiki, *Peace at Last? Executive and Legislative Branch Endorsement of Recent Software Copyright Case Law*, Computer Lawyer, Feb. 1999 at 1. Additionally, the D.C. Circuit condemned in harsh terms Microsoft's attempt to justify anticompetitive actions by asserting its right to use its intellectual property as it saw fit, so long as those rights were lawfully obtained. *United States v. Microsoft Corp.*, 253 F.3d 34, 63 (D.C. Cir. 2001)(*per curiam*) ("That is no more correct than the proposition that use of one's personal property, such as a baseball bat, cannot give rise to tort liability.")

[8] Jeanette Bozo, *Bristol Has June 1 Date for Microsoft Lawsuit*, InfoWorld Daily News, Jan. 4, 1999; Richard Wolffe, *FTC says Intel Lawsuit 'Vital to Stop Abuse'*, Financial Post, June 18, 1998, at 19.

basic tool of software product development. Without reverse engineering, interoperability can be difficult, if not impossible, to achieve.

## II. JURISDICTIONS THROUGHOUT THE WORLD HAVE ADOPTED EXCEPTIONS PERMITTING SOFTWARE REVERSE ENGINEERING

The U.S. Supreme Court has long recognized that there is nothing inherently wrong with studying a competitor's product to understand how it works and to figure out how to make a better product. Thus, in *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 476 (1974), the Court stated that "trade secret law … does not offer protection against discovery by fair and honest means, such as … by so-called reverse engineering, that is by starting with a known product and working backward to divine the process which aided in its development or manufacture."

The Court has also recognized the benefits of reverse engineering: "Reverse engineering … often leads to significant advances in technology." *Bonito Boats, Inc., v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 160 (1989). Further, the Court has noted that "the competitive reality of reverse engineering may act as a spur to the inventor, creating an incentive to develop inventions that meet the rigorous requirements of patentability." *Id.*

Copyright law, however, has the potential of raising obstacles to software reverse engineering. Because of the nature of computer technology, software reverse engineering almost always requires the making of a reproduction or

derivative work. For example, the reverse engineering method known as *disassembly* involves "translating" the publicly distributed, computer readable program into a higher level, human readable form. In another method referred to as *black box reverse engineering*, an engineer observes a program's behavior and interaction with its environment while executing the program on a computer.[9] The computer automatically copies the program into the computer's random access memory (RAM) in order to run it.

Since the Ninth Circuit's 1992 decision in *Sega v. Accolade*, no less than five U.S. courts have permitted reproduction during the course of software reverse engineering under the "fair use doctrine."[10] Other courts have prevented enforcement under a copyright misuse theory.[11]

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[9] Engineers refer to this method as black box reverse engineering because the externally visible characteristics of the program are observed without looking into the program itself; the actual contents of the program remain unknown.

[10] *Atari Games Corp. v. Nintendo of America, Inc.*, 975 F.2d 832 (Fed. Cir. 1992); *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532 (11th Cir. 1996); *DSC Communications Corp. v. DGI Techs.*, 898 F. Supp. 1183 (N.D. Tex. 1995), *aff'd*, 81 F.3d 597 (5th Cir. 1996); *DSC Communications Corp. v. Pulse Communications, Inc.*, 976 F. Supp. 359 (E.D. Va. 1997), *aff'd in part, rev'd in part, and vacated in part*, 170 F.3d 1354 (Fed. Cir. 1999); *Sony Computer Entm't, Inc. v. Connectix Corp.*, 203 F.3d 596 (9th Cir.), *cert. denied*, 531 U.S. 871 (2000).

[11] *DSC Communications Corp. v. DGI Techs.*, 81 F.3d 597 (5th Cir. 1996); *Alcatel U.S.A., Inc. v. DGI Techs.*, 166 F.3d 772 (5th Cir. 1999).

Similarly, the 1991 European Union Software Directive contains a specific exception for software reverse engineering.[12] The Directive has been implemented by all the member states of the European Union, including the newest members in Eastern and Central Europe.[13] Thus, both the United States and the European Union have recognized the central role reverse engineering plays in maintaining legitimate competition in the computer industry.

Pacific Rim countries share this recognition. Australia, Hong Kong, Singapore, Korea, and the Philippines have all amended their copyright laws to permit software reverse engineering.[14]

## III. SECTION 1201(f) OF THE DMCA PERMITS CIRCUMVENTION FOR THE PURPOSE OF ACHIEVING INTEROPERABILITY

Section 1201 of the DMCA, passed by Congress in October, 1998, implements the provisions of the World Intellectual Property Organization Internet Treaties relating to technological protection measures. Specifically, Section 1201 restricts the development, distribution, and use of technologies that circumvent other technologies that protect an author's copyrights. While the DMCA was

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[12] Council Directive 91/250/EEC on the Legal Protection of Software Programs, Articles 5 and 6 (May 14, 1991), O.J. No. L122/42,44 (May 17, 1991) (hereinafter "EU Software Directive").

[13] *See Interfaces on Trial*, *supra* note 4, at 258-62.

[14] Ord. No. 92 of 1997 (H.K.); Copyright (Amendment) Bill of 1998 (Sing.); Republic Act 8293 of 1996 (Phil.); Copyright Amendment (Computer Programs) Bill of 1999 (Austl.); Act No. 6357, Jan. 16, 2001 (Korea).

pending before Congress, developers of interoperable computer products, including CCIA, explained to Congress that the act of reverse engineering – the uncovering of the interface specifications – could require the circumvention of a technological protection measure. Moreover, the incorporation of these specifications in competitive products could run afoul of the DMCA's prohibition on the manufacture and distribution of circumvention technologies. This would particularly be the case when a company placed a software "lock" on a program that prevented access to the program, and the competitor circumvented that software lock to achieve interoperability. Thus, Section 1201 could prevent a developer of interoperable products from exercising his fair use privileges recognized in *Sega* and its progeny.

Accordingly, Congress created an exception to Section 1201 explicitly directed at the development of interoperable products. Section 1201(f) allows software developers to circumvent technological protection measures in a lawfully obtained computer program in order to identify the elements necessary to achieve interoperability of an independently created computer program with other programs. A person may engage in this circumvention only if the elements necessary to achieve interoperability are not readily available and the reverse engineering is otherwise permitted under the copyright law.[15] Furthermore, a

[15] 17 U.S.C. § 1201(f)(1).

person may develop, distribute, and employ the means to circumvent technological protection measures for the purpose of achieving interoperability.[16] Section 1201(f), therefore, provides a complete defense to Section 1201 liability to qualifying developers of interoperable products. It also provides a defense to users of these products.[17]

The Senate Judiciary Committee report on the DMCA explains the policy underlying Section 1201(f). It states that this exception was "intended to allow legitimate software developers to continue engaging in certain activities for the purpose of achieving interoperability to the extent permitted by law prior to the enactment of this chapter."[18] The Committee evidently understood that if a company placed on its program a technological measure that prevented interoperability, a legal prohibition on circumventing that technological protection could preclude other companies from developing products capable of operating in that company's computing environment. Citing *Sega*, the Committee states that "[t]he objective is to ensure that the effect of current case law interpreting the Copyright Act is not changed by enactment of this legislation for certain acts of

[16] 17 U.S.C. § 1201(f)(2) and (3).

[17] Section 1201(f) provides an exception to all the prohibitions of Section 1201: Section 1201(a)(1)'s prohibition on the circumvention of access controls, Section 1201(a)(2)'s prohibition on the manufacture and distribution of devices which circumvent access controls, and Section 1201(b)'s prohibition on the manufacture and distribution of devices which circumvent copy controls.

identification and analysis done in respect of computer programs."[19] The Committee concludes by noting that "[t]he purpose of this section is to foster competition and innovation in the computer and software industry."[20]

The Copyright Office recently affirmed that Section 1201(f)(3) permits software developers to provide consumers with the means of circumventing technological protection measures for the purpose of achieving software interoperability. While *Lexmark v. Static Control Components* was pending before the Sixth Circuit, Static Control Components (SCC) requested the Librarian of Congress to grant an exemption from Section 1201(a)(1) pursuant to the triennial rulemaking procedure established by Section 1201(a)(1)(C) and (D). Specifically, SCC asked for an exemption that would permit two embedded programs to interoperate so that the hardware in which they are embedded can interoperate.[21]

The Copyright Office concluded that an exemption was not necessary; Section 1201(f)(3) permitted the incorporation of interface information in products for the purpose of achieving interoperability. Not only does Section 1201(f) permit

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[18] S. Rep. No. 105-190, at 32 (1998).

[19] *Id.*

[20] *Id.*

[21] Recommendation of the Register of Copyrights, Rulemaking on Exemptions from Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies, at 172 (Docket No. RM 2002-4, Oct. 27, 2003), *available at* http://www.copyright.gov/1201/docs/registers-recommendation.pdf.

achieving interoperability by the reverse engineer, the Office determined, but Section 1201(f) also has the effect of "enabling competitive choices in the marketplace."[22]

The Office observed that SCC's "goal was not merely to privately circumvent, but rather to facilitate the distribution of competitive toner cartridges to others"[23] – a goal embraced by 1201(f)(3):

> 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....[24]

Thus, the Copyright Office determined that Congress "comprehensively addressed the important concern of interoperability for competition and functionality,"[25] and therefore no exemption was necessary.

Acting upon the Office's recommendations, the Librarian of Congress declined to establish an exemption for remanufacturers seeking to achieve interoperability, because the "existing exemption in section 1201(f) addresses the

[22] *Id.* at 178.

[23] *Id.* at 180-81.

[24] *Id.* at 181.

[25] *Id.* at 183.

concerns of remanufacturers, making an exemption under section 1201(a)(1)(D) unnecessary."[26]

This past October, the Sixth Circuit reversed the lower court's issuance of a preliminary injunction in *Lexmark v. Static Control Components*. The Sixth Circuit found that Lexmark was unlikely to prevail on its DMCA claim because Lexmark did not employ technological protection measures that effectively controlled all forms of access to its Printer Engine Program. Additionally, the Sixth Circuit addressed SCC's Section 1201(f)(3) defense because it could become relevant at the permanent injunction phase of the case. The Sixth Circuit disagreed with the lower court's conclusion that the defense did not apply. Specifically, the Sixth Circuit found evidence in the record that SCC's chips contained independently created programs. Further, the court rejected Lexmark's argument that the independently created programs had to exist prior to the reverse engineering necessary to achieving interoperability. *Lexmark*, 387 F.3d 522, at 550-551.

[26] Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies, 68 Fed. Reg. 62,011, at 62,017 (Oct. 31, 2003).

## IV. THE DISTRICT COURT ERRED IN REJECTING THE SECTION 1201(f) DEFENSE.

Just as the SCC chip allows owners of Lexmark printers to circumvent the technological protection in the Printer Engine Program so that the printer owners can use competing toner cartridges instead of Lexmark cartridges, so too the bnetd program allows owners of Blizzard games to circumvent the technological protection in the games so that the gamers can play their games in the Battle.net mode on a bnetd server rather than the Battle.net server. The development and distribution of this circumvention technology in the bnetd program falls squarely within the Section 1201(f) exception. Nonetheless, the lower court rejected the application of the defense. Although the district court's reasoning is obscure, it appears to have offered three flawed justifications for this rejection.

### A. An Independently Created Computer Program Can Perform The Same Function As Another Program.

First, the district court stated that Appellants are not eligible for the 1201(f) safe harbor because the bnetd program is not an "independently created computer program." *Davidson & Assocs.*, 334 F. Supp. 2d at 1185. The district court observed that "the bnetd program was intended as a functional alternative to the Battle.net service. Once game play starts there are no differences between Battle.net and the bnetd emulator from the standpoint of a user who is actually playing the game." *Id*. In other words, the district court concluded that the bnetd

program is not "independently created" because it has the same functionality as Battle.net. The district court evidently believed that a program is independently created only if it is developed in a complete vacuum, without any reference to other programs.

The district court misconstrued the meaning of the term "independently created." Although Section 1201(f) does not define "independently created computer program," the context of its usage makes clear that it means a noninfringing program developed by an entity different from the entity that wrote the programs with which it seeks to interoperate. Both Sections 1201(f)(2) and (f)(3) provide that circumvention is permitted "for the purpose of enabling interoperability of an independently created computer program with other programs." This clause makes sense only if "independently created" means that the developer of that program were different from the developer of the "other programs." If the programs at issue were developed by the same entity or by business partners, any circumvention would be performed with authorization, rendering the exception unnecessary.

This interpretation is supported by the Sixth Circuit's decision in *Lexmark*. Lexmark argued that the interoperability exception applied only if the independently created program existed prior to the reverse engineering that enabled the interoperability. The Sixth Circuit dismissed this contention, holding

instead that the program could be developed after the reverse engineering and at the same time as the element that enabled the interoperability; the program "just must be 'independently' created." *Lexmark*, 387 F.3d at 551.

Interpreting "independently created" to mean 'created by a separate entity' is consistent with that term's usage in copyright jurisprudence. The term "independently created" has frequently been used to describe the 'origin' element of copyright's originality requirement. As the Supreme Court stated in its landmark opinion on the subject, "Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity." *Feist Publ'ns Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). *See also Applied Innovations, Inc. v. Regents of Univ. of Minnesota*, 876 F.2d 626, 635 (8th Cir. 1989)("The standard for 'originality' is minimal. It is not necessary that the work be novel or unique, but only that the work have its origin with the author -- that it be independently created. Little more is involved in this requirement than a 'prohibition of actual copying.'" (quoting *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219, 1223 (8th Cir. 1986)).[27]

[27] In the DMCA context, "the independently created program" typically is written by the *defendant* who allegedly circumvented a technological measure or trafficks in a circumvention technology. By contrast, in the traditional copyright context, independent creation usually refers to the *plaintiff's* authorship. Although in all contexts the "independently created" work must not infringe, in the DMCA

The "prohibition on actual copying" refers to the copying of protected expression, not unprotected elements. Thus, in the Section 1201(f) context, Nimmer observes that the "independently created computer program" should be "a new and original work, in that it may not infringe the original computer program." 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 12A.04[B][1] (Matthew Bender & Co. 2004). Here, the district court dismissed the copyright infringement claims with prejudice. In any event, a program would still be independently created if its developer copied only unprotected ideas, *e.g.*, the functionality, of another program, and performed all the detailed design and coding himself.

The notion that an "independently created" program can have the same functionality as a preexisting program is supported by both the legislative history and the Copyright Office's interpretation of Section 1201(f). As noted above, the Senate Judiciary Committee declared that "[t]he purpose of this section is to foster competition and innovation in the computer and software industry."[28] The Copyright Office similarly recognized that a goal of Section 1201(f) was "enabling

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context the essential characteristic of independent creation is that "independently created computer program" and the "other programs" have different sources, which gives rise to the need to achieve interoperability.

[28] S. Rep. No. 105-190, at 32 (1998).

competitive choices in the marketplace."[29] A competitive program by definition offers much of the same functionality as the program with which it competes; if it performed a different function, it would not be competitive.[30]

Denying the protection of the Section 1201(f) safe harbor to developers of functionally similar but expressively different programs would significantly limit the utility of Section 1201(f). It would also frustrate Congress' intent of fostering competition in the computer and software industries.

### B. Appellants Did Not Infringe Copyright.

The district court's second justification for rejecting the Section 1201(f) defense was its finding "that defendants' actions extended into the realm of copyright infringement...." The court explained that because the bnetd program does not determine whether a particular game's CD Key is valid, it permits infringing copies of Blizzard games to run on the bnetd program. Moreover, by

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[29] Recommendation of the Register of Copyrights, *supra* note 21, at 178.

[30] The term "independently created computer program," like much of the language of Section 1201(f), was derived from Article 6 of the EU Software Directive. *See* Jonathan Band and Taro Isshiki, *The New Anti-Circumvention Provisions of the Copyright Act: A Flawed First Step*, Cyberspace Lawyer (February 1999) at 4. Article 6 permits the reverse engineering technique decompilation for the purpose of achieving "the interoperability of an independently created computer program with other programs." EU Software Directive, *supra* note 12, art. 6(1). The independently created program could compete, *i.e.*, have the same functionality, as the target of the decompilation. *See Interfaces on Trial* at 239-40, 253-54. However, the independently created program could not be "substantially similar in its expression" to the target program. EU Software Directive art. 6(2)(c).

allowing free distribution of the program software, the Appellants foster the proliferation of servers on which infringing games can run.

The district court failed to recognize that Appellants aren't making the copies of the Blizzard games; the gamers are. Moreover, Appellants aren't contributing to this infringement; at most they provide another venue for the infringing copies to be used *after* the infringement has occurred.[31]

But even if Appellants were infringing or contributing to the infringement of Blizzard's copyright, that would not affect the availability of the Section 1201(f) defense with respect to bnetd. Under Sections 1201(f)(2) and (3), a person make develop, employ, and make available to others a technological means of circumventing a protection for purposes of achieving interoperability, so long as the development, employment, or distribution of the technology does not constitute infringement. There is no evidence that the bnetd program itself infringes any Blizzard copyright. To be sure, the district court opinion could be read to suggest that the program infringes Blizzard's copyright because it has the same functionality as Battle.net. But such a suggestion would be incorrect as a matter of copyright law. It is well established that a program's function falls on the idea side

[31] Even if the bnetd program did somehow contribute to infringement, such contribution would be excused pursuant to the Supreme Court's decision in *Sony Corp. of America v. Universal City Studios*, 464 U.S. 417, 442 (1984) because the program is capable of substantial noninfringing uses.

of the idea/expression dichotomy, and thus is unprotected by copyright.[32] The bnetd program could infringe the copyright in Battle.net only if it copied enough expressive elements of Battle.net so as to be substantially similar in expression, and the copying was not a privileged fair use. Accordingly, the district court wrongly concluded that Appellants' "actions extended into the realm of copyright infringement."[33]

### C. The Sole Purpose For Circumvention Was To Enable Interoperability.

The district court's third justification for rejecting the 1201(f) defense was that "the sole purpose of the bnetd program was not to enable interoperability." Rather, Appellants' "purpose in developing the bnetd server was to avoid the anticircumvention restrictions of the game and to avoid the restricted access to Battle.net." This reasoning is completely circular. By avoiding the anticircumvention restrictions of the game, the bnetd program afforded gamers

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[32] *Gates Rubber Co. v. Bando Chem. Indus.*, 9 F.3d 823, 836 (10th Cir. 1993) ("the main purpose or function of a program will always be an unprotectable idea"); *Sony Computer Entm't, Inc. v. Connectix Corp.*, 203 F.3d 596, 602-03 (9th Cir. 2000) ("object code of a program may be copyrighted as expression… but it also contains ideas and performs functions that are not entitled to copyright protection.")

[33] Nothing in Section 1201(f) suggests that a license prohibition on circumvention would prevent application of the Section 1201(f) defense. To the contrary, Section 1201(f) might well preempt any license prohibition on circumvention for the reasons set forth in Appellants' brief and the brief *amicus curiae* of the Institute of Electrical and Electronics Engineers.

another online gaming service with which they could interoperate. The circumvention enabled the interoperability, which is precisely the point of Section 1201(f).

## V. CONCLUSION

Interoperability is critical to competition in the information technology industry. In turn, reverse engineering and subsequent use of the interface specifications learned through reverse engineering are critical to achieving interoperability. Congress inserted Section 1201(f) into the DMCA to insure that the prohibition of circumvention of technological protection measures did not interfere with interoperability. In contrast to the court below, this Court should not interpret and apply the interoperability exception in a manner that frustrates Congress's intent. Therefore, CCIA and OSAIA respectfully request the Court to reverse the district court's decision.

Respectfully submitted,

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# CERTIFICATE OF COMPLIANCE

Pursuant to Fed. R. App. P. 32(a)(7)(B) and (C), and Eighth Cir. R. 28A(c), I hereby certify that this brief uses the proportionally-spaced 14-point typeface "Times New Roman," and therefore complies with Fed. R. App. P. 32(a)(5). This document was composed in Microsoft Word 2002 SP3.

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Pursuant to Eighth Cir. R. 28A(d), I certify that the 3.5" floppy diskette that is being filed concurrently with this brief contains the same document in a searchable *.pdf format, and is virus free.

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Matthew Schruers

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