

CAHILL GORDON & REINDEL LLP  
EIGHTY PINE STREET  
NEW YORK, NY 10005-1702

FLOYD ABRAMS  
L. HOWARD ADAMS  
ROBERT A. ALESSI  
HELENE R. BANKS  
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JOEL H. LEVITIN  
GEOFFREY E. LIEBMANN

TELEPHONE: (212) 701-3000  
FACSIMILE: (212) 269-5420

1990 K STREET, N.W.  
WASHINGTON, DC 20006-1181  
(202) 862-8900  
FAX: (202) 862-8958

AUGUSTINE HOUSE  
6A AUSTIN FRIARS  
LONDON, ENGLAND EC2N 2HA  
(011) 44.20.7920.9800  
FAX: (011) 44.20.7920.9825

WRITER'S DIRECT NUMBER  
(212) 701-3621

MICHAEL MACRIS  
ANN S. MAKICH  
JONATHAN I. MARK  
BRIAN T. MARKLEY  
GERARD M. MEISTRELL  
WILLIAM J. MILLER  
ATHY A. MOBILIA  
NOAH B. NEWITZ  
MICHAEL J. OHLER  
DAVID R. OWEN  
JOHN PAPACHRISTOS  
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DEAN RINGEL  
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JONATHAN A. SCHAFFZIN  
JOHN SCHUSTER

MICHAEL A. SHERMAN  
DARREN SILVER  
HOWARD G. SLOANE  
SUSANNA M. SUH  
ANTHONY K. TAMA  
JONATHAN D. THIER  
JOHN A. TRIPODORO  
GLENN J. WALDRIP, JR.  
MICHAEL B. WEISS  
S. PENNY WINDLE  
COREY WRIGHT  
DANIEL J. ZUBKOFF  
ADAM ZUROFSKY

\*ADMITTED IN DC ONLY

November 7, 2011

Chairman Lamar Smith  
Ranking Member John Conyers  
Committee on the Judiciary  
United States House of Representatives  
2138 Rayburn House Office Building  
Washington, D.C. 20515

Re: Stop Online Piracy Act

Dear Chairman Smith and Ranking Member Conyers:

I write with regard to the Stop Online Piracy Act (H.R. 3261), which is currently under consideration by this Committee.<sup>1</sup> I represent the Directors Guild of America, the American Federation of Television and Radio Artists, the Screen Actors Guild, the International Alliance of Theatrical and Stage Employees, and the Motion Picture Association. I write to you at their request to offer my view that this legislation is consistent with the First Amendment and to set forth the basis for that conclusion.

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<sup>1</sup> I have previously written letters to the Senate Judiciary Committee regarding the Protect IP Act, on May 24, 2011, and the Combating Online Infringement and Counterfeits Act (COICA), which was reported out of the Judiciary Committee during the 111th Congress (S. 3804 (Reported in Senate)).

In this letter, I will summarize the provisions of the statute briefly and then turn to its constitutionality under the First Amendment. I think it useful, however, to begin with some observations about copyright law and the First Amendment in the age of the Internet.

I start with what should not be controversial. The Internet is one of the greatest tools of freedom in the history of the world. That is why, as Secretary of State Clinton has observed, there is an “urgent need” to protect freedom of expression on the Internet throughout the world. At the same time, however, she pointed out that “all societies recognize that freedom of expression has its limits,” observing specifically that those who use the Internet to “distribute stolen intellectual property cannot divorce their online actions from their real world identities” and that our ability to “safeguard billions of dollars in intellectual property [is] at stake if we cannot rely on the security of our information networks.”

It is no answer to this challenge to treat loose metaphors—the Internet as “the Wild West,” for example—as substitutes for serious legal analysis. It is one thing to say that the Internet must be free; it is something else to say that it must be lawless. Even the Wild West had sheriffs, and even those who use the Internet must obey duly adopted laws.

It is thus no surprise that libel law applies to material that appears on the Internet. *Milum v. Banks*, 642 S.E.2d 892 (Ga. Ct. App. 2007) (holding that defendant published libelous statements by posting them on his website) *cert. denied* (June 4, 2007). Or that libel precedents regarding printing information on paper are given comparable meaning as to information posted online. *Nationwide Bi-Weekly Administration, Inc. v. Belo Corp.*, 512 F.3d 137 (5th Cir. 2007) (holding that the “single publication rule” for the statute of limitations in libel suits applies to Internet publication). Or that principles of privacy law are applied to personal information posted online with the same animating principles that apply in more traditional media. *Yath v. Fairview Clinics, N.P.*, 767 N.W.2d 34 (Minn. Ct. Ap. 2009) (holding that posting information from a patient’s medical file on a social networking website constitutes the “publicity” element of invasion of privacy); *Benz v. Washington Newspaper Publishing Co.*, 2006 WL 2844896 (D.D.C. Sept. 29, 2006) (holding that false information posted on independent websites provided reasonable claim for defamation, invasion of privacy and false light against private party defendant, in addition to claims regarding publication of related information by a newspaper).

Copyright law is no different. It is not disputable that “[a]ll existing copyright protections are applicable to the Internet.” Edward H. Rosenthal, *J.D. Salinger and Other Reflections on Fair Use*, 1003 PLI/Pat 35, 42 (2010). See *Video Pipeline, Inc. v. Buena Vista Home Entertainment, Inc.*, 342 F.3d 191 (3d Cir. 2003) (upholding preliminary injunction against website compiling video clips of copyrighted movies for commercial use); *UMG Recordings, Inc. v. Stewart*, 461 F. Supp. 2d 837 (S.D. Ill. 2006) (finding *prima facie* case of liability in support of default judgment against Internet user who downloaded, reproduced and distributed copyrighted audio recordings online). The seizure provisions of copyright laws are applied to seize and stop the use of online property to facilitate infringement, such as domain names, just as offline property can be seized to stop its use to facilitate infringement. *United States v. The Following Domain Names: TVShack.net et al.*, 2010 WL

2666284 (S.D.N.Y. June 29, 2010) (treating domain names hosting infringing videos as forfeitable property under 18 U.S.C. §§ 2323(a) and ordering their seizure, locking domain names at registry level, replacing registrar information to identify the government as the domain names' owner, and compelling the registry to route traffic to the domain names to a government IP address notifying the public that the domain name was seized). While Congress has created safe harbors to accommodate the invention of online service providers, it has clearly declined to "simply rewrite copyright law for the on-line world." Copyright claims online are thus "generally evaluated just as they would be in the non-online world." *Ellison v. Robertson*, 357 F.3d 1072 (9th Cir. 2004) (internal quotations omitted).

Copyright law has existed throughout our Nation's history. The Constitution itself authorizes Congress to adopt copyright legislation (Art. I, Sec. 8, Clause 8) and the first such legislation was enacted in 1790, a year before the First Amendment was approved by Congress. Ch. 15, 1 Stat. 124 (1790) (repealed). From the start, injunctions were one form of relief accorded to victims of copyright infringement. (Courts applied the 1790 Act, and its later amendments, to grant injunctions "according to principles of equity." Act of Feb. 3, 1831, ch. 16, 4 Stat. at 438 (1831) (repealed 1870) (cited in Kristina Rosette, "Back to the Future: How Federal Courts Create a Federal Common Law Copyright Through Permanent Injunctions Protecting Future Works," 2 J. Intell. Prop. L. 325, 340 (1994)). However, since injunctions in non-copyright cases have frequently been held to be unconstitutional prior restraints on speech, *Near v. Minnesota*, 283 U.S. 697 (1931); *New York Times Co. v. United States*, 403 U.S. 713 (1971), and for other reasons, the subject has arisen as to the application, if any, of the First Amendment to copyright principles. See generally, Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 19 (2010).

The issue of whether and, if so, how certain elements of the Copyright Act should be read to accommodate various First Amendment interests remains open. The law could hardly be clearer, however, that injunctions are a longstanding, constitutionally sanctioned way to remedy and prevent copyright violations. Indeed, that premise was explicit in the critical concurring opinion in the Supreme Court's most famous prior restraint case, assessing publication of the Pentagon Papers, which noted that "no one denies that a newspaper can properly be enjoined from publishing the copyrighted works of another." *New York Times Co.*, 403 U.S. at 731 n.1 (White, J. and Stewart, J., concurring). Current treatises reflect this judicial consensus. "[C]ourts have found no constitutional obstacle to enjoining, pursuant to federal legislative mandate, the unlawful use of a registered trademark or copyright." Floyd Abrams & Gail Johnston, *Communications Law in the Digital Age 2010: Prior Restraints*, 1026 PLI/Pat 247, 261 (2010); James L. Oakes, *Copyrights and Copyremedies: Unfair Use and Injunctions*, 38 J. Copyright Soc'y 63, 71 (1990) ("A pirated or copied edition, record, movie, song or other work . . . cries out for an injunction").

The Supreme Court's most detailed treatment of the interrelationship between the First Amendment and copyright, the seminal case of *Harper & Row Publishers, Inc. v. Nation Enterpr.*, 471 U.S. 539, 560 (1985), stressed that far from conflicting with the First Amendment, the Copyright Act actually furthers the very interests which the First Amendment protects. "First Amendment protections," the Court noted, are "already embodied in the Copyright Act's distinctions

between copyrightable expression and uncopyrightable facts and ideas.” The Constitution supports the explicit protection of such expression and creativity, the Court stated, within a framework that defends *both* the right to speak *and* the ability to profit from speech. “[T]he Framers intended copyright itself to be the engine of free expression,” explained the Court, and “[b]y establishing a marketable right to the use of one’s expression, copyright supplies the economic incentive to create and disseminate ideas.” *Id.* at 558. Copyright law thus fortifies protections for speakers and creators, in a First Amendment context, while stimulating future creativity.

The evident constitutionality of injunctive relief for copyright violations does not mean, to be sure, that injunctions must automatically or always be issued in response to a copyright violation, nor that the seizure powers under the copyright law must be exercised without due regard to First Amendment considerations. Indeed, the Supreme Court has cautioned against the error of making a “categorical grant” of injunctive relief for patent infringement in *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 394 (2006), a proposition of law that the Second Circuit applied in a recent, celebrated copyright case, *Salinger v. Colting*, 607 F.3d 68 (2d Cir. 2010). What *no* court has ever denied, however, is that injunctions are a valuable and constitutional response to copyright violations.

### **Legislative Summary**

I turn to a discussion of the bill itself. The Stop Online Piracy Act is designed to enforce federal copyright and trademark law in the age of the Internet. Hearings before this Committee have powerfully revealed what Chairman Smith has aptly characterized as the “destructive effects of online ‘parasites’ -- web-based entities that steal intellectual property.” The Stop Online Piracy Act aims to combat the theft and infringement of American intellectual property, copyrights and trademarks, whether such activity originates within or beyond the United States.

The bill does so by strengthening the measures that the Attorney General and private parties may pursue, with court approval, to address infringing content. The bill buttresses injunctive relief previously available against infringing websites by providing a mechanism to compel operators of domain name lookup services, payment network providers, Internet advertising services, and search engines to cease supporting or cooperating with foreign infringing websites.

Attorney General Actions Against Foreign Infringing Sites

The Stop Online Piracy Act aims to counter the copyright infringement of “foreign infringing sites,” which it defines as sites that are (1) “committing or facilitating the commission of criminal violations” under current law,<sup>2</sup> (2) which would, based on those criminal violations, “be subject to seizure in the United States in an action brought by the Attorney General if such site were a domestic Internet site,” and (3) which are directed at the U.S. and used within the U.S.

For these foreign infringing sites, the bill authorizes the Attorney General to commence two types of actions. The Attorney General may commence an in personam action against the registrant of a domain name used by a foreign infringing site, or an owner or operator of a foreign infringing site. If such an individual cannot be located “through due diligence” by the Attorney General, then an in rem action may be commenced against the foreign infringing site or the foreign domain name used by such site.

Upon commencing one of these actions, the Attorney General shall send a notice of alleged violations and intent to proceed to the registrant of the domain name of the site, via both email and postal mail addresses listed in the applicable public registration database, and via both email and postal mail addresses of the registrar, registry or other domain name registration authorities that registered the domain name at issue (to the extent available). Likewise, the Attorney General shall send the same notice to the owner or operator of the site, via both email and postal mail, or, if there is no domain name, to the IP allocation entity, via both email and postal mail, as well as notice to the site’s owner or operator in any other form that a court “may provide,” including as may be required by Rule 4(f) of the Federal Rules of Civil Procedure.

Under the bill, courts “may” issue a temporary restraining order, a preliminary injunction or an injunction “in accordance with rule 65 of the Federal Rules of Civil Procedure,” against the site’s operator, a registrant of a domain name used by the site, the site itself, or a “specified portion” of the site, to order that it “cease and desist from undertaking any further activity as a foreign infringing site.”

By incorporating Rule 65, the bill applies the procedural protections that federal law currently affords all litigants in civil actions in the United States.

Under Rule 65, courts “may issue a preliminary injunction only on notice to the adverse party.” For temporary restraining orders to be issued without notice, Rule 65 requires that two

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<sup>2</sup> The enumerated laws are sections 2318, 2319, 2319A, 2319B, 2320 or chapter 90 of title 18 U.S.C (counterfeit labels, criminal infringement of copyright, trafficking in counterfeit goods or services, unauthorized recordings of motion pictures, unauthorized trafficking in sound recordings and music videos, and trade secrets).

conditions must be met. “[S]pecific facts in an affidavit or verified complaint [must] clearly show that immediate and irreparable injury, loss, or damage will result . . . before the adverse party can be heard in opposition.” And “the movant’s attorney [must] certif[y] in writing any efforts made to give notice and the reasons why it should not be required.” Hearings for orders without notice are to be held “at the earliest possible time, taking precedence over all other matters,” under Rule 65, and the adverse party may move to dissolve or modify an order on two days’ notice to the moving party. All these protections are incorporated into the legislation.

Pursuant to the Act, once court orders are issued, with “prior approval of the court,” a process server on behalf of the Attorney General may serve a copy of a court order on four types of entities that may be cooperating with the site question. First, service providers shall “prevent access” by its U.S. subscribers “to the foreign infringing site (or portion thereof) from resolving to that domain name’s [IP] address,” and may display a notice informing visitors that the operator is taking an action pursuant to a court order. The text of this notice is to be prescribed by the Attorney General, and specify that the action is being taken pursuant to a court order. Second, search engines<sup>3</sup> shall prevent the site, or a specified portion of the site, from being served as a direct hypertext link. Third, payment network providers shall prevent, prohibit or suspend payment transactions between U.S. customers, or customers subject to the jurisdiction of the U.S., and the site. Fourth, Internet advertising services shall prevent their networks from providing advertisements to the website named in the order.

Each of these entities are to take “technically feasible and reasonable measures” to comply within five days of receiving an order. In the case of service providers, the Stop Online Piracy Act states such providers “shall not be required” to modify their network or facilities to comply with such orders; nor to take “measures with respect to domain name resolutions not performed by its own domain name server”; nor to continue taking preventive actions under the order once access to the domain name has been “effectively disabled by other means.” The bill also notes that these enumerated protections do not “affect” or weaken the limitation on liability of such operators under section 512 of title 17 U.S.C.

The bill neither compels nor prohibits speech or communication by the four entities regarding any measures they take.<sup>4</sup> The entities may decide, at their discretion, “whether and how to communicate” their actions to users or customers.

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<sup>3</sup> The bill provides an original definition for Internet search engines. Previous Senate bills sought to regulate search engines with reference to the statutory term “Information Location Tools,” as defined in the Digital Millennium Copyright Act (DMCA) (section 512 of title 17 U.S.C.).

<sup>4</sup> The single possible exception to this description is the bill's provision that the Attorney General “shall prescribe the text of any notice displayed to users or customers of a service provider taking action pursuant to [the bill's remedies.]”

In the event of a willful and knowing failure to comply with orders under the bill, the Attorney General may seek injunctive relief directly against the entity in question. In such actions, technological inability to comply with the order “without incurring an unreasonable economic burden” shall serve as an affirmative defense. A showing that the order in question is not authorized under the Stop Online Piracy Act shall also serve as an affirmative defense. In addition, the bill does not limit or revoke current defenses to copyright infringement that may be offered, including but not limited to that of fair use. Entities taking actions reasonably designed to comply with court orders issued under bill are granted immunity from causes of action based on such compliance.

### Qualifying Plaintiff Actions Against Sites Dedicated to the Theft of U.S. Property

In addition to the Attorney General’s powers to pursue foreign infringing sites under the Stop Online Piracy Act, the bill also provides for a “market-based” system to address online infringement, including the establishment of a private right of action, in specified circumstances against sites “dedicated to the theft of U.S. property.”

Under this approach, the above remedies may be sought by qualifying plaintiffs through, first, a cooperative notification process, and second, in the event of noncompliance or dispute, by commencing an action against infringing sites and, with court approval, serving orders on payment network providers and Internet advertising services. This private right of action accorded to these third party entities is limited in scope. It does not provide for serving orders on service providers or search engines. The private right of action includes the same protections of Rule 65, the prioritization of in personam actions against U.S. individuals over in rem actions against domains, and the same requirements regarding notice, service of process and domain activity within the U.S.

This part of the Stop Online Piracy Act applies to sites, or specific portions of sites that are “dedicated to the theft of U.S. property” and directed towards the U.S., used by people in the U.S., and which are either (1) primarily designed or operated for the purpose of, or have only limited purposes other than, offering goods or services in violation of, or facilitating the violation of, current copyright or trademark law; or (2) the site operator is taking actions to “avoid confirming a high probability of the use of the site or portion thereof” is in violation of copyright and trademark law, or the individual operates the site or a portion thereof to promote its use to carry out violations of copyright and trademark law.

The qualifying plaintiffs are rights-holders of the intellectual property at issue. Before commencing any action in court, however, these plaintiffs must follow a formal notification process regarding any alleged sites dedicated to the theft of U.S. property. Plaintiffs must provide a written, signed communication to the designated agents of the two entities governed under this provision, financial service providers and Internet advertising services, which identifies the site and provides a statement and specific facts supporting the claim (under penalty of perjury), with facts establishing that the entity is servicing the site. Such a notification shall trigger private action remedies by the entity to cease their services for the site, unless the site owner or operator provides a counter-

notification to the entities disputing the claims, under penalty of perjury, and consenting to jurisdiction of U.S. courts.

In the event of a counter-notification or a failure by the entities to comply with the initial notification request, a qualifying plaintiff may commence an in personam action against the operator or owner of the site, or the registrant of the domain name. If a qualifying plaintiff, authorized under these conditions to bring such an in personam action, cannot “find a person” affiliated with the site to sue after due diligence, or no such person has an address in the U.S., the bill enables the plaintiff to commence an in rem action against the site or domain name. The plaintiff must give notice, via email and postal mail, to the registrant, the site owner or operator, or the IP allocation entity if there is no domain name, as well as any other form of notice that a court may prescribe, including as required by rule 4(f) of the Federal Rules of Civil Procedure. Then, in a companion structure to the Attorney General actions outlined above, a court may issue a temporary restraining order, preliminary injunction or injunction “in accordance with rule 65” against a registrant or site operator, and with prior approval of the court, such orders may be served on payment network providers and advertising services.

### **First Amendment Considerations**

Having discussed the broad constitutional and copyright framework for the Stop Online Piracy Act, and described what the bill does in basic terms, I now turn to two potential First Amendment issues in analyzing this legislation: the procedural protections in a First Amendment context, and issues related to potential overbreadth of the bill.

#### *Procedural Protections*

The Stop Online Piracy Act’s procedural protections are so strong, uniform and constitutionally rooted that it is no exaggeration to observe that complaints in this area seem not to really be with the bill, but with the Federal Rules of Civil Procedure itself, which govern all litigants in U.S. federal courts.

For potential suits by both the Attorney General and qualifying private party plaintiffs, the bill incorporates Rule 65 to provide the process governing how a judge “may” issue a temporary restraining order, preliminary injunction, or injunction. Thus website operators subject to the bill, including foreigners, would benefit from the same procedural safeguards afforded litigants in all other U.S. civil actions. For preliminary injunctions, those safeguards require notice in advance. For temporary restraining orders, the safeguards include first, the requirement that temporary restraining orders issued without notice must be based on specific facts showing the prospect of immediate and irreparable damage “*before* the adverse party can be heard in opposition” (emphasis added); and second, a written certification by the attorney (for the government or the plaintiff, depending on the action), explaining efforts made to give notice and the reasons it should not be required in this instance. Subsequent hearings for orders without notice are a first priority under Rule



65, which also grants the adverse party the option of moving to dissolve an order with two days' notice.

In addition to those well-established procedures, the bill requires several measures to ensure due process. First, the Attorney General or qualifying plaintiff must commence an in personam action against the registrant, owner or operator of a website dedicated to infringing activities, if it is possible to locate such an individual through due diligence. This approach, (which provides an additional step compared to the Senate's COICA legislation), may provide more warning and the prospect of adversarial hearings before injunctive relief -- at least in situations where such an individual resides in the U.S. and has provided accurate contact information. For in rem actions, the bill explicitly requires service of process by sending notice of the alleged violation and intent to proceed to the registrant, by email and postal mail listed in a public database, by email and postal mail of the registrar, as well as in any form a court finds necessary under Rule 4(f) of the FRCP. Consistent with the objectives of Rule 65, this requirement provides an opportunity to operators of allegedly infringing websites to defend themselves before an order is issued.

In the event that operators choose to respond later, or only learn of injunctive action later because they did not provide accurate contact information to their registry, they still retain their rights to seek later relief from the order by disputing the allegations or appealing to the interests of justice.<sup>5</sup> It is worth noting, in addition, that federal copyright law disfavors the submission of false contact information to a domain name registrar, treating the knowing provision of "materially false contact information to a domain name registrar" as a rebuttable presumption of willful infringement. 17 U.S.C.A § 504(c); *Chanel, Inc. v. Cui*, 2010 WL 2835749 (S.D.N.Y. July 7, 2010) (entering default judgment for permanent injunction against product trademark infringement and finding willful conduct based, in part, on defendant's repeated submissions of "false information in registering domain names" used for infringement). Finally, since the bill states that courts "may" issue preliminary injunctions or injunctions, the range of available remedies includes the prospect of a final—not preliminary—resolution of the dispute.

Even when the Stop Online Piracy Act's required procedural protections are satisfied, some operators of allegedly infringing websites may knowingly decline to participate in U.S. court proceedings. Such a choice, after legitimate notice and procedural safeguards are provided, may lead to *ex parte* proceedings and default judgments. Courts routinely enter default judgments in civil lawsuits, including comparable online copyright cases. After initial notice has been served, courts grant permanent injunctive relief for copyright violations in default judgments without additional attempts at notice. *Disney Enterprises, Inc. v. Farmer*, 427 F.Supp. 2d 807 (E.D. Tenn. 2006) (issu-

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<sup>5</sup> Each of these protections applies regardless of whether the Attorney General or a qualifying plaintiff commences an action. While the prospect of potential actions by private plaintiffs, which was not authorized by the COICA legislation, is one which raises significant policy issues, it does not fundamentally alter First Amendment and due process analysis in this area.

ing permanent injunction barring infringement of copyright by website distributing copyrighted movies over peer-to-peer network, with default judgment entitled without additional service of notice on defendant); *Priority Records, LLC v. Bradley*, 2007 WL 465754 (E.D. Mich. Feb. 8, 2007) (issuing permanent injunction in default judgment against defendant using online distribution system to download and distribute copyrighted recordings).

### *Breadth and Precedent*

It is a fundamental principle of First Amendment jurisprudence that government restrictions on speech should be narrowly tailored to avoid unnecessarily burdening protected speech. Courts closely scrutinize statutes that may hinder protected speech, and give special attention to rules that could sweep too broadly. As with any statute impacting speech, Congress must consider the potential overbreadth of the Stop Online Piracy Act's regulatory structure, both in how it is drafted and how it should be applied, in light of such First Amendment considerations.

Recent Senate bills in this area, COICA and the Protect IP Act, sought to address such First Amendment concerns, in part, by defining a statutory definition for the type of websites so predominantly engaged in infringement that orders to block, thwart or deter such activities would not have an excessive or unnecessary impact on protected speech.<sup>6</sup> As a trigger, the Protect IP Act effectively required that sites had no significant use other than infringement, or were designed, operated or marketed primarily for infringement. COICA provided a similar trigger in its definition for sites dedicated to infringing activity, and in addition, it provided an alternative definition based simply on the government's civil forfeiture powers under current law. Therefore, apart from any references to current law, both bills sought to define, in specific statutory language, something akin to a minimum threshold for triggering these new remedies to counter infringing sites.

The Stop Online Piracy Act does not articulate such a standard for actions by the Attorney General.<sup>7</sup> Instead, it cites to and is rooted in current copyright, trademark and seizure law,

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<sup>6</sup> The standard would be relatively new for a federal statute, although it is worth noting that the framework of sites "dedicated to infringing activities" was based on a precedent for online infringement liability in *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 936 (2005).

<sup>7</sup> The bill does define a term for sites "dedicated to theft of U.S. property" in its section on actions by qualifying plaintiffs, but my First Amendment analysis begins and focuses on the bill's earlier provisions regarding actions authorized only for the Attorney General, which reflect the strongest remedies provided for in the legislation.

similarly to the alternative definition in COICA, so as to extend the Attorney General's authority to foreign infringing sites and provide for remedies against third party intermediaries.<sup>8</sup>

The Stop Online Piracy Act uses three tests to define foreign infringing sites: First, the site must be committing or facilitating criminal violations of copyright or trademark law; second, those violations must "be subject to seizure" in the U.S. "if such a site were a domestic Internet site"; and third, the site (or portion thereof) must be directed at the U.S. and used within the U.S. The bill incorporates this seizure standard for definition purposes only -- it does not initiate the entire procedure of the forfeiture laws, nor does it trigger an actual forfeiture. Instead, as discussed above, the Stop Online Piracy Act enumerates its own set of procedures, consistent with Rule 65 and including enumerated notice requirements, and sets forth its own remedies against foreign infringing sites. Those remedies include injunctive relief ordering sites to cease violating the law, and serving orders, with court approval, on the four enumerated intermediaries. In contrast to the civil forfeiture procedures, these remedies are weighed under the traditional standards for injunctive relief.

In recent cases, courts have issued seizure warrants against domain names based on a probable cause finding of infringement, which can result in orders on registries to lock and seize domain names. *United States v. TVShack.net et al.*, 2010 WL 2666284 (S.D.N.Y. June 29, 2010) (treating domain names hosting infringing videos as forfeitable property under 18 U.S.C. §§ 2323(a) and ordering their seizure). There is a challenge to that domain name seizure process, on both statutory and First Amendment grounds, currently pending in the Second Circuit. In *Puerto 80 Projects v. United States*, the United States Southern District Court of New York rejected a challenge by operators of a Spanish website to the government seizure of its domain names, finding the loss of the domain names at issue did not constitute a substantial hardship under the law, but the court noted that First Amendment issues could still be argued on a future motion to dismiss.<sup>9</sup> (The Second Circuit is scheduled to hear argument in the case in December 2011.) If the Stop Online Piracy Act were adopted and courts ultimately alter, narrow or restrict the current application of the seizure standard to domain names, whether on First Amendment grounds or for other reasons, the Stop Online Piracy Act would incorporate the new standard. In other words, if the courts hold that the First Amendment demands a higher standard than is currently applied for seizure of domestic property implicating protected speech, the Stop Online Piracy Act would automatically import such a standard, given its definition trigger referencing sites "subject to seizure" in the U.S.

Regardless of the particular standard or definition of foreign infringing sites, court-approved remedies under the Stop Online Piracy Act may result in the blockage or disruption of

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<sup>8</sup> The definition refers to sites "committing or facilitating the commission of criminal violations" under current law, which would, based on those criminal violations, "be subject to seizure in the United States in an action brought by the Attorney General if such site were a domestic Internet site."

<sup>9</sup> No. 11 Civ. 4139 (S.D.N.Y. Aug. 4, 2011).

some protected speech. As discussed above, the bill provides a range of injunctive relief is available, with a court making the final determination as to whether and how to craft relief against a website operator or owner or third party intermediaries. When injunctive relief includes blocking domain names, the blockage of non-infringing or protected content may result. The presence of some non-infringing speech, in and of itself, generally does not provide a copyright violator with immunity from enforcement actions under current caselaw. The First Amendment allows government regulations to prevent piracy that has an incidental impact on non-infringing speech. *United States v. Elcom Ltd.*, 203 F. Supp. 2d 1111, 1129 (N.D. Cal. 2002) (noting that the First Amendment allows the government to pursue online infringement with an “incidental restriction” on First Amendment freedoms, so long as the traditional test is met that the “means chosen do not burden substantially more speech than is necessary to further the government’s legitimate interests”) (internal citations omitted). If an order under the bill does result in blocking some non-infringing content, the bill is sufficiently narrow to accommodate the immediate publication of that content elsewhere and the future publication of the content on the same domain. First, by definition, any non-infringing content is not specifically enjoined by the order, so it may still be legally posted anywhere else online. Second, such content may be unblocked or reposted *on the same* website or domain name in the future, once the infringing content at issue is removed. After the infringement issue is resolved and the site operator is in compliance with federal law, the domain name may post its archived non-infringing content.

Finally, it is worth noting that legislation in this area typically implicates linking, a key part of the Internet’s architecture, in two ways. Sites may facilitate infringement by linking alone, without directly hosting infringing content, and the Stop Online Piracy Act’s remedies include potential injunctions against linking by search engines, pursuant to a court order. These measures’ impact on linking are not overbroad, nor a break from precedent.

In recent enforcement actions against domain names, the U.S. Department of Homeland Security has seized “‘linking’ websites” which provided “links to files on third party websites that contain illegal copies of copyrighted content.” (Aff. ¶ 13) *United States v. The Following Domain Names: HQ-Streams.com et al.*, 2011 WL 320195 (S.D.N.Y. Jan 31, 2011). Targeting such linking is also consistent with caselaw regarding online copyright infringement, since “[l]inking to infringing material” can create secondary liability, 1003 PLI/Pat 35 at 43. Under current law, when a website links to infringing content, or links to technology to facilitate infringement, courts look to whether the website operator knowingly linked to facilitate violations of the law. *Universal City Studios, Inc. v. Reimerdes*, 111 F. Supp. 2d 294 (S.D.N.Y. 2000) (holding defendant violated DMCA by linking to program to unlock DVDs for unauthorized copying, and requiring knowing linking for the purpose of disseminating the program, and holding that prohibiting technology designed to circumvent protections for copyrighted works did not violate the First Amendment); *Bernstein v. JC Penney, Inc.*, 50 U.S.P.Q.2d 1063 (C.D. Cal. 1998) (plaintiff did not have a claim for mere linking to website without knowledge of infringing material on the site). With regard to potential injunctions against search engine linking -- a situation where there may be no knowledge element, and thus no secondary liability -- courts still retain the authority to issue injunctive relief specifically against linking, as a means to remedy ongoing or potential copyright infringement. *Universal City Studios,*

*Inc. v. Corley*, 273 F.3d 429 (2d Cir. 2001) (holding that injunctions issued against linking to thwart copyright infringement was consistent with the First Amendment). Even in cases that have narrowed injunctions against linking based on First Amendment violations regarding overbreadth, protected criticism and noncommercial speech, courts have still upheld injunctions tailored to protect intellectual property rights by banning commercial links. *Nissan Motor Co. v. Nissan Computer Corporation*, 378 F.3d 1002 (9th Cir. 2004) (holding injunction violated First Amendment “to the extent that it enjoins the placing of links [] to sites with disparaging comments” about plaintiff’s business, but upholding injunction compelling defendant to “refrain from displaying” links about the plaintiffs’ business on website with similar name, and holding trademark was infringed by certain links).

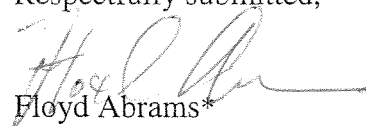
Given these precedents, actions against websites (or a portion thereof) committing violations by linking, not hosting, appear to rest on a solid constitutional foundation; potential injunctions against linking to such sites, pursuant to a court order, are consistent with courts’ current remedies for intellectual property violations online.

## Conclusion

Any legislative efforts to limit what appears on the Internet, or to punish those who post materials on it, requires the closest scrutiny to assure that First Amendment rights are not being compromised. That is true of all limits on speech, and it is no less true of the Internet. But the Internet neither creates nor exists in a law-free zone, and copyright violations on the Internet are no more protected than they are elsewhere.

The notion that adopting legislation to combat the theft of intellectual property on the Internet threatens freedom of expression and would facilitate, as one member of the House of Representatives recently put it, “the end of the Internet as we know it,” is thus insupportable. Copyright violations have never been protected by the First Amendment and have been routinely punished wherever they occur, including the Internet. This proposed legislation is not inconsistent with the First Amendment; it would protect creators of speech, as Congress has done since this Nation was founded, by combating its theft.

Respectfully submitted,

  
Floyd Abrams\*

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cc: Directors Guild of America  
American Federation of Television and Radio Artists  
Screen Actors Guild  
International Alliance of Theatrical and Stage Employees  
Motion Picture Association