IN THE COURT OF APPEALS
FIRST APPELLATE DISTRICT OF OHIO
HAMILTON COUNTY, OHIO

STATE OF OHIO,	:	APPEAL NO. C-090550 TRIAL NO. C-09CRB-18191
Plaintiff-Appellee,	:	*D E C I S I O N.*
vs.	:	
WALTER BOYD,	:	
Defendant-Appellant.	:	

Criminal Appeal From: Hamilton County Municipal Court

Judgment Appealed From Is: Reversed and Appellant Discharged

Date of Judgment Entry on Appeal: September 15, 2010

Joseph T. Deters, Hamilton County Prosecuting Attorney, and *Scott M. Heenan*, Assistant Prosecuting Attorney, for Plaintiff-Appellee,

Bruce K. Hust, for Defendant-Appellant.

Please note: This case has been removed from the accelerated calendar.

DINKELACKER, Judge.

{¶1} Defendant-appellant, Walter Boyd, was charged with record pirating under R.C. 1333.52 after a police officer discovered him selling bootleg pornographic DVDs on a street corner. He admitted to police that he had downloaded movies from the Internet and had "burned" them onto blank DVDs.

{¶2} Following a bench trial, he was convicted as charged and sentenced. He now appeals, presenting four assignments of error for review. In his first assignment of error, he contends that his conviction is contrary to law because federal law preempts his prosecution under Ohio's record-pirating statute. We agree.

I. The Record-Pirating Statute

{¶3} The record is unclear which subsection of the statute Boyd was convicted of violating. R.C. 1333.52(A) provides that "[n]o person shall purposely do either of the following: (1) Transcribe, without the consent of the owner, any sounds recorded on a phonograph record, disc, wire, tape, film, or other article on which sounds are recorded, with intent to sell or use for profit through public performance any product derived from the transcription. Each transcription of sound in violation of division (A)(1) of this section is a separate offense. (2) Advertise, offer for sale, any product knowing it to have been produced in violation of division (A)(1) of this section."

{¶4} R.C. 1333.52(B) provides that "[n]o person shall purposely manufacture, sell, or distribute for profit any phonograph record, tape, or album of phonographic records or tapes unless the record and the outside cover, box, or jacket of the record, tape, or album clearly and conspicuously discloses the name and street address of the manufacturer of the record, tape, or album, and the name of the performer or group

whose performance is recorded. Each manufacture, sale, or distribution of a different performance on a record, tape, or album in violation of this section is a separate offense."

{¶5} The Ohio General Assembly enacted this statute in 1976, approximately a year and one-half before the federal Copyright Act[1] took effect. We find no case law at all interpreting Ohio's record-pirating statute and no indication that it has ever been used in any prosecution.

II. Federal Copyright Act—Express Preemption

{¶6} The federal Copyright Act expressly preempts state-law actions.[2] The act states that "[o]n and after January 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of the copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright * * *, whether created before or after that date and where published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any state."[3]

{¶7} The act's preemption provisions are broad and absolute and are "stated in the most unequivocal language possible, so as to foreclose any conceivable misinterpretation of its unqualified intention that Congress shall act preemptively, and to avoid the development of any vague borderline areas between State and Federal protection."[4] Federal courts have repeatedly recognized that allowing state claims where

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[1] Section 101 et seq., Title 17, U.S.Code.
[2] *State v. Perry*, 83 Ohio St.3d 41, 42, 1998-Ohio-422, 697 N.E.2d 624; *State v. Moning*, 1st Dist. No. C-010315, 2002-Ohio-5097, ¶7.
[3] Section 301, Title 17, U.S.Code.
[4] *Perry*, supra, at 43, quoting Notes of the Committee on the Judiciary, H.R.Rep. No. 94-1476, U.S. Code Cong. & Adm. News (1976), 5659, 5746.

the core of the complaint centers on wrongful copying would render the act's preemption provisions useless.[5]

III. A Two-Part Test

{¶8} Our analysis under the Copyright Act's preemption provisions entails a two-part inquiry: "(1) whether a work is fixed in a tangible medium of expression within the subject matter of copyright and (2) whether the rights addressed are equivalent to the exclusive copyright rights set out in Section 106, Title 17, U.S.Code."[6]

A. Is the Work Subject to Copyright?

{¶9} As to the first inquiry, none of the parties claimed that the materials involved were not subject to copyright. Section 106, Title 17, U.S.Code, gives owners of copyrighted works exclusive rights to reproduce, prepare derivatives, perform, distribute, and display their work.[7] This court has stated that the Copyright Act confers on the owner of the copyright "certain exclusive rights and provides the *exclusive source for the protection of those rights*. Simply stated, the rights protected are reproduction, adaptation, public performance, public distribution and public display."[8]

B. An Extra Element?

{¶10} As to the second inquiry, a right is "equivalent to one of the rights comprised by a copyright if it 'is infringed by the mere act of reproduction, performance, distribution, or display.' "[9] "[T]o survive a preemption challenge based on equivalency

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[5] Id.
[6] Id.
[7] Id. at 42; *Moning*, supra, at ¶11.
[8] *Moning*, supra, at ¶9, quoting *Krapp v. McCarthy* (1997), 121 Ohio App.3d 64, 67, 698 N.E.2d 1049 (emphasis added).
[9] *Perry*, supra, at 42, citing *Baltimore Orioles, Inc. v. Major League Baseball Players Assn.* (C.A.7, 1986), 805 F.2d 663, 677; *Moning*, supra, at ¶11.

of protected rights, the state law claim must contain an extra element. * * * The extra element must not only distinguish the claim from a claim in copyright but also must change the state law claim so that it is '*qualitatively* different from a copyright infringement claim.' "[10]

{¶11} In *State v. Perry*, the Ohio Supreme Court held that "prosecution of state charges of unauthorized use of property that are based solely on the unauthorized uploading, downloading and posting of computer software on a computer bulletin board is preempted by the federal copyright laws."[11] In that case, the defendant had entered no-contest pleas to counts of the indictment alleging that he had used or operated computer software belonging to two different corporations without the consent of the owner or a person authorized to give consent.[12]

{¶12} At the plea hearing, the state explained one count by stating that the defendant had been running a bulletin board for people to share computer software, and that he had been "exchanging and moving software." The state further stated that the software used in another count had been "the software that [had] actually let [the defendant's] bulletin board work, so he [had] not only [been] distributing that, but he also [had been] using it to facilitate the distribution of other items."[13]

{¶13} The supreme court stated, "None of the uses or attendant circumstances argued by the state is sufficient to satisfy the 'extra element' requirement that would except the charge of unauthorized use in this case from the express preemption clause in the copyright statute, Section 301, Title 17, U.S.Code. The facts established in the record

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[10] Id. at 43, quoting *United States ex rel. Berge v. Bd. of Trustees of Univ. of Ala.* (C.A.4, 1997), 104 F.3d 1453, 1463 (emphasis in original).
[11] Id. at 42.
[12] Id. at 43-44.
[13] Id. at 44 (emphasis omitted).

simply do not support a finding that [the defendant] engaged in any unauthorized use other than that which is preempted by federal copyright laws."[14]

{¶14} Similarly, our review of the record-pirating statute does not reveal an element of a claim that is qualitatively different from a copyright-infringement claim. In fact, we believe the record-pirating statute presents an even stronger case for preemption than the unauthorized-use statute in *Perry*. The entire gist of the offense is using the recording without the owner's consent, and the record shows that Boyd engaged in conduct that was covered by the federal copyright laws. And the Copyright Act has a mechanism for criminal enforcement.[15]

{¶15} The record-pirating statute is different from the statute at issue in *State v. Moning*, in which this court determined that Moning's prosecution under the statute was not preempted by federal law. In that case, the defendant, a police officer, was convicted of unauthorized use of property under R.C. 2913.04(B) after he had improperly used law-enforcement databases without a legitimate law-enforcement purpose. R.C. 2913.04(B) provided, "No person shall knowingly gain access to, attempt to gain access to, or cause access to be gained to any computer, computer system, computer network, telecommunications device, telecommunications service, or information service without the consent of, or beyond the scope of the express or implied consent of, the owner of the computer, computer system, computer network, telecommunications device, telecommunications service, or information service or other person authorized to give consent by the owner."

{¶16} In rejecting the argument that Moning's prosecution under the statute was preempted by federal copyright law, we stated that "[t]he element of obtaining

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[14] Id.
[15] Section 506, Title 17, U.S.Code.

access to the computer and the [law-enforcement] database in violation of the rules and restrictions, and thus beyond the consent of the owner or other person authorized to give consent, is sufficient to satisfy the 'extra element' test and except [the] unauthorized-use-of[-]property charge from the express preemption clause in the Copyright Act * * *."[16]

{¶17} Thus, in that case, the extra element of using the database for an improper purpose was present. In holding that Moning's prosecution under the statute was not preempted, we stated that "[n]one of the exclusive rights protected by the Copyright Act [had been] implicated."[17] In Boyd's prosecution under the record-pirating statute, the exclusive rights protected by the act were definitely implicated.

IV. Raising Preemption for the First Time on Appeal

{¶18} Boyd never raised preemption in the trial court. We must decide if he can raise it for the first time in this court. The Ohio Supreme Court, in discussing the defendant's no-contest plea in *Perry*, stated that "because preemption is a jurisdictional bar to prosecution, a no contest plea, or even a guilty plea, cannot support a conviction on a state charge that is preempted by federal law."[18]

{¶19} Further, the United States Supreme Court has held, in a case involving the National Labor Relations Act, that state procedural rules cannot bar a federal preemption claim, and that preemption can be raised at any time.[19] It stated that a preemption claim is "a claim that the state court has no power to adjudicate the subject matter of the case, and when a claim of * * * preemption is raised, it must be considered

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[16] *Moning*, supra, at ¶13.
[17] Id.
[18] *Perry*, supra, at 43.
[19] See *Internatl. Longshoremen's Assn. v. Davis* (1986), 476 U.S. 380, 393, 106 S.Ct. 1904; accord *Jones v. Shannon* (2000), 139 Ohio App.3d 508, 510, 744 N.E.2d 776.

and resolved by the state court."[20] Thus, the fact that Boyd did not assert preemption in the trial court does not prevent this court from considering it.

V. Summary

{¶20} We hold that the state's prosecution of Boyd was preempted by federal copyright laws and, therefore, that the state did not have the power to pursue the state charge against him. This holding does not leave the state or the copyright holders without a remedy. They simply must pursue their remedy under federal law.[21] We also do not believe that it creates a void in state law, given that the state has apparently not engaged in any prosecutions for record pirating since the statute's enactment in 1976.

{¶21} We, therefore, sustain Boyd's first assignment of error, reverse the judgment of conviction, and order that Boyd be discharged. Because his other three assignments of error involve the interpretation of the record-pirating statute, we find them to be moot, and we decline to address them.[22]

Judgment reversed and appellant discharged.

HILDEBRANDT, P.J., and **SUNDERMANN, J.,** concur.

Please Note:

The court has recorded its own entry this date.

[20] *Davis*, supra, at 393.
[21] See *Perry*, supra, at 50.
[22] See App.R. 12(A)(1)(c).