

In The  
**Supreme Court of the United States**

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BREWSTER KAHLE; INTERNET ARCHIVE;  
RICHARD PRELINGER; and  
PRELINGER ASSOCIATES, INC.,

*Petitioners,*

v.

MICHAEL B. MUKASEY, Attorney General,  
in his official capacity as Attorney  
General of the United States,

*Respondent.*

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**On Petition For A Writ Of Certiorari  
To The United States Court Of Appeals  
For The Ninth Circuit**

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**REPLY TO BRIEF IN OPPOSITION**

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## ARGUMENT

### I. There Is Now A Plain Conflict Within The Circuits About The First Amendment Standard To Be Applied To Changes In Copyright Law

The question presented in this case is:

Do the “traditional contours of copyright protection” referred to in *Eldred v. Ashcroft*, 537 U.S. 186 (2003), extend beyond the two “traditional First Amendment safeguards” also identified in *Eldred*?

On this question, as the government’s brief plainly demonstrates, there is a clear split in authority within the federal courts.

As this case, the case in the Tenth Circuit, *Golan v. Gonzales*, 501 F.3d 1179 (10th Cir. 2007), *petition for reh’g pending*, No. 05-1259 (filed Nov. 16, 2007), and practically every case following this Court’s decision in *Eldred* has demonstrated, *see Luck’s Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107 (D.D.C. 2004), *aff’d on other grounds*, 407 F.3d 1262 (D.C. Cir. 2005); *321 Studios v. Metro Goldwyn Mayer Studios, Inc.*, 307 F. Supp. 2d 1085 (N.D. Cal. 2004), *Eldred* has been read to set the standard for First Amendment review of a new copyright statute, or of a change in an existing copyright statute.

There are now, however, two conflicting readings of this “*Eldred* standard.”

On the government’s view, followed by the Ninth Circuit below, *Eldred* holds that there are two, *but only two*, changes in a copyright law that might give rise to a First Amendment challenge: either (a) a change in copyright law’s idea/expression dichotomy, or (b) a change in the doctrine of “fair use.” (Opp. 13) (First Amendment review beyond two “First Amendment safeguards” “is inconsistent with the context and reasoning of *Eldred*, as well as with First Amendment doctrine”); (Appellee Pet. 10, *Golan*) (“unmistakably clear that ‘the traditional contours of copyright protection’ referred to in *Eldred* comprise [the two “First Amendment safeguards]”). As the government argued in the Ninth Circuit, and argues currently in the Tenth Circuit, these are the *exclusive* grounds upon which a change in copyright law might present a First Amendment question. (Appellee Pet. 13, *Golan*) (Congress’s discretion is “subject only to the requirements of the Copyright Clause and [the two First Amendment safeguards]”). Any change beyond these two is thus immune from First Amendment review. *See also, Luck’s Music Library*, 321 F. Supp. 2d at 119.

On Petitioners’ view, now followed by the Tenth Circuit, the scope of First Amendment review of a copyright act is broader. On this view, while *Eldred* immunized a vast range of copyright law from First Amendment review—namely, all that law within the “traditional contours of copyright protection”—*Eldred* does not immunize *changes* in those “contours of copyright protection.” Instead, as with any law of

Congress that implicates free speech values, deviations from the “traditional contours of copyright protection” must be tested under ordinary First Amendment review, whether or not those changes happen also to be changes in the idea/expression dichotomy, or fair use.

Whichever view is correct,<sup>1</sup> there can be no question now that there is a conflict within the Circuits about the standard for First Amendment review of copyright statutes.

## **II. This Court Should Use This Case To Resolve This Conflict In The First Amendment Standard Governing Copyright Law**

The government concedes there is “tension” within the Circuits about the meaning of *Eldred*, (Opp. 11), but insists there is no “conflict” because the statutes at issue in the two circuit court cases are different. But as the First Amendment question decided in each case is *precisely* the same—whether there is First Amendment review beyond changes in the two “traditional First Amendment safeguards”

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<sup>1</sup> The question whether the Tenth Circuit’s view is correct is addressed in Appellants’ Response to the Petition for Rehearing. The most concise statement of that argument—beyond the plain text of the opinion in *Eldred*—is to recognize that the government both here, and in the Tenth Circuit, is defending the standard articulated by the D.C. Circuit in *Eldred*, a standard *expressly rejected* by the Court in *Eldred*. (Appellants’ Resp. to Pet. 70-72a, *Golan*.)

identified in *Eldred*—and as that First Amendment question will be presented in a wide range of other cases, addressing different copyright statutes, see *Golan*, *Luck’s Music Library*, it is prudent and appropriate for this Court to address the meaning of *Eldred* now.

If the government is right—if *Eldred* really does mean that the only First Amendment grounds upon which a copyright statute might be challenged are (1) changes in the idea/expression dichotomy, and (2) changes in fair use—then clarifying that question now would avoid a host of costly litigation grounded upon the uncertainty made manifest by the conflict between the Ninth and Tenth Circuits. The challenges that have, and will continue to be made, all stem from (on the government’s reading) a failure of precision in this Court’s opinion in *Eldred*. On the government’s view, *Eldred* should have said “traditional First Amendment safeguards” when it said “traditional contours of copyright protection.” If indeed the government is correct about this Court’s misstatement, there is no reason not to remedy that imprecision now.

But if the government is wrong—if *Eldred* means “traditional contours of copyright protection” when it says “traditional contours of copyright protection”—then this case presents the perfect vehicle within which to further articulate and apply that standard: Petitioners have challenged the shift from an “opt-in” to an “opt-out” copyright regime; the opt-in regime was the most important “contour” of American

“copyright protection” for 186 years of its history; there is no change in the history of American copyright law that is more aptly described as a change in the “traditional contours of copyright protection.”

This fact may not be obvious from the government’s description of the case. While the government cites the copyright acts of 1790 and 1831, its description of the history of formalities in American copyright law—what Petitioners have referred to as “opt-in” copyright protection—begins just in 1909. (Opp. 3) But as Petitioners have argued, there is no “contour” of “traditional” American “copyright protection” more fundamental than its historical requirement that the exclusive right of copyright be granted only to those who opted into the system.<sup>2</sup>

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<sup>2</sup> First, the 1790 Act conditioned protection on the author’s registration of his work with the clerk’s office of the District Court where the author resided. Act of May 31, 1790, ch. 15, § 3, 1 Stat. 124 (“1790 Act”).

Second, within two months thereafter, the author was required to give notice of his copyright by publishing proof of registration in a newspaper for at least four weeks. *Id.* In 1802, in an enactment described as “supplementary” to the 1790 Act, Congress required, in addition to newspaper notice, that any author seeking to obtain copyright “give information” by marking each copy of his work with a prescribed copyright notice. *See* Act of Apr. 29, 1802, ch. 36, § 1, 2 Stat. 171 (1802).

Third, a surviving author was permitted to renew the copyright for an additional fourteen years. Renewal required the author to reregister the copyright and to publish proof of reregistration in a newspaper. Both actions were required to be taken within the final six months of the first term. 1790 Act, § 1.

(Continued on following page)

These conditions had an obvious effect on speech. By requiring some affirmative step by a copyright holder to claim or sustain an exclusive governmental right over speech, the opt-in system automatically

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This emphasis on formalities established in the Founders' copyright statutes stayed almost entirely intact through the revisions of the copyright law enacted in 1831 and 1909. *See* Act of Feb. 3, 1831, ch. 16, 4 Stat. 436 (1831) ("1831 Act"), Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075 (1909) (repealed 1976) ("1909 Act"). The 1831 Act extended the initial term of copyright to twenty-eight years, *see* 1831 Act, § 16, but kept the registration, deposit, and notice requirements of the 1790 Act, *id.* §§ 3-5, as well as the requirement that copyright owners renew their copyrights to secure the benefits of a second term. *Id.* § 2.

Like the 1831 Act, the 1909 Act retained the registration, notice, and renewal requirements—though it lengthened the renewal term from fourteen to twenty-eight years and softened the registration requirement somewhat. *See* 1909 Act, §§ 1, 19-21, 24. The 1909 Act allowed protection to attach upon "publication of the work with the notice of copyright." *Id.* § 12. Following publication, however, the Act required that the author "promptly" deposit copies of the work with the Copyright Office, and authors were required to submit an application for registration along with the deposit. 1909 Act, § 12; *see* 2-7 Nimmer on Copyright, § 7.16[A][2][b] (2007).

Rights-holders were barred from bringing a lawsuit for infringement of the copyright until they had complied with the registration and deposit formalities. 1909 Act, § 12. In addition, the Register of Copyrights was authorized to make a demand for deposit; failure to promptly comply (within three months from any part of the United States except for "outlying territorial possessions," and within six months from anywhere else) would result in fines and the voiding of the copyright. *Id.* § 13.

And there copyright came to rest, until its major revision—and the beginning of the move from opt-in to opt-out copyright—in 1976.

narrowed the reach of copyright regulation to those works that would arguably benefit from the exclusive right of copyright. The system thus left free from the costly regulation of copyright works whose creators would presumptively not benefit from the regulation of copyright. That speech lived outside the system of copyright regulation, permitting archives to preserve and assure access to such speech at low cost.

Eliminating this “traditional contour of copyright protection” has now radically changed the burden of copyright regulation on these same free speech interests. This change is evinced, for example, in the Copyright Office’s “Orphan Works” report. *See U.S. Copyright Office, Report on Orphan Works: A Report of the Register of Copyrights* (Jan. 2006). They are the obvious burdens that any archive now faces as it tries to preserve or make accessible work whose copyright owner cannot even be found. They are the burdens faced by Petitioners in this case, the worlds leading Internet archives, seeking to expand the scope of free work that it might make available by securing access to all work within the public domain.

If the government is wrong about the meaning of *Eldred*, then the change from an opt-in to an automatic, or opt-out copyright regime is precisely the kind of change in copyright law that the *Eldred* rule is meant to review. Obviously the consequence of that review would not be a requirement that Congress keep copyright law as it has always been. Neither *Eldred* nor the Constitution requires for all time the costly, cumbersome, and unforgiving requirements of

19th century formalities. But as a fundamental change in the “traditional contours of copyright protection,” the shift to an automatic regime of copyright must be tested under a rule that require it not “burden substantially more speech than necessary to further [the legitimate governmental] interests.” *Turner Broad. Sys. v. FCC*, 520 U.S. 180, 189 (1997). Congress is not required to maintain the copyright technologies of our founders. But it is required to be at least as protective of the *full range of free speech interests* affected by its copyright regulation as were our founders.

### **III. At A Minimum, This Court Should Hold This Petition Until The Tenth Circuit Resolves Whether To Grant A Petition For Rehearing**

The government argues that this Court need not grant review in this case, because the government has asked the Tenth Circuit to review its panel opinion en banc. (Opp. 11.) If this Court finds this fact significant, at a minimum, it should hold the review of this case until the Tenth Circuit answers the government petition.

The Tenth Circuit’s opinion is perhaps the most careful analysis of the relationship between the copyright clause and the First Amendment of any federal case. It is certainly the most careful analysis of this Court’s opinion in *Eldred*. The product of 15 months of deliberation, the opinion clearly demonstrates why the narrow reading of *Eldred* advanced by the government

is incorrect. It then applies the *Eldred* rule properly understood in a careful and balanced manner.

The government's decision to petition for review underscores the importance of the issues in these cases. But it should not lead this Court to deny review in the instant case. And at a minimum, this Court should hold this Petition until the Tenth Circuit resolves the government's request. Any other result would risk allowing the split to persist, and would unfairly deny Petitioners in this case the opportunity to present the distinct challenge to the far more fundamental change in the "traditional contours of copyright protection" raised here.

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## CONCLUSION

The petition for writ of certiorari should be granted or held for review until the Tenth Circuit rules on the rehearing petition in *Golan*.

Respectfully submitted,

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IN THE UNITED STATES COURT OF APPEALS  
FOR THE TENTH CIRCUIT

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LAWRENCE GOLAN, ESTATE OF RICHARD KAPP,  
S.A. PUBLISHING CO., INC., d/b/a ESS.A.Y.  
RECORDINGS, SYMPHONY OF THE CANYONS,  
RON HALL, d/b/a FESTIVAL FILMS, and  
JOHN McDONOUGH, d/b/a TIMELESS VIDEO  
ALTERNATIVES INTERNATIONAL,

Plaintiffs-Appellants,

v.

MICHAEL B. MUKASEY, in his official capacity  
as Attorney General of the United States, and  
MARYBETH PETERS, Register of Copyrights,  
Copyright Office of the United States,

Defendants-Appellees.

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ON APPEAL FROM THE UNITED STATES  
DISTRICT COURT FOR THE  
DISTRICT OF COLORADO  
HON. LEWIS T. BABCOCK, C.J.

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APPELLEES' PETITION FOR REHEARING  
AND REHEARING *EN BANC*

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**STATEMENT REQUIRED BY  
FED. R. APP. P. 35(b)(1)**

The panel decision conflicts with the Supreme Court’s decision in *Eldred v. Ashcroft*, 537 U.S. 186 (2003). Consideration by the full Court is therefore necessary to secure and maintain uniformity of the Court’s decisions.

In addition, this case involves the following question of exceptional importance:

Whether Section 514 of the Uruguay Round Agreements Act (“URAA”), Pub. L. No. 103-465, 108 Stat. 4809, 4976-4981 (codified as amended at 17 U.S.C. §§ 104A, 109(a) (1994)), which offers copyright protection to a limited number of foreign works that had been in the public domain, alters “the traditional

contours of copyright protection” for purposes of First Amendment scrutiny, within the meaning of *Eldred*.

The panel’s resolution of the latter question is in tension with the ruling and reasoning of the Ninth Circuit in *Kahle v. Gonzales*, 487 F.3d 697 (9th Cir. 2007), *pet. for cert. pending*.

### STATEMENT

1. Section 514 of the URAA<sup>1</sup> partially implements a major copyright treaty, the Berne Convention for the Protection of Literary and Artistic Works (“Berne Convention”), by granting protection to foreign works whose copyright terms had not yet expired in their countries of origin. In doing so, a limited number of works were removed from the public domain. Article 18 of the Berne Convention requires that member nations provide copyright protections to certain unprotected foreign works whose copyright terms have not yet expired in their countries of origin. Such works may have lacked protection in the United States due to a lack of national eligibility, the absence of subject-matter protection, or a failure to abide by formalities of U.S. law,

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<sup>1</sup> The URAA was the implementing legislation for the General Agreement on Tariffs and Trade 1994 (“GATT”), which established the World Trade Organization (“WTO”). Title V of the Act implements the Agreement on Trade-Related Aspects of Intellectual Property Rights, which requires WTO members, *inter alia*, to comply with Article 18 of the Berne Convention. See S. Rep. No. 103-412, at 225 (1994).

such as affixing a copyright notice or filing a timely renewal application. These copyright formalities have since been repealed, and are no longer required of any author. *See* Copyright Renewal Act of 1992, Pub. L. No. 102-307, § 102(a)(2)(A)(ii), 106 Stat. 264 (1992) (providing for automatic renewal of copyright term); Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 7, 102 Stat. 2853 (1988) (eliminating requirement that copyright notice be affixed to work). The URAA thus grants protection to works of foreign authors previously ineligible for protection or unfamiliar with the technicalities of American law.

Under Section 514 of the URAA (codified as amended at 17 U.S.C. § 104A), copyright may be granted to works that: (1) remain protected under the law of the country where the work was originally published or created; (2) were denied copyright protection in the United States due to a lack of national eligibility, failure to comply with statutory formalities, or (in the case of certain sound recordings) lack of prior subject-matter protection; and (3) are still within the remainder of the copyright term they would ordinarily have enjoyed if created or published in the United States. *See* 17 U.S.C. § 104A(a), (h)(6). Section 514 does not extend the term of a copyright; rather, copyrights granted under the URAA expire on

the same day that they would have had the work had been protected since its creation.<sup>2</sup> *Id.* at § 104A(a).

2. a. In this action, plaintiffs *inter alia* challenged Section 5.14 of the URAA on First Amendment free speech grounds.<sup>3</sup> The district court rejected plaintiffs' argument: *Golan v. Gonzales*, 2005 WL 914754, \*16-17 (D. Colo. April 20, 2005).

b. On appeal, a panel of this Court (*Henry, Briscoe, Lucero, JJ.*) vacated the district court's First Amendment ruling and remanded for further proceedings. The panel stated that "we hold that plaintiffs have shown sufficient free expression interests in works removed from the public domain to require First Amendment scrutiny of § 514." Slip op. 4-5. Specifically, the panel invoked what it called "the

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<sup>2</sup> Congress also provided in the URAA for the protection of parties who had made use of foreign works before the copyrights in those works were granted. These "reliance parties" are given immunity for any act, done prior to the time copyright was conferred on the work, that would otherwise have constituted infringement. 17 U.S.C. § 104A(d)(1)-(2). Copyright holders must notify reliance parties of their intent to enforce a URAA-granted copyright, *id.* § 104A(d)(2)(A)-(B); give reliance parties a year to use or sell copies of a URAA – copyrighted work already in existence at the time of the notice, *id.*; and allow reliance parties, in exchange for reasonable compensation, to continue to exploit derivative works created prior to enactment of the URAA, § 104A(d)(2)(B), (d)(3).

<sup>3</sup> Plaintiffs also raised a Copyright Clause challenge to Section 514 of the URAA, as well as a constitutional challenge to the Sonny Bono Copyright Term Extension Act of 1998. The district court rejected those challenges, and the panel affirmed.

bedrock principle of copyright law that works in the public domain remain there and conclude[d] that § 514 alters the traditional contours of copyright by deviating from this principle.” *Id.* at 16-17. The panel further held that “copyright’s two built-in free speech safeguards – the idea/expression dichotomy and the fair use defense – do not adequately protect the First Amendment interests,” and that “the URAA does not adopt supplemental free speech safeguards.” *Id.* at 17.

The panel stated that “[t]he history of American copyright law reveals no tradition of copyrighting works in the public domain.” *Id.* at 22. After analyzing the historical record (*id.* at 22-27), it found “no tradition of removing works from the public domain,” and that, “if anything, our examination of the history of American copyright law reveals that removal was the exception rather than the rule.” *Id.* at 27. Thus, it concluded that “by extending a limited monopoly to expressions historically beyond the pale of such privileges, the URAA transformed the ordinary process of copyright protection. . . .” *Id.*

Accordingly, the panel held that “under both the functional and historical components of our inquiry, § 514 has altered the traditional contours of copyright protection.” *Id.* The panel next “conclude[d] that once the works at issue became free for anyone to copy, plaintiffs in this case had vested First Amendment interests in the expressions, and § 514’s interference with plaintiffs’ rights is subject to First Amendment scrutiny.” *Id.* at 31. Finally, the panel held that “the

idea/expression dichotomy and the fair use defense are not designed to combat the threat to free expression posed by § 514's removal of works from the public domain" (*id.* at 31), and that the URAA, unlike the statute upheld in *Eldred v. Ashcroft*, 537 U.S. 186 (2003), "does not supplement the traditional First Amendment safeguards." *Id.* at 34. The panel therefore remanded the case for further First Amendment scrutiny.

### **REASONS WHY THE PETITION SHOULD BE GRANTED**

The panel's opinion clearly meets the criteria of Fed. R. App. P. 35(b)(1) for en banc review, inasmuch as it conflicts with the Supreme Court's decision in *Eldred*. It also raises a question of exceptional importance within the meaning of Fed. R. App. P. 35(b)(1), to wit, whether Section 514 of the URAA, which removes a limited number of works from the public domain, alters the "traditional contours of copyright protection," for purposes of First Amendment scrutiny, within the meaning of *Eldred*.

As the Supreme Court has recognized, "the Framers intended copyright itself to be the engine of free expression," by "suppl[ying] the economic incentive to create and disseminate ideas." *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985). Thus, as the Court held only recently in *Eldred*, "copyright law contains built-in First Amendment accommodations." 537 U.S. at 219. Given

these accommodations, its “limited monopolies are compatible with free speech principles.” *Id.* The *Eldred* Court therefore “reject[ed] petitioners’ plea for imposition of uncommonly strict scrutiny on a copyright scheme that incorporates its own speech-protective purposes and safeguards.” *Id.* at 218-19.

As described in *Eldred*, copyright’s First Amendment safeguards are twofold. First, the law “distinguishes between ideas and expression and makes only the latter eligible for copyright protection.” *Id.* The copyrights in foreign works granted by the URAA, like domestic copyrights, do not extend to ideas *per se*, but serve only to “protect[] authors’ original expression [of such ideas] from unrestricted exploitation.” *Id.* at 221. As the Court stated in *Harper & Row*, the “idea/expression dichotomy ‘strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author’s expression.’” 471 U.S. at 556 (internal citation omitted).

Second, and relatedly, copyright law provides an exception for fair use, which “allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances.” *Eldred*, 537 U.S. at 219. Under 17 U.S.C. § 107, the exclusive rights guaranteed by copyright do not include “fair use . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research.” The fair use exception “affords considerable

latitude for scholarship and comment,’ . . . and even for parody.” *Eldred*, 537 U.S. at 219-20 (internal citations omitted). The fair use exception safeguards the public discussion and debate inspired by copyrighted works, while prohibiting the wholesale infringement of such works. See *Harper & Row*, 471 U.S. at 563.

The Court in *Eldred* described the idea/expression dichotomy and the doctrine of fair use as the two “traditional First Amendment safeguards” at work in the copyright law. 537 U.S. at 220. It further noted that the protection of expression through copyright “does not raise the free speech concerns present when the government . . . burdens the communication of particular facts or ideas. The First Amendment securely protects the freedom to make . . . one’s own speech; it bears less heavily when speakers assert the right to make other people’s speeches.” *Id.* at 221.<sup>4</sup> The Court therefore concluded that, to the extent that copyright protections “raise First Amendment concerns, copyright’s built-in free speech safeguards are generally adequate to address them,” *id.* – unmistakably referring to the “traditional First Amendment safeguards” it had described two

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<sup>4</sup> Indeed, *Eldred* stressed that copyright protection also serves First Amendment values, as its purpose is “to promote the creation and publication of free expression.” *Id.* at 219. The power to restrict others’ exploitation of a work, including creating derivative works, similarly protects a First Amendment interest not to speak. See *Harper & Row*, 471 U.S. at 559-60.

paragraphs earlier. *Id.* at 220. In this context, while the Court acknowledged that copyrights may not be “categorically immune from challenges under the First Amendment,” *id.* at 221 (citation omitted) – *i.e.*, the mere label of “copyright,” applied without regard to fair use or the idea/expression distinction, would not immunize a statute from First Amendment review – it held that “when, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.” *Id.*

Section 514 of the URAA leaves these two traditional safeguards of First Amendment interests intact; the copyrights granted to foreign authors are coextensive with those enjoyed by American authors. They last for precisely the same term, expire on precisely the same day, offer precisely the same protections against others’ exploitation, and include precisely the same exceptions for pure ideas and fair use. The “built-in free speech safeguards” of copyright law, *id.*, are thus preserved.

Plaintiffs neither make use of facts or pure ideas, nor engage in fair use. Their proposed actions would constitute garden variety copyright infringement, receive no First Amendment protection. Compare *Harper & Row*, 471 U.S. at 558 (“The public interest in the free flow of information is assured by the law’s refusal to recognize a valid copyright in facts. The fair use doctrine is not a license for corporate theft. . . .”).

The only difference between American works and foreign works granted copyright protection by the URAA is that the latter have gone unprotected for much or all of their existence, at the expense of their foreign authors. URAA-copyrighted works thus by definition enjoy a considerably shorter span of copyright protection than their American counterparts.<sup>5</sup>

The panel, however, has rejected this straightforward analysis of *Eldred*. The panel does not directly take issue with *Eldred*'s holding that "when . . . Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary." 537 U.S. at 221. On the panel's alternative reading, however, the phrase "the traditional contours of copyright protection" does not refer solely to the "traditional First Amendment safeguards," *id.* at 220, discussed for the previous three pages of the *Eldred* opinion. Instead, the panel maintains in effect that the six-word phrase set out a new, unexplicated standard – never before articulated in the Court's jurisprudence – contemplating First Amendment review if a copyright statute "deviates from [a] time-honored tradition," slip op. 27, even if that "time-honored tradition" has admittedly been breached by Congress on numerous occasions over the centuries. Such a standard is entirely alien to the

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<sup>5</sup> The panel apparently did not focus on the fact that many if not most of these works never had the chance to pass through the traditional copyright "sequence" of progressing "from 1) creation; 2) to copyright; 3) to the public domain." Slip op. 20.

context and reasoning of *Eldred*, as well as to First Amendment doctrine.

In context, it is unmistakably clear that “the traditional contours of copyright protection” referred to in *Eldred* comprise the idea/expression dichotomy and the doctrine of fair use. These are the “traditional First Amendment safeguards,” *Eldred*, 537 U.S. at 220, and the “built-in First Amendment accommodations,” *id.* at 219, that the *Eldred* Court took great care to describe. These are the exceptions that render the “limited monopolies” of copyright “compatible with free speech principles.” *Id.* These are also the factors described in *Harper & Row*, which the Court specifically cited as authority with regard to “the traditional contours of copyright protection.” See *Eldred*, 537 U.S. at 221; *Harper & Row*, 471 U.S. at 560.

The Court’s reference in *Eldred* to “the traditional contours of copyright protection” thus did not create a new standard, but merely repeated prior law, which holds that the idea/expression dichotomy and the doctrine of fair use ensure the consistency of private copyright enforcement with the First Amendment. This sensible interpretation is also the only one consistent with the structure of the *Eldred* opinion. Although the *Eldred* Court certainly considered copyright term extensions to be consistent with past practice, 537 U.S. at 200-204, it did not dispose of the First Amendment question on those grounds. Instead, the Court discussed at length the unique features of copyright law that protect First Amendment values.

The Court simply did not suggest, let alone hold, that “deviat[ion] from [a] time-honored tradition,” slip op. 27, is the basis for a First Amendment inquiry into a copyright statute. Nor do Congress’s broad constitutional copyright powers somehow atrophy if unused.

The panel has not identified a single court that has interpreted the First Amendment in this fashion. Compare, e.g., *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1264-65 (11th Cir. 2001) (mentioning the “First Amendment protections interwoven into copyright law” and explicitly describing them to be “the fair use factors” and the “idea/expression dichotomy”). And all other courts since *Eldred* have agreed with this enumeration, and have squarely rejected the type of analysis employed by the panel. See *Luck’s Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107, 119 (D.D.C. 2004) (holding that “Congress has not altered the traditional contours of copyright protection,” because the URAA “does not alter First Amendment accommodations such as the idea/expression dichotomy or the fair-use doctrine.”), *aff’d on other grounds*, 407 F.3d 1262 (D.C. Cir. 2005); *Kahle v. Ashcroft*, 2004 WL 2663157 (N.D. Cal. 2004), *aff’d*, 487 F.3d 697 (9th Cir. 2007), *pet. for cert. pending*.

The panel’s proposed standard would be inconsistent with established First Amendment doctrine and impossible to administer. Mere “deviat[ion]” from past copyright practice is entirely irrelevant to First Amendment values. The elimination in 1988 of the requirement to affix a copyright notice surely

departed in some sense from traditional copyright protection (which had long required notice), but manifestly would not have required First Amendment scrutiny. What matters for First Amendment analysis is whether copyright's traditional First Amendment safeguards – fair use and the idea/expression dichotomy – have been altered, creating obstacles to others' use of copyrighted material in the course of making their own speech. This is why the Court in *Eldred* referred to “the traditional contours of copyright protection,” 537 U.S. at 221 (emphasis added); see also *Kahle*, 2004 WL 2663157, \*17 (“The concepts of copyright law that the Supreme Court suggests fall within those contours – the idea/expression dichotomy and the fair use exception – each relate to the scope of copyright protection.”).

Applied to cases beyond abandonment or alteration of the two traditional First Amendment safeguards recognized in copyright law, the panel's standard would be incompatible with customary modes of First Amendment review. Such an approach would quickly mire the courts in questions they were not meant to face.<sup>6</sup> The logic of the panel's holding is

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<sup>6</sup> The panel itself may have become mired in one such question: whether the URAA's protection of “reliance parties” who had been exploiting these works prior to the URAA amendments offered the kind of breathing space that the Supreme Court noted in passing that the CTEA had offered with its provisions for libraries, archives, small businesses and restaurants. The panel's conclusion that the URAA's reliance party provision compares unfavorably with the CTEA provisions

(Continued on following page)

that every time Congress makes a formal or substantive change to the “traditional” copyright scheme (such as eliminating renewal formalities and extending the copyright term, thereby creating an “opt-out” system – the very changes upheld by the Ninth Circuit in *Kahle, supra*), it has “altered the traditional contours of copyright protection,” and the First Amendment is therefore implicated. This approach is both inconsistent with *Eldred* and unworkable. Rather than transform every change in copyright law into a separate First Amendment question, the Supreme Court has recognized the broad discretion of Congress – subject only to the requirements of the Copyright Clause, the idea/expression dichotomy and the fair use doctrine – to determine which works will be copyrighted, who will receive copyright protection, and when copyright terms will expire. This is the only approach to First Amendment review consistent with the grant of power in the Copyright Clause, and it forecloses application of the panel’s amorphous new standard.

Finally, the panel’s decision rests upon a fundamental misunderstanding of *Eldred*, the history of American copyright law, and the “traditional contours of copyright protection.” Since 1790, Congress has repeatedly granted protection to works previously in the public domain, in both private bills and generally

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in *Eldred* is far from obvious in light of the modest nature of those provisions.

applicable legislation. See slip op. 25-27; *Luck's Music Library, Inc.*, 321 F. Supp. 2d at 115, 119 (rejecting First Amendment “traditional contours of copyright challenge to § 514), *aff'd on other grounds*, 407 F.3d at 1265-66 (rejecting Copyright Clause challenge to § 514 and recognizing history of withdrawal of works from the public domain). There is thus nothing approaching an ironclad rule or “tradition” against doing so. Section 514 of the URAA is entirely consistent with this history, to which the panel gives short shrift. The panel’s opinion creates a great danger: that all changes to copyright law that affect what is or is not protected are subject to First Amendment scrutiny.

It is certainly true that what goes into the public domain generally stays there. Over the last two-plus centuries, however, Congress has enacted enough exceptions to this general rule that it simply cannot be said that § 514 of the URAA “alters the traditional contours of copyright protection.” The many statutes allowing for removal of works from the public domain militate against such a conclusion – indeed, these statutes themselves form part of “the traditional contours of copyright protection.” And neither the cases cited by the panel (slip op. 28) nor any other cases we are aware of hold that works may never be withdrawn from the public domain. *Pace* the panel, copyright law rests upon no such “bedrock principle” (*id.* at 16, 27).

**CONCLUSION**

For the foregoing reasons, this petition should be granted.

Respectfully submitted,

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NOVEMBER 2007

**CERTIFICATE OF SERVICE**

I hereby certify that on the 16th day of November, 2007, I served two copies of the Petition for Rehearing And Rehearing En Banc of Appellee by causing them to be e-mailed and mailed, via first class mail, postage prepaid, to:

Lawrence Lessig, Esquire (one hard copy)  
Center for Internet Law and Society  
Stanford Law School  
559 Nathan Abbott Way  
Stanford, CA 94305

Hugh Q. Gottschalk, Esquire (one hard copy)  
Carolyn J. Fairless, Esquire  
Wheeler Trig Kennedy LLP  
1801 California Street, Suite 3600  
Denver, CO 80202

The Petition was also sent to the Clerk's Office by e-mail and Federal Express overnight mail on the same date.

/s/ John S. Koppel  
JOHN S. KOPPEL  
Attorney

**CERTIFICATE OF DIGITAL SUBMISSION**

Pursuant to this Court's General Order of August 10, 2007, I hereby certify that:

1. all required privacy redactions have been made and, with the exception of those redactions, every document submitted in Digital Form or scanned PDF format is an exact copy of the written document filed with the Clerk; and
2. the digital submissions have been scanned for viruses with the most recent version of the following commercial virus scanning program, which indicates that the submissions are free of viruses.

Program: Trend Micro OfficeScan Client

Version: 6.5

Last Updated: November 16, 2007

/s/ John S. Koppel  
JOHN S. KOPPEL  
Attorney

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**ADDENDUM**

**PUBLISH**

**UNITED STATES COURT OF APPEALS**

**TENTH CIRCUIT**

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LAWRENCE GOLAN;  
ESTATE OF RICHARD KAPP;  
S.A. PUBLISHING CO, INC.,  
d/b/a ESS.A.Y. RECORDINGS;  
SYMPHONY OF THE  
CANYONS; RON HALL d/b/a  
FESTIVAL FILMS; and  
JOHN McDONOUGH, d/b/a  
TIMELESS VIDEO ALTER-  
NATIVES INTERNATIONAL,

Plaintiffs-Appellants,

v.

ALBERTO R. GONZALES, in  
his official capacity as Attorney  
General of the United States;  
and MARYBETH PETERS,  
Register of Copyrights,  
Copyright Office of the  
United States,

Defendants-Appellees

INTERNATIONAL  
COALITION FOR  
COPYRIGHT PROTECTION,

Amicus Curiae.

No. 05-1259

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**Appeal from the United States District Court  
for the District of Colorado  
(D.C. No. 1:01-cv-01854 LTB-BNB)**

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(Filed September 4, 2007)

Lawrence Lessig, Center for Internet and Society, Stanford Law School, Stanford, California (Hugh Q. Gottschalk and Carolyn J. Fairless, Wheeler Trigg Kennedy LLP, Denver, Colorado, with him on the briefs), for Plaintiffs-Appellants.

John S. Koppel, Appellate Staff Civil Division (Peter D. Keisler, Assistant Attorney General, William J. Leone, United States Attorney, and William Kanter, Appellate Staff Civil Division, Washington, D.C., with him on the brief), for Defendants-Appellees.

Eric M. Lieberman and David B. Goldstein, Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., New York, New York, filed an Amicus Curiae brief in support of Defendants-Appellees.

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Before **HENRY**, **BRISCOE**, and **LUCERO**, Circuit Judges.

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**HENRY**, Circuit Judge.

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Plaintiffs in this case range from orchestra conductors, educators, performers, and publishers to film archivists and motion picture distributors. They challenge two acts of Congress, the Copyright Term Extension Act (“CTEA”), Pub. L. No. 105-298, §§ 102(b) and (d), 112 Stat. 2827-28 (1998) (amending 17 U.S.C. §§ 302, 304), and § 514 of the Uruguay Round Agreements Act (“URAA”), Pub. L. No. 103-465, 108 Stat. 4809, 4976-80 (1994), codified at 17 U.S.C. §§ 104A,<sup>1</sup> 109.

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<sup>1</sup> Section 104A provides in the pertinent part:

(a) Automatic protection and term.—

(1) Term.

(A) Copyright subsists, in accordance with this section, in restored works, and vests automatically on the date of restoration.

....

(h) Definitions. For purposes of this section and section 109(a):

....

(6) The term “restored work” means an original work of authorship that —

(A) is protected under subsection (a);

(B) is not in the public domain in its source country through expiration of term of protection;

(C) is in the public domain in the United States due to —

(I) noncompliance with formalities imposed at any time by United States copyright law, including failure of renewal, lack of proper notice, or failure to comply with any manufacturing requirements; (ii) lack of subject matter protection

(Continued on following page)

Also known as the Sonny Bono Copyright Term Extension Act, the CTEA increased the duration of existing and future copyrights from life-plus-50-years to life-plus-70-years. Section 514 of the URAA implements Article 18 of the Berne Convention for the Protection of Literary and Artistic works. Ushered into being in 1886 at the behest of *Association Littéraire et Artistique Internationale*, an organization founded by Victor Hugo and dedicated to obtaining protection for literary and artistic works, the Berne Convention requires member countries to afford the same copyright protection to foreign authors as they provide their own authors. In this case, congressional compliance with the Berne Convention meant copyrighting some foreign works in the public domain.<sup>2</sup>

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in the case of sound recordings fixed before February 15, 1972; or (iii) lack of national eligibility; and

(D) has at least one author or rightholder who was, at the time the work was created, a national or domiciliary of an eligible country, and if published was first published in an eligible country and not published in the United States during the 30-day period following publication in such eligible country.

<sup>2</sup> Article 18 of the Berne Convention provides in the pertinent part:

(1) This Convention shall apply to all works which, at the moment of its coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection.

(2) If, however, through the expiry of the term of protection which was previously granted, a work has fallen into the public domain, of the country where the

(Continued on following page)

Plaintiffs argue the CTEA extends existing copyrights in violation of the “limited Times” provision of the Constitution’s Copyright Clause. With regard to the URAA, plaintiffs contend § 514 shrinks the public domain and thereby violates the limitations on congressional power inherent in the Copyright Clause. In addition, plaintiffs argue that § 514’s removal of works from the public domain interferes with their First Amendment right to free expression.

The district court dismissed plaintiffs’ CTEA claim and granted summary judgment for the government on plaintiffs’ URAA challenges. We exercise jurisdiction pursuant to 28 U.S.C. § 1291 and affirm the district court’s dismissal of the CTEA claim as foreclosed by the Supreme Court’s decision in *Eldred v. Ashcroft*, 537 U.S. 186 (2003). We also agree with the district court that § 514 of the URAA has not exceeded the limitations inherent in the Copyright Clause. Nevertheless, we hold that plaintiffs have shown sufficient free expression interests in works removed from the public domain to require First Amendment scrutiny of § 514. On this limited basis, we remand for proceedings consistent with this opinion.

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protection is claimed, that work shall not be protected anew[.]

## I. BACKGROUND

Each plaintiff in this case relies on artistic works in the public domain for his or her livelihood. Lawrence Golan, for example, performs and teaches works by foreign composers including Dmitri Shostakovich and Igor Stravinsky. Before the CTEA, plaintiffs anticipated that certain works would soon outlive copyright protection and enter the public domain. The CTEA delayed this moment by 20 years. Prior to the URAA, each plaintiff utilized or performed works by foreign artists in the public domain, such as Sergei Prokofiev's renowned "Peter and the Wolf." Since the passage of the URAA, plaintiffs must pay higher performance fees and sheet music rentals as well as other royalties. In many cases, these costs are prohibitive.

Plaintiffs filed suit in the United States District Court for the District of Colorado arguing that both the CTEA and the URAA are unconstitutional. The court concluded the Supreme Court's decision in *Eldred* precluded plaintiffs' challenge to the CTEA and granted summary judgment to the government on plaintiffs' two URAA claims. *Golan v. Ashcroft*, 310 F. Supp. 2d 1215, 1218 (D. Colo. 2004). Reasoning that "Congress has historically demonstrated little compunction about removing copyrightable materials from the public domain," the district court ruled that Congress had the power to enact § 514 of the URAA under the Copyright Clause. *Golan v. Gonzales*, No. Civ. 01-B-1854(BNB), 2005 WL 914754, at \*14 (D. Colo. Aug. 24, 2005). The court also granted summary

judgment on plaintiffs' First Amendment claim, on the theory they had no protected interest in the now-copyrighted works. This appeal followed.

## II. STANDARD OF REVIEW

We review de novo a district court's grant of summary judgment. *Steffey v. Orman*, 461 F.3d 1218, 1221 (10th Cir. 2006). Summary judgment is appropriate only when "there is no genuine issue as to any material fact." FED. R. CIV. P. 56(c). We also examine de novo the district court's conclusions regarding the Constitution. *O'Connor v. Washburn Univ.*, 416 F.3d 1216, 1223 (10th Cir. 2005). "[I]t is also appropriate to bear in mind . . . that in the enactment of a statute Congress is presumed to act with knowledge of controlling constitutional limitations or proscriptions and with an intent and purpose to avoid their contravention." *Wells, by Gillig, v. Att'y General of the United States*, 201 F.2d 556, 560 (10th Cir. 1953); see also *INS v. Chadha*, 462 U.S. 919, 944 (1983) ("We begin . . . with the presumption that the challenged statute is valid.").

## III. DISCUSSION

Plaintiffs claim that the CTEA's 20-year extension of existing copyrights violates the Copyright Clause's "limited Times" provision. In addition, they contend that the URAA's removal of works from the public domain exceeds the authority granted to Congress under the Copyright Clause. Finally, plaintiffs

maintain that § 514 of the URAA must be subject to First Amendment review because it has altered the traditional contours of copyright protection. Since familiarity with the foundations of copyright law is crucial to understanding the dispute, we begin with an outline of basic copyright principles.

Under the Copyright Clause, Congress may “promote the Progress of Science and useful Arts, by securing for limited Times to Authors . . . the exclusive Right to their Writings.” U.S. Const. art. I, § 8, cl. 8. The Supreme Court has explained that “[the Clause] is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.” *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984). By encouraging creative expression through limited monopolies, the Copyright Clause “promot[es] broad public availability of literature, music, and the other arts.” *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). “[O]nce the . . . copyright monopoly has expired, the public may use the . . . work at will and without attribution.” *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33-34 (2003). These imaginative works inspire new creations, which in turn inspire others, hopefully, ad infinitum. This cycle is what makes copyright “the engine of free expression.” *Harper & Row Publishers Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985).

Congress's power to bestow copyrights is broad. See *Eldred*, 537 U.S. at 205 (“[I]t is Congress that has been assigned the task of defining the scope of the limited monopoly that should be granted to authors . . . in order to give the public appropriate access to their work product.”) (internal quotation marks omitted). But it is not boundless. The Copyright Clause itself limits Congress's power as to what kinds of works can be copyrighted and for how long. For instance, in order to be copyrightable, a work must be original. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (“The *sine qua non* of copyright is originality. . . . Originality is a constitutional requirement.”). In addition, a copyright must be limited in duration. *Dastar*, 539 U.S. at 37 (noting that Congress cannot “create [ ] a species of perpetual . . . copyright”). The rationale underlying this limitation is that an infinite copyright would deprive the public of the benefit – the right to use and enjoy the expression – that it is supposed to receive in exchange for the grant of monopoly privileges to the author for a discrete period of time. See *id.* at 33-34 (“The rights of a . . . copyright holder are part of a carefully crafted bargain under which, once the . . . copyright monopoly has expired, the public may use the . . . work at will and without attribution.”) (internal citation and quotation marks omitted).

The Supreme Court has recognized that the First Amendment can limit Congress's power under the Copyright Clause. *Eldred*, 537 U.S. at 219-21 (indicating that copyright acts are not “categorically

immune from challenges under the First Amendment”) (internal quotation marks omitted). The Court has emphasized, however, that “copyright’s built-in First Amendment accommodations” – the idea/expression dichotomy and the fair use defense – generally protect the public’s First Amendment interest in copyrighted works. *Id.* at 219-20.

The first of these “built-in safeguards,” the idea/expression dichotomy, denies copyright protection “to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in [a copyrighted] work.” 17 U.S.C. § 102(b). It reserves to authors, however, the right to exploit their “expression,” *id.*, a term that refers to “the particular pattern of words, lines and colors, or musical notes” that comprise a work. ROBERT A. GORMAN, *COPYRIGHT LAW* 23 (2d ed.2006).

The second safeguard, the fair use defense, allows the public to utilize a copyrighted work “for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research.” 17 U.S.C. § 107. The defense protects the public’s First Amendment interest in an author’s original expression by “afford[ing] considerable latitude for scholarship and comment, and even for parody.” *Eldred*, 537 U.S. at 220 (internal citations and quotation marks omitted).

Although these built-in free speech safeguards will ordinarily insulate legislation from First

Amendment review, the *Eldred* Court indicated that such review is warranted when an act of Congress has “altered the traditional contours of copyright protection.” *Id.* at 221. The Court did not define the “traditional contours of copyright protection.” However, as we discuss in detail below, one of these traditional contours is the principle that once a work enters the public domain, no individual – not even the creator – may copyright it.

With these principles in mind, we turn to plaintiffs’ challenges to the CTEA and URAA.

#### A. The CTEA

The Copyright Clause provides: “The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries[.]” U.S. Const., art. I, § 8, cl. 8. Plaintiffs contend the CTEA violates the “limited Times” prescription by increasing the term from life-plus-50-years to life-plus-70-years. More specifically, they argue that “the Framers would have considered the [life-plus-70] term to be so long as to be effectively perpetual.” Aplt’s Br. at 55.

Analyzing the CTEA in light of the Clause’s inherent limitations, the Supreme Court upheld the Act in *Eldred*. 537 U.S. at 194 (“[W]e reject petitioners’ challenges to the CTEA. . . . Congress acted within its authority and did not transgress constitutional limitations.”). Nevertheless, plaintiffs attempt

to distinguish *Eldred*, invoking the Court’s acknowledgment that “[p]etitioners [did] not challenge the ‘life-plus-70-years’ timespan itself.” *Id.* at 193. Plaintiffs therefore contend that *Eldred* does not foreclose the argument that the CTEA’s extension of all future copyrights to a life-plus-70-years timespan violates the Copyright Clause. Though plaintiffs may be correct that the *Eldred* Court did not technically address this term, the rationale underlying *Eldred* compels us to conclude that the CTEA-imposed timespan passes constitutional muster.

The Ninth Circuit recently upheld the dismissal of a nearly-identical CTEA challenge in *Kahle v. Gonzales*, 487 F.3d 697 (9th Cir. 2007). The plaintiffs in *Kahle*, like plaintiffs here, argued that the CTEA’s life-plus-70-years copyright term violated the “limited Times” prescription because the Framers would have viewed it as “effectively perpetual.” *Id.* at 699 (internal quotation marks omitted). As the Ninth Circuit observed, the *Eldred* Court “clearly grasped the role ‘limited Times’ play in the copyright scheme and the Framers’ understanding of that phrase.” *Id.* at 700. Indeed, the *Eldred* Court emphasized that our constitutional scheme charges Congress, and not federal courts, with “the task of defining the scope of the limited monopoly that should be granted to authors.” 537 U.S. at 205 (internal quotation marks omitted). As the *Kahle* court reasoned, “the outer boundary of ‘limited Times’ is determined by weighing the impetus provided to authors by longer terms against the benefit provided to the public by shorter terms. That

weighing is left to Congress, subject to rationality review.” *Kahle*, 487 F.3d at 701. This rationale is clearly consistent with *Eldred*. See 537 U.S. at 204 (reviewing the CTEA merely to determine “whether it is a rational exercise of the legislative authority conferred by the copyright clause”).

We agree with the *Kahle* court’s holding that *Eldred* precludes a challenge to the 20-year term extension. See *Eldred*, 537 U.S. at 208 (“We cannot conclude that the CTEA – which continues the unbroken congressional practice of treating future and existing copyrights in parity for term extension purposes – is an impermissible exercise of Congress’ power under the Copyright Clause.”). Plaintiffs here, like the plaintiffs in *Kahle*, “provide no compelling reason why we should depart from a recent Supreme Court decision.” *Kahle*, 487 F.3d at 701.

## B. THE URAA

Plaintiffs present two arguments regarding the constitutionality of § 514 of the URAA. First, they claim that § 514 exceeds the authority granted to Congress in the Copyright Clause. Second, they maintain § 514 has disrupted the traditional contours of copyright protection and thus demands First Amendment scrutiny. We begin with the contention that Congress has overstepped its Article I authority.

## 1. Section 514 does not violate the Copyright Clause

Plaintiffs ground their argument that § 514 transgresses the bounds of Congress's Article I authority in the text of the Copyright Clause. They contend that § 514's extension of copyright protection to works in the public domain eviscerates any limitations imposed by the "limited Times" prescription and the Progress Clause. In essence, plaintiffs aver that unless we hold that the Progress Clause and the "limited Times" prescription prevent Congress from copyrighting works in the public domain, Congress could adopt a practice of copyrighting works as they fall into public domain. This would prevent the public from ever gaining unfettered access to the expressions.

We agree it would be troubling if Congress adopted a consistent practice of restoring works in the public domain in an effort to confer perpetual monopolies. But this argument is similar to one the *Eldred* plaintiffs raised, and, like the *Eldred* Court, we are mindful that "a regime of perpetual copyrights is clearly not the situation before us." *Eldred*, 537 U.S. at 209.

Plaintiffs cite *Graham v. John Deere Co.*, 383 U.S. 1 (1966), in support of their contentions. There, the Supreme Court concluded that Congress could not issue a patent when the invention had resided in the public domain before the inventor had applied for the patent. For both their Progress Clause and "limited

Times” arguments, plaintiffs rely heavily on the *Graham* Court’s statement that “Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available.” *Id.* at 6. Plaintiffs contend there is no meaningful distinction between copyrights and patents that would prevent this court from applying *Graham* here.

The D.C. Circuit confronted and rejected an identical argument in *Luck’s Music Library, Inc. v. Gonzales*, 407 F.3d 1262 (D.C. Cir. 2005), a case in which the plaintiffs maintained that § 514’s copyright of works in the public domain violated the Copyright Clause. In rejecting the contention, the D.C. Circuit noted that

[*Graham*] dealt with patents rather than copyright, and the ideas applicable to one do [not] automatically apply to the other. For example, the *Eldred* Court saw the ‘quid pro quo’ idea as having a special force in patent law, where the patentee, in exchange for exclusive rights must disclose his ‘discoveries’ against his presumed will. In contrast, the author is eager to disclose her work.

407 F.3d at 1266.

In addition to these distinctions, the *Eldred* Court observed that while patents “prevent full use by others of the inventor’s knowledge,” “copyright gives the holder no monopoly on any knowledge.” 537 U.S. at 217. We further note that the language plaintiffs cite

from *Graham* is taken from a discussion about the Progress Clause in the context of conditions for patentability. The sentence following the one plaintiffs emphasize reads: “Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a *patent system* which by constitutional command must ‘promote the Progress of . . . the useful Arts.’” *Graham*, 383 U.S. at 6 (emphasis supplied). In fact, the *Graham* Court only mentioned copyright in a footnote when it explained that it had omitted the copyright portion of the Patent and Copyright Clause because it was “not relevant” to the disposition of the case. *Id.* at 6 n.1. Thus, we conclude that plaintiffs have thrust onto *Graham* a burden it was never intended to bear. We decline to read *Graham* as standing for the proposition that, in the context of copyright, the public domain is a threshold that Congress may not “traverse in both directions.” Aplt’s Br. at 50.

Furthermore, the *Graham* Court emphasized that the Constitution assigns Congress the task of “implement[ing] the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim.” 383 U.S. at 6. As discussed above, the *Eldred* Court echoed this refrain. *See Eldred*, 537 U.S. at 205 (“[I]t is Congress that has been assigned the task of defining the scope of the limited monopoly that should be granted to authors . . . in order to give the public appropriate access to their work product.”) (internal quotation marks omitted). The clear import of *Eldred* is that Congress

has expansive powers when it legislates under the Copyright Clause, and this court may not interfere so long as Congress has rationally exercised its authority. *See Eldred*, 537 U.S. at 213 (searching for a “rational basis for the conclusion that the CTEA ‘Promotes the Progress of Science’”). Here, we do not believe that the decision to comply with the Berne Convention, which secures copyright protections for American works abroad, is so irrational or so unrelated to the aims of the Copyright Clause that it exceeds the reach of congressional power. *Id.* at 208 (emphasizing that the Court was “not at liberty to second-guess congressional determinations and policy judgments of this order, however debatable or arguably unwise they may be”).

Nevertheless, legislation promulgated pursuant to the Copyright Clause must still comport with other express limitations of the Constitution. *Saenz v. Roe*, 526 U.S. 489, 508 (1999) (“Article I of the Constitution grants Congress broad power to legislate in certain areas. Those legislative powers are, however, limited not only by the scope of the Framers’ affirmative delegation, but also by the principle that they may not be exercised in a way that violates other specific provisions of the Constitution.”) (internal quotation marks omitted); *Buckley v. Valeo*, 424 U.S. 1, 132 (1976) (“Congress has plenary authority in all areas in which it has substantive legislative jurisdiction so long as the exercise of that authority does not offend some other constitutional restriction.”) (internal citation omitted). Thus, even if Congress has not

exceeded its Article I authority, § 514 may still be subject to First Amendment review.

## **2. Congress’s Removal of Works from the Public Domain Alters the Traditional Contours of Copyright Protection and Requires First Amendment Scrutiny**

We begin our First Amendment analysis by examining the intersection of the Copyright Clause and the First Amendment. In doing so, we address the *Eldred* Court’s holding that the CTEA’s extension of existing copyrights did not require First Amendment scrutiny and discuss the Court’s suggestion that an act of Congress would only be subject to First Amendment review if it “altered the traditional contours of copyright protection.” 537 U.S. at 221. Based on the *Eldred* Court’s analysis, we examine the bedrock principle of copyright law that works in the public domain remain there and conclude that § 514 alters the traditional contours of copyright protection by deviating from this principle. We then explain how this deviation implicates plaintiffs’ First Amendment interest in the works at issue and determine that copyright’s two built-in free speech safeguards – the idea/expression dichotomy and the fair use defense – do not adequately protect the First Amendment interests. Finally, we note that, unlike the CTEA, the URAA does not adopt supplemental free speech safeguards.

a. *The Copyright Clause & the First Amendment*

It is clear that the Copyright Clause is meant to foster values enshrined in the First Amendment. *See Harper & Row*, 471 U.S. at 558 (observing that “the Framers intended copyright itself to be the engine of free expression”). The Clause’s primary purpose is to provide authors with incentives to produce works that will benefit the public. *See id.* at 546 (“The monopoly created by copyright thus rewards the individual author *in order to benefit the public.*”) (internal quotation marks omitted) (emphasis supplied); *Aiken*, 422 U.S. at 156 (“The immediate effect of our copyright law is to secure a fair return for an ‘author’s’ creative labor. But the *ultimate aim* is, by this incentive, to stimulate artistic creativity for the general public good.”) (emphasis supplied); *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (“The economic philosophy behind the clause empowering Congress to grant [ ] copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors . . . in ‘. . . [the] useful Arts.’”); *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932) (“The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors.”).

In *Eldred*, the connection between the First Amendment and copyright prompted the Court to reject the proposition that “copyrights [are] categorically immune from challenges under the First

Amendment.” 537 U.S. at 221 (internal quotation marks omitted). However, under the facts of *Eldred*, copyright’s inherent free speech protections obviated any need for First Amendment review of the CTEA. The Court based this holding on three factors. First, the Court concluded that copyright law’s “built-in First Amendment accommodations” – the idea/expression dichotomy and fair use defense – adequately protected the First Amendment interests at stake. *Id.* at 219. Second, the Court reasoned that the plaintiffs had only a trivial interest in the copyrighted works because “[t]he First Amendment securely protects the freedom to make – or decline to make – one’s own speech; it bears less heavily when speakers assert the right to make *other people’s* speeches.” *Id.* at 221 (emphasis supplied). Finally, the Court noted that the CTEA provided supplemental protections to ensure that the Act did not diminish the public’s access to protected expression. *Id.* at 220. The Court further indicated that legislation could be subject to First Amendment scrutiny if it “altered the traditional contours of copyright protection.” *Id.* at 221.

- b. *The principle that works in the public domain remain there is a traditional contour of copyright protection that § 514 alters*

We begin our analysis of § 514 by exploring the traditional contours of copyright protection. The *Eldred* Court did not define the “traditional contours

of copyright protection,” and we do not find, nor do the parties suggest that the phrase appears in any other federal authority that might shed light on its meaning. Nevertheless, the term seems to refer to something broader than copyright’s built-in free speech accommodations.

Our understanding of the traditional contours of copyright protection has both a functional and a historical component. With regard to the functional aspect, we note that a contour is “an outline” or “the general form or structure of something.” WEBSTER’S NINTH NEW COLLEGIATE DICTIONARY 284 (1984). Because the term copyright refers to a process as well as a form of intellectual property rights, we assess whether removing a work from the public domain alters the ordinary procedure of copyright protection. Relatedly, we explore the way in which the public domain delimits the scope of copyright protection. In addition, the *Eldred* Court’s use of the word “traditional” to modify “contours” suggests that Congress’s historical practice with respect to copyright and the public domain must inform our inquiry. Based on these criteria, we conclude that the traditional contours of copyright protection include the principle that works in the public domain remain there and that § 514 transgresses this critical boundary.

i. Copyright Sequence

Although the specific requirements for perfecting a copyright have changed over the years, the process

has always begun when an author generates an original expression. The 1909 Copyright Act required an author seeking protection to attach notice to any distributed copies of his or her work. Moreover, the author could not initiate an infringement action or apply for a renewal unless he or she had formally registered the work with the copyright office. The 1976 Act removed many of the consequences for failure to register or attach notice, and, in 1989, the United States effectively abandoned all formalities as a condition of compliance with the Berne Convention. Thus, today, a limited copyright attaches at the moment a work is created.<sup>3</sup> When the copyright expires at the end of the statutory period, the work becomes part of the public domain. Until § 514, every statutory scheme preserved the same sequence. A work progressed from 1) creation; 2) to copyright; 3) to the public domain. Under § 514, the copyright sequence no longer necessarily ends with the public domain: indeed, it may begin there. Thus, by copyrighting works in the public domain, the URAA has altered the ordinary copyright sequence.

## ii. Public Domain

The significance of the copyright sequence, combined with the principle that no individual may copyright a work in the public domain, is that

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<sup>3</sup> An author must still include notice in order to defend against “innocent infringer[s].” GORMAN, *supra*, at 91.

ordinarily works in the public domain stay there. *See Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1287 (10th Cir. 1996) (holding that a doll design could not be copyrighted because it was characterized by “typical paper doll features found in the public domain”); *Lipton v. Nature Co.*, 71 F.3d 464, 470 (2d Cir. 1995) (“[F]acts are considered to be in the public domain and therefore not protectable under copyright law. . . .”); *Norma Ribbon & Trimming, Inc. v. Little*, 51 F.3d 45, 48 (5th Cir. 1995) (holding that certain flowers could not be copyrighted “because these same flowers already existed in the public domain”); *United States v. Hamilton*, 583 F.2d 448, 450 (9th Cir. 1987) (noting that “a map which represents a new combination of information already in the public domain lacks any element worthy of copyright protection”); *M.M. Bus. Forms Corp. v. Uarco, Inc.*, 472 F.2d 1137, 1140 (6th Cir. 1973) (“Elementary legal words and phrases are in the public domain and no citizen may gain monopoly thereover to the exclusion of their use by other citizens.”); *Amsterdam v. Triangle Publ’ns, Inc.*, 189 F.2d 104, 106 (3d Cir. 1951) (“The location of county lines, township lines and municipal lines is information within the public domain, and is not copyrightable.”); *Christianson v. West Pub. Co.*, 149 F.2d 202, 203 (9th Cir. 1945) (“The outline map of the United States with state boundaries is in the public domain and is not copyrightable.”) (internal quotation marks omitted); *Meade v. United States*, 27 Fed. Cl. 367, 372 (1992) (holding that “defendant’s LOVE stamp” could not be copyrighted because it “exist[ed] in the public domain”); *see also Toro Co. v. R & R*

*Prods. Co.*, 787 F.2d 1208, 1213 (8th Cir. 1908) (“If the disputed work is similar to a pre-existing protected work or one in the public domain, the second work must contain some variation recognizable as that of the second author.”).

In *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936), *aff’d*, 309 U.S. 390, 392 (1940), Judge Learned Hand, a luminary in the field of copyright law, illustrated this principle when he stated that “if by some magic a man who had never known it were to compose anew Keats’s Ode on a Grecian Urn, he would be an ‘author,’ and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats.” *Sheldon*, 81 F.2d at 54. As Judge Hand observed, Keats’s poems remained in the public domain – free for anyone to copy – even if someone copyrighted the identical language. Section 514 contravenes this principle.

iii. The history of American copyright law reveals no tradition of copyrighting works in the public domain

As we stated above, the fact that the *Eldred* Court used the word “traditional” to modify “contours” suggests that the history of American copyright law should inform our inquiry. *Eldred*, 537 U.S. at 221. Accordingly, we look for evidence indicating that the Framers believed removal of works from the public domain was consistent with the copyright scheme they designed. Congress’s past practices are

also pertinent to determining whether extricating works from the public domain is a tradition of our country's copyright law.

### **a. The Framers' Views**

Unfortunately, constitutional historians know little about the Framers' views regarding copyright and the public domain. In part, this is because, when the states ratified the Constitution, "the Common Law of the United States . . . was in a highly uncertain state on the subject of copyrights." 1 William W. Crosskey, *POLITICS AND THE CONSTITUTION IN THE HISTORY OF THE UNITED STATES* 477 (1953). Uncertainty also stems from the fact that none of the usual, reliable sources – The Federalist Papers, Madison's notes from the Constitutional Convention, or accounts of the First Congress's deliberations – take up the subject in any detail.

Passed in 1790, the first Copyright Act granted fourteen years of protection for books, maps, and charts already printed in the United States. *See Eldred*, 537 U.S. at 194 (discussing the 1790 Act). The parties debate whether the First Congress extended copyright protection to works already in the public domain. While the *Eldred* Court recognized that "the First Congress clearly did confer copyright protection on works that had already been created," *id.* at 196 n.3, plaintiffs argue convincingly that most, if not all, of these works were covered by a *state* common-law copyright and therefore not in the public domain. In

response, the government observes that not all states enacted copyright statutes during the period of the Articles of Confederation. See *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 350 (1998) (citing Copyright Enactments: Laws Passed in the United States Since 1783 Relating to Copyright 21 (Copyright Office ed., Bulletin No. 3, rev. 1963)); Thomas B. Nachbar, *Intellectual Property and Constitutional Norms*, 104 Colum. L. Rev. 272, 338 n.284 (2004) (“Of the general copyright laws passed by the States during the years of the Articles of Confederation, two of them (Maryland and Pennsylvania) never even came into effect; they included reciprocity clauses that were never fulfilled because one State, Delaware, never enacted a general copyright law. . .”).

Although the history of the 1790 Act could be highly informative of the Framers’ views, the answer to the question of whether Congress thought it was removing works from the public domain is probably not just unclear but also unknowable. Edward C. Walterscheid, *Understanding the Copyright Act of 1790: the Issue of Common Law Copyright in America and the Modern Interpretation of the Copyright Power*, 53 J. Copyright Soc’y U.S.A. 313, 332 (2006) (“There is very little contemporaneous legislative history dealing with the 1790 Act.”); see also *id.* at 340 (“[I]t is impossible to demonstrate with any reasonable certainty from the language of the 1790 Copyright Act and the circumstances surrounding its enactment that Congress believed that it was

creating a property right in authors rather than affirming and protecting an existing common-law right, albeit for a limited time.”).

Given the scarcity of historical evidence, we cannot conclude that the Framers viewed removal of works from the public domain as consistent with the copyright scheme they created. Nor do we discern at the dawn of the Republic any burgeoning tradition of removing works from the public domain.

**b. \_\_\_Congressional Practice Since the First Congress**

At oral argument, the government conceded that apart from the 1790 Act’s purported grant of copyright protection to works in the public domain, there have been few instances of such grants since. It does, however, point to a series of private bills granting copyrights to individuals. But “[t]hese private bills do not support the [government’s] historical gloss, but rather significantly undermine the historical claim.” *Eldred*, 537 U.S. at 234 (Stevens, J., dissenting). Far from providing evidence that copyrighting works in the public domain is within the traditional contours of copyright protection, the fact that individuals were forced to resort to the uncommon tactic of petitioning Congress demonstrates that this practice was *outside* the normal practice.

In addition, the government argues that the wartime acts of Dec. 18, 1919, Pub. L. No. 66-102, 41

Stat. 368, and the Emergency Copyright Act of 1941, Pub. L. No. 77-258, 55 Stat. 732, removed works from the public domain by granting the President authority to give foreign authors additional time to comply with copyright requirements. However, a review of the historical record reveals that these emergency wartime bills, passed in response to exigent circumstances, merely altered the means by which authors could comply with the procedural rules for copyright; these bills were not explicit attempts to remove works from the public domain. The Emergency Copyright Act of 1941, for example, recognized that authors “may have been *temporarily unable to comply* with [copyright formalities] because of the disruption or suspension of facilities essential for such compliance.” 55 Stat. 732 (emphasis supplied).

The statutory context of these acts reveals that they were, at most, a brief and limited departure from a practice of guarding the public domain. In previous actions granting copyrights to foreign authors, Congress emphasized that it was not attempting to interfere with the rights of Americans who had relied on the foreign works. For example, the 1919 Act stated that “nothing herein contained shall be construed to deprive any person of any right which he may have acquired by the republication of such foreign work in the United States prior to approval of this Act.” 41 Stat. 369. One of the Acts to which the 1919 Act referred was the 1909 Copyright Act. That Act made clear that “no copyright shall subsist in the original text of any work which is *in the public*

*domain.*” Copyright Act, Pub. L. No. 60-349, 35 Stat. 1075, 1077 (1909) (emphasis supplied).

This context notwithstanding, the wartime acts may have had the effect of removing a very small number of works from the public domain. Nevertheless, this possibility is insufficient to establish a traditional contour of copyright law. Indeed, world war is (hopefully) not traditional. The fact that the legislation was passed in response to the exigencies of a world war suggests that Congress felt compelled to depart from its normal practice of preserving the public domain. Moreover, the mere passage of these discrete acts does not indicate that such removal was consistent with any provision of the Constitution, including the First Amendment. See 3 NIMMER ON COPYRIGHT § 9A.07[A], 9A-79 to -80 (2007) (stating that “although three [wartime] enactments granted very limited resurrection, . . . the practice under those circumscribed enactments was simply to sweep the constitutional issues under the rug”).

Based on the foregoing, we see no tradition of removing works from the public domain. Indeed, if anything, our examination of the history of American copyright law reveals that removal was the exception rather than the rule. Thus, § 514 deviates from the time-honored tradition of allowing works in the public domain to stay there.

iv. Conclusion

In sum, by extending a limited monopoly to expressions historically beyond the pale of such privileges, the URAA transformed the ordinary process of copyright protection and contravened a bedrock principle of copyright law that works in the public domain remain in the public domain. Therefore, under both the functional and historical components of our inquiry, § 514 has altered the traditional contours of copyright protection.

c. *The URAA's removal of works from the public domain implicates plaintiffs' First Amendment interest*

We now explain how this alteration of traditional contours affects the First Amendment interests of these plaintiffs. To begin, as discussed above, copyright law bears out the rather obvious – but significant – point that works in the public domain belong to the public. See *Dastar*, 539 U.S. at 33-34 (2003) (“[O]nce the . . . copyright monopoly has expired, the public may use the . . . work at will and without attribution.”); *Am. Tobacco Co. v. Werckmeister*, 207 U.S. 284, 299-300 (1907) (observing that widespread publication of a work without copyright protection “render[s] such work *common property*”) (emphasis supplied). As Judge Hand made clear in *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, 191 F.2d 594, 603 (2d Cir. 1951), a case that involved copyrights to “Superman” and “Captain Marvel” comic strips, “once [the strips fell] into the

public domain . . . *anyone might copy them.*” In other words, each member of the public – “anyone” – has a non-exclusive right, subject to constitutionally permissible legislation, to use material in the public domain. The implication of this principle is that the plaintiffs here possessed a non-exclusive right to use the works at issue.

Furthermore, the First Amendment protects plaintiffs’ right to unrestrained artistic use of these works. The Supreme Court has emphasized that the right to artistic expression is near the core of the First Amendment. *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989) (“Music is one of the oldest forms of human expression. From Plato’s discourse in the Republic to the totalitarian state in our own times, rulers have known [music’s] capacity to appeal to the intellect and to the emotions, and have censored musical compositions to serve the needs of the state. . . . The Constitution prohibits any like attempts in our own legal order. Music, as a form of expression and communication, is protected under the First Amendment.”); *Schad v. Borough of Mount Ephraim*, 452 U.S. 61, 65 (1981) (“Entertainment, as well as political and ideological speech, is protected; motion pictures, programs broadcast by radio and television, and live entertainment, such as musical and dramatic works, fall within the First Amendment guarantee.”); *Kaplan v. California*, 413 U.S. 115, 119-120 (1973) (“[P]ictures, films, paintings, drawings, and engravings . . . have First Amendment protection. . . .”).

Together, the clear import of these principles is that the public in general and these plaintiffs in particular have a First Amendment interest in using works in the public domain. For example, at the moment that Dmitri Shostakovich's *Symphony No. 5* entered the public domain, Plaintiff John Blackburn had a right to create a derivative work for a high school band to perform at an event commemorating 9/11. The principle of copyright law that shields works in the public domain from copyright ensured Mr. Blackburn's right to create the piece, and the First Amendment protected his right to perform it.

Section 514 has interfered with Mr. Blackburn's right by making the cost of performance or creation of new derivative works based on Shostakovich's *Symphony No. 5* prohibitive. Moreover, as the example of Mr. Blackburn's composition suggests, plaintiffs' First Amendment interests in public domain works are greater than the interests of the *Eldred* plaintiffs. The *Eldred* plaintiffs did not – nor had they ever – possessed unfettered access to any of the works at issue there. As the *Eldred* Court observed, the most the *Eldred* plaintiffs could show was a weak interest in “making other people's speeches.” 537 U.S. at 221. By contrast, the speech at issue here belonged to plaintiffs when it entered the public domain. In reliance on their rights to these works, plaintiffs have already performed or planned future performances

and used these publically available works to create their own artistic productions.<sup>4</sup>

By removing works from the public domain, § 514 arguably hampers free expression and undermines the values the public domain is designed to protect. *See Meade*, 27 Fed. Cl. at 372 (“Extending copyright protection to a heart-shaped picture of earth effectively would grant the copyright holder a monopoly over the innumerable ways of expressing this picture. Allowing this picture to remain in the public domain for all artists to interpret freely, however, will foster creativity by ensuring that future mapmakers and artists have an ample store of ideas on which to build their works.”). We therefore conclude that once the works at issue became free for anyone to copy, plaintiffs in this case had vested First Amendment interests in the expressions, and § 514’s interference with plaintiffs’ rights is subject to First Amendment scrutiny.

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<sup>4</sup> Interestingly, during the *Eldred* oral argument, Justice Souter asked then-Solicitor General Olsen whether the Copyright Clause combined with the Necessary and Proper Clause could justify the extension of monopoly privileges to a “copyright that expired yesterday.” Aplt’s Supp. Auth. dated June 2, 2006, Transcript of Oral Argument at 44, *Eldred v. Ashcroft*, 537 U.S. 186 (No. 01-618). The Solicitor General replied that although such an act was not inconceivable, the public domain likely presented a “bright line” because once “[s]omething . . . has already gone into the public domain [] other individuals or companies or entities may then have acquired an interest in, or rights to be involved in disseminating [the work.]” *Id.*

f. *Copyright's built-in free speech safeguards are not adequate to protect the First Amendment interests at stake*

In *Eldred*, the Court indicated that “copyright’s built-in free speech safeguards are *generally* adequate to address [First Amendment concerns].” 537 U.S. at 221 (emphasis supplied). Below, we conclude that the idea/expression dichotomy and the fair use defense are not designed to combat the threat to free expression posed by § 514’s removal of works from the public domain.

i. *Idea/Expression Dichotomy*

The idea/expression dichotomy protects First Amendment interests by ensuring that “no author may copyright facts or ideas. The copyright is limited to those aspects of the work – termed ‘expression’ – that display the stamp of the author’s originality.” *Harper & Row*, 471 U.S. at 547 (citation omitted). The Supreme Court has observed that the idea/expression dichotomy “strikes a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author’s expression.” *Eldred*, 537 U.S. at 219 (quoting *Harper*, 471 U.S. at 556). See 4 NIMMER ON COPYRIGHT, *supra*, § 19E.03[A][2], at 19E-20 to -21 (“In general, the democratic dialogue – a self-governing people’s participation in the marketplace of ideas – is adequately served if the public has access to an author’s ideas, and such loss to the dialogue as results from inaccessibility to an author’s

‘expression’ is counterbalanced by the greater public interest in the copyright system.”).

However, the idea/expression dichotomy’s utility as a definitional mechanism is limited to determining whether a proposed work is an idea or whether the work displays sufficient originality to constitute an expression. In the typical case, the danger to free speech interests is that an individual might gain monopoly privileges over an idea. Here, by contrast, there is no doubt that the works at issue are expressions; the threat to free expression lies not in what is being copyrighted, but in the fact that the works are being removed from the public domain. The idea/expression dichotomy is simply not designed to determine whether Congress’s grant of a limited monopoly over an expression in the public domain runs afoul of the First Amendment.

## ii. Fair Use Defense

“The [fair use] defense provides: the fair use of a copyrighted work, including such use by reproduction in copies . . . , for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.” 17 U.S.C. § 107 (internal quotation marks omitted). “[It] allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances.” *Eldred*, 537 U.S. at 219. For example,

although Ralph Ellison's estate may retain the copyright to his classic novel *Invisible Man*, the fair use defense permits scholars and teachers to quote extensively from the book and even reproduce entire sections for the purpose of commenting on (say) the parallels between the narrator's literal and figurative vision. Because the purpose of the fair use defense is to "afford[ ] considerable latitude for scholarship and comment," *Eldred*, 537 U.S. at 220 (quoting *Harper*, 471 U.S. at 560), the Court has described it as a "guarantee of breathing space within the confines of copyright." *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

In our view, the fair use doctrine is not a sufficient safeguard of plaintiffs' First Amendment interests. Although the doctrine allows limited use of copyrighted works, it does not address works that have entered the public domain and are therefore available for unrestricted use. By withdrawing works from the public domain, § 514 leaves scholars, artists, and the public with less access to works than they had before the Act. The fact that the fair use doctrine permits some access to those works may not be an adequate substitute for the unlimited access enjoyed before the URAA was enacted. Thus, instead of providing additional "breathing space" for free expression, the fair use defense suggests that § 514 infringes upon plaintiffs' First Amendment rights.

In sum, "copyright's built-in free speech safeguards," *Eldred*, 537 U.S. at 221, are designed to govern the distribution of rights between authors and

the public from the moment a work is created and copyrighted until the copyright expires. This design presumes that some rights are properly reserved for the author who has never relinquished his right to exploitation. Once a work has entered the public domain, however, neither the author nor the author's estate possesses any more right to the work than any member of the general public. Because § 514 bestows copyrights upon works in the public domain, these built-in safeguards are not adequate to protect plaintiffs' First Amendment interests.

iii. *The URAA does not supplement the traditional First Amendment safeguards*

In concluding that the CTEA did not require First Amendment scrutiny, the *Eldred* Court noted that “the CTEA [ ] supplements the[ ] traditional safeguards.” *Id.* The Court described the additional protections as follows:

First, [the CTEA] allows libraries, archives, and similar institutions to “reproduce” and “distribute, display, or perform in facsimile or digital form” copies of certain published works “during the last 20 years of any term of copyright . . . for purposes of preservation, scholarship, or research” if the work is not already being exploited commercially and further copies are unavailable at a reasonable price. 17 U.S.C. § 108(h). Second, Title II of the CTEA, known as the Fairness in Music Licensing Act of 1998, exempts small

businesses, restaurants, and like entities from having to pay performance royalties on music played from licensed radio, television, and similar facilities.

*Id.* at 220 (quoting 17 U.S.C. § 108(h)) (some internal citations omitted).

The URAA contains none of the CTEA's supplemental First Amendment protections. It neither provides exceptions for "libraries, archives and similar institutions," nor exemptions for "small businesses, restaurants and like entities from having to pay performance royalties." 17 U.S.C. § 108(h). Rather than excepting parties, such as plaintiffs, who have relied upon works in the public domain, the URAA provides only a safe harbor allowing a party to use a restored work for one year after receiving notice of the restored copyright protection. 17 U.S.C. § 104A(d)(2). We note, however, that it does permit a party to continue to use a work if notice is not given. *See Luck's Music*, 467 F.3d at 1265 (discussing § 104A(d)(2)). When compared to the CTEA, this is hardly a "guarantee of breathing space." *Campbell*, 510 U.S. at 579.

#### **IV. INSTRUCTIONS FOR REMAND**

In conducting its First Amendment analysis on remand, the district court should assess whether § 514 is content-based or content-neutral. Content-based restrictions on speech are those which "suppress, disadvantage, or impose differential burdens upon speech because of its content." *Grace United*

*Methodist Church v. City of Cheyenne*, 451 F.3d 643, 657 (10th Cir. 2006) (internal citations and quotations omitted). These restrictions “are subject to the most exacting scrutiny.” *Id.* If § 514 is a content-based restriction, then the district court will need to consider whether the government’s interest in promulgating the legislation is truly “compelling” and whether the government might achieve the same ends through alternative means that have less of an effect on protected expression.<sup>5</sup> *United States v.*

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<sup>5</sup> Although not mentioned by the parties, Congress’s treaty, commerce, and takings powers may provide Congress with the authority to enact § 514. See 3 NIMMER ON COPYRIGHT § 9A.07[B], 9A-79 to -80, 90A.07[C], 9A-85. We also note that at oral argument, Professor Lessig claimed that the experience of other countries, such as the United Kingdom, suggests that the United States could comply with the Berne Convention through less restrictive means. Indeed, the United Kingdom Copyright Statute, as well as the statutes in Australia, Canada, India, and New Zealand, define a reliance party as any person who “incurs or has incurred any expenditure or liability in connection with, for the purpose of or with a view to the doing of an act which at the time is not or was not an act restricted by any copyright in the work.” Irwin Karp, *Final Report, Berne Article 18 Study on Retroactive United States Copyright Protection for Berne and Other Works*, 20 COLUM.-VLA J.L. & Arts 157, 178 (Winter 1996) (quoting “The Copyright (Application to Other Countries) Order in Council 988”; June 13, 1989, Article 7(2), reprinted in *Copyright Laws and Treaties of the World*, UK: Item 7c, at 2 (Unesco Supp.1989-1990)). Under the British, Canadian, Australian, and Indian systems, “the reliance party is allowed to continue making those uses of the work it had made, or incurred commitments to make, before its copyright is restored. But the reliance party can be ‘bought out’ by the owner of the restored copyright. That is, the reliance party must cease exploiting the

(Continued on following page)

*Playboy Entm't Group, Inc.*, 529 U.S. 803, 813 (2000). By contrast, “[a] regulation that serves purposes unrelated to the content of expression is deemed neutral, even if it has an incidental effect on some speakers or messages but not others.” *Rock Against Racism*, 491 U.S. at 791. A content-neutral restriction must be “narrowly tailored to serve a significant governmental interest.” *Id.* (quoting *Clark v. Cmty. for Creative Non-Violence*, 468 U.S. 288, 293 (1984)).

## V. CONCLUSION

For the foregoing reasons, we affirm the district court’s dismissal of the CTEA claim as foreclosed by *Eldred*. We also affirm the district court’s holding that § 514 of the URAA does not exceed the limitations inherent in the Copyright Clause. Nevertheless, since § 514 has altered the traditional contours of copyright protection in a manner that implicates plaintiffs’ right to free expression, it must be subject to First Amendment review. We therefore REMAND for proceedings consistent with this opinion.

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work if the owner pays compensation, in an amount to be determined by negotiation or arbitration.” *Id.*

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**05-1259**

**IN THE UNITED STATES COURT OF  
APPEALS FOR THE TENTH CIRCUIT**

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LAWRENCE GOLAN, ESTATE OF RICHARD KAPP,  
S.A. PUBLISHING COL, INC., d/b/a ESS.A.Y.  
RECORDINGS, SYMPHONY OF THE CANYONS,  
RON HALL d/b/a FESTIVAL FILMS, AND  
JOHN McDONOUGH, d/b/a TIMELESS  
VIDEO ALTERNATIVES INTERNATIONAL,  
Plaintiffs-Appellants,

v.

MICHAEL MUKASEY, in his official capacity  
as Attorney General of the United States, and  
MARYBETH PETERS, Register of Copyrights,  
Copyright Office of the United States,  
Defendants-Appellees.

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On Appeal from the United States District Court  
for the District of Colorado

Honorable Lewis T. Babcock, Chief Judge  
Case No. 1:01-cv-01854 LTB-BNB

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**APPELLANTS' RESPONSE TO APPELLEES'  
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**ARGUMENT**

The government’s petition has presented no argument that the panel did not adequately consider and address in its careful and balanced opinion produced after fifteen months of deliberation.

But the petition has at least made it perfectly clear just how extreme the rule the government advances is. Though it had come close both in this case and others before, its petition for review en banc

is the clearest articulation so far of the radical rule that the government derives from the Supreme Court's opinion in *Eldred v. Ashcroft*: In the government's view, *Eldred* permits First Amendment review of a copyright statute if *but only if* that statute changes either copyright's (1) idea/expression dichotomy, or (2) "fair use." Beyond these two grounds, "copyright is categorically immune from challenges under the First Amendment." *Eldred v. Reno*, 239 F.3d 372, 375 (D.C. Cir. 2001), *aff'd on other grounds sub nom. Eldred v. Ashcroft*, 537 U.S. 186 (2003).

This reading of *Eldred* (1) is inconsistent with the text of the opinion, (2) is in conflict with the specific holding about First Amendment immunity that the Supreme Court articulated in *Eldred*, and (3) produces absurd First Amendment results if applied in the manner in which the government advances it.

By contrast, the panel opinion is fully consistent with both the text and the reasoning of *Eldred*. Its result is simply that a practice deviating from a longstanding copyright tradition must be tested under the First Amendment. As the First Amendment is the constitutional default for laws regulating speech, the result of the panel opinion is simply to restore that default in cases where Congress has deviated from copyright's tradition. This requirement is in fact precisely what *Eldred* requires. There is no reason for the panel's careful work to be disturbed now by the court en banc.

## **I. The Government’s Reading Of *Eldred* Is Inconsistent With The Plain Text Of That Opinion**

In *Eldred v. Ashcroft*, 537 U.S. 186 (2003), the Supreme Court articulated a special exemption from First Amendment review for copyright statutes. If a copyright act is within the “traditional contours of copyright protection,” then “further First Amendment review” is unnecessary. *Eldred*, 537 U.S. at 221. But if an act deviates from these “traditional contours of copyright protection,” then ordinary First Amendment review is required.

The only disagreement between the government and Appellants is the scope of the phrase “traditional contours of copyright protection.”

The government argues that term is exhausted by the two “First Amendment safeguards” articulated by the Supreme Court earlier in the *Eldred* opinion, namely (1) the idea/expression dichotomy, and (2) fair use. As the government argues, if, *but only if*, Congress changes these two “safeguards,” then “further First Amendment review” is required. Any change beyond these two “safeguards” is beyond the scope of First Amendment review. As the government writes,

[i]n context, it is unmistakably clear that “the traditional contours of copyright protection” referred to in *Eldred* comprise the idea/expression dichotomy and the doctrine of fair use.

(Pet. 10.) The “broad discretion of Congress,” the government writes later in its petition, is

*subject only* to the requirements of the Copyright Clause, the idea/expression dichotomy and the fair use doctrine.

(Pet. 13-14) (emphasis added).

Appellants, and the panel opinion, read the scope of the “traditional contours of copyright protection” to refer not just to the “First Amendment safeguards” identified by the Court, but to any “traditional contours of copyright protection” that might raise free speech interests. No doubt, as the panel noted, the “built-in free speech safeguards will ordinarily insulate legislation from First Amendment review.” (Op. 9.) But as the panel also rightly noted, the Supreme Court did not stop with these “built-in safeguards.” Instead, “the *Eldred* Court indicated that [additional] review is warranted when an act of Congress has ‘altered the traditional contours of copyright protection.’” (Op. 9-10.) This understanding makes perfect sense of the actual words the Court used (since it is actually consistent with the words the Court used). It makes perfect sense of judicial resources in reviewing Congress’s copyright legislation (since it narrows review to *changes* from a tradition, and not to every law enacted within that tradition).

On the government’s reading of *Eldred*, the Court simply misspoke when it triggered “further First Amendment review” upon “traditional contours of copyright protection.” What it meant, on the government’s

view, was not “traditional contours” but rather the two “First Amendment safeguards” that it had previously identified. The government thus asks this Court in effect to read *Eldred* to say,

“when, as in this case, Congress has not altered these two traditional First Amendment safeguards, further First Amendment review is not necessary”

*rather than* what the opinion actually says:

“when, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.”

*Eldred*, 537 U.S. at 221.

The panel’s opinion adequately demonstrates why there is no need to rewrite the Supreme Court’s opinion. Its words are plain enough. And while they articulate a standard not yet fully explicated, that is not surprising, given *Eldred* was the first case to raise a First Amendment challenge to a copyright statute. Instead, the proper work of the lower courts is exactly what the panel demonstrated in Section II.b of its opinion, when it carefully parsed, and gave useable meaning to, the Court’s “traditional contours” language. (Op. 19.) That analysis makes perfect sense of *Eldred*; it offers useful guidance to other courts; and it merits no correction, or further review, by the court en banc.

The government's reading is also inconsistent with another part of *Eldred*. Again, the government argues that changes in the two "First Amendment safeguards" are the exclusive grounds upon which a First Amendment challenge to a copyright statute might be raised. But the Supreme Court did not say that these two "First Amendment safeguards" were *always* adequate First Amendment protections. The Court said that they are "generally adequate." *Eldred*, 537 U.S. at 221. As the government itself quotes *Eldred*, "[t]he Court therefore concluded that, to the extent that copyright protections 'raise First Amendment concerns, copyright's built-in free speech safeguards are *generally adequate* to address them.'" (Pet. 8, quoting *Eldred*, 537 U.S. at 221 (emphasis added)).

If the Supreme Court recognized that policing these two "First Amendment safeguards" would just be "*generally adequate*" to protecting First Amendment values, the government offers no reason why the Court would then leave the First Amendment values unprotected in the exceptional case – where these "First Amendment safeguards" are inadequate.

The panel's opinion leaves no such gap. In the exceptional case, if a plaintiff can demonstrate that Congress has deviated from the "traditional contours of copyright protection," then that deviation would be measured by the First Amendment.

## II. The Government's Reading Of *Eldred* Is Inconsistent With The Supreme Court's Express Rejection Of The D.C. Circuit's Standard

The Supreme Court in *Eldred* explicitly rejected the First Amendment rule advanced by the D.C. Circuit. As the Court wrote,

We recognize that the D.C. Circuit spoke too broadly when it declared copyrights “categorically immune from challenges under the First Amendment.” 239 F.3d at 375. But when, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.

537 U.S. at 221.

But the language of the D.C. Circuit (“categorically immune from challenges under the First Amendment”) should not be read out of context. The D.C. Circuit had not held that a First Amendment challenge to a copyright act could never be raised. Instead, its opinion explicitly narrowed the immunity it asserted to challenges beyond changes in (1) the idea/expression dichotomy, or (2) “fair use.” Immediately after the D.C. Circuit wrote the text quoted by the Supreme Court, the D.C. Circuit explained that such immunity exists only where the law regulates “expression” and leaves “fair use” protected. Only such copyright laws receive First Amendment immunity. As the D.C. Circuit wrote (again, in very next

paragraph after the “categorically immune” language):

that puts the works on the latter half of the “idea/expression dichotomy” and makes them subject to fair use. This obviates further inquiry under the First Amendment.

239 F.3d at 376. Put differently, so long as the idea/expression dichotomy remains, and so long as speech is subject to fair use, in the D.C. Circuit’s view, that “obviates further inquiry under the First Amendment.”

This standard – again, expressly rejected by the Supreme Court – is precisely the standard the government is advancing in this case again. The Court expressly stated that standard went too far, and it immediately stated a standard to govern in its place – one triggered not by deviations in “First Amendment safeguards,” but by deviations from the “traditional contours of copyright protection.” The government’s argument thus is flatly inconsistent with *Eldred*, to the extent the Supreme Court’s express statement rejecting the D.C. Circuit standard is given any fair meaning.

The government’s petition for rehearing works very hard to obscure this critical point about *Eldred*. As the government writes:

In this context, while the Court acknowledged that copyrights may not be “‘categorically immune from challenges under the First Amendment,’” *id.* at 221 (citation omitted) –

i.e., the mere label of “copyright,” applied without regard to fair use or the idea/expression distinction, would not immunize a statute from First Amendment review – it held that “when, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.”

(Pet. 8.)

But again, the D.C. Circuit had not made the (absurd) argument that merely labeling something “copyright” immunized it from First Amendment scrutiny. Again, the D.C. Circuit had acknowledged that fair use and the idea/expression dichotomy were First Amendment requirements. The Supreme Court was thus not rejecting the absurd statement that the government attributes to the D.C. Circuit here. The Supreme Court was rejecting – expressly – the standard for First Amendment review that the government advances here. The government’s standard is *precisely* the standard of the D.C. Circuit. The Supreme Court has *expressly* rejected that standard.

There is no reason this Court should ignore the plain and express statement in *Eldred* that a First Amendment rule that limits First Amendment review to changes in the “First Amendment safeguards” speaks “too broadly.” Instead, this Court should, as the panel did, apply the First Amendment standard that states a different, tradition-based rule for determining the scope of First Amendment review.

### III. The Government's Reading Of *Eldred* Produces Absurd Results

On the government's reading of *Eldred*, the only changes in the Copyright Act giving rise to a First Amendment question are changes in (1) the idea/expression dichotomy, and (2) "fair use." If these indeed are the only grounds for First Amendment review, then there are obvious changes in the Copyright Act that survive First Amendment review under the government's rule but cannot possibly be the law.

As Appellants argued to the panel, for example, a law that exempted "hate speech" from copyright protection would neither (1) change the idea/expression dichotomy, nor (2) alter fair use. But obviously such a law would be subject to First Amendment review. *Cf. R.A.V. v. St. Paul*, 505 U.S. 377 (1992) (striking hate speech statute). Likewise with a law removing from copyright protection works by convicted criminals. Again, such a law would not change "First Amendment safeguards." But no court would hold that sufficient to exempt the law from ordinary First Amendment review. *Cf. Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105 (1991) (invalidating law that regulated an accused or convicted criminal's income from work describing the crime). In both cases, such a copyright law would deviate from the "traditional contours of copyright protection." But neither law would be subject to First Amendment review under the standard articulated by the government.

The government has suggested its rule applies to content neutral regulations only. (Appellee Br. 27, *Golan*, No. 15-1259.) But that qualification, too, appears nowhere in the Supreme Court's opinion. It is another made-up qualification on what the Supreme Court wrote, in order to transform *Eldred* into the rule announced by the D.C. Circuit, but expressly rejected by the Supreme Court.

Thus, between

(A) a reading of *Eldred* that (1) assumes an error in the writing (substituting "traditional contours" for "First Amendment safeguards"), (2) ignores important qualifications (e.g., "generally"), and (3) adds a categorical qualification to the scope of the rule (applying to just content neutral regulations)

and

(B) a reading of *Eldred* that (1) accepts the Court at its word, (2) recognizing that "First Amendment safeguards" are only "generally" adequate, and (3) has no need to add an unstated qualification to the scope of the rule,

Appellants believe the panel was perfectly correct to select the latter. There is no cause for this court en banc to dislodge the panel's careful and correct interpretation.

#### **IV. The Government's Criticisms Of *Eldred* Are Not Appropriate For This Court To Resolve**

The government repeats the argument it made to the panel, that a standard that triggers First Amendment review upon the “traditional contours of copyright protection” is “impossible to administer.” (Pet. 12.) The government both misstates the panel’s work and complains to the wrong court.

But for the special immunity from First Amendment review articulated clearly by the Court for the first time in *Eldred*, every copyright act would be subject to ordinary First Amendment review. Just as a law regulating speech passed pursuant to the Commerce Power is subject to First Amendment review, *see, e.g., Turner Broad Sys. v. FCC*, 520 U.S. 180, 189 (1997) (cable law, passed pursuant to Commerce Clause authority, cannot “burden substantially more speech than necessary to further [the legitimate governmental] interests.”), for *Eldred* immunity, a law regulating speech (as copyright law plainly does) passed pursuant to the Progress Clause would have to satisfy the First Amendment.

This constitutional default notwithstanding, *Eldred* grants Congress a huge swath of First Amendment immunity. Because of the 212 year history of copyright regulation, the Court granted to any copyright regulation within the “traditional contours of copyright protection” an immunity from “further First Amendment review.” 537 U.S. at 221.

But it could make *no principled constitutional sense* to grant an immunity to regulations that stand outside those “traditional contours.” While the long history of copyright is enough sensibly to give the Court the assurance it needs to waive First Amendment review, deviation from that tradition gives the Court no reason to waive the ordinary requirement of the First Amendment review.

The government complains that this standard is “impossible to administer.” (Pet. 12.) The “logic,” the government argues, of this test is that “every time Congress makes a formal or substantive change to the ‘traditional’ copyright scheme . . . it has ‘altered the traditional contours of copyright protection.’” (Pet. 13.)

But this willfully misstates what the panel and the Supreme Court said. *Eldred* does not trigger First Amendment review upon changes in “traditional copyright scheme[s].” It triggers First Amendment review upon changes in the “traditional contours of copyright protection.” The “contours” of a regulatory program are obviously broader and less distinct than particular “schemes.”

Thus, even if there has never been an exclusive right granted to “digital audio performances” before, when Congress extended that right in 1995, Digital Performance Right in Sound Recordings Act of 1995 (“DPRA”), Pub. L. No. 104-39, 109 Stat. 336 (1995), it was acting within the traditional contours of copyright, crafting new exclusive rights in light of new

technologies. Or as the Court in *Eldred* found, when Congress extends the term of existing copyrights as part of a statute extending the term of copyrights prospectively, it is acting within the “traditional contours of copyright protection,” since, as the Court read the history, every change from the founding followed precisely this pattern. The *Eldred* test is explicitly targeting fundamental changes, not “every change.” (Pet. 13.) And while that standard will of necessity require line-drawing, the worst that might happen because of any uncertainty produced by line-drawing is that the government is required to do what the constitution by default requires the government to do whenever the government regulates speech: demonstrate that its regulation satisfies the requirements of the First Amendment.

If the government has a problem with the *Eldred* standard, then the proper remedy is to ask the Supreme Court to clarify the rule – rather than, as the government has in a brief filed November 28, 2007, arguing against any review on the basis that the “error” of the panel in the instant case will be reversed en banc. (Br. for Resp’t 13, *Kahle v. Gonzales*, 487 F.3d 697, *pet for cert. pending*, No. 07-189.) The panel has made no “error” in this case. Its opinion is an extraordinarily careful application of an admittedly new constitutional standard. That the government does not like the standard is not a reason to tax this court with any further work.

## **V. The Government Claims About The “Tradition” Of Restoring Copyrights To Works In The Public Domain Was Adequately Rejected By The Panel**

Though the panel spent five pages of its opinion detailing the reasons why it is not the case that “[s]ince 1790, Congress has repeatedly granted protection to works previously in the public domain,” (Pet. 14), the government’s response to that careful analysis is simply to repeat in summary form the flawed arguments the panel rejected.

First, as the panel rightly held, (Op. 24), it is not the case that the copyright act of 1790 “granted protection to works previously in the public domain.” (Pet. 14.) As the panel rightly noted, because of the uncertain status of state common law copyright at the founding, there was no work plainly in the public domain of the United States until the Act of 1790 put it there. This uncertainty is precisely why the Court in *Eldred* expressly reserved judgment about the 1790 Act. *See* 537 U.S. at 197 n.3 (refusing to “resolv[e] dispute” between government and Petitioners).

Second, private bills, as the panel rightly asserted, (Op. 25), cannot constitute a “tradition” in copyright law. If anything, they constitute, as the panel held, a deviation from a tradition.

And third, however one interprets the 20th Century wartime statutes, they certainly cannot define a “traditional contour of copyright protection,” when copyright protection in the United States began

120 years before. Appellants agree with the panel that these wartime measures were not “explicit attempts” to remove works from the public domain. (Op. 25-26.) Even if they were, however, we agree with the panel that they could not constitute a tradition that would displace the tradition that in America, copyrighted works, once entering the public domain, stay there.

### CONCLUSION

The only consequence of the panel’s opinion is that the government must now justify under ordinary First Amendment review its regulation of Plaintiffs’ speech. This is the ordinary rule under our Constitution for any law regulating speech. There is no extraordinary reason for the government to object to its application in the narrow context identified here.

This context is new. The Uruguay Round Agreements Act (“URAA”), Pub. L. No. 103-465, 108 Stat. 4809, 4976-4981 (codified as amended at 17 U.S.C. §§ 104A, 109(a) (1994)), represents a radical change in the tradition of American copyright law. And as the panel rightly pointed out, the speech interests in this case are fundamentally different from *Eldred*: In *Eldred*, plaintiffs challenged laws that restricted access to “other people’s speeches.” 537 U.S. at 221. In this case, the law that is challenged removes speech that “belonged to plaintiffs.” (Op. 30.) By entering the public domain, this speech became owned by us all. The only burden the government now faces is to

justify the removal of Plaintiffs' rights, consistent with the First Amendment.

The panel's opinion represents perhaps the most careful and extensively reasoned opinion about the relationship between the First Amendment and copyright of any in the circuit courts, and perhaps, in any federal court. There is nothing in the government's petition that justifies overturning this extraordinarily valuable work.

Respectfully submitted this 7th day of December, 2007.

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ADDENDUM

[Omitted In Printing]

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**No. 07-189**

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***In the Supreme Court of the United States***

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BREWSTER KAHLE, ET AL., PETITIONERS

*v.*

MICHAEL B. MUKASEY, ATTORNEY GENERAL

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***ON PETITION FOR A WRIT OF CERTIORARI  
TO THE UNITED STATES COURT OF APPEALS  
FOR THE NINTH CIRCUIT***

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**BRIEF FOR THE RESPONDENT IN OPPOSITION**

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## QUESTION PRESENTED

Whether the automatic renewal provisions of the Copyright Renewal Act, Pub. L. No. 102-307, § 102(a)(2)(A)(ii), 106 Stat. 264 (1992), in conjunction with the 20-year copyright extension contained in the Copyright Term Extension Act of 1998, Pub. L. No. 105-298, 112 Stat. 2827, alter the “traditional contours of copyright protection” within the meaning of *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

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*In the Supreme Court of the United States*

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No. 07-189

BREWSTER KAHLE, ET AL., PETITIONERS

*v.*

MICHAEL B. MUKASEY, ATTORNEY GENERAL

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*ON PETITION FOR A WRIT OF CERTIORARI  
TO THE UNITED STATES COURT OF APPEALS  
FOR THE NINTH CIRCUIT*

---

**BRIEF FOR THE RESPONDENT IN OPPOSITION**

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**OPINIONS BELOW**

The amended opinion of the court of appeals (Pet. App. 1a-8a) is reported at 487 F.3d 697. The original opinion of the court of appeals (Pet. App. 9a-16a) is reported at 474 F.3d 665. The order of the district court (Pet. App. 17a-51a) is unreported.

**JURISDICTION**

The judgment of the court of appeals was initially entered on January 22, 2007. The court of appeals issued an amended opinion on May 14, 2007, and a petition for rehearing was denied on the same date (Pet. App. 2a). The petition for a writ of certiorari was

filed on August 10, 2007. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

### STATEMENT

1. The Constitution grants Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. Const. Art. I, § 8, Cl. 8. The First Amendment provides, in pertinent part, that “Congress shall make no law \* \* \* abridging the freedom of speech, or of the press.” U.S. Const. Amend. I.

2. a. In 1790, the year after the adoption of the Constitution, the First Congress enacted the Nation’s first Copyright Act, establishing a 14-year initial term of copyright protection from the date of publication, renewable for an additional 14 years if the author survived the first term – for a potential total term of 28 years. Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124. In 1831, Congress extended the initial term to 28 years (while retaining the 14-year renewal term), extending the potential total term to 42 years. Act of Feb. 3, 1831, ch. 16, §§ 1, 16, 4 Stat. 436, 439. In 1909, Congress then extended the copyright’s renewal term to 28 years, further extending the total copyright term to 56 years. Act of Mar. 4, 1909, ch. 320, §§ 23-24, 35 Stat. 1075, 1080-1081 (1909 Act).

In 1976, Congress altered the method for computing copyright terms for works created on or after January 1, 1978 (as well as for unpublished works that were “fixed” before 1978 and previously enjoyed perpetual copyright protection), and established a single term of copyright protection for the life of the author plus 50 years. 17 U.S.C. 302-304 (1976 Act). “In these respects, the 1976 Act aligned United States copyright terms with the then-dominant international standard adopted under the Berne Convention for the Protection of Literary and Artistic Works” (Berne Convention). *Eldred v. Ashcroft*, 537 U.S. 186, 195 (2003) (citing H.R. Rep. No. 1476, 94th Cong., 2d Sess. 135 (1976)). In 1998, Congress enacted the Copyright Term Extension Act of 1998, Pub. L. No. 105-298, 112 Stat. 2827 (CTEA), which extended the copyright term by 20 years to the life of the author plus 70 years for all works not created by January 1, 1978 (17 U.S.C. 302(a), 303(a)), to “harmonize[] the baseline United States copyright term with the term adopted by the European Union in 1993.” *Eldred*, 537 U.S. at 196. By matching the United States’ copyright term with the European Union’s, “Congress sought to ensure that American authors would receive the same copyright protection in Europe as their European counterparts.” *Id.* at 205-206.

b. Under the 1909 Act, a copyright holder could secure a 28-year renewal term only “after filing a renewal registration with the Register of Copyrights” in the last year of the first 28-year term of protection. S. Rep. No. 194, 102d Cong., 1st Sess. 3 (1991). “In

1976, Congress concluded years of debate and study on all aspects of the Copyright Act by passing a comprehensive revision to the 1909 law.” *Ibid.* The copyright renewal revision was viewed as “[o]ne of the worst features of the present copyright law.” H.R. Rep. No. 1476, *supra*, at 134. “A substantial burden and expense, this unclear and highly technical requirement results in incalculable amounts of unproductive work. In a number of cases it is the cause of inadvertent and unjust loss of copyright.” *Ibid.* Thus, the 1976 Act “abolished the renewal requirement for future works created on or after January 1, 1978” – the effective date of the 1976 Act – and “established a single term of copyright protection for the life of the author plus 50 years.” S. Rep. No. 194, *supra*, at 3. Congress “retained the existing renewal registration requirement” for copyrights still subsisting in their first term on the 1976 Act’s effective date, however, because “Congress was concerned that eliminating the renewal requirement for these works altogether could potentially disrupt existing expectancies or contractual interests.” S. Rep. No. 194, *supra*, at 3-4; H.R. Rep. No. 1476, *supra*, at 139.<sup>1</sup>

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<sup>1</sup> Although Congress retained the renewal registration requirement for copyrights still in their first term prior to the 1976 Act’s effective date, the length of the renewal term for such copyrights was extended from 28 to 47 years (for a total potential term of 75 years), and copy-rights already in their renewal term at that time were extended by an amount sufficient to extend their total term to 75 years. H.R. Rep. No. 1476, *supra*, at 139-140.

The Copyright Office, publishers, authors, academics, and others “criticized the registration renewal provision for being burdensome and unfair to thousands of copyright holders and their heirs.” S. Rep. No. 194, *supra*, at 4. In 1991, the Senate Judiciary Committee conducted a hearing on the registration renewal issue and concluded that the public domain “should not be enlarged because of an author’s error in recordkeeping, or any other innocent failure to comply with overly technical formalities in the copyright law.” *Id.* at 6. Significantly, the Committee recognized that authors of earlier works who were still subject to the 1976 Act’s renewal requirements should retain the same rights enjoyed by authors of more recent works created after the 1976 Act’s effective date. *Ibid.* The Committee also sought to modify the 1976 Act’s renewal requirement because foreign authors faced an additional dilemma as they were even less familiar than domestic authors with the formality of a renewal requirement that is unique to United States law. The Committee understood that “[t]he domestic laws of most developed countries contain very few formalities conditioning copyright protection,” and that compliance with such formalities is “antithetical to the major international treaty on copyright relations, the Berne Convention.” *Id.* at 5.

Based on those concerns, Congress enacted the Copyright Renewal Act of 1992 (CRA), Pub. L. No. 102-307, § 102(a), 106 Stat. 264, which amended the renewal provisions set forth in 17 U.S.C. 304 to

“make[ ] clear that a timely registration by the proper statutory claimant vests the right to the renewal term on the date of registration in the Copyright Office and, if a registration is not made, the right in the renewal term vests automatically in the proper statutory claimant on the last day of the first term.” S. Rep. No. 194, *supra*, at 4. The automatic renewal provisions apply only to those pre-January 1, 1978, works still in their first 28-year copyright term when the CRA was enacted, *i.e.*, works that acquired a first term of copyright protection between January 1, 1964, and December 31, 1977. See *id.* at 7. Thus, the CRA puts protection of such works on equal footing with the protection of qualifying works for which renewal registration was made. *Ibid.* At the same time, the CRA’s legislative history recognized that a renewal registration system “provides a useful public record for users of copyright material so they may locate the copyright holder and arrange to license a work, or determine when copyright material falls into the public domain.” *Id.* at 6-7. Accordingly, the CRA offers incentives to authors to continue to voluntarily renew their copyright in a timely manner, while it “eliminates the harsh consequences of failing to renew.” *Id.* at 7.

c. As the Court stated in *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30, 41 (1939), the purpose of the deposit requirement (currently set forth in 17 U.S.C. 407) is not proof or preservation of copyright, but the acquisition of books for the Library of Congress. “Until 1976, failure to deposit with the

Library of Congress resulted in a forfeiture of copyright.” *Ladd v. Law & Tech. Press*, 762 F.2d 809, 813 (9th Cir. 1985), cert. denied, 475 U.S. 1045 (1986). With the enactment of the 1976 Act, Congress changed the deposit enforcement provisions because:

A realistic fine, coupled with the increased inducements for voluntary registration and deposit under other sections of the bill, seems likely to produce a more effective deposit system than the present one. The bill’s approach will also avoid the danger that, under a divisible copyright, one copyright owner’s rights could be destroyed by another owner’s failure to deposit.

*Id.* at 813 (quoting H.R. Rep. No. 1476, *supra*, at 150). Under the 1976 Act, therefore, deposit is still required of a copyright holder, but failure to deposit results, not in forfeiture, but in fines in the amount of the cost to the Library of obtaining the work, plus penalties. *Ibid.*

d. Under the 1909 Act, a work also had to bear a valid copyright notice upon publication in order to secure copyright protection. 17 U.S.C. 10, 19 *et seq.* At the time of its enactment, the 1976 Act continued to require that notice be affixed to all published copies and phonorecords of a work. 17 U.S.C. 401, 402. Congress also made clear, however, that the requirement was no longer absolute, took steps to avoid the harsh consequences of the omission of notice, and prescribed remedial measures that could

be taken in cases where notice was omitted. 17 U.S.C. 405.

In 1988, Congress enacted the Berne Convention Implementation Act (BCIA), Pub. L. No. 100-568, 102 Stat. 2853 (1988), to bring the United States into conformity with the Berne Convention. Pursuant to the BCIA, the attachment of copyright notice is no longer required in order to gain copyright protection for works first published after March 1, 1989, but it is still encouraged through various incentives. 17 U.S.C. 401(d), 402(d).

3. a. Petitioners filed this action in federal district court seeking, *inter alia*, a declaratory judgment that the automatic copyright renewal provisions of the CRA, in conjunction with the 20-year copyright extension contained in the CTEA, violate the First Amendment.<sup>2</sup> Respondent moved to dismiss petitioners' amended complaint for failure to state a claim upon which relief can be granted. Respondent relied primarily upon this Court's recent decision in *Eldred*, in which the Court rejected a Copyright Clause and First Amendment challenge to the CTEA.

The district court granted respondent's motion. Pet. App. 17a-51a. The district court rejected petitioners' claim that the CRA and the CTEA violate the

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<sup>2</sup> Although the complaint raised other claims, petitioners narrowed their claims on appeal to their challenge to the effect of the CRA and the CTEA on works published after 1963 and before 1978. See Pet. Am. C.A. Br. 28.

First Amendment “by imposing an unconstitutional burden on speech with respect to works created after January 1, 1964 and before January 1, 1978 as a result of having altered the ‘traditional contours’ of copyright law from a conditional copyright regime to an unconditional copyright regime.” *Id.* at 47a. The court focused on *Eldred’s* analysis and rejection of the argument that the CTEA violates the First Amendment (*id.* at 47a-49a), and dismissed petitioners’ assertion that “Congress, by eliminating the registration, renewal, deposit, and notice requirements as a condition of obtaining and maintaining a copyright, has altered the traditional contours of copyright protection.” *Id.* at 49a. The court reasoned that, unlike “the idea/expression dichotomy and the fair use exception,” *ibid.*, “the registration, renewal, deposit, and notice requirements do not define the scope of copyright protection but, rather, the procedural steps necessary to obtain and maintain a copyright.” *Id.* at 50a. The court observed that “Congress has repeatedly stated that these [latter] requirements are mere ‘formalities’” (*ibid.* (citations omitted)), which the court held “do not alter the scope of copyright protection, but merely determine the procedures necessary to obtain or maintain such protection.” *Ibid.*

Accordingly, “[b]ecause changes to requirements of this nature do not alter the substantive rights granted by copyright,” the court “f[ound] that the challenged amendments do not alter the ‘traditional contours of copyright protection.’” Pet. App. 50a. The

court therefore found immaterial petitioners' promise to "show at trial the 'real world effect' of the challenged changes to copyright law," because "no such evidence can alter this fundamental defect in their case." *Ibid.* (citation omitted).

b. The court of appeals affirmed. Pet. App. 1a-8a.<sup>3</sup> The court concluded that petitioners provided no "legal argument explaining why [it] should ignore the clear holding in *Eldred*." *Id.* at 5a. The court stated that petitioners "assert that the change from discretionary to automatic renewal and subsequent extension of copyrights for works created between 1964 and 1977 altered the 'traditional contours of copyright protection.'" *Ibid.* (quoting *Eldred*, 537 U.S. at 221). "However, *Eldred* also upheld the CTEA, in effect answering [petitioners'] challenge." *Ibid.*

The court concluded that under *Eldred*, "extending existing copyrights to achieve parity with future copyrights does not require further First Amendment scrutiny," because "traditional First Amendment safeguards such as fair use and the idea/expression dichotomy are sufficient to vindicate the speech interests affected by the CRA and the CTEA." Pet. App. 6a (citing *Eldred*, 537 U.S. at 219-220). The court held that the CRA "effectively extended copyright protection for works that would otherwise have

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<sup>3</sup> All references are to the court of appeals' amended opinion (Pet. App. 1a-8a), rather than to its original opinion (*id.* at 9a-16a).

fallen into the public domain,” and that the “CTEA further extended those works’ protection.” *Ibid.* Because “*Eldred* tells us that such extensions would not violate the First Amendment,” *ibid.* (citing *Eldred*, 537 U.S. at 221), “[i]t therefore follows that the materially indistinguishable CRA and CTEA provisions are constitutional as well.” *Ibid.* Thus, the court concluded that notwithstanding petitioners’ “attempt to frame the issue in terms of the change from an opt-in to an opt-out system rather than in terms of extension, they make essentially the same argument, in different form, that the Supreme Court rejected in *Eldred*,” which “fails here as well.” *Id.* at 6a-7a.

### ARGUMENT

The decision of the court of appeals is correct and is fully consistent with this Court’s decision in *Eldred v. Ashcroft*, 537 U.S. 186 (2003). Further review is not warranted.

1. The court of appeals correctly interpreted and applied this Court’s decision in *Eldred*. In *Eldred*, this Court upheld the CTEA’s 20-year extension of existing copyrights in the face of a First Amendment challenge. *Eldred*, 537 U.S. at 218-221. In so doing, this Court reasoned that “copyright’s limited monopolies are compatible with free speech principles”; “[i]ndeed, copyright’s purpose is to *promote* the creation and publication of free expression.” *Id.* at 219. This Court observed that “copyright law contains built-in First Amendment accommodations,” namely,

the “idea/expression dichotomy” and the “‘fair use’” defense. *Id.* at 219-220. While the Court concluded that copyrights may not be “categorically immune from challenges under the First Amendment,” *id.* at 221 (citation omitted), it held that, “when, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.” *Id.* at 221.

The court of appeals’ decision is a straightforward application of the decision in *Eldred*. “[T]he CRA eliminated the renewal requirements for works created between 1964 and 1977 and thus extended their term; the CTEA effected a further extension.” Pet. App. 4a.<sup>4</sup> As the court of appeals observed, under *Eldred*, “Congress could have achieved the identical result by extending the term of existing copyrights before their renewal was required.” *Id.* at 6a. Accordingly, as the court of appeals correctly concluded, “the materially indistinguishable CRA and CTEA provisions are constitutional as well.” *Ibid.*

Notwithstanding petitioners’ “attempt to frame the issue in terms of the change from an opt-in to an opt-out system rather than in terms of extension, they make essentially the same argument, in different form,” that the Court rejected in *Eldred*. Pet. App. 6a-7a. “Here, as in *Eldred*, extending existing

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<sup>4</sup> As in *Eldred*, 537 U.S. at 219 n.23, petitioners here “confine[d] their First Amendment challenge to the extensions granted to those works.” Pet. App. 4a.

copyrights while preserving speech-protective measures does not alter the ‘traditional contours of copyright protection.’” *Id.* at 6a. That correct application of *Eldred* does not warrant this Court’s review.<sup>5</sup>

2. Petitioners contend (Supp. Pet. 1-3) that a recent decision of a Tenth Circuit panel creates a conflict with the decision below. See *Golan v. Gonzales*, 501 F.3d 1179 (10th Cir. 2007) (Supp. Pet. App. 1a-35a), petition for reh’g pending (filed Nov. 16, 2007). In *Golan*, the Tenth Circuit held that Section 514 of the Uruguay Round Agreements Act (URAA), Pub. L. No. 103-465, 108 Stat. 4976-4981 (17 U.S.C. 104A, 109(a) (1994)), alters “the traditional contours of copyright protection” within the meaning of *Eldred*, and remanded to the district court for further First Amendment scrutiny. Pet. Supp. App. 1a-35a. Although the ruling and reasoning in *Golan* is in tension with the decision here, the panel’s decision in *Golan* – which is the subject of a pending petition for rehearing en banc filed by the government – does not justify further review in this case.

Section 514 of the URAA – the statute at issue in *Golan* – implements the Berne Convention by granting copyright protection for a limited time to a limited number of foreign works whose copyright terms had

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<sup>5</sup> Moreover, the justification for review by this Court is further attenuated in light of the fact that petitioners are challenging statutes concerning only a finite, 14-year period (January 1, 1964-December 31, 1977), rather than challenging an ongoing feature of copyright law.

not yet expired in their countries of origin. See Supp. Pet. App. 2a-4a nn.1, 2. Section 514 retains intact the two “traditional First Amendment safeguards” to which this Court referred in *Eldred*. 537 U.S. at 220. The copyrights granted to foreign authors are coextensive with those enjoyed by American authors. They last for precisely the same term, expire on precisely the same day, offer precisely the same protections against others’ exploitation, and include precisely the same exceptions for pure ideas and fair use.<sup>6</sup> The “built-in free speech safeguards” of copyright law, *id.* at 221, are thus preserved. See *Luck’s Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107, 119 (D.D.C. 2004) (holding that “Congress has not altered the traditional contours of copyright protection,” because the URAA “does not alter First Amendment accommodations such as the idea/expression dichotomy or the fair-use doctrine”), *aff’d* on other grounds, 407 F.3d 1262 (D.C. Cir. 2005).

In *Golan*, the Tenth Circuit panel read *Eldred’s* phrase “the traditional contours of copyright protection,” 537 U.S. at 221, to refer to more than the “traditional First Amendment safeguards” discussed in the passages in the *Eldred* opinion that immediately

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<sup>6</sup> The only difference between American works and foreign works restored under Section 514 is that the latter have gone unprotected in the United States for much of their existence, to the detriment of their foreign authors. URAA-restored works thus by definition enjoy a considerably shorter span of copyright protection than their American counterparts.

precede that phrase, *id.* at 219-220. See Supp. Pet. App. 15a-35a. Instead, in the view of the Tenth Circuit panel, that phrase established a new standard – never before articulated in the Court’s jurisprudence – that mandates First Amendment scrutiny whenever a copyright statute “deviates from [a] time-honored tradition,” *id.* at 25a, even if that “time-honored tradition” has been breached by Congress on a number of occasions over the centuries. See *id.* at 21a-25a. Such a standard is inconsistent with the context and reasoning of *Eldred*, as well as with First Amendment doctrine.

The error by the Tenth Circuit panel in *Golan*, however, does not warrant issuance of a writ of certiorari to the Ninth Circuit in this case. *Golan* involves a different statutory provision with different effect than the provisions at issue here, and the Tenth Circuit, while citing the decision below several times in its opinion in *Golan*, never suggested that its ruling was in conflict with the ruling below. While the results and reasoning of the two decisions are in tension, there is no actual conflict. The decision below is correct and represents nothing more than a straightforward application of *Eldred* to statutes (the CRA and CTEA) that accomplished essentially the same term extension as that upheld in *Eldred*. Moreover, as noted, respondent has filed a petition for rehearing en banc in *Golan*, and the court of appeals recently ordered a response to that petition. If rehearing is granted, the tension between the two decisions

may dissipate without the need for any action by this Court.

**CONCLUSION**

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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