

Case No. 04-17434

**UNITED STATES COURT OF APPEALS  
FOR THE NINTH CIRCUIT**

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

Appellants/Plaintiffs,

v.

ALBERTO GONZALES,

Appellee/Defendant.

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**On Appeal from a Decision of the  
United States District Court  
N.D. Cal. Case No. C04-1127 MC**

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**APPELLANTS' REPLY BRIEF**

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Respectfully submitted,

\_\_\_\_\_/s/\_\_\_\_\_  
\_\_\_\_\_

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## INTRODUCTION

*Eldred v. Ashcroft*, 537 U.S. 186 (2003), announced a special rule of First Amendment review for copyright statutes. This case is about the scope of that special rule.

As appellants described in their opening brief, in *Eldred* the government asked the Supreme Court to affirm a rule of First Amendment exceptionalism — that copyright laws be “categorically immune from challenges under the First Amendment.” *Eldred v. Reno*, 239 F.3d 372, 375 (D.C. Cir. 2001). The Court rejected that request. The petitioners in *Eldred* asked for ordinary First Amendment review. The Court declined that request as well. Instead the Court adopted a test tied to copyright law’s tradition: So long as Congress does not change “the traditional contours of copyright protection, further First Amendment scrutiny [of a copyright act] is unnecessary.” 537 U.S. at 221.

The issue before this Court is the meaning of this trigger for First Amendment review — viz., “the traditional contours of copyright protection.” Appellants submit that the shift from an opt-in to an opt-out copyright regime is a change in a “traditional contour[] of copyright protection.” The government accepts the argument that changes in

“traditional contours of copyright protection” merit “further First Amendment review,” but rejects the claim that a change from an opt-in to an opt-out copyright regime is a change in a “traditional contour[] of copyright protection.”

Yet, none of the government’s evolving arguments to this end are persuasive. First, it argued that the only changes in the “traditional contours of copyright protection” meriting First Amendment review are changes in the two “traditional First Amendment safeguards” described by the Court — the “idea/expression” distinction, and “fair use.” *Eldred*, 537 U.S. at 219-20. When appellants pointed out that this theory would exclude First Amendment review of a viewpoint-based copyright statute, the government qualified its position to narrow the *Eldred* rule to content- or viewpoint-neutral statutes only — despite the fact that *Eldred* draws no such distinction.<sup>1</sup>

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<sup>1</sup>There is nothing in the language of *Eldred* to suggest the Court was limiting its rule to content-neutral regulations only. The government points to one place where the Court mentions the term “content-neutral.” Gov’t Br. 37. But as is obvious from the context, the Court was simply repeating petitioners’ characterization of the CTEA. *Eldred*, 537 U.S. at 219 (“Petitioners separately argue that the CTEA is a content-neutral regulation of speech that fails heightened judicial review under the First Amendment.”). The Court was *not* characterizing the scope of its own rule.

Now, the government agrees with the district court that the “traditional contours of copyright protection” are not exhausted by the “traditional First Amendment safeguards,” *see* Gov’t Br. 32 (“these are the only safeguards recognized by the Supreme Court *thus far*”) (emphasis added); *id.* at 39-40 (“copyright’s ‘traditional First Amendment safeguards’ ... *largely, if not exclusively*, define the ‘traditional contours of copyright protection’”) (emphasis added), but argues that by “copyright protection,” the Court meant “the scope of copyright protection.” Because a change from opt-in to opt-out is not a change in “the scope of copyright protection,” the government asserts, appellants are barred from further First Amendment review of perhaps the most significant change in the history of American copyright law. Gov’t Br. 31.

But *Eldred* does not need these not-so-subtle amendments. The opinion does not equate “traditional contours of copyright protection” with the two “traditional First Amendment safeguards” that it described. It does not limit its application to content-neutral regulations. And the *Eldred* Court didn’t simply forget to narrow “copyright protection” to “the scope of copyright protection.” Instead, the opinion as written serves its sensible policy quite well: The Court has established a presumption of

constitutionality where Congress simply continues a traditional practice. It has channeled First Amendment review to changes in traditional practices.

Under the *Eldred* rule, appellants are entitled to present evidence that the shift from opt-in to opt-out copyright is a shift in copyright's traditional contours, and, as such, must be subjected to ordinary First Amendment review. Appellants have alleged — and the government does not deny — that there was no other feature of American copyright law more significant than its opt-in character. Consequently, a change in that character is precisely the sort of change in a “traditional contour[] of copyright protection” that merits “further First Amendment review.”

The alternative view, pressed by the government, is unprecedented in First Amendment law. On the government's view, Congress can craft radically different speech regulations, never tested by either tradition or the First Amendment, so long as Congress calls the regulation “copyright” and the regulation is outside of the undefined category of “the scope of copyright protection.” Thus, an entirely new and potentially very expansive *category* of speech regulation is put beyond First Amendment review: “copyright” regulation not within the “scope of copyright protection.”

But just as the Supreme Court expressly rejected the view that new copyright regulation was “categorically immune from challenges under the

First Amendment,” *Eldred*, 239 F.3d at 375, so too should this Court reject the view that a *category* of new copyright regulation is categorically immune from First Amendment review. The government’s rule creates a hole in the First Amendment — it would permit a kind of speech regulation that has not been tested by tradition to evade review. Excepting (perhaps<sup>2</sup>) “low value” speech, there is no such category of speech under our First Amendment.

The *Eldred* rule does not create such a hole in First Amendment review: the only practices that earn the presumption of constitutionality under that rule are those that actually define the “contours of copyright protection” throughout our tradition. Copyright regulations that shift those “traditional contours of copyright protection” get the same First Amendment review that any regulation of speech gets. In this case, the government cannot point to any tradition of opt-in copyright for published work. Thus, nothing in the text of *Eldred*, nor in its eminently sensible rationale, would justify denying appellants ordinary First Amendment review.

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<sup>2</sup>“Low value speech” is not wholly exempt from First Amendment review. See *R.A.V. v. City of St. Paul, Minn.*, 505 U.S. 377 (1992).

**I. Appellants Are Entitled to First Amendment Review**

**A. *Eldred* establishes a special rule of First Amendment review for changes to copyright law that the Court should strictly apply.**

Copyright law regulates speech. As with any speech regulation, it is subject to First Amendment review.

Ordinary First Amendment review would require that Congress tailor its speech restrictions to compelling or important governmental interests. That tailoring would at least assure that the regulation did not “burden substantially more speech than necessary to further [legitimate governmental] interests.” *Turner Broad. Sys., Inc. v. F.C.C.*, 520 U.S. 180, 189 (1997).

*Eldred*, however, established a special rule of First Amendment review for copyright regulation. Because of its express textual pedigree, its origin contemporaneous with the founding, and Congress’s longstanding tradition of incorporating free speech limitations into copyright regulation, the Supreme Court established a presumption of constitutionality for any copyright regulation that simply follows the “traditional contours of copyright protection.” *Eldred*, 537 U.S. at 221. Where Congress merely continues a practice that has defined copyright from the founding, that tradition will immunize the practice from “further First Amendment

review.” *Id.* But where a copyright regulation shifts those traditional contours, it is subject to First Amendment review.

*Eldred’s* special First Amendment rule has been criticized strongly.<sup>3</sup> But in appellants’ view, the rule makes perfect sense. If Congress has been following a certain copyright practice for 215 years, it does not make sense for a court to question that practice now. Tradition sensibly sets the First Amendment’s baseline. Laws that simply follow that tradition should not be burdened by “further First Amendment review,” *Eldred*, 537 U.S. at 221, at least where changed circumstances don’t render that tradition irrelevant.

The issue in this case is the scope of *Eldred’s* special First Amendment rule. Appellants have alleged a change in the “traditional contours of copyright protection”: For 186 years of the American Republic, copyright law was an opt-in system — a system that required those who wished to obtain a copyright to take steps to claim it, and then take

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<sup>3</sup> See, e.g., Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 Stan. L. Rev. 485 (2004); Travis J. Denneson, *The Definitional Imbalance Between Copyright and the First Amendment*, 30 Wm. Mitchell L. Rev. 895 (2004); Niels Schaumann, *Intellectual Property Symposium: The Impact of the United States Supreme Court on Intellectual Property*, 30 Wm. Mitchell L. Rev. 1617 (2004); Caren L. Stanley, Casenote, *A Dangerous Step Toward the Over Protection of Intellectual Property: Rethinking Eldred v. Ashcroft*, 26 Hamline L. Rev. 679 (2003).

additional steps to maintain it. Beginning in 1976, Congress changed American copyright law into an opt-out system — a system that grants copyright automatically and indiscriminately, whether a particular creator wishes to obtain copyright protection or not. Am. Compl. ¶¶ 46-54 (ER pp. 12-15). It takes a willed obliviousness not to recognize how significant this change has been to the burdens that copyright imposes upon the speech of not just appellants, but of anyone who would cultivate and spread our culture using digital technology. Before 1976, copyright law *automatically* and *effectively* narrowed the burden of copyright regulation to those works that could presumptively benefit from the continued protection of the law. After 1976, this system of narrow tailoring came to an end. The law no longer limits its scope to works that would presumptively benefit from its regulation. The law instead indiscriminately extends its protection to all creative works reduced to a tangible form, for a term of copyright approaching a century. This change in the system by which copyright protection is secured is a change in the “traditional contours of copyright protection,” requiring “further First Amendment review.”

**1. Eldred does not articulate a rule tied to the “scope of copyright protection.”**

The government’s most recent argument to the contrary is that *Eldred* tailored its special rule of First Amendment immunity not to changes in the “traditional contours of copyright protection,” but to changes in the “*scope of copyright protection.*” Gov’t Br. 32 (emphasis added). The government admits that the two “traditional First Amendment safeguards” that the Court enumerated in *Eldred* cannot be changed without “further First Amendment review.” Nor presumably could other aspects of copyright’s “scope” be changed without further First Amendment review.

The problems with the government’s argument are many. First, the text of the Court’s opinion in *Eldred* simply does *not* equate “the traditional contours of copyright protection” with the “traditional First Amendment safeguards.” They are separately described. They are conceptually distinct. “Copyright protection” issues from a congressional power. “First Amendment safeguards” are limits on that power. The “contours” of a power are not exclusively defined by rights-based “limits.” Just as the Bill of Rights does not define the “contours” of federal power (there are, for example, other inflections in those “contours” not touched by the Bill of Rights), so too are the “traditional First Amendment safeguards” not the only “traditional contours of copyright protection.” These “safeguards” —

*against the background of the “traditional contours of copyright protection”* — assure that copyright promotes, rather than restricts, speech. But there’s no reason to expect — and neither did the Court remotely suggest — that these two “safeguards” would always and necessarily be adequate regardless of the nature of the background system of copyright. Thus, nothing about these two safeguards should preclude First Amendment review if Congress radically changes other “traditional contours of copyright protection.”

Second, the language of *Eldred* itself refutes the government’s, and the district court’s, suggestion that “contours of copyright protection” refer just to the “scope of copyright protection.” Dist. Ct. Op. at 25 (ER p. 59). The district court reasoned to this conclusion from the observation that the “traditional First Amendment safeguards” “each related to the scope of copyright protection.” *Id.* It followed, the court below concluded, that the “traditional contours of copyright protection” could only refer to the “scope of copyright protection.” *Id.*

But the language of *Eldred* directly rejects the district court’s inference. While addressing the scope of the First Amendment argument raised in *Eldred*, the Supreme Court observed, “[petitioners do not] say whether or how their free speech argument applies to *copyright duration* but not to *other aspects of copyright protection, notably scope.*” *Eldred*, 537

U.S. at 219 n.23 (emphasis added). This language distinguishes “copyright protection” from “scope of copyright protection.” It is plain from this language that the Court understands “copyright protection” to have more “aspects” than “scope” — it includes at least, for example, duration.

That understanding is confirmed by the seven other instances in which the *Eldred* Court links “copyright protection” to copyright duration, and not scope. *See Eldred*, 537 U.S. at 192 (“Under the 1976 Copyright Act, copyright protection generally lasted from the work's creation until 50 years after the author's death”); *id.* at 199 (“the Copyright Clause empowers Congress to prescribe ‘limited Times’ for copyright protection and to secure the same level and duration of protection for all copyright holders”); *id.* at 200 (“all under copyright protection will be governed evenhandedly under the same regime [referring to duration]”); *id.* at 205-06 (“By extending the baseline United States copyright term to life plus 70 years, Congress sought to ensure that American authors would receive the same copyright protection in Europe as their European counterparts”); *id.* at 210 n.16 (“observing that ‘copyright protection should be for a limited time only’”); *id.* at 211 (“*Feist*, however, did not touch on the duration of copyright protection”); *id.* at 212 (“Th[e] evolution of the duration of copyright protection tellingly illustrates the difficulties Congress faces”) (citation omitted)). And it is supported by

one instance in which the Court directly referred to the formal differences in how the 1976 Act, and all acts before, triggered “copyright protection.” *See id.* at 195 (“federal copyright protection would run from the work's creation, not—as in the 1790, 1831, and 1909 Acts—its publication”). “Scope” is thus plainly not the only “aspect” of “copyright protection” subject to the *Eldred* rule.<sup>4</sup>

Third, any attempt to restrict the reach of “traditional contours of copyright protection” — whether to the “scope of copyright protection” only, or, the district court suggests, to “substantive rights” rather than mere “procedure,” Dist. Ct. Op. at 25 (ER p. 59) — suffers from the same fundamental flaw. Every such attempt simply opens up a hole in First Amendment review of a speech-regulating statute. *Eldred* justly exempts

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<sup>4</sup>In the context of the government’s systematic rewriting of what the *Eldred* Court actually said—transforming “traditional contours of copyright protection” into “traditional contours of the scope of copyright protection”—the government’s charge that appellants have selectively quoted *Eldred* as a means to “bolster[ing their] groundless theory,” Gov’t Br. 31, is amusing at best. Appellants have stated the standard to be “traditional contours of copyright.” The full quote in *Eldred* is “traditional contours of copyright protection,” 537 U.S. at 221, but appellants fail to see the difference in substance between “copyright” and “copyright protection,” given the broad sense the Supreme Court gave in *Eldred* to “copyright protection.” As has already been described, the Court in *Eldred* expressly spoke of “copyright protection” as including more “aspects” than the “scope” of “copyright protection.” *See supra* at 10-12.

features of copyright’s tradition from “further First Amendment review” because *those features* have enjoyed longstanding acceptance within the law. But any effort to narrow “copyright protection” to some subset would permit new features of copyright law to escape any First Amendment review, despite forming no part of any “tradition.” To the extent these new features affect First Amendment interests, Congress cannot exempt them from First Amendment review. For absent the category of “low value speech” — which the government does not claim copyrighted material is in — there is *no precedent* for exempting whole categories of speech regulation from the reach of the First Amendment, at least when unsupported by tradition.

Put differently, there is no doubt that if it were not copyright regulation at issue in this case, the First Amendment would police this speech regulation. *Eldred* provides a convincing reason for exempting a significant category of copyright regulation from the default jurisdiction of the First Amendment — namely tradition. But where, as is the case here, there is no tradition supporting a substantial regulation of speech within the scope of the copyright power, there is no exemption from First Amendment review.

Fourth, changing the rules triggering copyright protection (as the shift from opt-in to opt-out did) directly affects the “scope of copyright

protection.” That is, even though there is procedure involved, that procedure affects substance – it affects the number of works copyright reaches; i.e, it affects the “scope” of copyright’s regulation. Accordingly, the government’s rule creates a false distinction between “procedure” and “substance”. The same is true for any number of other examples: If Congress removed copyright protection from paparazzi who violated privacy laws when taking their pictures, would that be a regulation of the “scope” of copyright, or a mere limitation of “procedure”? Likewise, if Congress limited copyright to those who took a loyalty oath, is that regulation of “scope” or “procedure”? American law is far enough into the history of jurisprudence to know that any test that divides First Amendment protections on the basis of a “substance vs. procedure” distinction is doomed to uncertainty. Indeed, there is *no doctrine of First Amendment law* that automatically exempts from ordinary First Amendment scrutiny *procedural rules* simply because they are procedural. Indeed, the core protection of the First Amendment is a protection against a procedural rule — prior restraint. *See, e.g., Bantam Books, Inc. v. Sullivan*, 372 U.S. 58, 70 (1963).

Fifth, and finally, it would have made no sense for the *Eldred* Court to have limited all First Amendment review to changes in the particular “First Amendment safeguards” that it mentioned. The *Eldred* Court was, for the

first time, announcing a tradition-based standard for First Amendment review of changes in copyright law. Neither party had briefed the standard. Nor did the Court have before it any foundation fairly to determine a rule to govern all possible changes in copyright law. It thus would have been imprudent at best for the Court to craft a rule meant to decide all future cases by narrowing review to changes either in the two articulated “traditional First Amendment safeguards,” or in the “scope of copyright protection.” But on appellants’ reading of *Eldred*, there is nothing imprudent about the Court’s decision at all. The Court sanctioned legislation consistent with tradition, while leaving open challenges based upon changes in that tradition.

The correct reading of *Eldred* is thus what the opinion says. It ties “further First Amendment review” not to “traditional First Amendment safeguards” nor to “traditional contours of the scope of copyright protection,” but to “the traditional contours of copyright protection.” Sensibly, it asks a court presented with a First Amendment challenge to a copyright regulation to determine whether the regulation changes a “traditional contour of copyright protection.” If it does, then “further First Amendment review” is appropriate. If it does not — or alternatively, if it

simply continues the tradition that Congress has followed — then “no further First Amendment review is necessary.”

**2. *Appellants are entitled to First Amendment review.***

On that standard, there is no doubt that appellants are entitled to First Amendment review. As appellants have argued, and the government has not disputed, the change from an opt-in to an opt-out system of copyright is as significant a change in American copyright law as any in American history. It is, moreover, a change that profoundly affects free speech interests, as digital technologies make it easier for a wide range of citizens to build upon and spread our culture. This is precisely the sort of change in the “traditional contours of copyright protection” that should merit further First Amendment review under *Eldred*.

Appellants do not argue, as the government asserts, that “virtually any change by Congress to a ‘traditional’ feature of copyright ... [should] trigger[] an extensive and searching First Amendment review.” Gov’t Br. 33, citing Pl. Br. 43-47. Instead, as appellants had plainly stated on the page before the pages the government cites, “[i]t cannot be that every change in the contours of copyright law would raise a First Amendment question,” Pl. Br. 42. Appellants acknowledge that First Amendment review must be restricted to changes of “significance.” *Id.* And it is for that reason precisely

that the court below erred when it dismissed this case without affording appellants any opportunity to present evidence about the significance of the effects on First Amendment interests flowing from these changes in the nature of the system of copyright. This Court should therefore reverse the decision below, and remand the case to the district court with instructions to consider the evidence about the significance of the changes at issue in this case, to determine whether those changes should be considered changes in the “traditional contours of copyright protection.”

**B. The Framers’ views about the interaction between *their* copyright law and the First Amendment are plainly irrelevant to the questions presented in this case.**

The government argues, both below and in this Court, that special deference is owed Congress’s regulation of copyright because according to the understanding of the “Framers,” copyright laws “laws promote, rather than threaten, free expression.” Gov’t Br. 35. We agree this was the view of the Framers. We agree that view was justified. But the government’s argument again betrays a failure to apprehend the central point raised in appellants’ complaint.

The whole point of appellants’ case is that the nature of “copyright law” has radically changed. Thus, whatever consistency the “Framers” saw

between *their* copyright law and the First Amendment cannot transfer automatically to copyright law today.

The copyright law that the Framers enacted protected “maps, charts, and books” *only if* the author (1) registered the work, (2) marked the work, (3) deposited the work, and (4) only for 14 years, unless the author, being alive at the expiration of the initial term, renewed the protection for a second 14 year term. Am. Compl. ¶¶ 36-40 (ER p. 11). That regime was an “opt-in” system of copyright, as appellants have described. It regulated a *tiny* portion of published work. According to the estimates of James Gilreath, less than 4% of “maps, charts and books” published between the years 1790 and 1800 were registered for federal copyright. FEDERAL COPYRIGHT RECORDS 1790-1800 (James Gilreath & Elizabeth Carter Wills eds., 1987). And of that 4%, the vast majority did not renew the copyright after the initial term. The law was an opt-in regime that *automatically narrowed* the scope of copyright protection to a very small proportion of published work. The balance of published work thus moved into the public domain, and was free of copyright regulation completely, automatically, and immediately.

“Copyright law” today is radically different. Federal law today regulates any creative work within the scope of the Copyright Act (1) whether or not the work is registered, (2) whether or not the work is marked

with a copyright notice, (3) whether or not the work is deposited, and (4) for the full term of copyright, without any requirement of renewal. Am. Compl. ¶¶ 46-63. (ER pp. 12-15). The system is an opt-out regime. It thus burdens 100% of work within its scope, for a term approaching a century, while the law of the Framers regulated no more than 4% initially, less than 1% after 14 years, and none after 28 years.

Again, appellants do not argue that Congress may not change the nature or scope of copyright protection. The Framers gave Congress a power, not a straightjacket. Appellants' claim is simply about the scope of First Amendment review for any such change to copyright's "traditional contours." Modern copyright law can earn no free First Amendment pass from the Framers' copyright law.

**C. There are obvious First Amendment interests implicated by a change to an opt-out copyright regime, none of which are immunized from review by *Eldred*.**

The government asserts that "[p]laintiffs offer little argument as to why changes to formalities merit the same scrutiny that would apply to changes to copyright protection."<sup>5</sup> Gov't Br. 32. Instead, the government

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<sup>5</sup>This sentence as written sounds odd, since "changes to formalities" are "changes to copyright protection." But the government no doubt means "scope of copyright protection." See, e.g., Gov't Br. 31-32.

suggests that there are no important First Amendment interests raised by the automatic extension of copyright to works that otherwise would have passed into the public domain. Citing *Eldred*, the government argues that there is no First Amendment right “to make other people’s speeches,” Gov’t Br. 38, and concludes that the restriction effected by an automatic extension can therefore raise no First Amendment concerns.

Putting to one side the highly contested view that the First Amendment does not protect the right to “make other people’s speeches” (it wasn’t because Paul Cohen’s t-shirt uttered original speech that his speech received First Amendment protection, *see Cohen v. California*, 403 U.S. 15 (1971); *see also* Jack M. Balkin, *Digital Speech and Democratic Culture: A Theory of Freedom of Expression for the Information Society*, 79 N.Y.U. L. Rev. 1 (2004), the government’s argument ignores the fundamental claim raised in this case.

As Amicus ACLU observes, ACLU Br. 11-12, no doubt, between (A) a copyright owner exercising his exclusive right, and (B) a speaker who would infringe that exclusive right, there is no First Amendment problem raised by restricting the speaker to either “fair use” of the copyrighted work, or to use of the ideas behind that work. The copyright owner’s right trumps the infringer’s interest. But the regulations at issue here block speakers even

*when there is no competing copyright owner who would assert or exercise his rights.* The historical record shows that more than 85% of the copyrights extended by the Copyright Renewal Act would not have been renewed. Am. Compl. ¶ 90 (ER p. 21). Thus, even without a copyright owner seeking to exercise his exclusive rights, the law blocks subsequent speakers from building upon or spreading the copyrighted work. The issue in this case is therefore not whether the First Amendment should interfere with a copyright owner who seeks to exercise his exclusive rights; the issue instead is how the First Amendment should address regulation that blocks access to speech that its owner has abandoned. There is no “engine of free expression,” *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985), that is fueled by this sort of regulation; to the contrary, this regulation is a brake on free expression, with no compensating pro-speech benefit.

The essence of appellants’ claim is therefore, as Amicus ACLU describes it, ACLU Br. 14-16, overbreadth. As with any overbreadth claim, the question is not whether the law is without justification with respect to any of the speech that it burdens. The question instead is whether *with respect to the speech at issue* there is any justification for the law.

Appellants challenge the CRA and Copyright Term Extension Act because they effectively “orphan” creative work in which no “owner” would exercise

any continuing interest. The proper First Amendment question should be whether the government has any important interest in restricting such “orphaned” work, given the many ways that it could avoid that burden.

**D. This Court need not determine the appropriate standard for First Amendment review of changes in the “traditional contours of copyright,” but if it does, then appellants endorse Amicus ACLU’s analysis of the appropriate standard to be applied on remand.**

The only First Amendment issue that this Court need resolve now is whether the changes to the contours of copyright protection that appellants have identified should be subject to ordinary First Amendment review.

Appellants argued they are entitled to ordinary First Amendment review, pursuant to the special rule of *Eldred*. The district court below determined, erroneously, that rational basis applied to the questions appellants presented. That was the only First Amendment question decided by the court below. That was the only First Amendment question briefed.

Amicus ACLU has filed a brief in this Court supporting appellants’ claims. In the course of that brief, it has also suggested that the appropriate standard for ordinary First Amendment review is “overbreadth.” ACLU Br. 14-16. While appellants do not believe it is necessary for this Court to resolve the question of the appropriate standard for review upon remand, appellants agree with the ACLU that its standard would be appropriate. In

the alternative, appellants would also argue on remand that intermediate scrutiny under *Turner*, 520 U.S. at 180, would also be an appropriate standard for measuring changes in the “traditional contours of copyright” — at least so long as those changes were not content-based.

The government objects to the ACLU’s submission, arguing the appellants have not raised this argument. Gov’t Br. 41-42. But this simply misapprehends the issues decided below. The government below argued that appellants were not entitled to First Amendment review *at all*. On different grounds, the court below agreed. As it would have been plainly inappropriate for the district court after it had rejected First Amendment review to continue to decide the appropriate First Amendment standard, the standard of First Amendment review was not decided below. It is not a question requiring this Court’s review at this time.

**II. The District Court’s Dismissal of Appellants’ “Limited Times” Claims is Erroneous**

**A. The government simply ignores appellants’ argument that the extension of the CTEA is unprecedented.**

In their opening brief, appellants stated the question presented in this case to be whether extending the term of copyrights “that *have not, and will not*, pass through a filter of renewal violates the ‘limited Times’ condition of Article I, sec. 8, cl. 8.” Pl. Br. 2 (emphasis added). Appellants repeated that

same formulation eleven other times in the same brief.<sup>6</sup> They repeated the same point four times in their Complaint.<sup>7</sup> And they stated the equivalent point seven times in their Amended Complaint.<sup>8</sup>

As these citations evince, appellants’ argument is, and has always been, that there is *no* statute before the CTEA that extended the terms of copyrights that either had not, or would not be required to pass through the filter of renewal. The extension of 1831 extended the terms of subsisting copyrights in their first term. But those copyrights would themselves have to

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<sup>6</sup>*See id.* at 23 (“each extension historically has been for subsisting works that had been, or would be, filtered by the renewal requirement”); *id.* at 24 (“CTEA is the first extension of subsisting terms in our history that extends the terms for works that have not, or will have not, passed through the filter of renewal”); *id.* at 25 (“extension of terms for works that have not, nor would ever be, filtered by the requirement of renewal”); *id.* at 28 (same); *id.* at 49 (same); *id.* at 50 (same); *id.* at 50 n.8 (same (three times)); *id.* at 51 (same).

<sup>7</sup>*See* Compl. at p. 2 (“that the Copyright Renewal Act and CTEA are unconstitutional to the extent they extend the terms of copyrights that have not, and will not, be renewed”); *id.* at ¶ 55 (same (twice)); *id.* at p. 26 (same).

<sup>8</sup>*See* Am. Compl. at ¶ 38 (ER p. 11) (“requirement that copyright owners renew their copyright to secure the benefits of a second term”); *id.* at ¶ 39 (ER p. 11) (same, with respect to 1909 Act); *id.* at ¶ 56 (ER p. 15) (same, with respect to 1831 Act); *id.* at ¶ 59 (ER p. 15) (“*every extension of subsisting copyrights* until CTEA conditioned the maximum copyright term upon the copyright holder satisfying a renewal requirement”); *id.* at ¶ 68 (ER p. 16) (same); *id.* at ¶ 90 (ER p. 21) (same); *id.* at ¶ 116 (ER p. 26 ) (same).

be renewed to earn the benefit of the maximum term. Am. Compl. ¶ 56 (ER p. 15). In 1909, Congress extended the renewal term of copyrights. But again, the only copyrights to benefit from that extension were those that had, in fact, been renewed. Am. Compl. ¶ 57 (ER p. 15). And in 1976, Congress extended the term of subsisting copyrights again, by again extending the renewal term for subsisting copyrights. Am. Compl. ¶ 58 (ER p. 15). Thus in *every case* before the CTEA, Congress’s extension of subsisting copyrights only extended copyrights that *had or would have to* pass through the filter of renewal.

The government has chosen not to reply to the argument appellants actually make. Instead, it quotes from one example in appellants’ complaint where appellants failed to include the “or would not” language to “respond” to an argument that appellants do not make. Thus, the government writes:

“Plaintiffs also allege that the ‘CTEA was thus the first statute to extend the copyright term for works that had not been filtered by a renewal requirement. ...’ This allegation is incorrect — the 1831 Act extended the initial term of copyright.”

Gov’t Br. 29-30.

The government is correct. “*This*” particular allegation is incomplete. Appellants ought to have stated in that particular paragraph of their complaint — as they stated twenty-three times elsewhere in their complaint

and briefs — that the CTEA was thus the first statute to extend the copyright term for works that had not been, *nor would be*, filtered by a renewal requirement. The government has thus won a debating point, but it only confuses the issue that this Court must resolve.

This strategy is repeated less successfully elsewhere in the government’s brief. The government states that,

“Instead, plaintiffs seek reconsideration of the *Eldred* holding because ‘[t]he Court in *Eldred* did not consider that every extension before CTEA applied to works whose terms had to be renewed.’ ... This assertion is incorrect.”

Gov’t Br. 17-18.

The government then points to the 1831 Act, which extended the term of subsisting copyrights in their initial term, and asserts:

“[T]he crucial point, which plaintiffs ignore, is that in the 1831 Act the first term was doubled without requiring any affirmative action by the copyright owner ... just as Congress extended the copyright term ... in the CTEA.... The 1831 Act therefore removes the underpinnings of plaintiffs’ argument.”

Gov’t Br. 19.<sup>9</sup>

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<sup>9</sup>Appellants have omitted an argument that precedes the government’s point about the 1831 Act, because it involves an obvious non sequitur. Contrary to the government’s claim, the 1976 Act did not change the structure of term of protection for subsisting works. Gov’t Br. 18. Instead, the new structure was prospective only. Thus, the 1976 Act did not extend the term for a copyright that had not, or would not be renewed. It simply established a new structure for future copyrights.

This again is clever editing. It is not an argument. What appellants argued was that every extension before the CTEA had been of copyrights that *had been or would have to be* extended. The language the government quotes says “every extension before CTEA applied to works whose terms *had to be* renewed.” Am. Compl. at ¶ 116 (ER p. 26) (emphasis added). That statement is, again, precisely correct when predicated on the 1831 Act, as well as the 1909, and 1976 Acts.<sup>10</sup> In each case, the subsisting copyrights that Congress extended “had to be renewed” — either to receive the benefit of the extension (as is true with the 1909 Act, and 1976 Act, which both extended the renewal terms, *see* Am. Compl. at ¶¶ 57, 58 (ER p. 15)), or after receiving the benefit of the extension (as is true with the 1831 Act) to receive the maximum term of protection.

Perhaps the government simply missed the distinction. If so, then appellants are happy to repeat the point: while the Court in *Eldred* premised its decision upon a tradition of extending existing terms, it was mistaken

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<sup>10</sup> Appellants do acknowledge that footnote 8 of their opening brief omits a word that changes the meaning, and accuracy, of the claim. Appellants’ point was that the 1831 Act did not extend the terms of subsisting copyrights “uniformly,” because it only extended works in their initial, and not renewal, term of copyright. The second sentence of that note should therefore begin, “Congress did not extend the term ....”

about the nature of that tradition. Extensions of subsisting terms before the CTEA *were within the context of regimes that automatically narrowed the scope of copyright protection through renewal*. The CTEA extended subsisting terms within the context of a regime that does not.

That distinction may or may not have been significant to the Court in *Eldred*. And no doubt, this Court may well feel constrained by *Eldred*, this distinction notwithstanding. But appellants are at least entitled to an accurate statement of the distinction, and the reasons that may draw the determination in *Eldred* into doubt. Whatever “tradition” justified the 1976 Act, and the acts of 1909 and 1831 before, it did not justify the CTEA.

**B. The dicta in *Eldred* addressing Justice Breyer’s argument should not preclude appellants from supplying the evidence necessary to evaluate Justice Breyer’s argument.**

The government argues that *Eldred* precludes any court, presumably ever, from considering the historical evidence necessary to evaluate Justice Breyer’s argument in dissent in *Eldred*. Though the argument Justice Breyer advanced had not been made by any party, and though the basis upon which the Court rejected it had not been briefed by any party, the position of the government is that, bizarrely, that the Court’s mistaken dicta cannot *ever* be corrected through the judicial process.

Again, appellants acknowledge that this Court may feel constrained by the dicta in *Eldred* produced by Justice Breyer's dissent. No doubt, appellants agree that without knowing anything more about the actual history that is relevant to the argument that Justice Breyer made, it is virtually certain that the Supreme Court would make the same decision again.

But appellants seek to have a court review the merits of that argument with the advantage of proper briefing and evidence. Specifically, appellants argue that the actual historical understanding at the framing is different from the history that the Court presumed in *Eldred*. To the extent that difference is relevant to the reasoning of the Court in *Eldred*, it would be perverse if that history could not now, or presumably ever, be presented to any court. The Supreme Court, like any court, is free to roam far from the matters briefed. But there is absolutely no authority for the proposition that parties are thereafter barred from raising a claim premised upon demonstrating error in the Court's dicta — in general, and especially when that error arises in a context that was not briefed.

The government treats the matter as forever settled because the petitioners in *Eldred* filed a motion for rehearing that was itself denied. Gov't Br. 17. But that fact is again simply irrelevant. Petitioners in *Eldred*

*did not make the argument* appellants raise here. They were therefore not permitted to ask for rehearing to consider the argument that Justice Breyer made.

It is our tradition to rely upon parties to present the argument and evidence necessary for courts to interpret our Constitution. That tradition is best practiced by deciding only questions properly presented and briefed. But where a question is decided without *any* argument or briefing, it is essential that parties like the ones here — in a different case, under different facts, presenting different legal claims — be permitted to provide the foundation necessary to correct the Court’s mistake.

In this case, appellants have been barred any opportunity to submit evidence demonstrating that the Court’s account of the Framers’ understanding of the meaning of the “limited times” clause was flawed. Under the rule that the government advances in this case, *no party would ever* be able to supply the argument and evidence necessary for the Court to revise its judgment. Such a rule simply embarrasses our tradition, and has absolutely no precedent in this Court, or any other federal court. For this reason, again, the decision below should be reversed, the government’s motion to dismiss denied, and appellants afforded an opportunity to provide evidence about the original meaning of the term “limited Times.”

## CONCLUSION

Congress's change from an opt-in to opt-out system of copyright is the most significant change to copyright protection in American history. If appellants are correct, it will have a profoundly negative effect upon a wide range of speakers. Nothing in *Eldred* precludes this Court from weighing these free speech interests against the important governmental interests that copyright protection advances. Indeed, *Eldred* directly invites just such a review. If tradition immunizes a copyright practice from First Amendment review, then deviations from that tradition should be tested to assure that they serve the same pro-speech end that copyright law in general serves. This Court should therefore reverse the decision below, and remand this case for further proceedings applying ordinary First Amendment review.

Likewise, it should permit evidence on the original meaning of the term  
“limited Times.”

Dated: April 4, 2005

Respectfully submitted,

/s/

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## **PROOF OF SERVICE**

I, Judy Gielniak, the undersigned, do hereby state:

I am over eighteen years of age and not a party to the instant proceedings. My business address is: Stanford Law School, 559 Nathan Abbott Way, Stanford, California 94305.

On April 4, 2005, I caused to be served the within:

### **APPELLANTS' REPLY BRIEF**

on opposing counsel by depositing two true copies thereof, enclosed in a sealed envelope with postage fully pre-paid, in a mailbox regularly maintained by the Government of the United States at Palo Alto, California, to each person listed below, addressed as follows:

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