

No. 10-545

IN THE
Supreme Court of the United States

LAWRENCE GOLAN, *ET AL.*,

Petitioners,

—v.—

ERIC H. HOLDER, JR., ATTORNEY GENERAL, *ET AL.*,

Respondents.

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

**BRIEF OF *AMICI CURIAE*, INFORMATION SOCIETY
PROJECT AT YALE LAW SCHOOL PROFESSORS
AND FELLOWS, IN SUPPORT OF THE PETITIONERS**

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INTEREST OF *AMICI CURIAE*¹

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¹ No counsel for a party authored this brief in whole or in part, and no person or entity other than *amici* and their counsel made any monetary contribution toward the preparation or submission of this brief. Counsel for the respondents, on April 20, 2011, and counsel for the petitioners, on May 19, 2011, have filed in this Court consent to the filing of amicus curiae briefs in support of either party or of neither party in fulfillment of S. Ct. Rule 37.3. This brief was written by Nicholas Bramble, Lecturer in Law and MacArthur Fellow in the Information Society Project at Yale Law School, Bryan Choi, Postdoctoral Associate in Law and Kauffman Fellow in the Information Society Project at Yale Law School, and Bradley Wilson Moore, Visiting Fellow in the Information Society Project at Yale Law School, under the supervision of the undersigned Senior Fellow of the ISP, Priscilla Smith.

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SUMMARY OF ARGUMENT

By abrogating the rule that works pass permanently into the public domain, Section 514 of the Uruguay Round Agreements Act (“URAA”) violates one of the traditional contours of copyright law that serve to balance copyright and freedom of speech. These traditional contours, including the idea/expression distinction, the fair use defense, and limited times, are constitutional privileges that keep copyright law consistent with the requirements of the First Amendment. Congress may not abridge them any more than it could require that defamation for public figure plaintiffs should be governed by a negligence standard instead of the actual malice rule of *New York Times v. Sullivan*. Therefore strict scrutiny should apply.

The permanence of public domain status is a constitutional privilege that is justified both by long tradition and by the logic of the copyright system as an engine of free expression.

Congress’s revocation of works from the public domain is unprecedented. Legislative history since the time of the Framers reveals an unbroken congressional practice of preserving the finality of the public domain. Only wars and other exceptional disasters resulting in serious disruptions of communications systems that would unfairly prevent authors from claiming copyrights have warranted deviation from that basic agreement.

Congress has made policy judgments about which works should receive copyright protection, how copyrights are granted and expire, and when works will enter the public domain. But the public domain has never been subjected to this level of congressional manipulation. The contents of the public domain have always been free for all to use without fear that the privilege could be revoked at any time and works made in good faith would suddenly become illegal to publish or perform. The evidence in this case amply demonstrates the free speech harms imposed on creators, publishers, archivists, distributors, and other citizens who have come to rely on free and stable access to public domain works.

The URAA undermines central features of the constitutional arrangements that drive copyright's engine of free expression. That engine of free expression consists of a three-stage life cycle in which works are created, exclusive rights are granted to authors for limited times to incentivize production, and finally works are released permanently into the public domain. The last stage in the life cycle is crucial to copyright's free speech bargain because it allows future creators to make use of public domain material to produce new creations and new innovations. If Congress could take works out of the public domain at its pleasure, these future creative uses would be chilled because authors and artists would never know whether compositions using public domain material would later become contraband. Hence the finality of the public domain, like the idea/expression distinction and the fair use

defense, is a key constitutional privilege protected by the First Amendment.

The parties to this case were incorrect to stipulate that the URAA is content-neutral, and therefore that intermediate scrutiny is the appropriate standard of review. This Court's First Amendment doctrine often uses constitutional privileges, like the actual malice rule of *New York Times v. Sullivan* or the rule of *Brandenburg v. Ohio*, to demarcate zones of free speech protection in areas like defamation or conspiracy law; there, legislatures may justifiably regulate communications because of their content. These constitutional privileges balance important free speech values against interests in social order.

It is for this Court, and not for Congress, to strike this crucial balance. Thus, Congress may not change the actual malice rule because it wishes to balance speech and reputation differently from this Court. So too, Congress may not discard the traditional contours of copyright doctrine such as the idea/expression distinction, or, in this case, the permanent passage of works into the public domain. When Congress attempts to subvert a constitutional privilege that preserves the compatibility of the First Amendment with other areas of law—such as libel, obscenity, and incitement—it attempts to subvert a categorical balance already struck. Hence strict scrutiny should apply.

Section 514 cannot survive strict scrutiny. None of the interests articulated by the government—protecting the interests of American authors abroad, remedying past inequities suffered by foreign authors, and compliance with the Berne

Convention—are compelling. Even if they were, Section 514 is badly drafted to achieve these ends: it either fails to fulfill these goals or burdens far more speech than is necessary to fulfill them.

ARGUMENT

I. The Finality of Public Domain Status Is One Of The Traditional Contours Of Copyright Law That Is Essential To Protection Of Free Expression Under the First Amendment.

In *Eldred v. Ashcroft*, 537 U.S. 186 (2003), this Court held that First Amendment scrutiny is not necessary where Congress has not disturbed the traditional contours of copyright law that protect free speech values. In the present case, Congress has abridged important free speech protective features of copyright. Both the *traditions* of governmental practice dating back to the founding and the basic *logic* of granting exclusive rights for limited times to promote free expression reveal the constitutional significance of the public domain.

A. The Finality Of Public Domain Status Is A Longstanding Tradition That Can Be Traced To The Framers

In *Eldred*, this Court upheld the Sonny Bono Copyright Term Extension Act in part because history revealed “an unbroken congressional practice” of granting retroactive term extensions to existing copyrights. *Id.* at 200. This case is different. Here, history reveals that the URAA transgresses an

equally unbroken congressional practice of preserving the finality of the public domain.

1. By Long Tradition, Congress Has Upheld The Finality Of The Public Domain

The history of copyright legislation in the United States can be traced back to before the ratification of the Constitution. In 1783, acknowledging the need to protect copyright interests but lacking authority to do so, the Continental Congress passed a resolution encouraging the individual states to enact copyright provisions. That resolution recommended issuing copyrights only “to the authors or publishers of any new books *not hitherto printed.*” Resolution of May 2, 1783 (emphasis added), *reprinted in* Copyright Office, Copyright Enactments: Laws Passed in the United States Since 1783 Relating to Copyright 1 (1973). Because the resulting patchwork of conflicting state rules proved ineffectual in governing copyright, the framers granted power to Congress to enact a federal copyright regime. *See* The Federalist No. 43, at 272 (James Madison) (Clinton Rossiter ed., 1961).

The Copyright Act of 1790 was the first exercise of Congress’s new authority. Consistent with the original resolution of 1783, no works were removed from the public domain. The 1790 Act protected only: (1) works that already enjoyed copyright protection, and (2) works that had not yet been printed or published.

The first clause of Section 1 of the 1790 Act created a federal copyright for authors who “have not transferred to any other person the copyright of [their work],” and to any other persons who “have purchased or legally acquired the copyright of any such [work].” Act of May 31, 1790, 1 Stat. 124. That clause honored legacy copyrights, which was necessary to smooth the transition to a federal copyright system.

The second clause created a federal copyright for authors of works “already made and composed, and not printed or published, or that shall hereafter be made and composed.” *Id.* Under that clause, any work that already existed at the time of enactment was copyrightable only if it had not yet been printed or published. In other words, works that had been publicly circulated (and that were not protected by another valid copyright) were in the public domain, and the 1790 Act did not create or restore copyright protection for such works.

The Copyright Act of 1831 likewise upheld the traditional finality of the public domain. The 1831 Act extended the initial term of copyright from 14 years to 28 years. But while Congress applied the 1831 Act retroactively to all works still under copyright protection, it explicitly provided that the Act “shall not extend to any copyright heretofore secured, the term of which has already expired.” Act of Feb. 3, 1831, § 16, 4 Stat. 436, 439. The clear message was that the term of a copyrighted work could be extended but not resurrected. That exemption included works that had entered the public domain through failure to comply with requisite formalities, such as failure to record title or

print copyright notice. *See* Eaton S. Drone, *A Treatise on the Law of Property in Intellectual Productions in Great Britain and the United States* 297 (1879).

Similar statements and limitations accompanied subsequent extensions of scope or term. *See* Pet'rs Br. 34-41; *see also* Register's Report on the General Revision of the U.S. Copyright Law 57 (1961) (recommending term extension but assuring readers that the "new law would not, of course, restore protection to works that had gone into the public domain before its effective date").

2. Emergency Exceptions For Wartime Hardship Do Not Contravene Congress's Longstanding Practice Of Disallowing Removals Of Expired Copyrights From The Public Domain

Two exceptions help prove the rule that Congress has traditionally respected the finality of the public domain. In both instances, Congress provided a limited allowance because wartime disruption of international communications prevented foreign authors from complying with the necessary formalities of copyright registration.

First, in 1919, Congress passed a retroactive extension of time to register works published abroad during World War I. Act of Dec. 18, 1919, Pub. L. No. 66-102, 41 Stat. 368. The grace period applied only to foreign works that would have been eligible for copyright protection during that time period, and did

not restore copyright for any works that were otherwise in the public domain.

Second, in the midst of World War II, Congress generalized the hardship exception by providing that the President could grant an extension of time whenever there was a temporary “disruption or suspension of facilities essential for . . . compliance” with the formalities of copyright registration. Act of Sept. 25, 1941, Pub. L. No. 77-258, 55 Stat. 732.

Even if those amendments can be characterized as removing works from the public domain, “they were, at most, a brief and limited departure from a practice of guarding the public domain . . . passed in response to the exigencies of a world war.” *Golan v. Gonzales*, 501 F.3d 1179, 1192 (10th Cir. 2007) (“*Golan I*”). Those works would have been rightfully copyrighted but for the emergency of war. By contrast, the URAA extends retroactive protection to works that were never eligible for copyright protection, and to works whose protection expired legitimately through the natural process of law.

3. Private Copyright Bills Passed By Congress Do Not Undermine Longstanding Traditions or Support Copyright Restoration

Nor do the various private bills passed by Congress build a case for disrupting the public domain. While individual petitions to Congress were once common, private bills relating to copyright were seldom granted. Since the founding of this country,

only ten have been approved. *See generally* 1 William F. Patry, *Copyright Law and Practice* 27 n.80 (1994).

Of those ten, four were straightforward extensions of an existing copyright. *See* Act of Feb. 17, 1898, 30 Stat. 1396 (extending the copyright of Judson Jones); Act of Mar. 3, 1843, 6 Stat. 897 (continuing the copyright of John Rowlett); Act of Feb. 11, 1830, 6 Stat. 403 (same); Act of May 24, 1828, 6 Stat. 389 (same). Two addressed petitions to cure errors of noncompliance with the formalities of registration. *See* Act of June 23, 1874, 18 Stat. 618 (imperfect copy deposited); Act of Feb. 19, 1849, 9 Stat. 763 (mistaken venue). Another involved the outright purchase by Congress of a copyright. *See* Act of Aug. 2, 1854, 10 Stat. 810.

In two instances, copyrights were granted to the widows of authors whose books had already been “published under order of Congress.” *See* Act of May 24, 1866, 14 Stat. 587; Act of Jan. 25, 1859, 11 Stat. 557. At first glance, they might resemble retroactive copyrights due to the fact of prior publication. But Congress commissioned both publications, thus distinguishing them from ordinary publications. In each case Congress seized the copyrightable interest, temporarily permitted publication for national purposes, and later transferred that interest back to the widow as compensation.

The final private copyright bill, the only one passed in the twentieth century, did attempt to revive copyrights in all editions of the primary religious text of the Church of Christian Science. *See* Act of Dec. 15, 1971, Priv. L. No. 92-60, 85 Stat. 857. The bill was held unconstitutional for violating the

Establishment Clause, and thus no determination was made on the question relevant to this case. *See United Christian Scientists v. Christian Sci. Bd. of Dirs., First Church of Christ, Scientist*, 829 F.2d 1152 (D.C. Cir. 1987). Nevertheless, the court observed that the copyright granted was “far from ordinary,” and that there was scant authority for “such a dramatic departure from copyright practice.” *Id.* at 1169-70.

B. The Finality Of Public Domain Status Is An Essential Component Of The Engine Of Free Expression Established By The United States Copyright System

This history of protecting the permanence of the public domain is reinforced by the logical operation of copyright law’s “engine of free expression.” *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 558 (1985). That engine of free expression operates by coupling exclusive rights for limited times (to incentivize the production of future works) with the eventual and permanent release of works into a public domain where they can be the basis of new creations and innovations. During the first decades of a work’s existence, the author reaps the economic rewards of production; after the conclusion of the copyright term, the public enjoys the benefits, and later authors can use these materials free of charge.

This bargain, and the lifecycle of creative works that it establishes, is not accidental or optional; it is essential to copyright’s function as an engine of free expression. That is why the

requirement of “limited times” was placed in the Constitution: after the “limited times” are concluded, the work belongs to the public. *See Graham v. John Deere Co.*, 383 U.S. 1, 5-6 (1966) (“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.”).

2. Copyright’s Engine Of Free Expression Consists Of A Three-Stage Life Cycle That Concludes With The Public Domain

American copyright law furthers and is made consistent with First Amendment values by moving creative works through a life cycle consisting of three distinct stages. This life cycle of creative work—expression, protection, and public use—is implicit in the Constitution’s grant of Congressional power to create copyrights for “limited times.” *See Graham*, 383 U.S. at 6 (bar on removing existent knowledge from the public domain is a “standard expressed in the Constitution [that] may not be ignored”).

Allowing Congress to disrupt this life cycle by removing works from the public domain would seriously undermine the free-speech-protecting functions of copyright. This disruption would violate the central purpose behind Congress’s “limited times” power and would frustrate reliance on the public domain as a source of expressions and ideas for future creation.

Congress may extend *existing* intellectual property protections without disturbing reliance

interests. *See Eldred*, 537 U.S. at 218-19. What Congress may not do is snatch works out of the public domain and thereby make illegal the performance or distribution of creative works produced in reliance on copyright's grand bargain. Absent wartime emergencies, the basic plan of the founders must remain inviolate for copyright to serve its function as an engine of free expression.

a. Stage I: Creation Of A Work Of Authorship

At the first stage of copyright's engine of expression, a prospective author or creator draws upon a variety of prior ideas and expressions, and combines those inputs with new concepts and inspirations to produce a discrete output—a work of authorship. Many of these prior ideas and expressions come from the public domain, which is a crucial source of material for future expression.

b. Stage II: Legal Protection Of A Work

Once a work has been created, Congress may confer on its authors exclusive rights to protect and exploit its value. These rights fuel the engine of innovation by providing appropriate incentives to produce additional works. Authors are able to recoup the costs of production by requiring compensation from others who wish to use or perform the work. In addition, copyright entitlements confer systemic benefits by “free[ing] [authors] from reliance on patronage and cultural hierarchy.” Neil Netanel, *Copyright and a Democratic Civil Society*, 106 Yale L. J. 283, 364 (1996).

In earlier copyright regimes, the second stage of a work's life cycle began only after registration; today, the second stage begins at the moment of fixation. *See Eldred*, 537 U.S. at 217. Congress's power under the Copyright Clause includes the power to design formalities and other eligibility requirements that authors must satisfy in order to obtain or retain U.S. copyright protection. Past examples have included registration with the Copyright Office, submission of copies of the work, publication of copyright notice, application for renewal terms, and restriction by country of production. In setting such eligibility requirements, Congress is setting forth its judgment that the optimal term of protection for noncompliant works is zero years. Such works shall, upon publication, pass directly through the second stage of copyright's engine of free expression and into the third stage, the public domain.

While Congress may alter these eligibility requirements at any time, it may not bestow retroactive eligibility upon a work that has already entered the public domain. Eligibility requirements are designed to create clear rules for obtaining and renewing copyright protection and to draw clear distinctions between works that are subject to copyright protection and those that are not. Once the opportunity for copyright protection has passed, the copyright system does not give authors a second bite at the apple.

c. Stage III: Permanent public availability of a work

A work enters the final stage of its life cycle when it becomes part of the public domain.³ The public domain holds some of the most central and hallowed relics of Western culture—including the Bible and Shakespeare’s plays. Becoming part of the public domain means that works are available for all to use. New creators have the chance to use, distribute, contextualize, modify, and improve upon previous public domain work without asking permission. *See Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33-34 (2003) (“[O]nce the . . . copyright monopoly has expired, the public may use the . . . work at will and without attribution.”). The public domain ensures that new authors can draw upon a vast inventory of works as inputs for new expression and innovation.

Before a work enters the public domain, free speech rights to use the work are limited in order to create incentives for production. After the work enters the public domain, however, full free speech

³ Traditionally, authors’ ownership and ability to control publication of their works ended after publication, *Wheaton v. Peters*, 33 U.S. 591, 658 (1834), and any published material was privileged for all to use. The Copyright Act of 1790 created a new limited right to control works after initial publication, but otherwise preserved the privilege to use materials after the expiration of that limited period. *Id.* at 661; *see also* Neil Netanel, *Copyright’s Paradox* 83 (2008) (“[A]t the Founding copyright law served the goal of disseminating knowledge as much by providing for an exceedingly limited scope, duration, and subject matter of copyright protection as by the grant of exclusive rights itself.”).

rights are restored to the public. This feature, along with other doctrines like fair use and the idea/expression distinction, *see Eldred*, 537 U.S. at 219-21, is crucial to maintaining the balance between copyright and the First Amendment.

3. Retroactive Removal Of Works From The Public Domain Derails Copyright's Engine of Free Expression

Both history and constitutional logic justify the finality of public domain status in the American system of copyright law. If Congress could revoke this finality whenever it liked, real harms will occur to a wide range of groups and creators engaged in artistic expression. Although these harms may not look significant when taken individually, the collective threat to free speech values that they pose is the erosion of longstanding conventions that have allowed the First Amendment and the Progress Clause to work harmoniously together.

Permanent entry of works into the public domain after “limited times” have expired is central to the free speech bargain. Most works of authorship contain “much which is old and well known, mixed up with something which perhaps is new, peculiar, and original.” 2 Joseph Story, *Equity Jurisprudence* § 940 (8th ed. 1861). If public domain status were temporary, or could be revoked at the pleasure of Congress, then authors who use public domain works to build new creations could be stripped at any time of the right to perform and distribute those new works. Such instability would discourage people from using the public domain to speak and create new

works, because they could never be certain whether works were genuinely free for the public to use and how their use of the public domain would affect their rights down the road. This would undermine the very point of releasing works into the public domain: increasing the free availability of inputs into speech and creative activity.

Perhaps more troublingly, giving Congress the ability to snatch works out of the public domain would leave authors unable to determine whether their creative labors and their artistic expression will be made *retroactively* illegal to perform or distribute. For example, if Congress were to remove Shakespeare's plays or Jane Austen's novels from the public domain, then any books, plays, music, or recordings that extensively reused quotations, characters, or plotlines from those works could become contraband. Presumably the Ex Post Facto Clause would prevent criminal liability for works created before Congress changed the rules. But the Ex Post Facto Clause does not apply to civil litigation, *see Smith v. Doe*, 538 U.S. 84 (2003), and authors who had used Shakespeare's or Austen's works in good faith could be subjected to a civil regime of damages that nevertheless results in ruinous liability.

Preventing retroactive civil liability or creating a grace period, as the URAA does, 17 U.S.C. § 104A(d)(2)(A), is insufficient protection. All prospective uses or performances of works using formerly public domain materials would trigger significant civil penalties. The authors and users of this speech would henceforth be prohibited from performing or distributing their own works—works

that they had full First Amendment rights to create, perform, or distribute before Congress changed the rules. Archival efforts, machine-learning projects, Internet search tools, and other aggregative uses of public domain works would be thrown into disarray, particularly those that generate multiple copies of such works and enable others to add layers of additional information atop a given work. Encouraging people to use public domain materials, and then later making those uses illegal, strikes at the very heart of copyright's bargain and raises the most serious First Amendment concerns.

Accordingly, the longstanding rule for public domain works has been that once a work enters the public domain, it remains there permanently. This rule is so intuitive and so inherent in the concept of a public domain that it seldom rises to the level of conscious articulation. *See* 4 David Nimmer, *Nimmer on Copyright* § 18.06[C][1] (2010) (describing Congress's "shatter[ing]" of "the long-standing practice of refusing to resurrect works from the public domain" through passage of the URAA). Just like the doctrines of fair use and the idea/expression distinction, the permanence of the public domain is integral to the copyright system. It is an essential element of copyright's engine of free expression and "an affirmative manifestation of copyright's democracy-enhancing principles." Netanel, *Copyright and a Democratic Civil Society*, *supra*, at 363. The public domain functions as a crucial stopgap measure that prevents reappropriation of works by former owners once the works have crossed a recognized threshold.

The founders could have arranged for the limited times requirement to operate in a different manner—for instance, through case-by-case determinations of when works would enter the public domain—but such a process would likely be subject to abuse and might raise free speech concerns of its own. Instead, Congress implemented copyright law in a straightforward fashion: works travel through a three-stage lifecycle concluding with permanent entry into the public domain. That decision involved a series of policy judgments: it clearly prioritized protecting settled expectations and making it easy to determine who owns—and does not own—property in artistic creations.

If Congress were permitted to renew the copyright of works after their copyrights had already expired, the basic system of logical tradeoffs underlying copyright's engine of free expression would be subject to piecemeal redesign. Powerful interests would lobby to reclaim ownership of public domain works with little regard for the systemic goals of copyright law. No constitutional principle would stand in the way of propertizing more and more of the public domain after the fact. Layer upon layer of special interests would corrode the engine of free expression, and its performance would eventually suffer.

The facts of this case show just how such a regime creates bad incentives and significant public choice problems. As a general matter, performers, archivists, and resellers are diffuse and poorly organized; they are therefore unlikely to be able to monitor, much less influence the details of international treaty negotiations. Copyright holders

with large portfolios have concentrated interests: far more resources and much stronger incentives to attempt to influence such proceedings. If plucking works out of the public domain is constitutionally permissible, increasing amounts of the public domain may someday be reclaimed, for the defenders of Section 514 offer no limiting principle to prevent this result. But the constitutional purpose of the finality of the public domain is to ensure that petitioners such as Golan need *not* anticipate the possibility that a faraway treaty negotiator will bargain away their rights of artistic expression and essential conditions of their economic livelihoods. The First Amendment, like other constitutional protections, exists precisely to compensate for such failures in the democratic process. See *United States v. Carolene Products*, 304 U.S. 144, 152 n. 4 (1938).

4. Fair Use And The Idea/Expression Dichotomy Cannot Protect Against The Speech Harms Associated With Destruction Of The Finality Of Public Domain Status

Fair use and the idea/expression dichotomy by themselves are insufficient to protect against the speech harms associated with destruction of the finality of public domain status. See David S. Olson, *First Amendment Interests and Copyright Accommodations*, 50 B.C. L. Rev. 1393, 1403-04 (2009). These doctrines protect free speech values during the first two stages of the three-stage life cycle; but both fail to adequately guard against piecemeal deterioration of the third stage. Neither

the fair use defense nor the idea/expression dichotomy would permit petitioners to continue performing works in their entirety and creating derivative interpretations.

Moreover, both doctrines may protect the use of only a small portion of a given work. *Golan I*, 501 F.3d at 1195. The idea/expression dichotomy offers no refuge, as it extends only to the “idea[s], theor[ies], and fact[s] in a copyrighted work,” and not to the work itself. *Eldred*, 537 U.S. at 219. Similarly, the scope of fair use is limited by an inquiry into whether a “reasonable copyright owner [would] have consented to the use.” *Harper & Row*, 471 U.S. at 550. The public domain extends beyond that narrow scope and enables a wide variety of complete and unforeseen uses—such as Ron Hall’s small business built on selling classic and foreign films—that are not tethered to the agenda or expectations of a “reasonable copyright holder.” *Cf. id.*

There is an additional problem: fair use is structured “as an affirmative defense requiring a case-by-case analysis.” *Harper & Row*, 471 U.S. at 561. The ad hoc form of the defense limits the ability of speakers to rely upon it as a systematic bulwark against efforts by copyright owners to diminish speech privileges. See Jessica Litman, *Reforming Information Law in Copyright’s Image*, 22 U. Dayton L. Rev. 587, 612 (1997). Users and secondary authors cannot simply rely on the existence of fair use; it must be privately litigated based on a different set of facts each time it is invoked.

II. Because Section 514 Radically Alters Copyright Law’s Traditional Contours And

Supersedes The Court's Role In Interpreting And Applying The Constitution, Strict Scrutiny Is The Required Standard Of First Amendment Review

Amici agree with Petitioners that Section 514 fails intermediate scrutiny. *See* Pet'rs' Br. 48. However, Section 514 should be subject to strict scrutiny. The traditional contours of copyright—fair use, idea/expression, and limited times—are First Amendment privileges. *See* Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. Rev. 354, 363 (1999) (“To say that a person is *privileged* to do something is to say that she can do that thing, and that no one can get a court to enlist the government against her.”). They represent balances between free speech values and other concerns, which Congress may not eliminate without the strongest justification.

The best analogy is to the rules that shape the laws of defamation, obscenity, and incitement. Although legislatures may devise a wide range of different solutions to those problems, if they abridge key constitutional privileges—like the “actual malice” rule in defamation—their innovations are subject to strict scrutiny. A test of intermediate scrutiny would make it far too easy for Congress to undermine the Court’s careful balancing of reputational interests and freedom of expression in the actual malice rule. In the same way, applying intermediate scrutiny to this case would make it too easy for Congress to undermine the traditional

contours of copyright law that balance copyright protections with the First Amendment.

A. Where A Basic Constitutional Privilege Is Undermined, The Court Should Apply Strict Scrutiny

First Amendment doctrine generally prohibits regulations of speech based on viewpoint or content. *See, e.g., Citizens United v. Fed. Election Comm'n*, 558 U.S. 50 (2010); *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989).

In some contexts, however, legislatures are free to regulate speech on the basis of content and viewpoint. Defamation law is a good example: defendants can be held liable for falsely saying that “Smith is a liar” but not for falsely saying that “Smith is an honest woman.” That distinction is both content- and viewpoint-based. Defamation is one of a number of *communications torts* like fraud, perjury, and invasion of privacy that have this distinctive character: what makes the conduct tortious or criminal is the *content* of what is being said.

In these situations, the Court protects freedom of speech not through a simple ban on content-based regulation but instead through the creation of *constitutional privileges* that balance free speech with governmental interests in restricting speech. In the law of defamation, for example, public figure plaintiffs must prove that defendants have spoken with actual malice. *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 282 (1964) (describing the speech standard as a “privilege for criticism of official conduct”). Private figure plaintiffs must show at least

negligence and they must show actual malice to receive presumed and punitive damages. *Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974). Similarly, in regulating obscenity, legislatures may make many different distinctions based on content and subject matter, but they must not run afoul of the constitutional privileges created by *Miller v. California*, 415 U.S. 15, 23 (1973). Finally, the law of conspiracy and incitement routinely make liability turn on the content of what was said, but legislatures must abide by the rule of *Brandenburg v. Ohio*, 395 U.S. 444, 447-49 (1969), which permits liability only when advocacy of illegal conduct is directed to producing imminent lawless action and is likely to result in such action.

Each of these constitutional privileges strikes a balance between free speech values and societal interests through the creation of categories of protected and unprotected expression. The “actual malice” requirement—which focuses on the plaintiff’s status and the defendant’s *mens rea*—is the result of the Court’s careful balancing of the importance of citizens’ contributions to public discourse with the legitimate reputational interests of public figures.

As with the laws of defamation, obscenity, and incitement, copyright law regulates expression and exposes material to liability based on the content of what it expresses. Even fair use, a defense against infringement, exempts various material from liability based on its content, its viewpoint, or the purposes (e.g., educational, charitable) for which it is used. A simple rule *prohibiting* distinctions based on content or viewpoint makes no more sense in

copyright than it does in the law of defamation or obscenity.

As a result, in copyright law, as in defamation law, the Court has struck categorical balances between free speech values and governmental interests. It has protected First Amendment interests through a set of constitutional privileges: these are the “traditional contours” of copyright law that the *Eldred* Court described, e.g., fair use, the idea/expression distinction, and limited times.

Once a given constitutional privilege is identified, legislatures may work within its boundaries by making adjustments and exemptions that are related to the purposes of defamation, obscenity, conspiracy, or copyright law. For example, Congress may seek to determine what forms of defamatory speech are most harmful and should be the most discouraged, while exempting others or creating new defenses. *See R.A.V. v. City of St. Paul*, 505 U.S. 377, 388 (1992) (content-based distinctions of nominally unprotected speech are permissible where “the basis for the content discrimination consists entirely of the very reason the entire class of speech at issue is proscribable”). Nevertheless, if a legislature seeks to abolish the core of the constitutional privilege—in the case of defamation law, to abolish the actual malice rule for public figure plaintiffs and replace it with liability for mere negligence—such a law would be subject to strict scrutiny. Congress may reshape these contours at the margins, but it may not abolish or alter them in a manner that reconfigures the basic constitutional balance. If it does so, its regulations are subject to strict scrutiny.

The reason for subjecting such laws to the Court's strictest standard of scrutiny is simple but essential: "Congress may not legislatively supersede [the Court's] decisions interpreting and applying the Constitution." *Dickerson v. United States*, 530 U.S. 428, 437 (2000); *see also City of Boerne v. Flores*, 521 U.S. 507, 519–20 (1997). Strict scrutiny ensures that when this Court creates a categorical balance that preserves an important constitutional liberty, Congress cannot legislatively supersede this balance under a relaxed standard. Instead, it must justify its regulation by showing that it is narrowly tailored to serve a compelling state interest with no less restrictive alternatives. A lower standard of scrutiny would effectively allow Congress to rewrite First Amendment decisions like *New York Times v. Sullivan* by choosing a different balance between reputation and public debate and asserting that it was justified by an important government interest.

B. Where Congress Alters The Contours And Structure Of Copyright Law In A Way That Derails Copyright's Engine Of Free Expression, Its Actions Abridge A Basic Privilege Of Free Expression And Must Be Subject To Strict Scrutiny

The rules of copyright law, like those developed for libel law, obscenity law and the law of seditious advocacy, require special privileges that balance Congress's interests in regulation against free speech values. As shown earlier in this brief, both tradition and copyright's three-stage engine of

free expression require that works permanently enter the public domain following the “limited times” of copyright protection. The entrance of works into the public domain, and the corresponding right to use such works without seeking permission, is a constitutional privilege of citizens that furthers key First Amendment values.

Although Congress may adjust these basic contours of copyright, it may not substantially alter them, much less abolish them. If it does so, its regulation is subject to strict scrutiny, just like a law seeking to punish incitement inconsistent with the rule of *Brandenburg v. Ohio*. Section 514 abridges the traditional privilege of permanent use of the public domain; therefore strict scrutiny applies.

It is instructive to compare what Congress did in enacting Section 514 with the must-carry rules upheld in this Court’s decision in *Turner Broadcasting System, Inc. v. F.C.C.*, 520 U.S. 180 (1997). Unlike defamation law, telecommunications law generally involves structural regulation designed to promote goals like innovation or the free flow of information, but it ordinarily does not regulate on the basis of content or viewpoint. The Court regarded the must-carry rules as a structural regulation designed to ensure that cable companies treat broadcast companies fairly and to prevent Americans from losing the benefits of on-air broadcasting. As Justice Breyer’s concurrence explained, ensuring “diverse and antagonistic” sources of information necessary to democracy was not a direct regulation of content, but an indirect regulation of industry structure. *Id.* at 226-27 (Breyer, J., concurring). No equivalent constitutional privilege like that in *New*

York Times v. Sullivan was implicated or abridged. Because the Court was faced with a structural regulation of time, place, and manner, intermediate scrutiny applied.

Section 514 of the URAA bears little resemblance to the statute upheld in *Turner*. Section 514 is not a structural regulation of the publication industries that seeks to increase the total number of voices and promote the wide dissemination of information. Instead, Section 514 seeks to shut down free access to works and limit the dissemination of information to a wider audience. It undermines the free speech bargain that makes copyright effective as an engine of free expression, and it violates a traditional feature of copyright law that dates back to the founding. Accordingly, a higher standard of constitutional scrutiny is necessary.

A comparison of Section 514 with the statute upheld in *Eldred v. Ashcroft* is similarly informative. In *Eldred*, the Court found that temporal adjustments to an existing term of copyright did not substantially alter copyright's basic contours, so long as those temporal adjustments did not transform copyright into "a forever thing." 537 U.S. at 209 n.16. *Eldred* thus concerned a pragmatic question over *when* an item should finally and permanently enter the public domain. The Court held that Congress could resolve that pragmatic question so long as the basic concept of "limited times" was respected. *Id.* at 205, 208. Congress had made a number of laws extending the duration of copyright in a manner consistent with the traditional contours of copyright law, and it could continue to do so.

Section 514 of the URAA, on the other hand, involves no such questions of pragmatic balancing or historical continuity. Unlike the Copyright Term Extension Act, which regulates the length of existing copyright protection, Congress has used Section 514 to make a law restricting speech in an area where no laws had previously been made. *See Golan I*, 501 F.3d at 1193 (noting that *Eldred* plaintiffs never “possessed unfettered access” to the works in question). The effects of Section 514 bear little similarity to the incremental change that occurs when Congress lengthens or reduces an existing term of a copyright. Rather, Section 514 regulates a domain of speech that heretofore had been wholly shielded from the enforcement of exclusive private rights.

The extension of *existing* copyrights does not undermine reliance interests in the same way that Section 514 does. The CTEA may have frustrated authors’ future expectations as to when a particular work would enter the public domain and become eligible for free use without licenses or liability. By contrast, Section 514 threatens the legal status of works that authors *have already created* using public domain materials and in reliance on the enduring legality of using those materials. Whereas CTEA frustrated future hopes, Section 514 changes the rules after creation has already occurred and after the game has already been played.

By removing works from the public domain, Section 514 violates the traditional contours that have governed copyright from the nation’s inception and upsets the balance of interests forged since the founding; it abridges the justified interests and

settled expectations of people who have made and who wish to make creative works from materials that have already entered the public domain. As such, courts should treat Section 514 just like a law that imposes strict liability for defaming a public figure, or a law that bans the advocacy of violent action against the government without requiring any showing of incitement of imminent lawless action.

Where Congress has abrogated a longstanding constitutional privilege, the Court must do more than simply balance the rights of affected speakers against the interests of Congress. The balance has already been struck through the creation of the constitutional privilege. Therefore the law must be held invalid, or, at the very least, strict scrutiny must apply.

C. Section 514 Of The URAA Fails Strict Scrutiny

If strict scrutiny applies, then the government must show that Section 514 of the URAA advances a compelling state interest, and that it is narrowly tailored to achieve that purpose. *Sable Commc'ns of Cal., Inc. v. F.C.C.*, 492 U.S. 115, 126 (1989). The government has asserted that the speech restrictions imposed by Section 514 are justified by three separate interests: (1) protecting the interests of American authors abroad; (2) remedying past inequities suffered by foreign authors in the United States; and (3) compliance with the Berne Convention. None of those interests meet the requirements of strict scrutiny.

1. Securing The Foreign Copyright Interests Of U.S. Authors Is Not A Compelling State Interest, And Section 514 Is Not Narrowly Tailored To Achieve It

Amici agree with Petitioners that “[f]ar from being an important interest,” the goal of promoting the rights of U.S. copyright holders abroad is “not even a legitimate purpose.” Pet’rs’ Br. 49.

As an initial matter, the government is incorrect in asserting that U.S. authors have a First Amendment interest in controlling their works abroad. Only once has this Court even suggested (“arguendo”) the possibility of applying the First Amendment abroad. *See Haig v. Agee*, 453 U.S. 280, 308 (1981). But that case involved an effort by the U.S. government to suppress the speech of a U.S. citizen living abroad, not to protect his speech.

By contrast, the claim in this case is that there is a First Amendment right to control speech under the laws of *foreign* countries. That claim is controversial at best. *See Yahoo! Inc. v. La Ligue Contre Le Racisme Et L’Antisemitisme*, 433 F.3d 1199, 1226 (9th Cir. 2006) (“Yahoo! is necessarily arguing that it has a First Amendment right to violate French criminal law [T]he very existence of such an extraterritorial right under the First Amendment is uncertain.”). It certainly is not compelling.

The only viable interest that the government has in securing foreign copyrights for U.S. authors is economic. But this Court has never found private

economic aims sufficiently compelling to justify abridgement of protected speech. It is rare for such interests to even be asserted, let alone affirmed. *See, e.g., Lewis v. Colorado Rockies Baseball Club, Ltd.*, 941 P.2d 266, 276 (Colo. 1997) (“[T]he economic interests of the Rockies are not an appropriate consideration at the ‘significant government interest’ stage of a free speech analysis.”). Instead, interests that have been found sufficiently compelling are those that advance public concerns. *See, e.g., Holder v. Humanitarian Law Project*, 130 S. Ct. 2705, 2724 (2010) (combating terrorism); *Buckley v. Valeo*, 424 U.S. 1, 45 (1976) (preventing corruption and the appearance of corruption in elections).

Even if the private economic interest of U.S. authors were exceptional, Congress failed to advance sufficient evidence to “adequately explain” how Section 514 of the URAA would serve that interest. *Eu v. San Francisco County Democratic Central Comm.*, 489 U.S. 214, 226-29 (1989); *see also Edenfield v. Fane*, 507 U.S. 761, 773 (1993) (requiring restriction on speech to serve articulated interest in a “direct and effective way”). Very little evidence presented before Congress indicated that the URAA would be able to fulfill its promise. This Court should not allow the government to “sacrifice First Amendment protections for so speculative a gain.” *Columbia Broad. Sys., Inc. v. Democratic Nat’l Comm.*, 412 U.S. 94, 127 (1973); *see also Consol. Edison Co. v. Pub. Serv. Comm’n*, 447 U.S. 530, 543 (1980) (“Mere speculation of harm does not constitute a compelling state interest.”).

The evidence before Congress consisted of aspirational, conclusory, and conflicting statements.

One witness testified that the URAA would “increase the leverage available to the U.S. to protect [domestic] industries.” GATT Intellectual Prop. Provisions: Joint Hearing Before the Subcomm. on Intellectual Prop. & Judicial Admin. of the H. Comm. on the Judiciary & the Subcomm. on Patents, Copyrights and Trademarks of the S. Comm. on the Judiciary, 103d Cong. 340 (1994) [hereinafter Joint Hearing]. A representative of the Recording Industry Association of America asserted that “the Russians simply said . . . that they will interpret their obligations . . . in exactly the same manner the United States interprets its obligations,” *id.* at 291, but offered no evidence to indicate Russia would actually pass such a law. Meanwhile, another witness stated more pragmatically that there “is absolutely no guarantee that [foreign nations] are stupid enough to adopt the reliance-party provisions you are being asked to adopt . . . unless we engage in trade-tactic arm twisting.” *Id.* at 231.

None of the evidence showed that Congress’s gambit—sacrificing reliance parties’ speech interests so that other countries would accede to U.S. copyright demands—would likely succeed. As the District Court observed, there “appears to be an assumption that Section 104A will encourage other countries to limit the rights of reliance parties, despite . . . having no obligation to do so under the Berne Convention.” *Golan v. Holder*, 611 F. Supp. 2d 1165, 1175 (D. Colo. 2009). Even if it were possible for Congress to show that protecting U.S. copyright interests abroad is a compelling state interest, it failed to do so. The government has not set forth

evidence that would justify deference. *See Sable Commc'ns*, 492 U.S. at 129.

The absence of substantial evidence before Congress also means that Section 514 cannot be narrowly tailored. When there are no “findings concerning the actual effects” of a regulation, a court cannot conduct a proper inquiry into whether a law is narrowly tailored, because it cannot determine whether speech burdened by the law was unnecessarily suppressed. *See Turner*, 512 U.S. at 667-68; *see also Eu*, 489 U.S. at 228-29.

Moreover, Section 514 burdens a disproportionately large amount of speech—in order to secure foreign copyright interests, it need not burden the speech of citizens as to works that rightsholders will never claim—and thus fails to satisfy strict scrutiny on a third independent ground. *See Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 120-21 (1991).

2. Treating Foreign Authors Equally Is Not A Compelling State Interest, And Section 514 Is Not Narrowly Tailored To Achieve It

Promoting the financial interests of foreign authors is even less compelling than promoting the financial interests of domestic authors. In the first place, the government’s interest lies in “protecting the health, safety, and welfare of its citizens,” *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 485 (1995), not in guaranteeing reciprocity to foreign citizens. Unless

issues of national security are at stake, the government should not be trading the constitutionally protected rights of domestic groups to foreign groups.

Furthermore, the interest itself is disingenuous. Giving retroactive economic rights to foreign authors was merely the bargaining chip with which Congress hoped to obtain its real objective: protection for U.S. copyright holders abroad. Equitable treatment for foreigners was not an actual interest of the government in enacting Section 514. The Court must consider Congress's actual purposes in enacting a statutory scheme. *See Weinberger v. Wiesenfeld*, 420 U.S. 636, 648 & n.16 (1975).

Even if Congress has a compelling interest in holding the rights of foreigners above the rights of its own citizens, it could have achieved that aim in a less restrictive manner. Most notably, Congress could have set a limited window of time for foreign authors to claim their retroactive copyrights, after which point all unclaimed works would remain permanently in the public domain. *See Joint Hearings at 277* (Statement of Larry Urbanski). That process would have been fair because it mirrors the temporary window of time that was available to register those copyrights in the first instance. But indefinite eligibility restricts speech in ways that are unnecessary and unintended. Although unclaimed foreign works remain in the public domain, they are too risky for domestic authors to use: the residual claim could make derivative works illegal at any time, and of course no one can license or sell unclaimed works. Thus the URAA deters the use of works that could have been made available without

restriction for public use under an alternative statute that restricts less speech. *See Sable Commc'ns*, 492 U.S. at 129.

3. Compliance With The Berne Convention May Be A Significant Interest, But It Is Not A Compelling Interest, And Section 514 Is Not Narrowly Tailored To Achieve That Aim

The goal of maintaining good international relations creates valid incentives for the government to comply with international conventions. But that is a far cry from demonstrating that compliance with a specific treaty is a compelling interest. *See Boos v. Barry*, 485 U.S. 312, 324 (1988) (“[T]he fact that an interest is recognized in international law does not automatically render that interest ‘compelling’ for purposes of the First Amendment analysis.”); *see also Bullfrog Films, Inc. v. Wick*, 847 F.2d 502, 512 (9th Cir. 1988) (“[T]he existence of a treaty does not by itself justify . . . violation[s] of the First Amendment.”). The government must demonstrate that the execution of the particular international agreement at issue rises to the level of a compelling interest; it cannot simply rely on generic claims of treaty compliance.

In this case, the government has not shown that the international consequences of noncompliance with the Berne Convention are of higher priority than the speech that is being deterred and threatened by Section 514 of the URAA. Perhaps national security interests could satisfy that criterion, but no such issues are presented here.

Here, the purpose of treaty compliance has been purely one of international trade, i.e., promoting the interests of American authors in foreign countries through the retroactive award of domestic copyright to foreign authors. Neither of those interests is compelling alone, as discussed above, and they are not more compelling in conjunction.

Even if this Court deems the promotion of international trade to be more compelling than the protection of free speech, Section 514 suppresses far more speech than required for compliance with the Berne Convention. Amici concur with the reasons provided by Petitioners, that (1) the government could have negotiated accommodations protective of First Amendment rights; (2) the government could have provided stronger protections for parties with reliance interests; and (3) the government could have adopted the “rule of the shorter term” and protected “first sale” rights. *See* Pet’rs’ Br. 54-61.

In addition to those reasons, the Berne Convention does not require the restoration of copyrights for works that have already received a term of protection under U.S. copyright law. Article 18 of the Berne Convention addresses works that have “fallen into the public domain of the country where protection is claimed”—here, the United States—“through the expiry of the term of protection which was previously granted,” and states that such works “shall not be protected anew.” Berne Convention, art. 18(2). Nevertheless, the URAA authorizes restoration of copyright specifically for works that have entered the public domain through “failure of renewal.” 17 U.S.C. § 104A(h)(6)(C)(i). The recapture of such works, which necessarily received

an initial term of protection, “would seem *not* to be required under the terms of the Berne Convention.” Nimmer on Copyright § 9A.06 (2010).

CONCLUSION

The Court should reverse the judgment below and remand the case with instructions to enter judgment for petitioners.

Respectfully submitted,

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June 21, 2011