
05-1259

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

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

v.

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

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

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

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**APPELLANTS' RESPONSE TO APPELLEES' PETITION FOR
REHEARING AND REHEARING EN BANC**

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ARGUMENT

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

But the petition has at least made it perfectly clear just how extreme the rule the government advances is. Though it had come close both in this case and others before, its petition for review en banc is the clearest articulation so far of the radical rule that the government derives from the Supreme Court's opinion in *Eldred v. Ashcroft*: In the government's view, *Eldred* permits First Amendment review of a copyright statute if *but only if* that statute changes either copyright's (1) idea/expression dichotomy, or (2) "fair use." Beyond these two grounds, "copyright is categorically immune from challenges under the First Amendment." *Eldred v. Reno*, 239 F.3d 372, 375 (D.C. Cir. 2001), *aff'd on other grounds sub nom. Eldred v. Ashcroft*, 537 U.S. 186 (2003).

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

By contrast, the panel opinion is fully consistent with both the text and the reasoning of *Eldred*. Its result is simply that a practice deviating from a longstanding copyright tradition must be tested under the First Amendment. As the First Amendment is the constitutional default for laws regulating speech, the result of the panel opinion is

simply to restore that default in cases where Congress has deviated from copyright's tradition. This requirement is in fact precisely what *Eldred* requires. There is no reason for the panel's careful work to be disturbed now by the court en banc.

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

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

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

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

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

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

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

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

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

On the government’s reading of *Eldred*, the Court simply misspoke when it triggered “further First Amendment review” upon “traditional contours of copyright protection.” What it meant, on the government’s view, was not “traditional contours” but rather the two “First Amendment safeguards” that it had previously identified. The government thus asks this Court in effect to read *Eldred* to say,

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

rather than what the opinion actually says:

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

Eldred, 537 U.S. at 221.

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

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

generally adequate to address them.’” (Pet. 8, *quoting Eldred*, 537 U.S. at 221 (emphasis added)).

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

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

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

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

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

537 U.S. at 221.

But the language of the D.C. Circuit (“categorically immune from challenges under the First Amendment”) should not be read out of context. The D.C. Circuit had not held that a First Amendment challenge to a copyright act could never be raised. Instead,

its opinion explicitly narrowed the immunity it asserted to challenges beyond changes in (1) the idea/expression dichotomy, or (2) “fair use.” Immediately after the D.C. Circuit wrote the text quoted by the Supreme Court, the D.C. Circuit explained that such immunity exists only where the law regulates “expression” and leaves “fair use” protected. Only such copyright laws receive First Amendment immunity. As the D.C. Circuit wrote (again, in very next paragraph after the “categorically immune” language):

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

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

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

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

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

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

(Pet. 8.)

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

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

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

On the government’s reading of *Eldred*, the only changes in the Copyright Act giving rise to a First Amendment question are changes in (1) the idea/expression dichotomy, and (2) “fair use.” If these indeed are the only grounds for First Amendment

review, then there are obvious changes in the Copyright Act that survive First Amendment review under the government's rule but cannot possibly be the law.

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

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

Thus, between

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

and

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

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

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

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

But for the special immunity from First Amendment review articulated clearly by the Court for the first time in *Eldred*, every copyright act would be subject to ordinary First Amendment review. Just as a law regulating speech passed pursuant to the

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

This constitutional default notwithstanding, *Eldred* grants Congress a huge swath of First Amendment immunity. Because of the 212 year history of copyright regulation, the Court granted to any copyright regulation within the “traditional contours of copyright protection” an immunity from “further First Amendment review.” 537 U.S. at 221. But it could make *no principled constitutional sense* to grant an immunity to regulations that stand outside those “traditional contours.” While the long history of copyright is enough sensibly to give the Court the assurance it needs to waive First Amendment review, deviation from that tradition gives the Court no reason to waive the ordinary requirement of the First Amendment review.

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

But this willfully misstates what the panel and the Supreme Court said. *Eldred* does not trigger First Amendment review upon changes in “traditional copyright

scheme[s].” It triggers First Amendment review upon changes in the “traditional contours of copyright protection.” The “contours” of a regulatory program are obviously broader and less distinct than particular “schemes.”

Thus, even if there has never been an exclusive right granted to “digital audio performances” before, when Congress extended that right in 1995, Digital Performance Right in Sound Recordings Act of 1995 (“DPRA”), Pub. L. No. 104-39, 109 Stat. 336 (1995), it was acting within the traditional contours of copyright, crafting new exclusive rights in light of new technologies. Or as the Court in *Eldred* found, when Congress extends the term of existing copyrights as part of a statute extending the term of copyrights prospectively, it is acting within the “traditional contours of copyright protection,” since, as the Court read the history, every change from the founding followed precisely this pattern. The *Eldred* test is explicitly targeting fundamental changes, not “every change.” (Pet. 13.) And while that standard will of necessity require line-drawing, the worst that might happen because of any uncertainty produced by line-drawing is that the government is required to do what the constitution by default requires the government to do whenever the government regulates speech: demonstrate that its regulation satisfies the requirements of the First Amendment.

If the government has a problem with the *Eldred* standard, then the proper remedy is to ask the Supreme Court to clarify the rule — rather than, as the government has in a brief filed November 28, 2007, arguing against any review on the basis that the “error” of the panel in the instant case will be reversed en banc. (Br. for Resp’t 13, *Kahle v.*

Gonzales, 487 F.3d 697, *pet. for cert. pending*, No. 07-189.) The panel has made no “error” in this case. Its opinion is an extraordinarily careful application of an admittedly new constitutional standard. That the government does not like the standard is not a reason to tax this court with any further work.

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

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

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

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

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

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

CONCLUSION

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

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

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

Respectfully submitted this 7th day of December, 2007.

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ADDENDUM

In the Supreme Court of the United States

BREWSTER KAHLE, ET AL., PETITIONERS

v.

MICHAEL B. MUKASEY, ATTORNEY GENERAL

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

BRIEF FOR THE RESPONDENT IN OPPOSITION

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QUESTION PRESENTED

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

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In the Supreme Court of the United States

No. 07-189

BREWSTER KAHLE, ET AL., PETITIONERS

v.

MICHAEL B. MUKASEY, ATTORNEY GENERAL

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

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

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

JURISDICTION

The judgment of the court of appeals was initially entered on January 22, 2007. The court of appeals issued an amended opinion on May 14, 2007, and a petition for rehearing was denied on the same date (Pet. App. 2a). The petition for a writ of certiorari was filed on August 10, 2007. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

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

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

In 1976, Congress altered the method for computing copyright terms for works created on or after January 1, 1978 (as well as for unpublished works that were “fixed” before 1978 and previously enjoyed perpetual copyright protection), and established a single term of copyright protection for the life of the author plus 50 years. 17 U.S.C. 302-304 (1976 Act). “In these respects, the 1976 Act aligned United States copyright terms with the then-dominant international standard adopted under the Berne Convention for the Protection of Literary and Artistic Works” (Berne Convention). *Eldred v. Ashcroft*,

537 U.S. 186, 195 (2003) (citing H.R. Rep. No. 1476, 94th Cong., 2d Sess. 135 (1976)). In 1998, Congress enacted the Copyright Term Extension Act of 1998, Pub. L. No. 105-298, 112 Stat. 2827 (CTEA), which extended the copyright term by 20 years to the life of the author plus 70 years for all works not created by January 1, 1978 (17 U.S.C. 302(a), 303(a)), to “harmonize[] the baseline United States copyright term with the term adopted by the European Union in 1993.” *Eldred*, 537 U.S. at 196. By matching the United States’ copyright term with the European Union’s, “Congress sought to ensure that American authors would receive the same copyright protection in Europe as their European counterparts.” *Id.* at 205-206.

b. Under the 1909 Act, a copyright holder could secure a 28-year renewal term only “after filing a renewal registration with the Register of Copyrights” in the last year of the first 28-year term of protection. S. Rep. No. 194, 102d Cong., 1st Sess. 3 (1991). “In 1976, Congress concluded years of debate and study on all aspects of the Copyright Act by passing a comprehensive revision to the 1909 law.” *Ibid.* The copyright renewal revision was viewed as “[o]ne of the worst features of the present copyright law.” H.R. Rep. No. 1476, *supra*, at 134. “A substantial burden and expense, this unclear and highly technical requirement results in incalculable amounts of unproductive work. In a number of cases it is the cause of inadvertent and unjust loss of copyright.” *Ibid.* Thus, the 1976 Act “abolished the renewal requirement for future works created on or after January 1, 1978”—the effective date of the 1976 Act—and “established a single term of copyright protection for the life of the author plus 50 years.” S. Rep. No. 194, *supra*, at 3. Congress “retained the existing renewal registration requirement”

for copyrights still subsisting in their first term on the 1976 Act's effective date, however, because "Congress was concerned that eliminating the renewal requirement for these works altogether could potentially disrupt existing expectancies or contractual interests." S. Rep. No. 194, *supra*, at 3-4; H.R. Rep. No. 1476, *supra*, at 139.¹

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

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

tioning copyright protection,” and that compliance with such formalities is “antithetical to the major international treaty on copyright relations, the Berne Convention.” *Id.* at 5.

Based on those concerns, Congress enacted the Copyright Renewal Act of 1992 (CRA), Pub. L. No. 102-307, § 102(a), 106 Stat. 264, which amended the renewal provisions set forth in 17 U.S.C. 304 to “make[] clear that a timely registration by the proper statutory claimant vests the right to the renewal term on the date of registration in the Copyright Office and, if a registration is not made, the right in the renewal term vests automatically in the proper statutory claimant on the last day of the first term.” S. Rep. No. 194, *supra*, at 4. The automatic renewal provisions apply only to those pre-January 1, 1978, works still in their first 28-year copyright term when the CRA was enacted, *i.e.*, works that acquired a first term of copyright protection between January 1, 1964, and December 31, 1977. See *id.* at 7. Thus, the CRA puts protection of such works on equal footing with the protection of qualifying works for which renewal registration was made. *Ibid.* At the same time, the CRA’s legislative history recognized that a renewal registration system “provides a useful public record for users of copyright material so they may locate the copyright holder and arrange to license a work, or determine when copyright material falls into the public domain.” *Id.* at 6-7. Accordingly, the CRA offers incentives to authors to continue to voluntarily renew their copyright in a timely manner, while it “eliminates the harsh consequences of failing to renew.” *Id.* at 7.

c. As the Court stated in *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30, 41 (1939), the purpose of the deposit requirement (currently set forth in 17 U.S.C.

407) is not proof or preservation of copyright, but the acquisition of books for the Library of Congress. “Until 1976, failure to deposit with the Library of Congress resulted in a forfeiture of copyright.” *Ladd v. Law & Tech. Press*, 762 F.2d 809, 813 (9th Cir. 1985), cert. denied, 475 U.S. 1045 (1986). With the enactment of the 1976 Act, Congress changed the deposit enforcement provisions because:

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

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

d. Under the 1909 Act, a work also had to bear a valid copyright notice upon publication in order to secure copyright protection. 17 U.S.C. 10, 19 *et seq.* At the time of its enactment, the 1976 Act continued to require that notice be affixed to all published copies and phonorecords of a work. 17 U.S.C. 401, 402. Congress also made clear, however, that the requirement was no longer absolute, took steps to avoid the harsh consequences of the omission of notice, and prescribed remedial measures that could be taken in cases where notice was omitted. 17 U.S.C. 405.

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

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

The district court granted respondent's motion. Pet. App. 17a-51a. The district court rejected petitioners' claim that the CRA and the CTEA violate the First Amendment "by imposing an unconstitutional burden on speech with respect to works created after January 1, 1964 and before January 1, 1978 as a result of having altered the 'traditional contours' of copyright law from a conditional copyright regime to an unconditional copyright regime." *Id.* at 47a. The court focused on *Eldred*'s analysis and rejection of the argument that the CTEA violates the First Amendment (*id.* at 47a-49a), and dis-

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

missed petitioners’ assertion that “Congress, by eliminating the registration, renewal, deposit, and notice requirements as a condition of obtaining and maintaining a copyright, has altered the traditional contours of copyright protection.” *Id.* at 49a. The court reasoned that, unlike “the idea/expression dichotomy and the fair use exception,” *ibid.*, “the registration, renewal, deposit, and notice requirements do not define the scope of copyright protection but, rather, the procedural steps necessary to obtain and maintain a copyright.” *Id.* at 50a. The court observed that “Congress has repeatedly stated that these [latter] requirements are mere ‘formalities’” (*ibid.* (citations omitted)), which the court held “do not alter the scope of copyright protection, but merely determine the procedures necessary to obtain or maintain such protection.” *Ibid.*

Accordingly, “[b]ecause changes to requirements of this nature do not alter the substantive rights granted by copyright,” the court “f[ound] that the challenged amendments do not alter the ‘traditional contours of copyright protection.’” Pet. App. 50a. The court therefore found immaterial petitioners’ promise to “show at trial the ‘real world effect’ of the challenged changes to copyright law,” because “no such evidence can alter this fundamental defect in their case.” *Ibid.* (citation omitted).

b. The court of appeals affirmed. Pet. App. 1a-8a.³ The court concluded that petitioners provided no “legal argument explaining why [it] should ignore the clear holding in *Eldred*.” *Id.* at 5a. The court stated that petitioners “assert that the change from discretionary to

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

automatic renewal and subsequent extension of copyrights for works created between 1964 and 1977 altered the ‘traditional contours of copyright protection.’” *Ibid.* (quoting *Eldred*, 537 U.S. at 221). “However, *Eldred* also upheld the CTEA, in effect answering [petitioners’] challenge.” *Ibid.*

The court concluded that under *Eldred*, “extending existing copyrights to achieve parity with future copyrights does not require further First Amendment scrutiny,” because “traditional First Amendment safeguards such as fair use and the idea/expression dichotomy are sufficient to vindicate the speech interests affected by the CRA and the CTEA.” Pet. App. 6a (citing *Eldred*, 537 U.S. at 219-220). The court held that the CRA “effectively extended copyright protection for works that would otherwise have fallen into the public domain,” and that the “CTEA further extended those works’ protection.” *Ibid.* Because “*Eldred* tells us that such extensions would not violate the First Amendment,” *ibid.* (citing *Eldred*, 537 U.S. at 221), “[i]t therefore follows that the materially indistinguishable CRA and CTEA provisions are constitutional as well.” *Ibid.* Thus, the court concluded that notwithstanding petitioners’ “attempt to frame the issue in terms of the change from an opt-in to an opt-out system rather than in terms of extension, they make essentially the same argument, in different form, that the Supreme Court rejected in *Eldred*,” which “fails here as well.” *Id.* at 6a-7a.

ARGUMENT

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

1. The court of appeals correctly interpreted and applied this Court’s decision in *Eldred*. In *Eldred*, this Court upheld the CTEA’s 20-year extension of existing copyrights in the face of a First Amendment challenge. *Eldred*, 537 U.S. at 218-221. In so doing, this Court reasoned that “copyright’s limited monopolies are compatible with free speech principles”; “[i]ndeed, copyright’s purpose is to *promote* the creation and publication of free expression.” *Id.* at 219. This Court observed that “copyright law contains built-in First Amendment accommodations,” namely, the “idea/expression dichotomy” and the “‘fair use’” defense. *Id.* at 219-220. While the Court concluded that copyrights may not be “categorically immune from challenges under the First Amendment,” *id.* at 221 (citation omitted), it held that, “when, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.” *Id.* at 221.

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

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

Notwithstanding petitioners’ “attempt to frame the issue in terms of the change from an opt-in to an opt-out system rather than in terms of extension, they make essentially the same argument, in different form,” that the Court rejected in *Eldred*. Pet. App. 6a-7a. “Here, as in *Eldred*, extending existing copyrights while preserving speech-protective measures does not alter the ‘traditional contours of copyright protection.’” *Id.* at 6a. That correct application of *Eldred* does not warrant this Court’s review.⁵

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

Section 514 of the URAA—the statute at issue in *Golan*—implements the Berne Convention by granting copyright protection for a limited time to a limited number of foreign works whose copyright terms had not yet

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

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

In *Golan*, the Tenth Circuit panel read *Eldred*’s phrase “the traditional contours of copyright protection,” 537 U.S. at 221, to refer to more than the “traditional First Amendment safeguards” discussed in the passages in the *Eldred* opinion that immediately precede that phrase, *id.* at 219-220. See Supp. Pet. App. 15a-35a. Instead, in the view of the Tenth Circuit panel, that phrase established a new standard—never before articulated in the Court’s jurisprudence—that mandates First Amendment scrutiny whenever a copyright statute “deviates

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

from [a] time-honored tradition,” *id.* at 25a, even if that “time-honored tradition” has been breached by Congress on a number of occasions over the centuries. See *id.* at 21a-25a. Such a standard is inconsistent with the context and reasoning of *Eldred*, as well as with First Amendment doctrine.

The error by the Tenth Circuit panel in *Golan*, however, does not warrant issuance of a writ of certiorari to the Ninth Circuit in this case. *Golan* involves a different statutory provision with different effect than the provisions at issue here, and the Tenth Circuit, while citing the decision below several times in its opinion in *Golan*, never suggested that its ruling was in conflict with the ruling below. While the results and reasoning of the two decisions are in tension, there is no actual conflict. The decision below is correct and represents nothing more than a straightforward application of *Eldred* to statutes (the CRA and CTEA) that accomplished essentially the same term extension as that upheld in *Eldred*. Moreover, as noted, respondent has filed a petition for rehearing en banc in *Golan*, and the court of appeals recently ordered a response to that petition. If rehearing is granted, the tension between the two decisions may dissipate without the need for any action by this Court.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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