

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLORADO

Civil Action No. 01-B-1854

LAWRENCE GOLAN, et. al.

Plaintiffs,

v.

JOHN ASHCROFT, in his official
capacity as Attorney General of the
United States

Defendant.

MEMORANDUM IN SUPPORT OF DEFENDANT'S
MOTION FOR SUMMARY JUDGMENT

PETER D. KEISLER
Assistant Attorney General

JOHN W. SUTHERS
United States Attorney

VINCENT M. GARVEY
Deputy Branch Director

JOSHUA Z. RABINOVITZ
Trial Attorney
United States Department of Justice
Civil Division, Room 7340
20 Massachusetts Ave, NW
Washington D.C. 20530
(202) 353-7633
(202) 616-8470, facsimile

Counsel for Defendant

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Preliminary Statement

On March 15, 2004, the Court granted in part and denied in part the government's motion to dismiss this lawsuit. See *Golan v. Ashcroft*, 310 F. Supp. 2d 1215 (D. Colo. 2004). The Court dismissed Plaintiffs' challenge to the constitutionality of the Copyright Term Extension Act (CTEA).¹ However, while explaining that Plaintiffs "may ultimately be unsuccessful," the Court found that "Plaintiffs ha[d] adequately stated a legally cognizable claim" as to their challenge to

¹ Pub. L. 105-298, Title I, 112 Stat. 2827 (1998).

the constitutionality of §514 of the Uruguay Round Agreements Act (URAA).² *Id.* at 1221.

Since the Court issued its order, the United States District Court for the District of Columbia issued a decision holding that the URAA is constitutional and dismissing a challenge similar to this one. See *Luck's Music Library, Inc. v. Ashcroft*, Civ. No. 01-2220 (D.D.C. June 10, 2004) [Slip opinion attached at Tab 1]. In the *Luck's Music Library* decision, the Court addressed and rejected almost all of the arguments raised by Plaintiffs here.

The government now moves for summary judgment. “Summary judgment is appropriate if there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law.” *Bell v. Fur Breeders Agricultural Cooperative*, 348 F.3d 1224, 1230 (10th Cir. 2003). It is no longer enough for Plaintiffs to merely state a claim. “The very purpose of a summary judgment action is to determine whether trial is necessary.” *Wollan v. Department of the Interior*, 997 F. Supp. 1397, 1400 (D. Colo. 1998). As the government shows in each section of this memorandum, there are no genuine issues of material fact preventing summary judgment. Each contention raised by the government is a matter of pure law, given to resolution without factual findings or expert testimony.

To succeed on their facial challenge to the URAA,³ Plaintiffs face a high bar: They “must

² Pub. L. 103-465, 108 Stat. 4976 (1994) (amending 17 U.S.C. §§ 104A, 109(a)). Because only §514 of the Act is at issue in this lawsuit, this memorandum uses “URAA” to refer to §514 of that Act.

³ Plaintiffs’ lawsuit is a facial challenge. See Pl. Am. Compl. at p. 41 (seeking a declaration that the URAA is unconstitutional and a nationwide injunction preventing the government from enforcing it). See also *United States v. Castillo*, 140 F.3d 874, 879 (10th Cir.

(continued...)

establish that no set of circumstances exists under which the [regulation] would be valid.” *Reno v. Flores*, 507 U.S. 292, 301 (1993) (bracket in original, internal quotation marks omitted).

Plaintiffs have not, and cannot, surmount this hurdle. The URAA is constitutional. It is valid legislation pursuant both to the Copyright Clause and the treaty power. It does not violate the First Amendment or the Due Process Clause.

Background

The URAA restores copyright protection to original works of foreign origin whose authors lost their U.S. copyrights for failure to comply with U.S. copyright law formalities. See 17 U.S.C. §104A(h)(6)(C)(i).⁴ Copyright protection restored by the URAA subsists for the remainder of the period that would have been granted had the work been protected from its inception. See 17 U.S.C. §104A(a)(1)(B). Significantly, the copyright law formalities that caused works restored by the URAA to lose protection have since been repealed, and thus are no longer required of any author. For instance, §304 of the 1976 Copyright Act previously required authors to renew their copyrights by application to the Copyright Office within one year prior to

³(...continued)

1998) (“The defendant here ... challenges the rule in the abstract, thus presenting us with a facial challenge rather than an as-applied challenge.”).

⁴ The Act also restores protection to foreign works that were not previously eligible for protection because the United States did not have reciprocal arrangements with the source country, and to foreign sound recordings made before February 15, 1972, that were not eligible for protection. See 17 U.S.C. §104A(h)(6)(C)(ii), (iii). Because the “formalities” provision in §104A(h)(6)(C)(i) is the gravamen of Plaintiffs’ amended complaint, this memorandum refers mainly to that provision. This memorandum’s discussion of the “formalities” provision, however, applies equally to these other provisions.

the copyright's expiration. See Pub. L. 94-553, 90 Stat. 2573. In addition, §401 of the 1976 Act required that a copyright notice appear on all publicly distributed copies of a work. *Id.* Often foreign authors, many of whom were unaware of the nuances of U.S. copyright law, lost their copyrights for failure to adhere to these provisions. Congress has since repealed both of these requirements, but those statutes did not affect copyrights that had already been lost. See Copyright Amendments Act of 1992, Pub. L. 102-307, 106 Stat. 264, §102(a)(2)(A)(ii); Berne Convention Implementation Act of 1988, Pub. L. 100-568, 102 Stat. 2853, §7. The URAA, then, corrects for the greater burdens that these technicalities wrought on foreign authors. It evinces Congress's belief that it is unfair to continue to penalize foreign authors for failing to comply with the outdated technical requirements of United States copyright law:

As difficult as it has been for American authors to comply with the strict formalities that were the hallmark of United States copyright law for so many years, it has been even more difficult for foreign authors. Many lost their U.S. copyrights to the public domain without having sought to exploit their works here, or without being aware of the requirements of our law. Now that we have essentially eliminated formalities from our copyright system, it is appropriate to restore these copyrights and redress the draconian effects of our prior law.

Joint House and Senate Committee Hearings on the URAA, 103rd Cong. 191 (1994) (statement of Shira Perlmutter).

Congress also enacted the URAA to implement fully the Berne Convention for the Protection of Literary and Artistic Works [attached at Tab 2]. Article 18(1) of the Convention requires member countries to protect "all works which ... have not yet fallen into the public domain in the country of origin through the expiry of term." Prior to the URAA, the United

States had not complied with Article 18 because copyright formalities prevented works that had “not yet fallen into the public domain in the country of origin through the expiry of term” from receiving protection under U.S. copyright law. Because the Berne Convention allows its members to penalize the authors (by reducing their protection) from countries that have not fully implemented the Convention, see *Berne Convention*, Article 6, the URAA was critical to preventing the rights of American authors from being undermined abroad.

Argument

Plaintiffs contend that the URAA is faulty on two accounts. First, Plaintiffs suggest that Congress did not have power under the Constitution to enact such legislation. Second, Plaintiffs posit that the URAA violates the First Amendment and the Due Process Clause. Neither of these arguments can succeed. The URAA is valid under two separate, independent powers enumerated in the Constitution—the Copyright Clause, see U.S. Const., Art. I, §8, cl. 8, and the Treaty power, see *id.* Art. II, § 2, cl. 2—although, of course, this Court need only find the URAA proper under one of the powers in order for the Act to be valid. Further, the URAA runs afoul of neither the First Amendment nor the Due Process Clause.

I. The URAA is a Permissible Exercise of Congress’s Power Under the Copyright Clause.

The Copyright Clause of the Constitution grants to Congress the power: “To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. Const., Art. I, §8, cl. 8.

Inherent in this grant of power are three distinct limitations on Congress’s copyright power:⁵ First, Congress must have had a rational basis for believing that the legislation would “promote the Progress of Science”; second, the copyright term must extend only for a “limited Time[]”; and, finally, copyright legislation may protect only works that are original to the “Author[.]” Legislation that respects these three limits is proper under the Copyright Clause.

A. A Rational Basis Exists for Believing that the URAA “promote[s] the Progress of Science.”

The Supreme Court has been clear that courts should review copyright legislation under the deferential “rational basis” standard only to ensure that the legislation “promote[s] the Progress of Science.” See *Eldred v. Ashcroft*, 537 U.S. 186, 204 (2003) (“[W]e turn now to whether [the Act] is a rational exercise of the legislative authority conferred by the Copyright Clause.”); *id.* at 213 (finding “a rational basis for the conclusion that the CTEA ‘promote[s] the Progress of Science.’”). In general, statutes reviewed under the rational basis standard are accorded “a strong presumption of validity” and must be sustained “if there is any reasonably conceivable state of facts that could provide a rational basis.” *Heller v. Doe*, 509 U.S. 312, 319–20 (1993). See also *Grigsby v. Barnhart*, 294 F.3d 1215, 1220 (10th Cir. 2002). The federal government “has no obligation to produce evidence to sustain the rationality” of the Act;

⁵ These limits apply only to Congress’s power under the Copyright Clause itself, not to the federal government’s power under any other enumerated power, such as the treaty power, which independently enables the URAA. See, e.g., *United States v. Moghadam*, 175 F.3d 1269, 1277 (11th Cir. 1999) (“The Court’s reasoning illustrates that, as a general matter, the fact that legislation reaches beyond the limits of one grant of legislative power has no bearing on whether it can be sustained under another.”).

“[a] legislative choice is not subject to courtroom factfinding and may be based on rational speculation unsupported by evidence or empirical data.” *Heller*, 509 U.S. at 320. Instead, “[t]he burden is on the one attacking the legislative arrangement to negative every conceivable basis which might support it ... whether or not the basis has a foundation in the record.” *Id.* at 320–21 (internal citation omitted). See also *Cordoba v. Massanari*, 256 F.3d 1044, 1049 (10th Cir. 2001); *United States v. Phelps*, 17 F.3d 1334, 1344–45 (10th Cir. 1994).

As applied specifically to copyright legislation, rational basis review is exceedingly deferential: “As the text of the Constitution makes plain, it is Congress that has been assigned the task of defining the scope of the limited monopoly that should be granted to authors.” *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984). “[I]t is not [the courts’] role to alter the delicate balance Congress has labored to achieve.” *Stewart v. Abend*, 495 U.S. 207, 230 (1990), quoted and reaffirmed in *Eldred*, 537 U.S. at 205 n.10.

The URAA “bears a rational relation to the progression of science.” *Luck’s Music Library*, Slip op. at 17. The primary reason that Congress enacted the URAA was to comply with Article 18 of the Berne Convention for the Protection of Literary and Artistic Works (1989). See *Senate URAA Report*, S. Rep. 103-412 at 225 (1994). Article 18 requires member countries to protect “all works which ... have not yet fallen into the public domain in the country of origin through the expiry of the term of protection.” Had the United States failed to implement fully the Berne Convention, other Berne signatories would have been entitled to “restrict the [copyright] protection” that they bestow on U.S. authors. See *Berne Convention*, Article 6.

Thus, by fulfilling its obligations under the Berne Convention, Congress secured copyright protection for American authors on a worldwide scale:

[The URAA will] promote progress by assisting American authors and adding indirectly to future incentives to create. In the short run, American authors would be helped by the willingness of [present and future members of the Berne Convention] to reciprocate by granting retroactive protection to American works.... In the long run, American authors would be helped by improved international copyright relations generally, which is likely to strengthen their enforceable rights abroad for both existing and future works.

See *Joint House and Senate Committee Hearing on the URAA*, 103rd Cong. 203-04 (1994)

(statement of Shira Perlmutter).⁶ Moreover, by fully implementing the Berne Convention, the United States gained the ability to credibly urge other countries that do not currently protect U.S. authors (or do not protect them adequately) to improve their copyright guarantees. See David Nimmer, *Nation, Duration, Violation, Harmonization: An International Copyright Proposal for the United States*, 55-2 *Law & Contemp. Probs.* 211, 216 (1992). “Given industry losses of \$43 to \$61 billion through piracy because of ‘inadequate [foreign] legal protection for United States intellectual property,’ the Senate noted that implementing Section 514 ‘is a significant opportunity to reduce the impact of copyright piracy on our world trade position.’” *Luck’s Music Library*, Slip op. at 17 (quoting S. Rep. No. 100-352 (1988), bracket in original). Thus, the URAA rationally “promote[s] the Progress of Science” by putting the United States in a position to protect its authors’ works abroad.

⁶ Shira Perlmutter, subsequent to her testimony, served as Associate Register for Policy and International Affairs, United States Copyright Office. See *Eldred*, 537 U.S. at 206 n.12.

The Supreme Court's *Eldred* decision held explicitly that enhancing copyright protection for foreign authors in order to better protect American authors is a rational means of "promot[ing] the Progress of Science." In *Eldred*, the Supreme Court reviewed Congress's principal reason for enacting the CTEA, which was to respond to "a 1993 European Union (EU) directive instructing EU members to establish a copyright term of life plus 70 years." *Eldred*, 537 U.S. at 205. The United States' failure to match the European Union's term would have resulted in lesser protection for U.S. authors, and thus the CTEA secured protection for American authors by adhering to Europe's copyright term. The Supreme Court found the CTEA a rational method of promoting progress; it held that Congress may under the Copyright Clause "ensure that American authors would receive the same copyright protection in Europe as their European counterparts." *Id.* at 205–06.

If the CTEA promotes the "Progress of Science" by securing better protection for American authors, so too then does the URAA. Each statute was motivated by an effort to better protect American authors by amending U.S. law to match the international community's standard. Accordingly, a rational basis supports Congress's determination that the URAA "promote[s] the Progress of Science."

Plaintiffs plainly disagree with Congress that the URAA "promote[s] the Progress of Science." Indeed, they seek the opportunity to establish through expert testimony that the URAA does *not* "promote the Progress of Science." Their position misapprehends the scope of rationality review. The rational basis test does not necessitate that Congress's judgment be

proved correct through testimony and evidence. Precisely the opposite, rationality review definitively does not entail “courtroom factfinding.” *Heller*, 509 U.S. at 320. “[W]e are not at liberty to second-guess congressional determinations and policy judgments of this order, however debatable or arguably unwise they may be.” *Eldred*, 537 U.S. at 208. As a result, expert testimony on this question, which is a question of law, would be inappropriate. See *Wollan v. Department of the Interior*, 997 F. Supp. 1397, 1403 (D. Colo. 1998) (“Where the ultimate issue is question of law, the opinion of a legal expert, even a lawyer, interferes with the judge’s role as ‘sole arbiter of the law’ and should not be allowed.”). This court’s role is only to ensure that Congress *could have* rationally believed that the URAA would promote scientific progress. Given that the Supreme Court approved this type of legislation in *Eldred*, and the deferential review under the rational-basis test, the URAA plainly satisfies that standard.

B. The URAA Does Not Alter the Length of the Copyright Term Created by the Copyright Term Extension Act, which is a “limited Time[.]”

The second limit under the Copyright Clause requires that legislation protect creators’ rights only for a “limited Time[.]” The URAA plainly respects this limitation. The Act does not alter the copyright term established by the CTEA. See 17 U.S.C. §302. Rather, it preserves the CTEA’s copyright term of the author’s life plus 70 years, a term that this Court’s March 15, 2004 order already held to be a limited time. 310 F. Supp. 2d at 1217–18 (“The Supreme Court in *Eldred v. Ashcroft* held that the extension of the copyright term in the CTEA was constitutional, in that it was not effectively or virtually perpetual.”). See also *Eldred*, 537 U.S. at 209 (“[A] regime of perpetual copyrights clearly is not the situation before us.”). As a result, it is clear that

the URAA falls within the bounds of the Copyright Clause's second limitation.

C. The URAA Grants Copyright Protection Only To Original Works.

The final limit on Congress's power under the Copyright Clause is that copyright law can only protect works that are original to the "Author[]." See *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 345 (1991) ("[T]o qualify for copyright protection, a work must be original to the author."). Original, as the term is used in copyright jurisprudence, "means *only* that the work was independently created by the author (as opposed to copied from other works), and that it possess some minimal degree of creativity." *Id.* (emphasis added).

The URAA protects only original works—works that *originated* with the person claiming copyright protection. "[T]he works to which Section 514 restores copyrights already comply with the originality requirement because Section 514 only covers works that would be eligible for copyrights but for the formalities imposed by the United States, lack of subject-matter protection or lack of national eligibility." *Luck's Music Library*, Slip op. at 19. See also 17 U.S.C. §104A(h)(6) (limiting the URAA's application to "original work[s] of authorship"). Thus, the URAA respects the originality requirement because the Act does not change the requirements for copyright protection—under the URAA, as under copyright law generally, only works that originated with the person claiming protection (or his designee) and that possess a minimal degree of creativity may be protected. The URAA only removes various procedural barriers to protection, none of which implicate originality in the slightest. Of course, an author who claimed to have created a new work simply by taking material from the public domain

would not be eligible for copyright protection, for any such work would not be original—the “author” took it from someone else’s work. See, e.g., *Gates Rubber Co. v. Bando Chemical Industries*, 9 F.3d 823, 837–38 (10th Cir. 1993). That is not the situation presented by restored works under the URAA, all of which must have originated with the person claiming the right and possess a minimum degree of creativity.⁷ As a result, the URAA does not violate the Copyright Clause’s originality requirement.

D. The Copyright Clause Does Not Prevent Copyright Restoration.

In addition to the three well-established limitations on Congress’s ability to legislate pursuant to the Copyright Clause, Plaintiffs suggest a fourth limitation, one that has no basis in the text of the Copyright Clause and has never been adopted by any decision of any court. Specifically, Plaintiffs contend that the Copyright Clause prevents a work that has fallen into the public domain from being restored to protection. This position has been rejected outright by both the Supreme Court and by the legislative and executive branches.

1. Supreme Court Precedent Confirms Congress’s Power to Restore Copyright Protection to Works in the Public Domain.

The Supreme Court long ago rejected the position that Congress cannot restore protection to public-domain works. In *McClurg v. Kingsland*, 42 U.S. 202 (1843), the Supreme Court considered James Harley’s invention of a mode of casting chilled rollers, an invention which was

⁷ Because the question of the URAA’s compliance with the originality requirement is a question of statutory construction and constitutional interpretation, it is properly resolved at this time, without factual inquiry or expert testimony. See *Oklahoma ex rel. Department of Human Services v. Weinberger*, 741 F.2d 290, 291 (10th Cir. 1983); *Union Pacific Land Resources Corp. v. Moench Investment Co.*, 696 F.2d 88, 93 n.5 (10th Cir. 1982).

“unprotected under the law in force when the patent issued because [Harley] had allowed his employer briefly to practice the invention before he obtained the patent.” *Eldred*, 537 U.S. at 203 (discussing *McClurg*). Only two years later, when Congress amended the patent law so that Harley’s actions were acceptable, did the patent become valid. *Id.* During the two years before the amendment to the patent law, however, Harley’s patent was invalid, and the public was free to exploit the invention without license. The Supreme Court saw no constitutional problem when the invention was restored to protection. *Id.*

Because the invention at issue in *McClurg* was unprotected during the two years prior to the amendment to the patent law, the invention was in the public domain. “Public domain” is merely a shorthand term referring to all unprotected works. See *Black’s Law Dictionary* at 1229 (6th ed.). Accordingly, when Congress amended the patent laws, thereby validating Harley’s patent, the invention went from being “unprotected,” see *Eldred*, 537 U.S. at 203—and in the public domain—to being protected—and outside the public domain. No other reading of *Eldred*’s summary of *McClurg* is possible.

The action taken by the amendment to the patent law at issue in *McClurg*—restoring protection to an invention whose protection had lapsed for failure to adhere to a patent law formality—is legally indistinguishable from the action taken by the URAA—restoring protection to works whose protection lapsed for failure to respect copyright law formalities. See *Eldred*, 537 U.S. at 201 (“Because the Clause empowering Congress to confer copyrights also authorizes patents, congressional practice with respect to patents informs our inquiry.”). *McClurg*, and

Eldred's discussion of *McClurg*, then, definitively establish the permissibility of restoring copyright protection to works in the public domain.

In this Court's March 15, 2004 order, the Court noted correctly that, in *McClurg*, a patent "existed" even during the two years prior to the statutory amendment. 310 F. Supp. 2d at 1219. But while a patent did "exist" as to the invention at issue, that patent was merely an invalid piece of paper, legally indistinguishable from no patent at all. As the Supreme Court made clear in *Eldred*, during the two years prior to the amendment to the patent law, James Harley's invention was "unprotected." *Eldred* 537 U.S. at 203. The existence of the invalid patent during this time does not change that fact. The patent law amendment took an invention that was unprotected and restored it to protection.⁸ The Supreme Court in 1843 did not object to this practice, nor did the Supreme Court in 2003.

2. Historical Tradition, From the First Congress Through the Present, Further Supports the Government's Interpretation of the Copyright Clause.

Not only has the Supreme Court rejected Plaintiffs' proposed reading of the Copyright Clause, but the legislative and executive branches have evinced consistently, from the First Congress through the present, their belief that no constitutional principle prevents them from restoring copyright protection to works whose protection lapsed for failure to comply with

⁸ The government's position does not rest on the use (or non-use) of the invention in *McClurg* after the application for the patent. Rather, the government's position rests on the Supreme Court's indication that the invention was unprotected for two years, and subsequently restored to protection. That alone defeats Plaintiffs' assertion that works cannot be removed from the public domain.

copyright formalities. See *Luck's Music Library*, Slip op. at 9–14.

a. The 1790 Copyright Act

The Copyright Act of 1790, enacted by the First Congress, offered copyright protection to works “already printed within these United States.” See 1 Stat. 124 (May 31, 1790). This protection applied regardless of whether a work had been protected prior to 1790 or whether it had been unprotected—that is, in the public domain. At least as to three states, Delaware, Maryland, and Pennsylvania, no other protection existed at the time, meaning that any works published in those states would have been previously unprotected, in the public domain, and freely exploitable.⁹ Thus, the 1790 Act took previously unprotected works and granted them protection, demonstrating that the First Congress did not believe that the Copyright Clause prevented it from restoring copyright protection to works in the public domain. See *Luck's Music Library*, Slip op. at 10–11. The interpretation of the Constitution by the First Congress is “almost conclusive” as to the Constitution’s meaning:

The construction placed upon the Constitution ... by the men who were contemporary with its formation, many of whom were members of the convention which framed it, is of itself entitled to very great weight, and when it is remembered that the rights thus established have not been disputed during a period of nearly a century, it is almost conclusive.

⁹ Delaware never enacted copyright legislation. See Bruce W. Bugbee, *Genesis of American Patent and Copyright Law* 123–24 (1967). Maryland and Pennsylvania did pass copyright legislation, but their statutes became effective only if “similar laws” were enacted “in all and every of the United States.” 1783 Md. Laws Ch. 34 (Apr. 21, 1783) reprinted (along with Pennsylvania’s statute) in Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* App. 7[C]. As a result, Delaware’s failure to protect copyrights rendered Maryland’s and Pennsylvania’s statutes nugatory.

Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 57 (1884), quoted and reaffirmed in *Eldred*, 537 U.S. at 213.

While Plaintiffs agree that no statutory copyright protection existed prior to 1790 in the three states mentioned above, they suggest that the common law offered copyright protection or, at the very least, that the First Congress mistakenly thought that the common law protected copyrights. Therefore, Plaintiffs conclude, there were no unprotected works for the 1790 Act to apply to (or, Congress believed that there were no unprotected works for the 1790 Act to apply to). At the outset, it is critical to note that this is not a factual disagreement. The status of the common law in 1790 is a legal question to be resolved by the Court, for construction of the law is a legal task. See *Heublein, Inc. v. United States*, 996 F.2d 1455, 1461 (2d Cir. 1993); *Oklahoma ex rel. Department of Human Services v. Weinberger*, 741 F.2d 290, 291 (10th Cir. 1983); *Union Pacific Land Resources Corp. v. Moench Investment Co.*, 696 F.2d 88, 93 n.5 (10th Cir. 1982). That the relevant legal principle is old, the common law from 1790, changes nothing. See *Wollan v. Department of the Interior*, 997 F. Supp. 1397, 1403–04 (D. Colo. 1998) (holding that an expert on “statutes enacted by Congress in the late 1800s and early 1900s” would inappropriately usurp the judicial function). Reading caselaw and determining the status of the common law is a legal task, and is not subject to fact finding or to expert testimony.

So too with the beliefs about the common law held by the First Congress. Legislative history—that is, what the First Congress believed about the 1790 Copyright Act—is a subject for legal memoranda and for judges, not for expert witnesses and for juries as finders of fact. “[I]n

construing statutes courts routinely look beyond the text to external sources such as legislative history, but doing so is not considered reliance on ‘evidence’ but on interpretive aids.” *Thomson Consumer Electronics, Inc. v. Innovatron, S.A.*, 3 F. Supp. 2d 49, 52 (D.D.C. 1998). As a result, the Tenth Circuit has held that questions of legislative history “present legal questions properly resolved on summary judgment.” *Oklahoma ex rel. Department of Human Services*, 741 F.2d at 291. See also *Union Pacific Land*, 696 F.2d at 93 n.5; *accord Heublein*, 996 F.2d at 1461. Thus, Plaintiffs’ objections to the government’s reliance on the 1790 Act are properly addressed by the Court on this motion for summary judgment.

Plaintiffs’ attempts to undermine the importance of the 1790 Act should be rejected. First, the common law did not provide copyright protection prior to the 1790 Act. The Supreme Court held conclusively in *Wheaton v. Peters*, 33 U.S. 591, 659–61 (1834), that the common law, as it existed prior to the 1790 Act, did not protect published works. “In *Wheaton*, the Court interpreted the words ‘by securing’ in the IP clause to mean that the Constitution gave Congress the power to create a new right through the 1790 Act.... The Court explained that ‘securing’ had to refer to the creation of a new right, since the Constitution includes both copyright and patent law in the same clause, and patent law had no existing common law equivalent in England.” *Luck’s Music Library*, Slip op. at 11. As a result, *Wheaton*’s holding makes clear that no common law protection existed prior to 1790. Plaintiffs’ primary argument as to why the 1790 Act did not remove material from the public domain therefore fails.

And Plaintiffs' fallback argument fares no better. The First Congress did not mistakenly believe that common law copyright protection existed when it passed the 1790 Act; the Supreme Court has explicitly rejected that position too. In *Wheaton*, counsel for the complainants made the precise argument that Plaintiffs advance here, positing that the 1790 Act "clearly indicates an intention" to merely continue the existing protections of the common law in statutory form, "not to originate a right." *Wheaton*, 33 U.S. at 661. The Supreme Court roundly rejected that this might have been the First Congress's understanding:

Now if this exclusive right existed at common law, and congress were about to adopt legislative provisions for its protection, would they have used this language? Could they have deemed it necessary to vest a right already vested. Such a presumption is refuted by the words above quoted, and their force is not lessened by any other part of the act.

Id. *Wheaton* therefore disposes conclusively of Plaintiffs' contention that the First Congress enacted the 1790 Act in error.

As a result, the effect of the 1790 Copyright Act is clear. Neither the federal government nor at least three state governments offered statutory copyright protection prior 1790. And binding Supreme Court precedent, *Wheaton v. Peters*, explicitly rejects both the claim that common law copyright protection existed prior to 1790 and the claim that Congress might have thought, at the time it enacted the 1790 Act, that common law copyright protection existed. It cannot be disputed, then, that the First Congress fully understood that the 1790 Act restored to protection works that had previously been in the public domain—freely exploitable by the public. That the First Congress, whose interpretation of the Constitution is "almost conclusive"

as to the Constitution’s meaning, did not view the Copyright Clause as limiting the federal government’s ability to protect works that had previously been in the public domain, establishes the propriety of the URAA.

b. The 1832 Patent Act

In 1832, Congress again demonstrated its belief that the Copyright Clause does not prevent the government from restoring protection to works in the public domain, this time with legislation that is factually indistinguishable from the URAA.¹⁰ See 4 Stat. 559 (July 3, 1832). The 1832 Act restored protection to any works whose patent was made “invalid or inoperative” because the patent holder failed to comply with legal technicalities “by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.”¹¹ *Id.*, §3.

Significantly, the 1832 Act did not purport only to allow patent owners to cure defects in otherwise valid patents. The Act expressly indicated that it restored protection to “invalid or inoperative” patents. An invalid patent—like the patent at issue in *McClurg*, see *supra* at 12–13—is legally equivalent to no patent at all. By definition, a work protected only by an invalid patent is freely exploitable—in the public domain. Thus, the 1832 Act demonstrates again that early congresses saw no constitutional barrier to copyright or patent restoration.

¹⁰ Because the construction of the 1832 Act is an issue of pure law, it does not require factual inquiry, and is properly presented in this motion for summary judgment. See *Oklahoma ex rel. Department of Human Services v. Weinberger*, 741 F.2d 290, 291 (10th Cir. 1983); *Union Pacific Land Resources Corp. v. Moench Investment Co.*, 696 F.2d 88, 93 n.5 (10th Cir. 1982).

¹¹ Also like the URAA, the 1832 Act provided for a term extending only for the remainder of the original term. *Id.*

c. Other 19th Century Restorations

In addition to the 1832 Patent Act, Congress in the 19th century passed numerous private statutes to restore protection to works that had been in the public domain. These restorations were uniformly approved by the courts, which held that the public domain is not the inviolable repository of intellectual property that Plaintiffs contend.¹² The first example of these restorations is the private statute affecting the patent of Oliver Evans. See Ch. XIII, 6 Stat. 70 (Jan. 21, 1808). Oliver Evans' patent for improvements in milling flour expired, under the 1790 Patent Act, on January 7, 1805. See Federico, *Patent Trials of Oliver Evans*, 27 J. Pat. Off. Soc. 586, 590 (1945). Still, on January 21, 1808, three years after his patent expired and fell into the public domain, Congress extended his patent term by another 14 years. See 6 Stat. at 70. Evans then sued a purported infringer of his new patent, who promptly challenged the constitutionality of the restored patent. The Circuit Court, by Justice Bushrod Washington, upheld the validity of the statute:

It is not true that the grant of an exclusive privilege to an invention for a limited time, implies a binding and irrevocable contract with the people, that at the expiration of the period the invention shall become their property.

Evans v. Eaton, 8 F. Cas. 846, 848–49 (C.C.D. Pa. 1816) *reversed on other grounds*, 16 U.S. 454 (1818).

¹² Because this section requires only the interpretation of federal statutes and judicial decisions, it presents pure questions of law, properly resolved on this motion for summary judgment without factual findings or expert testimony. See *supra* at 16.

Likewise, Thomas Blanchard's patent in a machine for "turning or cutting irregular forms" expired initially on January 20, 1834. Six months after the expiration, Congress passed a private statute granting to Blanchard another 14 years of protection. See Ch. CCXIII, 6 Stat. 589 (June 30, 1834). Congress clearly knew that it was removing a work from the public domain. The Act contained a proviso protecting persons that had begun to use the invention while it was unprotected: "[A]ny person who has ... constructed any manufacture or machine for the purpose of putting said invention into use ... *after the expiration of the patent heretofore granted* ... shall have and enjoy the right of using said invention." *Id.* at §2 (emphasis added). This legislation, like the Evans restoration, met a challenge to its constitutionality. Justice Story, writing for the Circuit Court, upheld the constitutionality of the statute:

[I]t is suggested, that the grant of the patent ... is not constitutional; for it operates retrospectively to give a patent for an invention, which, though made by the patentee, was in public use and enjoyed by the community at the time of the passage of the act. But this objection is fairly put at rest by the decision of the supreme court in the case of the patent of Oliver Evans. [citation omitted] For myself, I never have entertained any doubt of the constitutional authority of congress to make such a grant.... There is no restriction, which limits the power of congress to enact, where the invention has not been known or used by the public. All that is required is, that the patentee should be the inventor.

Blanchard v. Sprague, 3 F. Cas. 648, 650 (C.C.D. Mass. 1839), cited approvingly by *Eldred*, 537 U.S. at 202. At least six other restorations were passed in the early 19th century after the original patents had expired. See Tyler T. Ochoa, *Patent and Copyright Term Extension and The Constitution: A Historical Perspective*, 49 J. Copyright Soc. of the U.S. 19, 65–66 (2001). See also Ch. CXXXI, 6 Stat. 895 (Mar. 3, 1843) (suspending only as to William Gale the rule in the

Patent Act of 1836 that “prohibits the extension of a patent after the expiration of the term for which it was originally issued”).

These private restorations were not limited to the first half of the 19th century. John Goulding’s patent in machinery for the manufacture of wool expired on December 15, 1840. See *Jordan v. Dobson*, 13 F. Cas. 1092, 1093 (C.C.E.D. Pa. 1870). More than 21 years *after its* expiration, Congress enacted a measure to give Goulding another seven years’ protection. See Ch. LXXXVIII, 12 Stat. 904 (May 30, 1862). Again the private statute was challenged. Again the statute was upheld:

It has been further contended ... that the act of congress of May 30, 1862 ... was unauthorized and beyond the power of congress, because the patent had expired in 1840, and the invention had become the property of the public, and because, therefore, the act was in effect taking property which belonged to the public and giving it to an individual. It assumes that every person had a right of property in Goulding’s invention immediately after the expiration of his first patent, even before any attempt to appropriate it.... I see no reason why, under this commission, congress may not secure to an inventor an exclusive right to his invention for a limited period, beginning at any time after the invention is made, and after it became publicly known. Congress may be trusted, and they are trusted, to take care that in protecting the inventor, the public shall not be injured.... *I am not aware that it has ever been seriously thought congress has not power, after a patent has expired, to provide for its extension.*

Jordan, 13 F. Cas. at 1095 (emphasis added). Other examples abound. See, e.g., *An Act for the relief of the heirs of William A. Graham*, Ch. 187, 20 Stat. 542 (June 11, 1878)¹³; *Ochoa*, 49 J.

¹³ The William Graham Act was upheld by the Circuit Court in *Graham v. Johnston*, 21 F. 40 (C.C. Md. 1884), where the Court held that “[t]he right which the public has acquired to use the thing invented, by reason of the applicant for a patent failing to do something prescribed by congress, and the necessity for which congress might, by previous legislation, have dispensed with, has never been held to be a vested right. The cases of *Evans v. Eaton*, *supra*; *Evans v.* (continued...)

Copyright Soc. at 72. These 19th century private restorations, and the opinions of the courts and Justices upholding them, again belie the existence of any constitutional barrier to restoring protection to works in the public domain.

d. 20th Century Restorations

The position of the political branches (as ratified by the judicial branch) in the 18th and 19th centuries was reinforced by subsequent congresses and presidents during the First and Second World Wars. Relying on a rationale similar to the URAA's—the hardship to foreign authors—Congress authorized the President in 1919 to restore copyright protection to foreign works published during World War I, if protection had lapsed during that time for failure to comply with U.S. copyright formalities. See Act of Dec. 8, 1919, Pub. L. 102, 41 Stat. 368–69. Congress authorized similar powers during World War II, this time allowing restoration for both foreign and American authors who had been unable to comply with copyright formalities due to “disruption or suspension of facilities essential for such compliance.” Act of Sept. 25, 1941, Pub. L. 258, 55 Stat. 732. The committee report from the House of Representatives regarding the 1941 Act expressly indicated that Congress realized that the Act would restore protection to works “which had lapsed.” H.R. Rep. No. 77-619 at 2 (July 21, 1941).

Six different presidents exercised the restoration power granted by Congress. For example, President Johnson restored renewal rights to German authors whose renewal periods

¹³(...continued)

Jordan, 9 Cranch, 199; *Bloomer v. Stolley*, 5 McLean, 161; *Jordan v. Dobson*, 2 Abb.(U.S.) 408, hardly leave this question debatable.” 21 F. at 42.

had expired between September 3, 1939 and May 5, 1956. See 32 Fed. Reg. 10341 (1967). President Johnson took this action in 1967—at least 11 years after the last of the affected works fell into the public domain. Other presidents issued similar proclamations. See 41 Stat. 1790 (1920) (proclamation of President Wilson); 42 Stat. 2271–78 (1922) (proclamation of President Harding); 58 Stat. 1129–31 (1944) (proclamation of President Roosevelt); 61 Stat. 1057–58 (1947) (proclamation of President Truman); 74 Stat. c69–71 (1960) (proclamation of President Eisenhower).

“Thus, these presidential proclamations allowed foreign authors to restore copyright to their works, which had fallen into the public domain.” *Luck’s Music Library*, Slip op. at 14. They were not merely extensions of time to comply with copyright formalities. *Id.* As with the 1832 Patent Act and the patent at issue in *McClurg*, these 20th century restorations actually restored protection to works that had been in the public domain, freely exploitable by the public.¹⁴

As the Court noted in its March 15, 2004 Order, the 20th century restorations may have been promulgated “only to address the ‘emergency’ of world wars that caused suspension of facilities essential for compliance [with copyright formalities].” 310 F. Supp. 2d at 1219. This does not undermine the government’s position. The constitutional principle that Plaintiffs read into the Copyright Clause does not come with an exception for “emergencies.” If the Copyright

¹⁴ The interpretation of the statutes and presidential proclamations discussed in this section presents a legal question, not subject to fact finding or expert testimony, and ripe for resolution on this motion for summary judgment. See *supra*, at 16.

Clause prohibits Congress from using the enumerated copyright power in order to restore protection to works in the public domain, then it does so at all times. Therefore, the 20th century restorations—even if undertaken in response to world wars—establish concretely Congress’s power to restore copyright protection to works in the public domain. If this power exists in times of emergency, it must exist likewise in times of peace.

* * * * *

The historical practice of copyright restoration, initiated by the First Congress and followed by subsequent congresses and presidents, establishes conclusively the validity of copyright restorations. As the Supreme Court noted in *Eldred*, when courts consider “the scope of Congress’ power under the Copyright Clause, a page of history is worth a volume of logic.” 537 U.S. at 200 (internal quotation marks omitted). What has been acceptable to all three branches of the federal government, from the Republic’s inception through its maturity, remains constitutionally permissible today.

3. The Supreme Court’s Decision in *Graham v. John Deere Co.* Does Not Undermine the Validity of the URAA.

Plaintiffs’ sole support for their notion that the Copyright Clause limits Congress’s ability to restore protection to works in the public domain comes from a single line of dicta in a Supreme Court decision unrelated to copyright protection or to the public domain. In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Supreme Court wrote that “Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain.” *Id.* at 6. The argument that this single sentence in the background section of an otherwise

unrelated decision constitutes the Supreme Court's definitive gloss on the Constitution fails for two reasons.

First and foremost, even if the *Graham* dicta did promulgate a constitutional rule, that rule would not apply to copyright. "*Graham* concerns specific requirements unique to patent law." *Luck's Music Library*, Slip op. at 15. The *Graham* dicta refers only to the removal of "knowledge" from the public domain. This could only apply to patents, for copyright protection *never* gives an author any property right to the knowledge in his work: "[C]opyright gives the holder no monopoly on any knowledge. A reader of an author's writing may make full use of any fact or idea she acquires from her reading." *Eldred*, 537 U.S. at 217. Restoring copyright protection to a work in the public domain, therefore, does not remove knowledge in the public domain. "The grant of a patent, on the other hand, does prevent full use by others of the inventor's knowledge."¹⁵ *Id.* To the extent that the *Graham* dicta promulgates a rule at all, then,

¹⁵ When the *Graham* dicta was raised during the congressional hearings on the URAA, similar observations were made regarding the discussion's application only to patent protection:

In the context of the entire opinion, the basis for the statement is clear. If an invention is already available to the public, then by definition it is not novel. Therefore, the fundamental standard for patent protection just is not met. In contrast, in the copyright area, restoring copyright to a work that is in the public domain because of a failure to comply with formalities or a lack of national eligibility does not call into question the satisfaction of the fundamental standard for copyright protection. You have a work that contains no less original authorship than it did at the time of its creation.

In addition, the Supreme Court made clear that its concern was the removal of existing knowledge from the public domain in the patent context. That concern is not implicated when you restore a copyright. Since facts and ideas are not protected by copyright, the knowledge that is contained in a restored

(continued...)

the rule “has been deemed to be limited only to applications for patents.” *Golan*, 310 F. Supp. 2d at 1219. See also *Luck’s Music Library*, Slip op. at 15–16.¹⁶

The dichotomy between patents and copyrights is not a fanciful creation of the government’s, but rather a well-established doctrine of the Supreme Court, which made the distinction between copyright’s protection of expressions but not ideas and patent’s protection of both expressions and ideas the primary basis for resolving the tension between copyright protection and the First Amendment. See *Eldred*, 537 U.S. at 218–21. Thus, when the Supreme Court’s discussion in *Graham* makes clear that it is concerned with removing “knowledge” from the public domain, it is not hair splitting to read that passage as referring only to patent protection; it is mandated by the inherent differences in the scope of copyright and patent protection. As the Supreme Court recognized in *Eldred*: “In light of these distinctions, one cannot extract from language in our patent decisions,” limitations on copyright protection. *Id.* at 216.

¹⁵(...continued)

work would remain freely available to the public.

Joint House and Senate Committee Hearings on the URAA, 103rd Cong. 188 (1994) (statement of Shira Perlmutter).

¹⁶ The Supreme Court made this precise point in the same section of *Graham* that contains the line of dicta on which Plaintiffs rely. There, the Court, quoting only the patent part of the Patent and Copyright Clause, deleted the words applicable only to copyright and indicated that “[t]he provision [the Patent Clause] appears in the Constitution spliced together with the copyright provision, *which we omit as not relevant here.*” *Graham*, 383 U.S. at 6 n.1 (emphasis added). Thus, the Supreme Court itself signaled that its discussion extended only to patent protection. See also *Luck’s Music Library*, Slip op. at 16.

The second reason that Plaintiffs' attempted reliance on the *Graham* dicta fails is because the single line on which Plaintiffs rely is a mere summary of a more nuanced rule announced much earlier in *Pennock v. Dialogue*, 27 U.S. 1 (1829). Because *Graham* only summarized the *Pennock* rule by way of background, it did not fully articulate the rule's scope. Examination of *Pennock* establishes that any prohibition on removing works from the public domain is narrower than Plaintiffs' isolated quotation suggests.

Once an author creates a work, he has a choice: either accept protection for the creation or donate it to the public domain. If an author chooses protection, he gets a limited term during which he can prevent others from infringing on his property right. At any time during the period the author may give up his rights and allow the public to make free use of the work. If an author chooses donation, however, that decision is final. As the Supreme Court held with regard to patents: “[O]nce gone, [the protected work] cannot afterwards be resumed at [an patent-holder’s] pleasure; for, where *gifts* are once made to the public in this way, they become absolute.” *Pennock*, 27 U.S. at 16 (emphasis added). Thus, the *Pennock* rule prohibits donations to the public domain from later being restored to protection.

Some authors do not “voluntarily” relinquish their rights, however; their rights are involuntarily extinguished—either because the United States and their home country had no reciprocal agreement for the protection of intellectual property, or because the formalities formerly required by the United States effectively deprived authors of the chance to retain their copyright because the authors were unaware of the steps necessary to protect their work:

As difficult as it has been for American authors to comply with the strict formalities that were the hallmark of United States copyright law for so many years, it has been even more difficult for foreign authors. Many lost their U.S. copyrights to the public domain without having sought to exploit their works here, or without being aware of the requirements of our law. Now that we have essentially eliminated formalities from our copyright system, it is appropriate to restore these copyrights and redress the draconian effects of our prior law.

Joint House and Senate Committee Hearings on the URAA, 103rd Cong. 191 (1994) (statement of Shira Perlmutter). The *Pennock* rule does not apply to these works whose protection was involuntarily stripped.

Pennock was concerned that authors might donate a work to the public domain and then renege on that decision. It did not pass judgment on the permissibility of restoring protection to authors whose rights had been involuntarily extinguished. Nor did *Graham*, which merely summarized the *Pennock* rule. Although the *Graham* decision itself does not make the connection between its dicta and the *Pennock* rule clear, a later decision of the Supreme Court does. See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989). First, *Bonito Boats* cites the relevant *Graham* dicta and other background authority regarding patent law. *Id.* at 146. The decision then explains that “[i]n the case of *Pennock v. Dialogue* [citation omitted], Justice Story applied these principles.” *Id.* at 149. Finally, the Court restates with the specificity that was lacking in *Graham* the rule created by *Pennock*:

[I]f [an inventor] suffers the thing he invented to go into public use, or to be publicly sold for use [h]is *voluntary act or acquiescence* in the public sale and use is an abandonment of his right.

Id. (emphasis added, brackets in original, internal quotation marks omitted). *Bonito Boats*

establishes definitively, then, that *Graham* is an abridged summary of *Pennock*.

The URAA does not run afoul of the *Pennock* rule because the foreign authors affected by the Act never made the “voluntary act or acquiescence in the public sale” that constitutes “an abandonment of [their] right.” *Bonito Boats*, 489 U.S. at 149 (quoting *Pennock*, 27 U.S. at 21–22). The URAA is explicitly limited in application to authors that could not previously make the choice between protection and donation. First, foreign authors of sound recordings that were not protected by previous copyright statutes, and foreign authors that could not secure a U.S. copyright because the United States did not have a reciprocal agreement with their home country at the time the work was created, plainly had no ability to secure copyright protection when their works were created. See 17 U.S.C. §104A(h)(6)(C)(ii), (iii). Accordingly, these authors never made the “voluntary” donation to the public domain with which *Pennock* is concerned. And even the foreign authors whose works fell into the public domain for failure to comply with U.S. copyright formalities were, as a practical matter, deprived of a meaningful choice between protection and donation. See 17 U.S.C. §104A(h)(6)(C)(i). Congressional hearings on the URAA made clear the concern that the copyright formalities were so burdensome as to effectively make it impossible for foreign authors to comply—the rules were simply too complex:

As difficult as it has been for American authors to comply with the strict formalities that were the hallmark of United States copyright law for so many years, it has been even more difficult for foreign authors. Many lost their U.S. copyrights to the public domain without having sought to exploit their works here, or without being aware of the requirements of our law. Now that we have essentially eliminated formalities from our copyright system, it is appropriate to

restore these copyrights and redress the draconian effects of our prior law.

Joint House and Senate Committee Hearings on the URAA, 103rd Cong. 191 (1994) (statement of Shira Perlmutter). See also *Scandia House Enterprises v. Dam Things Establishment*, 243 F.Supp. 450, 455 (D.D.C. 1965) (author lost copyright because he misunderstood U.S. copyright requirements, and he labeled his product with a “Denmark” stamp, instead of a “Dam” stamp to denote the work’s place of origin). Indeed, the “draconian effects” of the formalities is the precise reason why Congress has now eliminated them totally from the copyright law. On rational basis review, the government’s burden is only to prove that Congress could rationally have believed that foreign authors were deprived of copyright protection by these formalities. That burden has been satisfied. Because authors affected by the URAA were never presented with the meaningful choice contemplated by *Pennock*, it is impossible to characterize their actions as a donation to the public domain. As a result, neither *Pennock* nor *Graham* speak to the permissibility of restoration.

II. The URAA Is a Permissible Exercise of Congress’s Power to Implement Treaties.

Independent of Congress’s power to enact the URAA using the power enumerated in the Copyright Clause, the URAA is a proper exercise of Congress’s power to implement treaties.¹⁷

The Constitution grants to the President the power, “by and with the Advice and Consent of the

¹⁷ Of course, the URAA need only be a proper exercise of one of Congress’s powers, the Copyright Clause or the treaty power. Accordingly, if the Court finds the Act proper under one power, it need not consider the propriety of the Act under the other power. See *Luck’s Music Library*, Slip op. at 8–9 (“The court concludes that Section 514 does not violate the IP clause and, therefore does not address whether there are other constitutional power through which Congress might pass Section 514.”).

Senate to make treaties, provided two thirds of the Senators present concur.” U.S. Const., Art. II, §2, cl. 2. “If the treaty is valid there can be no dispute about the validity of [an implementing] statute under Article I, §8, as a necessary and proper means to execute the powers of the Government.” *Missouri v. Holland*, 252 U.S. 416, 432 (1920).

The treaty power (and the corresponding power to implement treaties through domestic legislation) is not limited by Congress’s Article I powers. For instance, at issue in *Missouri v. Holland* was the Migratory Bird Treaty Act, which increased protection for wild birds domestically in order to comply with the Migratory Bird Treaty. While assuming *arguendo* that Congress could not enact the legislation using the powers granted to it by Article I of the Constitution, the Court held that the Constitution did not forbid achieving the same result by treaty (and then implementing legislation). *Id.* at 432–34. The Supreme Court reasoned that the powers granted to Congress by Article I cannot provide the outer boundaries for the Article II power to make international agreements. *Id.* at 433.

What is true for the Migratory Bird Treaty Act is true for the URAA. The URAA implements Article 18 of the Berne Convention. See *supra* at 7–8. See also *Luck’s Music Library*, Slip op. at 2 (“Section 514 implements Article 18 of the Berne Convention for the Protection of Literary and Artistic Works.”). Accordingly, Congress had the power to implement it, independent of whether Congress could pass identical language under the Copyright Clause.

The treaty power does come with a significant limitation: Treaties cannot violate “prohibitions of the Constitution.” *Reid v. Covert*, 354 U.S. 1, 17 (1957). Plaintiffs likely will

contend that, if the Copyright Clause prohibits the restoration of copyright protection to public domain works, that constitutes a constitutional “prohibition”—one that would prevent Congress from enacting the URAA under the treaty power (as well as the Copyright Clause). This argument fails, and not only because *Missouri v. Holland* already made clear that Congress’s Article I powers do not limit the treaty power.

Every enumerated power is both a grant of power and a limitation of that power. It simply cannot be the case, however, that the limitation on an enumerated power serves also as an independent “prohibition” on every other power. For instance, the Constitution grants to Congress the power to “define and punish Piracies and Felonies committed on the high Seas.” U.S. Const., Art. I, §8, cl. 10. Yet surely Plaintiffs do not contend that the federal government’s current criminal laws punishing felonies committed on land, many of which are passed pursuant to the Commerce Clause, are unconstitutional. Likewise, the Constitution grants to Congress the power to “provide for the Punishment of counterfeiting the Securities and current Coin of the United States.” *Id.* at cl. 6 (emphasis added). Still, no one doubts Congress’s power to punish, under the Commerce Clause or under the “Law of Nations,” see *id.* at cl. 10, the counterfeiting of *foreign* currency that occurs in this country. See 18 U.S.C. §§478–489 (criminalizing the manufacture, possession, and use of counterfeit foreign currency). See also *United States v. Arjona*, 120 U.S. 479, 483–84 (1887) (upholding a predecessor statute criminalizing counterfeiting foreign currency). Nor has the Supreme Court held unconstitutional federal trademark protection on the ground that the Copyright and Patent Clause allows only for the

issuance of copyrights and patents.

Thus, an argument that each grant of power in Article I—each of which, by virtue of its enumeration, is also a limitation on that power—also constitutes a “prohibition,” is untenable. Such an argument would require the Supreme Court to overrule *Missouri v. Holland*, and to declare the Lanham Act and all federal, non-maritime felony statutes unconstitutional. As a result, the Copyright Clause cannot affect the ability of Congress to enact the URAA pursuant to the treaty power.¹⁸

III. The URAA Does Not Abridge the Freedom of Speech.

The URAA does not abridge the First Amendment’s free speech guarantee. As the Supreme Court explained in *Eldred*, rather than creating a tension with the First Amendment, “copyright’s purpose is to *promote* the creation and publication of free expression.... [T]he Framers intended copyright itself to be the engine of free expression.” *Eldred*, 537 U.S. at 219 (emphasis in original). Accordingly, “copyright’s limited monopolies are compatible with free speech principles.” *Id.*

The Supreme Court’s holding in *Eldred* is dispositive of Plaintiffs’ challenge to the URAA under the First Amendment, as *Luck’s Music Library* establishes.¹⁹ “For those instances

¹⁸ To be clear, the First Amendment and the Due Process Clause, each discussed below, see *infra*, are constitutional prohibitions. See, e.g., *United States v. Carolene Products Co.*, 304 U.S. 144, 153 n.4 (1938) (referring to “a specific prohibition of the Constitution, *such as those in the Bill of Rights*”) (emphasis added).

¹⁹ The government recognizes that, in denying its renewed motion to dismiss, this Court concluded that “Plaintiffs’ argument adequately distinguishes the free speech holding in *Eldred*.”
(continued...)

when copyright protection raises First Amendment concerns, copyright law contains built-in accommodations for First Amendment speech such as through the idea/expression dichotomy and the fair use doctrine.” *Luck’s Music Library*, Slip op. at 19 (citing *Eldred*, 537 U.S. at 219–21). “First, [copyright law] distinguishes between ideas and expression and makes only the latter eligible for copyright protection.” *Eldred*, 537 U.S. at 219. This bright line, between protecting the author’s expression, while allowing free exploitation of the idea inherent in the expression—often called the idea/expression dichotomy—strikes “a *definitional balance* between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting the author’s expression.” *Harper & Row, Inc. v. Nation Enterprises*, 471 U.S. 539, 556 (1985) (emphasis added), quoted and reaffirmed in *Eldred*, 537 U.S. at 219. Thus, by “definition,” the balance between the First Amendment and the Copyright Clause rests on the division between ideas and expression. Second, copyright law also contains fair use provisions, which “allow[] the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances.” *Eldred*, 537 U.S. at 219. See also 17 U.S.C. §107 (codifying fair use provisions). As a result, use of copyrighted material for activities such as “criticism, comment, news reporting, teaching, ... scholarship, or research, is not an infringement of copyright.” *Eldred*, 537 U.S. at 220. Together, the idea/expression dichotomy and the fair use provisions serve as “traditional contours of copyright protection,” which, if

¹⁹(...continued)
310 F. Supp. 2d at 1220. In light of the district court’s decision in *Luck’s Music Library*, the government respectfully requests that the Court reconsider this analysis. *Eldred* definitively foreclosed Plaintiffs’ claim.

unaltered, protect copyright legislation from First Amendment scrutiny. See *Eldred*, 537 U.S. at 221.

The URAA “has not altered the traditional contours of copyright protection.” *Luck’s Music Library*, Slip op. at 20. The Act does not alter in the slightest copyright’s protection of expression only, and it does not restrict the fair use provisions codified at 17 U.S.C. §107. Not only does the URAA respect copyright’s traditional protections, it *supplements* them. See *Luck’s Music Library*, Slip op. at 20. First, the URAA protects authors that have created new works, called “derivative works,” based on works that have been restored to protection. 17 U.S.C. §104A(d)(3). Authors of derivative works “may continue to exploit that work for the duration of the restored copyright,” provided that the author pays a “reasonable” royalty to the owner of the restored copyright. *Id*; *Luck’s Music Library*, Slip op. at 20. Second, the URAA also protects “reliance parties”—persons who made use of a work before its copyright was restored. See 17 U.S.C. §104A(d)(2). Reliance parties may freely use a work whose copyright the URAA restores until the owner of the copyright files a Notice of Intent to Enforce (“NIE”) the restored copyright in the Federal Register, or the copyright owner serves an NIE directly on the reliance party. 17 U.S.C. §104A(d)(2)(A), (B). Even once an NIE is published in the Federal Register or delivered to a reliance party, the reliance party may still use already-existing copies of the work freely for an additional year. *Id*; *Luck’s Music Library*, Slip op. at 20. “Given that Section 514 does not encroach on the traditional copyright protections and includes additional protections, further scrutiny under the First Amendment is unnecessary.” *Id.* at 20.

Plaintiffs cannot possibly contend that, while not altering the idea/expression dichotomy or the fair use provisions, the URAA modifies *other* traditional contours of copyright law and therefore warrants heightened scrutiny. The *Eldred* decision admits to no other traditional contours, and the government can find no other judicial decision pointing to other contours that *Eldred* forgot. Indeed, *Eldred*'s single reference to "traditional contours" is plainly a shorthand reference to the two doctrines that it had been discussing in the preceding paragraphs. *Eldred*, 537 U.S. at 221. Any attempt to read into the *Eldred* decision a suggestion that Congress must preserve anything other than the idea/expression dichotomy and the fair use provisions takes the shorthand phrase "traditional contours of copyright protection" out of context. It finds no support in *Eldred* or in anywhere else in the caselaw.

But even if the Court were to consider whether other "traditional contours of copyright protection" exist, the purported "traditional contours" to which Plaintiffs point are no such thing. First, as established above, there is no principle that copyright protection cannot be restored to works in the public domain. See *supra* at 12–31. Thus, the URAA's restoration of protection draws no heightened First Amendment scrutiny.

And, second, the "first sale doctrine" is hardly a tradition of copyright that, if changed, would warrant heightened scrutiny under the First Amendment. As an initial matter, the first sale doctrine has nothing to do with free speech—it is a protection for subsequent commercial distribution of lawfully purchased works:

The whole point of the first sale doctrine is that once the copyright owner places a copyrighted item in the stream of commerce by selling it, he has exhausted his

exclusive statutory right to control its distribution.

Quality King Distributors, Inc. v. L'anza Research International, Inc., 523 U.S. 135, 152 (1998).

Thus, the first sale doctrine acts a commercial lubricant: Once a product is sold, the copyright holder no longer has any ownership rights in the product; although he can prevent copies of the product from being created or sold, the actual physical product that was sold now belongs to the buyer. *Id.* This commercial doctrine cannot be characterized as helping to toe the line between the First Amendment and the Copyright Clause.

But even if the first sale doctrine did have some connection to the First Amendment (which it does not), the doctrine cannot properly be characterized as “traditional.” The first sale doctrine was created by the Supreme Court in 1908 as a matter of statutory interpretation. See *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 346 (1908) (recognizing that the question presented is a novel one). A doctrine dating from the early 20th century can hardly become a copyright tradition the alteration of which would create a conflict with the First Amendment, which has existed in harmony with the Copyright Clause since 1791. This is particularly true given the complete lack of support for Plaintiffs’ contention that there are any “traditional contours of copyright protection” outside of the idea/expression dichotomy and the fair use principles. Accordingly, the first sale doctrine should not cause the URAA to be subjected to heightened First Amendment scrutiny.

Like the CTEA, considered in *Eldred*, the URAA “does not oblige anyone to reproduce another’s speech against the carrier’s will,” an action that would face heightened scrutiny under

the First Amendment. See *Eldred*, 537 U.S. at 221. Instead, the URAA “protects authors’ original expression from unrestricted exploitation. Protection of that order does not raise the free speech concerns present when the government compels or burdens the communication of particular facts or ideas.” *Id.* As the Supreme Court held, “[t]he First Amendment securely protects the freedom to make—or decline to make—one’s own speech; it bears less heavily when speakers assert the right to make other people’s speeches. To the extent such assertions raise First Amendment concerns, copyright’s built-in free speech safeguards are generally adequate to address them.” *Id.* Thus, the URAA does not violate the First Amendment.²⁰

IV. The URAA Does Not Violate the Due Process Clause.

Finally, for two reasons the URAA does not violate the Due Process Clause of the Fifth Amendment. First, the URAA does not apply retroactively. And, second, even if the URAA did apply retroactively, it would be subject only to rational basis review, and it would pass muster easily.

As an initial matter, the URAA is not “retroactive,” a term with a specific connotation in the legal lexicon:

[W]hether [the statute] would impair rights a party possessed when he acted, increase a party’s liability for past conduct, or impose new duties with respect to transactions already completed.

Landgraf v. USI Film Products, 511 U.S. 244, 280 (1994). Thus, “[a] law is retroactive when it

²⁰ Because Plaintiffs’ suggestion that the URAA should be subject to heightened scrutiny is a question of statutory construction and constitutional interpretation, it is ripe for resolution on this motion for summary judgment, without any fact finding or expert testimony. See *supra* at 16.

alters the legal consequences of completed acts.... Changing the rules governing future behavior, by contrast, is a prospective application.” *Eco Manufacturing, LLC v. Honeywell International Inc.*, 357 F.3d 649, 652 (7th Cir. 2003) (concluding that “applying the 1998 law to Eco’s conduct in 2003 and beyond is entirely prospective”).

The URAA does not apply retroactively. It governs the legality of *future* exploitation of restored works; it does not render illegal exploitation that has already occurred.²¹ See *supra* at 3–4. The URAA does not extend a work’s protection backwards in time to the point where the protection first lapsed. And while the Act does govern how already-existing copies of a restored work must be handled (copiers have at least one year to sell off their stock, see 17 U.S.C. §104A(d)(2)), it governs selling in the future only; copies that were sold before the URAA’s effective date do not come under the scope of the Act. Thus, because the URAA does not attach new liabilities or duties to conduct that occurred prior to the statute’s passage, it cannot be considered retroactive.

However, even if the URAA were considered a retroactive statute, such a distinction would raise no due process concerns. The Supreme Court held long ago that amendments to intellectual property legislation may affect existing works without violating the Constitution:

Whether these exceptions are well taken or not, must depend on the law as it stood at the emanation of the patent, together with such changes as have been since made; for though they may be retrospective in their operation, that is not a sound objection to their validity; the powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution, and as there are no restraints

²¹ However, the statute at issue in *McClurg* did render past exploitation illegal, and was still acceptable to the Supreme Court. See *supra* at 12–14.

on its exercise, there can be no limitation of their right to modify them at their pleasure.

McClurg, 42 U.S. at 206 (1843). See also *Baker v. GTE North Inc.*, 110 F.3d 28, 30 (7th Cir. 1997) (“Congress has an unquestioned right to make economic legislation retroactive, provided that this does not require the revision of a judgment that has become final.”).

Courts adjudicate due process claims under the lenient rational-basis standard: Unless a plaintiff can “establish that the legislature has acted in an arbitrary and irrational way,” then the law must be upheld. *Usery v. Turner Elkhorn Mining Co.*, 428 U.S. 1, 15 (1976). See also *Williamson v. Lee Optical Co.*, 348 U.S. 483, 491 (1955) (holding that the law must have a “rational relation” to a legitimate aim). Retroactive laws are subject to the same rational-basis review as any other statute, with the caveat that the Court must ensure not only that a rational basis exists for the statute, but also that a rational basis exists for the retroactive application of that statute. See *United States v. Sperry Corp.*, 493 U.S. 52, 64 (1989); *Pension Benefit Guaranty Corp. v. R.A. Gray & Co.*, 467 U.S. 717, 730 (1984); *Usery*, 428 U.S. at 17.

For the reasons discussed above, Congress’s rationale for passing the URAA was neither arbitrary nor irrational. See *supra* at 6–10. Under rational basis review, the URAA must be sustained “if there is any reasonably conceivable state of facts that could provide a rational basis” for the enactment. *Heller v. Doe*, 509 U.S. 312, 319-20 (1993). The federal government “has no obligation to produce evidence to sustain the rationality” of the Act; “a legislative choice is not subject to courtroom factfinding and may be based on rational speculation unsupported by evidence or empirical data.” *Id.* at 320. Instead, “[t]he burden is on the one attacking the legisla-

tive arrangement to negative every conceivable basis which might support it, ... whether or not the basis has a foundation in the record.” *Id.* at 320-21 (internal citation omitted). Thus, there is no need for factfinding or expert testimony on this claim. Because the federal government has established that the URAA was a rational enactment, it is entitled to summary judgment.

The argument that the URAA unsettled Plaintiffs’ expectations by depriving them of public-domain works is beside the point. As the Court noted in its March 15, 2004 order, a statute that applies retroactively “is not unlawful solely because it upsets otherwise settled expectations.” 310 F. Supp. 2d at 1221. This statement is in accord with the Supreme Court’s holding in *Usery*, which rejected the position that unsettled expectations have legal consequence, and did so in the context of a more onerous statute than the URAA. See *Usery*, 428 U.S. at 16. Moreover, Congress built extra precautions into the URAA specifically so as not to upset settled expectations. First, Congress gave people substantial time to prepare. The United States signed the Berne Convention in March 1989. The URAA was not passed until December 1994. The effective date of the Act was not until January 1996. See 60 Fed. Reg. 7793 (Feb. 3, 1995). That is almost seven years’ notice of this change in law. The advance warning belies any claim of undue surprise. Further, as discussed above, the URAA protects both reliance parties and derivative works. 17 U.S.C. §104A(d)(2), (3). These protections also prevent upsetting settled expectations. Authors who used a work prior to the URAA’s enactment are protected as reliance parties, and if they created a derivative work they receive even greater protection. Authors who do not qualify as a reliance party could not have been using the work prior to the URAA’s

passage and cannot, therefore, claim an unsettled expectation. Accordingly, Plaintiffs' Due Process challenge should be dismissed.

Finally, when applying the rationality review required by the Supreme Court, this Court should not consider the Third Circuit's decision in *Anker Energy Corp. v. Consolidation Coal Co.*, 177 F.3d 161 (3d Cir. 1999), which articulates what must be considered a heightened standard of rationality review, something that *Eldred* made clear was inappropriate. See *Eldred*, 537 U.S. at 205 n.10. Rationality review is not foreign to the courts. It is applied frequently, and the Supreme Court articulates the test consistently: "It is enough to say that the Act approached the problem ... rationally; whether a [different] scheme would have been wiser or more practical under the circumstances is not a question of constitutional dimension." *Usery*, 428 U.S. at 19. Therefore, *Anker Energy* should not be followed. The decision is not binding in this circuit, whereas the Supreme Court's rationality jurisprudence is. On review under the proper standard, it is clear that the URAA was not irrational.

Conclusion

For the foregoing reasons, Defendant's motion for summary judgment should be granted.

Dated: June 21, 2004

Respectfully submitted,

PETER D. KEISLER
Assistant Attorney General

JOHN W. SUTHERS
United States Attorney

VINCENT M. GARVEY
Deputy Branch Director



JOSHUA Z. RABNOVITZ

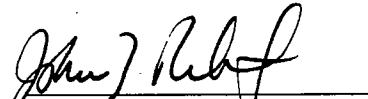
Trial Attorney
United States Department of Justice
Civil Division, Room 7340
20 Massachusetts Ave, NW
Washington D.C. 20530
(202) 353-7633
(202) 616-8470, facsimile

Counsel for Defendant

Certificate of Service

I certify that, on June 21, 2004, I caused a copy of the foregoing Memorandum in Support of Defendant's Motion for Summary Judgment to be served by first-class mail, postage prepaid, upon counsel at the following address:

Hugh Gottschalk
WHEELER TRIGG KENNEDY LLP
1801 California Street, Suite 3600
Denver, CO 80202



Joshua Z. Rabinovitz