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GOLAN V. HOLDER: COPYRIGHT IN THE IMAGE OF THE FIRST AMENDMENT

DAVID L. LANGE, RISA J. WEAVER & SHIVEH ROXANA REED

ABSTRACT

Does copyright violate the First Amendment? Professor Melville Nimmer asked this question forty years ago, and then answered it by concluding that copyright itself is affirmatively speech protective. Despite ample reason to doubt Nimmer's response, the Supreme Court has avoided an independent, thoughtful, plenary review of the question. Copyright has come to enjoy an all-but-categorical immunity to First Amendment constraints. Now, however, the Court faces a new challenge to its back-of-the-hand treatment of this vital conflict. In *Golan v. Holder* the Tenth Circuit considered legislation (enacted pursuant to the Berne Convention and TRIPS) "restoring" copyright protection to millions of foreign works previously thought to belong to the public domain. The Tenth Circuit upheld the legislation, but not without noting that it appeared to raise important First Amendment concerns. The Supreme Court granted certiorari. This article addresses the issues in the *Golan* case, literally on the eve of oral argument before the Court. This article first considers the Copyright and Treaty Clauses, and then addresses the relationship between copyright and the First Amendment. The discussion endorses an understanding of that relationship in which the Amendment is newly seen as paramount, and copyright is newly seen in the image of the Amendment.

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INTRODUCTION

Upon enacting the Bill of Rights, our Founders guaranteed that the federal government would make no law abridging the freedom of speech; yet, Congress routinely enacts laws that do exactly that, ostensibly in the name of some more worthy goal. In particular, the United States copyright laws are, quite simply, government-sanctioned abridgements of speech. While the courts have consistently declined to view copyright law in this light, the fact remains that our freedom of expression is severely constrained by the monopolies granted by the government to individuals and institutions in the form of copyrights. The stated purpose of copyright (and patents) is "[t]o promote the Progress of Science and useful Arts . . . ."[1] Progress is achieved when the public benefits from the creativity of others, by building on what has come before to further create. Progress is achieved when a group of student musicians spends months practicing a complicated symphony composed by Dmitri Shostakovich and performs that symphony for family and classmates, each member of the orchestra contributing his own expressive qualities to the notes written by a Russian composer they never met. Is progress achieved when Congress suddenly tells those musicians that the symphony previously made freely available to them through the public domain is no longer available because it has decided to "restore" Mr. Shostakovich's copyright?[2]

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[1] U.S. CONST. art. I, § 8, cl. 8.

[2] A copyright, one might add, that Mr. Shostakovich never, in fact, possessed because the United States did not have copyright relations with the Soviet Union at the time of the symphony's composition. How can one restore what never existed? *See* Golan v. Holder, 609 F.3d 1076, 1095

The statute that allows Congress to effect this restoration is section 104A of the Copyright Act of 1976, which was added after the United States signed the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS") in 1994.[3] Section 104A restores copyright protection to works by foreign authors who previously lost (or never had) U.S. copyright protection for their works because they did not comply with United States formalities, such as notice and deposit, or because we had no copyright relations with their home countries at the time their work was created.[4] Restoration of copyright is available only for works that are still under copyright in the author's country of origin.[5] Restoring copyright protection essentially removes a work from the public domain—what once was free for all to use now requires license fees that can be well beyond the financial means of individuals and organizations that have previously made use of the works.[6]

I. BACKGROUND

Understanding why United States copyright law now contains a provision allowing for the restoration of copyright requires a brief foray into the area of world trade and globalization. After World War II, many of the world's nations formed the General Agreement on Tariffs and Trade ("GATT") in order to promote free trade by removing protectionist barriers, such as tariffs and quotas.[7] The GATT is periodically revised at negotiating sessions known as "rounds" named for the location where they are held.[8] The Uruguay Round met from 1986 until 1994, out of which emerged the World Trade Organization ("WTO") and the TRIPS Agreement, the first worldwide trade agreement covering intellectual property rights ("IPRs"), including copyright.[9]

In addition to prescribing its own rules for IPRs, TRIPS incorporates certain provisions of earlier multilateral IP treaties, most importantly for our purposes, Articles 1 through 21 of the Berne Convention for the Protection of Literary and Artistic Works ("Berne Convention").[10] The Berne Convention came into being in 1886 with nine original members, including the colonial powers of the day, France,

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(10th Cir. 2010), *cert. granted*, 131 S. Ct. 1600 (2011); *U.S. Supreme Court Will Review Constitutionality of Restoring Copyrights in Foreign Works: Court Grants Cert in Stanford Law School Fair Use Project Case* Golan v. Holder, STAN. L. SCH. NEWS CENTER (Mar. 7, 2011), http://www.law.stanford.edu/news/pr/135.

[3] *Golan*, 609 F.3d at 1080.

[4] 17 U.S.C. §§ 104A(a), 104A(h)(6)(C) (2006).

[5] *Id.* § 104A(h)(6)(B).

[6] *Golan*, 609 F.3d at 1082.

[7] *See* Loretta F. Smith, *The GATT and International Trade*, 39 BUFF. L. REV. 919, 919, 924–25 (1991).

[8] *See id.* at 942.

[9] The final agreement of the Uruguay Round was signed on April 15, 1994, in Marrakesh, Morocco and is entitled Marrakesh Agreement Establishing the World Trade Organization. TRIPS is Annex 1C to the Marrakesh Agreement. Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments—Results of the Uruguay Round, 33 I.L.M. 1125, 1869 U.N.T.S. 299 [hereinafter TRIPS], *available at* http://www.wto.org/english/docs_e/legal_e/27-TRIPS.pdf.

[10] TRIPS *supra* note 9, at art. 9. Only Article 6*bis*, having to do with moral rights, is exempted from incorporation.

Spain, and Great Britain; membership today includes more than 150 countries.[11] Notably absent from the Convention for many years was the United States, which did not accede until 1989, when negotiations were already underway to create the WTO and TRIPS.[12]

The fundamental difficulty in achieving worldwide harmony in copyright law is that civil law countries (such as France and most of Continental Europe) and common law countries (such as Great Britain and the United States) have dramatically different justifications for copyright. The civil law countries view copyright as a "natural" right residing in the author, who invests the work with his personality.[13] This view favors very strong protections with few exceptions—authors are inherently "entitled" to control their creations.[14] Common law countries, on the other hand, view copyright as an economic bargain—the temporary monopoly is granted to the creator as an incentive for creation and to compensate him for his investment of time and money before the work is ultimately dedicated to the public.[15] This view endorses narrow protection with broader exceptions to protect the "public good."[16] Our constitutional requirement that copyright be for "limited times," along with fair use exceptions and First Amendment protection, is intended to ensure that private creators' rights do not deprive the public of its rights.[17]

To this end, the Berne Convention is not a self-executing treaty in the United States—its provisions are only enforceable to the extent that Congress explicitly implements them through domestic law.[18] Congress passed the Berne Convention Implementation Act of 1988 ("BCIA") to amend the United States Copyright Act as necessary to comport with the Berne Convention.[19] Notably, section 12 of the BCIA explicitly declined to extend "copyright protection for any work that is in the public

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[11] Natalie Wargo, *Copyright Protection for Architecture and the Berne Convention*, 65 N.Y.U. L. REV. 403, 403 n.5 (1990).

[12] *Id.* Indeed, Congress had begun the process of bringing U.S. copyright law into compliance with the Berne Convention much earlier, during the drafting of the Copyright Revision Act of 1976. Under the 1909 Act, which the 1976 Act replaced, authors were awarded an initial copyright term of twenty-eight years and had to actively renew their copyright in order to secure a second twenty-eight-year term. The 1976 Act eliminated the renewal requirement and instituted a new term of fifty years *post mortem auctoris* (fifty years after the death of the author, or "life-plus-fifty" as it is commonly phrased), both of which changes comported with the Berne Convention, despite the fact that the U.S. had not formally acceded to the Berne Convention at that point. R. Anthony Reese, *Is the Public Domain Permanent?: Congress's Power to Grant Exclusive Rights in Unpublished Public Domain Works*, 30 COLUM. J.L. & ARTS 531, 541 (2007). The Sonny Bono Copyright Term Extension Act of 1998 extended the term again to life-plus-seventy years in order to harmonize our term with that of the European Union, although the Berne Convention's minimum standard remains life-plus-50.

[13] MARSHALL A. LEAFFER, UNDERSTANDING COPYRIGHT LAW 3 (Matthew Bender & Co., Inc. ed., 3d ed. 1999) (1989).

[14] *Id.*

[15] *Id.* at 6.

[16] Lior Zemer, *Copyright Departures: The Fall of the Last Imperial Copyright Dominion and the Case of Fair Use*, 60 DEPAUL L. REV. 1051, 1051–71 (2011).

[17] U.S. CONST. art. I, § 8, cl. 8; 17 U.S.C. § 107 (2006); LEAFFER, *supra* note 13, at 18.

[18] Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988) [hereinafter BCIA].

[19] *Id.* Along with the change in term, *supra* note 12, other formalities, including the requirement that all copies have affixed copyright notices, were eliminated, along with other substantive changes.

domain in the United States,"[20] a condition that was arguably required by the Berne Convention.[21]

Article 18(1) of the Berne Convention states, "[t]his Convention shall apply to all works which, at the moment of its coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection."[22] As previously mentioned, this Article was incorporated into TRIPS, which the United States signed at inception, on April 15, 1994. In order to implement the Marrakesh Agreement and TRIPS, President Clinton signed the Uruguay Round Agreements Act ("URAA") on December 8, 1994 (with an effective date of January 1, 1995).[23] Section 514 of the URAA is titled "Restored Works" and amends the United States Copyright Act to add section 104A, "Copyright in Restored Works."[24]

In sum, section 514/section 104A requires copyright to be restored in any *foreign* works that are in the public domain in the United States for reasons other than expiry of term.[25] The three most common reasons for foreign works to have fallen into our public domain are, (1) failure to comply with formalities when they were still required (such as affixing copyright notice to all copies or registering for renewal of copyright term); (2) lack of copyright relations with the foreign author's country of residence at the time of publication; and (3) lack of protection under U.S. law for the particular medium (e.g., sound recordings prior to 1972).[26] Works whose copyrights are restored under section 514 gain a term of protection equal to what it would have been if the work had been properly protected initially.[27] Upon either filing with the United States Copyright Office a Notice of Intent to Enforce a Restored Copyright or directly notifying a user of a work that the copyright has been restored,[28] a foreign

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[20] BCIA, *supra* note 18, § 12.

[21] 37 C.F.R. § 201–02 (2005); *see* Copyright Office, *Rules and Regulations Library of Congress*, 60 FED. REG. 50414 (Sept. 25, 1995) ("The United States arguably failed to conform its law fully to the Berne Convention in 1989 when it declined to interpret Article 18(1) on restoration as being mandatory.").

[22] Berne Convention for the Protection of Literary and Artistic Works, art. 18(1) (Sept. 9, 1886) [hereinafter Berne Convention].

[23] Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809 (1994) [hereinafter URAA]. The URAA was neither negotiated nor passed in typical fashion; Congress played no part in writing the bill—it was handled entirely by the Executive Branch and the U.S. Trade Representative—and Congress was only permitted to vote "yes" or "no" without imposing any changes. Irwin Karp, *Final Report, Berne Article 18 Study on Retroactive United States Copyright Protection for Berne and Other Works*, 20 COLUM.-VLA J. LAW & ARTS, 157, 173, 185–86, 231 (1996); *see also* David Nimmer, *David Nimmer on the Constitutionality of Anti-Bootlegging legislation*, 2008 EMERGING ISSUES 1131 (Nov. 27, 2007) (noting that the URAA "broke new ground" with an "eerie abdication of oversight").

[24] URAA, *supra* note 23, § 514.

[25] *Id.* (noting that section 514(h)(3) defines "eligible country" to be any country "*other than the United States*" that is a member of the WTO or the Berne Convention or the subject of a presidential proclamation to that effect).

[26] *See* 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 9A.04 (2011) [hereinafter NIMMER].

[27] 17 U.S.C. § 104A(a)(1)(B) (2006); *see generally* NIMMER, *supra* note 26, § 9A.02 (providing a variety of examples relating to the duration of a work's restored protection based on when it was originally published and which U.S. copyright law was in effect at that time).

[28] Arguably, this is a formality in contravention of the Berne Convention. However, in its regulations governing such filings, the United States Copyright Office stated, "[w]e believe that such a filing is not inconsistent with the Berne Convention because Article 18(3) of the Berne Convention

copyright owner may seek remedies for copyright infringement as described in Chapter 5 of the Copyright Act of 1976.[29]

Section 514 makes some allowances for "reliance parties," those who *relied* on the work's public domain status in using the work directly (such as publishing copies of the original) or in creating a derivative work.[30] If a reliance party continues to make use of the work beyond the twelfth month after the owner files the Notice of Intent to Enforce, the owner may seek remedies under the Copyright Act.[31] In the case of reliance parties who have created derivative works, they may continue exploiting those derivative works, but only upon paying the owner "reasonable compensation," which may be set by a U.S. district court if the parties cannot agree on an amount.[32]

II. *GOLAN*'S SLOW MARCH TO THE SUPREME COURT

This brings us to the facts of *Golan v. Holder*.[33] Lawrence Golan, the named plaintiff, is the conductor of the University of Denver orchestra.[34] With an annual budget of only $4000 for music licensing fees, the school cannot afford to purchase or license its entire repertoire and must rely on works in the public domain.[35] Aided by the Fair Use Project at The Center for Internet and Society at Stanford Law School, Mr. Golan filed suit in 2001, asserting that section 514 unconstitutionally removes works from the public domain.[36] The case was decided in 2005 by Lewis Babcock, Chief Judge for the District Court of Colorado, on competing motions for summary judgment.[37]

A. The First District Court Opinion

Chief Judge Babcock framed his decision in terms of three issues: (1) whether Congress exceeded its authority in enacting section 514; (2) whether the government's basis for section 514 is rationally related to a legitimate governmental

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specifically permits member nations to determine 'conditions' for applying the principles of restoration." *See* Copyright Office, *supra* note 21, at 50416.

[29] 17 U.S.C. § 104A(c)–(e).

[30] URAA, *supra* note 23, § 514(d).

[31] 17 U.S.C. § 104A(d)(2).

[32] *Id.* § 104A(d)(3).

[33] Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010). The case as originally filed was *Golan v. Ashcroft*; however, that earlier iteration of the case involved a challenge to the Copyright Term Extension Act of 1998 which was dismissed because it was foreclosed by the Supreme Court's decision in *Eldred v. Ashcroft*. Golan v. Ashcroft, 310 F. Supp. 2d 1215 (D. Colo. 2004); Eldred v. Ashcroft, 537 U.S. 186 (2003). Alberto Gonzales then replaced John Ashcroft as attorney general, and our review of the cases begins with the first opinion under the name *Golan v. Gonzales*. When Eric Holder replaced Alberto Gonzales as attorney general, the case became *Golan v. Holder*.

[34] Marc Parry, *Supreme Court Takes-Up Scholars' Rights*, CHRON. HIGHER EDUC. (May 29, 2011), *available at* http://chronicle.com/article/A-Professors-Fight-Over/127700.

[35] *Id.*

[36] *Id.*

[37] Golan v. Gonzales, 74 U.S.P.Q.2d (BNA) 1808, 1809 (D. Colo. 2005).

interest; and (3) whether section 514 impermissibly violates the plaintiffs' First and Fifth Amendment rights.[38] Chief Judge Babcock devoted the most attention to the first issue, for which he analyzed copyright history from passage of the first copyright law, the 1790 Copyright Act, and concluded that Congress had removed works from the public domain with that enactment.[39] Because three of the original thirteen states did not have statutory copyright laws in effect prior to 1790, those three states had only common law copyright protection, which lapsed upon publication, thereby causing published works to fall into the public domain.[40] The 1790 Copyright Act applied to "any map, chart, book, or books already printed within these United States,"[41] which necessarily included works published in states that had no statutory copyright protection. Because those public domain works were removed from the public domain when their authors sought statutory protection under the new federal law, Chief Judge Babcock viewed this as evidence that Congress had determined that the practice of removing works from the public domain was "constitutionally permissible."[42]

On the second issue, with little discussion, Chief Judge Babcock concluded that the government's attempt "to promote protection of American authors by ensuring compliance with the Berne Convention within our own borders . . . is rationally related to, and constitutes a rational basis for, URAA [s]ection 514."[43] Lastly, Chief Judge Babcock did not take seriously the plaintiffs' claim that their First Amendment rights were infringed, disposing of that argument in one sentence: "I see no need to expand upon the settled rule that private censorship via copyright enforcement does not implicate First Amendment concerns."[44] He gave the Fifth Amendment due process claim slightly more thought, but concluded that, although section 514 provides authors with retroactive benefits, it does not impose retroactive burdens on users and, therefore, does not offend due process.[45] In light of his conclusions, Chief Judge Babcock granted the government's motion for summary judgment and denied the plaintiffs'.[46]

B. The First Tenth Circuit Opinion

Plaintiffs appealed the case to the Tenth Circuit, which issued its first opinion in 2007.[47] The court first evaluated whether section 514 exceeds Congress's authority, and then whether section 514 requires First Amendment scrutiny.[48] On the first

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[38] *Id.* at 1810.
[39] *Id.* at 1813.
[40] *Id.*
[41] *Id.*
[42] *Id.* at 1817.
[43] *Id.* at 1821.
[44] *Id.*
[45] *Id.* at 1822.
[46] *Id.*
[47] Golan v. Gonzales, 501 F.3d 1179 (10th Cir. 2007). Plaintiffs once again raised the CTEA argument, but the Tenth Circuit agreed with the Colorado district court and other courts that had heard similar claims and held that *Eldred v. Ashcroft* precluded challenges to the CTEA. *Id.* at 1185.
[48] *Id.* at 1186–87.

question, the court concluded that Congress's goal of compliance with the Berne Convention was not "so irrational or so unrelated to the aims of the Copyright Clause that it exceeds the reach of congressional power."[49] There is nothing remarkable in this conclusion, as it is the same conclusion as that reached by other courts to have considered the question, including the Supreme Court in *Eldred v. Ashcroft*.[50]

What is remarkable about the Tenth Circuit's opinion is its conclusion that section 514, by removing works from the public domain, alters the "traditional contours of copyright—the peg upon which the *Eldred* decision hangs—and, therefore, demands First Amendment scrutiny.[51] In the Tenth Circuit's view:

> Until [section] 514, every statutory scheme preserved the same sequence. A work progressed from (1) creation; (2) to copyright; (3) to the public domain. Under [section] 514, the copyright sequence no longer necessarily ends with the public domain: indeed, it may begin there. Thus, by copyrighting works in the public domain, the URAA has altered the ordinary copyright sequence.[52]

The Tenth Circuit rejected all of the government's arguments that removing works from the public domain had, in fact, been a traditional part of copyright law, including the argument that had been successful at the district court level, namely that the 1790 Copyright Act illustrated the Founders' comfort with removing works from the public domain: "Given the scarcity of historical evidence, we cannot conclude that the Framers viewed removal of works from the public domain as consistent with the copyright scheme they created. Nor do we discern at the dawn of the Republic any burgeoning tradition of removing works from the public domain."[53]

The court also characterized as unusual, rather than traditional, the two other instances of Congress ostensibly allowing public domain works to be copyrighted, both of which took place in response to world wars.[54] Although the *Eldred* Court created from whole cloth the notion that First Amendment scrutiny of copyright laws

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[49] *Id.* at 1187.

[50] Eldred v. Ashcroft, 537 U.S. 186 (2003). *Eldred* involved a challenge to the Sonny Bono Copyright Term Extension Act, which lengthened the term of copyright to life-plus-seventy years to align with European Union law. *Id.* at 193. The Supreme Court upheld the extension as a valid exercise of Congress's power under the copyright clause and also concluded that, although copyright laws were not immune from First Amendment scrutiny, such scrutiny was only necessary when the "traditional contours of copyright" were altered. *Id.* at 221.

[51] *Gonzales*, 501 F.3d at 1187–88.

[52] *Id.* at 1189.

[53] *Id.* at 1191.

[54] *Id.* at 1191–92. The court noted:

> [T]he government argues that the wartime acts of Dec. 18, 1919, Pub. L. No. 66-102, 41 Stat. 368, and the Emergency Copyright Act of 1941, Pub. L. No. 77-258, 55 Stat. 732, removed works from the public domain by granting the President authority to give foreign authors additional time to comply with copyright requirements. However, a review of the historical record reveals that these emergency wartime bills, passed in response to exigent circumstances, merely altered the means by which authors could comply with procedural rules for copyright; these bills were not explicit attempts to remove works from the public domain.

Id.

is only necessary when the traditional contours of copyright are altered, lower courts are now bound to analyze copyright laws within that framework. Because section 514 removes works from the public domain, which is not a traditional contour of copyright, and because the plaintiffs have a First Amendment speech interest in using those public domain works, the Tenth Circuit concluded that section 514 must be given full First Amendment scrutiny, which the district court did not do.[55] Therefore, the court remanded the case to the district court for the appropriate First Amendment review.[56]

C. The Second District Court Opinion

On remand, the case was decided once again by Chief Judge Babcock under standard First Amendment jurisprudence. The initial step in traditional First Amendment analysis is to determine whether the law in question is content-neutral or content-based, which in turn determines the level of scrutiny applied to the law and the level of importance that the government must demonstrate in order to sustain the law.

The parties and Chief Judge Babcock agreed that section 514 is a content-neutral regulation of speech.[57] As will be demonstrated in Part V, plaintiffs should not have conceded this fact and should have argued that section 514 is content-based and thereby requires a higher level of scrutiny. Alternatively, as Part V also posits, plaintiffs could have argued that regardless of the nature of the speech regulation contemplated by section 514, the statute cannot stand against a First Amendment phrased as it is—"Congress shall make no law . . . abridging the freedom of speech."[58] The purpose in this section, however, is merely to outline the analysis undertaken by the district court of a concededly content-neutral statute.

In the words of the court,

> 'A content-neutral regulation [of speech] will be sustained under the First Amendment if it advances important governmental interests unrelated to the suppression of free speech and does not burden substantially more speech than necessary to further those interests.' While a content-neutral restriction must be 'narrowly tailored to serve a significant government interest' unrelated to the suppression of free speech, it 'need not be the least restrictive or least intrusive means of doing so.' The requirement of narrow tailoring is satisfied so long as the restriction promotes a substantial government interest that would be achieved less effectively absent the restriction . . . . 'So long as the means chosen are not substantially broader than necessary to achieve the government's interest,' the restriction will not

[55] *Id.* at 1194.
[56] *Id.* at 1197.
[57] Golan v. Holder, 611 F. Supp. 2d 1165, 1170 (D. Colo. 2009).
[58] U.S. CONST. amend. I.

> be invalid simply because 'the government's interest could be adequately served by some less-speech-restrictive alternative.'[59]

The government offered three interests which, in its view, are significant enough to justify the burden on speech imposed by section 514: (1) compliance with treaty obligations; (2) protection of U.S. copyright owners' interests; and (3) correction of "historic inequities wrought on foreign authors who lost their United States copyrights through no fault of their own."[60]

Chief Judge Babcock acknowledged that compliance with international treaties is an important governmental interest but pointed out that even a treaty is subject to constitutional limitations, including the First Amendment.[61] In keeping with conventional First Amendment analysis, Chief Judge Babcock considered whether section 514 is "substantially broader than necessary to achieve" the goal of complying with the Berne Convention and TRIPS.[62] As part of that analysis, Chief Judge Babcock had to determine whether section 514 excludes a substantial amount of speech from First Amendment protection, the "unprotected speech." The government pointed out that the reliance provisions of section 514 protect plaintiffs from liability for copying that occurred before the copyright was restored and allow plaintiffs two options with respect to derivative works—one year in which to sell or use copies made before restoration of copyright, or payment of a royalty for exploitation beyond the one-year period.[63] This constitutes the "protected speech," but it leaves unprotected "any speech that involves copying more than one year after notice has been filed, and any derivative works made after notice is filed and without payment of a royalty."[64] In Chief Judge Babcock's view, this amount of unprotected speech is a substantial amount, which necessitates determining whether that unprotected speech is or is not "'tied to the Government's interest' in complying with the Berne Convention."[65]

Plaintiffs argued that Article 18 of the Berne Convention allows member nations discretion in implementing copyright restoration statutes, and Chief Judge Babcock ruled that in light of this discretion, "Congress could have complied with the Berne Convention without interfering with a substantial amount of protected speech . . . ."[66] Thus, by limiting the First Amendment speech rights of reliance parties, section 514 burdens speech in a way that is not required by the Berne Convention and is, therefore, not tied to the government's interest. Because those speech limitations are not tied to the government's interest in complying with the Berne Convention, Chief Judge Babcock found that section 514 is "substantially broader than necessary to achieve the government's interest" and that summary judgment for plaintiffs was appropriate on that question.[67]

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[59] *Golan*, 611 F. Supp. 2d at 1170–71 (alteration in original) (citations omitted).
[60] *Id.* at 1172.
[61] *Id.*
[62] *Id.*
[63] *Id.* at 1173.
[64] *Id.*
[65] *Id.* (citations omitted).
[66] *Id.* at 1174.
[67] *Id.* at 1174–75.

As to the government's second justification for section 514, that it protects U.S. authors' interests abroad, Chief Judge Babcock found that it was "largely intertwined with its argument regarding compliance with Article 18 of the Berne Convention—a justification which has been rejected as insufficient to justify the infringement of plaintiffs' First Amendment rights above."[68] The government made a half-hearted attempt to argue that by not protecting foreign authors' restoration rights, the United States opens the door to "reprisals" by other Berne Convention members against our authors; however, Chief Judge Babcock disposed of that argument by simply pointing to the text of the Berne Convention. The Berne Convention only allows for reprisals against nationals of countries that are not members of the Berne Convention. Because the United States is a member of the Berne Convention, the reprisals article does not apply.[69] Therefore, summary judgment for plaintiffs was appropriate on that issue.[70]

Lastly, Chief Judge Babcock addressed the government's argument that it has a significant interest in correcting historical inequities by restoring U.S. copyright protection to foreign authors who lost it through no fault of their own.[71] The force of this argument is blunted by the fact that section 514 itself creates further inequities in that it applies only to foreign authors.[72] A U.S. national who lost his U.S. copyright for failing to comply with formalities cannot have his copyright restored under section 514. As Chief Judge Babcock points out, "[r]ather than correct an historic inequity, [s]ection 514 appears to create an inequity where one formerly did not exist. The Government proffers no evidence showing how granting foreign authors copyrights in the United States—yet denying similar protections to United States authors—could constitute an important Government interest."[73] Thus, summary judgment for plaintiffs was appropriate on this issue as well.[74] In sum, Chief Judge Babcock found that section 514 burdened substantially more speech than necessary in order to achieve compliance with the Berne Convention and granted summary judgment to the plaintiffs.[75]

Unsurprisingly, the government appealed Chief Judge Babcock's ruling to the Tenth Circuit. However, the plaintiffs also appealed, on the grounds that:

> [Chief Judge Babcock's decision] fails to adjudicate the question of whether section 514 of the URAA is unconstitutional on its face; fails to enjoin Defendant Holder, his successor, and his subordinates from enforcing copyrights created by section 514 for all works that have previously been in the public domain; and fails to order Defendant Peters, her successor, and her subordinates to cancel all copyright registrations of works whose

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[68] *Id.* at 1175 (emphasis omitted).

[69] *Id.*

[70] *Id.* at 1176–77.

[71] *Id.* at 1176. The government seems to forget here that section 514 also restores copyright protection to authors who failed to comply with formalities such as notice and renewal, the blame for which failure must lie squarely with the authors.

[72] *See* 17 U.S.C. § 104A(h)(3) (2006) (defining an "eligible country" as one "other than the United States").

[73] *Golan*, 611 F. Supp. 2d at 1177.

[74] *Id.*

[75] *Id.*

copyright status was restored under section 514 of the URAA and to refrain from issuing registrations for any such works in the future.[76]

D. The Second Tenth Circuit Opinion

In June 2010, the Tenth Circuit issued its second opinion in the case, reversing the district court and finding that section 514 does not violate the First Amendment.[77] Unfortunately for the plaintiffs, and for free speech advocates, constitutional challenges to statutes are reviewed de novo, giving the Tenth Circuit justification to substitute its own judgment in place of the district court's judgment.[78] The parties and the court once again agreed that section 514 is a content-neutral regulation of speech.[79] The government offered the same three justifications for section 514 that it had advanced at the district court level: (1) compliance with treaties, (2) protecting U.S. authors' copyright interests abroad, and (3) remedying past inequities.[80] This time, however, the court agreed with the government that it has "a substantial interest in protecting American copyright holders' interests abroad, and section 514 is narrowly tailored to advance that interest."[81]

The court began by evaluating the government's interest and whether it was "unrelated to the suppression of free expression."[82] The plaintiffs argued that the government was attempting a "'reallocation of speech interests' between American reliance parties and American copyright holders" and that this reallocation does not qualify as an important governmental interest.[83] The court acknowledged that the plaintiffs have a First Amendment interest in using the public domain works, but it countered their interest by pointing out that U.S. authors also have a First Amendment right to secure their "economic and expressive interests" through foreign copyright.[84] In the court's view, the authors' interests "are at least as important or substantial as other interests that the Supreme Court has found to be sufficiently important or substantial to satisfy intermediate scrutiny."[85]

In deciding whether section 514 "was 'designed to address a real harm, and whether [it] will alleviate [that harm] in a material way,'"[86] the Tenth Circuit largely deferred to Congress. The court seems to have been under the impression that Congress was able to carefully weigh the implications of section 514 during consideration of the URAA. However, in light of the fact that Congress was not permitted to make any changes to the URAA—it was negotiated by the Clinton

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[76] Plaintiff's Notice of Appeal to the United States Court of Appeals for the Tenth Circuit at 1–2, Golan v. Holder, 611 F. Supp. 2d 1165 (D. Colo. 2009) (No. 1:01-CV-1854). The reference, "Peters," is to Defendant Marybeth Peters, Register of Copyrights at the time the case was heard. Ms. Peters has since retired and was succeeded by Maria Pallante on June 1, 2011.

[77] Golan v. Holder, 609 F.3d 1076, 1172 (10th Cir. 2010).

[78] *Id.* at 1082.

[79] *Id.* at 1083.

[80] *Id.*

[81] *Id.*

[82] *Id.* at 1084.

[83] *Id.*

[84] *Id.*

[85] *Id.*

[86] *Id.* at 1084 (alteration in original).

Administration and the United States Trade Representative, and Congress was forced to accept or reject it as a whole[87]—the court's deference was probably misplaced in this instance. The court also probably put too much weight on the fact that "Congress heard testimony addressing the interests of American copyright holders,"[88] failing to properly consider the source of that testimony, namely, the Recording Industry Association of America, the International Intellectual Property Alliance, and the Motion Picture Association of America—i.e., industry representatives, all of whom had a financial interest in passing section 514 despite its First Amendment problems.[89]

The court ultimately concluded that section 514 does not burden substantially more speech than necessary to advance the government's interest.[90] The court first reiterated the Supreme Court's view that the idea/expression dichotomy and fair use are sufficient "built-in" First Amendment protections and then concluded that because section 514 does nothing to "disturb these traditional, built-in protections," it does not burden a substantial amount of speech that would otherwise be protected by the First Amendment.[91] The court seems to have forgotten that the question is whether the traditional contours of copyright are altered, not whether the Supreme Court's so-called "built-in First Amendment protections" remain in place.

After determining that section 514 does not burden substantially more speech than necessary to advance what is an important government interest and is thus narrowly tailored, the court decided that despite the fact that other, less restrictive means could have been used to comply with the Berne Convention, Congress was not required to choose those less restrictive means.[92] In light of these conclusions, the Tenth Circuit reversed the district court's finding that section 514 violates the First Amendment, finding instead that section 514 is "consistent with the First Amendment."[93] The court also refused to find section 514 unconstitutional on its face, as plaintiffs requested in their cross-appeal.[94] With the Tenth Circuit's reversal, the stage was set for an appeal to the Supreme Court.

III. ARGUMENTS BEFORE THE SUPREME COURT

Following the Tenth Circuit decision, the plaintiffs filed a petition for a writ of certiorari, and the United States Supreme Court granted certiorari on March 7, 2011.[95] Plaintiffs, now petitioners, filed their merits brief on June 14, 2011,[96] and the

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[87] Karp, *supra* note 23, at 185–86.
[88] *Golan*, 609 F.3d at 1085.
[89] *Id.* at 1085–88.
[90] *Id.* at 1094.
[91] *Id.* at 1091 n.9.
[92] *Id.* at 1091–94.
[93] *Id.* at 1094.
[94] *Id.*
[95] Petition for Writ of Certiorari, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2010 WL 4232641.
[96] Brief for the Petitioners, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2423674 [hereinafter Pets. Br.].

government, now respondents, filed its merits brief on August 3, 2011.[97] Petitioners filed their reply brief on August 31, 2011.[98]

Meanwhile, this case attracted the active interest of several organizations in favor of both parties. In addition to two amicus briefs filed in support of the certiorari petition,[99] sixteen organizations filed amicus briefs in support of petitioners and eight organizations filed amicus briefs in support of respondents. Out of these sixteen amicus briefs supporting petitioner, three amici focused their arguments on the Copyright Clause violation,[100] and six amici focused on the First Amendment violation.[101] Six amici argued that section 514 violated both the Copyright Clause and the First Amendment,[102] and one amicus argued that treaties, including the URAA, do not expand Congress's legislative authority.[103] The eight remaining amicus briefs supported respondents and argued that section 514 was not unconstitutional under the Copyright Clause or the First Amendment.[104]

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[97] Brief for the Respondents, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 3379598 [hereinafter Resps. Br.].

[98] Reply Brief for the Petitioners, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 4500811 [hereinafter Pets. Reply Br.].

[99] Brief for Internet Archive as Amicus Curiae in Support of Petitioners, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2010 WL 4876471; Brief of the Conductors Guild as Amicus Curiae Supporting Petitioners, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2010 WL 4874473.

[100] Brief of Peter Decherney as Amicus Curiae in Support of Petitioners at 2, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2470832, at *2; Brief for Creative Commons Corp. as Amicus Curiae in Support of Petitioners at 5–6, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2470826, at *5–6 (June 20, 2011) (No. 10-545); Brief of Pub. Domain Interests as Amicus Curiae in Support of Petitioners at 4–6, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2470829, at * 4–7.

[101] Brief of Daniel J. Gervais as Amicus Curiae in Support of Petitioners at 2–3, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2470824, *2–3; Brief of Pub. Knowledge as Amicus Curiae in Support of Petitioners at 2–3, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2470822, at *2–3; Brief of Info. Soc'y Project at Yale Law as Amicus Curiae in Support of Petitioners at 2, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2470834, at *2; Brief of the Am. Civil Liberties Union as Amicus Curiae in Support of Petitioners at 5–6, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2578555, at *5–6; Brief of the Conductors Guild as Amicus Curiae in Support of Petitioners at 3, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2010 WL 4874473, at *3; Brief of Project Petrucci, L.L.C. as Amicus Curiae in Support of Petitioners at 5, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2578554, at *3.

[102] Brief of H. Tomas Gomez-Arostegui and Tyler T. Ochoa as Amicus Curiae in Support of Petitioners at 1–2, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2470823, at *1–2; Brief of Eagle Forum Educ. & Legal Def. Fund as Amicus Curiae in Support of Petitioners at 4–5, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2470821, at *4–5; Brief of Heartland Angels, Inc. as Amicus Curiae in Support of Petitioners at 5–6, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2470833, at *5–6; Brief of Justice and Freedom Fund as Amicus Curiae in Support of Petitioners at 2, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2470825, at *2; Brief of Am. Library Ass'n, et al. as Amicus Curiae in Support of Petitioners at 5–6, 28, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2533007, at *28; Brief for Google, Inc. as Amicus Curiae in Support of Petitioners at 8–9, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2533006, at *8–9.

[103] Brief of The Cato Inst. as Amicus Curiae in Support of Petitioners at 2–3, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 2532843, at *2–3.

[104] Brief for the Int'l Publishers Ass'n et al. as Amicus Curiae in Support of Respondents at 4–5, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 3467247, at *4–5; Brief of

The Supreme Court will address whether section 514 of the URAA violates either of two constitutional provisions: the Copyright Clause or the First Amendment. The petitioners' brief also addresses the respondents' previous argument that Congress can avoid these constitutional provisions by invoking the Commerce Clause or its Treaty Power.[105] Respondents do not address this argument at length in their brief, but they explain in a footnote that if the Court finds section 514 to have violated the Copyright Clause, but not the First Amendment, it should remand the case to the court of appeals.[106] There, the lower court would determine whether another enumerated Congressional power could uphold section 514, an issue preserved by the government below.[107] In their reply brief, petitioners contend that respondents did not preserve this issue below, or if they did, that the questions can and should be resolved by the Court itself without remand.[108]

Focusing on the main issues, this Part elucidates each of the parties' arguments with respect to the Copyright Clause and, primarily, the First Amendment.

A. Whether Section 514 Violates the Copyright Clause.

As noted above, on this case's first appeal, the Tenth Circuit held that section 514 did not violate the Copyright Clause.[109] The next two opinions, by the district court and then the Tenth Circuit on the case's second appeal, focused on the First Amendment questions at stake.[110] Before the Supreme Court, petitioners again argue that section 514 violates the Copyright Clause; the government disagrees. The parties base their arguments on the Clause's text, the Framers' intentions, and consistent historical practice.

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the Int'l Coal. for Copyright Prot. as Amicus Curiae in Support of Respondents at 3, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2009 WL 3760476, at *3; Brief of The Am. Soc'y of Composers, Authors, and Publishers as Amicus Curiae in Support of Respondents at 3, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 3561885, at *3; Brief of Intellectual Prop. Owners Ass'n as Amicus Curiae in Support of Respondents at 2–3, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 3561889, at *2–3; Brief for the Motion Picture Ass'n of Am. as Amicus Curiae in Support of Respondents at 7–8 , Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 3561888, at *7–8; Brief of the Am. Bar Ass'n as Amicus Curiae in Support of Respondents at 4–5 , Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 3561887, at *4–5; Brief of Franklin Pierce Ctr. for Intellectual Prop. as Amicus Curiae in Support of Respondents at 2, Golan v. Holder, 609 F.3d 1076 (10th Cir. 2010) (No. 10-545), 2011 WL 3561883, at *2, 5; Brief of Am. Intellectual Prop. Law Ass'n as Amicus Curiae in Support of Respondents at 2–3, Golan v. Holder, , 609 F.3d 1076 (10th Cir. 2010) (No. 10-545).

[105] Pets. Br., *supra* note 96, at 62.

[106] Resps. Br., *supra* note 97, at 33 n.15.

[107] *Id.*

[108] Pets. Reply Br., *supra* note 98, at 22–23.

[109] *See supra* note 49 and accompanying text.

[110] *See supra* notes 57–94 and accompanying text.

1. Does the Text of the Copyright Clause Prohibit Removal of Works from the Public Domain?

Petitioners and respondents first squabble over the actual text of the Copyright Clause and whether it allows—or prohibits—removal of works from the public domain. As stated by the Court in its most recent seminal copyright case, *Eldred v. Ashcroft*,[111] the Constitution defines Congress's copyright power in its Copyright Clause: "Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[112]

Petitioners cite Supreme Court copyright cases that define the public domain based on this clause.[113] Most importantly for *Golan*, petitioners cite the Court's 1966 patent opinion in *Graham v. John Deere Co.*[114] which states, "Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available."[115] Petitioners conclude from this patent case that in copyright law as well, "[u]pon entering the public domain, a work must remain there."[116] Section 514, petitioners argue, violates this concept and "evaporated" the public's right to access these materials that had entered the public domain.[117] Respondents, on the other hand, acknowledge that the Copyright Clause imposes "various constraints" on Congress's authority, but they contend "[s]ection 514 is fully consistent with each of those limitations."[118] Respondents cast aside petitioners' textual restriction as "an additional, atextual limitation" created by and for the petitioners.[119]

Although the parties use the same definition of "limited [t]imes,"[120] they disagree on the definition's implications for section 514. Quoting *Eldred*, they both define "limited" as having the same meaning at the Framing as it has now: "'confine[d] within certain bounds,' 'restrain[ed],' or 'circumscribe[d].'"[121] According to petitioners, "[r]emoving works from the public domain violates the [Copyright Clause's] 'limited [t]imes' restriction by turning a fixed and predictable period into one that can be reset or resurrected at anytime, even after it expires."[122] When a work enters the public domain, petitioners argue that this "entry . . . must mark the end of protection, not an intermission. Otherwise, there is no way for members of the public to know if the limit has been reached, and no way to rely on it."[123] Petitioners

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[111] Eldred v. Ashcroft, 537 U.S. 186, (2003).

[112] *Id.* at 223 (Stevens, J., dissenting) (quoting U.S. CONST. art. I, § 8, cl. 8).

[113] Pets. Br., *supra* note 96, at 21–22 (citing Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 34 (2003); Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 165 (1989); Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, 237 (1964)).

[114] Graham v. John Deere Co., 383 U.S. 1 (1966).

[115] Pets. Br., *supra* note 96, at 22 (citing Graham v. John Deere Co., 383 U.S. 1, 6 (1966)).

[116] *Id.*

[117] *Id.* at 23.

[118] Resps. Br., *supra* note 97, at 13–14.

[119] *Id.* at 14.

[120] *See* Pets. Br., *supra* note 97, at 21; Resps. Br., *supra* note 98, at 15.

[121] Pets. Br., *supra* note 96, at 21 (quoting Eldred, 537 U.S. at 199); Resps. Br., *supra* note 97, at 14.

[122] *Id.* at 22.

[123] *Id.* at 23.

conclude that section 514's removal of works from the public domain "violated the plain and sensible meaning of the 'limited [t]imes' restriction."[124] Respondents, on the other hand, interpret the limitation as prohibiting Congress from granting *permanent* copyrights.[125] They find that section 514's restored copyrights are "'limited' in the relevant respect" simply because they have expiration dates.[126] In their reply brief, petitioners call respondents' expiration-date limit "illusory."[127] Under this limit, petitioners worry that "there is no way for the public to tell if the limit has been reached or rely on it," and that "nothing stops [the government] from reaching back hundreds of years" to remove more works from the public domain.[128] Thus, the two parties thus read the same terms—"limited [t]imes"—to reach two opposite results regarding section 514.

Similarly, the parties disagree on the import of the Copyright Clause's preamble, that "Congress shall have the Power . . . To promote the Progress of Science and useful Arts."[129] Respondents point out that petitioners cite no precedent holding that the preamble is "an independent limitation" on Congress's authority.[130] Still, petitioners argue that the preamble does limit Congress's copyright power.[131] Based on definitions from Framing-era dictionaries, petitioners define "progress" as having meant "the advancement of knowledge, as well as its spread,"[132] and they define "science" as having "referred to knowledge and learning."[133] Thus, they conclude that Congress's copyright legislation must promote "progress," defined as "the creation and spread of knowledge and learning."[134] Rather than encourage this artistic innovation, petitioners assert that section 514 "inhibits the spread of existing works, reduces the universe of material available to the public for further creation, and threatens to destroy the incentive to use even those works that remain unprotected."[135]

Respondents disagree, stating that if the preamble is a limitation, then section 514 promotes international progress as required by "today's global economy."[136] Respondents relate petitioners' argument to the argument rejected in *Eldred* that expansion of copyright law covering existing works serves no incentive purpose because the works have already been created.[137] *Eldred* recognized that Congress was not required to aim all copyright legislation at incentivizing the creation of new works, and that the United States' international leadership role required participation in "give-and-take" negotiations.[138] Here, respondents argue that section

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[124] *Id.* at 25.
[125] Resps. Br., *supra* note 97, at 13.
[126] *Id.* at 14–15.
[127] Pets. Reply Br., *supra* note 98, at 1.
[128] *Id.*
[129] U.S. CONST. art. I, § 8, cl. 8.
[130] Resps. Br., *supra* note 97, at 16.
[131] Pets. Br., *supra* note 96, at 21.
[132] *Id.*
[133] *Id.*; Arthur H. Seidel, *The Constitution and a Standard of Patentability*, 48 J. PAT. OFF. SOC'Y 5, 11–12 (1966).
[134] Pets. Br., *supra* note 96, at 21.
[135] *Id.* at 24.
[136] Resps. Br., *supra* note 97, at 17.
[137] *Id.* (citing Eldred v. Ashcroft, 537 U.S. 186, 214–17 (2003)).
[138] *Id.* (citing *Eldred*, 537 U.S. at 206).

514 promotes the country's international leadership efforts in negotiating copyright laws, thus promoting its overall progress.[139] Petitioners reply that respondents merely "insis[t] without explanation that copyright statutes promote 'progress' whenever they involved '"participation" in [the] international system.'"[140]

Thus, petitioners make a textual argument that section 514 violates the Copyright Clause, but respondents reply that this text does not restrain Congress from enacting section 514.

2. Did the Framers Intend to Create a Permanent and Stable Public Domain from Which Works Could Not Be Removed?

Petitioners next appeal to the originalists on the Court by turning to the Framers' intentions regarding the public domain.[141] Petitioners explain that the Framers were familiar with the potential perils of English monopolies, the equivalent of U.S. copyright and patent law.[142] Petitioners conclude from this history that the Founders and Framers recognized the importance of spreading knowledge, and that they enacted the Copyright Clause to "facilitat[e] the release of . . . works to the public"[143] in "a stable and permanent public domain."[144]

Respondents do not directly counter petitioners' originalist argument, but they mention the actions of certain Framers in their discussion of Congressional historical practice and what they interpret as its support for removal of works from the public domain.[145]

3. Does Historical Practice Confirm that Congress Cannot Restore Copyrights to Public Domain Works?

History always teaches, although its message may be unclear—and here, each party uses Congressional history to bolster its own argument. In *Eldred*, the Supreme Court held that Congress's "unbroken" historical practice affirmed its authorization to extend copyright terms.[146] Petitioners accordingly cite similarly "unbroken" Congressional practice of leaving works untouched in the public domain as confirmation of Congress's *lack* of authorization to copyright public domain works.[147] Respondents, however, interpret historical practice differently to affirm Congress's power to protect works already in the public domain.[148]

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[139] *Id.*
[140] Pets. Reply Br., *supra* note 98, at 3 (quoting Resps. Br., *supra* note 97, at 17).
[141] Pets. Br., *supra* note 96, at 25–30.
[142] *Id.* at 26.
[143] *Id.* at 14, 30.
[144] *Id.* at 25–26.
[145] Resps. Br., *supra* note 97, at 24–25.
[146] Pets. Br., *supra* note 96, at 31 (quoting Eldred v. Ashcroft, 537 U.S. 186, 200 (2003)).
[147] *Id.*
[148] Resps. Br., *supra* note 97, at 17–33.

The parties' first historical disagreement focuses on whether the public domain existed in 1790, when Congress enacted the first federal copyright law.[149] Petitioners explain that without federal copyright law, "the public domain of the United States" did not yet exist,[150] but respondents assert that the first federal copyright statute removed works from the existing public domain of the 1790s.[151] As petitioners acknowledge, copyright protection varied greatly under state law in 1790, leaving many works unprotected—and thus free for the public to exploit—in different states.[152] Respondents assert that this public freedom placed these works in the public domain until Congress's 1790 act copyrighted many of them.[153] Petitioners accuse respondents of "tr[ying] to rewrite history by misconstruing the first Copyright Act."[154] Citing language in this act, petitioners explain that "the 1790 Act explicitly *presupposes existing copyrights*," thus not applying to any works that were not already under copyright protection.[155]

Petitioners assert that over the next two hundred years, Congress did not remove works from the public domain in any of its nineteen amendments to the Copyright Act.[156] Respondents point to several separate, private patent and copyright bills, however, that removed individual works from the public domain.[157] Petitioners acknowledge "this trickle of private bills that ended in the nineteenth century,"[158] but note that they "[e]ach apparently reflected an isolated judgment by Congress" and that they do not compare with section 514's application to potentially millions of public domain works.[159] Further, petitioners note that the copyright bills do not appear to have been challenged in court.[160] Respondents concede this point, but assert the relevance of the "uniformly favorable judicial rulings" when the individual patent bills were challenged.[161] Petitioners respond to these patent rulings by again citing the Court's conclusion in *Graham* that Congress does not have plenary power to patent inventions in the public domain.[162]

Respondents also cite laws that applied beyond individual copyrights and patents. Congress excused failure to comply with certain formalities for patents in 1832 and copyrights in 1893, and it authorized copyright protection for foreign works

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[149] Pets. Br., *supra* note 96, at 31.

[150] *Id.*

[151] Resps. Br., *supra* note 97, at 18.

[152] *Id.* at 18–20.

[153] *Id.* at 21.

[154] Pets. Reply Br., *supra* note 98, at 5.

[155] *Id.* at 6.

[156] Pets. Br., *supra* note 96, at 31.

[157] Resps. Br., *supra* note 97, at 24 (citing An Act for the Relief of Levi H. Corson, ch. 57, 9 Stat. 763 (Feb. 19, 1849); An Act for the Relief of William Tod Helmuth, ch. 543, 18 Stat., pt. 3, at 618 (June 23, 1874); An Act for the Relief of Judson Jones, ch. 29, 30 Stat. 396 (Feb. 17, 1898); An Act for the Relief of Mistress Henry R. Schoolcraft, ch. 16, 11 Stat. 557 (Jan. 25, 1859); An Act for the Relief of Mrs. William L. Herndon, ch. 99, 14 Stat. 587 (May 24, 1866)).

[158] Pets. Reply Br., *supra* note 98, at 9.

[159] Pets. Br., *supra* note 96, at 40.

[160] *Id.*

[161] Resps. Br., *supra* note 97, at 25–26, 31.

[162] Pets. Br., *supra* note 96, at 40–41 (citing Graham v. John Deere Co., 383 U.S. 1, 6 (1966)).

in the public domain during World War I and II in 1919 and 1941.[163] The 1919 Act allowed reliance parties to retain all rights acquired prior to the Act, and the 1941 Act permitted continued exploitation of works by reliance parties for one year.[164] Although these statutes do not appear to have been challenged in court, respondents derive support from an analogous Supreme Court case, *McClurg v. Kingsland*,[165] concerning a similar patent statute.[166] Petitioners differentiate *McClurg*[167] and dismiss these wartime copyright laws because Congress did not premise these Acts on its Article I authority, the Acts were never challenged in court, and, at most, the Acts were mere exceptions in the "exigency of wartime."[168] Respondents argue that these explanations would not excuse Congressional exceptions "if petitioners' basic constitutional theory were correct" that historical precedent determines whether Congress can remove works from the public domain.[169] Petitioners maintain that these unchallenged, constitutionally questionable, wartime acts "merely suggest Congress may provide limited relief in the rare case in which it is factually impossible for an author or inventor to comply with statutory requirements . . . ."[170]

Lastly, respondents dispute that petitioners' citation of a judicially recognized "federal right to 'copy and use'"[171] public domain works is a "*constitutional* right or a restriction on the power of Congress."[172] Rather than containing an affirmative right, respondents define public domain works as "contingent on the scope of federal patent and copyright statutes" and thus subject to Congressional revision.[173] Respondents interpret the relevant cases as affirming that courts "should respect the various balances struck by Congress in its patent and copyright statutes."[174]

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In all, petitioners conclude that section 514 violates the Copyright Clause's specific limitations by removing works from the public domain.[175] Respondents instead argue that section 514 is a "rational means of achieving [Congress's goals]" and that it "easily satisfies [the applicable] deferential standard" of review.[176]

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[163] Resps. Br., *supra* note 97, at 26–27 (citing Act of July 3, 1832, ch. 162, § 3, 4 Stat. 559; Act of Mar. 3, 1893, ch. 215, 27 Stat. 743; Act of Dec. 18, 1919, ch. 11, 41 Stat. 368; Act of Sept. 25, 1941 (1941 Act), ch. 421, 55 Stat. 732).

[164] *Id.* at 27 (citing 1919 Act, 41 Stat. 369; 1941 Act, 55 Stat. 732).

[165] McClurg v. Kingsland, 42 U.S. 202 (1843).

[166] Resps. Br., *supra* note 97, at 28. In *McClurg*, the Court allowed the retroactive application of an 1839 patent law amendment to protect an invention that would have otherwise been void. *Id.* (citing *McClurg*, 42 U.S. at 206–09).

[167] Pets. Reply Br., *supra* note 98, at 12 ("[N]o party in that case challenged the constitutionality of any statute on any ground[,] . . . the patent at issue . . . was not in the public domain[,] . . . [and] the holding of *McClurg* is that defendants did not infringe because they had a license.").

[168] Pets. Br., *supra* note 96, at 39–40.

[169] Resps. Br., *supra* note 97, at 29.

[170] Pets. Reply Br., *supra* note 98, at 9.

[171] Resps. Br., *supra* note 97, at 32 (quoting Pets. Br., *supra* note 96, at 22) (emphasis in original).

[172] *Id.*

[173] *Id.*

[174] *Id.* at 32–33.

[175] Pets. Br., *supra* note 96, at 19.

[176] Resps. Br., *supra* note 97, at 33.

B. Whether Section 514 Violates the First Amendment.

Whereas petitioners' Copyright Clause argument was not accepted in the lower courts, petitioners achieved more success with their First Amendment argument. As noted above, the Tenth Circuit recognized on its first appeal that section 514 altered the "traditional contours of copyright" and thus was subject to heightened First Amendment scrutiny.[177] On remand, the district court held that section 514 burdened substantially more speech than necessary and thus failed this First Amendment review.[178] On its second appeal, however, the Tenth Circuit held that section 514 was subject to this level of scrutiny, but that it survived the review based on the government's interest in protecting the rights of U.S. authors abroad.[179]

Before the Supreme Court, both parties again agree that section 514 is a content-neutral statute and that it is subject to intermediate First Amendment scrutiny if it burdens speech rights.[180] Petitioners argue that section 514 is subject to and fails this intermediate scrutiny and that it is substantially overbroad. Respondents argue first that section 514 does not trigger heightened First Amendment review, and then that if such scrutiny is warranted, section 514 is narrowly tailored to further important governmental interests and thus it survives this review.

1. Is Section 514 Subject to First Amendment Scrutiny?

Petitioners assert that section 514 is subject to First Amendment scrutiny,[181] and respondents argue that heightened First Amendment scrutiny is not warranted.[182] In *Eldred*, the Court held that copyright law had "built-in free speech safeguards" that generally protect speech interests and remove any need for further First Amendment scrutiny unless Congress alters "the traditional contours of copyright protection."[183] Petitioners contend that section 514 does alter these contours "in a dramatic and unprecedented way."[184] Based on two hundred years of consistent historical practice, petitioners contend that Congressional revisions to copyright law have traditionally left the public domain intact.[185] Section 514 alters this historical practice by removing works from the public domain, making copyright law "unreliable and unpredictable," and imposing a "substantial chilling effect" on the intended uses of the public domain.[186] Thus, petitioners see the altered contours as earning heightened First Amendment review.

Respondents disagree with this premise. They contend that the Tenth Circuit, on its initial appeal, "misread" *Eldred* to mandate First Amendment scrutiny

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[177] *See supra* note 51 and accompanying text.
[178] *See supra* notes 57–75 and accompanying text.
[179] *See supra* notes 77–94 and accompanying text.
[180] Pets. Br., *supra* note 96, at 47; Resps. Br., *supra* note 97, at 42.
[181] Pets. Br., *supra* note 96, at 42–43.
[182] Resps. Br., *supra* note 97, at 35.
[183] Eldred v. Ashcroft, 537 U.S. 186, 221 (2003).
[184] Pets. Br., *supra* note 96, at 43.
[185] *Id.*
[186] *Id.* at 44.

whenever a copyright statute deviated from "any 'traditional contou[r]' or 'time-honored tradition' of copyright protection."[187] Respondents instead read these "traditional contours" within *Eldred*'s greater context, concluding that the relevant contours are "best understood" as the historic lines "between an author's exclusive rights" and the public's rights in a copyrighted work.[188] Specifically, the idea/expression dichotomy and the fair use doctrine are of "particular significance."[189] Section 514, respondents point out, does not alter either of these doctrines, and thus—like in *Eldred*—further First Amendment scrutiny is unnecessary.[190]

Regarding copyright law's "built-in free speech safeguards," the idea/expression dichotomy and the fair use doctrine, petitioners find them "plainly inadequate" to absolve section 514 from First Amendment scrutiny.[191] Prior to section 514, petitioners and the public "had the unrestricted right to perform, copy, teach and distribute the *entire* work, for any reason."[192] Whereas the idea/expression dichotomy and fair use doctrine permit certain types of restricted access to the works, "[p]laying a few bars of a Shostakovich symphony is no substitute for performing the entire work."[193] Petitioners explain that *Eldred* did not state or even suggest that there were only two applicable safeguards.[194] Further, petitioners argue that irrevocable entry into the public domain was not relevant to the facts in *Eldred*, and that the public domain actually has more historic and Framing-era significance than either of *Eldred*'s two safeguards.[195] Thus, because leaving the public domain intact is "a defining feature" and "an essential safeguard" of copyright law, petitioners assert that heightened First Amendment scrutiny must be applied.[196]

To disprove respondents' analogy of *Golan* to *Eldred*, and its attendant result, petitioners differentiate the speech interests at stake in each case.[197] On the one hand, in *Eldred*, the affected works had never entered the public domain, so the Court identified the speech interests as "no more than the right to make 'other people's speeches.'"[198] Under section 514, on the other hand, petitioners assert "the right to make the speeches that belonged to them and to the American public . . . ."[199] Petitioners further cite case law to assert that First Amendment rights "do not become less important" when they involve another's expression.[200]

Respondents disagree, stating that the "practical effect" of the challenged statutes in both *Eldred* and *Golan* "is to limit, for finite temporal periods, the use of a defined category of works of authorship that would have been subject to unrestricted public exploitation" without the statutes.[201] Unlike petitioners, respondents do not

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[187] Resps. Br., *supra* note 97, at 35.
[188] *Id.* at 37.
[189] *Id.*
[190] *Id.* at 37–38.
[191] Pets. Br., *supra* note 96, at 46.
[192] *Id.* at 46–47 (emphasis in original).
[193] *Id.* at 47.
[194] Pets. Reply Br., *supra* note 98, at 15.
[195] *Id.* at 16.
[196] Pets. Br., *supra* note 96, at 47.
[197] *Id.* at 44–45.
[198] *Id.* at 44 (quoting Eldred v. Ashcroft, 537 U.S. 186, 221 (2003)).
[199] *Id.*
[200] *Id.* at 45–46.
[201] Resps. Br., *supra* note 97, at 38.

find meaningful the distinction that section 514 removes works that already rested in the public domain.[202] Petitioners contend that these interests are "vested and established public speech rights,"[203] but respondents note that section 514 avoids imposing retroactive liability, and that petitioners cite no case law supporting a "vested" right to prevent a restriction that otherwise survives First Amendment scrutiny.[204]

Further, respondents state that petitioners' claimed harm of diminishment of investment value is not a sufficient economic effect to constitute a constitutional violation.[205] Even if section 514 disappointed petitioners investment-backed expectations, respondents argue that no Supreme Court precedent "suggest[s] that [this] disappointment . . . can raise First Amendment concerns simply because the relevant investments pertain to expressive activities."[206] Respondents explain that this economic diminishment would "more naturally" premise a claim under the Due Process clause—abandoned by the petitioners in the lower court—or the Just Compensation Clause—not asserted by petitioners.[207] In a footnote, respondents recognize that copyright laws that violate "some independent First Amendment prohibition"—such as those premised on an author's viewpoint—would raise "[d]ifferent constitutional issues."[208] Respondents also acknowledge that "the restrictions traditionally associated with copyright law could not constitutionally be imposed on a viewpoint-discriminatory basis."[209] But respondents assert that "nothing of that sort is at issue here."[210]

Respondents also argue that, on its first appeal, the Tenth Circuit "misread the historical record" to find that section 514 was not consistent with the "traditional contours" of copyright law.[211] Respondents warn that this reading places "a broad range" of previous copyright law revisions under heightened First Amendment scrutiny each time Congress departed from prior copyright practice, including the extensions of protection to sound recordings and architectural works.[212] Respondents also caution that this interpretation would "substantially undermin[e]" judicial deference to Congress on copyright legislation.[213] Nevertheless, respondents refer to their earlier historical analysis[214] to state that section 514 is consistent with the

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[202] *Id.*

[203] Pets. Br., *supra* note 96, at 45 (citing Jane C. Ginsburg et al., *The Constitutionality of Copyright Term Extension: How Long is Too Long?*, 18 CARDOZO ARTS & ENT. L.J. 651, 701–02 (2000) ("[T]here is a First Amendment right to publish freely works that are in the public domain.")).

[204] Resps. Br., *supra* note 97, at 38–39.

[205] *Id.* at 39 (citing Lucas v. S.C. Coastal Council, 505 U.S. 1003, 1027–28 (1992)).

[206] *Id.*

[207] *Id.*

[208] *Id.* at 39 n.17.

[209] *Id.*

[210] *Id.*

[211] *Id.* at 35.

[212] *Id.* at 40 (citing Copyright Act of Oct. 15, 1971, Pub. L. No. 92-140, 85 Stat. 391 (17 U.S.C. § 102(a)(7) (2006)); Architectural Works Copyright Protection Act, Pub. L. No. 101-650, 104 Stat. 5133 (17 U.S.C. § 102(a)(8) (2006))).

[213] *Id.*

[214] *See supra* text accompanying notes 168–212.

"frequen[t]" Congressional practice of removing works from the public domain, beginning with its first copyright law in 1790.[215]

Lastly, respondents describe the applicability of "[t]he same two First Amendment 'supplements' on which the Court relied in *Eldred*."[216] These 'supplements' established that copyright law exemptions apply to certain uses of copyrighted works by institutions such as libraries and small businesses.[217] Respondents point to the URAA's "additional accommodation," such as its provisions for reliance parties.[218] Respondents mention that copyright holders sent "fewer than 50,000" notices of their intent to enforce, and that reliance parties who did not receive notices may continue exploitation of the works.[219] Respondents' statistic counts only notices sent to the Copyright Office, and ignores the potentially millions of notices that were or will be sent directly to reliance parties, as the URAA permits.[220]

Thus, petitioners agree with the lower *Golan* opinions that intermediate scrutiny should apply to section 514, whereas respondents argue that this heightened level of scrutiny should not apply.

2. Does Section 514 Survive Heightened First Amendment Scrutiny?

Petitioners explain that section 514 fails heightened First Amendment scrutiny, and thus that section 514 violates the First Amendment. Respondents, however, assert three potential justifications for section 514: Berne Convention compliance, promoting U.S. authors abroad, and remedying prior inequities for foreign authors. This Part examines each of the respondents' justifications in turn, coupled with the petitioners' arguments against them.

a. Does the Government's Interest in Complying with the Berne Convention Justify Section 514?

The parties first dispute whether the government's interest in complying with the Berne Convention justifies section 514. Petitioners argue that the government cannot justify section 514 based on its interest incompliance with the Berne Convention,[221] but respondents assert that section 514 is narrowly tailored to achieve this goal.[222] Petitioners argue that the government did not assert the "substantial evidence of real harm" from apparent noncompliance required to justify its burden on speech.[223] Before enacting section 514, the United States had already secured

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[215] Resps. Br., *supra* note 97, at 40.
[216] *Id.* (citing Eldred v. Ashcroft, 537 U.S. 186, 220 (2003)).
[217] *Id.* at 40–41 (citing 17 U.S.C. §§ 108(h), 110(5)(B) (2006)).
[218] *Id.* at 41.
[219] *Id.* at 41–42.
[220] *See supra* text accompanying note 28.
[221] Pets. Br., *supra* note 96, at 51.
[222] Resps. Br., *supra* note 97, at 53–54.
[223] Pets. Br., *supra* note 96, at 53.

protection for its authors by joining the Berne Convention.[224] In 1988, Congress concluded that it did not need to remove works from the public domain to comply with the Berne Convention, and that the United States was in compliance with the Berne Convention.[225]

Respondents claim that, in 1994, "Congress and the Executive Branch revisited implementation of Article 18, and Congress enacted [s]ection 514 of the URAA."[226] Petitioners dispute this fact, explaining that "[t]he URAA was drafted by the [U.S. Trade Representative] and sent to Congress under a fast track procedure that precluded amendment."[227] The Office of the United States Trade Representative confirmed that "restoration was discretionary,"[228] and "Congress did not revisit any of the findings it made in 1988," or make any findings that the Berne Convention or TRIPS compliance required enactment of section 514.[229] If the lack of restoration did cause any noncompliance, "the only apparent consequence" was that a few Berne Convention member countries, such as Thailand and Russia, "had apparently declined to restore copyright protection to U.S. works" in their public domains.[230] According to the petitioners, any U.S. interest in "creating economic windfalls" for American authors in these few countries is not a legitimate, or important enough, interest to justify section 514's burden on speech.[231]

Responding to this argument, respondents first state that the Berne Convention's restoration requirements are not in dispute in that they technically require restoration of foreign works.[232] The government may have an important interest, they argue, in avoiding harms such as not experiencing the "full benefits" of Berne Convention membership unless its "international partners" recognize U.S. compliance,[233] maintaining the United States' "international credibility," and reducing the chance that other countries would challenge its Article 18 implementation under the WTO dispute settlement mechanism and with potential trade sanctions.[234] Respondents cite the Executive Branch's advice to Congress that a WTO challenge was "likely."[235] Petitioners question the importance of avoiding WTO challenges, considering that the United States has lost at least thirty-seven of its 128 or more formal disputes before the WTO, and that it has done nothing in response to a ten-year-old WTO ruling that another U.S. copyright law violates TRIPS.[236]

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[224] *Id.* at 52.
[225] *Id.*
[226] Resps. Br., *supra* note 97, at 46.
[227] Pets. Reply Br., *supra* note 98, at 17.
[228] Pets. Br., *supra* note 96 at 52–53 (citing *Joint House and S. Comm. Hearings on the URAA*, 103d Cong. 2 (1994) (statement of Chairman William J. Hughes)).
[229] Pets. Reply Br., *supra* note 98, at 17–18.
[230] Pets. Br., *supra* note 96, at 53.
[231] *Id.*
[232] Resps. Br., *supra* note 97, at 43.
[233] *Id.* at 44.
[234] *Id.*
[235] *Id.* at 45 (citing *General Agreement on Tariffs and Trade (GATT): Intellectual Property Provisions: Joint Hearing Before Subcomms. of the H. & S. Comms. on the Judiciary,* 103d Cong. 137 (1994) (statement of Ira S. Shapiro, Gen. Counsel, Office of the U.S. Trade Representative (USTR))).
[236] Pets. Reply Br., *supra* note 98, at 19.

If respondents are correct that the United States was not in compliance with the Berne Convention, petitioners argue that section 514 is still not narrowly tailored to the goal of compliance because it could have burdened "substantially less speech" while achieving compliance.[237] Petitioners describe the government's three potentially less-restrictive means in turn: special negotiations, more protection for reliance parties, or allowing application of the rule of the shorter term or first sale rights.

First, petitioners argue that the United States could have achieved full compliance by negotiating the "special conventions" permitted by the Berne Convention to modify its restoration provisions.[238] Under these conventions, the United States could have negotiated the modification or elimination of restoration provisions "to accommodate the unique position of the United States relative to any other Berne Convention signatory" based on the United States Constitution and the size and scope of the U.S. public domain.[239] Respondents, however, doubt the practicality and success of entering into "extremely arduous" negotiations with "each of the more than 160 Berne Convention or WTO members."[240] Further, respondents argue that these negotiations would have conflicted with the government's interests in U.S. authors abroad and in the equitable treatment of foreign authors.[241]

Second, petitioners argue that section 514's "weak and temporary protection for reliance parties" was not narrowly tailored to an interest in Berne Convention compliance.[242] The Berne Convention gave parties "broad discretion" to determine protection for reliance parties, and petitioners explain that "[t]here is nothing in its text that prohibits reliance interests from being protected completely and permanently," or from receiving "permanent freedom to do as they wish with any copy or recording that was lawfully made prior to section 514."[243] In fact, the district court on remand had invalidated section 514 because "the government could have provided complete and permanent protection for reliance parties like petitioners under the express terms of the Berne Convention."[244] Respondents disagree, contending that this "full and permanent" protection would not have achieved "actual and perceived compliance with the Berne Convention," and that it may have been challenged in a WTO proceeding.[245] This risk was too high, respondents explain, and the United States has a "substantial interest in avoiding the appearance of an international-law violation" that could affect its international credibility and status as a "trusted partner."[246]

Third, petitioners contend that the United States could have provided shorter protection terms or more protection for existing copies of restored works.[247] First, under the Berne Convention's rule of the shorter term, the United States could have

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[237] Pets. Br., *supra* note 96, at 54.
[238] *Id.* (citing Berne Convention, *supra* note 22, art. 18(3)).
[239] *Id.* at 55.
[240] Pets. Reply Br., *supra* note 98, at 46.
[241] *See id.*
[242] Pets. Br., *supra* note 96, at 59.
[243] *Id.* at 56–58.
[244] *Id.* at 58.
[245] Resps. Br., *supra* note 97, at 47–48.
[246] *Id.* at 48.
[247] Pets. Br., *supra* note 96, at 59–60.

restored protection for foreign works only until their terms expired in their countries of origin.[248] Instead, section 514 restores these works to the full term of U.S. protection, often "result[ing] in years of unnecessary protection . . . ."[249] Additionally, the Berne Convention would have allowed the United States to protect first sale rights.[250] For over a century, the United States has recognized first sale rights, "generally permit[ting] the owner of any lawfully made copy to sell or otherwise dispose of that copy without the permission of the copyright owner."[251] section 514 does not allow first sale rights beyond a one-year grace period, thus burdening rights more than required for compliance with the Berne Convention.[252]

Because these arguments were not raised below, respondents ask the Court not to consider the rule of the shorter term or first sale rights.[253] Petitioners argue against this waiver because they have maintained a consistent argument against narrow tailoring throughout the litigation, and "in any event" the burden of proving narrow tailoring is on respondents.[254] Respondents further argue that once the Court establishes Congress's authority to restore these copyrights, the "appropriate *period* of protection is subject only to rational-basis review."[255] They further state that petitioners' entire "less-restrictive-alternative analysis . . . has never been a part of the inquiry into the validity of content-neutral regulations on speech."[256]

In all, respondents present Berne Comvention compliance as a sufficient governmental interest to justify section 514's restriction on speech. Petitioners disagree, arguing that respondents did not assert enough evidence of harm to make this a legitimate government interest. Petitioners further point to three less-restrictive alternatives that the government could have pursued, but respondents dispute both the alternatives and their relevance.

b. Does the Government's Interest in Promoting the Rights of United States Authors Abroad Justify Section 514?

The parties next dispute whether the government's interest in promoting the rights of U.S. authors abroad justifies section 514's restriction on speech. The Tenth Circuit addressed only this interest on appeal, and found it to be a valid justification of section 514. Petitioners contend that the United States does not have an important—or "even a legitimate"—interest in promoting the rights of U.S. authors abroad.[257] In petitioners' view, Congress "g[ave] away vested public speech rights on the bare possibility that it might someday create private economic benefits for U.S.

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[248] *Id.* (citing Berne Convention, *supra* note 22, art. 7(8)).

[249] Pets. Br., *supra* note 96, at 60.

[250] *Id.*

[251] *Id.* (citing 17 U.S.C. § 109(a) (2006)).

[252] *Id.* at 60–61.

[253] Resps. Br. *supra* note 97, at 48 (citing Grupo Mexicano de Desarrollo, S.A. v. Alliance Bond Fund, Inc., 527 U.S. 308, 318 n.3 (1999)).

[254] Pets. Reply Br., *supra* note 98, at 19 n.3.

[255] Resps. Br., *supra* note 97, at 49 (citing Eldred v. Ashcroft, 537 U.S. 186, 204–05 (2003)).

[256] *Id.* (citation omitted) (quoting Turner Broad. Sys., Inc. v. FCC, 520 U.S. 180, 217 (1997)) (internal quotation marks omitted); Ward v. Rock Against Racism, 491 U.S. 781, 798 (1989)).

[257] Pets. Br., *supra* note 96, at 49.

authors."[258] Respondents object to petitioners' portrayal of this protection as "windfalls," instead defining it as "a (belated) opportunity to receive a reasonable return on their creative investment."[259] In fact, respondents accuse petitioners and other reliance parties of receiving a "windfall" in their pre-URAA exploitation of foreign works by Russian composers who were never compensated for these uses within the United States.[260] Respondents assert that the government's interest in these authors is part of copyright law's recognized purpose of "[r]ewarding authors for their creative labor."[261] Accordingly, section 514 creates economic incentives for foreign authors, whose works benefit Americans, and for American authors, who require "effective protections abroad" in "today's global economy."[262]

Petitioners dispute the certainty of *any* benefit to U.S. authors, arguing that Congress had only "guesses" and "a general hope that a few foreign nations may one day provide reciprocal protection . . . ."[263] Petitioners contend that this "abstract and unsubstantiated hope" does not provide the required "substantial evidence" for Congress's predictive judgment.[264] Respondents, however, contend that Congress had "clear, substantial evidence" that the foreign restoration of U.S. works was "directly tied" to the U.S. government's own restoration of foreign works.[265] This prediction, respondents argue, "proved correct" when Russia restored copyrights for U.S. authors sometime after section 514 was enacted.[266] Petitioner asserts that respondents can point out "exactly one country (Russia)" and that its reciprocal restoration "did not happen until 2004."[267] Interestingly enough, this occurred three years after Golan filed suit,[268] and ten years after the URAA's enactment.[269] Respondents further state that this foreign demand for reciprocity included "the scope and extent" of restored rights.[270] Respondents explain that Congress's "predictions accord with common sense," and that "Congress has broad latitude to make such predictive judgments, particularly in the realm of foreign affairs . . . ."[271] Petitioners maintain that "the government . . . does not attempt to explain why it has any proper interest in giving away public speech rights to create private economic benefits."[272] Thus, the parties dispute whether section 514 promotes U.S. authors' rights, and whether any such promotion justifies section 514.

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[258] *Id.* at 49–50.
[259] Resps. Br., *supra* note 97, at 49.
[260] *Id.* at 50.
[261] *Id.* (quoting Eldred v. Ashcroft, 537 U.S. 186, 212 n.18 (2003)).
[262] *Id.*
[263] Pets. Br., *supra* note 96, at 50.
[264] *Id.* at 51.
[265] Resps. Br., *supra* note 97, at 51.
[266] *Id.*
[267] Pets. Reply Br., *supra* note 98, at 20–21.
[268] *See supra* note 36 and accompanying text.
[269] *See supra* note 23 and accompanying text.
[270] Resps. Br., *supra* note 97, at 52.
[271] *Id.* at 53.
[272] Pets. Reply Br., *supra* note 98, at 21.

c. Does the Government's Interest in Remedying Prior Inequalities of Treatment of Foreign Authors Justify Section 514?

Lastly, respondents contend that section 514 furthers the government's important interest in "remedying prior inequalities of treatment between American and foreign authors."[273] Certain works had entered the public domain because their foreign authors did not comply with copyright formalities that did not exist in their countries, and that Congress later repealed.[274] Respondents explain that section 514 "alleviate[s] those prior disparities."[275] Petitioners contend that section 514 instead "creates inequity where none existed" because U.S. authors who similarly failed to comply with formalities during this time do not receive restoration under section 514.[276] The parties thus disagree on whether the United States has a valid remedial interest which justifies section 514.

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In their briefs before the Court, the parties differ sharply in their interpretations of constitutional text, Congressional history and practice, international obligations, and governmental interests. They ultimately argue for and against the constitutionality of section 514 under both the Copyright Clause and the First Amendment.

IV. *GOLAN* IN THE COURT: AN APPRAISAL OF THE ISSUES

As we have seen, the Court might plausibly consider four issues in *Golan*.[277] Does restoration of copyright in works that have been in the public domain violate the Copyright Clause? Assuming that to be so as a general proposition, is the specific restoration of foreign works (as allowed by section 514 of the URAA) permitted nevertheless? Does the Treaty Power additionally or separately enable Congress to authorize such restoration? And finally, does the restoration in this case violate the First Amendment, whether in the particular circumstances occasioned by the URAA or more generally?

We will comment on the first three issues only briefly, mainly in order to anticipate our somewhat longer comment on the fourth. What the Court ultimately may do with any of these issues is an open question as we write, of course, but at least in our judgment there is no doubt that the role of the First Amendment ought to be seen as paramount among them. To put the matter bluntly, the Court's previous cases have dealt with the relationship between copyright and the First Amendment in a cavalier and barely coherent fashion. Copyright has been given primacy of place between them, while the First Amendment has been treated as if it were an inconvenient subject of merely secondary concern. *Golan* affords an opportunity to do a better job of reordering that relationship, against a background of more thoughtful

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[273] Resps. Br., *supra* note 97, at 54.

[274] *Id.* at 53–54.

[275] *Id.* at 54.

[276] Pets. Br., *supra* note 96, at 22.

[277] *See infra* Part IV.C. We are restating and reordering the issues somewhat in this portion of our essay, but without intending to affect them in substantive terms. As we will explain, the role of the Treaty Power does not actually appear to be at issue in the case.

and persuasive reasoning. With others who are following the case closely, we can hope that the Court will prove itself equal to that challenge.

But first things first.

A. The General Inviolability of the Public Domain

It seems unlikely that Congress can authorize a general restoration of copyright in works in which protection has vested and then run to its conclusion in due course. Copyright in the United States has long been thought to presuppose limited terms followed by permanent repose in the public domain as part of an essential bargain envisioned by the Framers and reflected in the Copyright Clause. Original works of authorship are given limited terms of protection in order "to promote the progress of science," a phrase in which "science" is taken to mean human knowledge and understanding, rather than technical know-how.[278] Copyright is justified as an incentive to produce such works; the public domain is the place to which every work of authorship must eventually be consigned in order to fulfill the terms of the bargain.[279] Congress generally has no power to set aside this bargain under that Clause.[280]

To be sure, no case confirms this proposition in quite such unequivocal terms.[281] But it has long been an article of faith, one amounting to common ground, among serious students of copyright. The oral argument in *Eldred* proceeded against what appeared to be a general concession to this effect from all quarters, including members of the Court who found occasion to address the proposition in passing, and whose comments left no reason to suppose they doubted it.[282] Still other recent cases

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[278] *See* Sen. Orrin G. Hatch & Thomas R. Lee, *To Promote the Progress of Science: The Copyright Clause and Congress's Power to Extend Copyrights*, 16 HARV. J.L. & TECH. 1, 7 (2002) (explaining that the notion of "science" during copyright's founding era generally meant all forms of learning and knowledge) (citing THOMAS SHERIDAN, A COMPLETE DICTIONARY OF THE ENGLISH LANGUAGE (5th ed. 1789)).

[279] *See* James H. Billington, Copyright, Electronic Works, And Federal Libraries: Maintaining Equilibrium, FED. LIBR. & INFO. CTR. COMM. (Mar. 10, 1999) *available at* http://www.loc.gov/flicc/forum99.html; *see also* Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 1023 (1990) (noting that the public domain contains "raw material" for the use of other authors).

[280] *See* EDWARD C. WALTERSCHEID, THE NATURE OF THE INTELLECTUAL PROPERTY CLAUSE: A STUDY IN HISTORICAL PERSPECTIVE 265-66 (William S. Hein & Co., Inc. 2002).

[281] *But cf.* Graham v. John Deere Co., 383 U.S. 1, 6 (1966) (explaining that "Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available"). Article I, section 8, clause 8 of the Constitution, which was the subject of the Court's observation in *Graham*, applies to copyright as well as patent law. There is no defensible reason to suppose that the public domain is or should be less secure in copyright than in patent law. Indeed, if there is any difference between them historically, then, as we will point out presently, the exact opposite is to be expected. *See infra* notes 333–335 and accompanying text.

[282] The question of restoration of works in the public domain after an expired term was not before the Court in *Eldred*, but it was addressed briefly and hypothetically during oral argument. Transcript of Oral Argument, at 21–22, Eldred v. Ashcroft, 537 U.S. 186 (2002) (No.01-0618). The government sought to leave the question open, but ultimately appeared to concede that there was a "bright line" between term extensions and restoration from the public domain. *Id.* at 29–30, 44. The

have treated the passage of works into the public domain as an all-but-inviolable assurance of their availability to anyone who may care to make use of them.[283] Nothing in *Golan* is really at odds with a general proposition that works in the public domain are ordinarily beyond the protection of copyright under a conventional understanding of the Copyright Clause. We think it likely that the Court will concur in this essential understanding.

B. Restoration of Public Domain Works under the URAA and the Copyright Clause

It does not necessarily follow from the general inviolability of the public domain that the "restoration" to copyright protection of works like those covered by section 514 is forbidden by the Copyright Clause. To be sure, such restoration cannot be said to be included among the powers granted to Congress in any explicit sense. It is doubtful the Framers themselves would have expected it. There is nothing even remotely conventional about it: restoration of this sort falls well outside the "traditional contours" of copyright. And yet Congress surely is not to be seen as enmeshed forever in the uses of the past, no more so in the context of copyright than in some other setting altogether. Article I of the Constitution imposes any number of limits on Congressional action, including limits on the general restoration to protection of public domain works; but whether the Copyright Clause limits the action taken in the context of restoration under the URAA remains a more subtle question.

Restoration in these very particular circumstances might be seen (more or less as the government has argued) as an essentially procedural step taken to limit the untoward or inequitable effects of erstwhile formal requirements now judged to have been unnecessary or unjustified as applied to a limited class of works. Whether that is so is debatable. But the petitioners are surely right to argue in response that one historic pattern of legislative unfairness does not justify another one now. The new Act might have been tailored in a different way, particularly so as to exempt "reliance parties" from its detrimental strictures. Reliance parties might have been given the right, for example, to continue to exploit these works in such fashion as they had already undertaken to do, essentially as the creators of derivative works are

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Justices who entertained hypotheticals involving restoration (Justices Stevens, Breyer, and Souter) did not suggest that they thought such action would be constitutional. *Id.* at 38. The petitioners stated early on that work could not be withdrawn from the public domain after the expiration of an applicable term, even if the term might be extended while the copyright still subsisted. *Id.* at 43–48. The Court's eventual opinion appeared to reflect this understanding. *See* Eldred v. Ashcroft, 537 U.S. 186, 234 (2002) ("The Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose . . . *Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available*.") (quoting Graham v. John Deere, 383 U.S. 1, 5–6 (1966)) (internal quotation marks omitted)).

[283] *See* TrafFix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 29 (2001); *see also* Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 33–34 (2003) (explaining that once a patentee or copyright holder's monopoly has expired, the public has the right to use the work at will without attribution to the original creator).

given the right to continue the exploitation of their works after the exercise of termination rights.[284]

We do not presume to rewrite the Act. Nor do we mean to endorse restoration even in less objectionable circumstances. We intend merely to acknowledge in passing the greater resulting plausibility of an argument in support of such restoration, as against the countervailing weight of the Copyright Clause, were restoration to be carefully tailored so as to work at least no immediate harm to persons who had acted in reliance on the public domain. The important point here is that Congress could have provided for restoration, well within the requirements of the Berne Convention, without necessarily having substituted one form of inequity for another. It might well have done so, but it did not clearly do so.

Given the uncertain consequences of restoration as it is actually configured in the legislation, the result seems plainly at odds with the essential purpose and function of the public domain.[285] As the Court itself has acknowledged in at least two recent cases, the public domain is meant to enable secure reliance on the availability of the works residing there for such uses as those who encounter them may choose to make.[286] The petitioners could not sensibly have been expected to suppose otherwise. They have obviously been harmed by the legislation that figures in this case: the licensing scheme woven into the URAA legislation does not secure them against the threat of ruinous expenses and transaction costs.[287] In these circumstances

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[284] *See* 17 U.S.C. §§ 203(b)(1), 304(a)(4)(A) (2006); *see also* notes 22–32, 236–255 and accompanying text, which addresses the following observations. As to the essential terms and conditions of continuing exploitation, proprietors of post-termination derivative works remain in the position they were in prior to termination. In contrast, proprietors of post-restoration derivative works arguably must negotiate new license fees or else face litigation in a federal court into whose judgment the question of a "reasonable" fee is consigned. The effect is to throw reliance parties into a position of uncertainty as to the viability of continued exploitation of derivative works under the URAA; *see* Email from Eric Schwartz, Attorney at Mitchell Silberberg & Knupp L.L.P., and Acting General Counsel at the U.S. Copyright Office at the time of the drafting of the URAA, to author, Oct. 3, 2011 (on file with author) (noting that the then-Acting Copyright Register herself drafted the reliance party exceptions). The exceptions: (a) included the certain and unambiguous right of the user to continue to exploit the derivative work for the remainder of copyright after restoration, pursuant to section 104A(d)(3), subject only to (b) a "reasonable" compensation, which might be in some instances de minimis (i.e., $1). *Id.; see* Irwin Karp, Final Report, *Berne Article 18 Study on Retroactive United States Copyright Protection for Berne and Other Works*, 20 COLUM.-VLA J.L. & ARTS 157, 241 (discussing the limited requirements of the Berne Convention, and the numerous ways in which Congress might have secured reliance parties against the adverse effects of restoration).

[285] No party to the case disputes that petitioners will be harmed. The Tenth Circuit accepted it as a given that some restriction on the petitioners' rights would follow from the legislative scheme enacted pursuant to the URAA. *See* Golan v. Holder, 609 F.3d 1076, 1086 (10th Cir. 2010).

[286] *See, e.g.,* TrafFix, 532 U.S. at 29 (stating "[t]rade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products"); *see also* Dastar, 539 U.S. at 24 (explaining that Dastar took a creative work that was within the public domain, copied it, made a few minor changes, and then produced its own set of videotapes based on the original).

[287] *See supra* notes 30–32 and accompanying text. The legislation enables restoration proprietors to demand fees for licenses without any explicit limit on those demands. If agreement is not reached as to the amount of a disputed fee, then the matter is remitted to the jurisdiction of a federal court for a decision as to a "reasonable" amount, with litigation likely to follow.

restoration appears to be deeply and fundamentally at odds with both the purpose of the public domain and of the Copyright Clause itself.[288]

C. The Role of the Treaty Power

The petitioners in *Golan* plainly anticipated reliance by the government on the Treaty Power conferred on Congress under Article I, and briefed the issue accordingly.[289] As we have said in our summary of the parties' positions, however, the government has not addressed the issue at length, and in fact has asked that any ruling on this issue take place in a lower court.[290] We can expect that the Court will not take up the question either. Though the matter now appears to be less pressing, we think it still deserves some passing attention in our comments.

Does the Treaty Clause authorize Congress to do what the Copyright Clause does not? Or to sharpen the question, can Congress rely on its Treaty Power to act against an affirmative constraint implicit in the Copyright Clause? To this latter inquiry we think the answer must be, decisively, No.

Again, no case in the Supreme Court has addressed this question directly. In *The Trade-Mark Cases*[291] in 1879 the Court did reserve its opinion as to whether the Treaty Power might serve as a source of jurisdiction in enacting trademark legislation that the Copyright Clause did not support.[292] But the Copyright Clause did not affirmatively forbid trademark legislation; it merely established certain prerequisites to enactment (namely, originality) that trademark law did not meet.[293] Trademark law itself was not seen as conflicting with copyright in any inherent or fundamental way. Indeed, had the Commerce Clause otherwise been available, the Court appeared to suppose (without actually deciding) that the two systems of law (copyright and trademark) might have proceeded on separate jurisdictional grounds.[294]

In the event, the Commerce Clause was not available under the restricted interpretation that governed it in the late nineteenth century. Meanwhile, no treaty was involved in *The Trademark Cases* at all. The Court appeared merely to happen upon the Treaty Clause as it rummaged among the provisions of the Constitution for other suitable sources of jurisdiction. In the end, then, the Court went no further than to acknowledge the unexamined possibility of alternative sources of jurisdiction under multiple clauses in a case involving no direct conflict arising from one clause as against another. There is nothing at all remarkable in that scenario. Today, the

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[288] *See* Graham v. John Deere Co., 383 U.S. 1, 6 (1966) ("Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system . . . . This is the standard expressed in the Constitution and it may not be ignored.").

[289] Pets. Br., *supra* note 96, at 62.

[290] *Supra* notes 100–108 and accompanying text.

[291] In re The Trade-Mark Cases, 100 U.S. 82 (1879).

[292] *Id.* at 99.

[293] *Id.* at 93–94.

[294] *See id.* at 95 ("The question, therefore, whether the trade-mark bears such a relation to commerce in general terms as to bring it within congressional control, when used or applied to the classes of commerce which fall within that control, is one which, in the present case, we propose to leave undecided.").

Commerce Clause is given an expanded reading that generally accommodates trademark law, ordinarily without conflicting with the Copyright Clause at all.[295] The Treaty Power meanwhile has remained essentially unexamined in this context.

In a case like *Golan*, however, the circumstances might be thought to present just such a conflict. As we have seen, the URAA provisions reflected in sections 514 affront the Copyright Clause in a fundamental way by limiting secure reliance on the public domain. But the Treaty Power does not justify this affront explicitly, and cannot sensibly be said to do so by implication. As a preliminary matter, we should remember that general provisions in law ordinarily are not to be given precedence over more specific limitations. This is as true in constitutional interpretation as it is in other settings.[296] It is especially so when Congress has not been thrust upon the horns of a dilemma—as it has not been in this case.

Again, the Berne Convention did not oblige Congress to enact the URAA with its attendant strictures upon the legitimate expectations of reliance parties vis-à-vis the public domain, and its resulting conflict with the Copyright Clause. No treaty obligation lurked in the background of this affair. The Berne Convention imposed no particular obligation to act one way or another. This was entirely a matter of overreaching and misjudgment on the part of Congress, urged on by the Executive Branch. It would amount to a notable species of chutzpah to defend it now by turning to the Treaty Power for authority to do what the Copyright Clause forbids. In the end there is no greater reason to rely on the Treaty Power in a case like *Golan* than there was in *The Trademark Cases*. In our judgment, the government was quite correct to make no issue of the matter here.

D. Summing-Up, Ad Interim

Neither the Copyright Clause nor the Treaty Power can sensibly be said to justify the scheme adopted by Congress for restoring copyright to foreign works that had previously entered the public domain.

Congress itself has not generally thought it has the power to restore public domain works to copyright protection. The restoration of foreign works provided for by the URAA cannot be defended as an exercise in fairness for foreign proprietors, given the plainly unfair consequences for reliance parties who may now face hardship and even ruin as the public domain status they counted on is swept away. Whether generally or in more particular circumstances, Congress cannot strip works in the public domain of their status in violation of the assurance of availability that status is meant by the Copyright Clause to secure.

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[295] In both *TrafFix* and *Dastar*, for example, no question was raised as to the general authority of Congress to enact trademark legislation pursuant to the Commerce Clause. That authority have been acknowledged at least since the enactment of The Lanham Act of 1946. *See generally*, David L. Lange, *The Lanham Act After Fifty Years*, 59 L. & CONTEMP. PROBS. 1, 1–3 (1996) (prefacing the historical evolution of trademark law as noted in a symposium by leading authorities on the subject).

[296] *See* David L. Lange, *The Intellectual Property Clause in Contemporary Trademark Law: An Appreciation of Two Recent Essays and Some Thoughts About Why We Ought to Care*, 59 L. & CONTEMP. PROBS. 213, 224–29 (1996).

The Treaty Power does not confer the authority to do what Congress has done in this case either. No treaty obligation is involved in *Golan*, and certainly none that requires or justifies the results envisioned by the URAA. Reliance on the Treaty Power would have been a red herring, and nothing more.

What remains meanwhile is the question—or, really, the array of questions occasioned by the role of the First Amendment vis-à-vis copyright. These were the questions that the Tenth Circuit quite rightly recognized in this setting two years ago. That Circuit's ultimate decision in the case was misjudged, or so we think, but the issues themselves remain alive and well. We turn to them now in the final portion of our comments.

V. COPYRIGHT AND THE FIRST AMENDMENT

How should we understand the relationship between copyright and the First Amendment? No case before the Court has considered this question in a serious, measured, contemplative or plenary fashion. Thus the pleadings, lower court opinions and briefs in *Golan* to this date all reflect responses that are in their nature tentative and inadequate, and often at odds with the real nature of the controversy. We will acknowledge these responses, but in our observations here we will also advance an understanding of the subject that we think offers a better appreciation of the absolute primacy of the Amendment in its on-going relationship with copyright.[297]

A. Twice-Told Tales[298]

No one who knows copyright doubts seriously that it abridges expression. Its very purpose is to abridge some expression in order to encourage other expression, all according to an elaborate system of exclusive rights and limitations established by Congress. Copyright may or may not offer important incentives to the expression it protects. Proponents say it does; skeptics question whether that is so. It does so in any event, if it does so at all, by abridging expression that it judges inconsistent with

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[297] Much of the discussion acknowledges and reflects an understanding of the appropriate relationship between copyright and the First Amendment developed by Professors David Lange and Jefferson Powell in their recent book, *No Law: Intellectual Property in the Image of an Absolute First Amendment*. *See* DAVID L. LANGE & H. JEFFERSON POWELL, NO LAW: INTELLECTUAL PROPERTY IN THE IMAGE OF AN ABSOLUTE FIRST AMENDMENT (Stanford University Press 2009). This work is extensively researched; we count on our readers to avail themselves of that research. We assume readers will also understand that Professor Lange is among the co-authors of both the book and this essay. (Professor Powell, who is currently on leave from the George Washington University School of Law to serve in a senior position on the staff of the Department of Justice, has played no role in the development of this essay).

[298] The origins of the Court's current approach to copyright and the First Amendment has been recounted numerous times. *See, e.g.*, LANGE & POWELL, *supra* note 297, at 108–46. Much of the treatment in their work acknowledges and reflects a conventional understanding of the subject, often amounting to common ground. Their ultimate approach to the subject, however, is considerably less conventional.

the incentives, such as they may be. That is the nature of copyright. Judging and abridging expression are among its central functions.

The government emphatically agrees with us as to this critically important point:

> The Copyright Clause differs from other Article I provisions . . . in that the very purpose of copyright protection is to limit the manner in which expressive works may be used. The imposition of some restrictions on expressive activity is therefore the intended and inherent effect of *every* grant of copyright.[299]

Surely, then, copyright must inevitably contravene the First Amendment in an important and inescapable way. How could that not be so?

Some forty years ago Professor Melville Nimmer published an essay in which he himself asked whether, for this very reason, copyright must also therefore violate the First Amendment.[300] A distinguished scholar of both copyright and the First Amendment, Nimmer seemed superbly suited to the inquiry he proposed. The Amendment says, among other things, that "Congress shall make no law . . . abridging freedom of speech, or of the press."[301] Surely, he reasoned in a powerful introduction to his essay, a system like copyright must be at odds with the meaning plainly evident in this language. Taking the language at face value, as he understood Justice Black would do, Nimmer argued that the Amendment is clearly inconsistent with the exclusive rights in expression that copyright allows.[302] Indeed, or so one might easily imagine upon still further reflection, the more important the reasons for granting exclusive rights in expression may be, the more important the violation of the First Amendment's absolute proscription also must become.

In fact, however, Nimmer's introduction was a cunning exercise in devil's advocacy. Justice Black's absolutism ("no law means no law, and no ifs, ands, buts or whereases")[303] had been dismissed by nearly everyone with a professional interest in the First Amendment, including every member of the Court except Justice Douglas. Nimmer himself did not accept the language of the Amendment as an absolute. Instead, like many other students of the Amendment then and now, he counted himself a disciple of an approach that sought to determine meaning and primacy by balancing supposed First Amendment interests against the interests to be served by abridgement. This approach was not limited to copyright; any effort at abridgement might be tested in similar fashion. Indeed, "definitional balancing," as this approach was then known and practiced, was simply a descendant of a more general approach to interpreting the constitution at large that Justice Oliver Wendell Holmes had advocated years before.[304] Among lawyers, legal scholars and judges, constitutional

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[299] Resps. Br., *supra* note 97, at 34 (emphasis in original).

[300] Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guaranties of Free Speech and Press?*, 17 UCLA L. Rev. 1180, 1181 (1970)*; see generally* LANGE & POWELL, *supra* note 297, at 134–38.

[301] U.S. CONST. amend. I.

[302] *See* Nimmer, *supra* note 300, at 1181–83.

[303] *Id.* at 1811 (quoting Justice Black); *see* LANGE & POWELL, *supra* note 297, at 239–60.

[304] *See* LANGE & POWELL, *supra* note 297, at 225–238.

absolutes are generally frowned upon in conceptual terms and routinely disfavored in practice.[305]

Nimmer considered himself free, then, to answer his original question by concluding, on balance, that copyright did not ordinarily violate the First Amendment. Some instances of copyrightable expression might be sufficiently impressed with public significance to justify First Amendment protection against exclusivity: news of the My Lai massacre, then still a relatively fresh matter of public interest and concern, would have qualified in his opinion, as would some other subjects.[306] But generally it was copyright that would prevail, thanks to doctrinal "safeguards" (as they have come to be called) that served to offset First Amendment concerns. In particular, he thought, copyright's so-called "idea/expression dichotomy"—according to which ideas themselves are never copyrightable—meant that exclusive rights in expression could be tolerated.[307] It is also probable that Nimmer would have counted the fair use doctrine as a safeguard, though in fact his discussion of that doctrine was actually somewhat ambivalent as to that point.[308]

Nimmer's general conclusion as to copyright's primacy has survived, augmented by two decisions in the Supreme Court that have actually appeared to strengthen copyright's considerable immunity to First Amendment scrutiny. In *Harper & Row v. The Nation Magazine*,[309] decided in 1985, the Court considered a case in which the defendants (a minor journal of political commentary and its publisher) had purloined and published excerpts from a copyrighted biography of former President Gerald Ford which was scheduled to be published later by Harper & Row, accompanied by exclusive excerpts to appear in *Time Magazine*. Harper & Row claimed damages for copyright violation, while *The Nation* argued that the First Amendment privileged the publication—as indeed Nimmer himself might imaginably have argued in the circumstances.[310]

But Justice O'Connor and the majority rejected the First Amendment defense to the copyright claim.[311] In her opinion she embraced Nimmer's reasoning as to copyright's doctrinal safeguards,[312] but did not credit the defendant's argument as to the importance of the public interest. Indeed, in the circumstances, which had involved unauthorized publication of the excerpt prior to the authorized release of the book-length biography, O'Connor thought that neither fair use nor the First Amendment provided a defense. In her opinion for the Court, she offered an additional historic gloss on the Framers' understanding of the relationship between copyright and the Amendment that Nimmer had not suggested. "The Framers intended copyright itself to be the engine of free expression," she wrote. "By

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[305] *See generally id.* at 263–83 (discussing "[c]onstitutional [a]bsolutes in a Holmesian [w]orld" and historical viewpoints of absolute rights).

[306] *See* Nimmer, *supra* note 300, at 1197–99.

[307] *See id.* at 1189–93.

[308] *See id.* at 1190–91; *but cf.* LANGE & POWELL, *supra* note 297, at 137 n.104 (noting that "a close reading" of Nimmer's fair use analysis "can leave the reader in some doubt as to the relationship he saw between [the fair use] doctrine and the First Amendment").

[309] Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539 (1985).

[310] *Id.* at 543–44; *see, e.g.*, Nimmer, *supra* note 300, at 1181.

[311] *Harper*, 471 U.S. at 560.

[312] *See id.* at 556.

establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas."[313]

This is dubious history at best.[314] In the first place it is unlikely that the Framers intended anything more from the First Amendment than that it would constrain Congress against abridging freedom of speech and press, just as it said in so many words. Contemporary theory, invented entirely in the twentieth century, does sometimes envision more for the Amendment;[315] what the framers may have anticipated remains fair game for debate.[316] It is unlikely that they intended copyright to be the "engine of free expression," if by that phrase one means to link copyright with affirmative goals supposedly implicit in the First Amendment. They were obviously not thinking of the First Amendment at all when they included the Copyright Clause in the original draft of the Constitution. Meanwhile, it is likely that they were not thinking clearly about copyright either. As every student of the subject knows, the Copyright Clause was adopted without any record of debate.[317] That the Framers may have expected something of copyright is plausible enough, but what that something may have been is anything but clear, and may well not have been the same thing from one Framer to the next. That they imagined in 1787 that copyright would be the device by which they would secure what twentieth century citizens might one day hope for from a First Amendment not to be considered or adopted until 1791 is altogether improbable.[318]

Still, O'Connor's fanciful metaphor in *Harper & Row* was of a piece with history in the Supreme Court of the United States, and was so nicely wrought meanwhile as to be all but irresistible. In *Eldred v. Ashcroft*,[319] a 2003 decision, Justice Ginsburg dutifully quoted the passage above from *Harper & Row* in the course of endorsing, yet again, that earlier decision's adoption of Nimmer's rationale. "In addition to spurring the creation and publication of new expression," Ginsburg intoned,

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[313] *Id.* at 558.

[314] We mean to convey both of the implications in this sentence. It is at best dubious history; it would do no injustice to O'Connor's proposition to dismiss it as outright bogus. But it is also a splendid example of the genre, in which Justices allow each other considerable latitude with the truth about the past in exchange for adaptable analogies, muscular metaphors, soaring flights of fancy and other forensic utilities of like kind.

[315] *See* LANGE & POWELL, *supra* note 297, at 171–72:

> [N]o part of the Constitution has grown more dramatically or played a greater role in defining the American experience than has the First Amendment. In the decades since . . . the Supreme Court's first important decision touching upon the meaning of the First Amendment . . . [in 1919,] the value of the First Amendment has grown by measures that are beyond our ability to account for here. Perhaps no complete assessment of the First Amendment's place in American life is possible. Certainly it seems likely that for most Americans the cultural value of the First Amendment exceeds by severalfold the value assigned to the interests protected by intellectual property. From a cultural perspective it is entirely plausible to suggest that First Amendment interests are beyond price.

Id.

[316] *See* LANGE & POWELL, *supra* note 297, at 126–27, 127 n.74. We are inclined to think Zechariah Chafee summed up that debate most persuasively when he suggested that the Framers "had no very clear idea what they meant."

[317] WALTERSCHEID, *supra* note 277, at 2.

[318] *See* LANGE & POWELL, *supra* note 297, at 124–27. This passage especially embraces the position taken by Professors Lange and Powell in their book.

[319] Eldred v. Ashcroft, 537 U. S. 186 (2003).

"copyright law contains built-in First Amendment accommodations. First, it distinguishes between ideas and expression and makes only the latter eligible for copyright protection . . . . Second, the 'fair use' defense allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances."[320] This was dutiful enough, but neither new nor particularly thoughtful in itself, since what Ginsburg had to say about this much of the subject amounted to little more than an echo of what had been said before.

Yet Ginsburg's opinion in *Eldred* was destined to be something more than merely derivative. The petitioners in *Eldred* had asked the Court to weigh the purposes and burdens imposed by the Copyright Term Extension Act of 1998 ("CTEA") against the constraints imposed by the First Amendment in the light of "heightened scrutiny" —this according to a hierarchy of balances that had long since supplanted the definitional balancing that Nimmer knew. More specifically, the petitioners had argued that extending the terms of existing copyrights, as the CTEA would do, amounted to a content-neutral regulation of speech.[321] Professors David Lange and Jefferson Powell have recently discussed "heightened scrutiny" in their book length treatment of copyright and the First Amendment:

> Contemporary First Amendment doctrine distinguishes regulations of expression in which the burden on expression is related to its content from regulations in which the burden on expression is unrelated to content. The former "content-based" regulations are, the Supreme Court has said repeatedly, "presumptively invalid": in reviewing them a court must use "the most exacting scrutiny" to ensure that it upholds only those regulations that are "narrowly tailored" in order to serve a compelling governmental interest. In contrast, "content-neutral" regulations that impose "an incidental burden" on expression are reviewed for their compatibility with the First Amendment under what the Court has termed "an intermediate level of scrutiny": in this case the regulation is valid if "it furthers an important or substantial governmental interest; if the governmental interest is unrelated to the suppression of free expression; and if the incidental restriction on alleged First Amendment freedoms is no greater than is essential to the furtherance of that interest."[322]

On the face of the matter, heightened scrutiny might have seemed especially justified as against the decision below in *Eldred*, in which the Court of Appeals for the District of Columbia had concluded that copyright was "categorically immune from challenges under the First Amendment."[323] Such a conclusion might have suggested the risks inherent in according copyright a primacy vis-à-vis the First Amendment that no other system of law can claim. Yet Ginsburg's response was merely to "reject petitioners' plea for imposition of uncommonly strict scrutiny on a copyright scheme that incorporates its own speech-protective purposes and safeguards. 'The copyright Clause and the First Amendment were adopted close in

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[320] *Id.* at 219–20.
[321] *Id.* at 218.
[322] LANGE & POWELL, *supra* note 297, at 116–17.
[323] Eldred v. Reno, 239 F.3d 372, 375 (D.C. Cir. 2001).

time. This proximity indicates that, in the Framers' view, copyright's monopolies are compatible with free speech principles.'"[324]

To this rejection, which seemed clumsily reasoned but might imaginably have been reconciled with prior case law, including *Harper & Row*, Ginsburg offered an additional response that had no provenance at all in any decision that had gone before. "We recognize that the D.C. Circuit spoke too broadly [in suggesting categorical immunity]," she allowed; but "when, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary."[325]

One might suspect that this was essentially a throw-away line, intended to do little more than deflect serious criticism of her notably thin opinion on the First Amendment questions while deferring serious contemplation of the answers. However it may have been intended, a different result was bound to follow. No one encountering Ginsburg's reference to "traditional contours" could fail to wonder where the line implicit in that phrase might fall. For those to whom the Court's ill-judged opinions on copyright and the First Amendment were anathema, if not an invitation to outright contempt, even a faint-hearted suggestion that at some point copyright might yield to concerns for a larger freedom of expression was bound to pose an occasion for a quest.

B. Traditional Contours of Copyright

What are we to understand the "traditional contours" of copyright to be? What does it mean when we speak of these contours in the context of the First Amendment? And why should it matter?

The answer is that it ought to matter enormously if we think the First Amendment means even approximately what it seems to say. Whatever the traditional configurations of copyright may be, they are surely relevant to the more important question of copyright's potential for conflict with freedom of expression. Professor Nimmer was correct to approach this question as he did in the opening paragraphs of his seminal article on the subject. He was also right to conclude that copyright's traditional contours, taken at face value, appear to violate the First Amendment, also taken at face value.

He was wrong, however, to conclude that copyright doctrines could serve as a substitute for the explicit constraints in the First Amendment. The doctrinal safeguards are presumably close to the center of whatever Justice Ginsburg may have meant when she spoke in passing of copyright's "traditional contours." But copyright's doctrines and contours define the nature of their conflict with the First Amendment, not an excuse for wishing it away.

That conflict results mainly from the exclusivity that copyright today generally presupposes, an exclusivity of the sort that figures in *Golan,* as it does in virtually every doctrinal aspect of copyright at large.[326] The conflict is not lessened by the fact

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[324] Eldred v. Ashcroft, 537 U.S. 186, 218–19 (2002).
[325] *Id.* at 221.
[326] *See* LANGE & POWELL, *supra* note 297, at 175.

that copyright's exclusivity is not total or absolute. The idea-expression dichotomy and the fair use doctrine may ameliorate the conflict to a degree. They do not eliminate it. They cannot justify it. They furnish no excuse for ignoring it. Nimmer was wrong to think so. And so has been the Court which, in following Nimmer's lead, can be pardoned only on the ground that its inquiry into the matter to date has been so cursory as to amount to no inquiry at all.[327]

And yet sometimes we can be grateful even for half measures. If copyright is immune to heightened scrutiny under the First Amendment only for so long as it falls within its traditional contours, then we can take some satisfaction in agreeing with the Tenth Circuit that the URAA's withdrawal of millions of foreign works from the public domain, and their "restoration" to protection under American copyright law, are anything but traditional.[328] They are in fact unprecedented, and that is so even if one sees the very rare, very different and very limited restoration of works during wartime as analogous.[329] Analogous these wartime actions may be, perhaps, in some very distant sense, but they were anything but traditional. Precedents for the URAA they are not.

Meanwhile, the government and a handful of amici before the Court in *Golan* have argued in effect that the first copyright act in 1790 "restored" public domain works to protection under the first federal copyright act.[330] What they mean is that some works long since published under prevailing colonial law suddenly became eligible for new federal protection. But this argument simply misunderstands the nature of the newly created Constitutional version of the public domain, and its role as a function of the Copyright Clause. In this new relationship, the one begat the other.[331] There was no restoration; there was merely a beginning. As an original matter, informed by the First Amendment *nunc pro tunc*, we might well argue that this beginning was also the beginning of a conflict with freedom of expression. And

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> In the evolution of the First Amendment to date, multiple theories addressing and defining freedom of expression have been advanced by scholars and courts alike . . . . It is enough for the moment to note that at the center of them all is a common concern for the question of freedom from suppression, a concern aimed at realizing the well-being that follows when citizens are free not only to 'think as they will' but also to 'speak as they think.' Our contention here is that the exclusivity commonly recognized and protected among the principal intellectual property doctrines [with particular emphasis upon copyright] is antithetical to the realization of that freedom.

Id.

[327] *See* LANGE & POWELL, *supra* note 297, at 91–97. If the Court itself labored under the so-called "doctrinal safeguards" afforded by copyright, opinion writing would be transformed, and might well grind to a halt. *Id.* Ideas and holdings could still be transmitted from one case to the next, of course, but the customary free appropriation of language and patterns of expression from earlier cases would have to cease while Justices and their clerks searched for "original" ways to express ideas. *Id.* Fair use might help from time to time, in theory; in practice the Justices would soon think otherwise. The lesson they would learn is clear. In the supple interplay among ideas and expression, the one simply cannot reliably be made to serve in place of the other. And this is so whether the substitution is full- or part-time.

[328] We think the Tenth Circuit's holding on this point was correct. *See supra* notes 47–56 and accompanying text.

[329] *See supra* note 133 and accompanying text.

[330] Resps. Br., *supra* note 97, at 11.

[331] *See* Pets. Br., *supra* note 96, at 31.

we would certainly insist that in a larger sense the public domain existed, as it still exists, before and beyond the fact of the Copyright Clause itself.[332] But incorporating pre-1787 works into the realm of copyright was in no sense a violation of its "traditional contours." These were only beginning to subsist. They had yet to be defined.

The government also cites examples of patent restoration in its brief, and in doing so underscores the essential problem in the way it sees copyright and the First Amendment. Patent law and copyright are discrete doctrinal systems. Patent law ordinarily does not abridge expression, and therefore has nothing to do with the First Amendment. Copyright, in contrast, is "intentionally and inherently" speech suppressive with respect to "*every* grant of copyright"—exactly as the government itself proclaims.[333]

Patent restoration thus does not speak to the issue of "traditional contours" or "doctrinal safeguards" in copyright. Why, then, does the government imagine that the patent cases can serve as precedents in *Golan*? The answer is that in the government's implicit understanding of the Constitution the Copyright (or Patent) Clause actually stands higher than the First Amendment. And so, in evaluating Congressional action under the Copyright Clause the Court is advised repeatedly and insistently by the government to "defer" to the legislative will.[334] But of course that cannot be sound advice. Were it not for the arguments advanced by Nimmer and artlessly embraced by the Court in *Harper & Row* and *Eldred*, the constitutional role reversal envisioned by the government would seem obviously flawed to any thoughtful student of the constitution. Even Nimmer understood clearly that it is the Copyright Clause (and therefore copyright itself) that must be reconciled with the First Amendment, not the other way around. Copyright is said to contain "doctrinal safeguards" that enable us to see that reconciliation, but only for so long as copyright remains within its "traditional contours." Patent law has nothing to contribute in this context. The patent restoration cases are all simply, utterly and embarrassingly beside the point.[335]

We have previously described the Tenth Circuit's approach to the question of traditional contours.[336] Its preliminary analysis on this point seems to us to be

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[332] *See* David Lange, *Reimagining the Public Domain*, 66 L. & CONTEMP. PROBS. 463, 475, 483 (2003).

[333] Resps. Brief *supra* note 97, at 34.

[334] *Id.* The Court reasoned that:

> The imposition of some restrictions on expressive activity is . . . the intended and inherent effect of *every* grant of copyright. If the existence of these restrictions were treated as a ground for heightened judicial scrutiny under the First Amendment, the principle of deference to Copyright Clause legislation would effectively be negated.

Id. (emphasis in original).

[335] The patent restoration cases are inapposite for an additional reason. All of these cases are early decisions from the nineteenth century, when the constitutional significance of the public domain in patent law was still evolving, and at the time were still notably lagging behind copyright. Today, these cases are all seriously undercut by the later decisions in Graham v. John Deere, 383 U.S. 1 (1966), Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964), Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964), and Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141 (1989), which have considerably harmonized patent law with copyright insofar as the public domain is concerned.

[336] *See supra* notes 47–56 and accompanying text.

unassailable. Restoration under the URAA cannot be said to be traditional in any sensible meaning of that term. This was the Tenth Circuit's own conclusion, one expressly occasioned by Justice Ginsburg's opinion in *Eldred*. And so it appeared that the scenario she envisioned now lay at hand. First Amendment scrutiny of at least this much of copyright could no longer be avoided.

C. Copyright, Heightened Scrutiny, and the Question of Content Neutrality

As we have also previously explained, heightened scrutiny comes in two forms. Laws that seek to abridge expression in an immediate, direct or otherwise inescapable sense are presumptively invalid. Laws that abridge expression only indirectly, without evident concern for content qua content, are invalid if the law is insufficiently related to its objective, or if it appears excessive or irrational.[337] The latter is still a form of heightened scrutiny, so it is said, but heightened just enough that a judge or panel of judges must review the limitation on expression. In the end, thanks to a striking form of path dependency insured by the principles of judicial deference and *stare decisis*, Congressional judgment ordinarily prevails. Heightened scrutiny of the lesser sort is not altogether an arid exercise, but it is often largely so. Its typical function is to provide a masque, from behind which a court can conceal or rationalize the fact that, once again, Congress has abridged expression. In this conventional usage it is not merely Congress that is abridging expression but also the courts, and ultimately the Court.[338]

It would seem to follow that lawyers for clients like the petitioners in *Golan* would inevitably insist that the URAA is content-based unless that argument is somehow expressly precluded by precedent. To succeed on that ground would bring their clients close to victory, *a fortiori*. No precedent expressly precluded that argument in *Golan*; at most it might have seemed debatable. Yet, as we have said, all the parties conceded that the restoration provisions were merely content-neutral. The District Court judge might have overridden this concession, but did not do so; the Tenth Circuit followed suit on this point.[339]

That concession almost certainly undercut the petitioners' case. As we have explained, the District Court did find that the legislation was impermissibly broad under even the lesser standard of review. But the Tenth Circuit panel concluded that Congress had acted rationally, within the limits of its authority to abridge expression. In our judgment the District Court was correct, for reasons implicit in a

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[337] *See* LANGE & POWELL, *supra* note 297, at 118–22; Turner Broad. Sys. v. FCC (*Turner I*), 512 U.S. 622 (1994); Turner Broad. Sys. v. FCC (*Turner II*), 520 U.S. 180 (1997). The *Turner I* and *Turner II* cases appear to have dominated the thinking of both the petitioners and the government, as is evidenced in their briefs before the Court, though not ultimately to the same end. In our own assessment, the *Turner I* and *Turner II* cases and the "content neutrality" cases are inapposite for reasons we develop more fully in the text.

[338] *See* LANGE & POWELL, *supra* note 297, at 143–44.

[339] *See supra* notes 57, 79 and accompanying text. In the Supreme Court the parties are bound by their earlier positions. One amicus brief does argue that the URAA is content-based. *See* Brief of Info. Soc'y Project at Yale Law as Amicus Curiae in Support of Petitioners, *supra* note 101, at 3. In our judgment, the position urged in the amicus brief is correct on this point for reasons we elaborate in our own comments in the text.

legislative scheme that was seriously flawed, in no small part through overreaching and overbreadth. The Tenth Circuit panel's opinion was hardly unforeseeable, however. Intermediate scrutiny shifts the balance in any case decidedly in favor of Congressional judgment and the status quo.

Are the restoration provisions of the URAA "content-neutral?" No. The URAA is an artifact of copyright at large in the supposed service of professional authorship. Copyright has never been an "engine of free expression." In today's world it is the *de facto* engine of professional authorship. Authorship itself is the antithesis of content neutrality. Copyright is no less so. Like authorship at large copyright is "content-based" to the very core of its being.

The practice of authorship is content-based in the same sense that the practice of journalism is content-based. No one would imagine that Congress could simply enact a law silencing, limiting or licensing American journalists in order to encourage increased coverage of the day's events by reporters working for Agence France Presse or Al Jazeera or the British Broadcasting Corporation. At the very least, heightened scrutiny of the most exacting sort would follow. No Article of the Constitution could shield such legislation. No argument on behalf of a more enlightened public would suffice. No claim of entitlement grounded in some jumped-up notion of "content neutrality" as to any given news story could result in "deference" to "Congressional discretion." On the contrary, a deliberate attempt by Congress to limit the practice of American journalism in order to manipulate public opinion in the service of global commerce would be seen as all the more offensive to the First Amendment as the legislative provisions became more comprehensive, more unyielding, more undiscriminating or more remote.

And yet the professional practices of journalists and authors are in most important respects fundamentally the same. What is different in their respective situations is that journalists are embedded in a profession that has been protected historically against Congressional licensing and oversight. Theory notwithstanding, the actual practice of journalism has never been subjected to the strictures of copyright in any important way.[340] Authors, on the other hand, are professionally enmeshed in a complex web of laws and regulations in which licensing and oversight are increasingly omnipresent. These laws and regulations are no less content-based for the fact that they are generally sweeping and intrusive.

As the government itself concedes, the copyright regime is in fact an engine for evaluating the worthiness or unworthiness of individual authorial works and licensing those works accordingly. A copyrightable work must be capable of being weighed and found deserving according to principles of creativity, originality, and exclusivity established and maintained by Congress.[341] For every work that receives protection, myriad works are rejected as correspondingly unworthy. The copyright system, its programs and its principles, may have no particular interest in one example of expression as against another from one moment to the next; but it is quite wrong to imagine that copyright is "content-neutral."

Against this background one must wonder why the petitioners in *Golan* yielded so much as an inch of ground on the question of content neutrality. Perhaps the

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[340] *See* LANGE & POWELL, *supra* note 297, at 72–73.

[341] 17 U.S.C. §§ 102, 106 (2006); Feist Publ'ns, Inc., v. Rural Tel. Serv. Co., 499 U.S. 340, 362 (1991) (noting that copyrightable expression must have a "modicum of creativity").

concession was driven by a straitened understanding of the case law—in which event we would dissent from that reading of the cases.[342] Whatever the reason may have been, no doubt it was professionally defensible and well-intentioned. Yet if heightened scrutiny meant anything of consequence at all, the consequences of this concession were not unlikely to be adverse, as indeed they appear to have been to this point in the progress of the case.

We have detailed the evolution of those consequences in the District Court and in the Tenth Circuit. Having lost in the Tenth Circuit on the ground of heightened scrutiny, the petitioners have briefed the point yet again with admirable clarity and force; having elected to fight on this ground, they have at least given no quarter. The government's response is to argue that judicial deference must be paid to any scheme that Congress has bestirred itself sufficiently to ratify, and this is so whether the question of sufficiency is addressed in the context of the Copyright Clause or the First Amendment.[343] Our own judgment, meanwhile, is in accord with the District Court's conclusion that the scheme enacted by Congress in the URAA goes well beyond what might be defended under even the lesser form of heightened scrutiny. In the end, the function of intermediate scrutiny in *Golan* has been to enable three judges of the Tenth Circuit to excuse what all the parties concede to be a Congressional exercise in abridging expression. That is the blunt and inescapable truth of the matter. As such, it is an affront to the First Amendment, the public domain, the Copyright Clause, and copyright itself, all of which deserve better.

But "better" does not require a zero sum game. The risk in finding that a law or regulation is content-based under the existing approach to heightened scrutiny is that a sensible legislative scheme may fail entirely when a relatively modest alternative or compromise might suffice to satisfy the First Amendment's constraints. This is especially true when the context is copyright, where the present concept of exclusivity should be seen as anathema to freedom of expression, but where it is possible to imagine alternatives that do not offend, alternatives that Congress and the Court, like Nimmer himself, have failed to see.

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[342] A considerable literature has appeared on the subject of content-based versus content-neutral regulations in the context of copyright and the First Amendment. Opinions tend to be closely reasoned and sharply divided. *Compare, e.g.*, Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred, 44 Liquormart, and Bartnicki*, 40 HOUS. L. REV. 697, 703–17 (2003) (discussing why copyright law is a form of speech restriction, but whether or not copyright law is content-based simply on the grounds that it keeps people from publishing, producing, and performing the speech that they want to publish, produce, and perform, the fair use exception to copyright law, would make the laws content-based); *with* Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1, 5–6 (2001) (discussing why in First Amendment terms, copyright law is a type of content-neutral speech regulation that should be subject to rigorous "intermediate scrutiny). Author's note: we are indebted to Professor Lange's former research assistant, Sandra Newmeier, Duke University School of Law, J.D. 2011, for an excellent memorandum collecting and summarizing this literature. We do not intend to join in this debate in a plenary way. In our view those who see copyright as predominantly content-based have the better of the argument.

[343] *See supra* note 286 and accompanying text. As suggested, the epistemology of the government's argument is one in which the First Amendment is inevitably subordinated to the Copyright Clause.

VI. ALTERNATIVES AND COMPROMISE

A. Copyright in the Image of the First Amendment

Professors Lange and Powell have proposed that, as between copyright and the First Amendment, the latter must be seen as paramount and absolute.[344] In this embrace of First Amendment primacy, they are frankly influenced by a larger understanding of the Amendment most closely identified with Justices Black and Douglas—an understanding, as we have earlier said, that Professor Nimmer himself considered in the opening paragraphs of his seminal 1970 essay in which he posed the question: *Does copyright violate the First Amendment*?[345]

Though he did not quite say so, there is little reason to doubt that his ultimate search for an alternative understanding of the relationship between copyright and the First Amendment proceeded in some part from what he otherwise imagined would be copyright's inevitable demise. His alternative understanding, as we have also said, lay in copyright's so-called doctrinal safeguards, set off against the First Amendment's "definitional balancing" that preceded today's "heightened scrutiny." His endorsement of this understanding has led to a vast outpouring of writing about copyright and the First Amendment, and meanwhile to so much of what the Court has said about these issues in *Harper & Row* and *Eldred*, the two cases in which the Court has given them passing attention. None of this writing has appeared to depart from the fundamental assumption that copyright and the First Amendment must be reconciled in order to insure that copyright survives intact.[346]

In their book, Lange and Powell concur in Nimmer's initial reasoning as to the troubled relationship between copyright and an absolute First Amendment. They entertain no assumption, however, as to the continuing necessity of "saving" copyright from the consequences of whatever conflict cannot be avoided. In their view copyright must yield where necessary to the greater constitutional weight of the Amendment. This is especially so with respect to copyright's traditional reliance on Congressional power to grant monopolies in expression. Lange and Powell write:

> We propose . . . that the First Amendment be read absolutely, in keeping with its first and most obvious meaning: *that Congress shall make no law abridging freedom of speech or of the press by conferring monopolies in expression that otherwise would belong to the universe of discourses in which all are free to share and share alike.* In at least this sense, "no law" should mean *no law*.[347]

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[344] *See* LANGE & POWELL, *supra* note 297, at 305.

[345] *See* Nimmer, *supra* note 300, at 1180.

[346] *See* LANGE & POWELL, *supra* note 297, at 138–42 (summarizing this literature briefly); NEIL WEINSTOCK NETANEL, COPYRIGHT'S PARADOX (Oxford Press 2010) (reconciling the treatment of the subject).

[347] LANGE & POWELL, *supra* note 297, at 305 (emphasis in original).

Would this lead to the demise of copyright as Nimmer and others have seemed to fear? In their response to this question, Lange and Powell observe that in large measure copyright would continue unchanged:

> The subject matter of the doctrines, the reasons for recognizing them, the disposition of the underlying interests, the incentives and rewards, the acknowledgment of creativity itself – all of these and more remain essentially the same . . . .
>
> What [would] change most dramatically is the single thing that makes [copyright] obviously objectionable under the Constitution at present. Congress [would] simply have no power to create or recognize monopolies in expression that otherwise would press itself upon the public consciousness at large, and this is so whether the monopolies are justified under the . . . copyright clause, the commerce clause, the treaty power, or otherwise. When exclusive interests in expression are conferred for no better reason than that exclusivity [would] encourage the production of such interests, or make them valuable in the hands of a favored few, the First Amendment [would] then intervene . . . . Interests in expression [would] no longer be consigned exclusively to proprietors recognized by the state.[348]

Recognizing an absolute First Amendment primacy in *Golan* would change the nature of the argument and point the way to an outcome considerably less destructive to the interests of the parties on both sides. To begin with, of course, it would mean abandoning the tedious and arid debate over content neutrality and its consequences. No one can deny that the URAA is speech suppressive: it is legislation indisputably aimed at recognizing and "restoring" exclusive rights in an array of works once consigned to the public domain. This it proposes to do by limiting or licensing the expressive interests of parties who otherwise would rely on the public domain. This much of the legislation Congress could have no power to enact against the reach of an absolute First Amendment.

But it does not follow that Congress could not generally provide for an allocation of net revenues according to the value of a copyrighted work in the production of those revenues. Professor Jed Rubenfeld proposed just such an approach to revenue sharing in a seminal article early in the last decade.[349] Presupposing an entitlement to appropriate and make use of a copyrighted work, he argued that such revenues could be apportioned and allocated to the copyright proprietor.[350] *A priori* rents, he emphasized, were not to be confused with net revenues: the former amount to an impermissible impediment to appropriation, and therefore are anathema to freedom of expression; the latter are merely an equitable measure for sharing in the profitable exploitation of a work meanwhile otherwise freely available to all.[351] Rubenfeld advanced his proposal in the context of a limited concern for what he called "freedom

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[348] *Id.* at 306–07.

[349] *See* Jed Rubenfeld, *The Freedom of Imagination: Copyright's Constitutionality*, 112 YALE L.J. 1, 57–58 (2002).

[350] *Id.* at 57.

[351] *Id.* at 53–54.

of imagination," but there is no reason why the proposal cannot have wider application. Taking their lead from Rubenfeld, Lange and Powell have proposed the availability and allocation of net revenues as one way to deal with the continuing issue of incentives in a copyright regime that no longer recognizes exclusive interests in expression itself.[352]

In *Golan*, then, a straightforward recognition of an absolute First Amendment would require an equally straightforward recognition by Congress that restoration under the URAA can be defended against the interests protected by the Amendment only to the extent that exclusive rights in expression are eliminated. The provisions with respect to reliance parties would have to be changed or clarified so that, at most, post-restoration license fees did not exceed net revenues. That could be accomplished rather easily, however, and in itself would affront neither the Copyright Clause nor the demands of the Berne Convention. Whether restoration of a work from the public domain is separately inconsistent with the Copyright Clause would remain an issue to be resolved. But that resolution would follow along lines no longer burdened in one significant respect: no one acting, or merely contemplating action, in reliance on the public domain would be threatened by the prospect of licensing fees due and payable at the outset of an appropriation.

Meanwhile, presumably, no continuing exclusivity within the "traditional contours" of copyright could long be sustained against other, more sweeping challenges to copyright sure to follow. Is *Golan* the occasion for the adoption of a change in direction for the First Amendment as profound as that? We think it is. For the first time in history, copyright legislation has been challenged and haled before the Court directly and primarily on First Amendment grounds. It is within the Court's gift under the Constitution to uphold that challenge. To recognize the primacy of the First Amendment in the context of copyright is merely to reverse an error with a provenance of no great length, and a pedigree no more significant than the opinions in two half-hearted cases.

B. A Compromise in the Service of Expression

Finally, is it plausible to imagine that the Court may find room in the URAA legislation to escape the constitutional conflicts that appear inherent there, while saving the public domain and the First Amendment from the most immediate ravages wrought by that legislation? Again, we think it is.

As we have noted, the legislation presupposes licenses resulting from negotiations between the proprietors of newly restored copyright in erstwhile public domain works and reliance parties who may wish to continue using them.[353] In the event of a failure to come to terms, the decision as to the fee is consigned to a federal court.[354] It is clear that the drafters of the legislation imagined that a "reasonable"

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[352] *See* LANGE & POWELL, *supra* note 297, at 179–82, 181 n.47.

[353] *See Copyright Restoration of Works In Accordance with the Uruguay Round Agreements Act; List Identifying Copyrights Restored Under the Uruguay Round Agreements Act for Which Notices of Intent to Enforce Restored Copyrights were Filed in the Copyright Office*, 63 FED. REG. 43829, 43830 (Aug 14, 1998).

[354] *See* 17 U.S.C. §§ 104A(e)(1)(C), 111(a)(3) (2006).

fee would be imposed as to new and continuing uses; but the amount of that fee is unspecified. With respect to reliance parties whose continuing uses generate little or no revenue it is possible that no more than a token fee need be paid. The legislation does not say so explicitly, but reason to entertain that proposition can be inferred from a personal account of the negotiations that led to it.[355] Meanwhile, given the lack of specificity in the language of the Act, it would seem that a "reasonable" fee for even a new use unlikely to produce net revenue would not necessarily require payment in advance.

There is ample precedent among the Court's intellectual property opinions for limiting or withholding a remedy when an act does not clearly provide for one, and when fairness meanwhile suggests strongly that the remedy should be modified accordingly.[356] On the strength of these opinions a lower court might justifiably conclude that a fee ought to be limited at most to a stream of net revenues, rather than from first dollar or still earlier.

A compromise along these lines is not unthinkable in the circumstances presented in *Golan*. We ourselves would favor something closer to a bright line defense against affronts to the public domain, lest it die the death of a thousand cuts. But at least a compromise could be fashioned that would not violate the First Amendment in a primary sense. It might lead to still more useful reflections on the importance of that Amendment in a world increasingly dominated by a system for licensing creative expression.

VII. CONCLUSION

Golan offers the Court an opportunity to revisit an array of issues in a single case. The Copyright Clause, the public domain, the Treaty Power, the First Amendment—no single case has ever presented issues quite as sweeping or as vital

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[355] Golan v. Holder: *Does Restoring Copyright in Foreign Works Violate the First Amendment?*, GEO. WASH. UNIV. (Jan. 2010), *available at* http://www.law.gwu.edu/Academics/FocusAreas/IP/Pages/Podcasts.aspx. In January, 2010, Professor Robert Brauneis convened a pannel discussion at the George Washington University School of Law to consider the issues then pending in *Golan*. In the course of that discussion, Professor Lange and Eric Schwartz engaged in the following exchange:

> David Lange: 'Do I understand you to say that your own sense of what the negotiations led to, and their reflection in the subsequent legislation, means that if the reliance party really doesn't have any revenue, then no reasonable royalty need be paid at all?'
>
> Eric Schwartz: "Alas, the person who drafted this provision, Barbara Ringer, died last April. But . . . as I recall, when the notion of reliance part[ies] surfaced . . . she was arguing for kind of a balance between the author's rights with their restored protection . . . and that yes, [as to] reasonable compensation, it could be in some instances that the rightsholder would acknowledge that, as against everyone else, they were restored to protection on January 1, [1996], but as against this derivative works reliance party they may or may not . . . be able to get anything more than token compensation, and that should be sufficient.'

[356] *See* Stewart v. Abend, 495 U.S. 207, 224 (1990); Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 578 n.10 (1994); New York Times Co. v. Tasini, 533 U.S. 483, 520 n.18 (2001).

to copyright and freedom of expression as this case does. The Court's decision could redirect the course of creative expression before the law. This is an opportunity that has arrived not a moment too soon.