

No. 10-545

**In the
Morris Tyler Moot Court of Appeals at Yale**

LAWRENCE GOLAN ET AL.,
Petitioners,

v.

ERIC HOLDER ET AL.,
Respondents,

*On Writ of Certiorari to the United States
Court of Appeals for the Tenth Circuit*

BRIEF FOR PETITIONER LAWRENCE GOLAN

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QUESTIONS PRESENTED

1. When Congress passed the Uruguay Round Agreements Act (URAA), it gave new terms of copyright protection to works in the public domain that were initially created by foreign authors. The copyrights had expired pursuant to previous requirements of U.S. copyright law, and Congress had never before enacted a wholesale resurrection of works from the public domain. Does the Progress Clause of the United States Constitution bar such a large-scale restoration of copyrights?
2. Petitioners have relied upon works in the public domain for their speech interests, through the performance, preservation, and sale of those works. The enactment of Section 514 of the URAA has made it prohibitively expensive or legally impossible for petitioners to continue using large numbers of these works. Does the URAA violate the First Amendment rights of petitioners by burdening their speech?

PARTIES TO THE PROCEEDING

The petitioners in this action include Lawrence Golan, Richard Kapp, S.A. Publishing Company, Inc., Symphony of the Canyons, Ron Hall, and John McDonough. The respondents in this case are Attorney General Eric Holder and Acting Register of Copyrights Maria A. Pallante.

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OPINIONS BELOW

The Tenth Circuit’s opinion in *Golan II* denying petitioners’ First Amendment claim is reported at 609 F.3d 1076 (10th Cir. 2010). The district court’s *Golan II* opinion, which had granted summary judgment for petitioners on that claim, is reported at 611 F.Supp.2d 1165 (D. Colo. 2009). The Tenth Circuit’s opinion in *Golan I*, which rejected petitioners’ Progress Clause claim but recognized their First Amendment claim, is reprinted at 501 F.3d 1179 (10th Cir. 2007). The district court’s opinion in *Golan I*, which is unpublished, is available at 2005 WL 914754 (D.Colo.); and the district court’s opinion rejecting both of the government’s motions to dismiss is reprinted at 310 F.Supp.2d 1215 (D.Colo. 2004).

STATEMENT OF JURISDICTION

The Tenth Circuit issued its ruling on June 21, 2010. This Court granted certiorari on March 7, 2011. This Court has jurisdiction under 28 U.S.C. §§ 1254(1), 1332 (2006).

RELEVANT CONSTITUTIONAL PROVISIONS AND STATUTES

This case involves the Progress Clause of the Constitution, Art. I., Section 8, Clause 8; the First Amendment to the United States Constitution; Section 512 of the Uruguay Round Agreements Act (codified as amended at 17 U.S.C. § 104A (2006)); and Article 18 of the Berne Convention on Literary and Artistic Works. All such provisions are reproduced in the Appendix.

STATEMENT OF THE CASE

This case is about a set of petitioners who have long expressed themselves by restoring, producing, performing, and developing public domain works. For many years, plaintiff Golan has brought “classical music to new audiences, young and old” to inspire future Mozarts and Tchaikovskys. Compl. ¶ 49. Realizing that interest in classical music as an expressive form has waned in this country, Golan has “originated several innovative events that incorporate the

performance of classical music with other entertainment that may be more familiar.” Compl. ¶ 50. Plaintiff Richard Kapp also seeks to expand interest in classical music as an expressive form. *Id.* ¶ 61. He established “Cushion Concerts” for young children, which “introduce[] children to classical music through live performances at a minimal expense.” *Id.* Kapp also expands exposure to classical music at low prices through his recording label, ESS.A.Y recordings.

Plaintiff Symphony of the Canyons, meanwhile, has provided opportunities for its community members to express themselves through music for some time. *Id.* ¶ 73. Its members range in age from 12 to 70 and receive no compensation for their performances. *Id.* ¶ Nearly 80 percent of the music the symphony performs is in the public domain, and it “simply cannot afford to pay for renting or performing a large amount of copyrighted music due to the cost of the rental fees.” *Id.* ¶ 74.

Other plaintiffs sell, restore, and preserve, classic films and television shows. Plaintiff Ron Hall has sold and compiled archived public domain films including classics like *Birth of a Nation* and *Phantom of the Opera*. *Id.* ¶ 78. Plaintiff John McDonough of Timeless Video has preserved old films to “facilitate[] the airing of public domain works on TV.” *Id.* ¶ 84. He seeks to expose the public to such films that may not otherwise be available to the public at large. In fact, absent McDonough’s efforts, many such films would “deteriorate[] rapidly and eventually become[] lost forever.” *Id.* ¶ 89. If that happens, many of the expressive elements of these films would not be available to shape our culture.

All of petitioners’ activities changed with Congress’ enactment of Section 514 of the Uruguay Round Agreements Act (URAA). This Act, which took a step initially deemed unnecessary by Congress and was passed as a result of significant pressure from private economic interests, restored all foreign copyrights in works that had expired in the United States

as a result of their initial authors' failure to meet various statutory requirements: These include failures to renew the work after 28 years, failures to provide notice, and failures to manufacture the work in the United States. The URAA also restored the works of authors from countries that did not provide copyright protection to U.S. authors at the time of original publication. 17 U.S.C. § 104A (2006). It "has resulted in the removal of thousands, if not millions, of works from the public domain." Compl. ¶ 46. The work extended limited protection to reliance parties—such as the plaintiffs—who had expected works that had entered the public domain to remain there.

The URAA, however, has devastated the plaintiffs' ability to fulfill their expressive goals. For Golan, "[i]t is now cost prohibitive for Golan to perform many works." *Id.* ¶ 53. His orchestra not only must pay "hundreds of dollars" to play any restored work, *Id.* ¶ 57, it is also forced to redo orchestral markings on sheet music that constitute Golan's interpretive spin on the works. *Id.* ¶ 53. Now, one single rental—at the *discounted* rate of \$685—consumes over 25 percent of Golan's budget, meaning that he "simply could not afford additional rentals of copyrighted works to fill the anticipated 19 other pieces the orchestra would perform over the year." *Id.* ¶ 58. This is unsurprising given that copyrighted music scores cost roughly twenty times as much as ones that are in the public domain. *See id.* ¶¶ 66-67.

Richard Kapp, meanwhile, was warned that he could not play *Peter and the Wolf* for young audiences anymore without paying licensing fees; this was despite the fact that he had purchased a public domain copy of the work many years ago. *Id.* ¶ 70. His recording label, which was founded on the premise that he could recoup his significant investments in sound recording through the use of public domain works, had its hopes dashed by the URAA. Symphony of the Canyons has been severely constrained in its ability to select and perform works, *Id.* ¶ 76, Ron Hall can no longer offer a wide range of films, *Id.* ¶ 81-82, and John McDonough has been

forced “to forego selling [restored] works altogether,” Compl. ¶ 88, despite his efforts to preserve those films. *Id.* ¶ 89. The URAA has also created a substantial number of “orphan” works that are now “essentially unavailable” to petitioners. *Id.* ¶ 89.

This action followed. Initially, the district court rejected respondents’ motions to dismiss. *Golan v. Ashcroft*, 310 F.Supp.2d 1215 (D. Colo. 2004). The district court then held for respondents on petitioners’ Progress Clause claim on the ground that copyright restoration was within Congress’ authority under that clause. *Golan v. Ashcroft*, 2005 WL 914754 (D.Colo.). Applying rational basis review, the Tenth Circuit affirmed that ruling under the assumption that “the clear import of *Eldred* [was] that Congress has expansive powers when it legislates under the Copyright Clause.” *Golan v. Gonzales*, 501 F.3d 1179, 1187 (10th Cir. 2007).

At the same time, the Tenth Circuit recognized the viability of petitioners’ First Amendment claim because “Section 514 alters the traditional contours of copyright protection” by deviating from the principle that works in the public domain must remain there. *Golan I*, 501 F.3d at 1187-88. It then remanded to determine a standard of review. *Id.* At 1196. After the district court determined that the URAA is unconstitutional on First Amendment grounds, *Golan v. Holder*, 611 F.Supp.2d 1165 (D. Colo. 2009), the Tenth Circuit reversed. *Golan v. Holder*, 609 F.3d 1076 (10th Cir. 2010). This Court granted certiorari.

SUMMARY OF ARGUMENT

I. Section 104A of the Copyright Act is unconstitutional because it exceeds the power of Congress. Under the Progress Clause of the Constitution, copyrights may not be granted to works that have entered the public domain. This foundational limitation has been confirmed from the earliest days of the Constitution, as Congress has consistently rejected any attempt to restore protection to works which had become free for use by the public. In fact, even in periods of

declared war, the government allowed only for an extension of time to comply with the formalities of American copyright law, and never resurrected works that had lost their copyright protection via expiration of their term of protection.

The Supreme Court has also firmly established the federal public domain as a sacrosanct and inviolable component of copyright law. As early as *Wheaton v. Peters*, the Court noted the importance on placing firm limits on the terms of copyright protection. In that case, the Court eliminated the possibility of perpetual copyright by ensuring that works that failed to comply with formalities—like the works restored by the URAA—remained in the public domain. In later cases, the Court held that the permanent status of works as free for use, once having entered the public domain, safeguards the ability of any citizen to rely upon those works into the future. Further, the strict requirements of originality as a prerequisite to copyright protection are inherently absent from a work that has become available for unfettered use. The Court noted most recently in *Eldred v. Ashcroft* that copyright regulations must adhere to the longstanding boundaries of copyright. Where Congress exceeds its authority under the Progress Clause by restoring copyright to works in the public domain, as Congress did with the URAA, several constitutional rights, such as those under Fifth Amendment, are threatened. These limitations on Congressional power imposed by the Progress Clause cannot be circumvented by the Berne Convention treaty or the Commerce Clause.

II. Section 104A is also unconstitutional as applied because it violates the First Amendment speech rights of petitioners. Unlike the Copyright Term Extension Act in the *Eldred* case, Section 104A provides no economic incentive towards the formation of future creative works, and as such does not inherently support the interests of the First Amendment. Instead, the URAA restores whole categories of works from the public domain to copyright status, making it

prohibitively expensive or legally impossible for petitioners to continue their expressive use of these works. The built-in speech protections of copyright are inapplicable to the speech interests of petitioners. That is, foreign works in the public domain had been relied upon, in their entirety, for the speech of petitioners. That reliance parties such as petitioners may now only use the ideas and facts in these works, or employ them only for limited purposes does not alleviate the burdens imposed on their speech by the URAA.

In fact, every expressive use that petitioners have previously made of these works is constitutionally protected. Accordingly, Section 104 should be regarded as a content-neutral law infringing on the speech rights of petitioners. The government must show that the law (1) advances a sufficiently important government interest and (2) that it does not suppress more speech than necessary to accomplish that prescribed aim. While the government asserts three different interests addressed through the law, they are all inadequate: they are either insufficiently important to justify a restriction on the speech of petitioners or they are not addressed by the URAA in a narrowly tailored manner.

ARGUMENT

I. THE URAA IS UNCONSTITUTIONAL UNDER THE PROGRESS CLAUSE BECAUSE IT REMOVES WORKS WITH EXPIRED COPYRIGHTS FROM THE PUBLIC DOMAIN

The Progress Clause of the United States Constitution provides that 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.” U.S. Const. Art. I, § 8, Cl. 8 (emphasis added). This clause is “both a grant of power and a limitation.” *Graham v. John Deere Co.*, 383 U.S. 1, 5 (1966). One limitation is that Congress cannot grant perpetual copyrights. *See Eldred v. Ashcroft*, 537 U.S. 186, 209-10 (2003). Another is that

protected inventions or works cannot be removed from the public domain after their underlying patents or copyrights have expired *for any reason*. As this Court noted in *Graham*, “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.” *Graham*, 383 U.S. at 6. This Constitutional standard—which can apply equally to copyrights—“may not be ignored” because Congress must “promote progress” of the useful arts. *Id.* And, “[i]t is emphatically the province and duty of the judicial department to say what the law is.” *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 177 (1803).

When Congress passed the URAA, it chose to ignore a “bedrock principle of copyright law” by restoring copyrights from the public domain that had already expired. *Golan v. Gonzales*, 501 F3d 1179, 1187 (10th Cir. 2007). The statute explicitly restores the copyrights of works that “are in the public domain in the United States.” 17 U.S.C. § 104A(h)(6)(C) (2006). It restores previously copyrighted foreign works that had expired pursuant to a bona fide 28-year copyright term. *Id.* § 104A(h)(6)(C)(A)(i) (noting that “restored works” are those where the copyright owner had failed to renew). It restores other copyrights that had received common law protection prior to publication and expired after their authors failed to comply with notice, manufacturing, and other well-established requirements of US law that were in existence since the Copyright Act of 1790. *Id.* All works of American authors whose copyrights have expired for the same reasons, meanwhile, remain in the public domain. The URAA also restored the copyright of sound recordings for which Congress originally chose to provide a limited, common law protection. *Id.* § 104A(h)(6)(C)(ii). Finally, the act restores copyrights that had common law protections before publication, but expired upon publication or fixation because their home countries had failed to establish copyright relations with the United States at the time of original

publication. 17 U.S.C. § 104A(h)(7)(C)(A)(iii). These copyrights had expired due to conceptions of progress held by Congress when it passed previous copyright statutes. Those Congressional choices to allow certain copyrights to expire quickly, unlike the decision to restore public domain works, were within Congress' discretion under the Progress Clause.

A. Prior to the URAA, Consistent Congressional Practices Confirmed that Copyrights Cannot Be Restored From The Federal Public Domain Once They Expire

Congress made an unprecedented move when it enacted the URAA. Indeed, the Tenth Circuit acknowledged below that “the URAA has altered the ordinary copyright sequence.” *Golan*, 501 F.3d at 1189. In so doing, Congress contradicted its own historical practices—practices that are probative on the URAA's constitutionality. This Court emphasized in *Eldred v. Ashcroft* that “a page of history is worth a volume of logic” in interpreting “the scope of Congress' power under the Progress Clause.” 537 U.S. at 200 (internal citation omitted). Here, Congressional practice since the founding has systematically *rejected* restoration of works from the public domain after their copyrights had expired. This supports a constitutionally imposed, categorical bar against removal of expired copyrights from the public domain.

1. Copyright Legislation And Congressional Interpretations Since The Founding Demonstrate That Federal Statutes Have Repeatedly Rejected Attempts to Remove Works From The Public Domain

Before the Constitution was enacted in 1787, Congress had no authority under the Articles of Confederation to pass copyright laws. The federal government, however, began to realize the need for such laws in the early 1780's. Thus, Congress commissioned a report in 1783 to “to consider the most proper means of cherishing genius and useful arts through the United States by securing to the authors or publishers of new books their property in such works.” Bruce W. Bugbee, *Genesis of American Patent and Copyright Law* 112 (1967). The committee recommended that states should secure copyright “to the authors or publishers of any new books

not hitherto printed.” Bugbee at 113 (emphasis added). It recommended a renewable copyright term of fourteen years and did not suggest that works be removed from the public domain. *Id.* States varied in their implementation of this recommendation, but every state except Delaware eventually passed laws according some degree of copyright protection to authors. *Id.* at 117.

These state laws, however, were short lived. Because of the lack of uniformity in state copyright laws and the need to establish a distinctly federal copyright regime, the framers incorporated the Progress Clause into the constitution. In the Federalist Number 43, James Madison explained that “[t]he States [could not] separately make effectual provision” for copyright, and most States hoped that the copyright conundrum would be resolved “by laws passed at the instance of Congress.” The Federalist No. 43, at 272 (James Madison) (Clinton Rossiter ed., 1961). And, “in light of the statute of Anne and the then recent decisions of the English courts, it is clear that” the Progress Clause was “enumerated in the Constitution, *for the purpose* of expressing its limitations.” William W. Crosskey, I Politics and the Constitution in the History of the United States 486 (1953) (emphasis in original).

a. The 1790 Act Extended Existing Copyrights, But Did Not Restore Any Copyrights From the Federal Public Domain

Congress’ use of its new constitutional authority began with the 1790 Copyright Act. A simple reading of the plain text of this act illustrates that it was only meant to protect works that already had *existing copyrights* in 1790. Although the 1790 act does protect works that were “already printed” in the United States at the time of its enactment, it only protects those authors who “ha[d] not transferred . . . the copyright” of a map, chart, or book to another person. Act of May 31, 1790, § 1, 1 Stat. 124, 124 (1845). It also provided copyright protections for pre-existing works to those authors’ “executors, administrators, or assigns” if their assignees had “purchased or legally acquired the copyright” of such materials. 1 Stat. 124. Thus, if a work had

already been published prior to the enactment of the act, persons who wished to obtain copyright protection could *only do so* if they had been granted a pre-existing copyright from *somewhere*. For works “not yet made or published,” meanwhile, the act did not place *any* pre-existing copyright limitation on the authors’ right to receive a Fourteen Year term. *Id.* The First Congress made this critical distinction between “previously published” works and “not yet published” works so that works could *not* be removed from the public domain.

The pre-existing copyrights that Congress alluded to in the act could have taken one of three forms. First, they could have been *state statutory* copyright protections—at the time the 1790 Act was passed, twelve of the thirteen states had passed copyright statutes—ten of these statutes had already conferred copyright protection to authors who fulfilled formality requirements. *Golan v. Gonzales*, 2005 WL 914754, at *8 (D.Colo). If copyright protection had been conferred to a work by these state statutes as of 1790, the pre-existing work was not in the public domain. Second, the pre-existing copyright could have been a state or federal common law copyright protection—perpetual or otherwise. An analysis of state copyright provisions in the nineteenth century illustrated that “the rights of authors in their *published works* existed by statute, in some of the states, before the constitution of the United States was formed; and *there cannot be much doubt* that they existed, in the older states, at common law.” George T. Curtis, *A Treatise on the Law of Copyright* 81 (1847) (emphasis added). If common law copyrights in published works—at *either* the state or federal level—had been perpetual (or even of a limited duration) before 1790, the 1790 statute did not restore copyrights.

The pre-existing copyright assumed by the 1790 statute may have been solely a common law copyright protection that protected authors *prior to publication*. But that is impossible, since such copyrights would have been extinguished upon publication. There would have been *no*

copyright to transfer or assign by a published work’s author, as the statute requires, in 1790. Thus, it would have been impossible for an author or assignee to obtain copyright protection if the work had already entered the public domain through publication. Thus, the district court erred when it assumed that “it is reasonable to conclude that Congress in 1790 anticipated the removal of some works from the public domain.” *Golan v. Gonzales*, 2005 WL 914754, at *11 (D.Colo.). If authors “lost exclusive rights in their creations by general publication at common law,” they *could not* “have obtained copyrights pursuant to the 1790 Act.” *Id.*

To interpret otherwise would render the 1790 Act’s assumption of pre-existing copyrights as unnecessary surplusage. As the Supreme Court has noted, statutes should be construed to give their terms full effect. *See Lamar v. United States*, 241 U.S. 103, 112 (1916). The Tenth Circuit was correct when it stated that one “cannot conclude that the Framers viewed removal from the public domain as consistent with the copyright scheme they created,” *Golan v. Gonzales*, 501 F.3d 1179, 1191 (10th Cir. 2007), but this did not go far enough. From the basic statutory construction one *must* conclude that the First Congress viewed removal from the public domain as *inconsistent* with the copyright scheme. Rather than “point[] toward constitutionality,” *Luck’s Music Library v. Gonzales*, 407 F.3d at 1262, 1265 (D.C. Cir. 2005), the actions of the First Congress point toward the unconstitutionality of copyright restoration.

b. Other Major Copyright Enactments Also Reject Copyright Restoration From The Public Domain

The Copyright Act of 1831 similarly rejected application of its terms to any work that had entered the public domain. While the act extended the copyright term to a renewable 28-year term, it attached a proviso that the act “shall not extend to *any copyright* heretofore secured, the term of which *has already expired*.” Act of Feb. 3, 1831, § 16, 4 Stat. 436, 439 (1846) (emphasis added). Once any previous copyrighted work had entered the public domain, therefore, the act

categorically barred protection—this included any works that entered the public domain for failures to comply with formality requirements, such as failures to renew.

The Copyright Act of 1909, meanwhile, also rejected any expansion of copyright to works already in the public domain. It noted that “no copyright shall subsist in the original text of *any work which is in the public domain*” or in any published work that “has not been already copyrighted in the United States.” Pub. L. No. 60-349, § 7, 35 Stat. 1075, 1077 (1909) (emphasis added). The House Committee Report for the 1909 Act reiterated that the Progress Clause “limits the power of Congress by several conditions.” H. Rep. No. 60-2222 (1909), at 6.

When the Register of Copyrights prepared a report in anticipation of Congress’ major overhaul of copyright law in 1976, moreover, the Register suggested that copyrighted works could not be restored from the public domain when he noted that the proposed suggestions “would not, *of course*, restore protection to works that had gone into the public domain before its effective date.” Register’s Report on the General Revision of the U.S. Copyright Law 57 (1961) (emphasis added). This same report, meanwhile, encouraged the internationalization of intellectual property protections. *Id.* at 119. But it acknowledged the distinction between *prospective* compliance and *retrospective* conformity, and that the latter would presumably be unconstitutional. Unsurprisingly, then, the 1976 Copyright Act itself explicitly “does not provide copyright protection for *any work* that [went] into the public domain before January 1, 1978.” Copyright Act of 1976, Pub. L. 94-553, § 103, 90 Stat. 2541, 2545 (1976).

This trend continued in the lead-up to the URAA. In Congress’ initial attempt to implement the Berne Convention, Congress was wary of subverting constitutional principles by removing works from the public domain. In the Berne Implementation Act of 1988, Congress explicitly reaffirmed that the copyright provisions of the U.S. Code “do[] not provide copyright

protection *for any work* that is in the public domain in the United States.” Act of Oct. 31, 1988, § 12, 102 Stat. 2853, 2860 (1990) (emphasis added). The Senate Report for this act provided that, “if a work has enjoyed protection in the United States, *either as an unpublished or as a published work*, and has subsequently had its term of protection expire there is no obligation to renew protection in that work.” S. Rep. 100-352 (1988), at 48 (emphasis added).

This analysis illustrates that there is not an “unbroken string of authority” supporting the broad copyright restoration of the URAA as consistent with Congress’ authority under the Progress Clause. *Golan v. Gonzales*, 2005 WL 914754, at *4 (D.Colo). Indeed, the unbroken string of authority suggests just the opposite.

2. Congress’ 1919 and 1941 Emergency Enactments Were Solely Extensions Of Time To Comply With Formalities And Did Not Contravene Congress’ Longstanding Principle Disallowing Removals of Expired Copyrights From The Public Domain

To the extent that respondents allege that the emergency copyright statutes of 1919 and 1941 suggest that Congress endorsed the removal of works from the public domain, they are incorrect. Each of these statutes simply extended the amount of time to comply with formalities *before initial copyright protection* was conferred. The first copyright statute, along with *Wheaton v. Peters*, illustrate that perfect title in copyright did not vest until all formalities were complied with. *See infra* Section I.B. In the 1919 statute, works that were published abroad during World War I were given extended time to comply with formalities. They could only achieve such protection if they complied with formalities “before the expiration of fifteen months after the date of the President’s proclamation of peace.” Act of December 18, 1919, Pub. L. 66-102, § 8(b), 41 Stat. 368, 369 (1921). This statute, meanwhile, amended but remained consistent with the 1909 Copyright Act, which repudiated removal of works from the public domain.

The 1941 Act, which also amended the 1909 Act, provided that the President could issue proclamations to extend time to comply with formalities—renewal or otherwise—when World War II made authors or their assigns “temporarily unable to comply with [those] conditions or formalities . . . *because of the disruption or suspension of facilities essential for such compliance.*” Act of September 25, 1941, Pub. L. 77-258, 55 Stat. 732 (1942) (emphasis added). This, therefore, was not meant to be an act to restore expired copyrights from the public domain. Rather, it was meant to give authors who published works abroad a fair opportunity to obtain initial copyright protection. To the extent that some works may have arguably been restored from the public domain as a result of these acts, moreover, the Tenth Circuit noted that the passage of such discrete acts “does not indicate that such removal was consistent with any provision of the Constitution.” *Golan v. Gonzales*, 501 F.3d 1179, 1192 (10th Cir. 2007). It was, “at most, a brief and limited departure from a practice of guarding the public domain.” *Id.* These enactments only “swe[pt] the constitutional issues under the rug.” Nimmer on Copyright § 9A.07 (2010).

3. Private Copyright Bills Passed By Congress Only Reinforce The Unconstitutionality of Copyright Restoration

While Congress has enacted several private copyright bills in the past, these bills only reinforce the unconstitutionality of Congress’ enactment of the URAA. Most of these bills were passed in the nineteenth century and, like the Sonny Bono Copyright Term Extension Act (CTEA), primarily extended the terms of *existing copyrights*.

The First three private copyright bills were granted to extend copyrights in John Rowlett’s book provided that he comply with certain formalities. Act of May 24, 1828, 6 Stat. 389, 389 (1862); Act of Feb. 11, 1830, 6 Stat. 403 (1862); Act of March 3, 1843, 6 Stat. 897, 897 (1843). Another Act provided an author additional time to comply with formalities as “if he had not already, by mistake,” proceeded to fulfill the deposit requirement in the wrong district court.

Act of Feb. 19, 1849, 9 Stat. 763 (1862). Two “widow’s bills” provided exclusive rights to widows whose husbands had created works and had not been fully compensated after they created those works. *See* Act of Jan. 25 1859, 11 Stat. 557 (1859); Act of May 24 1866, 14 Stat. 587 (1868). Two other private acts extended copyrights in the nineteenth century. Act of June 23, 1874, 18 Stat. 618, 618 (1875); Act of Feb. 17, 1898, 30 Stat. 1396 (1899). Such private acts were rare and secured rights for isolated individuals who had legitimate, short-term excuses for noncompliance with formalities.

The practice of private copyright bills virtually ceased in the twentieth century, but the one private bill that was passed was blatantly unconstitutional. This law granted copyright to Mary Baker Eddy in *Science and Health with Key to the Scriptures* for an extended copyright of seventy-five years and revived the copyright in “all editions heretofore published.” Act of Dec. 15, 1971, Priv. L. 92-60, 85 Stat. 857, 857 (1972). It, like the URAA, immunized reliance parties from liability who had engaged in “lawful uses made or acts done prior to the effective date” of the Act, and gave them one year to dispose of remaining copies. *Id.* The law was challenged on both Progress Clause and Establishment Clause grounds. *See United Christian Scientists v. Christian Science Board of Directors*, 829 F.2d 1152, 1154 (D.C. Cir. 1987). The District of Columbia Circuit held that this act of copyright restoration was unconstitutional based on the Establishment Clause of the First Amendment. *Id.* Although this case did not reach the Progress Clause claim, the case suggests that litigants have previously recognized the constitutional problems associated with copyright restoration.

B. *Wheaton v. Peters* Confirms That Materials With Expired Copyrights May Not Be Removed From the Public Domain

Wheaton v. Peters strengthens the argument that copyright restoration is unconstitutional. 33 U.S. (8 Pet.) 591 (1834). The thrust of the majority’s opinion was meant to place meaningful

limits on monopoly power—this was why the Court distinguished between the common law copyright prior to first publication and the “right from that which asserts a perpetual and exclusive property in the future publication of the work.” 33 U.S. at 657. The alternative—holding that Congress was merely sanctioning a pre-existing, perpetual copyright through the Copyright Act—would have suggested that grants of perpetual monopolies were a permissible option for Congress or state common law regimes under the Progress Clause. As the District Court below noted, the *Wheaton* Court “doubted the extent and duration of an author’s exclusive rights in his intellectual property at common law *but not the existence of those rights.*” *Golan v. Gonzales*, 2005 WL 914754, at *7 (D.Colo.) (emphasis added).

As we know, a federal perpetual copyright grant would clearly have violated the Constitution based on *Eldred*, 537 U.S. 186, 209-10 (2003), and a *state* copyright regime that effectively granted perpetual intellectual property rights would likewise contravene constitutional principles. *Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141 (1989). Thus, faced with the choice between perpetual copyright and a newly minted *federal right* that limited copyright terms, the *Wheaton* court ruled as it did.

The *Wheaton* ruling also said something about copyright formalities. Indeed, it supported the very principle supported by petitioners in this case: that copyrights, once expired, cannot be copyrighted anew. In *Wheaton*, the petitioner had allegedly not deposited a copy of the book—a case reporter—with the Secretary of State within six months of its publication. The court emphasized that “every requisite . . . is essential to the title” and copyright does not vest until all copyright formalities are performed. *Id.* at 665. If, on remand, a jury determined that formalities were not complied with, the Court effectively ruled that the case reporters *had expired* and must therefore enter the public domain. *Id.* at 667-68.

In *Luck's Music Library v. Gonzales*, 407 F.3d 1262 (D.C. Cir. 2005), the D.C. Circuit incorrectly assumed that *Wheaton v. Peters* supported an argument that the 1790 Act created new copyright protection for works in the public domain. 33 U.S. at 591. Without any analysis of the facts or context of the *Wheaton* decision, the *Luck's Music* court determined that Congress could remove works from the public domain because the *Wheaton* Court suggested that “Congress . . . , by [the 1790] act, instead of sanctioning an existing right, . . . created it.” 407 F.3d at 1265 (quoting *Wheaton v. Peters*, 33 U.S. (8 Pet.) at 661).

This argument, however, was simply incorrect. Congress did create a new *federal* right in the 1790 Act, but this federal right was only meant to create a uniform federal copyright regime. The new right, as noted above, did not remove works from the public domain. It only applied to “already printed” works that had obtained some form of copyright protection via state statute or common law. Since state copyright protections were not available across the United States, Congress needed to “secure” “exclusive rights to take the profits of their own publications *throughout the United States.*” Curtis, *supra*, at 81 (emphasis added). Further, even if one were to assume for the sake of argument that unprotected, public domain works could have been copyrighted under the act, the argument erroneously assumes that a *federal* public domain had been established prior to the 1790 Act. To the extent that any public domain existed in 1790, it was a *state* public domain established by existing state statutory or common law protections.

C. Principles Inherent To The Progress Clause Impose Categorical Limitations on Congress' Ability To Restore Works From The Public Domain

One of the primary goals of the Progress Clause is to promote the development of new and creative uses for works. It is a means to “motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius *after the limited period of exclusive control has expired.*” *Sony Corp. of America v.*

Universal City Studios, Inc., 464 U.S. 417, 429 (1984) (emphasis added). This Court has repeatedly reaffirmed this principle in numerous contexts, where it has confirmed that expired copyrights cannot be restored from the public domain.

1. Once A Copyright Expires, The Progress Clause Requires That the Public Be Able To Make The Reasonable Assumption That The Work Will Remain In The Public Domain

It does not matter how intellectual property protection expires. Once it does, the work irrevocably enters the public domain. In *Bonito Boats v. Thunder Craft Boats*, for example, the Court struck down a Florida statute that provided patent-like “protection for an unlimited number of years to all boat hulls and their component parts,” regardless of whether or not “patent protection has been denied or has expired” for the boat hulls. 489 U.S. 141, 159 (1989). Regardless of *how* patent protection was unavailable or had expired, the public needed to safely assume that it could innovate using information in the public domain. The Court expressed concern that the Florida statute would effectively chill any efforts to innovate through the use of “reverse engineering,” which often leads to “significant advances in technology.” *Id.* at 160.

In the copyright context, analogous efforts to innovate—creating derivative works, for example—could be chilled in a regime that allowed for copyright restoration, as similarly situated parties to *Golan* would not be willing to assume the risk associated with the possibility of future infringement claims. If parties are unwilling to assume the risk to innovate, the fact that current reliance parties are given a one-year grace period and freed from liability under the URAA is irrelevant. A ruling for respondents here would only reinforce the possibility that *more* works will be restored by the URAA in the future. And, a failure to categorically bar restoration could also open the door for Congress to restore American works, which were not restored by the URAA. The potential for future restoration creates uncertainty and unpredictability in our

Copyright law akin to the current “Orphan Works Problem,” which chills uses of myriad creative works today out of concern that missing copyright owners will file infringement lawsuits.¹

This Court has embraced a predictable regime of copyright expiration to maintain the integrity of the public domain. In *Dastar*, this Court rejected a Lanham Act Claim by Twentieth Century Fox for “reverse passing off” after the defendant had adapted and repackaged Fox’s television show that had entered the public domain. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003). Despite the legitimacy of federal regulation via the Lanham Act under the Commerce Clause, the Court held for the defendants because, in this context, “the Lanham Act [conflicted] with the law of copyright,” which requires that, “once the patent or copyright monopoly *has expired* the public may use the invention or work *at will* and without attribution.” *Id.* at 33-34 (emphasis added). In that case the copyright was deemed expired because Fox “did not renew the copyright on the . . . television series, which expired in 1977, leaving the television series in the public domain.” *Id.* at 26. Here, many of the restored works governed by the URAA are in the public domain due to expiration from failed renewals.²

2. The URAA Grants Restored Copyrights to Unoriginal Works of Authorship, Which is Unconstitutional Under the Progress Clause

The URAA also contravenes the “originality” requirement of copyright law. In interpreting the meaning of the “origin” of a work in *Dastar*, the Court noted that the defendant *Dastar* had “originated” the work that it had adapted from the public domain. 539 U.S. at 38.

¹ See Marybeth Peters, The Orphan Works Problem and Proposed Legislation, <http://www.copyright.gov/docs/regstat031308.html> (Mar. 13, 2008). The URAA will also chill innovation for works that *remain in the public domain*, since the URAA “has made it almost impossible to determine with certainty whether a book published from 1923 to 1964 is, indeed, in the public domain. Peter B. Hirtle, Copyright Renewal, Copyright Restoration, and the Difficulty of Determining Copyright Status (July/Aug 2008) http://ecommons.library.cornell.edu/bitstream/1813/10884/6/Copyright_renewal_final.pdf, at 3.

² Indeed, if American copyrights were restored by the URAA, the work at issue in *Dastar* would have presumptively been renewed in 1975, which would have extended copyright protection in the work until 2042. See 17 U.S.C. § 304(a)(2)(A) (2006) (granting a 67 year renewal term to works published on or before January 1, 1978). Note that the last possible renewal date for *any* work in the U.S. Copyright System was January 1, 2006. See *id.*

This underscores the relevance of cases like *Graham* and *Feist*, as discussed below. Per the interpretation of “origin” in *Dastar*, the originator of a work that has entered the public domain is *not* necessarily the original copyright holder, but instead can be *any person* who uses a public domain work, such as the reliance parties here who have used the works restored by the URAA.

If the originator of a work that has entered the public domain can be *any citizen*, a public domain item can hardly be deemed original or worthy of copyright protection. In *Feist v. Rural Telephone Service*, the petitioner—again like the reliance parties here—created a local telephone directory using public domain information from the respondent’s white pages listings. 499 U.S. 340 (1991). The Court rejected the respondent’s infringement claim, however, because the white pages were not copyrightable. As the Court noted, “[t]o qualify for copyright protection, a work must be original.” *Id.* at 345. There, the work was unoriginal—and uncopyrightable—because the organization of ideas within the white pages did not possess the “minimal degree of creativity” necessary for protection, albeit some creativity. *Id.* at 345. In the URAA, meanwhile, an *entirely new copyright* is being granted to an initial author’s next of kin despite the fact that the work is no longer original and possesses *no degree of creativity*.

The same principle—that materials in the public domain cannot be copyrighted anew—that applies to *Dastar* also applies to *Feist*. In *Dastar*, the “origin” of the public domain work was Dastar—and not Fox—because the work at issue had already entered the public domain. In *Feist*, the originator of the uncopyrightable facts was Feist—and not Rural—because Rural could not have been an author when this Court has defined “‘author,’ in a constitutional sense, to mean ‘he to whom anything owes its origin; originator; maker.’” *Feist*, 499 U.S. at 346 (quoting *Burrow-Giles*, 111 U.S. at 58). As *Dastar* noted, because the copyright laws were designed to “protect originality or creativity,” the “originator” of a work no longer refers to the initial author

“of any idea concept, or communication embodied in those goods” once that work has entered the public domain. *Dastar*, 539 U.S. at 38. Rather, it can refer to *anyone* who utilizes the work. The initial author, for constitutional purposes, is thus not the “author” of an “original” work once the work has entered the public domain.

If this Court were to adopt a copyright regime allowing works with expired copyrights to be granted protection anew, moreover, we would enable Congress to declare that an unoriginal, public domain, work is somehow original by legislative fiat. But, as this Court has noted, “[t]he originality requirement articulated in *The Trade-Mark Cases* and *Burrow-Giles* remains the touchstone of copyright protection today.” *Feist*, 499 U.S. at 340. At one point, the works restored by the URAA were original works of their initial authors, but that is no longer true now. Some of the works restored by the URAA were in the public domain for 60 years or more prior to restoration.³ And, if this Court allows Congress to declare that a public domain work is an “original” work of an author at any time, we effectively open the door to the specter of perpetual copyright, for any reliance party who seeks to use a public domain work moving forward must live with the possibility that a copyright may be restored in the future. The constitution mandates this Court to foreclose that looming possibility. This, again, is distinct from *Eldred*, where the works at issue had never actually reached the public domain; there was less of a justification for an assumption that the works could—or should—be freely exploited by reliance parties. There was no issue of *new* copyright grants to unoriginal works. Terms were simply extended.

³ A noteworthy example of this is Prokofiev’s *Peter and the Wolf*. This work, which was originally published in the USSR in 1936, was in the public domain for 60 years before its copyright was restored on January 1, 1996 by the URAA. See 17 U.S.C. § 104A(h)(2)(A) (2006). This work has been performed for small children by Plaintiff Richard Kapp, Compl. ¶ 69, and adapted by numerous others for decades as *their* original works. Despite the fact that this work completely lacked any originality as of 1996, it has been copyrighted anew for a term that will last until 2031. See 17 U.S.C. § 104(a)(1)(B) (2006) (noting that the copyright term shall subsist for the remainder of the term of copyright that the work would have otherwise been granted in the United States if the work never entered the public domain in the United States). For works created before 1978, that term is 95 years from publication. 17 U.S.C. § 304(b) (2006).

Graham, meanwhile, embodies similar principles. Like the originality requirement of copyright law, *Graham* was based, in principle, on the novelty requirement in patent law. While the Court below attempted to dismiss *Graham* on this ground, noting that “the language plaintiffs cite from *Graham* is taken from a discussion about the Progress Clause in the context of conditions for patentability,” *Golan v. Gonzales*, 501 F.3d 1179, 1186 (10th Cir. 2007), the court below failed to acknowledge the useful analogue between copyright’s originality requirement and patent’s novelty requirement. Just as the novelty requirement in patent fosters “[i]nnovation, advancement, and things which add to the sum of useful *knowledge* . . . in a patent system,” *Graham*, 383 U.S. at 6 (emphasis added), the originality requirement in the copyright system fosters innovations in *creative expression* that “promote the Progress of Science and useful Arts” in that context. U.S. Const. Art. I., § 8, Cl. 8. Indeed, original expression is what drives innovation in copyright—the layout of facts in a phone book, the design of drop down menus in computer software, and the repackaging of a musical work to reach the educational needs of a young audience are all expressive elements of works that serve useful purposes in copyright.

D. *Eldred* Also Illustrates That Removal Of Expired Works From The Public Domain Is Barred by the Progress Clause

While *Eldred* supported the proposition that Congress could extend the term of *existing* copyrights, that opinion did not suggest that Congress could resurrect *expired* copyrights from the public domain. If anything, its reasoning suggests just the opposite. In upholding the CTEA, the Court emphasized that Congress had engaged in an “unbroken . . . practice of granting to authors of works with *existing copyrights* the benefit of term extensions so that all under copyright protection will *be governed evenhandedly* under the same regime.” *Eldred*, 537 U.S. at 200 (emphasis added). This consistent congressional practice was entitled to “very great weight.” *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57 (1884). But, as the Court noted, the

consistent practice had *only* applied to future works and existing works “not yet in the public domain.” *Id.* at 213. The foregoing discussion showed how the consistent congressional practice has been to *deny* general copyright restorations. And, URAA’s restoration does not ensure that all copyright owners are treated evenhandedly, as the URAA only restored foreign copyrights.

As Justice Stevens noted in dissent in *Eldred*, meanwhile, “no one seriously contends that the Copyright/Patent clause would authorize the grant of monopoly privileges for works already in the public domain.” *Eldred*, 537 U.S. at 799-800 (Stevens, J., dissenting). No member of the *Eldred* majority challenged this, despite its efforts to refute several of Justice Stevens’ arguments. The D.C. Circuit’s *Eldred* opinion also emphasized that the Progress Clause “preclude[s] Congress from authorizing . . . a copyright to a work already in the public domain.” *Eldred v. Ashcroft*, 239 F.3d 372 (D.C. Cir. 2001). This, too, went unchallenged by the Court.

The *Eldred* holding, finally, is consistent with petitioners’ reading of “limited Times.” Because the Framers were presumably aware of the Statute of Anne and the British practice of “granting patent term extensions and of term renewal for copyright,” the Framers contemplated that “for limited times” provided authority for *extensions* of existing copyrights. *See* Edward C. Walterscheid, *The Nature of The Intellectual Property Clause: A Study in Historical Perspective* 272 (2002). As this Court noted in *Pennock v. Dialogue*, however, the phrase “limited Times” “contemplates . . . that this exclusive right shall exist but for a limited *time*, and that the *period* shall be subject to the discretion of Congress.” 27 U.S. (2 Pet.) 1 (1829) (emphasis added). This language contemplates a copyright grant for a single, uninterrupted term. The constitution has never been construed by this Court to allow Congressional grants of multiple copyright time periods that allow works to arbitrarily exit and re-enter the public domain. *Eldred* would have been a different case if the works at issue there—such as “Rhapsody and Blue” and Mickey

Mouse—had already lapsed into the public domain and then Congress decided five years later through a different statute to add another twenty years to those *expired* copyrights.

E. The Categorical Constitutional Bar Against Copyright Restoration Imposed By the Progress Clause is a Safeguard Against Additional Constitutional Problems

When Congress first considered copyright restoration in the Berne Convention Implementation Act, it chose to leave the public domain intact and acknowledged that “Constitutional, commercial and consumer considerations” needed to be examined further. H. Rep. No. 100-609 (1988), at 52. It acknowledged, moreover, that there was “considerable debate” over whether or not Article 18(1) of the Berne Convention was “absolutely required in light of the sweeping discretion accorded states by Article 18(3).” *Id.* at 51.

When Congress initially enacted Section 104A to restore Mexican and Canadian copyrights under NAFTA shortly before it enacted the URAA, however, “Congress paid little, if any, attention to the Constitutional issues under the First and Fifth Amendments and the Copyright Clause.” 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, 172 (1996). This is similarly the case with the URAA, where Congress gave short shrift to constitutional considerations. *See* GATT Intellectual Property Provisions, Joint Hearing, House Committee of the Judiciary, Aug. 12, 1994; Uruguay Round Agreements Act, J. Rep. 103-412 (1994) (hereinafter Joint Hearings) (failing to address constitutional concerns within the URAA).

In the meantime, the Constitutional concerns triggered by copyright restoration remain. Besides the First Amendment problems due to the URAA’s suppression of reliance parties’ speech, the URAA also implicates concerns under the Fifth Amendment’s takings clause. The takings clause applies to intellectual property. *Ruckelshaus v. Monsanto*, 467 U.S. 986, 100-03 (1984). Insofar as copyright restoration constrains the movie restorer—such as Plaintiff John

McDonough— from disposing of restored versions of an original film, for example, he may not be adequately compensated for his creative efforts. The one year sell-off period outlined in the statute may not be sufficient to compensate for the reliance party’s initial investment. *See* 17 U.S.C. § 104A(d)(2)(A) (recognizing a reliance party’s right to infringe for only 12-months after receiving a notice of intent). The makers of derivative works who invest creative efforts to translate works or convert a book into an interesting movie also have their property taken from them. Although the URAA provides a compulsory license, such a license could be prohibitively expensive for reliance parties—moreover, it paradoxically forces the *creator* of the derivative work to pay *someone else* for an innovation that he or she created. *See* 17 U.S.C. § 104A(d)(3) (2006) (requiring the derivative work creator to pay “reasonable compensation” to the owner of the restored copyright). Copyright restoration has and will trigger takings claims in the future. These claims will be assessed under the regulatory takings framework of *Penn Central Transportation Co. v. New York City*. 438 U.S. 104 (1978). And, if a particular situation prevents a particular reliance party from doing virtually anything with a work, more general concerns may be raised. *See Lucas v. South Carolina Coastal Council*, 505 U.S. 1003 (1992).⁴

The fact that both First Amendment and Fifth Amendment claims are feasible as a result of the URAA sheds further light on why the Progress Clause can and should bar restoration of expired copyrights. In *Eldred*, this Court noted that further First Amendment scrutiny would be necessary when “Congress has . . . altered the traditional contours of copyright protection.”

Eldred, 537 U.S. at 221. When those bounds are unaltered—and they were not by the CTEA at

⁴ More reliance parties with possible takings claims are possible in the future, given that several countries—such as Singapore, the UAE, and Vietnam have joined Berne since Congress passed the URAA. Berne Convention for the Protection of Literary and Artistic Works, Status on April 15, 2011, <http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/berne.pdf>. As more countries join, more copyrights will be restored. *See* 17 U.S.C. § 104A(h)(2) (2006) (noting that the “date of restoration” of copyright is January 1, 1996 or the “date of adherence” to Berne).

issue in *Eldred*—it is unsurprising that Copyright’s internal safeguards were sufficient to protect constitutional interests. Moreover, no takings interests were implicated in *Eldred* because no reliance party could assume that a work would enter the public domain prematurely. At the point Congress has broken those traditional bounds of copyright, however, the floodgates of future constitutional challenges are opened, as they have been here. A clear, bright line rule against copyright restoration for expired copyrights guards against that.

F. The Limitations of the Progress Clause Constrain Congress’ Authority Under the Treaty Power and the Commerce Clause

The Progress Clause, as noted, places significant limitations on Congress’ power to enact Copyright legislation. Of Congress’ enumerated powers in Article I, the Progress Clause is the only one that sets forth “a particular mode of accomplishing the task.” Walterscheid, *supra*, at 156. It specifically requires that Congress “promote the Progress of Science and useful Arts, by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings.” U.S. Const. Art. I., § 8, Cl. 8 (emphasis added). In the other provisions of Article I, Section 8, meanwhile, Congress is given authority to accomplish the enumerated task without limitation. *Id.* Despite that fact, this Court has interpreted some of these clauses, such as the Commerce Clause and the Bankruptcy Clause, to contain implied limitations on constitutional power. *See United States v. Morrison*, 529 U.S. 598 (2000) (commerce clause); *United States v. Lopez*, 514 U.S. 549 (1995) (commerce clause); *Railway Labor Executives’ Assn v. Gibbons*, 455 U.S. 457, 471 (1982) (bankruptcy clause). Given the Progress Clause’s limiting language, it must provide even stronger limits on Congressional power.

1. The Berne Convention Cannot Be Used To Amend Constitutional Limits On Congress' Authority

And these limitations on Congressional Authority in the Progress Clause are not superseded by our adherence to the Berne Convention. Indeed, “the provisions of the Berne and TRIPs treaties cannot validate any provision of the retroactivity legislation that violates other provisions of the Constitution.” Karp, *supra*, at 183. In *Reid v. Covert*, moreover, the Supreme Court noted that there is nothing in the Supremacy Clause “which intimates that treaties and laws enacted pursuant to them do not have to comply with the provisions of the Constitution.” 354 U.S. 1, 16 (1957). Allowing treaties to take such force would “permit amendment” of the Constitution in a manner that is not sanctioned by Article V. *Id.* at 17. Ratification of a treaty only requires two-thirds of the Senate for Ratification, while the ratification of a Constitutional Amendment requires approval from two thirds of *both houses* as well as from three-fourths of the states. U.S. Const. Art. V. Thus, Congress’ attempt “to comply with the Berne Convention” *can*, contrary to the Tenth Circuit’s view, “exceed[] the reach of congressional power.” *Golan v. Gonzales*, 501 F.3d 1179, 1187 (10th Cir. 2007).

Ultimately, then, the European Union “may have all sorts of laws about copyrights or any other subject which are beyond the power of our constitutionally defined central government.” *Eldred v. Ashcroft*, 239 F.3d 372, 384 (D.C. Cir. 2001)(Sentelle, J., dissenting). But those laws are irrelevant to *our* Constitution’s interpretation. No Berne country has a “limited Times” provision in their written Constitution that maintains the fidelity of the public domain to the extent the United States does.⁵ The Court below ignored this reality.

⁵ See Lynn McLain, Thoughts on *Dastar* From a Copyright Perspective: A Welcome Step Toward Respite for the Public Domain, 11 U. Balt. Intell. Prop. L.J. 71, 86 n.69 (2003).

2. The Commerce Clause Cannot Be Used To Circumvent The Limitations of the Progress Clause

International trade considerations under the Commerce Clause also do not justify the enactment of unconstitutional legislation under the Progress Clause. The Court has already acknowledged that it can limit the applicability of a statute passed pursuant to Commerce Clause authority when it conflicts with the Progress Clause. *See Dastar v. Twentieth Century Fox Film Corp.*, 538 U.S. 23 (2003). The Bankruptcy Clause also limits Congress' authority to enact bankruptcy laws under the Commerce Clause. *See Railway Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457, 469 (1982). Moreover, a basic analysis of the Constitution illustrates that the Progress clause must limit Congress' authority to restore copyrights under the Commerce Clause. The Commerce Clause appears in the same list of enumerated powers in the Constitution as the Progress Clause, yet the Progress Clause also pertains to legislation that involves regulation of "Commerce with foreign Nations, and among the several states." U.S. Const. Art. I, § 8, Cl. 3. Thus, unless the Progress Clause were completely superfluous, one must conclude that the Progress Clause limits Congress' Commerce Clause authority.⁶

II. SECTION 104A IS ALSO UNCONSTITUTIONAL BECAUSE IT FAILS INTERMEDIATE SCRUTINY UNDER THE FIRST AMENDMENT.

While Section 104A exceeds the power of Congress under the Progress Clause of the Constitution, it also violates the First Amendment rights of petitioners. The law should be

⁶ Congress has already acknowledged this fact. International pressures recently led to the proposal of a law called the Database and Collections of Information Misappropriation Act, which would have protected *unoriginal* computer databases under copyright law. The goal, similar to the goal with the URAA, was to establish reciprocity with EU law, which protects such databases. The House Committee that reviewed the bill, however, reported it unfavorably out of committee. It noted that the bill "raised Constitutional questions," "defied the parameters articulated by the Supreme Court in the *Feist* decision," and "attempts to rely on the Commerce Clause of the United States Constitution *to do what the Intellectual Property Clause prohibits.*" H. Rep. 108-421 (2004), at 8 (emphasis added). In that case, Congress recognized that blind adherence to international law norms cannot justify a law that contravenes the Progress Clause.

subjected to heightened scrutiny under the First Amendment because the built-in safeguards of copyright law are inapplicable to the speech interests at issue here. Under such scrutiny, Section 104A should be found unconstitutional. As a content-neutral restriction on speech, the government must first show (1) that the statute was passed to deal with a significant government interest, and (2) that it does not burden substantially more speech than necessary. Section 104A cannot be justified by reference to any of the three government interests asserted.

A. Section 104A Should Be Subjected To First Amendment Scrutiny.

In *Eldred v. Ashcroft*, the Court discussed at length the relationship between copyright law and the First Amendment. 537 U.S. 186 (2003). In that case, the CTEA, which lengthened the current term of copyright by twenty years, was upheld. *Id.* In its analysis, the Court found that a First Amendment challenge to the CTEA was inappropriate. First, the Court noted that, in general, copyright serves as an aid to free expression by providing measurable financial incentives towards the issuance of new creative works. *Id.* at 219. Second, the “idea/expression dichotomy” preserves speech rights by ensuring that the underlying ideas, facts and concepts of a copyrighted work remain free for public use. *Id.* Third, the *Eldred* Court observed that even copyrighted works may themselves be exploited in limited ways by the public through the “fair-use” doctrine. *Id.* at 220. Finally, the CTEA statute itself contained significant free-speech safeguards that themselves served to prevent any major assault on speech rights. *Id.* Thus, *Eldred* held “copyright’s built-in free speech safeguards are generally adequate to address” First Amendment concerns. *Id.* at 221.

The Court was explicit, however, in noting that it was possible to subject a copyright law to a First Amendment challenge. Such a claim could presumably be entertained where, “Congress ha[d]. . . altered the traditional contours of copyright protection...” *Eldred*, 537 U.S.

at 221. Taken as a whole, the *Eldred* decision makes it clear that copyright laws can be scrutinized under the First Amendment in select circumstances. Namely, (1) the built-in safeguards and inherent purpose of copyright must be insufficient to safeguard the asserted speech rights; and (2) the offending law must have altered the traditional contours of copyright protection. These conditions are met here.

1. The Built-In Safeguards Of Copyright Are Inapplicable To The Speech Rights Asserted By Petitioners

Neither the general nature of copyright law nor preexisting accommodations to free speech therein will adequately protect the interests of petitioners. Specifically, the notion that copyright acts an “engine of free expression” is completely irrelevant to Section 104A. *Eldred*, 537 U.S. at 219. This law only serves to restore copyright protection to the works of foreign authors which have fallen into the public domain. 17 U.S.C. § 104A (2006). As such, the statute does not provide foreign authors with any prospective incentive to create new expressive works. The only purported benefit of the law to domestic authors is that foreign nations could “mirror” Section 104A and provide similar retroactive protection to American authors. *See* Joint Hearings at 231 (statement of Irwin Karp). Such a benefit similarly fails to create an “economic incentive to create and disseminate ideas.” *Eldred*, 537 U.S. at 219. In sum, Section 104A, unlike general copyright law, does not inherently support free expression.

In addition, the inherent safeguards of First Amendment rights in general copyright law cannot adequately protect the petitioners’ speech. For instance, the Court held in *Eldred* that the idea/expression dichotomy served effectively to protect the First Amendment rights. *Eldred*, 537 U.S. at 220. Under the CTEA, in fact, the speech rights of the public remained constant as it retained free use of the ideas and facts in currently copyrighted works. However, in this case, petitioners have relied for their livelihoods upon *full expressions* already in the public domain.

For instance, Lawrence Golan conducts student and community orchestras in Colorado. Compl. ¶ 52. He has accordingly relied upon musical works in the public domain, as the cost of the sheet music is hundreds of dollars less than for copyrighted works. Compl. ¶ 53. With the passage of Section 104A Golan and his orchestras are simply no longer able to continue performing works by foreign composers such as Prokofiev, Shostakovich, and Stravinsky. *Id.* ¶ 56. That Golan is now free only to utilize the ideas or concepts in these scores does not alleviate the suppression of his speech. As with all petitioners here, Section 104A has significantly burdened their speech and the idea/expression dichotomy of copyright law offers them no refuge.

The doctrine of fair use is similarly inapt to the present situation. This general First Amendment accommodation permits any member of the public to exploit a copyrighted work, if done for teaching, research, or similar non-commercial purposes. 17 U.S.C. § 107 (2006). However, as the Tenth Circuit noted, “The fact that the fair use doctrine permits some access to those works may not be an adequate substitute for the unlimited access enjoyed before the URAA was enacted.” *Golan v. Gonzales*, 501 F.3d 1179, 1195 (10th Cir. 2007). As an example, Ron Hall has operated his business Festival Films for over a quarter-century in part by selling classic movies which have entered the public domain. Compl. ¶ 78. He had previously been able to offer a substantial library of public domain, foreign films for purchase. *Id.* ¶ 82. Yet because of Section 104A, many of these movies have been granted new terms of copyright and Festival Films is no longer able to offer them for sale. *Id.* The speech of Festival Films is thus significantly burdened by Section 104A, regardless of whether Hall may now use the film *Metropolis* to teach a class on the director Fritz Lang. The URAA thus has harmed petitioners’ speech interests, even in spite of the doctrine of fair use.

Finally, while Congress included additional First Amendment protections in the CTEA, no comparable safeguards were written into the language of Section 104A. The *Eldred* Court observed that under the CTEA, libraries, archives and other institutions were allowed to distribute or utilize copyrighted works during the last twenty year period of copyright, if those works were not being exploited commercially. *Eldred*, 537 U.S. at 220. Further, the CTEA exempted small businesses from having to pay royalties for certain uses of copyrighted music. *Id.* Yet, as the Tenth Circuit held in this case, “[r]ather than excepting parties, such as plaintiffs, who have relied upon works in the public domain, the URAA provides only a safe harbor allowing a party to use a restored work for one year after receiving notice of the restored copyright protection.” *Golan*, 501 F.3d at 1195. This one-year grace period is wholly insufficient to protect petitioners’ speech. Symphony of the Canyons, for instance, is a local Utah orchestra and relies on public domain works for nearly 80 percent of its repertoire. Compl. ¶ 74. With Section 104A now law, it is no longer able to perform whole categories of foreign works. *Id.* ¶ 76. The mere fact that Symphony of the Canyons could potentially perform some of these works for a year does not change the reality that it would be financially prevented from ever using them after that point. Section 104A thus contains inadequate protections for the speech of petitioners. As the free speech accommodations in copyright law generally are similarly unsuited to address petitioners’ concerns, Section 104A should be subjected to First Amendment scrutiny.

2. Section 104A Alters The Traditional Contours Of Copyright Law.

The *Eldred* Court held, meanwhile, that the above-described speech protections contained in copyright law are adequate to protect speech rights “generally”, but in situations where a law has “altered the traditional contours of copyright protection,” it may be subject to First Amendment challenge. *Eldred*, 537 U.S. at 220. The Court did not specify these “traditional

contours,” but the opinion structurally provides indicia regarding what elements of copyright law would qualify. For example, Justice Ginsburg held that fair use and the idea/expression dichotomy were themselves “traditional” elements of copyright protection. *Id.* Such designation indicates that long-recognized doctrines which dictate the “scope of copyright protection” constitute these traditional contours. *Kahle v. Ashcroft*, 2004 WL 2663157 (N.D. Cal. Nov. 19, 2004) *aff’d sub nom. Kahle v. Gonzales*, 487 F.3d 697 (9th Cir. 2007). Section 104A alters the longstanding scope of copyright by providing new protection to works which were free for use in the public domain. As the Tenth Circuit Court emphatically held, “The principle that works in the public domain remain there is a traditional contour of copyright protection that § 104A alters.” *Golan*, 501 F.3d at 1195.

As shown above, American copyright has steadfastly adhered to the model that a new creative work is created, legally protected, and then becomes permanently available for unfettered use in the public domain. Section 104A, by contrast, serves to undo this foundational conception of copyright law by removing works from the public domain and providing them newfound legal protections. Professor David Nimmer has noted that the extraction of works from the public domain amounted to a “revolution.” As he argued in *Nimmer On Copyright*: “No longer [does the public domain] represent a boundary from which no copyright could ever return. Instead, the public domain was transformed into a way-station of suspended protection, a limbo from which works could potentially be rescued . . .” *Nimmer on Copyright* § 9A.01 (2010). The lower court also recognized this significant break from past legal understanding. As the Tenth Circuit held below, “Under § 104A, the copyright sequence no longer necessarily ends with the public domain: indeed, it may begin there.” *Golan*, 501 F.3d at 1189. Indeed, it is difficult to envision a more radical change effected upon expressive protection than that enacted under

Section 104A. No longer do the speech rights of the public expand with regard to expressive works over time, as copyright protections are lost and enter the public domain. Instead, the rights utilized by petitioners for decades have contracted with the copyrighting of the formerly public works which they had used. As shown above, there is no precedent for Congress enacting a regulation which pulled works wholesale out of the public domain. See *supra* Section I.A. Both legal and historical perspectives demonstrate that Section 104A alters the contours of copyright law, and as such the measure should be subjected to First Amendment scrutiny.

B. Section 104A Implicates First Amendment Rights of Petitioners

The First Amendment speech rights of petitioners have been unconstitutionally violated. Petitioners have established vested interests in the continued use of certain public-domain works for the purposes of speech through performance, restoration, preservation, and sale. With the newfound copyright status of many of these materials, petitioners can no longer expressively utilize them as had been possible for several decades. As such, Section 104A amounts to a profound burden on the speech of petitioners.

These speech interests are not in any way diminished because of their association with commercial endeavors. For instance, the musically-oriented petitioners Lawrence Golan, Richard Kapp, and Symphony of the Canyons may charge a small fee to their concert-audiences. This sale does not lessen the First Amendment protections of their musical speech. The Court recognized, for instance, in *International Society for Krishna Consciousness, Inc. v. Lee* that the sale of literature is itself a type of speech. 505 U.S. 672 (1992). In that case, a ban on the sale and distribution of literature in a public airport was struck down on First Amendment grounds. In his concurrence, Justice Kennedy noted that these commercial activities implicated the very core of the First Amendment. *Lee*, 505 U.S. at 703 (Kennedy, J. concurring). As he noted, “The effect of

a rule of law distinguishing between sales and distribution would ...leav[e] speech as the preserve of those who are able to fund themselves.” *Lee*, 505 U.S. at 709 (Kennedy, J. concurring). Further, *Ward v. Rock Against Racism* held that, “[m]usic, as a form of expression and communication, is protected under the First Amendment.” 491 U.S. 781, 790 (1989). Thus, petitioners engaged in musical expression have significant speech rights which have been violated by Section 104A.

No less important are the speech interests of petitioners John McDonough and Ron Hall who preserve and sell public domain-films and television shows. The Court has demonstrated in several contexts that the sale of an expressive work itself amounts to an activity protected by the First Amendment. In *Arcara v. Cloud Books, Inc.* the Court found that “bookstores” are “engaged in First Amendment protected activities.” 478 U.S. 697, 705-06 (1986). Further, Justices White, Stevens and O’Connor reaffirmed this point in *City of Lakewood v. Plain Dealer Pub. Co.*, where they agreed that, “[t]here is a First Amendment right to sell books...” 486 U.S. 750, 780 (1988)(White, J. dissenting). Finally, in the specific context of selling and exhibiting of films the Court has held that even operators of adult-themed theaters and video stores possess First Amendment speech rights in operation of their businesses. *See e.g., FW/PBS, Inc. v. City of Dallas*, 493 U.S. 215, 224 (1990); *City of Renton v. Playtime Theatres, Inc.*, 475 U.S. 41, 45, (1986). As such, the Court has consistently agreed that the commercial sale of expressive works amounts to a constitutionally protected speech act on the part of the seller.

Petitioners also possess strong speech rights to communicate through works originally composed by others. In the *Eldred* case, the petitioners there sought the right to exploit copyrighted works which would have entered the public domain but for the CTEA. *Eldred*, 537 U.S. at 220. The Court held that while First Amendment concerns are raised when the

government burdens original communication, “it bears less heavily when speakers assert the right to make other people's speeches.” *Id.* Here, the First Amendment bears quite heavily on the rights asserted by petitioners for two reasons. First, in performing musical works, conductors must make numerous expressive decisions, such as which parts of a score to play, in what manner, and through which instruments.⁷ Such activity clearly is more akin to creative speech rather than mere copying of previously made work. Thus, when Lawrence Golan, Richard Kapp or Symphony of the Canyons arranges and performs a musical composition, the resulting communication is quite clearly the protected, expressive speech of petitioners, though they did not originate the score.

Second, even if petitioners are indeed only relaying the speech of others to new audiences, then the First Amendment is still implicated when such endeavors are burdened. As noted earlier, the Court has firmly held that purveyors of expressive works possess speech rights in their distributive acts. Further, the iconic case of *New York Times v. Sullivan* demonstrates that a speaker’s First Amendment rights may be violated, even when another party originally authored the words spoken. 376 U.S. 254 (1964). In that case the Court famously held that newspapers possessed important First Amendment rights and as such, libel actions of public officials may not be sustained unless actual malice can be proved. *Id.* The fact that the offending words were authored by persons outside the staff of the Times was of no moment. The Court held “[t]hat the Times was paid for publishing the advertisement is as immaterial in this connection as is the fact that newspapers and books are sold.” *Id.* at 266. Accordingly, the First Amendment rights of the newspaper remained constant regardless of where the words in their

⁷ See e.g., Jonathan N. Schildt, *One's Own Speech: First Amendment Protection for the Use of Public Domain Works in Golan v. Gonzales*, 58 DePaul L. Rev. 219, 237 (2008) (finding that musical arrangements are a “common example of the interplay between copying and creation.”) See also, Christopher Sprigman, *Reform(Aliz)ing Copyright*, 57 Stan. L. Rev. 485, 568 (2004) (finding that, “appropriation and “remixing” is a common way that speech is constructed in our culture.”).

pages had originated from. The Court has also found consistently that burdens upon hand-billing, leafleting and canvassing were unconstitutional restrictions upon the speech of those performing such actions. *See, e.g., Watchtower Bible & Tract Soc. of New York, Inc. v. Vill. of Stratton*, 536 U.S. 150 (2002); *Schneider v. State of New Jersey, Town of Irvington*, 308 U.S. 147 (1939). In those cases the Court paid no attention to the original author of the handbills or other literature, and found that restrictions upon the expressive act of distribution themselves implicated the First Amendment. Accordingly, petitioners here have engaged in expressive activity by disseminating the public-domain works of foreign authors. They have both selected which works to sell and distributed them, acts which are communicative and constitutionally-protected under the Court's precedent. Such actions necessarily allow petitioners to relate their opinions about the quality of the works themselves, and the messages contained therein. A restriction on further distribution implicates the constitutional guarantee of free speech.

C. Section 104A Is Unconstitutional Under The First Amendment, As It Either Fails To Advance A Significant Government Interest Or Is Not Narrowly Tailored.

As a content-neutral restriction on petitioners' speech, Section 104A should be found unconstitutional. Intermediate scrutiny is utilized to review regulations that restrict communication but are not justified by the content of the speech restricted. *Turner Broad. Sys., Inc. v. F.C.C.*, 512 U.S. 622, 642 (1994) (holding that "regulations that are unrelated to the content of speech are subject to an intermediate level of scrutiny"). Both the District Court and Tenth Circuit held correctly that Section 104A amounts to a content-neutral restriction upon petitioners' speech. Accordingly, the Court should apply the test from *United States v. O'Brien* which holds that to sustain a content-neutral speech regulation, the government must initially be addressing an "important or substantial government interest." *United States v. O'Brien*, 391 U.S. 367, 377 (1968). This prong has been subdivided by the Court in later cases into three discrete

inquiries. First, the state must demonstrate that the challenged regulation addresses a significant interest in the abstract. *Edenfield v. Fane*, 507 U.S. 761 (1993). Second, that interest must pertain to a real problem which the law is designed to solve. *Id.* Third, the government must show that the regulation will in fact alleviate this harm in a “direct and effective” manner. *Id.* Yet, even if the government demonstrates that its alleged interests are sufficiently important, real, and addressed by the law, under *O’Brien* the state still has the burden of showing that the restrictions on speech caused by the law are “no greater than is essential” to achieve the government’s prescribed aim. *O’Brien*, 391 U.S. 367, 377 (1968).

The government has asserted three separate aims which allegedly justify Section 104A’s speech-restrictions. In lower courts the government argued that Section 104A advances the goals of (1) compliance with the Berne Convention; (2) protecting the interests of American authors abroad; and (3) remedying past inequities suffered by foreign authors in the United States. As such, the government must demonstrate that these goals are in fact sufficiently important to justify the ensuing speech burdens of Section 104A. Further, the government must show that the law is narrowly tailored to the achievement of these interests. The government is unable to meet this burden as none of their asserted interests satisfy both requirements of *O’Brien*.

1. While Compliance With The Berne Convention May Be A Significant Interest, Section 104A Is Not Narrowly Tailored To Achieve That Aim.

a. Treaty Compliance Is Possibly A Significant Interest Of The Government.

Compliance with the Berne Convention mandates may be a substantial goal for the government in general but, Section 104A remains subject to further constitutional review even if justified on those grounds. The Court has often reviewed the question of what interests are significant in the abstract de novo, examining the objective importance of the interest asserted and the relative burdens imposed upon speech rights. Given the constitutional responsibility of

the legislature to approve treaties entered into by the executive, it is possible that the goal of treaty compliance amounts to an “important” interest of the government in the context of First Amendment challenges. *See, Citizens for Peace in Space v. City of Colorado Springs*, 477 F.3d 1212 (10th Cir. 2007). Further, while there is debate on this issue, Congress was presented with evidence that the nation may not have been complying with its obligations under the Berne Convention. *Joint Hearings* at 131 (Statement of Ira Shapiro) (arguing that “It is likely that other WTO members would challenge the current implementation of Berne if it is not enlarged”). The legislature thus could have reasonably concluded that granting retroactive protections to foreign authors through harsh suppression of domestic reliance party-speech would remedy this problem.

b. Section 104A Is Not Narrowly Tailored To Advance The Interest Of Treaty Compliance, And Should Thus Be Found Unconstitutional.

However, the URAA unconstitutionally suppresses far more speech than required in order to comply with the Berne Convention and thus fails the narrow-tailoring requirement of *O’Brien*. Congress initially declared U.S. law to be in compliance with the Berne Convention through the original Implementation Act in 1989. *Nimmer on Copyright* § 9A.01 (2010). That law did not restore foreign works to copyright status if they had fallen into the public domain through noncompliance with U.S. law, as potentially required by Article 18 of the Berne treaty. The URAA was passed, allegedly in part, to bring domestic copyright protection in line with the broader retroactivity requirements of the Berne Convention. *Joint Hearings* at 131. Yet Section 104A provides foreign authors with far more copyright protection than the treaty requires. Ordinarily, nothing prevents the federal government from exceeding its obligations under international agreements, to provide additional assurances of compliance, for instance. However, when those unnecessary measures come at the expense of constitutionally protected

speech, then such provisions are unconstitutional. In this case petitioners have had their speech burdened far more than necessary to achieve compliance with the Berne Convention.

It is clear from the very text of the Berne treaty that Section 104A is not narrowly tailored for compliance. Article 18 only holds that foreign works which have not fallen into the public domain through an “expiry of the term of protection which was previously granted” must be restored to copyright status. Berne Convention, Article 18(2). Yet, through the URAA, Congress has mandated that foreign works which already received a period of protection under U.S. copyright law, but then fell into the public domain, are now restored to copyrighted status. 17 U.S.C. § 104A(h)(6)(C)(i) (2006). Incredibly, this means that a foreign symphony which received 28-year period of copyright, was not renewed for a second term, and accordingly entered the public domain, has now been granted copyright protection anew. Professor Nimmer agrees that the recapture of such unrenewed works “would seem not to be required under the terms of the Berne Convention.” Nimmer on Copyright § 9A.06 (2010). But this is precisely what Section 104A provides, and in so doing, it needlessly prevents petitioners from using such works often for decades into the future.

Further, Article 18 of the Berne Convention is highly accommodating to differing implementations. The treaty states, “...the respective countries shall determine, each in so far as it is concerned, the conditions of application of this principle [of retroactive protection].” Berne Convention, Article 18(3). The official commentary on the treaty is even more explicit when it comes to the situations of countries like the United States, as it explains, “Thought must be given to those who have, *quite properly*, taken steps to exploit those works [in the public domain] and who would be financially embarrassed, to say the least, if the authors suddenly acquired exclusive rights to control what they had been freely doing” World Intellectual Property

Organization, Guide to the Berne Convention 101 (1978)(emphasis added). The United States has an unusually large number of foreign works in the public domain in large part because it joined the Berne Convention only recently. Accordingly, there exists in the United States a uniquely large group of reliance parties, including petitioners, who have “quite properly” relied upon works in the public domain for their expressive interests. World Intellectual Property Organization at 101. While the government may argue that congressional interpretation of treaties is entitled to some deference, evidence consistently indicates that treatment of the domestic reliance parties under the URAA is not required under Berne. As Irwin Karp stated, “The Berne Convention does not require [the language of the URAA]. On the contrary it permits much more protection of reliance parties...” Joint Hearings at 230 (statement of Irwin Karp).

Further, while the Court has made clear that a content-neutral regulation should not be struck down on the basis of some “less-speech-restrictive alternative,” it has also held that a narrow-tailoring inquiry can be aided by looking to the various ways by which the government’s interest might have been achieved. *Ward*, 491 U.S. at 800. Justice O’Connor noted how “[t]he availability of less burdensome alternatives . . . signals that the fit between the legislature’s ends and the means chosen to accomplish those ends may be too imprecise to withstand First Amendment scrutiny.” *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 529 (1996) (O’Connor, J., concurring). Accordingly, the various options that were put before Congress which would protect reliance party speech further illuminate the overbreadth of Section 104A.

Indeed, the URAA could have incorporated a far more protective scheme towards reliance interests while still complying with U.S. obligations under Berne. For instance, under the “Commonwealth Model” of retroactive protection, the owners of restored copyrights have the option to buy-back the use of their works from reliance interests or, in some cases, submit to

an arbitration process to determine an adequate compensation. Joint Hearings at 230 (Statement of Irwin Karp). This scheme is utilized in nations such as the United Kingdom, Ireland, India, South Africa, New Zealand and Australia. *Id.* Yet the hired defense expert, Mihaly Ficsor, contends that such a model is insufficient under Berne and would thus place these nations at risk for adverse judgment at a World Trade Organization settlement dispute panel. Report of Dr. Mihaly Ficsor (December 5, 2008) ¶ 95.

Ficsor erroneously relies in large part for his conclusions on a 1986 book by Sam Ricketson which interprets the language of the Berne Convention. *Id.* at ¶ 66. Ricketson is singularly cited by Ficsor for the proposition that, “the authors [of restored works]... must enjoy ...all the rights provided for in the Convention.” *Id.* On this basis, Ficsor concludes that the Commonwealth Model does not adhere to the requirements of Berne as it “does not grant [all] rights to the authors and other owners of rights under the Convention, but to the “reliance parties...”” *Id.* ¶ 95. However, this conclusion is flatly contradicted by an interpretation of the Berne Convention language by the same Sam Ricketson, published some twenty years after the work relied upon by Ficsor in his report. In their 2006 work, *International Copyright and Neighboring Rights*, Ricketson and Jane Ginsburg specifically note a “general point” under Berne Article 18(3): “Transitional provisions may require the restored copyright owner to compensate the reliance party whose business will be prejudiced, or terminated, by the enforcement of the restored copyright” Sam Ricketson and Jane Ginsburg, *International Copyright and Neighboring Rights* 343 (2006). It is unclear whether Ficsor ignored or did not have access to this new clarification from Ricketson and Ginsburg, but the conclusions of the defense report are left without any foundation. As such, the U.S. could have implemented greater

protections for reliance parties, such as those of the Commonwealth Model, while fully complying with Berne requirements.⁸

An alternative scheme such as that described above would in fact serve to fully protect the speech interests of petitioners. For instance, under a buy-out model, the restored copyright owner has an “option” to purchase the use rights of the work from a reliance party. As such, whenever an owner declines to purchase these use rights, a reliance party may permanently continue to utilize the work as they had prior to the restoration of copyright protection. Further, a reliance party may demand a price for their use rights which is prohibitively expensive for the copyright owner, and thus similarly continue to access the work as they had done previously. Accordingly, the Tenth Circuit erred when it held that a buyout model is not “substantially more protective of reliance parties’ *expressive* interests,” since under many circumstances such parties would retain full access to previously public works. *Golan*, 609 F.3d at 1093 (emphasis in original).

At least in some Commonwealth nations arbitration is employed to find a level of compensation appropriate for both sides, a process which also preserves the speech interests of reliance parties. In a report to Congress, Irwin Karp proposed a system of arbitration for the URAA that would provide reliance parties with more time to continue using works which they had substantially invested in or altered. Joint Hearings at 220. For as long as six to ten years, the speech of petitioners would not even be implicated by the URAA under his proposed statute. *Id.* at 221. Such temporal allowances would also satisfy Berne obligations, as noted by Ricketson and Ginsburg, since they remain “transitional in nature.” Ricketson at 343. Yet even without such grace periods, as Keith Glaser notes, such an arbitration process, “would reduce the

⁸ To the extent there is debate over the facts, given the Summary Judgment posture of this case, it may need to be remanded for a full development of the record.

incidental restriction on the First Amendment interests [of reliance parties.]”⁹ This is a consequence of the negotiated process itself, whereby parties that relied substantially upon works previously would be compensated to a far greater extent than those who had more limited interests in continued use of a given work. In addition, the Supreme Court has consistently held that while not itself speech, “money . . . enables speech” as it greatly assists citizens in disseminating their messages. *Nixon v. Shrink Missouri Gov't PAC*, 528 U.S. 377, 400 (2000) (emphasis in original). A compensatory payment would *solely* be used allow reliance parties to continue their expressive pursuits, either by enabling them to purchase copyrighted versions of other public domain works or by providing them the means to engage in similar forms of speech. As these described protections would comply with the requirements of Berne, Section 104A suppresses far more speech than is necessary to achieve compliance with the treaty; it is unconstitutional if justified by that interest.

2. Securing The Foreign Copyright Interests Of American Authors Is Not A Substantial Government Objective, And Section 104A Is Not Narrowly Tailored To Achieve It.

a. Acquiring Foreign Copyrights For American Authors Is Not A Significant Government Interest.

The government cannot demonstrate that the protection of American authors’ foreign interests is a significant goal in the abstract. First, the Tenth Circuit ruled incorrectly in holding that, “[a]lthough plaintiffs have First Amendment interests, so too do American authors.” *Golan*, 501 F.3d at 1084. This blanket statement misconstrues the nature of the protection afforded by the First Amendment abroad. Only once, in the case *Haig v. Agee*, has the Supreme Court held, “arguendo,” that the constitutional freedom of speech could have *any* relevance to Americans

⁹ Keith Glaser, *A Tune-Up on the Engine of Free Expression: The Traditional Contours of Copyright in Golan*, 18 DePaul J. Art, Tech. & Intell. Prop. L. 185, 210-11 (2007).

abroad. *Haig v. Agee*, 453 U.S. 280, 308 (1981). Furthermore, in that case, an American citizen was protesting adverse action taken against him by U.S. government for speech made abroad.

This case presents an entirely different situation, as the government asserts that American authors have First Amendment rights in controlling their speech internationally, under the laws of *foreign countries*. The Ninth Circuit came closest to ruling on this precise issue when Yahoo! Inc. challenged a French court order which blocked consumers in that country from parts of Yahoo!'s website. *Yahoo! Inc. v. La Ligue Contre Le Racisme Et L'Antisemitisme*, 433 F.3d 1199 (9th Cir. 2006). Yahoo! asserted that the foreign order infringed upon their First Amendment rights. However, as the Ninth Circuit noted, "Yahoo! is necessarily arguing that it has a First Amendment right to violate French criminal law and to facilitate the violation of French criminal law by others" and that, "the very existence-of such an extraterritorial right under the First Amendment is uncertain." *Id.* at 1226. Similarly, in this case American authors have no firm constitutional rights to control their speech under the laws of foreign nations. Rather, only petitioners who assert their rights of expression in the United States under American law have relevant constitutional concerns. Thus, securing the general expressive interests of some American authors abroad is an insufficient government rationale upon which to justify the silencing of constitutionally-protected speech.

Instead, securing foreign copyrights for American authors amounts to a sheer desire to enhance their income. The Tenth Circuit baldly asserted that this aim constituted a substantial interest of the government, on the basis that it was "at least as important" as others which the Supreme Court had upheld in the past. *Golan*, 501 F.3d at 1084. However, the Court has never found private economic aims to be significant in the context of Free Speech protection. The only interests that have been found sufficient to justify the silencing of speech are those which

advance public concerns, such as security, health and aesthetics. *See e.g., Young v. Am. Mini Theatres, Inc.*, 427 U.S. 50, 71 (1976) (finding a “city’s interest in attempting to preserve the quality of urban life is one that must be accorded high respect”).

Infringement on First Amendment rights has never been justified simply by the prospect of private economic gain. Such an interest has rarely been asserted in this context and never at the level of the Supreme Court. One lower court example is *Lewis v. Colorado Rockies Baseball Club, Ltd.* where a major league baseball club sought to prevent merchants from selling their programs on sidewalks adjacent to the stadium. *Lewis v. Colorado Rockies Baseball Club, Ltd.* 941 P.2d 266, 276 (Colo. 1997). The Rockies cited their concessions and other economic interests in the sidewalks, but the Colorado Supreme Court found that any monetary interests of the team in that area were matched by the merchants. *Id.* The court further noted that private economic interests had never been upheld as aims sufficient to justify burdens upon free speech. *Id.* The court held that “the economic interests of the Rockies are not an appropriate consideration at the ‘significant government interest’ stage of a free speech analysis.” *Id.* Similarly, the potential monetary gains for American authors through new foreign copyrights cannot be invoked to suppress the speech of petitioners here. In short, Congress cannot prevent Symphony of the Canyons from performing “Peter and the Wolf,” only to increase the profits of an American movie studio abroad. Accordingly, the financial dream of certain American authors is an insufficient government interest in the context of a First Amendment challenge.

Yet, even if these aforementioned interests of American authors are important government goals in the abstract, Congress did not have sufficient evidence to conclude that Section 104A would achieve them. Importantly, the interest which allegedly motivated Congress in passing the URAA was to achieve *strong* copyright protection for American authors abroad,

rather than any copyright protection at all. Eric Smith, for instance, testified that the URAA gave significant copyright protection to foreign authors so that the United States would be provided with “the *expansive* protection that we need.” Joint Hearings at 247 (emphasis added). Ira Shapiro noted the importance of using the URAA generally to “*increase* the leverage available to the U.S. to protect [domestic] industries” *Id.* at 340 (emphasis added). To achieve this goal, it was hoped that by burdening domestic reliance parties to the advantage of foreign authors, other countries would take similar action and thus provide robust copyright protection to American authors.¹⁰ The District Court below pointed out that this, “appears to be an assumption that Section 104A will encourage other countries to limit the rights of reliance parties, despite . . . having no obligation to do so under the Berne Convention.” *Golan v. Holder*, 611 F. Supp. 2d 1165, 1175 (D. Colo. 2009). Under the Court’s precedent, Congress must have found on the basis of “substantial evidence” that, by its treatment of reliance parties, Section 104A would secure American author’s foreign copyrights in a “a direct and effective way” *Turner Broad. Sys., Inc. v. F.C.C.*, 520 U.S. 180, 196 (1997); *Edenfield v. Fane*, 507 U.S. 761, 773 (1993). As the Tenth Circuit held, the relevant question is whether it was reasonable for Congress to conclude that, “limited protections for reliance parties were ‘necessary’ to garner similar protections from foreign countries.” *Golan v. Holder*, 609 F.3d 1076, 1090 (10th Cir. 2010). Congress lacked sufficient support for this questionable assertion.

In fact, very little evidence before Congress indicated the URAA would lead other countries to deny substantial protection to their reliance interests. A few interested parties attempted to support this position. As an example, Jason Berman, Chairman and CEO of the

¹⁰ *See, e.g.* Joint Hearings at 231 (Statement of Irwin Karp) (arguing, “A primary reason for the proposed limited and inadequate protections of American reliance interests is the desire of the motion picture, recording and software industries to avoid having other countries protect their reliance interests who are now legally using U.S. works in their public domain) (emphasis in original).

Recording Industry Association of America, testified, “[T]he Russians simply said . . . that they will interpret their obligations . . . in exactly the same manner the United States interprets its obligations.” Joint Hearings at 291. However, there was no discussion regarding whether Russia was actually *likely* to pass such a similar law, or if a representative of the American music industry was really in a position to predict such an outcome. At the same time, Congress heard evidence which specifically refuted the argument that harsh treatment of reliance parties here would cause other nations to follow suit abroad. For instance, Irwin Karp noted that there, “is absolutely no guarantee that [foreign nations] are stupid enough to adopt the reliance-party provisions you are being asked to adopt . . . unless we engage in trade-tactic arm twisting, there is no way in the world that they would cut their own throats by adopting these provisions.” Joint Hearings at 231 (statement of Irwin Karp, Counsel, Committee for Literary Studies). In sum, Congress lacked a substantial amount of evidence to conclude that denying protection to U.S. reliance parties would lead to foreign nations taking similar action against reliance parties within their borders. Thus, the burdens on petitioners’ speech cannot be justified by reference to the goals of American authors abroad.

b. Section 104A Silences Far More Expression Than Is Necessary To Acquire Foreign Copyrights For American Authors, And Is Therefore Unconstitutionally Overbroad.

Even if economic interests of American authors constitute an important government aim, and one addressed by the restrictions on reliance parties, Section 104A burdens much more speech than is required to achieve this aim. In order to conduct a proper inquiry into the relative overbreadth of a regulation, a court must be apprised of the predicted effect of the law. In *Turner I*, it was held that when there are no “findings concerning the actual effects,” of a regulation then a court cannot conclude that such a law is narrowly tailored. *Turner Broad. Sys.*,

Inc. v. F.C.C., 512 U.S. 622, 667-68 (1994)(plurality opinion). In such a situation, a law cannot satisfy the narrow tailoring inquiry precisely because it is impossible to determine whether the speech burdened by the law was unnecessarily suppressed. Here, no evidence was put before Congress elaborating on the likely benefits that would flow to American authors because of the burdens on petitioners' speech. The District Court agreed that there was "no evidence showing how suppression of reliance parties' First Amendment rights . . . provide[s] a 'direct and material' benefit to United States authors." *Golan*, 611 F. Supp. 2d at 1167 (quoting *Turner*, 512 U.S. at 664). Thus, Section 104A cannot be deemed narrowly tailored to achieve the copyright interests of American authors, because of the lack of hard evidence required to conduct such an inquiry.

Second, what little evidence was provided to Congress on achieving copyright protection for American authors overseas implies that petitioners' speech was unnecessarily burdened. Importantly, while the government may have a substantial interest in securing strong copyright protections for American authors abroad, it does not have a comparable interest in achieving such protection *solely* through the reduced rights of foreign reliance parties. Such a view would wrongly take the potential "effect of the statute and posit that effect as the State's interest." *Simon & Schuster v. Members of the N.Y. State Crime Victims Board*, 502 U.S. 105, 120 (U.S. 1991). As the government sought generally to provide strong copyrights to American authors, it had multiple avenues by which to accomplish that goal in a reciprocal framework. For instance, Congress could have provided longer terms of protection or harsher penalties for prospective infringement on restored foreign copyrights. Either measure, if reciprocated in turn to American authors abroad, would provide for stronger copyright protection than would have been received otherwise. Further, to suppress foreign reliance parties, Congress or U.S. Trade Representatives

could have engaged in the “trade-tactic arm twisting” suggested by Irwin Karp to achieve such a result *without* burdening the speech rights of domestic reliance parties. Joint Hearings at 231.

There is no evidence, in the legislative history or elsewhere which indicates that American foreign copyrights would be weakened if the U.S. utilized one of these alternative tactics.

Further, these options would have served to protect the speech of reliance parties to a far greater extent than the URAA. Yet, as implemented, Section 104A suppresses substantially more speech than necessary to acquire strong American copyrights abroad, and fails the narrow tailoring inquiry of *O’Brien*.

3. Equitable Treatment Of Foreign Authors Is Not A Substantial Government Interest And Section 104A Does Not Address It In A Narrowly-Tailored Manner.

The interest of providing equitable treatment to foreign authors is also insubstantial. The government has essentially argued that Section 104A provides fairness by granting “copyright protection to authors of foreign origin who lost their United States copyrights through no fault of their own” *Golan v. Holder*, 611 F. Supp. 2d 1165, 1177 (D. Colo. 2009). Accordingly, Section 104A was enacted on this view in order to provide these foreign authors with protections that were unfairly taken from them. This interest fails as an important government motivation, even in the abstract. Equitable treatment to foreigners has never been advanced as a motive to justify the suppression domestic speech. *Cf. Minneapolis Star & Tribune Co. v. Minnesota Com'r of Revenue*, 460 U.S. 575, 591-92 (1983) (holding that domestically, where a “State's commitment to . . . ‘equity’ is questionable,” such an interest cannot justify burdening speech). Instead, the goals of domestic safety, security or community standards have consistently motivated past content-neutral regulations upheld by the Court. *See, e.g. Rubin v. Coors Brewing Co.*, 514 U.S. 476, 490-91(1995) (finding, “the Government . . . has a significant interest in protecting the health, safety, and welfare of its citizens . . .”). Here, given the sheer novelty of the

desire to provide “fairness” to foreign authors, and the inherent need to protect the constitutional rights of citizens over the abstract interests of foreigners, it is highly doubtful that this aim constitutes a significant government interest.

Further, the goal of providing fair treatment to foreign authors cannot be shown to be a real problem or one that Section 104A effectively addresses. Congress was provided with virtually no evidence demonstrating that the supposedly treatment of foreign authors amounted to a threat facing the country. In fact, testimony was provided that many, “foreign authors...have lost their American copyrights without even having sought to exploit their works here...” Joint Hearings at 187 (Statement of Shira Perlmutter, Professor, Catholic University School of Law). If authors abroad never attempted to exploit their works in the U.S. it is difficult to see how providing them retroactive copyright protection is fair. Also, no actual inequity has affected foreign authors. Domestic and foreign authors alike were previously responsible for complying with the formalities of applicable copyright law, and if either failed to do so then copyright protection would be lost. Notably, the copyrights of American authors are *not* restored under the URAA. As the District Court found, “Section 104A appears to create an inequity where one formerly did not exist.” *Golan v. Holder*, 611 F. Supp. 2d 1165, 1176 (D. Colo. 2009). As Congress lacked any evidence to support the argument that Section 104A would provide equity to foreign authors the principle cannot be used to silence the speech of petitioners.

Finally, the URAA is not narrowly-tailored to provide fairness to foreign authors. The speech of reliance parties is unrelated to the provision of fairness to foreign authors. Here, the purported goal of the URAA was simply to give foreign authors the opportunity to reclaim copyrights that they had unjustly lost. Some of the alternative proposed schemes of regulation demonstrate the overbreadth of Section 104A if justified by this interest. For instance, Congress

could have utilized the “Commonwealth Model” described above, or the set time period advocated by Larry Urbanski, after which point works that had gone unclaimed by their authors would remain in the public domain. Joint Hearings at 277. It makes little sense to argue that it is necessary out of a principle of fairness to provide authors with permanent, new copyrights in cases where the copyright would ultimately be orphaned. Any combination of these schemes would provide a measure of equity to foreign authors by granting new terms of copyright protection, but would also serve to protect the speech rights of reliance parties. Section 104A is thus substantially overbroad as it suppresses far more speech than necessary to accomplish the interest of affording fairness to foreign authors.

CONCLUSION

For the foregoing reasons, the ruling of the Tenth Circuit should be reversed.

Respectfully submitted,

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April 18, 2011

APPENDIX

The Progress Clause of the United States Constitution provides:

The 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

U.S. Const. Art. I, § 8, Cl. 8.

The First Amendment to the United States Constitution provides:

Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.

Section 512 of the Uruguay Round Agreements Act (codified as amended at 17 U.S.C. § 104A (2006)) provides:

§ 104A. Copyright in restored works

(a) Automatic protection and term.--

(1) Term.--

(A) Copyright subsists, in accordance with this section, in restored works, and vests automatically on the date of restoration.

(B) Any work in which copyright is restored under this section shall subsist for the remainder of the term of copyright that the work would have otherwise been granted in the United States if the work never entered the public domain in the United States.

(2) Exception.--Any work in which the copyright was ever owned or administered by the Alien Property Custodian and in which the restored copyright would be owned by a government or instrumentality thereof, is not a restored work.

(b) Ownership of restored copyright.--A restored work vests initially in the author or initial rightholder of the work as determined by the law of the source country of the work.

(c) Filing of notice of intent to enforce restored copyright against reliance parties.--On or after the date of restoration, any person who owns a copyright in a restored work or an exclusive right therein may file with the Copyright Office a notice of intent to enforce that person's copyright or exclusive right or may serve such a notice directly on a reliance party. Acceptance of a notice by the Copyright Office is effective as to any reliance parties but shall not create a presumption of the validity of any of the facts stated therein. Service on a reliance party is effective as to that reliance party and any other reliance parties with actual knowledge of such service and of the contents of that notice.

(d) Remedies for infringement of restored copyrights.--

(1) Enforcement of copyright in restored works in the absence of a reliance party.--

As against any party who is not a reliance party, the remedies provided in chapter 5 of this title shall be available on or after the date of restoration of a restored copyright with respect to an act of infringement of the restored copyright that is commenced on or after the date of restoration.

(2) Enforcement of copyright in restored works as against reliance parties.--As

against a reliance party, except to the extent provided in paragraphs (3) and (4), the remedies provided in chapter 5 of this title shall be available, with respect to an act of infringement of a restored copyright, on or after the date of restoration of the restored copyright if the requirements of either of the following subparagraphs are met:

(A)(i) The owner of the restored copyright (or such owner's agent) or the owner of an exclusive right therein (or such owner's agent) files with the Copyright Office, during the 24-month period beginning on the date of restoration, a notice of intent to enforce the restored copyright; and

(ii)(I) the act of infringement commenced after the end of the 12-month period beginning on the date of publication of the notice in the Federal Register;

(II) the act of infringement commenced before the end of the 12-month period described in subclause (I) and continued after the end of that 12-month period, in which case remedies shall be available only for infringement occurring after the end of that 12-month period; or

(III) copies or phonorecords of a work in which copyright has been restored under this section are made after publication of the notice of intent in the Federal Register.

(B)(i) The owner of the restored copyright (or such owner's agent) or the owner of an exclusive right therein (or such owner's agent) serves upon a reliance party a notice of intent to enforce a restored copyright; and

(ii)(I) the act of infringement commenced after the end of the 12-month period beginning on the date the notice of intent is received;

(II) the act of infringement commenced before the end of the 12-month period described in subclause (I) and continued after the end of that 12-month period, in which case remedies shall be available only for the infringement occurring after the end of that 12-month period; or

(III) copies or phonorecords of a work in which copyright has been restored under this section are made after receipt of the notice of intent.

In the event that notice is provided under both subparagraphs (A) and (B), the 12-month period referred to in such subparagraphs shall run from the earlier of publication or service of notice.

(3) Existing derivative works.--(A) In the case of a derivative work that is based upon a restored work and is created--

(i) before the date of the enactment of the Uruguay Round Agreements Act, if the source country of the restored work is an eligible country on such date, or

(ii) before the date on which the source country of the restored work becomes an eligible country, if that country is not an eligible country on such date of enactment, a reliance party may continue to exploit that derivative work for the duration of the restored copyright if the reliance party pays to the owner of the restored copyright reasonable compensation for conduct which would be subject to a remedy for infringement but for the provisions of this paragraph.

(B) In the absence of an agreement between the parties, the amount of such compensation shall be determined by an action in United States district court, and shall reflect any harm to the actual or potential market for or value of the restored work from the reliance party's continued exploitation of the work, as well as compensation for the relative contributions of expression of the author of the restored work and the reliance party to the derivative work.

(4) Commencement of infringement for reliance parties.--For purposes of section 412, in the case of reliance parties, infringement shall be deemed to have commenced before registration when acts which would have constituted infringement had the restored work been subject to copyright were commenced before the date of restoration.

(e) Notices of intent to enforce a restored copyright.--

(1) Notices of intent filed with the copyright office.--(A)(i) A notice of intent filed with the Copyright Office to enforce a restored copyright shall be signed by the owner of the restored copyright or the owner of an exclusive right therein, who files the notice under subsection (d)(2)(A)(i) (hereafter in this paragraph referred to as the "owner"), or by the owner's agent, shall identify the title of the restored work, and shall include an English translation of the title and any other alternative titles known to the owner by which the restored work may be identified, and an address and telephone number at which the owner may be contacted. If the notice is signed by an agent, the agency relationship must have been constituted in a writing signed by the owner before the filing of the notice. The Copyright Office may specifically require in regulations other information to be included in the notice, but failure to provide such other information shall not invalidate the notice or be a basis for refusal to list the restored work in the Federal Register.

(ii) If a work in which copyright is restored has no formal title, it shall be described in the notice of intent in detail sufficient to identify it.

(iii) Minor errors or omissions may be corrected by further notice at any time after the notice of intent is filed. Notices of corrections for such minor errors or omissions shall be

accepted after the period established in subsection (d)(2)(A)(i). Notices shall be published in the Federal Register pursuant to subparagraph (B).

(B)(i) The Register of Copyrights shall publish in the Federal Register, commencing not later than 4 months after the date of restoration for a particular nation and every 4 months thereafter for a period of 2 years, lists identifying restored works and the ownership thereof if a notice of intent to enforce a restored copyright has been filed.

(ii) Not less than 1 list containing all notices of intent to enforce shall be maintained in the Public Information Office of the Copyright Office and shall be available for public inspection and copying during regular business hours pursuant to [sections 705](#) and [708](#).

(C) The Register of Copyrights is authorized to fix reasonable fees based on the costs of receipt, processing, recording, and publication of notices of intent to enforce a restored copyright and corrections thereto.

(D)(i) Not later than 90 days before the date the Agreement on Trade-Related Aspects of Intellectual Property referred to in section 101(d)(15) of the Uruguay Round Agreements Act enters into force with respect to the United States, the Copyright Office shall issue and publish in the Federal Register regulations governing the filing under this subsection of notices of intent to enforce a restored copyright.

(ii) Such regulations shall permit owners of restored copyrights to file simultaneously for registration of the restored copyright.

(2) Notices of intent served on a reliance party.--(A) Notices of intent to enforce a restored copyright may be served on a reliance party at any time after the date of restoration of the restored copyright.

(B) Notices of intent to enforce a restored copyright served on a reliance party shall be signed by the owner or the owner's agent, shall identify the restored work and the work in which the restored work is used, if any, in detail sufficient to identify them, and shall include an English translation of the title, any other alternative titles known to the owner by which the work may be identified, the use or uses to which the owner objects, and an address and telephone number at which the reliance party may contact the owner. If the notice is signed by an agent, the agency relationship must have been constituted in writing and signed by the owner before service of the notice.

(3) Effect of material false statements.--Any material false statement knowingly made with respect to any restored copyright identified in any notice of intent shall make void all claims and assertions made with respect to such restored copyright.

(f) Immunity from warranty and related liability.--

(1) In general.--Any person who warrants, promises, or guarantees that a work does not violate an exclusive right granted in [section 106](#) shall not be liable for legal, equitable,

arbitral, or administrative relief if the warranty, promise, or guarantee is breached by virtue of the restoration of copyright under this section, if such warranty, promise, or guarantee is made before January 1, 1995.

(2) Performances.--No person shall be required to perform any act if such performance is made infringing by virtue of the restoration of copyright under the provisions of this section, if the obligation to perform was undertaken before January 1, 1995.

(g) Proclamation of copyright restoration.--Whenever the President finds that a particular foreign nation extends, to works by authors who are nationals or domiciliaries of the United States, restored copyright protection on substantially the same basis as provided under this section, the President may by proclamation extend restored protection provided under this section to any work--

(1) of which one or more of the authors is, on the date of first publication, a national, domiciliary, or sovereign authority of that nation; or

(2) which was first published in that nation.

The President may revise, suspend, or revoke any such proclamation or impose any conditions or limitations on protection under such a proclamation.

(h) Definitions.--For purposes of this section and [section 109\(a\)](#):

(1) The term “date of adherence or proclamation” means the earlier of the date on which a foreign nation which, as of the date the WTO Agreement enters into force with respect to the United States, is not a nation adhering to the Berne Convention or a WTO member country, becomes--

(A) a nation adhering to the Berne Convention;

(B) a WTO member country;

(C) a nation adhering to the WIPO Copyright Treaty;

(D) a nation adhering to the WIPO Performances and Phonograms Treaty; or

(E) subject to a Presidential proclamation under subsection (g).

(2) The “date of restoration” of a restored copyright is--

(A) January 1, 1996, if the source country of the restored work is a nation adhering to the Berne Convention or a WTO member country on such date, or

(B) the date of adherence or proclamation, in the case of any other source country of the restored work.

(3) The term “eligible country” means a nation, other than the United States, that--

(A) becomes a WTO member country after the date of the enactment of the Uruguay Round Agreements Act;

(B) on such date of enactment is, or after such date of enactment becomes, a nation adhering to the Berne Convention;

(C) adheres to the WIPO Copyright Treaty;

(D) adheres to the WIPO Performances and Phonograms Treaty; or

(E) after such date of enactment becomes subject to a proclamation under subsection (g).

(4) The term “reliance party” means any person who--

(A) with respect to a particular work, engages in acts, before the source country of that work becomes an eligible country, which would have violated [section 106](#) if the restored work had been subject to copyright protection, and who, after the source country becomes an eligible country, continues to engage in such acts;

(B) before the source country of a particular work becomes an eligible country, makes or acquires 1 or more copies or phonorecords of that work; or

(C) as the result of the sale or other disposition of a derivative work covered under subsection (d)(3), or significant assets of a person described in subparagraph (A) or (B), is a successor, assignee, or licensee of that person.

(5) The term “restored copyright” means copyright in a restored work under this section.

(6) The term “restored work” means an original work of authorship that--

(A) is protected under subsection (a);

(B) is not in the public domain in its source country through expiration of term of protection;

(C) is in the public domain in the United States due to--

(i) noncompliance with formalities imposed at any time by United States copyright law, including failure of renewal, lack of proper notice, or failure to comply with any manufacturing requirements;

(ii) lack of subject matter protection in the case of sound recordings fixed before February 15, 1972; or

(iii) lack of national eligibility;

(D) has at least one author or rightholder who was, at the time the work was created, a national or domiciliary of an eligible country, and if published, was first published in an eligible country and not published in the United States during the 30-day period following publication in such eligible country; and

(E) if the source country for the work is an eligible country solely by virtue of its adherence to the WIPO Performances and Phonograms Treaty, is a sound recording.

(7) The term “rightholder” means the person--

(A) who, with respect to a sound recording, first fixes a sound recording with authorization, or

(B) who has acquired rights from the person described in subparagraph (A) by means of any conveyance or by operation of law.

(8) The “source country” of a restored work is--

(A) a nation other than the United States;

(B) in the case of an unpublished work--

(i) the eligible country in which the author or rightholder is a national or domiciliary, or, if a restored work has more than 1 author or rightholder, of which the majority of foreign authors or rightholders are nationals or domiciliaries; or

(ii) if the majority of authors or rightholders are not foreign, the nation other than the United States which has the most significant contacts with the work; and

(C) in the case of a published work--

(i) the eligible country in which the work is first published, or

(ii) if the restored work is published on the same day in 2 or more eligible countries, the eligible country which has the most significant contacts with the work.

Article 18 of the Berne Convention provides:

(1) This 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.

(2) If, however, through the expiry of the term of protection which was previously granted, a work has fallen into the public domain of the country where protection is claimed, that work shall not be protected anew.

(3) The application of this principle shall be subject to any provisions contained in special conventions to that effect existing or to be concluded between countries of the Union. In the absence of such provisions, the respective countries shall determine, each in so far as it is concerned, the conditions of application of this principle.

(4) The preceding provisions shall also apply in the case of new accessions to the Union and to cases in which protection is extended by the application of [Article 7](#) or by the abandonment of reservations.