No. 10-545

In The Supreme Court of the United States

LAWRENCE GOLAN et al.,

Petitioners,

v.

ERIC H. HOLDER, JR. et al.,

Respondents.

On Writ Of Certiorari To The United States Court Of Appeals For The Tenth Circuit

BRIEF FOR THE PETITIONERS

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QUESTIONS PRESENTED

Section 514 of the Uruguay Round Agreements Act of 1994 granted copyright protection to millions of works that the Copyright Act had placed in the public domain of the United States, where they had remained for years as the common property of all Americans and free to use without restriction. The questions presented here are:

1. Does the Copyright Clause of the United States Constitution prohibit Congress from taking works out of the public domain?

2. Does Section 514 violate the First Amendment of the United States Constitution?

PARTIES TO THE PROCEEDINGS AND CORPORATE DISCLOSURE STATEMENT

Petitioners are Lawrence Golan, Estate of Richard Kapp, S.A. Publishing Co., Inc., d/b/a Ess.A.Y. Recordings, Symphony of the Canyons, Ron Hall, d/b/a Festival Films, and John McDonough, d/b/a Timeless Video Alternatives International. Petitioners certify that they have no parent corporation, nor do any publicly held corporations own 10% or more of their stock. Respondents are Eric H. Holder, Jr., in his official capacity as Attorney General of the United States, and Maria Pallante, in her official capacity as Register of Copyrights.

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BRIEF FOR THE PETITIONERS

Petitioners respectfully request that this Court reverse the judgment of the United States Court of Appeals for the Tenth Circuit.

OPINIONS BELOW

The district court's initial decision dismissing petitioners' claims (Pet. App. 10-52) is unreported and available at 2005 WL 914754. The court of appeals' initial decision affirming in part and reversing in part (Pet. App. 70-109) is reported at 501 F.3d 1179. The district court's decision on remand granting summary judgment to petitioners on First Amendment grounds (Pet. App. 43-69) is reported at 611 F. Supp. 2d 1165. The decision of the court of appeals reversing (Pet. App. 1-42) is reported at 609 F.3d 1076.

JURISDICTION

The judgment of the United States Court of Appeals for the Tenth Circuit was issued on June 21, 2010. Petitioners obtained an extension of time within which to file a petition for writ of certiorari to October 20, 2010, and filed a timely petition on that date. This Court granted certiorari on March 7, 2011, 131 S. Ct. 1600 (2011), and has jurisdiction pursuant to 28 U.S.C. § 1254(1).

RELEVANT CONSTITUTIONAL AND STATUTORY PROVISIONS

The Copyright Clause gives Congress the power to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8.

The First Amendment provides, in pertinent part, that "Congress shall make no law . . . abridging the freedom of speech." U.S. Const. amend I.

The pertinent provisions of the Copyright Act, 17 U.S.C. §§ 104A, 109(a) (codifying Sec. 514 of Uruguay Round Agreements Act (URAA)), are reprinted in the petition appendix at 173-90.

STATEMENT OF THE CASE

In 1994, Congress did something unique in the history of American copyright law. After expressing doubts about its constitutional authority to do so, Congress granted copyright protection to a large body of foreign works that the Copyright Act had placed in the public domain, where most had remained for decades. As a result, petitioners lost important speech and expression rights central to their professions, as well as the expected return on significant investments. The Tenth Circuit held the statute was within Congress's powers under Article I of the Constitution and did not violate the First Amendment.

1. Article I of the Constitution gives Congress the power to grant authors copyrights, but only for "limited [t]imes," and only to "promote the [p]rogress" of knowledge and learning. U.S. CONST. art. I, § 8, cl. 8. The careful balance it strikes reflects the fact that providing exclusive rights encourages the creation of new works, but also inhibits the progress of knowledge and learning by restricting access to existing works. Congress may therefore set a limited time of protection, but once the selected period expires, the work enters the public domain. At that point, every American is free to use the work without restriction, spread its contents, and use it in the creation of still other works.

For two hundred years, copyright legislation was consistent with a simple command: what enters the public domain remains in the public domain. In the first Copyright Act of 1790, Congress created the public domain of the United States by replacing a patchwork of state law protection with a uniform federal system that placed works in the public domain quickly and reliably. *See* Copyright Act of 1790, ch. 15, § 1, 1 Stat. 124 ("1790 Act"). Under the 1790 Act, works by foreign authors entered the public domain immediately. *See id*. § 5, 1 Stat. at 125. U.S. "authors of any map, chart, book or books" were eligible for an initial term of fourteen years upon compliance with certain formalities such as registration, public notice and deposit. *Id.* §§ 1, 3, 4, 1 Stat. at 124-25. An additional term of fourteen years was available upon compliance with additional

formalities. *See id.* § 1, 1 Stat. at 124. Many of these formalities were retained until 1976, and some until 1988. As a result, the public domain grew based on a combination of term limitations and eligibility requirements.

From 1790 to 1994, Congress exercised its power to expand the duration and scope of copyright protection no fewer than nineteen times. On each occasion, it left the public domain completely intact. *See, e.g.*, Copyright Act of 1976, Pub. L. No. 94-553, § 103, 90 Stat. 2541, 2599 ("This Act does not provide copyright protection for any work that goes into the public domain before January 1, 1978."); Copyright Act of 1909, Pub. L. No. 60-349, § 7, 35 Stat. 1075, 1077 ("no copyright shall subsist in the original text of any work which is in the public domain").

This time-honored tradition of preserving and expanding the public domain makes the products of learning, knowledge and creativity widely available and free to all for any purpose. It also helps expand that body of knowledge by providing the building blocks of future creativity in music, art, entertainment and literature. The public domain promotes the diffusion of knowledge, and provides the raw material to expand it.

2. Congress recognized this tradition and followed it in 1988 when it joined the Berne Convention for the Protection of Literary and Artistic Works ("Berne Convention"). S. Treaty Doc. No. 99-27, 1161 U.N.T.S. 3 (last revised on July 24, 1971). The Berne

Convention was first signed in 1886, but the United States declined to join for more than one hundred years. Instead, the United States secured widespread foreign protection for U.S. authors through the Universal Copyright Convention ("UCC") and bilateral copyright agreements. *See* 4 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 17.01[B][2] (2010).

The Berne Convention sets minimum standards of copyright protection, and provides authors with automatic protection in each member nation. *See* Berne Conv. Arts. 2-19. It prohibits members from conditioning protection on compliance with formalities. *See id*. Art. 5(2). The Convention also contains a provision that requires members to grant copyright protection to works that "have not yet fallen into the public domain in the country of origin [*i.e.*, generally where the work was first published] through the expiry of the term of protection." *Id.* Art. 18(1). But it empowers every member to modify this requirement through "special conventions" and to otherwise "determine, each in so far as it is concerned, the conditions of application of this principle." *Id.* Art. 18(3).

As Congress considered joining the Berne Convention, a major subject of its deliberations was whether Berne required the United States to grant protection to any foreign works in the public domain of the United States, and whether the Constitution permitted Congress to do so. *See* H.R. REP. NO. 100-609, at 51-52 (1988). The leading copyright treatise at the time stated "neither the copyright clause nor the First Amendment would permit the granting of

copyright to works which have theretofore entered the public domain." 1 M. Nimmer, *Nimmer on Copyright*, § 105[A] (1984). In addition, Members of Congress, the Register of Copyrights, an ad hoc working group of experts convened by the State Department, and other commentators believed that providing retroactive protection would raise serious constitutional concerns. *See* H.R. REP. NO. 100-609, at 51 (1988); *The Berne Convention: Hearings on S. 1301 and S. 1971 Before the Subcomm. on Patents, Copyrights and Trademarks of the S. Comm. on the Judiciary*, 100th Cong. 150 (1988) (statement of Ralph Oman, Register of Copyrights and Assistant Librarian for Copyright Services); *Final Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention*, *reprinted in* 10 COLUM.-VLA J.L. & ARTS 513, 590-91 & nn.15-16 (1986).

After extensive consideration, Congress decided the United States would join the Convention, but would not grant any protection to works in its public domain. Congress adopted the Berne Convention Implementation Act ("BCIA"), which changed U.S. copyright law by easing restrictions on foreign authorship and aligning U.S. law with Berne's minimum standards. *See* Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853. The BCIA did not remove any works from the public domain of the United States. *See* BCIA § 12 ("Title 17, United States Code, as amended by this Act, does not provide copyright protection for any work that is in the public domain in the United States."). Congress

determined the BCIA satisfied U.S. obligations under Berne based on the express terms of Article 18 and the specific discretion it provides. *See* H.R. REP. NO. 100-609, at 51-52; BCIA § 2(3) (BCIA "satisf[ies] the obligations of the United States in adhering to the Berne Convention").

After the United States joined Berne in 1988, new works by U.S. authors received full protection in every member nation. *See, e.g.*, Berne Conv. Art. 2(6); BCIA § 2(3). As a result of Congress's decision not to provide retroactive protection to public domain works, some nations such as Thailand and Russia refused to grant protection for some existing U.S. works that were in the public domains of those nations. *See, e.g.*, *General Agreement on Tariffs and Trade (GATT): Intellectual Property Provisions: Joint Hearing Before the Subcomm. on Intellectual Property and Judicial Administration of the H. Comm. on the Judiciary and the Subcomm. on Patents, Copyrights, and Trademarks of the S. Comm. on the Judiciary on H.R. 4894 and S. 2368*, 103d Cong. 136-37 (1994) ("*Joint House and Senate Comm. Hearings on the URAA*") (statement of Ira S. Shapiro, General Counsel, Office of the U.S. Trade Representative).

A variety of copyright owners urged Congress to reconsider the question of granting copyright protection to foreign works in the public domain of the United States. *See id.* 244 (statement of Eric H. Smith, Executive Director and General Counsel, International Intellectual Property Alliance), 256 (statement of Jack Valenti, President and Chief Executive

Officer, Motion Picture Association of America), and 291 (statement of Jason S. Berman, Chairman and Chief Executive Officer, Recording Industry Association of America). They expressed the hope that if the United States granted such protection to foreign works, foreign nations would reciprocate by granting protection to certain U.S. works in their public domains. *See id.*

3. In 1994, Congress reversed course and enacted Section 514 of the URAA in connection with implementing the Uruguay Round of negotiations on the General Agreement on Tariffs and Trade (GATT), and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). *See* Pub. L. No. 103-465, § 514, 108 Stat. 4809, 4976 (1994) (amending 17 U.S.C. §§ 104A & 109), Pet. App. 173-90.

Section 514 grants automatic protection to a large body of existing foreign works that were in the public domain of the United States (many for decades) and sets the term as "the remainder of the term of copyright that the work would otherwise have been granted in the United States if the work never entered the public domain in the United States." 17 U.S.C. § 104A(a)(1), (h)(6), Pet. App. 173, 183-84. Section 514 also places substantial restrictions on the "first sale" doctrine by restricting the right to sell, or otherwise distribute, copies of restored works that were lawfully made when the work was in the public

domain. *See* 17 U.S.C. § 109(a) & (b)(1)(A), Pet. App. 186-87.[1]

Section 514 provides one year of temporary protection for "reliance parties" who invested in using the newly-restored works before they were removed from the public domain. *Id.* §§ 104A(d)(2)(A)-(B), 109(a), Pet. App. 174-76, 186. After that period, authors of derivative works based on newly-restored works are required to pay compensation if they wish to continue using the derivative works they created using material that was once in the public domain. *Id.* § 104A(d)(3), Pet. App. 176-77.

While Section 514 grants substantial protection to foreign authors, it confers no rights on U.S. authors, and provides no additional protection for any newly-created works. Pet. App. 173-90.

Unlike the BCIA, the URAA was drafted almost entirely by the Office of the U.S. Trade Representative and submitted to Congress under "fast track"

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[1] Section 514's provisions were codified as amendments to 17 U.S.C. §§ 104A and 109. The original version of Section 104A was enacted one year before and restored a limited and designated set of Mexican and Canadian copyrights in motion pictures as part of NAFTA. *See* North American Free Trade Agreement Implementation Act (NAFTA) of December 8, 1993, Pub. L. No. 103-182, § 334, 107 Stat. 2057, 2115. Because the original provisions of Section 104A had not taken effect by the time the URAA was enacted, *see id.,* Section 104A's current restoration provisions implement both NAFTA and URAA restoration.

procedures that precluded any amendment. *See* S. REP. NO. 103-412, at 4 (1994); H.R. REP. NO. 103-826, at 10-12, 19 (1994). The 245-page URAA addressed a wide array of trade-related questions in addition to copyright restoration: tariff modification, anti-dumping regulations, trade subsidies, textile importation, food safety, and taxes. The Act was sent to Congress on September 27, 1994, approved by both Houses of Congress, and signed by the President on December 8, 1994. *See* Uruguay Round Agreements Act, Pub. L. No. 103-465, § 101, 108 Stat. 4809, 4814 (1994).

The immediate effect of Section 514 was to remove a vast number of foreign works from the public domain. The former Register of Copyrights stated that the affected works "probably number in the millions." Marybeth Peters, *The Year in Review: Accomplishments and Objectives of the U.S. Copyright Office*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 25, 31 (1996). The precise number will never be known because registration of the restored works is voluntary. *See* 17 U.S.C. § 104A(c), Pet. App. 173-74.

4. Petitioners are orchestra conductors, educators, performers, film archivists, and motion picture distributors who depend upon the public domain for their livelihood. For many years, petitioners relied upon the free availability of such works in their own artistic performance and distribution. Prior to the enactment of Section 514, petitioners Lawrence Golan, Symphony of the Canyons, and the orchestra of Richard Kapp (since deceased) had the unrestricted

right to perform Prokofiev's *Classical Symphony* and *Peter and the Wolf*; Shostakovich's *Symphony 14*, *Cello Concerto* (Op. 107) and *Piano Concerto* (Op. 35); and Stravinsky's *Petrushka*. Section 514 now forbids them from performing these works publicly without permission, even if they have already acquired the sheet music. J.A. 22-27 (Declaration of Lawrence Golan); J.A. 35-40 (Declaration of Richard Kapp); J.A. 51-53 (Declaration of Kortney Stirland). It also makes it infeasible for Golan to teach the standard repertoire of classical music to his students at the University of Denver. J.A. 22-23, 25-26 (Declaration of Lawrence Golan).

Section 514 also destroys substantial business investments by petitioners. It makes it infeasible for S.A. Publishing to distribute its recording of Shostakovich's *String Quartets*, which was recorded at substantial expense and named by Time Magazine in 1991 as one of the best recordings in classical music. J.A. 40-43 (Declaration of Richard Kapp). It also prohibits Ron Hall and John McDonough from distributing hundreds of films they owned and distributed prior to Section 514's enactment. J.A. 31-32 (Declaration of Ron Hall); J.A. 46-48 (Declaration of John McDonough).

5. In 2001, petitioners filed this suit alleging that Section 514 exceeds Congress's power under the Copyright Clause and violates their First Amendment right to free speech and expression. The district court granted the government summary judgment on both claims and dismissed the suit. Pet. App. 110-52. On

petitioners' appeal, the Tenth Circuit affirmed in part, vacated in part, and remanded. *Id.* 70-109. It held Section 514 fell within Congress's power under the Copyright Clause because complying with the Berne Convention "secures copyright protections for American works abroad." *Id.* 85.

But the court of appeals vacated the dismissal of petitioners' First Amendment claim and remanded the case for further consideration. Applying this Court's decision in *Eldred v. Ashcroft*, 537 U.S. 186 (2003), the court of appeals held that Section 514 is subject to First Amendment scrutiny because granting copyright protection to works in the public domain represents a substantial departure from the traditional contours of copyright protection, Pet. App. 86-98, and restricts speech "near the core of the First Amendment." *Id.* 99-100. The court remanded the case to determine whether Section 514 satisfies First Amendment scrutiny. *Id.* 107-09.

On remand, the district court granted summary judgment for petitioners. It held that Section 514 is subject to intermediate scrutiny and violates the First Amendment because "Congress could have complied with the [Berne] Convention without interfering with [petitioners'] protected speech." Pet. App. 68. The district court also held the government presented no evidence sufficient to show that suppressing the speech of reliance parties would generate any additional benefits to U.S. authors, and found that there

was no substantial interest in providing foreign authors with protections unavailable to U.S. authors. *See id.* 64-65, 67-68.

On appeal, the Tenth Circuit reversed. Pet. App. 1-42. It agreed that Section 514 is subject to intermediate scrutiny but concluded that Congress has an important interest in protecting the rights of U.S. copyright owners abroad. It found sufficient evidence to conclude that restoring copyrights for existing foreign works in the United States might encourage foreign countries to restore protection for existing U.S. works abroad. *Id.* 13-29. The Tenth Circuit acknowledged that Congress might have been able to comply with the Berne Convention while still providing full protection to petitioners' speech interests. *Id.* 31-32. Yet it concluded the actual requirements of Berne were "beside the point" because Section 514 was supported by the broader interest of pursuing enhanced foreign protection for the existing works of U.S. authors. *See id.* 32.

The Tenth Circuit therefore upheld Section 514 based not on the need to comply with the Berne Convention or any public benefits Berne compliance might create, but on the premise that the government has an important interest in giving away the public domain to foreign authors in the hope that might create private economic benefits for U.S. authors from existing works.

6. This Court granted certiorari to determine whether Section 514 violates the Copyright Clause or the First Amendment. 131 S. Ct. 1600 (2011).

SUMMARY OF THE ARGUMENT

Section 514 violates the restrictions of the Copyright Clause by removing works from the public domain, and it violates the First Amendment by imposing speech burdens on petitioners and the public that are unnecessary to advance any important government interest.

In *Eldred v. Ashcroft*, 537 U.S. 186 (2003), this Court affirmed Congress's power to extend the terms of existing copyrights. The Court relied principally on an uninterrupted tradition of two hundred years of congressional amendments to the copyright laws, which had consistently extended the terms of copyright protection and applied those extensions to existing copyrights. The Court looked to that tradition to identify the limits of Congress's power under the Copyright Clause. It looked to that same tradition to define the "traditional contours of copyright protection" and determine whether the term extension statute before the Court was subject to First Amendment scrutiny.

History and tradition tell a different story here. In removing a vast number of works from the public domain of the United States, Section 514 marks a startling and dramatic departure from the traditions

of U.S. copyright law. Congress created the public domain when it enacted the first Copyright Act in 1790. It amended the Copyright Act nineteen times over the next two hundred years to expand both the duration and scope of copyright protection. Yet each expansion left the public domain completely intact. Indeed, because Congress recognized that the works could not receive the benefits of future term extensions upon entering the public domain, several amendments served no *other* purpose than to ensure that the covered works did not enter the public domain.

Congress's unbroken respect for the integrity of the public domain was no accident. It reflected the specific limitations imposed on Congress's legislative power by Article I. The Copyright Clause authorizes Congress to enact laws that grant copyright protection only for "limited [t]imes," and only to "promote the [p]rogress" of knowledge and learning. Congress may determine the precise length of copyright protection, but that choice must form a boundary. Congress may leave the work unprotected and set the term at zero years, or it may specify a lengthy term. It may even extend the term before it expires. But when the "limit[ ]" of the selected period expires, the work enters the public domain, and the public must enjoy the right to perform, publish, copy, distribute and teach it free of restrictions.

Removing works from the public domain violates the "limited [t]imes" restriction by turning a fixed and predictable period into one that can be reset or

resurrected at any time, even after it expires. The entry of a work into the public domain must mark the end of protection, not an intermission. Otherwise, the limit is meaningless. There is no way for members of the public to know if the limit has been reached, and no way to rely on it. That uncertainty undermines the very "progress" Congress is required to promote. By guaranteeing unrestricted access to every work at the end of the period Congress selects, the Copyright Clause promises the unrestricted spread of existing works, provides the public with the building blocks of future creativity, and fuels the engine of free expression. Removing works from the public domain undermines these goals by restricting the diffusion of works that were once allowed to circulate freely, snatches back the building blocks of creativity, and disrupts the settled expectations of those who exercised their right to use the contents of the public domain.

Even if the Copyright Clause permits Congress to remove works from the public domain in some circumstances, Section 514 violates the First Amendment. Unlike the term extension statute at issue in *Eldred*, Section 514 is subject to First Amendment scrutiny because it is far outside the "traditional contours of copyright protection." This Court has recognized the "federal right to copy and use" material in the public domain. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003). Congress respected that right consistently for two hundred years, in large part because it ensures that

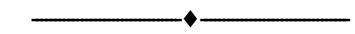
copyright law will ultimately promote – rather than inhibit – basic speech and expression values. Section 514 dismantles that protection and places substantial burdens on core speech and expression rights that once belonged to petitioners and other members of the American public. Like many others, petitioners relied on the unrestricted availability of music and films in performing, teaching, recording, restoring and distributing public domain works. In each case, they invested substantial time, effort and money doing so. Section 514 eliminated the speech and expression rights central to their professions, and expropriated the investment they made.

The speech burdens Section 514 imposes on petitioners and the public are not justified by any important government interest. Congress removed foreign works from the public domain of the United States in the hope that some foreign nations would reciprocate and grant protection to existing works of U.S. authors that were in the public domains of those countries. But there is no legitimate interest in giving away public speech rights in the hope of creating private economic windfalls. Nor was there any substantial evidence to conclude the government's give-away would be reciprocated, or to what degree, and to what specific benefit.

While the government asserts an interest in complying with the Berne Convention, the United States joined Berne in 1988, and Congress specifically found that Article 18 permitted the United States to do so without removing any works from its public domain.

Even if the United States was not then fully compliant with Berne, Section 514 imposes speech burdens far greater than anything Berne demands. Berne provides specific mechanisms by which the United States could have assured the continued integrity of its public domain. The plain terms of Berne also demonstrate that Congress did not have to impose *any* burden on the speech and expression interests of reliance parties like petitioners; moreover, Congress could have imposed a substantially lower burden on the public at large by limiting the copyright term for restored works to the period of the nation in which the work was originally authored.

Section 514 privatized public speech rights, and did so unnecessarily. It violates the Copyright Clause and the First Amendment. The judgment below should be reversed.



ARGUMENT

Section 514 is unconstitutional for two reasons. First, it violates the specific limitations on Congress's power imposed by the Copyright Clause. Second, even if authorized by the Copyright Clause, Section 514 violates the First Amendment by revoking expressive freedoms that petitioners and the public enjoyed for decades.

I. Section 514 Violates The Specific Limitations Of The Copyright Clause.

This Court last considered the meaning of the Copyright Clause in *Eldred v. Ashcroft*, 537 U.S. 186 (2003). In that case, the Court held the Copyright Clause permits Congress to extend the term of existing copyrights. *See id.* at 199. The Court recognized Congress had extended the term of existing copyrights consistently for two hundred years. *See id.* at 200-04, 213-14. The Court concluded this practice did not violate the Copyright Clause's "limited [t]imes" restriction because extended copyrights were still "limited" by a specific date upon which they would expire, and the constitutionality of term extension for existing copyrights was supported by two hundred years of unbroken congressional practice. *See id.*

Here, the text and history of the Copyright Clause show Congress has no power to grant copyright protection to works in the public domain, and that limit is confirmed by Congress's application of its copyright power over two centuries. Congress amended the Copyright Act nineteen times from 1802 to 1988, but those amendments never extended copyright to works in the public domain. *See Eldred*, 537 U.S. at 213 (previous term extensions applied to "works not yet in the public domain"). To the contrary, Congress amended the copyright statutes nine times in twelve years to prevent works from entering the public domain precisely because it recognized it could not grant protection to those works once they entered the public domain.

The government itself has acknowledged the difference between extending the term of existing copyrights and removing works from the public domain. At the oral argument in *Eldred*, Justice Souter asked the Solicitor General whether the Copyright Clause would permit Congress to grant an extension that applied to a "copyright that expired yesterday." Trans. of Oral Arg. 44, *Eldred v. Ashcroft*, 537 U.S. 186 (Oct. 9, 2002), *available at* http://bit.ly/lcdn2F. The Solicitor General acknowledged, "there is a bright line there" because at that point the work "has already gone into the public domain. . . . other individuals or companies or entities may then have acquired an interest in, or rights to, or be involved in disseminating" the work. *Id*.

The text and history of the Copyright Clause command a bright line, and two hundred years of Congressional practice confirm it: Congress has no power to remove works from the public domain.

A. The Text Of The Copyright Clause Shows Congress Cannot Remove Works From The Public Domain.

The Copyright Clause defines Congress's copyright power. *See Eldred*, 537 U.S. at 212; *Feist Publ'ns, Inc. v. Rural Tel. Servs. Co., Inc.*, 499 U.S. 340, 346 (1991). It is "both a grant of power and a limitation." *Graham v. John Deere Co.*, 383 U.S. 1, 5 (1966). *See also Eldred*, 537 U.S. at 212; *Burrow-Giles*

Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884). It states:

> Congress shall have the power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

U.S. CONST. art. I, § 8, cl. 8.

At the time of the Framing, "limited" "meant what it means today: 'confine[d] within certain bounds,' 'restrain[ed],' or 'circumscribe[d].'" *Eldred*, 537 U.S. at 199 (*quoting* Samuel Johnson, *Dictionary of the English Language* (7th ed. 1785)). "Progress" meant the advancement of knowledge, as well as its spread. *See* Samuel Johnson, *Dictionary of the English Language* (4th ed. 1775) (defining progress as "advancement in knowledge" and "[r]emoval from one place to another"); *Webster's American Dictionary of the English Language* (1828) (reprinted 2010) (progress includes both an "[a]dvance in knowledge" and "passage from place to place"). "Science" referred to knowledge and learning. *See id.*; Arthur H. Seidel, *The Constitution and a Standard of Patentability*, 48 J. PAT. OFF. SOC'Y 5, 11-12 (1966). The "progress" Congress must "promote" is therefore the creation and spread of knowledge and learning.

In setting these textual limitations, the Copyright Clause announces a "federal policy" of "allowing free access to copy whatever the federal patent and copyright laws leave in the public domain." *Compco*

Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, 237 (1964). Once a work is placed in the public domain, every member of the public acquires the "federal right to 'copy and use'" it without restriction. *Dastar,* 539 U.S. at 34 (*quoting Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 165 (1989)); *see also Compco*, 376 U.S. at 237. Upon entering the public domain, a work must remain there. *See Graham*, 383 U.S. at 6 ("Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available.").[2]

Removing works from the public domain violates the "limited [t]imes" restriction by turning a fixed and predictable period into one that can be reset or resurrected at anytime, even after it expires. This Court in *Eldred* held that an extended copyright term was still "limited" because it had a definite outer boundary. 537 U.S. at 199. Section 514 is radically different. It destroys the boundary *Eldred* identified and renders it meaningless. Prior to Section 514, a work received a specific term of protection (sometimes expressly set to zero), entered the public domain at the end of that period, and remained there. The time limitation was predictable, meaningful, reliable, and

[2] The Copyright Clause further reinforces the constitutional significance of the public domain by its originality requirement, which only permits the protection of new and original expression that adds to the existing store of knowledge. *See Feist*, 499 U.S. at 346.

permanent. If Congress may, as it did here, place works into the public domain only to reclaim them decades later, the limit placed on a copyright term at any given moment is meaningless.

A limit that can be reset even after it has been passed does not "restrain[ ]" or "confine[ ]" as the Copyright Clause requires. *Eldred*, 537 U.S. at 199. If an unprotected work may become protected again decades after entering the public domain, the boundary between protected works and unprotected works is erased. The entry of a work into the public domain must mark the end of protection, not an intermission. Otherwise, there is no way for members of the public to know if the limit has been reached, and no way to rely on it. That is precisely the problem here: the limited time Congress initially selected turned out not to be the limit after all, and petitioners' "federal right to copy and use" material in the public domain simply evaporated. *See Dastar*, 539 U.S. at 34.[3]

Granting protection to public domain works not only violates the "limited [t]imes" restriction, it also impedes the very "progress" Congress is required to

[3] The difference between extending the term of existing copyrights and resurrecting copyrights in works that were already part of the public domain parallels a distinction this Court has drawn in other contexts. This Court has recognized the legislature may extend the statute of limitations for criminal offenses without violating the Ex Post Facto Clause of the Constitution, but it cannot revive time-barred prosecutions once the statute of limitations has run. *See Stogner v. California*, 539 U.S. 607, 617-21 (2003).

promote. *See Graham*, 383 U.S. at 6. The free availability of works in the public domain fuels the engine of free expression by providing unrestricted access to the building blocks of future creativity. *See Sony Corp. of Am. v. Universal City Studios, Inc.,* 464 U.S. 417, 429 (1984); Pet. App. 76-77. The incentive to invest in activities that rely on the contents of the public domain, or to use those contents as ingredients for new creations, is destroyed if the fruits of that effort can be confiscated at any time.

A statute that does no more than grant protection for works that were long part of the public domain cannot "promote the [p]rogress of [s]cience." U.S. CONST. art. I, § 8, cl. 8. It does not spur the creation of any new works. Instead, it inhibits the spread of existing works, reduces the universe of material available to the public for further creation, and threatens to destroy the incentive to use even those works that remain unprotected. It impedes both the creation of knowledge and its spread.

The limitations of the Copyright Clause exist to ensure copyright legislation fulfills its distinctly public purpose. *See Sony*, 464 U.S. at 429, (public purpose of copyright is to spur creative activity and provide free access upon conclusion of limited term); *Graham*, 383 U.S. at 5-6; *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932). To fulfill that purpose, the boundaries of protection must be clear, stable and reliable. *Cf. Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 527 (1994) ("Because copyright law ultimately serves the purpose of enriching the general public through

access to creative works, it is peculiarly important that the boundaries of copyright law be demarcated as clearly as possible."); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 731 (2002) (boundaries of intellectual property monopoly must be clear: "[a] patent holder should know what he owns, and the public should know what he does not").

By removing millions of works from the public domain, Section 514 erased those boundaries. It treated the termination of each work's "limited [t]ime" as a potential beginning, not an end. In so doing, it violated the plain and sensible meaning of the "limited [t]imes" restriction, impaired the reliance interests that were based on the clear boundary that restriction commands, and impeded progress itself.

B. The Framers Intended To Create A Permanent And Stable Public Domain From Which Works Could Not Be Removed.

The Framers of the Constitution did not enact the Copyright Clause in a vacuum. That provision was written against the backdrop of English experience, which shaped the Clause itself. *See Graham*, 383 U.S. at 5-6; Edward C. Walterscheid, *The Nature of the Intellectual Property Clause: A Study in Historical Perspective* 13, 32 (2002). That history teaches that the Framers intended to create a stable and

permanent public domain from which works could not be removed.

From the middle of the sixteenth century, a series of decrees by the Star Chamber and acts of Parliament provided members of the Stationers Company with a monopoly over nearly every aspect of printing and publishing in England. *See* Lyman Ray Patterson, *Copyright in Historical Perspective* 115-42 (1968). Under the Licensing Act of 1662 and its predecessors, the Stationers Company and its members held perpetual copyrights in almost every book published. *See id.* Under this monopoly system, books were expensive and difficult to acquire. *See* William St. Clair, *The Reading Nation in the Romantic Period* 99-102 (2004). The diffusion of knowledge was substantially impeded.

In 1710, the Statute of Anne dismantled that system and limited copyrights on existing books to twenty-one years. Statute of Anne, 1710, 8 Ann., c.19 (Eng.); *See* Tyler T. Ochoa & Mark Rose, *The Anti-Monopoly Origins of the Patent & Copyright Clause*, 49 J. COPYRIGHT SOC'Y U.S.A. 675, 680-81 (2002). New books received shorter terms of fourteen years. *Id.* By limiting what had otherwise been a perpetual monopoly, the Statute of Anne created the public domain of England. As copyright protection expired under these limits, a wide array of books became available in greater quantities and at substantially lower prices. *See* St. Clair, *supra*, at 114, 118-19.

But the battle between copyright owners and the public interest in access to knowledge was not over. As statutory protection for existing works under the Statute of Anne expired, publishers asked the English courts to reinstate their rights by recognizing common law copyrights. *See* Patterson, *supra*, at 153-68. In 1769, the King's Bench held that the common law provided perpetual copyrights in published works. *See Millar v. Taylor*, 4 Burr. 2303, 98 Eng. Rep. 201 (K.B. 1769). As a result, the monopoly of the Stationers Company continued to impose substantial restrictions on the distribution of books, including Shakespeare's works, among others. *See* St. Clair, *supra*, at 140-57, 692-714. The House of Lords overruled *Millar* in 1774 and held the time limitations in the Statute of Anne cut off any common law copyrights the stationers might have held in published works. *See Donaldson v. Beckett*, 4 Burr. 2408, 98 Eng. Rep. 257, 2 Bro. PC 129, 1 Eng. Rep. 837, 17 Cobb. Parl. Hist. 953 (H.L. 1774).

The English experience with Crown monopolies was similarly important. *See Graham*, 383 U.S. at 5-7; *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 228-30 & n.6 (1964); Ochoa & Rose, *supra*, at 675; J.A. 54-79 (Declaration of copyright historian Mark Rose). While limited monopolies for new technology provided a useful incentive to innovate, the Crown's practice of granting monopolies over existing technology and established industries created no such incentive. Instead, it created a "race for favors," as would-be monopolists sought to capture already

existing markets. William Hyde Price, *The English Patents of Monopoly* 16 (Harvard Univ. Press 1913) (1906).

The principal offense of such monopolies was the privatization of public rights – they took existing rights away from the public, and placed them in private hands. *See* 4 William Blackstone, *Commentaries on the Laws of England* 154 (Robert Malcolm Kerr ed., 4th ed. 1876); *see generally Proprietors of Charles River Bridge v. Proprietors of Warren Bridge*, 36 U.S. 420, 607 (1837) (Taney, C.J.) (monopoly is "an exclusive right, granted to a few, of something which was before of common right"). The English Parliament reacted to this abuse by enacting the Statute of Monopolies, which limited the terms of new and existing patents, and restricted the issuance of patents to "the true and first Inventor and Inventors" of "new Manufactures." *See Sears, Roebuck & Co.*, 376 U.S. at 225 n.6.

The Statute of Anne and Statute of Monopolies share a basic purpose. They permit monopolies and exclusive rights over new creations in order to provide beneficial incentives, but deny them to existing creations because the latter restricts the spread of knowledge without any corresponding benefit.

Promoting the spread of knowledge was also important to the Founders of our country and the Framers of our Constitution. Thomas Jefferson recognized that the "diffusion of knowledge among people" is essential to a democratic government.

Letter from Thomas Jefferson to George Wythe (Aug. 13, 1786), *in* 10 *The Papers of Thomas Jefferson* 243, 244 (Julian P. Boyd ed., 1954). James Madison, John Adams, and George Washington agreed. *See* Letter of James Madison to W.T. Barry (Aug. 4, 1822), *in* 9 *The Writings of James Madison* 103, 107 (Gaillard Hunt ed., 1910) ("American people owe it to themselves, and to the cause of free Government," to excel in "the advancement and diffusion of Knowledge."); MASS. CONST. pt. II, ch. 5, § 2 ("[w]isdom, and knowledge, as well as virtue, diffused generally among the body of the people, [are] necessary for the preservation of their rights and liberties");[4] George Washington, Address to Both Houses of Congress (Jan. 8, 1790), *reprinted in* Thorvald Solberg, *Copyright in Congress, 1789-1904*, 115-16 (1905) ("[T]here is nothing which can better deserve your patronage than the promotion of science and literature. Knowledge is, in every country, the surest basis of public happiness."). *See generally* Michael D. Birnhack, *The Idea of Progress in Copyright Law*, 1 BUFF. INTEL. PROP. L.J. 3, 20-21 (2001).

The first Congress recognized that this purpose was foundational in the Copyright Clause. The 1790 Copyright Act was "[a]n act for the encouragement of learning." Copyright Act of 1790, ch. 15, § 1, 1 Stat. 124. The House Journal remarked that "the

[4] John Adams was the sole drafter of the Massachusetts Constitution. *See* Louis Adams Frothingham, *A Brief History of the Constitution and Government of Massachusetts* 25-27 (1925).

promotion of science and literature will contribute to the security of a free Government; in the progress of our deliberations we shall not lose sight of objects so worthy of our regard." H.R. Journal, 1st Cong., 2d Sess. 139 (Jan. 12, 1790), *reprinted in* Solberg, *supra*, at 118.

It was in light of this history and their understanding of the purpose of copyright that the Framers imposed specific limits on Congress's copyright power to make sure it would promote, not inhibit, the diffusion of knowledge. They gave Congress the power to grant copyrights but only for "limited [t]imes." U.S. CONST. art. I, § 8, cl. 8. In doing so the Framers ensured there would be a point after which the public was guaranteed the free and permanent availability of every work, its diffusion forever free of constraint.

The Framers would have recognized that Section 514 commits the principal offense of monopoly that Blackstone identified and against which the Framers sought to guard: it privatizes rights that once belonged to petitioners and the public. The day before Congress enacted Section 514, every one of the works covered by the statute was in the public domain. At that time, petitioners performed symphonies, taught music, and distributed films that had been in the public domain for decades. They were performing precisely the role the Framers intended, by facilitating the release of these works to the public. Section 514 turned that public right into a private monopoly held by the heirs of foreign authors.

C. Two Centuries Of Unbroken Practice Confirm That Congress Cannot Remove Works From The Public Domain.

"To comprehend the scope of Congress' power under the Copyright Clause, 'a page of history is worth a volume of logic.'" *Eldred*, 537 U.S. at 200 (*quoting New York Trust Co. v. Eisner*, 256 U.S. 345, 349 (1921) (Holmes, J.)). In *Eldred*, this Court looked to history and tradition to identify the limits of Congress's power. *See id.* In doing so, it identified "an unbroken congressional practice" that confirmed Congress's power to extend the term of existing copyrights. *Id*.

Here, history and tradition point the opposite way. Congress created the public domain of the United States when it enacted the first copyright statute in 1790, and it left the public domain intact as it amended the Copyright Act nineteen times over two hundred years. That tradition, unbroken since 1790, confirms Congress has no power to remove works from the public domain.

Prior to 1790, there was no federal copyright law, and no public domain of the United States by definition. That is not to say there were no copyrights. The Founders recognized copyrights existed at common law. *See The Federalist No. 43* at 281 (James Madison) (Paul Leicester Ford ed., 1898) ("The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law."); *see also* 2 Joseph Story, *Commentaries on the Constitution of*

the United States 78 § 1152 (4th ed. 1873); William Rawle, *A View of the Constitution of the United States of America* 101-02 (1825).

State copyright statutes enacted prior to 1790 provided a patchwork of statutory protection for published works that varied in scope, duration, formalities and conditions. *See* Patterson, *supra*, at 183-92. The copyright statutes of Connecticut, Georgia and New York expressly preserved common law rights. *See id.* at 186, 189. New York common law provided perpetual common law protection for published works. *See Capitol Records, Inc. v. Naxos of Am., Inc.*, 830 N.E.2d 250, 262-63 (N.Y. 2005). In other jurisdictions, the scope of common law protection for published works was hotly contested. *See Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 659-61 (1834) (majority opinion concluding there was no common law protection for published works in Pennsylvania), and *id*. at 690 (dissenting opinion concluding Pennsylvania common law did protect published works).[5]

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[5] In *Wheaton*, the majority concluded Pennsylvania common law provided no protection for published works based largely on the language of the Copyright Act of 1790. *See* 33 U.S. at 660-61. That question of Pennsylvania state law is not one for a federal court or Congress to decide. *See Erie R.R. Co. v. Tompkins*, 304 U.S. 64 (1938). So *Wheaton* is not dispositive of Pennsylvania law, much less the law of any other state. The Justices' disagreement about common law protection for published works parallels a similar controversy that raged in England for most of the eighteenth century. While *Donaldson* settled the preemptive effect of the Statute of Anne, it reflected profound disagreement

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The 1790 Act displaced the patchwork of state copyright statutes and common law protection for published works. It replaced it with a clear, uniform federal system that created the public domain of the United States, and placed works into that public domain clearly, quickly and predictably.

The 1790 Act placed works by foreign authors into the public domain immediately by making them expressly ineligible for protection. *See* 1790 Act, § 5, 1 Stat. at 125. For American authors, it protected "any map, chart, book or books" for an initial term of fourteen years, with an available renewal term of fourteen years. *See id.* § 1, 1 Stat. at 124. It also required authors to register their works, which made it possible to determine with precision when a work would enter the public domain. *See id*. Finally, by providing the same term of protection for works "already printed," the 1790 Act eliminated any doubt that these works were also subject to its limited term of protection. *Id.* By displacing existing protection for published works – whatever its scope – the 1790 Act guaranteed that all works would be treated alike and all would enter the public domain within twenty-eight years.

Upon creating the public domain of the United States, Congress began its two-hundred-year tradition of respecting the integrity of the public domain.

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over the scope of the common law protection for published works that statute displaced. 4 Burr. 2408, 98 Eng. Rep. 257.

In the nineteenth century, Congress expanded the scope and duration of copyright six times. Each amendment left the public domain completely intact:

- The 1802 amendment extended copyright to engravings, but only those created "from and after the first day of January next." Act of Apr. 29, 1802, ch. 36, § 2, 2 Stat. 171.
- The 1831 amendment (a) extended copyright to subsequent music compositions, and also (b) extended the term of copyright protection from fourteen to twenty-eight years. Act of Feb. 3, 1831, ch. 16, §§ 1, 16, 4 Stat. 436, 439. But Congress specified "this act shall not extend to any copyright heretofore secured, the term of which has expired." *Id.* § 16, 4 Stat. at 439.
- The 1856 amendment extended copyright to publication and public performance of dramatic compositions but was limited to "any copyright hereafter granted." Act of Aug. 18, 1856, ch. 169, § 1, 11 Stat. 138, 139.
- The 1865 amendment granted copyright protection to photographs and negatives "which shall hereafter be made." Act of Mar. 3, 1865, ch. 126, § 1, 13 Stat. 540.
- The 1870 amendment extended copyright to art works, and conferred upon copyright holders the exclusive rights of dramatization and translation. Act of

July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212. But the statute did not apply to works already in the public domain, because its application was expressly conditioned upon registration of the work with the Library of Congress "before publication." *Id.* § 90, 16 Stat. at 213.

- The 1891 amendment authorized (for the first time) copyrights for authors from certain foreign countries. Act of Mar. 3, 1891, ch. 565, § 13, 26 Stat. 1106, 1110. But once again, the statute did not apply to works in the public domain because it was limited to works registered no later than the date of publication. *Id.* § 3, 26 Stat. at 1107.

In the twentieth century, Congress enacted four further significant revisions to copyright law. Once again, each left the public domain completely intact:

- In 1909, Congress revised U.S. copyright law extensively. It expanded the scope of copyrightable subject matter, and extended protection to "all the writings of an author." Copyright Act of 1909, Pub. L. No. 60-349, § 4, 35 Stat. 1075, 1076. But Congress made clear these changes would not remove works from the public domain: "[N]o copyright shall subsist in the original text of any work which is in the public domain, or in any work which was published in this country or any foreign country prior to the going into effect of this Act and has not already been

copyrighted in the United States. . . ." *Id.* § 7, 35 Stat. at 1077.

- The 1971 amendment extended copyright to sound recordings. Act of Oct. 15, 1971, Pub. L. No. 92-140, 85 Stat. 391. But the statute did not apply "retroactively" and did not "affect[ ] in any way rights with respect to sound recordings fixed before the effective date of this Act." *Id.* § 3, 85 Stat. at 392.

- The 1976 amendments expanded the scope of copyrightable works and substantially extended the term of copyright protection. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541. But it did not "provide copyright protection for any work that [went] into the public domain before its effective date of January 1, 1978." *Id.* § 103, 90 Stat. at 2599.

- The 1988 Berne Convention Implementation Act likewise did not grant copyright to works in the public domain. Pub. L. No. 100-568, § 12, 102 Stat. 2853, 2860 (BCIA "does not provide copyright protection for any work that is in the public domain in the United States.").

Congress's practice was especially illuminating in the twelve years leading up to the 1976 amendments. As debate over extending the length of the copyright term dragged on without legislative action, a significant concern arose that existing copyrights would "expire and be *irretrievably* lost" as the works entered

the public domain. *See Extending the Duration of Copyright Protection in Certain Cases, Hearings on H.J. Res. 627 Before Subcomm. No. 3 of the H. Comm. on the Judiciary*, 87th Cong. 4 (1962) (statement of Rep. Hale Boggs) (emphasis added). The House Judiciary Committee recognized that because "*it is not possible to revive expired terms of copyright*, it seems to the committee desirable to suspend further expiration of copyright for a period long enough to enable the working out of the remaining obstacles to the overall revision of the copyright law." H.R. REP. NO. 87-1742, at 3 (1962) (emphasis added).

Congress responded to this concern by enacting an extraordinary series of term extensions. From 1962 to 1974 it extended the terms of existing copyrights nine times in order to ensure these works would not enter the public domain.[6] This remarkable series of extensions was necessary precisely because Congress recognized it had no power to restore protection in works once they enter the public domain. H.R. REP. NO. 87-1742, at 3 (1962).

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[6] Act of Sept. 19, 1962, Pub. L. No. 87-668, 76 Stat. 555; Act of Aug. 28, 1965, Pub. L. No. 89-142, 79 Stat. 581; Act of Nov. 16, 1967, Pub. L. No. 90-141, 81 Stat. 464; Act of July 23, 1968, Pub. L. No. 90-416, 82 Stat. 397; Act of Dec. 16, 1969, Pub. L. No. 91-147, 83 Stat. 360; Act of Dec. 17, 1970, Pub. L. No. 91-555, 84 Stat. 1441; Act of Nov. 24, 1971, Pub. L. No. 92-170, 85 Stat. 490; Act of Oct. 25, 1972, Pub. L. No. 92-566, 86 Stat. 1181; Act of Dec. 31, 1974, Pub. L. No. 93-573, 88 Stat. 1873.

Congressional reports and materials presented to that body in other deliberations reflect the same understanding. The public domain is a one-way ratchet; materials can enter but they cannot be removed. The House Report on the 1909 Act took care to explain that Congress had included a specific provision "to make it clear that the original text of any work which has fallen into the public domain can not be copyrighted." H.R. REP. NO. 59-7083, at 11 (1907). The Report on the 1976 amendments likewise recognized that "[t]here can be no protection for any work that has fallen into the public domain," and that "lost or expired copyrights cannot be revived." H.R. REP. NO. 94-1476, at 180 (1976); *accord Final Report of the Ad Hoc Working Group, supra*, at 591 n.15 (*quoting* 1 M. Nimmer, *Nimmer on Copyright* § 105[A] (1984)) ("[N]either the copyright clause nor the First Amendment would permit the granting of copyright to works which have theretofore entered the public domain.").

That understanding was crucial when Congress considered whether to grant protection to works in the public domain in 1988 in connection with joining Berne. As Representative Kastenmeier – widely respected on matters of copyright and regarded as the principal force behind the formative 1976 Act – explained, works in the "public domain" are "the common property of the people to use as they see fit." 7 William F. Patry, *Patry on Copyright* § 24:21 (2008) (*quoting* 133 Cong. Rec. H1293, H1296 (daily ed. Mar. 16, 1987)). The House Committee on the Judiciary

noted that providing copyrights in public domain works posed constitutional issues: "The question of whether and, if so, how Congress might provide retroactive protection to works now in our public domain raises difficult questions, possibly with constitutional dimensions." H.R. REP. NO. 100-609, at 51 (1988), *quoted in Patry on Copyright*, *supra*, § 24:21. The Register of Copyrights likewise recognized that restoration was contrary to "American traditions against the removal of works from the public domain," and could raise "serious constitutional concerns." *The Berne Convention: Hearings on S. 1301 and S. 1971 Before the Subcomm. on Patents, Copyrights and Trademarks of the S. Comm. on the Judiciary*, 100th Cong. 150 (1988) (statement of Ralph Oman, Register of Copyrights and Assistant Librarian for Copyright Services); *see also Final Report of the Ad Hoc Working Group*, *supra*, at 590-91 & nn.15-16 (recognizing the Copyright Clause and First Amendment might impose "constitutional obstacles" to copyright restoration).

Against this two-hundred-year tradition dating back to the first Congress and the Copyright Act of 1790, the government has offered two wartime statutes (the Acts of 1919 and 1941) that authorized the President to give foreign authors additional time to comply with copyright formalities. Act of Dec. 18, 1919, Pub. L. No. 66-102, 41 Stat. 368; Act of Sept. 25, 1941, Pub. L. No. 77-258, 55 Stat. 732. Congress never invoked its Article I authority to justify these measures, and neither was challenged in court. On

the contrary, it appears Congress simply decided to "sweep the constitutional issues under the rug." *Nimmer on Copyright*, *supra*, § 9A.07[A]. If anything, these two statutes reflect Congress's recognition that in the exigency of wartime, it would be inappropriate to deny protection to authors who were "temporarily unable to comply with the conditions and formalities" prescribed by the U.S. statute "because of the disruption or suspension of facilities essential for such compliance." Act of Sept. 25, 1941, *supra*, 55 Stat. 732.

In the proceedings below the government also pointed to five private bills that extended copyright protection to individual works that had entered the public domain.[7] Each apparently reflected an isolated judgment by Congress based on the specific circumstances of the people involved. None of the bills appears to have been challenged, and none is remotely comparable to Section 514's wholesale grant of copyright protection for the estimated millions of works in the public domain. So too the private patent bills the government identifies,[8] and any

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

[8] An Act to Renew the Patent of Thomas Blanchard, ch. 213, 6 Stat. 589 (June 30, 1834); An Act for the Relief of William

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suggestion that Congress has plenary power to remove inventions from the public domain has been rejected. *See Graham*, 383 U.S. at 6.

Taken together, or individually, the isolated aberrations on which the government relies demonstrate that removing any work from the public domain is a highly unusual exception to the "time honored tradition" of leaving the public domain intact and undisturbed. Pet. App. 98. That tradition confirms what the text and purpose of the Copyright Clause make clear: Congress has no power to remove works from the public domain, and Section 514 exceeds the limited powers the Copyright Clause provides.

II. Section 514 Violates The First Amendment.

Section 514 imposes extraordinary burdens on core speech and expression rights by eliminating established rights to perform music, distribute films and publish books that were in the public domain. Under *Eldred*, copyright statutes that burden such rights and alter the "traditional contours of copyright protection" may be subject to the usual standards of First Amendment scrutiny. The Tenth Circuit held Section 514 departed from the "time honored

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Gale, ch. 131, 6 Stat. 895 (Mar. 3, 1843); An Act for the Relief of John Goulding, ch. 88, 12 Stat. 904 (May 30, 1862); An Act for the Relief of the Heirs of William Graham, ch. 187, 20 Stat. 542 (June 11, 1878).

tradition" of leaving the public domain intact, and was subject to First Amendment scrutiny. But it erred when it later concluded that Section 514 survives First Amendment scrutiny. To the contrary, none of the interests the government identifies can justify the speech burdens Section 514 imposes.

A. Section 514 Is Subject To First Amendment Scrutiny Because It Alters The Traditional Contours Of Copyright Protection.

In *Eldred*, this Court recognized that copyright statutes are not "categorically immune" from First Amendment scrutiny. 537 U.S. at 221. It nonetheless excused the Copyright Term Extension Act from ordinary First Amendment scrutiny based on history and tradition. *See id.* at 219-21. It held that when Congress has not altered "the traditional contours of copyright protection," copyright's "built-in free speech safeguards" are generally adequate to protect speech interests, and further First Amendment review is unnecessary. *Id.* at 221.

That conclusion was based on the historical compatibility between copyright and First Amendment values. *See id.* at 219-20. The Court reasoned that although statutes conforming to "historical contours" may be presumed constitutional because of that historical compatibility, substantial deviations from those "traditional contours" cannot be presumed

constitutional on that basis, and must be assessed under ordinary First Amendment review. *Id.* at 221.

Section 514 alters the "traditional contours of copyright protection" in a dramatic and unprecedented way. *Eldred*, 537 U.S. at 221. For two hundred years, Congress expanded the scope and duration of copyright protection but left the public domain intact. *See supra*, 28-37. It respected the "bedrock principle" of copyright law: "works in the public domain remain in the public domain." Pet. App. 98.

That "bedrock principle" protects core First Amendment values. As new works enter the public domain, they expand the universe of speech and expression that is available to the public to learn, express, distribute and enjoy without restriction. This is a principal mechanism by which copyright fulfills its speech-enhancing mission of "promoting broad public availability of literature, music, and the other arts." *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). It is also a principal mechanism by which copyright fuels the "engine of free expression." *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985). Once works enter the public domain their contents become the building blocks of future creations. *See Sony,* 464 U.S. at 429; Pet. App. 76-77.

It is precisely the absence of any restrictions that makes the public domain so valuable. Each member of the public is free to use any part of a work in the public domain, or all of it, in any way for any purpose

whatsoever. The rules are clear, and they maximize both dissemination and further creativity.

Removing works from the public domain contracts the universe of speech and expression available to the public, and restricts access to the very fuel that fires the engine of free expression. It also takes clear and stable rules and makes them unreliable and unpredictable. That uncertainty itself has a substantial chilling effect on those who would use the public domain for its intended purpose. Any incentive to invest in using the contents of the public domain is substantially diminished if the fruits of that labor may be confiscated at any time.

The speech interests that petitioners lost here are very different from those asserted by the petitioners in *Eldred*. In that case, the works affected by term extension had never entered the public domain. Those works had always been subject to copyright protection, so the public arguably lost nothing at the time the copyrights were extended. As a result, the Court concluded the *Eldred* petitioners asserted no more than the right to make "other people's speeches." 537 U.S. at 221.

Here, petitioners do not assert the right to make other people's speeches. They assert the right to make the speeches that belonged to them and to the American public until Congress took them away and gave them to the heirs of foreign authors. The expression contained in the symphonies, books, films, and artwork at issue here "belonged to [petitioners] when it

entered the public domain." Pet. App. 101. "[N]either the author nor the author's estate [had] any more right to the work than any member of the general public." *Id*. 105-06.

In this case, petitioners and the public enjoyed the "federal right to copy and use" for any purpose all of the works Section 514 removed from the public domain. *See Dastar*, 539 U.S. at 33-34. Unlike the term extension statute that was before the Court in *Eldred*, Section 514 takes away vested and established public speech rights. *See* Symposium, *The Constitutionality of Copyright Term Extension: How Long Is Too Long?*, 18 CARDOZO ARTS & ENT. L.J. 651, 701-02 (2000) ("[T]here is a First Amendment right to publish freely works that are in the public domain.").

The rights to perform music, distribute a film, and publish a book are critical First Amendment freedoms. *See Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989); *Vance v. Universal Amusement Co.*, 445 U.S. 308, 315-16 (1980) (per curiam); *Bantam Books, Inc. v. Sullivan*, 372 U.S. 58 (1963). First Amendment rights do not become less important just because they involve the expression of another author. *See*, *e.g.*, *Hurley v. Irish-Am. Gay, Lesbian & Bisexual Group of Boston*, 515 U.S. 557, 570 (1995) (presentation of edited compilation of speech "generated by other persons . . . fall[s] squarely within the core of First Amendment security"); *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 116 (1991) (publishing house that selects authors for publication is "speaker" for First

Amendment purposes); *Ward*, 491 U.S. at 790 (recognizing unincorporated association's First Amendment right to sponsor musical performances by others); *N.Y. Times Co. v. United States*, 403 U.S. 713 (1971) (per curiam) (recognizing newspaper's First Amendment interest in publishing work authored by government employees); *Lovell v. City of Griffin*, 303 U.S. 444, 452 (1938) (the "[l]iberty of circulating is as essential . . . as liberty of publishing; indeed, without the circulation, the publication would be of little value").

The two "built-in free speech safeguards" this Court identified in *Eldred* are plainly inadequate to protect the speech and expression rights that Section 514 took from petitioners, or those it took from the public. While the distinction between idea and expression provides some protection for First Amendment interests because it limits copyright protection to the author's expression, and leaves the idea free for all to use, *see Eldred*, 537 U.S. at 219, that safeguard provides little consolation here. Petitioners and the public had, for instance, the unrestricted right to use the *expression* of Shostakovich and Prokofiev, not just the "ideas" those works embody. Similarly, the fair use doctrine permits the use of some copyrighted expression "in certain circumstances" and provides "considerable latitude for scholarship and comment," *id*. at 219-20, but that safeguard provides no protection for the rights Section 514 took from petitioners and the public. They had the unrestricted right to perform, copy, teach and distribute the *entire* work,

for any reason. "The fact that the fair use doctrine permits some access" is not an "adequate substitute for the unlimited access enjoyed before [Section 514] was enacted." Pet. App. 105. Playing a few bars of a Shostakovich symphony is no substitute for performing the entire work.

The "federal right to copy and use" material in the public domain, *Dastar*, 539 U.S. at 34, is not simply a "traditional contour of copyright protection." It is a defining feature of American copyright law, and an essential safeguard that ensures copyright remains "compatible with free speech principles." *Eldred*, 537 U.S. at 219. Section 514 departs from the time-honored tradition of leaving the public domain intact, and dismantles the speech protections that tradition provided to both petitioners and the public. It cannot escape First Amendment scrutiny.

B. Section 514 Fails Intermediate Scrutiny And Is Substantially Overbroad.

A content-neutral statute that burdens speech rights is subject to intermediate First Amendment scrutiny, and must not be substantially overbroad. *See, e.g.*, *Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622 (1994) ("*Turner I*"); *Village of Schaumburg v. Citizens for a Better Environment*, 444 U.S. 620, 637-39 (1980) (regulation limiting speech held invalid when it promotes substantial government interest, but only "peripherally").

A statute survives intermediate scrutiny only if "it furthers an important or substantial governmental interest; if the governmental interest is unrelated to the suppression of free expression; and if the incidental restriction on alleged First Amendment freedoms is no greater than is essential to the furtherance of that interest." *Turner I*, 512 U.S. at 662 (*quoting United States v. O'Brien*, 391 U.S. 367, 377 (1968)). The government must do more than simply identify an important interest. It must prove that "the recited harms are real, not merely conjectural, and that the regulation will in fact alleviate these harms in a direct and material way." *Id*. at 664.

In the proceedings below, the government invoked three interests in support of Section 514: (1) promoting the rights of U.S. copyright holders abroad; (2) complying with the Berne Convention; and (3) correcting the supposedly "inequitable treatment of foreign authors." Resp. C.A. Br. 28-48. None of these interests is sufficient to uphold Section 514.

1. The Interest In Promoting The Rights Of U.S. Authors Abroad Cannot Justify Section 514.

The only government interest the Tenth Circuit addressed is the first. It held Section 514 is narrowly tailored to the interest in promoting the rights of U.S. copyright holders abroad because the United States could "set an example" for other countries with respect to restoring public domain works.

Pet. App. 21-22. The purpose of granting protection to foreign works that were in the public domain of the United States, the Tenth Circuit observed, was to induce other countries to provide "similar protection for American copyright holders." *Id.* 24; *see also id.* 19-22 (United States needed to restore foreign copyrights because U.S. trading partners were refusing to restore copyrights on previously created U.S. works).

Far from being an important interest, that goal is not even a legitimate purpose. Standing on its own and separated from Berne, removing works from the public domain does nothing but create private economic benefits – windfalls to authors of existing works that entered the public domain long ago. Section 514 confers windfalls directly on foreign authors in the hope that this may create later windfalls for U.S. authors. But the defect is the same either way: creating private benefits is not a legitimate objective of copyright regulation. *See Sony*, 464 U.S. at 429; *Fox Film*, 286 U.S. at 127.

More importantly, Section 514 sacrifices established public speech rights to create these private benefits. The government cannot claim a legitimate – much less important – interest in sacrificing public speech rights simply to create economic benefits for any private party. While the Tenth Circuit suggested that Congress was "balanc[ing] the interests of American copyright holders against American reliance parties," Pet. App. 24, that is precisely the problem. Congress was giving away vested public speech rights on the bare possibility that it might someday create

private economic benefits for U.S. authors. It takes from petitioners and the public the established rights to perform music and distribute films (and all sorts of other works) in the hope that this will allow U.S. copyright owners to make more money.

Even if there were a legitimate or important interest in giving away the established speech and expression rights of the American public so that U.S. copyright owners can obtain retroactive copyright protection abroad, Congress had no substantial evidence that Section 514 would actually advance that interest. *See Turner I*, 512 U.S. at 665. The testimony on which the government and the Tenth Circuit rely expresses nothing more than a general hope that a few foreign nations may one day provide reciprocal protection for existing U.S. works in their public domains. *See* Pet. App. 19-25; *see also Joint House and Senate Comm. Hearings on the URAA* at 120, 137, 225 & 249 n.2.

These statements are nothing more than guesses about what other countries might do someday. *See id*. At best they are predictions, but they are not based on anything like the "empirical support" or "factual predictions" *Turner* demands. *See Turner I*, 512 U.S. at 666; *cf. Turner Broad. Sys., Inc. v. FCC*, 520 U.S. 180, 196-210 (1997) ("*Turner II*") (detailing extensive evidence justifying must-carry provisions, including "years of testimony" and "volumes of documentary evidence and studies offered by both sides"). While Congress is certainly allowed to make predictive judgments, it must do so based on substantial evidence.

The abstract and unsubstantiated hope that foreign countries might provide voluntary but unspecified economic benefits of uncertain value to a group of U.S. copyright owners does not provide the "substantial evidence" *Turner* demands. *See Turner I*, 512 U.S. at 665-66; *cf. Ibanez v. Bd. of Accountancy*, 512 U.S. 136, 143 (1994) (speculation, conjecture and unsupported assertions cannot justify commercial speech restriction).

2. The Government's Interest In Complying With The Berne Convention Cannot Justify Section 514.

The second interest the government asserts in defense of Section 514 is the need to comply with the Berne Convention. But no treaty can authorize the government to do what the Constitution otherwise prohibits. *Boos v. Barry*, 485 U.S. 312, 324 (1988); *Reid v. Covert*, 354 U.S. 1, 16 (1957) (plurality opinion). Simply invoking a treaty, or the need to comply with it, does not by itself demonstrate an important interest. The importance of the government's interest, and whether it is sufficient to support Section 514, must depend on what Section 514 actually accomplishes.

The benefits that Berne participation provides cannot justify Section 514 for two reasons. First, the government *already* secured those benefits by joining the Berne Convention in 1988 and there is no evidence sufficient to show those benefits were in any

jeopardy. Second, Section 514 causes far more harm to speech interests than the terms of Berne require, and is not narrowly tailored to any interest in Berne compliance.

a. There Was No Substantial Evidence Of Any Harm.

The government asserts that Congress enacted Section 514 to comply with the Berne Convention. Yet the United States had already joined Berne in 1988, securing for U.S. authors all the prospective benefits of protection under the Convention. Congress concluded in 1988 that the Convention permitted the United States to join Berne without granting protection to any works in the public domain of the United States, and that the United States had complied with Berne upon enacting the BCIA. *See* H.R. REP. NO. 100-609, at 51-52; BCIA § 2(3) ("The amendments made by this Act, together with the law as it exists on the date of enactment of this Act, satisfy the obligations of the United States in adhering to the Berne Convention. . . .").

There are scattered suggestions in Section 514's legislative history that some Berne members believed that the United States was out of compliance with Berne because it had not provided copyright protection to foreign works in the public domain of the United States. *See Joint House and Senate Comm. Hearings on the URAA* at 137, 248. But the Office of the U.S. Trade Representative disagreed, and

informed the Chairman of the Subcommittee on Intellectual Property and Judicial Administration of the House Committee on the Judiciary in 1994 that restoration was discretionary. *Id.* at 2 (Opening Statement of Chairman William J. Hughes).

Even if the enactment of the BCIA in 1988 did not bring the United States into full compliance with Berne, the only apparent consequence of any such noncompliance was limited: a few Berne members had apparently declined to restore copyright protection to U.S. works that were in the public domain in those nations. *Id.* at 137 (statement of Ira S. Shapiro, General Counsel, Office of the U.S. Trade Representative) (noting that Thailand and Russia had refused to restore copyright of U.S. works in their public domains). U.S. authors were not threatened with the loss of any of the benefits secured in 1988, or the loss of any existing protection.

To justify the burdens Section 514 imposes on public speech rights, the government must point to substantial evidence of real harm. *See Turner I*, 512 U.S. at 666. The only evidence of harm here was the continued refusal of a limited and specific number of foreign nations to grant protection to U.S. works that were already in the public domain of those foreign nations. The interest in avoiding the so-called harm of that status quo is nothing more than the interest in creating economic windfalls. Again, that is not a legitimate government interest, much less an important one, and it cannot justify the vast burdens on public speech rights that Section 514 imposes.

b. Section 514 Is Not Narrowly Tailored Because The United States Could Have Complied With Berne While Burdening Substantially Less Speech.

Even if the United States were out of compliance with Berne following the enactment of the BCIA, Section 514 is not narrowly tailored to the interest of Berne compliance, because the United States could have complied with any restoration obligation Berne imposes while burdening substantially less speech. First, the United States could have avoided restoration altogether through existing mechanisms that permit negotiated exceptions to Berne's restoration obligations. Second, even if that were not feasible, the plain terms of Berne show the United States could have met any plausible restoration obligation while burdening substantially less speech.

i. Berne Permits Negotiated Exceptions To Restoration Requirements.

The Berne Convention permits each member to negotiate "special conventions" that modify Article 18's restoration provisions. *See* Berne Conv. Art. 18(3) ("The application of this [restoration] principle shall be subject to any provisions contained in special conventions to that effect existing or to be concluded between countries of the Union."). Nineteenth-century bilateral treaties among Berne members denied retroactive protection or qualified it with

exceptions and conditions. *See* Sam Ricketson, *The Berne Convention for the Protection of Literary and Artistic Works: 1886-1986* 666-67 (1987).

As Congress recognized in 1988, providing any protection for public domain works posed unique problems for the United States given the size and scope of its public domain, as well as the unique protection for speech and expression rights that the U.S. Constitution demands. *See* H.R. REP. NO. 100-609 at 51-52 (1988). The plain terms of Article 18 would have allowed the United States to negotiate agreements that modified or eliminated Berne's restoration requirements to accommodate the unique position of the United States relative to any other Berne signatory. Indeed, the United States demanded and obtained an exception to another provision of Berne relating to "moral rights" in the course of negotiating the TRIPS agreement that made Berne obligations enforceable through the World Trade Organization. *See* 2 *The GATT Uruguay Round: A Negotiating History (1986-1992)* 2288-89 (Terence P. Stewart ed., 1999); Ralph Oman, *Berne Revision: The Continuing Drama*, 4 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 139, 143 (1993).

The government cannot invent an important First Amendment interest simply by signing a treaty or trade agreement that requires it to dismantle First Amendment protections. If anything, it has an obligation to protect fundamental speech rights, not to bargain them away. *See* Curtis Bradley & Jack Goldsmith, *Treaties, Human Rights, and Conditional*

Consent, 149 U. PA. L. REV. 399, 417-22 (2000) (United States declined to adopt restrictions on hate speech in connection with ratification of International Covenant on Civil and Political Rights because they conflicted with First Amendment speech and expression rights). Neither Berne nor TRIPS permits the government to simply cast aside the "serious constitutional concerns" it recognized in 1988 when it declined to provide copyrights in public domain works.

ii. Berne Permits Complete And Permanent Protection For Reliance Parties Like Petitioners.

Even in the absence of any "special conventions" or other agreements, the plain text of Article 18 leaves every Berne member wide and unilateral discretion to "determine the conditions" of restoration. *See* Berne Conv. Art. 18(3) ("[T]he respective countries shall determine, each in so far as it is concerned, the conditions of application of this [restoration] principle."). The text of Article 18 places no restrictions on the "conditions" each member may attach. It leaves that decision up to the broad discretion of each member, especially in regard to the protection of reliance parties. *See, e.g.*, Paul Goldstein & Bernt Hugenholtz, *International Copyright* § 8.4, at 295 (2010); J.A. 201-02 (Declaration of Professor Lionel Bently); *see also* Claude Masouyé, *Guide to the*

Berne Convention for the Protection of Literary and Artistic Works (Paris Act, 1971) 101 (WIPO ed., 1978).

While Berne provided the United States with wide latitude to protect reliance parties as it saw fit, the United States chose to provide only temporary protection for reliance parties. Reliance parties who are performing, selling, distributing or otherwise using restored works are protected only for one year after a copyright owner files the notice necessary for enforcing restored copyrights. *See* 17 U.S.C. §§ 104A(d)(2)(A)-(B), Pet. App. 174-77. A party who creates a derivative work may continue to exploit that work for a longer period, but only upon paying "reasonable compensation" to the new copyright owner for using what was by definition free and previously in the public domain. *See id.* § 104A(d)(3), Pet. App. 176. This restrictive protection of reliance interests stands in contrast to the approach of other Berne signatories, which provide varying forms of permanent protection to certain reliance interests. J.A. 197-200, 202-03, 206-08 (Declaration of Professor Lionel Bently).

Nothing in Berne required the United States to provide weak and temporary protection for reliance parties. The terms of Article 18 do not specify, demand or require *any* restoration of rights against reliance parties. *See* Berne Conv. Art. 18. There is nothing in its text that prohibits reliance interests from being protected completely and permanently. Section 514 recognizes as a reliance party any person who, prior to restoration, exercised any of the

exclusive rights the Copyright Act provides in Section 106, or acquired copies or recordings of restored works. *See* 17 U.S.C. § 104A(h)(4), Pet. App. 183. Nothing in Article 18 would prohibit the United States from providing these reliance parties with the permanent right to do anything they did prior to Section 514, or the permanent freedom to do as they wish with any copy or recording that was lawfully made prior to Section 514.

The district court agreed. It recognized that Article 18(3) provides "broad latitude to protect reliance parties – even for an unlimited time." Pet. App. 61-62. It invalidated Section 514 on that ground, holding that the government could have provided complete and permanent protection for reliance parties like petitioners under the express terms of Berne. *See id.* 62 (holding Section 514 invalid "to the extent Section 514 suppresses the rights of reliance parties to use works they exploited while the works were in the public domain").

This is not a new or novel suggestion. When Congress first considered granting protection in public domain works in connection with joining Berne, the Copyright Office itself concluded that any grant of copyright protection to public domain works must provide strong – and permanent – protection for reliance parties. It recognized that "recapture [of copyrights] cannot cut off existing rights in the continued utilization of works in the United States, which were lawful prior to recapture." *U.S. Adherence to Berne Convention: Hearings Before the Subcomm.*

on Patents, Copyrights and Trademarks of the S. Comm. on the Judiciary, 99th Cong. 662 (May 16, 1985 and Apr. 15, 1986) ("Implementing Legislation to Permit U.S. Adherence to the Berne Convention," a draft bill and commentary).

The weak and temporary protection for reliance parties that Section 514 provides is neither required by Berne, nor narrowly tailored to the interest in complying with Berne. All the United States had to do to provide complete and permanent protection for reliance parties was exercise the unilateral discretion that Article 18(3) provides. In refusing to do so, the United States burdened substantially more speech than Berne requires.

iii. Berne Permits The United States To Provide Shorter Terms Of Protection For Many Restored Works, And More Protection For Existing Copies Of Restored Works.

The plain terms of Berne would have permitted the United States to burden substantially less speech in two additional but similarly important ways, yet the United States chose not to adopt them.

Berne Article 7(8) permits each member to adopt the so-called "rule of the shorter term." *See* Goldstein, *International Copyright* § 8.3.1, at 287-88 (2010); Berne Conv. Art. 7(8). Under this provision, each Berne member is permitted to limit the term of

protection for any foreign work to the term that work receives in its country of origin. *See id.* Section 514 ignores the "rule of the shorter term." Instead, it states the copyright in a restored work "subsist[s] 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." 17 U.S.C. § 104A(a)(1)(B), Pet. App. 173. In other words, the restored work automatically receives the full term it would have received in the United States even if the work is protected for a shorter period in the country of origin. In many instances, this results in years of unnecessary protection for works originating in countries that provide terms shorter than those provided by the United States. *See Nimmer on Copyright*, *supra*, § 9A.04[A][1][a] & n.17.5.

Berne would also have permitted the United States to protect "first sale" rights, which have been recognized in the United States for over one hundred years, first by common law and then by statute. *See* 17 U.S.C. § 109, Pet. App. 186; *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339 (1908). The "first sale" right is an exception to the exclusive right of distribution that generally permits the owner of any lawfully made copy to sell or otherwise dispose of that copy without the permission of the copyright owner. *See* 17 U.S.C. § 109(a), Pet. App. 186.

Section 514 eliminates "first sale" rights for restored works after a one-year grace period. *See id.* But that restriction was also unnecessary. Berne does

not require its members to provide any exclusive rights of distribution in the first place, except for cinematographic works. *See* Goldstein, *International Copyright*, *supra* § 9.1.2; Berne Conv. Art. 14(1)(i). Berne plainly did not require the U.S. to abandon an exception to exclusive distribution rights that Berne does not recognize. By limiting the "first sale" right for all restored works, Section 514 burdens the right to sell or dispose of untold copies of the millions of works restored.

The plain terms of the Berne Convention show that Section 514 imposes burdens on the speech and expression rights of petitioners and the public that are far greater than anything Berne requires. Whatever interest the government might have in complying with Berne, the government is not permitted to burden more speech than Berne requires. *See Boos*, 485 U.S. at 324-29 (interest in complying with treaty does not permit government to ignore less restrictive alternatives permitted by treaty).[9]

[9] The unnecessary burdens Section 514 imposes on core speech rights demonstrate it is unconstitutional on its face, and as applied to petitioners or any other reliance party.

III. Congress Cannot Avoid The Explicit Restrictions Of The Copyright Clause Or The First Amendment By Invoking Other Powers.

In the proceedings below, the government contended the Commerce Clause or the Treaty Power might empower Congress to enact Section 514 even if that statute violates the Copyright Clause or the First Amendment. But Congress's other powers cannot enable it to violate the express restrictions that the Copyright Clause or the First Amendment impose.

In general, Congress may pass legislation under one power even if that legislation is outside the ambit of another power. *See, e.g.*, *Heart of Atlanta Motel, Inc. v. United States*, 379 U.S. 241 (1964) (Civil Rights Act authorized under Commerce Clause power, even if not authorized under Fourteenth Amendment Section 5 power); *Missouri v. Holland*, 252 U.S. 416, 432 (1920) (legislation implementing treaties authorized under Necessary and Proper Clause, even if not authorized under other enumerated powers).

Trademarks, for instance, do not relate to inventions, discovery, or authorship, so their regulation falls outside the ambit of the Copyright and Patent Clauses. *See Trade-Mark Cases*, 100 U.S. 82, 93-94 (1879). Consequently, the power to protect trademarks may (or may not) be found in the Commerce Clause. *See id*. at 95. Criminal statutes prohibiting bootleg sound recordings do not create exclusive

rights for authors. *See United States v. Martignon*, 492 F.3d 140, 152 (2d Cir. 2007). So the power to enact them may also be found in the Commerce Clause. *See id.*

Congress may not, however, use one power – not even its broad commerce or treaty powers – to avoid express restrictions on another power. That is plainly true where a prohibition is imposed by the Bill of Rights. *See, e.g.*, *Reid*, 354 U.S. at 16-19 (Congress cannot use its power to implement treaties to violate the Fifth and Sixth Amendments); *New York v. United States*, 505 U.S. 144, 156 (1992) (First Amendment limits commerce power). It is equally true where a prohibition appears as an express restriction on an Article I power. In *Railway Labor Executives Ass'n v. Gibbons*, 455 U.S. 457 (1982), Congress passed a targeted bankruptcy law applying to a single bankrupt railroad. *See id.* at 461-63. The Court held that the law could not be upheld under the Bankruptcy Clause, which requires bankruptcy laws to be "uniform." *Id.* at 470-71. The Court concluded that Congress could not pass a non-uniform bankruptcy law under its Commerce Clause power either, because that would "eradicate from the Constitution a limitation on the power of Congress." *Id.* at 468-69; *cf. United States v. Moghadam*, 175 F.3d 1269, 1280 n.12 (11th Cir. 1999) (assuming without deciding that "the Commerce Clause could not be used to avoid a limitation in the Copyright Clause" if the statute is "fundamentally inconsistent" with a specific limitation of the Copyright Clause).

Like the Bankruptcy Clause, the Copyright Clause "is both a grant of power and a limitation." *Graham*, 383 U.S. at 5. It authorizes Congress to grant copyrights, but it places explicit restrictions on that power by requiring copyrights to last only for "limited [t]imes." If Congress could avoid that specific restriction by invoking another power, that limitation would also be "eradicated." *See Railway*, 455 U.S. at 469. Congress cannot be permitted to "eradicate" that restriction with the Commerce Clause or the Treaty Power. *See Reid*, 354 U.S. at 16 ("[N]o agreement with a foreign nation can confer power on Congress . . . which is free from the restraints of the Constitution."). So while this Court held in *Missouri v. Holland* that a treaty can empower Congress to exercise power that is ordinarily reserved to the states by the "invisible radiation" of the Tenth Amendment, that was only true because the "treaty in question [did] not contravene any prohibitory words to be found in the Constitution." 252 U.S. at 434. Here, Section 514 does exactly that. Neither the Commerce Clause nor the Treaty Power can authorize Section 514's violation of the "limited [t]imes" restriction or the First Amendment.

CONCLUSION

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

Respectfully submitted,

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