
INTELLECTUAL PROPERTY

FIRST AMENDMENT CHALLENGES TO COPYRIGHT LAWS:

Kahle v. Gonzales AND *Golan v. Gonzales*

By David S. Olson*

There has been an attempt in the last few years to reverse some of the territorial creep of copyright law that has occurred in recent decades. These challenges have sought to undo copyright term extensions, increase the purview of fair use exceptions, and, in the cases discussed below, to constrict Congress's ability to expand copyright protections by use of First Amendment arguments. There is a reason for this recent pushback against copyright law. It is well known that the ways in which we create, distribute, critique, imitate, and copy writings and graphic arts have changed enormously in the three decades since the advent of the personal computer. Much ink has been spilled detailing the powerful changes that computers, cheap memory, digitization, the Internet, and increasing broadband adoption have wrought in the way that content is created and copyright enforcement challenged. But at least as important for copyright as technological changes are the profound changes to copyright law itself that have resulted in an unprecedented increase in the number of works copyrighted and the length of time copyright endures. In 1976—the same year that the Apple I personal computer was created¹—Congress changed copyright law from an “opt-in” registration system, in which less than half of all new works were copyrighted each year and the average copyright lasted only a short time,² to a longer-term automatic copyright system from which it is relatively difficult to “opt-out.”³

Prior to the 1976 Copyright Act, authors had to comply with formalities and register their works in order to receive copyright protection. The result was that about half of otherwise-qualifying works were never registered. In addition, the copyright term was fairly short before 1976, lasting only 14 years at first, which was eventually extended to 28 years. If an author wanted to renew his copyright, he had to pay a fee and officially renew the work. Approximately 85% of copyrighted works were never renewed.⁴ This regime meant that for the entirety of United States history prior to the 1976 Copyright Act, (1) many works of authorship were never covered by copyright at all, and (2) the vast majority of copyrighted works lost copyright protection within 14-28 years.⁵

The 1976 Copyright Act worked a sea change on the practice of copyright in the United States. The Act made two important changes. It extended copyright terms to life of the author plus 50 years, and it did away with the registration requirement and all formalities for achieving copyright

protection for a work. Thus, since January 1, 1978, virtually every bit of expression set down in a “tangible medium” has automatically received copyright protection for life of the author plus 50 years (75 years for certain older works and works made for hire). Subsequently, the Copyright Term Extension Act of 1998 extended copyright terms to life of the author plus seventy years (95 years for certain older works and works made for hire).⁶

Congress made these changes to copyright law out of concern for copyright owners and to comply with the Berne Convention for the Protection of Literary and Artistic Works.⁷ Thus, when it came to formalities, Congress was concerned that copyright owners were losing their copyrights due to carelessness in complying with copyright formalities. Eliminating the formalities eliminated the problem. Likewise, when Congress extended copyright terms after intense lobbying from corporate copyright owners like the Walt Disney Company,⁸ Congress was concerned with keeping valuable intellectual property in U.S. companies' hands. What Congress does not seem to have focused on is the interests of public users of copyrighted works. Making copyright owners register and renew their copyrights put the burden (which was low) of attaining and keeping copyright on the copyright owners, who had the best information as to copyright value and thus were the least cost avoiders. Likewise, although copyright term extension benefited a select group of copyright owners who owned work that had long-term value, it denied the public the right to unrestricted use of both commercially valuable and non-valuable copyrighted works for an additional 20 years.

The significance of these copyright law changes on those who would quote, copy, or otherwise use another's pre-existing work should not be underestimated. A researcher working before 1978 would safely assume that things published more than 56 years ago were in the public domain and could be used freely. He would also likely assume that anything out of print and published longer than 28 years ago was in the public domain, and he would be correct about 85% of the time. Finally, if a work bore no copyright notice, he would know immediately that the work was not covered by copyright and that he could freely use it.

Today's would-be user of copyrighted material faces a different scenario entirely. He knows that anything published since 1978 is automatically copyrighted for the life of the author plus 70 years. He knows that he may only safely use materials published over 85 years ago—prior to 1923.⁹ For works published between 1923 and 1976 he must trace the history of registration and renewal to determine copyright status.¹⁰

Thus today's researcher or user of copyrighted materials faces a very different landscape than he did thirty years ago. While the pre-1976 Act researcher could make use of the vast majority of materials from just a generation or two earlier

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without running afoul of copyrights, today's researcher may need to seek copyright permission to use many materials from the last three or four generations. The researcher of 2108 will need to seek permission to use all materials created in the preceding 70 years and many works that are over 100 years old will remain covered by copyright.

Some may see little cause for concern because use of others' work has a flavor of theft to it—one thinks of college students lobbying for the destruction of copyright so that they may download music freely. But a growing body of literature points out that the more one looks at the concepts of novelty and originality in authorship, the more one realizes that, one way or another, there truly is (as Ecclesiastes tells us) "nothing new under the sun." For instance, in Judge Posner's recent book, *The Little Book of Plagiarism* (2007), the author discusses how Shakespeare could not have created his brilliant plays without extensive (and uncredited) use of numerous, and often recent, historical and literary sources.¹¹ Likewise, only a couple of generations ago, it was expected that persons of letters would quote without attribution from the works of others.¹² Such allusions were the mark of a well-read person.

But even when a user of copyrighted materials seeks to document each quote assiduously, and to add value to a work rather than to divert sales, copyright law can stymie non-exploitative use of copyrighted material. The case of *Shloss v. Estate of James Joyce* is a good example.¹³ In that case, Carol Shloss, a Stanford professor and Joyce scholar, wrote a book on James Joyce's relationship with his daughter Lucia and the way that relationship and Lucia's artistic work impacted, and can be seen in, Joyce's *Finnegans Wake*. Shloss's book in no way competed for sales with *Finnegans Wake* or any of the other materials from which she quoted. If anything, her book served as a complementary good that increased interest in *Finnegans Wake*. Nevertheless, because the copyright in Joyce's works is controlled by his grandson (Joyce died in 1941), who takes a very dim view about any research whatsoever into his aunt, and thus refused any discussion of licensing Joyce's work for that purpose, Shloss's book was gutted of many of the supporting quotations before publication.¹⁴ Shloss subsequently received pro bono representation from Larry Lessig and the attorneys of the Stanford Law School Center for Internet and Society Fair Use Project and sued for a declaratory judgment of fair use in order to post the supporting quotations on her academic website. After a period of intense litigation, Shloss won her right to quote Joyce's work as needed for her project.¹⁵ The story ended happily for Shloss, though only after much time and aggravation. But she never would have had to fight that fight under the pre-1976 Act regime. And many authors never would have found the resources to fight.

Copyright does not only affect those wanting to quote written materials. Because dramatic arts such as music, choreography, and plays are also copyrighted, under the post-1976 Act regime, a community theater may not use dramatic works without license. Thus, many of the works of the last 85 years are off-limits to those who cannot pay a license fee, and going forward copyright will only be more restrictive, so that the majority of works from the previous century will be copyrighted.

The elimination of formalities with the 1976 Copyright Act had other profound effects. As discussed above, prior to 1978, over 90% of works were in the public domain by the time of their renewal. They had either never been copyrighted (about half of published works) or they were not renewed (about 85% of copyrighted works).¹⁶ Of the small percentage of works whose copyrights were renewed, determining who owned the copyright was fairly straightforward. Not only did the work have to be published with notice and registered, but upon renewal the copyright owner was on record again. Thus, if one wanted to use a copyrighted work, generally one could quickly and easily determine with whom one should be negotiating. The abandonment of formalities and automatic term renewal has changed all of this and created a huge number of "orphan works."

"Orphan works" is the term that has been coined to describe the many works that are now in copyright but are out-of-print, and for which it is difficult to determine the copyright owner.¹⁷ Because copyright now lasts so long, even when the original creator of a work can be easily identified, it may be very difficult to determine who owns the copyright after the originator has died. While the ownership of copyrights in valuable works by famous authors will usually be established at the time of death when other assets are divided, ownership of the copyrights of more ordinary people is not generally determined after death. Thus, such rights likely pass with the residue of the estate. And once copyright ownership has passed beyond the original author, it may continue to be sold, given, or devised in a series of private, non-centrally-recorded transactions. The puzzle of ownership can take significant time and energy to untangle, if the ownership interests can be untangled at all without an opinion from a court.¹⁸

It is against this very changed backdrop of copyright law that the Stanford Law School Center for Internet and Society litigated the recent cases of *Kable v. Gonzales* and *Golan v. Gonzales*.

BACKGROUND: *Eldred v. Ashcroft*

Kable and *Golan* built on the litigation that began in *Eldred v. Ashcroft*.¹⁹ In *Eldred*, plaintiffs challenged the Sonny Bono Copyright Term Extension Act of 1998 (CTEA).²⁰ The CTEA added twenty years to the term of copyright protection, so that for works produced after January 1, 1978, copyright protection lasts for life of the author plus 70 years.²¹ For works for hire and works published before 1978 and still in copyright at the time of the CTEA, copyright was extended to 95 years.²² Plaintiffs made two main arguments as to why the CTEA was unconstitutional, at least in part.²³ First, they argued that the CTEA's extension of copyright terms to existing works violated the Constitution's limitation of Congress's power to grant copyrights only for "limited times."²⁴ Plaintiffs argued that allowing Congress to retrospectively extend copyright terms of previously published works eviscerated the "limited times" limitation and allowed Congress the ability to enact perpetual copyright term a bit at a time. Second, plaintiffs argued that extensions of copyright terms for new and previously published works impacted the speech interests of those who would make use of work that would otherwise fall into the public domain.

Thus, plaintiffs argued, First Amendment scrutiny should be applied to the CTEA, and such scrutiny should result in the CTEA being held unconstitutional.

After losing at the district and circuit court levels, plaintiffs argued their case before the Supreme Court. The Supreme Court affirmed the lower courts, rejecting the plaintiffs' arguments. First, the Court addressed the plaintiffs' arguments that Congress could effectively grant perpetual copyright through a series of term extensions that would apply both prospectively and retrospectively.²⁵ The plaintiffs pointed out that a series of term extensions had kept certain works in copyright for much longer than originally expected. The Court acknowledged the plaintiffs' argument, but rejected that the CTEA's term extension had effectuated a perpetual copyright.²⁶ The Court seemed to think that Congress had extended copyright not out of a nefarious plan to achieve perpetual copyright via continued incremental term extensions but instead to harmonize copyright term in the U.S. with the term adopted by the E.U. in 1993, which is life of the author plus 70 years.²⁷ Notwithstanding that copyright term is now long, the Court held that on its face it is clearly still "limited."²⁸ In addition, the Court suggested that extending copyright terms to existing work could promote authorship because Congress's policy of parity assures authors that their works will get the benefit of future term extensions whether they are published before or after a statute extending copyright term.²⁹ Thus, according to the Court, the CTEA did not violate the Copyright Clause of the Constitution.³⁰

Next, the Supreme Court rejected the plaintiffs' argument that the CTEA violated the First Amendment. The Court did "recognize that the D.C. Circuit spoke too broadly when it declared copyrights 'categorically immune from challenges under the First Amendment.'" But said the Supreme Court, when Congress passes copyright legislation that does not "alter[] the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary."³² The Court noted two important features of copyright law that protect First Amendment interests—the idea/expression dichotomy and fair use.³³ The idea/expression dichotomy strikes a First Amendment balance in copyright law by allowing protection only of an author's expression of her ideas, but not of the ideas themselves.³⁴ Likewise, the fair use exemption to copyright protection allows use of copyrighted works, including direct copying and quotation, "for purposes such as criticism, comment, news reporting, teaching... , scholarship, or research,"³⁵ and for purposes of parody.³⁶ The Supreme Court also noted that the CTEA included specific additional protections for First Amendment interests including the rights of libraries, archives, and the like to make certain uses of works during their last twenty years of copyright for purposes such as preservation, scholarship or research,³⁷ and exemptions for small businesses and restaurants from paying performance royalties for playing televisions or radios in their businesses.³⁸

The Supreme Court's decision in *Eldred* was an unequivocal defeat for the plaintiffs. But it was not a total defeat. The Court's rejection of the D.C. Circuit's holding that copyright statutes are "categorically immune" from First Amendment review left some hope for those seeking to restrict copyright expansion on First Amendment grounds. The logical converse of the holding that

First Amendment scrutiny is not necessary where a statute does not "alter[] the traditional contours of copyright protection" is that, when a statute does alter those traditional contours, First Amendment review should apply.

But what are the traditional contours of copyright protection? The Court left this unanswered in *Eldred*. Are the traditional contours of copyright protection present so long as the idea/expression dichotomy and fair use protections remain in the Copyright Act? Or are the traditional contours of copyright protection altered whenever a statute passed under the copyright clause differs from historical precedent?

Kable v. Gonzales

Two circuit courts have recently addressed these questions, each coming to a different conclusion.³⁹ Lead plaintiff in *Kable v. Gonzales*, Brewster Kahle, runs the Internet Archive, whose goal it is to archive the oft-ephemeral data and content generated digitally on the Internet.⁴⁰ Co-plaintiff Richard Prelinger of Prelinger Associates, Inc., makes free copies of ephemeral movies available on the Internet. These plaintiffs made two challenges in *Kable*. First, they challenged the Copyright Renewal Act of 1992, which eliminated copyright renewal requirements for works created between 1964 and 1977.⁴¹ Second, and probably unfortunately, they argued that they should be allowed to present evidence that the Copyright Term Extension Act (already challenged in *Eldred*) violated the framers' understanding of the "limited times" restriction on copyright in the Constitution.

The Ninth Circuit quickly rejected the plaintiffs' CTEA argument. It stated that even though *Eldred* had only addressed in dicta what the framers would have thought the term "limited times" meant,⁴² the Court had nevertheless upheld the constitutionality of the entire CTEA. True, the issue before the Court in *Eldred* was whether the retroactive application of the term extension was constitutional, while the plaintiffs in *Kable* argued that the length of the term itself was unconstitutional. Still, the Ninth Circuit deemed this difference too small to merit review. The Ninth Circuit thought that the Supreme Court's reasoning as to why the CTEA's retroactive application was constitutional was broad enough to apply to the length of the CTEA's term as well. The Ninth Circuit stated that because "[a]rguments similar to Plaintiffs'" were presented in *Eldred*, "[t]he Supreme Court has already effectively addressed and denied Plaintiffs' arguments."⁴³

The Ninth Circuit's disregard for the plaintiffs' argument as to copyright term may have encouraged the Court to give short shrift to their constitutional arguments about the elimination of the copyright renewal requirement. The plaintiffs argued that the elimination of the renewal requirement altered the traditional contours of copyright protection because renewal had long been a requirement for enjoying extended copyright term in the United States.⁴⁴ They argued that the effect the renewal requirement had of ensuring a large public domain of published works was a traditional contour of copyright. Plaintiffs pointed out, and the Court accepted, that renewal requirements both limited orphan works and made it so that "only a small percentage" of creative works were under copyright for the maximum term.⁴⁵

The Court also acknowledged that “[e]liminating the renewal requirement dramatically increased the average copyright term and correspondingly decreased the number of works currently entering the public domain.”⁴⁶ The plaintiffs characterized this as a change from an “opt-in” patent system to an “opt-out” system. Under the previous, opt-in system, formalities were required to gain copyright protection, and most copyrighted works were not renewed. Thus, the opt-in system created a large public domain. Under the so-called opt-out system, copyright attaches immediately to any expression fixed in a tangible medium, and it lasts for the full term of copyright without the author needing to do anything at all. If an author does not want the full extent of copyright protection, he must affirmatively opt-out of the default maximum copyright protection. An author may either disclaim copyright in his work or choose to reserve only limited rights via such licenses such as those provided by Creative Commons.⁴⁷ Only a small percentage of authors disclaim copyright or limit their copyright interest in their works, however, resulting in a vast majority of material that is automatically covered for the maximum term of copyright.

The plaintiffs in *Kable* limited their challenge to the elimination of renewal requirements for works created between 1964 and 1977.⁴⁸ They did not challenge the elimination of the renewal requirement or of other formalities generally. The Ninth Circuit fixed on this fact, and instead of delving into whether the elimination of the renewal requirement changed the traditional contours of copyright law, the Court treated the question as whether Congress could place existing copyrighted work in parity with future works by eliminating the renewal requirement for both. The Ninth Circuit held summarily that *Eldred* disposed of this question. According to the Court, the Supreme Court had already ruled “that when Congress passed the CTEA, it ‘placed existing and future copyrights in parity. In prescribing that alignment... Congress acted within its authority and did not transgress constitutional limitations.’”⁴⁹ Thus, a broad reading of the Ninth Circuit’s reasoning in *Kable* would mean that under *Eldred* any retroactive change in copyright law is constitutional so long as the change is aimed at providing parity for existing and future works.

Golan v. Gonzales

The Tenth Circuit in *Golan v. Gonzales* addressed whether a different change to copyright laws altered a traditional contour of copyright, thus necessitating First Amendment review.⁵⁰ Plaintiffs in *Golan* challenged section 514 of the 1994 Uruguay Round Agreements Act (URAA), which provided copyright protection to foreign works that were still in copyright in their country of origin, but were in the public domain in the U.S. because their authors failed to comply with U.S. copyright law formalities, or because the U.S. did not recognize copyright from the author’s nation at the time the work was created.⁵¹ By agreeing to section 514, the U.S. accepted Article 18 of the Berne Convention for the Protection of Literary and Artistic Works, which the U.S. previously had refused to join for more than 100 years.⁵² The Berne Convention requires member countries to give equal copyright treatment to foreign and domestic authors. It also does away with copyright formalities

and requires that signatory countries grant copyright protection to foreign works if those foreign works still have copyright protection in their countries of origin.⁵³ Thus, when the U.S. enacted legislation to comply with section 514 of the URAA the legislation granted copyright status to certain foreign works that were previously in the public domain in the U.S. due either to copyright holders’ failure to comply with U.S. copyright formalities or failure to renew their copyrights.⁵⁴

Plaintiffs in *Golan* each relied on artistic works in the public domain for their livelihood. They included orchestra conductors, educators, performers, publishers, archivists, and others who made use of works in the public domain. Many of the plaintiffs made use of works in the public domain because they could not afford to pay copyright licenses for uses that were often local or non-profit. Others had created derivative works based on foreign works in the public domain. The plaintiffs claimed that the URAA unconstitutionally interfered with their protected First Amendment interests in making use of public domain works.⁵⁵

The district court disagreed, and held both that “Congress has historically demonstrated little compunction about removing copyrightable materials from the public domain” and that the plaintiffs had no First Amendment interests in the now-copyrighted foreign works.⁵⁶ The plaintiffs appealed to the Tenth Circuit, which took a different view.

The plaintiffs made three arguments in the Tenth Circuit. First, they argued that the CTEA’s twenty-year extension violated the “limited Times” provision of the Copyright Clause because the founders would have found the extended term length “effectively perpetual.”⁵⁷ Second, and similarly, the plaintiffs argued that the URAA’s extension of copyright to works in the public domain violated the same “limited Times” provision of the Copyright Clause because allowing Congress to copyright works already in the public domain could enable Congress to repeatedly and perpetually copyright works.⁵⁸ Third, plaintiffs argued that the URAA violated the plaintiffs’ First Amendment interests in making artistic use of the formerly public domain foreign works.⁵⁹

The Tenth Circuit, like the Ninth, made short work of the plaintiffs’ CTEA argument. The court agreed with the Ninth Circuit’s conclusion that *Eldred* precluded a challenge to the CTEA’s twenty-year term extension.⁶⁰ It also held that the URAA did not violate the Copyright Clause. The court rejected plaintiffs’ argument that section 514 must be held unconstitutional to prevent Congress from forever keeping materials from the public domain. The court stated that, as in *Eldred*, “a regime of perpetual copyrights is clearly not the situation before us.”⁶¹ Moreover, the court rejected any invitation to second-guess Congress’s determinations of how best to promote works of authorship under the Copyright Clause. The court stated firmly: “The clear import of *Eldred* is that Congress has expansive powers when it legislates under the Copyright Clause, and this court may not interfere so long as Congress has rationally exercised its authority.”⁶² The court believed that compliance with the Berne Convention, thereby assuring copyright protection for American works abroad, was a rational basis for enacting section 514.⁶³

But, said the Tenth Circuit, the URAA’s validity under

the Copyright Clause did not make it immune to challenges based on other provisions of the Constitution, such as the First Amendment.⁶⁴ The Tenth Circuit began by addressing the Supreme Court's statement in *Eldred* that copyright laws should get the presumption of constitutionality *vis a vis* the First Amendment so long as the laws do not "alter[] the traditional contours of copyright protection."⁶⁵ After a detailed examination of the history of copyright laws in the United States, the Tenth Circuit concluded that "the traditional contours of copyright protection include the principle that works in the public domain remain there and that § 514 [of the URAA] transgresses this critical boundary."⁶⁶

The Tenth Circuit analyzed how this alteration of the traditional contours of copyright affected the First Amendment interests of the plaintiffs. The Court found two First Amendment interests that plaintiffs had in the formerly public domain foreign works. First, the Court held that everyone has a non-exclusive right to use material in the public domain. Second, the Court held that "the First Amendment protects plaintiffs' right to unrestrained artistic use of the works at issue."⁶⁷

Thus, said the Court, "at the moment that Dmitri Shostakovich's Symphony No. 5 entered the public domain, Plaintiff John Blackburn had a right to create a derivative work for a high school band to perform at an event commemorating 9/11."⁶⁸ Once created, the First Amendment protected Blackburn's right to perform his derivative work, according to the Tenth Circuit. Section 514 of the URAA impinged on Blackburn's and the other plaintiffs' First Amendment rights because the owners of the now-copyrighted original material could now charge fees for the performance of plaintiffs' derivative works.⁶⁹ The court found the plaintiffs' First Amendment interests greater than those of the plaintiffs in *Eldred*, because plaintiffs in *Eldred* had never enjoyed unfettered access to the works in question. Here, by contrast, the works at issue belonged to all when they were in the public domain, and the plaintiffs relied on their rights to use the works in performing or planning to perform the works and in building on the works for their own artistic productions. Thus, by removing works from the public domain, the court held that section 514 of the URAA "hampers free expression and undermines the values the public domain is designed to protect."⁷⁰

The Tenth Circuit also held that "copyright's built-in free speech safeguards are not adequate to protect the First Amendment interests at stake."⁷¹ The court held that neither the idea/expression dichotomy nor the fair use defense were adequate to protect plaintiffs' First Amendment interests in making use of the formerly public domain works. While the idea/expression dichotomy protects speech interests by allowing an author to copyright only her expression of an idea, but not the idea itself, in this case plaintiffs had previously had rights to the whole of the now-copyrighted works. The idea/expression dichotomy did not serve to protect these rights. Likewise, although fair use allows the use of a portion of a work for certain purposes such as "criticism, comment, news reporting, teaching... scholarship, or research," it could not serve to protect plaintiffs' interests in using the whole of the works that had been removed from the public domain.⁷²

In addition, the court noted that unlike the CTEA, the

URAA did not supplement the traditional First Amendment safeguards of copyright law. When Congress passed the CTEA, it gave additional protections to certain users of the works whose terms were extended. The CTEA gave certain rights to libraries, archives, and similar institutions for their actions related to preservation, scholarship or research in the last twenty years of a work's copyright. The CTEA also exempted small businesses and restaurants from paying performance royalties for music played from the radio, television or the like.⁷³ Unlike the CTEA, the URAA provided no supplemental First Amendment protections, other than a one-year safe harbor for using a restored work.⁷⁴

The Tenth Circuit remanded the case to the district court for consideration of whether section 514 of the URAA is content-based or content-neutral and thus what level of First Amendment scrutiny is appropriate. If the district court finds that the URAA is content-based, then the district court is to apply strict scrutiny to determine "whether the government's interest in promulgating the legislation is truly 'compelling' and whether the government might achieve the same ends through alternative means that have less of an effect on protected expression."⁷⁵ If the district court finds that the URAA is content-neutral, then it must determine whether the restriction imposed by the URAA is "narrowly tailored to serve significant governmental interests."⁷⁶

The URAA seems content-neutral. It allows foreign works to be copyrighted based on criteria that have nothing to do with the content of the works. Thus intermediate scrutiny will apply. In determining whether the URAA is "narrowly tailored to serve significant governmental interests," the district court may look to footnote 5 of the Tenth Circuit's opinion. There, the Court notes that in complying with the Berne Convention, the copyright laws of the United Kingdom, Canada, Australia, and India give parties who incurred any expenditure or liability in making use of a formerly public domain the right to continued use of that work even after the work is covered by copyright.⁷⁷ The copyright owner can only stop the reliance party from using the work if the copyright owner pays compensation to the user of the work, in an amount determined by negotiation or arbitration.⁷⁸ If the court determines that the government interest at issue is simply complying with the Berne Convention, then allowing users of formerly public domain work greater rights to continued use, as other countries have done, might be a constitutionally required narrowing of the URAA. If, on the other hand, the court determines that the government interest behind the URAA was more than just complying with Berne, and instead reflected Congressional judgment as to either the proper incentive for authors or the bargaining position of the United States with regard to international negotiations over copyright protections for authors, then the court is much less likely to second-guess whether Congress's enactment of the URAA was sufficiently narrowly tailored.

FIRST AMENDMENT CHALLENGES TO COPYRIGHT LAWS AFTER *Kable* AND *Golan*

So where are First Amendment challenges to copyright laws left after *Kable* and *Golan*? First, the Tenth Circuit seems plainly correct in holding that the traditional contours

of copyright protection must extend farther than the idea/expression dichotomy and the fair use defense. While these traditional safeguards do much to protect First Amendment interests, one can easily imagine legislation passed under the Copyright Act that would impinge on First Amendment interests notwithstanding the idea/expression dichotomy and fair use defense. The plaintiffs in *Kable* gave one such example in their certiorari petition to the Supreme Court. Noting that, “copyright law has traditionally been viewpoint neutral,” plaintiffs set forth the following scenario: “Imagine the European Union decided to deny copyright protection to ‘hate speech,’ and Congress, in an effort to ‘harmonize’ international copyright law, did the same.”⁷⁹ The plaintiffs asked whether, in such a case, First Amendment review would be appropriate. It obviously would. Indeed, affirming that First Amendment review of copyright laws may sometimes be necessary does no more than affirm the general rule that legislation drafted under one constitutional provision must be consistent with the remainder of the Constitution.⁸⁰

Eldred should not be understood as a case defining when the Copyright Clause trumps the First Amendment, or holding that a couple of safeguards within copyright law are sufficient to protect all First Amendment interests that might arise under any conceivable copyright law. Rather, *Eldred* is better understood as setting forth a simple rule of judicial economy. *Eldred* makes two simple and straightforward assumptions. First, the copyright laws that have developed over the last 200-plus years in the United States have adequately protected speech interests, and are therefore constitutional. Second, if a copyright law conforms to these “traditional contours of copyright protection” developed over the last 200 years, a court may presume that the law adequately protects speech interests, and may forgo First Amendment review. What are the “traditional contours of copyright protection” and whether the presumption of adequate First Amendment protection can be rebutted even when a law conforms to the traditional contours was not decided in *Eldred*, and is left for future courts to decide, as needed.

An interesting question is whether *Golan* is a one-off departure from the traditional contours of copyright, the likes of which we will not see again. It is hard to imagine future copyright laws that will remove more material from the public domain. Legislation under the URAA was enacted to harmonize U.S. law with foreign copyright law. Now that the U.S. has done away with formalities and “restored” copyright to those foreign works that were formerly denied copyright due to idiosyncrasies of U.S. law, it is extremely unlikely that other public domain works will be copyrighted.

Are there other current or future copyright laws that may depart from the traditional contours of copyright protection and thus require First Amendment analysis? The elimination of copyright formalities may be a candidate for direct assault. As the Ninth Circuit acknowledged in *Kable*, formalities have long been a feature of copyright laws, and their elimination has resulted in a vastly diminished public domain. Although courts may be loath to second-guess Congress’s determinations of the appropriate incentives for authors, the changes to copyright law that have resulted in most works being in copyright for a century or more plainly has an effect on the speech that others

are allowed to make and the ways that others can communicate and discuss copyrighted expressions of ideas.

If litigants bring a First Amendment challenge to the elimination of copyright formalities (rather than just to the elimination of the renewal requirement for existing works, as plaintiffs challenged in *Kable*), any First Amendment analysis should be under intermediate scrutiny, because elimination of formalities is content-neutral. Under intermediate scrutiny, it is hard to see how litigants could force the resumption of formalities given that the government has a significant interest in complying with Berne (which demands elimination of formalities that would deprive a copyright holder of “enjoyment and exercise” of the economic rights appertaining to copyright). But some reliance rights allowing continued use of works whose copyrights were not voluntarily registered or renewed before enforcement proceedings began might be both acceptable under Berne and serve to more narrowly tailor U.S. copyright law to account for First Amendment interests in the public domain.⁸¹

At the end of the day, the courts seem to recognize that determining the contours of copyright is a job for Congress. Likewise, courts are likely to be deferential to Congress in establishing the boundary between copyright and the public domain, even when the First Amendment interests of users of copyrighted material are considered. Whatever the success of future First Amendment challenges to copyright laws that depart from the traditional contours of copyright protection, focusing attention on the fact that copyright laws can injure First Amendment interests of users of copyrighted works is salutary. Hopefully, Congress will consider the First Amendment interests of copyright users in passing future copyright laws so that courts need not attempt to navigate between the Scylla of narrowly tailoring copyright laws so as to protect speech interests and the Charybdis of second-guessing congressional decision-making about how best to promote works of authorship.

Endnotes

1 Steve Wozniak and Steve Jobs created the Apple I computer in March 1976, and founded Apple Computer, Co. on April Fools’ day. See Lev Grossman, 80 Days That Changed the World: April 1, 1976, Time.com (available at <http://www.time.com/time/80days/760401.html> (last visited April 21, 2008)). In March 1977 they created the Apple II computer, which many consider to have been the first affordable and easily-usable personal computer. See <http://web.mit.edu/invent/iow/apple.html> (last visited April 21, 2008).

2 See Christopher Sprigman, *Reform(alizing) Copyright*, 57 STAN. L. REV. 485, 491-93 (2004).

3 The Copyright Act of 1976 became Public Law number 94-553 on October 19, 1976 and went into effect on January 1, 1978. It is codified, as subsequently amended, at 17 U.S.C. §100 et seq.

4 Sprigman, *supra* note 2, at 519.

5 *Id.* at 522.

6 17 U.S.C. §§ 102, 302.

7 Berne Convention Implementation Act, Pub. L. No. 100-568, 102 Stat. 2853 (1988). The Berne Convention is available at http://www.wipo.int/treaties/en/ip/berne/trtdocs_wo001.html (last visited April 21, 2008).

8 See William M. Landes & Richard A. Posner, *Indefinitely Renewable Copyright*, 70 U. CHI. L. REV. 471, 483 (noting “Disney’s successful efforts to lobby for the Sonny Bono [Copyright Term Extension]Act”).

9 Works published prior to 1923 are in the public domain because prior to the 1976 Copyright Act, the 1909 Copyright Act provided a maximum term of 56 years (28-year original term plus 28-year renewal term). 17 U.S.C. § 24 (repealed 1976). The 1976 Act only extended copyright terms for works still in copyright. 17 U.S.C. § 304. Thus those works published before 1923 that had already entered the public domain remained there.

10 17 U.S.C. § 304.

11 RICHARD A. POSNER, *The Little Book of Plagiarism* 51-74 (2007).

12 *Id.* at 54-56.

13 515 F. Supp. 2d 1083 (N.D. Cal. 2007). I served as counsel for Professor Shloss in this case. Accordingly, I emphasize that the opinions expressed here are my own, and should not be attributed in any way to Carol Shloss or to the Stanford Law School Center for Internet and Society or Stanford Law School Cyberlaw Clinic.

14 *Id.* at 1068, 1073.

15 *Id.* at 1085-86.

16 *See supra* notes 1-3 and accompanying text.

17 U.S. Register of Copyrights, *Report on Orphan Works* (2006), available at <http://www.copyright.gov/orphan/orphan-report-full.pdf> (last visited April 21, 2008).

18 *See id.* at 32.

19 537 U.S. 186 (2003).

20 Pub. L. No. 105-298, 112 Stat. 2827 (1998).

21 17 U.S.C. § 302(a).

22 *Id.* § 302(c).

23 I do not address plaintiffs' third argument, that the CTEA violated the public trust doctrine by transferring public property (the works about to enter the public domain) into private hands without a showing of government benefit. Plaintiffs abandoned this argument by the time they filed their certiorari petition with the Supreme Court.

24 U.S. CONST. art. I, § 8, cl. 8 (stating, in relevant part, that "Congress shall have power... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.").

25 *Eldred*, 537 U.S. at 208.

26 *Id.* at 209 ("As the Court of Appeals observed, a regime of perpetual copyrights 'clearly is not the situation before us.'") (quoting *Eldred v. Reno*, 239 F.3d 372 (D.C. Cir. 2001)).

27 *Id.* at 195-96 (citing H.R.Rep. No. 94-1476, p. 135-36 (1976), U.S.Code Cong. & Admin.News 1976, p.5659 (explaining that term extension of 1976 Copyright Act was done in part to harmonize United States law with foreign copyright terms); Council Directive 93/98/EEC of 29 October 1993 Harmonizing the Term of Protection of Copyright and Certain Related Rights, 1993 Official J. Eur. Coms. (L290), p. 9 (EU Council Directive 93/98)).

28 *Id.* at 209.

29 *Id.* at 203-04.

30 *Id.* at 204.

31 *Id.* (citing *Eldred v. Reno*, 239 F.3d at 375).

32 *Id.* at 221 (citing *Harper & Row Pub., Inc. v. Nation Ent.*, 471 U.S. 539, 560 (1985); *San Francisco Arts & Athletics, Inc. v. U. S. Olympic Comm.*, 483 U.S. 522 (1987)).

33 *Id.* at 219-20.

34 *Id.* at 219.

35 *Id.* at 220 (quoting 17 U.S.C. § 107).

36 *Id.* (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994)).

37 *Id.* (citing 17 U.S.C. § 108(h)).

38 *Id.* (citing 17 U.S.C. § 110(5)(B)).

39 Like *Eldred*, both of these cases have been litigated by Larry Lessig and the Stanford Law School Center for Internet and Society.

40 487 F.3d 697 (9th Cir. 2007).

41 Pub. L. No. 102-307, 106 Stat. 264 (1992).

42 *Eldred*, 537 U.S. at 210 n. 16 (majority opinion stating "[i]t is doubtful... that those architects of our Nation, in framing the 'limited Times' prescription, thought in terms of the calculator rather than the calendar.").

43 *Kable*, 487 F.3d at 698.

44 *Id.* at 698-700. *See also* *Stewart v. Abend*, 495 U.S. 207, 217 (1990) ("Since the earliest copyright statute in this country, the copyright term of ownership has been split between an original term and a renewal term.").

45 *Id.* at 699.

46 *Id.*

47 *See* <http://creativecommons.org/license/> (last visited Apr. 21, 2008).

48 *Kable*, 487 U.S. at 699-700.

49 *Kable*, at 700 (quoting *Eldred*, 537 U.S. at 194).

50 501 F.3d 1179 (10th Cir. 2007).

51 Pub. L. No. 103-465, 108 Stat. 4809, 4976-80 (1994), codified at 17 U.S.C. §§ 104A, 109.

52 *Golan*, 501 F.3d at 1182, note 2; Berne Convention Implementation Act, Pub. L. No. 100-568, 102 Stat. 2853 (1988).

53 *Id.* at 1189; 17 U.S.C. §§ 104A, 109.

54 17 U.S.C. §§ 104A, 109.

55 *Golan*, 501 F.3d at 1182-83.

56 *Id.* at 1183 (quoting *Golan v. Gonzales*, No. Civ. 01-B-1854, 2005 WL 914754, at *14 (D. Colo. April 20, 2005)).

57 *Id.* at 1185.

58 *Id.* at 1185-86.

59 *Id.*

60 *Id.* at 1185 ("As the *Kable* court reasoned, 'the outer boundary of "limited Times" is determined by weighing the impetus provided to authors by longer terms against the benefit provided to the public by shorter terms. That weighing is left to Congress, subject to rationality review.'") (quoting *Kable*, 487 F.3d at 701).

61 *Id.* at 1186 (quoting *Eldred*, 537 U.S. at 209). The Court also noted that the D.C. Circuit had rejected an identical argument in *Luck's Music Library, Inc. v. Gonzales*, 407 F.3d 1262 (D.C. Cir. 2005) (holding § 514 of the URAA valid over the Copyright Clause). The D.C. Circuit did not address validity over the First Amendment.

62 *Id.* at 1187.

63 *Id.* ("we do not believe that the decision to comply with the Berne Convention, which secures copyright protections for American works abroad, is so irrational or so unrelated to the aims of the Copyright Clause that it exceeds the reach of congressional power") (citing *Eldred* at 208).

64 *Id.* (citing *Saenz v. Roe*, 526 U.S. 489, 508 (1999); *Buckley v. Valeo*, 424 U.S. 1, 132 (1976)).

65 *Eldred*, 537 U.S. at 221.

66 *Golan*, 501 F.3d at 1189. The D.C. Circuit in *Luck's Music Library, Inc. v. Gonzales*, 407 F.3d 1262, 1265-66 (D.C. Cir. 2005), came to the opposite conclusion—that removal of works from the public domain had been done several times in the past under federal copyright laws. But the Tenth Circuit's analysis seems better. The Tenth Circuit noted that the Government's purported examples of copyright laws that removed works from the public domain (the first Copyright Act (passed in 1790), laws allowing registration of foreign works that could not be registered during World War II, and a handful of private bills) were at best exceptions to the traditional rule in copyright that works in the public domain stay there. *Golan*, 501 F.3d at 1192.

67 *Id.* at 1193. The Court noted that "The Supreme Court has emphasized that the right to artistic expression is near the core of the First Amendment." The Tenth Circuit quoted *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989):

Music is one of the oldest forms of human expression. From Plato's discourse in the Republic to the totalitarian state in our own times, rulers have known [music's] capacity to appeal to the intellect and to the emotions, and have censored musical compositions to serve the needs of the state.... The Constitution prohibits any like attempts in our own legal order. Music, as a form of expression and communication, is protected under the First Amendment.

68 *Id.*

69 *Id.*; 17 U.S.C. § 104A(d)(3) (allowing creator of derivative work created while foreign work was in public domain to continue using work if reasonable compensation is paid to copyright owner, which compensation is determined via normal infringement damages analysis). If the creator of the derivative work cannot pay the fee to the copyright owner, not only would they not be able to use their derivative work, but if the holding of cases such as *Anderson v. Stallone* is followed, the owner of the copyright in the original work could both use the derivative work at will, and is the only party who could license others to use the derivative work. See *Anderson v. Stallone*, No. 87-0592 WDKGX, 1989 WL 206431 (C.D. Cal. April 25, 1989) (giving copyright owner exclusive rights to derivative work created without authorization).

70 *Id.* at 1193-94 (citing *Meade v. U.S.*, 27 Fed. Cl. 367, 372 (Fed. Cl. 1992)).

71 *Id.* at 1196.

72 *Id.* at 1195-96 (quoting 17 U.S.C. § 107).

73 *Id.* (citing *Eldred*, at 220 (quoting 17 U.S.C. § 108(h))).

74 *Id.* at 1196 (citing 17 U.S.C. § 104A(d)(2)).

75 *Golan*, 501 F.3d at 1196 (citing *U.S. v. Playboy Entm't Group, Inc.*, 529 U.S. 803, 813 (2000)).

76 *Id.* (quoting *Rock Against Racism*, 491 U.S. at 791)).

77 *Id.* at note 5.

78 *Id.* at 1197 (citing Irwin Karp, *Final Report, Berne Article 18 Stud on Retroactive United States Copyright Protection for Berne and Other Works*, 20 COLUM.-VLA J.L. & ARTS 157, 178 (Winter 1996) (quoting "The Copyright (Application to Other Countries) Order in Council 998"; June 13, 1989 Article 7(2), reprinted in *COPYRIGHT LAWS AND TREATIES OF THE WORLD*, UK: ITEM 7C, AT 2 (UNESCO SUPP. 1989-90))).

79 *Kahle v. Gonzales Petition for Writ of Certiorari*, 2007 WL 2323450 (2007) at *15.

80 See *Saenz v. Roe*, 526 U.S. 489, 508 (1999) ("Article I of the Constitution grants Congress broad power to legislate in certain areas. Those legislative powers are, however, limited not only by the scope of the Framers' affirmative delegation, but also by the principle that they may not be exercised in a way that violates other specific provisions of the Constitution.") (internal quotation marks omitted).

81 Christopher Sprigman makes a similar, and much more fleshed-out argument as to how "new-style formalities" can be adopted in the United States and still comply with the Berne Convention. Christopher Sprigman, *Reform(Aliz)Ing Copyright*, 57 STAN. L. REV. 485, 555 (2004) (arguing for "new-style formalities" that "preserve formally voluntary registration, notice, and recordation of transfers (and reestablish a formally voluntary renewal formality) for all works... but then incent compliance by exposing the works of noncompliant rightsholders to a 'default' license that allows use for a predetermined fee.").

