

THE PUBLIC DOMAIN REVISITED

*Edward Samuels**

I. THE EMERGENCE OF A THEORY OF THE PUBLIC DOMAIN

A. The Public Domain, Circa 1993

In a 1993 article published in the *Journal of the Copyright Society*, I posed the following questions:

Is the public domain simply whatever is left over after various tests of legal protection have been applied? Is it the mere “background,” the “negative” of whatever may be protected? Or is there something about the public domain, some compelling public policy or legal principle, that gives it a life of its own, that would tend to attribute positive aspects to it, that would make it something of the form instead of just the background?¹

I answered the questions as follows:

After reviewing the various proposed arguments supporting a general theory of the public domain . . . it would appear that there simply is no such general theory. Instead, there are several discrete contexts in which arguments about the public domain are encountered, each context raising different considerations that may have little or nothing to do with each other, and that cumulatively constitute what remains after one examines all possible sources of legal protection for works of authorship. What is gained by reifying the negative, and imagining a “theory” of the public domain? If one wants to encourage a presumption against new forms or areas of protection, then one can do so

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1. Edward Samuels, *The Public Domain in Copyright Law*, 41 J. COPYRIGHT SOC’Y 137, 137 [hereinafter Samuels, *The Public Domain*].

without having to invoke a magical “public domain.” There are dozens of battlegrounds between those who want to expand intellectual property protection and those who want to limit it or narrow it in any given context. The arguments in each context should be kept separate, since they raise different policy issues.

Nevertheless, the individual issues sometimes tend to be elusive, and one’s attitude toward them tends to be flavored as often as not by one’s general attitude toward copyright law. If those who find themselves continually on the side arguing for a limitation of protection need a rallying cry, perhaps it can be “the public domain.” The invocation may seem to add a moral overtone to the argument, to counter-balance the morally charged principles invoked time and again by the protectionists. In the final analysis, however, [paraphrasing Ralph Brown] “such vague rhetoric does little more than adorn the stage on which actual choices must be played out.”²

Professor James Boyle has responded to the questions I asked in my earlier article, as follows:

What is gained by reifying the negative? Professor Samuels’ question is a good one. He supplies part of the answer with his thought that perhaps the language of the public domain will be used to counter the language of sacred property. This is indeed an important point; *language matters*, and not just as “rhetoric.”

...

Of equal importance is the power of a concept like the environment both to clarify and to reshape perceptions of self interest.³

Professor Boyle goes on to compare the development of the “public domain” movement to the development of the environmental law movement.⁴

2. *Id.* at 150.

3. James Boyle, The Second Enclosure Movement and the Construction of the Public Domain, *in* CONFERENCE ON THE PUBLIC DOMAIN, Nov. 9-11, 2001, DUKE LAW SCHOOL, at 39-41, at <http://www.law.duke.edu/pd/papers/boyle.pdf>.

4. *See id.* at 42-43.

Notwithstanding the power of the word, or the phrase, that Professor Boyle describes, I believe that what I said in 1993 is essentially still correct. The major difference is that the literature invoking, creating, celebrating, or applying the public domain ideology has expanded tremendously in the intervening years. Not since economic theory invaded copyright (and just about every other area of law) have we seen such a joining of voices to create a new body of scholarship, building one article and book upon another—without having much actual influence, however, upon the development of the law as created by legislators and judges. That last point may be about to change. In their attack upon the Copyright Term Extension Act of 1998,⁵ the petitioners in *Eldred v. Ashcroft*⁶ hope to bring the public domain rhetoric and theory to the fore, and make it, from now on, a dominant force in Congress's deliberations and judges' reviews of copyright generally.

In my article, I identified six different categories of the public domain.⁷ In each category, the trend over the past 200 years has been an expansion of copyright, and a concomitant diminution of what might be considered the public domain. In the first category, the duration of copyright has been extended from a maximum of twenty-eight years to, under the Copyright Term Extension Act of 1998, life of the author plus seventy years.⁸ The second category, public domain through forfeiture of copyright, has been all but eliminated by the abandonment of copyright formalities under the Berne Implementation Act of 1988.⁹ The third category, works categorically excluded from copyright, has also been diminishing over the years as the scope of copyright has expanded to cover a widening category of works. I argued that the other three categories, although aligned by some writers with public domain theory, should particularly be decided on other grounds: public domain aspects of otherwise copyrightable works, public domain as a substitute for preemption analysis, and public domain as a substitute for measuring the

5. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified as amended at 17 U.S.C. §§ 108, 203(a)(2), 301(c), 302, 303, 304 (2000)).

6. *Eldred v. Ashcroft*, No. 01-618 (U.S. oral argument Oct. 9, 2002).

7. See Samuels, *The Public Domain*, *supra* note 1, at 151-77.

8. See § 102, 112 Stat. at 2827.

9. See Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (amending scattered sections of 17 U.S.C. (1988)).

retroactivity of copyright enactments.¹⁰ In all six areas, the public domain advocates were making arguments against the tide; they lamented the expansions of copyright, but could hardly claim that the public domain analysis had in fact already worked its way into dominant copyright theory.

B. The Technological Battleground—Everybody's Losing!

In the intervening years, the public domain agenda seems to have been spurred primarily by technological concerns. What is fascinating to me is that, in the technological realm, everybody thinks that they have lost the copyright battle. The copyright owners look on as others digitize and disseminate their works on the Internet. In the words of Apple's advertisements for its new iMac, the mantra is "Rip. Mix. Burn."¹¹ This sounds awfully like "Copy. Make a derivative work. Distribute." which are supposed to be the exclusive rights of copyright under section 106.¹² The copyright owners are horrified at the "hemorrhaging" of their control over their works.

Some of the early technological pronouncements had a decidedly flippant tone, as if no one but the digerati could possibly understand what was going on. As declared in *Wired Magazine* in March 1994, and repeated by such advocates as Mitch Kapor and John Perry Barlow in presentations across the country:

Notions of property, value, ownership, and the nature of wealth itself are changing more fundamentally than at any time since the Sumerians first poked cuneiform into wet clay and called it stored grain. Only a very few people are aware of the enormity of this shift, and fewer of them are lawyers or public officials.¹³

This was the same time as Internet gurus were proclaiming that the Internet world was not subject to other basic concepts, like principles of investment, accounting or gravity.

10. See Samuels, *The Public Domain*, *supra* note 1, at 164-77.

11. See Apple website, at www.apple.com/uk/hardware/ads/ripmixburn.html (last visited Aug. 18, 2002).

12. See 17 U.S.C. § 106 (2000).

13. John Perry Barlow, *The Economy of Ideas: A Framework for Rethinking Patents and Copyrights in the Digital Age (Everything You Know About Intellectual Property is Wrong)*, WIRED, Mar. 1994, at 85, 86.

However, the established interests did in fact “get it.” Various copyright industries were successful in convincing Congress to pass copyright laws directed at the new digitization of copyrighted works. The Record Rental Amendment of 1984 created an exception to the first sale doctrine in the case of rented audio works, largely because the emergence of DVDs made the copying of rented music much more of a threat to the existing markets for distribution of music.¹⁴ The Computer Rental Software Amendment of 1990 created a similar exception for the rental of computer software.¹⁵ Congress passed the Audio Home Recording Act of 1992 to handle the modern consequences of home recording using the new digital recording devices.¹⁶ Congress passed the Digital Performance Right in Sound Recordings Act of 1995 to handle the distribution of music over the Internet and other digital distribution systems.¹⁷ And then, in 1998, Congress adopted the Digital Millennium Copyright Act to allow copyright owners to better enforce their rights through technological protection measures and copyright management information systems.¹⁸

The landscape has so changed that the public domain advocates are beginning to announce that *they*, not the copyright industries, are losing the copyright battle. The primary spokesperson, Lawrence Lessig, in his most recent manifesto, portrays a grim future—actually present—in which the digital technologies are not a liberating force for the masses, but rather a tool of the copyright industries in absolutely controlling access to cultural works.¹⁹ It all comes as

14. See Record Rental Amendment of 1984, Pub. L. No. 98-450, 98 Stat. 1727 (codified as amended at 17 U.S.C. §§ 109, 115(c) (1984)).

15. See Computer Software Rental Amendments Act of 1990, Pub. L. No. 101-650, 104 Stat. 5134 (codified as amended at 17 U.S.C. § 109(b) and adding § 109(e) (1991)).

16. See Audio Home Recording Act of 1992, Pub. L. No. 102-563, 106 Stat. 4237 (codified at 17 U.S.C., ch. 10 (1992)).

17. See Digital Performance Right in Sound Recordings Act of 1995, Pub. L. No. 104-39, 109 Stat. 336 (codified as amended in scattered sections of 17 U.S.C. (1996)).

18. See Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended at 17 U.S.C. §§ 101, 104 and adding 17 U.S.C., ch. 12 (1998)).

19. See LAWRENCE LESSIG, *THE FUTURE OF IDEAS: THE FATE OF THE COMMONS IN A CONNECTED WORLD* 180-217 (2001). I have just finished reading the science fiction works, *Hyperion* and *The Fall of Hyperion*, by Dan Simmons. Those works are somewhat more apocalyptic in their portrayal of

something of a surprise to the copyright industries that they have won the war.

Given the recent technological battleground, it is interesting, and perhaps surprising, that the major case to present the public domain agenda before the Supreme Court should have nothing to do with technology. Instead, it ostensibly focuses upon just about the oldest question that has been at the heart of the copyright debate from the beginning—how long should the term of copyright be? As this Article will discuss later, there is probably a tendency to try to view the public domain agenda broadly, and decide even the age-old questions in light of the new issues raised by technology. As this Article suggests, it is better for everyone if we focus upon the issues one at a time, and if we do not allow the broader agenda to cloud decisions that must be made in the discrete contexts.

C. The Relationship Between Public Domain Analysis and Other Bases of Copyright

In my 1993 article, I briefly explored the relationship between the discussions of the public domain and basic theories about the role and basis for copyright, as follows:

The writings about the importance of the public domain seem to some extent to parallel other arguments that have been around since copyright was first recognized in English and American law; namely, arguments about the theoretical source or justification for copyright generally. Many protectionists have tried to justify copyright law as based upon (1) natural rights (2) moral rights or (3) property rights. Critics have tried to limit this approach by (1) gleefully citing the embarrassing early history of copyright law in England . . . ; (2) emphasizing the “social utility” theory of copyright, by which the only or main justification for allowing what is basically a “monopoly” is the ultimate good that is achieved for society by an increase in the number, maybe even the quality, of works destined for the public domain; and (3) in recent years, subjecting copyright protection to a

the battle among the forces of the “Hegemony,” the “Technocore,” and the mysterious “Ousters.” See DAN SIMMONS, *THE FALL OF HYPERION* (reissue 1995); DAN SIMMONS, *HYPERION* (1989). But Lessig’s book certainly taps into a popular fear/fantasy of the tech-savvy citizens of the Internet.

strict economic analysis that would limit any benefit to the copyright owner that was not clearly justified by a concomitant increase in the public good (read “public domain”). These arguments might be bolstered by (4) an explicit or implicit reference to principles, even constitutional standards, from outside the copyright clause, particularly the first amendment’s guarantee of free speech.²⁰

The arguments about the public domain and the theoretical underpinnings of copyright have taken on almost a religious fervor in recent years. Otherwise reasonable people arguing different sides of the issue tend to become as emotionally overwrought as any abortion rights (or anti-abortion rights) advocate. In several recent conferences and private discussions about copyright theory, about all one has to do is mention the words “natural rights” or “property rights,” and public domain advocates are practically jumping from their seats to “set the record straight.” They argue passionately that property rights talk is a development of the latter part of the twentieth century, and that copyright was not brought under the rubric of “intellectual property” until the last fifty years when the giant corporations somehow manipulated the world into thinking that their exclusive rights of patent, copyright, trademark and other rights were entitled to be protected as “property.”²¹

But the natural rights and property rights rhetoric is firmly rooted in copyright history. It is recognized as the basis for copyright protection in civil law and other countries outside of England and the United States.²² Although it is commonly argued that the English and United States origins were based upon non-property,

20. Samuels, *The Public Domain*, *supra* note 1, at 177-80.

21. Black’s Law Dictionary defines property as “that which belongs exclusively to one”; copyright is defined as a set of “exclusive rights” in 17 U.S.C. §§ 106 and 106A. BLACK’S LAW DICTIONARY 1216 (abr. 6th ed. 1991); Exclusive Rights in Copyrighted Works, 17 U.S.C. §§ 106-106A (2000). When it serves their interests, petitioners in the *Eldred* case are not averse to using a property law analogy: “Copyright law had, in effect, vested in these petitioners, as well as in the public, a remainderman interest in the works at stake.” Brief for Petitioners at 6, *Eldred v. Ashcroft*, No. 01-618 [hereinafter Petitioners Brief]. Of course, a remainderman is only “[o]ne who is entitled to the remainder of the estate after a particular estate carved out of it has expired.” BLACK’S LAW DICTIONARY 1293 (abr. 6th ed. 1991).

22. See PAUL GOLDSTEIN, *COPYRIGHT’S HIGHWAY: FROM GUTENBERG TO THE CELESTIAL JUKEBOX* 165-96 (2d ed. 1995).

non-natural rights principles, the preambles to several of the state copyright statutes under the Articles of Confederation incorporated property and natural rights rhetoric with the “social utility” theory. For example, the Connecticut statute of 1783, which served as the model for the Georgia and New York statutes, began:

Whereas it is perfectly agreeable to the principles of natural equity and justice, that every author should be secured in receiving the profits that may arise from the sale of his works, and such security may encourage men of learning and genius to publish their writings; which may do honor to their country, and service to mankind.²³

The Massachusetts statute of 1783, which served as a model for the New Hampshire and Rhode Island statutes, provided:

Whereas the improvement of knowledge, the progress of civilization, the public weal of the community, and the advancement of human happiness, greatly depend on the efforts of learned and ingenious persons in the various arts and sciences: As the principal encouragement such persons can have to make great and beneficial exertions of this nature, must exist in the legal security of the fruits of their study and industry to themselves; and as such security is one of the natural rights of all men, there being no property more peculiarly a man’s own than that which is produced by the labour of his mind.²⁴

The North Carolina statute of 1785 provided:

Whereas nothing is more strictly a man’s own than the fruit of his study, and it is proper that men should be encouraged to pursue useful knowledge by the hope of reward; and as the security of literary property must greatly tend to encourage genius, to promote useful discoveries, and to the general extension of arts and commerce²⁵

In addition, many scholars and observers over the years have found natural and property rights bases in United States copyright

23. THORVALD SOLBERG, LIBRARY OF CONGRESS, COPYRIGHT ENACTMENTS: LAWS PASSED IN THE UNITED STATES SINCE 1783 RELATING TO COPYRIGHT 1 (rev. bulletin no. 3, 1973) [hereinafter COPYRIGHT ENACTMENTS].

24. *Id.* at 4.

25. *Id.* at 15.

legislation. For example, the Report of the Register of Copyrights, in the early stages of copyright revision, identified strands of property right and personal right, as well as monopoly limitation theories.²⁶

Many of the expansions and other developments of copyright simply cannot be explained by a strict public domain theory of copyright. As concluded by Paul Goldstein, “[t]he 1976 Copyright Act’s special treatment of involuntary transfers of copyright, for example, and its provisions for termination of transfers can be better explained in terms of natural rights theory than in terms of a utilitarian balance of social benefit.”²⁷ Contrary to the suggestions of some public domain advocates, Goldstein observes: “As a general rule, copyright law in the United States entitles copyright owners to capture the full value that consumers attach to their works and not just the minimum sum that they would require to support their investment.”²⁸

Here is my conclusion as expressed in the 1993 article:

American copyright law has suffered for two hundred years from the absence of a clearly articulated theoretical basis. Some might see this as some sort of oversight or conspiracy. I don’t think so. I think that Congress and the courts have thereby maintained flexibility in the development of the law.

. . . [T]he different theories represent different ways of looking at copyright law that can be used to explain different aspects of it, but none of which is adequate to explain the whole, and none of which trumps the others.²⁹

I even suggested that, based upon the clear expansions of copyright over the years, and the “convergence” of copyright principles through the adoption of international standards, “[i]t should therefore

26. See STAFF OF HOUSE COMM. ON THE JUDICIARY, 87TH CONG., COPYRIGHT LAW REVISION: REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 3-6 (1961); see also Wendy J. Gordon, *A Property Right in Self-Expression: Equity and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533 (1993). While Professor Gordon analyzes copyright under a Lockean property model, she finds in that model not only principles of protection but also principles of limitation. See *id.* at 1549-51.

27. 1 PAUL GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE 9 (1989).

28. *Id.* at 7.

29. Samuels, *The Public Domain*, *supra* note 1, at 180-81.

now be possible to ascribe to American copyright law the broad theoretical basis that until recent years may have been premature.”³⁰

In any event, because there is no consensus that any one copyright principle trumps any other, and because the whole of copyright is ultimately based upon a balancing of interests, the principles simply do not help in resolving discrete copyright issues. If it were within my power, I would call a truce. I would not invoke natural rights and property rights justifications for copyright if public domain advocates would concede that there is no public domain theory that trumps other rights. We could then proceed to deal with the copyright issues as they arise.

D. “Retroactivity”

In my earlier article, I argued that the public domain rhetoric was sometimes used, inappropriately, as a substitute for measuring the retroactivity of a copyright statute. After analyzing the issue, I concluded as follows:

[I]t simply is not clear whether Congress is prohibited from reviving works that previously entered the public domain, and there are at least some convincing suggestions that it has power to revive works not previously protected. In any event, issues of retroactivity should not be determined by an ill-defined concept of the “public domain,” but can be analyzed by reference to a richer literature dealing with retroactivity of legislation.³¹

Part of that “richer literature” suggests that: “Even for statutes that affect criminal behavior or contract rights, most securely protected against retroactive legislation by the due process, ex post facto, and impairment of contracts clauses of the Constitution, it is hard to make absolute statements.”³²

As stated by one expert in statutory construction:

It is misleading to use the terms “retrospective” and “retroactive,” as has sometimes been done, to mean that the act is unconstitutional. The question of validity rests on further subtle judgments concerning the fairness of applying the

30. *Id.* at 181-82.

31. *Id.* at 175.

32. *Id.* at 175-76.

new statute. Even where a constitution explicitly and unqualifiedly prohibits the enactment of retrospective statutes, the courts usually strike down only those statutes whose retroactivity results in measurable unfairness.³³

Since I made my observations, Congress has indeed found a context in which it has restored copyrights in certain works. Congress passed a new section 104A, which provided for the restoration of foreign copyrights that had gone into the public domain, primarily through noncompliance with U.S. copyright formalities.³⁴ That amendment was passed pursuant to international obligations—first, in 1993, in the North American Free Trade Agreement,³⁵ and then, in 1994, broadened as a result of the World Trade Organization agreement.³⁶ Public domain advocates have brought a court challenge to that Act in the case of *Golan v. Ashcroft*.³⁷

Section 104A was designed partly to be fair to foreign authors whose works went into the public domain in this country through a failure to comply with formalities that no other country required.³⁸ It was also motivated by a desire to allow U.S. copyright owners to get their works “restored” in other countries that for one reason or another had not granted copyright protection.³⁹

It is not my purpose to defend the *Golan* case or section 104A here. The *Eldred* case, that is the subject of the rest of this Article, does not actually involve the retroactive application of copyright law, since the Copyright Term Extension Act of 1998 that is challenged in

33. 2 NORMAN J. SINGER, SUTHERLAND STAT. CONST. § 41.05, at 368 (5th ed. 1992).

34. While the primary import of section 104A is to cover works that went into the public domain due to “noncompliance with formalities imposed at any time by United States copyright law, including failure of renewal, lack of proper notice, or failure to comply with any manufacturing requirements,” the act also applies to foreign sound recordings published before the effective date of U.S. protection. 17 U.S.C. § 104A(h)(6) (2000).

35. North American Free Trade Agreement, Dec. 17, 1992, 32 I.L.M. 289.

36. See General Agreement on Tariffs and Trade: Multilateral Trade Negotiations Final Act Embodying the Results of the Uruguay Round of Trade Negotiations, Dec. 30, 1994, 33 I.L.M. 1125, 1867 U.N.T.S. 154.

37. No. 01-B-1854 (D. Colo. filed Sept. 19, 2001).

38. See 17 U.S.C. § 104A.

39. For example, some countries did not grant rights in sound recordings or computer programs until relatively late in the twentieth century, and sound recordings and computer programs represented substantial U.S. exports.

that case does not apply to any works that have already fallen into the public domain. And, as I urge here, we should not be arguing the *Eldred* case by jockeying for position in other contexts. But I do believe that my cautious approach, not necessarily setting off the constitutional alarm every time a magic word, like retroactive,⁴⁰ is used, is as important today as it was when I made the suggestion a decade ago. Let us save the arguments about *Golan* for another day.

II. ELDRED V. RENO/ASHCROFT

A. *The Undesirable Extremes*

1. The D.C. Circuit opinion

In 1998, Congress passed the Copyright Term Extension Act (CTEA).⁴¹ That Act extended the term of protection for all works created after January 1, 1978 (the effective date of the Copyright Act of 1976) by twenty years, from life of the author plus fifty years to life of the author plus seventy years.⁴² It extended the term of works created prior to 1978 from seventy-five years from publication to ninety-five years from publication.⁴³ Eric Eldred and various other plaintiffs, represented by Lawrence Lessig, brought a constitutional challenge to the CTEA, suing Janet Reno, as Attorney General, in the District Court of the District of Columbia.⁴⁴ That court upheld the constitutionality of the CTEA.⁴⁵ In 2001, the District of Columbia

40. Retroactive is probably the wrong word to use here. Even section 104A does not apply to activities that took place before it was passed. It restores copyrights, but only applies to activities that take place after its enactment. Indeed, it contains an elaborate mechanism for protecting "reliance parties" who may have invested in what they thought were public domain works. These mechanisms involve notice of intent to restore copyright, and even a compulsory license at a reasonable compensation for creators of derivative works based upon works that were, at the time, in the public domain. See 17 U.S.C. § 104A(d)(3).

41. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified as amended at 17 U.S.C. §§ 108, 203(a)(2), 301(c), 302, 303, 304 (2000)).

42. See *id.* § 102(b), 112 Stat. at 2827 (amending 17 U.S.C. § 302(a)).

43. See *id.* § 102(d), 112 Stat. at 2827-28 (amending 17 U.S.C. § 304(a)(1)).

44. See *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999).

45. See *id.* at 3.

Circuit Court of Appeals affirmed the lower court, with a dissent by Judge Sentelle.⁴⁶ The Circuit Court denied a petition for rehearing and for rehearing en banc.⁴⁷ The Supreme Court granted a writ of certiorari in February 2002.⁴⁸

The approach of the D.C. Circuit Court was to cut off discussion of the constitutional issues by the adoption of what appeared to be an absolute rule that copyright laws were immune from constitutional attack.⁴⁹ The court concluded that the preamble to the Constitution's Copyright Clause (granting Congress the power "[t]o promote the Progress of Science and useful Arts" by securing exclusive rights "for limited Times"⁵⁰) "is not a substantive limit on Congress' legislative power."⁵¹ The court went on to conclude that "copyrights are categorically immune from challenges under the First Amendment" because of the idea/expression dichotomy, the fair use doctrine, and other limiting principles that already factor in the constitutional considerations.⁵²

The concern of public domain scholars is not only with copyright term extension, but also with other recent expansions of copyright. For example, as discussed above, the public domain advocates have brought a lawsuit challenging the restoration of copyright under section 104A of the Copyright Act.⁵³ But the 800-pound gorilla looming on the horizon is the Digital Millennium Copyright Act of 1998 (the DMCA).⁵⁴ That Act provides for the legal protection of technological protection systems and copyright management information systems.⁵⁵ In *Universal City Studios, Inc. v. Reimerdes*,⁵⁶ the District Court for the Southern District of New York, and then, under

46. See *Eldred v. Reno*, 239 F.3d 372 (D.C. Cir. 2001).

47. See *Eldred v. Reno*, 239 F.3d 372 (D.C. Cir. 2001), *reh'g denied*, 255 F.3d 849 (2001).

48. See *Eldred v. Ashcroft*, 122 S. Ct. 1062 (Feb. 19, 2002) (No. 01-618).

49. See *Eldred*, 74 F. Supp. 2d at 3.

50. U.S. CONST. art. I, § 8, cl. 8.

51. *Eldred*, 239 F.3d at 378.

52. *Id.* at 375-76.

53. See *Golan v. Ashcroft*, No. 01-B-1854 (D. Colo. filed Sept. 19, 2001).

54. Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended at §§ 101, 104 and adding 17 U.S.C., ch. 12 (1998)).

55. See *id.*

56. 82 F. Supp. 2d 211 (S.D.N.Y. 2000).

the name *Universal City Studios, Inc. v. Corley*,⁵⁷ the Second Circuit Court of Appeals upheld the statute against constitutional challenge.⁵⁸ Despite the ruling of the Second Circuit Court of Appeals, some scholars still maintain that the statute is constitutionally defective because, as the courts have interpreted it, the Act does not apply the idea/expression dichotomy, the fair use doctrine, or other limitations of copyright to the DMCA protections. Constitutional issues might also be relevant to other acts that Congress may consider, such as in the area of database protection.

The public domain scholars are thus particularly alarmed at the categorical exclusion test adopted by the D.C. Circuit Court in *Eldred*.⁵⁹ Quite frankly, the pro-copyright industries should also have been alarmed, since the broadness of the ruling may have been what piqued the interest of the Supreme Court in granting certiorari. The petitioners were able to frame the issue as whether the D.C. Circuit erred in holding that copyrights are “categorically immune from challenge[s] under the First Amendment.”⁶⁰ The respondent now has to make the tactical decision: to what extent should he box himself into the corner of defending the categorical test announced by the Circuit Court; or, at least for the sake of argument, concede a potential First Amendment claim, and jump right into the merits of the case? Presumably, respondent will address the First Amendment arguments on the merits.

I am sure that, had the D.C. Circuit Court’s analysis been the final statement on the matter, future courts, when faced with challenges to other Congressional actions, would have been able to limit the *Eldred* holding to the facts of the case. No matter what the court said about categorical exclusions, different situations raise different concerns, and those concerns should be separately addressed in the context of each case. Since the case will now be decided by the Supreme Court, that Court should weigh the copyright and First Amendment policies in more detail, instead of relying upon a categorical approach.

57. 273 F.3d 429 (2d Cir. 2001).

58. *See id.* at 459-60; *Reimerdes*, 82 F. Supp. 2d at 226-27.

59. *See, e.g.*, Petitioners Brief, *supra* note 21, at 34-37.

60. *Id.* at 34.

2. Petitioners' novel theory

Petitioners' argument is based upon the premise that the CTEA violates the "limited Times" provision of the Copyright Clause.⁶¹ Presumably recognizing that the life of the author plus seventy years, or ninety-five years, is obviously a "limited time," they seek to link the limited times provision to a novel interpretation of the Copyright Clause. They essentially argue that the phrase "to promote the Progress of Science and useful Arts" is synonymous with an increase in the public domain.⁶² They argue that Congress may not decrease the public domain (an issue not before the Court in the *Eldred* case, since the CTEA did not remove a single work from the public domain).⁶³ Extending their novel theory, they argue that once Congress, pursuant to its constitutional power, has set a term of copyright, it is prohibited from extending that term, even if the term has not yet expired.⁶⁴

The gist of petitioners' reasoning is that Congress may only grant rights when to do so will result in the creation of new works. Once a work has been created, under whatever inducement existed at the time of its creation, Congress may not grant any further rights to the copyright owners, since to do so would be to grant rights without the "quid pro quo" called for under the Constitution—the creation of new works.⁶⁵

If the D.C. Circuit opinion was objectionable because it was overly broad, the petitioners' theory is even more objectionable. If the Court were to adopt the petitioners' reasoning, not only would it

61. *See id.* at 10-11.

62. *See id.* at 10.

63. *See id.*

64. Although several amici take a different position, petitioners concede in their brief that Congress is the proper body to determine the duration of copyright: "Whether 50 years is enough, or 70 years too much, is not a judgment meet [sic] for this Court." *Id.* at 14. Petitioners' entire constitutional attack is directed at the application of the CTEA to existing works; their only argument against the application of the CTEA to works created after its effective date is that the different applications of the statute are inseverable. *See id.* at 47-48.

I find the concession remarkable. It also reintroduces the very same issue that was decided by the D.C. Circuit, but that the Supreme Court specifically declined to hear: the extent to which courts may consider arguments raised by amici that are not raised, or are conceded, by the parties to the action. *See Eldred v. Reno*, 239 F.3d. 372 (D.C. Cir. 2001).

65. *See* Petitioners Brief, *supra* note 21, at 10.

decide the instant case, but it would have implications in dozens of other settings. I will respond to the petitioners' argument in the next section. But let us take a look now at the "parade of horrors" (or, from petitioners' view, perhaps a "parade of desirables") that might flow from an adoption of their novel theory.

If the 1998 term extension is unconstitutional, then presumably the 1994 addition of section 104A, restoring copyright in foreign works that had already gone into the public domain, would also be unconstitutional. If that is the case, then the United States would be in violation of our treaty obligations under NAFTA and WTO, and there would be serious international repercussions.

If Congress may not extend the term of existing copyrights, as petitioners argue, then the 1976 extension of copyright to life of the author plus fifty years was also unconstitutional. If the 1976 extension is unconstitutional, then we are in violation of the Berne Treaty,⁶⁶ with serious international repercussions.

Works used to go into the public domain whenever they failed to comply with the copyright formalities of notice, registration, and renewal. Does that mean that it was unconstitutional in 1988 to dispense with copyright formalities?⁶⁷ Was it unconstitutional to "rescue" works from going into the public domain when Congress, in 1992, provided for automatic renewal of works published after 1964?⁶⁸ Was it unconstitutional for Congress to expand the scope of rights in copyrighted works, as it has done many times in the 212-year history of copyright? Was it unconstitutional when Congress passed the DMCA, granting new rights in technological protection systems and copyright management systems, even for works that already existed?

Petitioners might be delighted at any of the above suggestions. But the promotion of science and useful arts is allied with, not opposed to, the interests of copyright owners. As stated by James Madison in *The Federalist No. 43*, "the public good fully

66. Berne Convention for the Protection of Literary and Artistic Works, July 24, 1971, S. TREATY DOC. NO. 99-27, at 40 (1986), 828 U.N.T.S. 221, 233 [hereinafter Berne Convention].

67. See Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (amending scattered sections of 17 U.S.C. (1988)).

68. See Copyright Renewal Act of 1992, Pub. L. No. 102-307, 106 Stat. 264 (amending 17 U.S.C. § 304(a) (1992)).

coincides . . . with the claims of individuals.”⁶⁹ As explained by Justice O’Connor in the *Harper & Row* case, “it should not be forgotten that the Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one’s expression, copyright supplies the economic incentive to create and disseminate ideas.”⁷⁰ Would it therefore be unconstitutional for Congress to *decrease* the rights of copyright, affecting the rights in existing works, as it did, for example, in the so-called “Fairness in Music Licensing Act” of 1998?⁷¹

The problem with petitioners’ argument is that it would not only decide the instant case, but it would also frame the issue in practically every other area of copyright. Petitioners argue that the categorical approach of the D.C. Circuit is unacceptable because the court identified no “stopping point” by which to measure what was constitutional.⁷² The petitioners’ own argument is unacceptable because it, too, has no stopping point. It would bar Congress from making *any* adjustments in the terms of existing copyrights.

The Supreme Court should therefore not endorse either the categorical approach of the D.C. Circuit, nor the novel theory of the petitioners. If it affirms the D.C. Circuit, as I believe it should, then it should make clear that the decision is based upon a full consideration of the First Amendment standards, and that courts are not foreclosed in other contexts from considering limitations that may be raised by the preamble to the Copyright Clause and by the First Amendment. If it should choose to reverse the D.C. Circuit, and either remand the case or make a finding on the merits, then it should make clear that it is deciding only the issue of Congress’s power to set the duration of copyright. It should not adopt any particular “theory” of copyright that will have an impact on cases beyond the one argued before it.

69. THE FEDERALIST NO. 43, at 279 (James Madison) (Modern Library ed., 1937).

70. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985).

71. Fairness in Music Licensing Act of 1998, Pub. L. No. 105-298, 112 Stat. 2830 (codified as amended in scattered sections of 17 U.S.C. (1999)).

72. See Petitioners Brief, *supra* note 21, at 13.

B. The History of the Constitutional Phrase “to promote the Progress of Science and useful Arts”

As stated in the previous section, the petitioners’ argument rests upon the premise that the constitutional phrase “to promote the Progress of Science and useful Arts” is synonymous with placing works into the public domain. In my amicus brief filed with the Supreme Court, I review the history of the constitutional phrase “to promote the Progress of Science and useful Arts,” and demonstrate that the phrase incorporates many factors, not just an increase in the public domain.⁷³ To focus upon just the one factor is to thwart the meaning of the constitutional phrase, and to bind Congress in ways inconsistent with the full meaning of the constitutional mandate. Here are the arguments I make in the brief.

1. The constitutional phrase “the Progress of Science and useful Arts” is not directed primarily at the ultimate increase in the public domain

a. the state statutes under the Articles of Confederation

There is little direct record of what the drafters of the Constitution intended when they adopted the phrase “to promote the Progress of Science and useful Arts.” But much insight can be gleaned from the practice of the states under the Articles of Confederation, since it can be assumed that the drafters of the Constitution and of the first Copyright Act were familiar with the pre-existing state laws.

As seen earlier, the preambles to the state statutes contained language of natural rights and property rights.⁷⁴ The preambles also made clear that the inducement contemplated in the statutes was to “encourage learned and ingenious persons to write”⁷⁵ and to “encourage men of learning and genius to publish”⁷⁶ their works. Although works were obviously intended to go into the public domain at the expiration of the copyrights, the “public good” was not something that would be achieved only at that later date; the public good

73. See Brief of Amicus Curiae Edward Samuels in Support of Respondent at 18-22, *Eldred v. Ashcroft*, No. 01-618.

74. See discussion *supra* Part I.C.

75. As stated in the Massachusetts and related statutes.

76. As stated in the Connecticut and related statutes.

was achieved at the outset by the creation and publication of the works.

b. the constitutional phrase

The Constitution grants Congress the power to pass copyright law as follows:

Article I, sec. 8. The Congress shall have Power: . . .

To promote the Progress of Science and useful Arts, by securing, for limited Times, to Authors and Inventors, the exclusive Right to their respective Writings and Discoveries.⁷⁷

In *The Federalist No. 43*, James Madison gave pretty much the only contemporary public explanation of the phrase when he said:

The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law. . . . The public good fully coincides . . . with the claims of individuals. The States cannot separately make effectual provision [for copyright], and most of them have anticipated the decision of this point, by laws passed at the instance of Congress.⁷⁸

By “the public good,” Madison could not have meant simply the public domain, since the “public good” will not “fully coincide . . . with the claims of individuals” after the term of copyright has expired. What he meant was that the progress of science and arts depends entirely upon the creation and distribution of such works. Madison’s focus was, as the Constitution’s focus was, as the earlier state statutes’ focus was, primarily on the creation and distribution of works.⁷⁹ Of course, it was assumed that works would ultimately go into the public domain, but that was as a result of the “limited Times” provision, not something necessarily envisioned within the “Progress of Science and useful Arts” clause.

c. the plain meaning and logical understanding of the constitutional phrase

The Copyright Clause of the Constitution is the only enumerated power within Article 1, section 8, that mentions the “purpose” for

77. U.S. CONST. art. I, § 8.

78. THE FEDERALIST, *supra* note 69, at 279.

79. *See id.* at 278-79.

which it was enacted.⁸⁰ Why might the framers have chosen to add that language, instead of empowering Congress to grant exclusive rights to authors and inventors without limitation? Possibly, the framers were simply following the pattern of the prior state enactments, almost all of which had preambles explaining their purpose.⁸¹ The “whereas” clauses in the preambles explained the purposes of the earlier statutes, but they can hardly be read as specific limitations upon the rights granted under those statutes.

The other model for the structure of the constitutional phrase was the Statute of Anne, adopted in England in 1710.⁸² That Act was entitled “An Act for the Encouragement of Learning, by vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, during the Times therein mentioned.”⁸³ It is hard to imagine how the words “Encouragement of Learning” provided any particular limitation upon what rights were granted.

Petitioners would have us believe that “Science and useful Arts” does not progress until someone, such as petitioner Eldred, has made a work available to those who use it free of charge. But that certainly is not the common sense meaning of “Progress of Science and useful Arts.” Millions of works are created, published, read, and commented upon every year. Shortly after their publication, some of the greatest works receive accolades, criticism, and literary and other awards, for the contribution that they make to the arts and sciences. For example, the Nobel Prizes are awarded to those who “shall have conferred the greatest benefit to mankind.”⁸⁴ Under the Nobel rules, “[t]o be eligible to be considered for a prize, a written work shall have been issued in print or have been published in another form”⁸⁵ Pulitzer Prizes are awarded for “work done” and

80. See U.S. CONST. art. I, § 8.

81. See, e.g., *supra* Part I.C.

82. See An Act for the Encouragement of Learning, 1710, 8 Ann., c. 21 (Eng.).

83. *Id.*

84. THE NOBEL FOUNDATION, STATUTES OF THE NOBEL FOUNDATION § 1, available at <http://www.nobel.se/nobel/nobel-foundation/statutes.html> (last visited Aug. 3, 2002).

85. *Id.* at § 3.

“published” or “performed” during the prior year.⁸⁶ The public value of the works is hardly diminished by the fact that they will not go into the public domain for many years.

Authors who make “transformative” uses of copyrighted works should and do have wide leeway to produce their works under the fair use doctrine, as illustrated by the Supreme Court’s decision in *Campbell v. Acuff-Rose Music, Inc.*⁸⁷ and the Eleventh Circuit’s decision in *Suntrust Bank v. Houghton Mifflin Co.*⁸⁸ Petitioners, however, are not such “creators” who desire to make transformative uses of existing works; instead, their businesses, for the most part, are in making already existing works available over the Internet or otherwise.⁸⁹ While this may be a valuable service to the public, it does not result in any immediate “Progress” of “Science and useful Arts,” since the works that they distribute are works that have already been published, almost all of which are already available (though of course for a fee) from other sources.⁹⁰

In short, the “Progress of Science and useful Arts” takes place primarily when works are created and published, not (or at least not primarily) when they go into the public domain.

2. United States copyright statutes

a. the Copyright Act of 1790

The first copyright act, passed in 1790 in the first Congress, was entitled “An Act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned.”⁹¹ The legislative history of the Act confirms that Congress, in passing the Act, was focusing upon the inducement to create and publish.⁹² President

86. See THE PULITZER PRIZES, GUIDELINES & FORMS, available at <http://www.pulitzer.org/Entry-Forms/entry-forms.html> (last visited Aug. 3, 2002).

87. 510 U.S. 569 (1994).

88. 268 F.3d 1257 (2001).

89. See Petitioners Brief, *supra* note 21, at 3-6.

90. See *id.* at 5.

91. Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124.

92. See THORVALD SOLBERG, COPYRIGHT IN CONGRESS 1789-1904: A BIBLIOGRAPHY, AND CHRONOLOGICAL RECORD OF ALL PROCEEDINGS IN CONGRESS IN RELATION TO COPYRIGHT FROM APRIL 15, 1789, TO APRIL 28,

George Washington, in his January 1790 address to a joint session of Congress, urged the new Congress that “there is nothing which can better deserve your patronage than the promotion of science and literature.”⁹³ He went on: “Whether this desirable object [knowledge] will be best promoted by affording aids to seminaries of learning already established, by the institution of a national university, or by any other expedients, will be well worthy of a place in the deliberations of the legislature.”⁹⁴ Congress responded with an address to the President: “We concur with you in the sentiment that . . . the 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.”⁹⁵ The act that was passed by Congress and signed into law by President Washington in that same year was the copyright act, entitled “An Act for the encouragement of learning.”⁹⁶

The 1790 Act was inconsistent with petitioners’ theory that Congress may not constitutionally extend the duration of existing works. Most states already had copyright laws that created exclusive rights for periods varying from a minimum of fourteen to a maximum of twenty-eight years.⁹⁷ The 1790 Act not only continued these copyrights in force, but extended the duration to run for a period of fourteen to (upon renewal) twenty-eight years from the date of new registration. This was not some incidental effect, but was quite clearly set forth in the statute in a separate provision:

1904, FIRST CONGRESS, 1ST SESSION, TO FIFTY-EIGHTH CONGRESS, 2D SESSION 117 (reprint 1976) (1905).

93. *Id.* at 115.

94. *Id.* at 116.

95. *Id.* at 118.

96. 1 Stat. 124.

97. Actually, the statutes of Pennsylvania and Maryland provided that they would not apply until copyright statutes had been adopted in all thirteen states, so presumably copyright was inoperative in those states because Delaware never adopted a copyright law. Additionally, the statutes of Connecticut, Massachusetts, New Hampshire, Rhode Island, North Carolina, and New York provided that copyright would not extend to works created by authors from other states unless those other states adopted their own copyright laws. See generally COPYRIGHT ENACTMENTS, *supra* note 23 (history of laws passed in the United States since 1783 relating to copyright). So even in these states, works by citizens of other states may have gone into the public domain when they were published.

Be it enacted . . . That from and after the passing of this act, the author and authors of any map, chart, book or books already printed within these United States . . . shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the term of fourteen years from the recording the title thereof in the clerk's office⁹⁸

Thus, the authors of existing works, even if they had already received up to seven years of protection under the prior state laws (from 1783 to 1790), or even if their works might have gone into the public domain because they were from a state that had not yet passed an effective copyright law, were entitled to begin their copyrights anew under the 1790 Act.

b. subsequent extensions

All subsequent copyright acts that have extended the term of copyright—to a total of forty-two years from the date of publication in 1831;⁹⁹ fifty-six years from publication in 1909;¹⁰⁰ life of the author plus fifty years in 1976;¹⁰¹ and life of the author plus seventy years in 1998¹⁰²—have specifically applied the extension to existing works. This application of new terms to existing works was not some incidental outcome, but was specifically considered by Congress.

In 1831, when the first term of copyright was extended twenty-eight years, to create a maximum copyright term of forty-two years, this result was accomplished by repealing the prior 1790 Act, but preserving rights under that Act and applying the terms of the new Act to the existing works.¹⁰³

Sec. 14. *And be it further enacted*, That the “Act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such

98. § 1, 1 Stat. at 124.

99. See Act of Feb. 3, 1831, ch. 16, 4 Stat. 436.

100. See Act of Mar. 4, 1909, ch. 320, § 24, 35 Stat. 1075 (repealed 1978).

101. See Act of Oct. 19, 1976, Pub. L. No. 94-553, 90 Stat. 2541.

102. See Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified as amended at 17 U.S.C. §§ 108, 203(a)(2), 301(c), 302, 303, 304 (2000)).

103. See §§ 14-15, 4 Stat. at 439.

copies during the times therein mentioned," passed May thirty-first, one thousand seven hundred and ninety, and the act supplementary thereto . . . shall be, and the same are hereby, repealed: saving, always, such rights as may have been obtained in conformity to their provisions.

Sec. 15. *And be it further enacted*, That all and several the provisions of this act, intended for the protection and security of copyrights, and providing remedies, penalties, and forfeitures . . . shall be held and construed to extend to the benefit of the legal proprietor or proprietors of each and every copyright heretofore obtained, according to law, during the term thereof, in the same manner as if such copyright had been entered and secured according to the directions of this act.¹⁰⁴

The 1909 Act, which extended the renewal term of copyright by an additional fourteen years for a total copyright term of up to fifty-six years, made clear that it did not revive works that had already gone into the public domain; but the extension of the additional fourteen years *did* apply to copyrights that had been obtained under the prior act and had not yet expired.¹⁰⁵

Sec. 7. . . . [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 . . . [July 1, 1909] and has not been already copyrighted in the United States¹⁰⁶

In the twenty years of legislative history leading up to the 1976 Act, Congress carefully considered the varying means for measuring the term of copyright. Although it adopted the life-plus-50-year term for works created after the effective date of the statute, Congress chose to continue to measure the term of existing copyrights (and works-for-hire and pseudonymous and anonymous works) from the date of publication.¹⁰⁷

104. *Id.*

105. *See* 35 Stat. at 1075.

106. *Id.* at 1077.

107. The 1976 Act provided that anonymous works, pseudonymous works, and works-for-hire would be protected for seventy-five years from publication, or 100 years from the date of creation, whichever expired first. The CTEA provides that such works are protected for ninety-five years from publication

Under the 1976 Act, life plus fifty years actually resulted in a *shorter* duration of copyright for works produced toward the end of an author's life. Such works would be protected for a little over fifty years, less than the fifty-six-year maximum under the 1909 law. Congress concluded that, *on average*, the life of the author plus fifty years was the equivalent of about seventy-five years from publication; but, of course, in individual instances, it might be more or less. That is the inevitable result of using two different methods for computing the duration of copyright.

Congress considered that it might be unfair to grant the benefits of the nineteen-year term extension to licensees who may have paid only for a shorter license term. Accordingly, Congress established in section 304(c) an elaborate provision for "termination," or recapture, of the extension term for the benefit of the authors or their heirs.¹⁰⁸ In this way, the term extension was not necessarily a "victory" for the large corporations that may have owned many of the copyrights, since in many cases they had to renegotiate the rights with the original authors or their heirs.

While Congress in 1976 extended the term of copyright for works that had already been published, it significantly decreased the term of protection for works that were not yet published.¹⁰⁹ Under prior law from 1790 through 1977, state common law copyright in *unpublished* works had extended in perpetuity.¹¹⁰ Under the new Act, Congress brought works under the federal system of copyright beginning from the date of "fixation" in a "tangible medium of expression" (rather than from the date of publication) and preempted state common law copyright in all such works, including unpublished works.¹¹¹ In section 303, Congress provided that copyright in previously created but unpublished works would be measured by the life-plus-50-year term.¹¹² However, in order to prevent "old"

or 120 years from creation, whichever expires first. Petitioners can hardly complain about the 100 or 120-year periods from the date of creation, since those terms are much shorter than the rights "in perpetuity" that applied to unpublished works from 1790 through 1977. *See infra* this Section.

108. *See* 17 U.S.C. § 304(c) (1976).

109. *See* Act of Oct. 19, 1976, Pub. L. No. 94-553, 90 Stat. 2541.

110. *See* EDWARD SAMUELS, THE ILLUSTRATED STORY OF COPYRIGHT 222-23 (2000) [hereinafter ILLUSTRATED STORY].

111. *See* 17 U.S.C. §§ 102(a), 301(a) (1976).

112. *See* 17 U.S.C. § 303 (1976).

unpublished works from immediately going into the public domain, Congress provided that no such works would go into the public domain before December 31, 2002, at the earliest. And, to encourage publication of such old works, Congress provided that if such old works were published by the end of the year 2002, they would be granted additional protection until the year 2027.¹¹³ In any event, since the duration of copyright for unpublished works was reduced from “in perpetuity,” and since some copyrights actually received a *shorter* term of copyright under the new Act, the net effect of the 1976 Act was not simply to “extend” the term of copyright, but more precisely to “adjust” the term of copyright.¹¹⁴

While Congress’s prior enactments, of course, do not definitively decide the constitutional issue in the *Eldred* case, they do evince a practice of careful deliberation that has been clear and consistent from the Copyright Act of 1790 to the Copyright Act of 1998. Each of these statutes, affecting the terms of existing as well as future copyrights, is inconsistent with the novel constitutional theory proposed by petitioners.

c. other copyright acts

Extension of the copyright term is not the only way in which Congress has expanded the scope of copyright over the years. A few examples include: owners of previously copyrighted works saw their rights expand when Congress added the right to receive payment under a compulsory licensing system for cable retransmissions in 1976;¹¹⁵ a public display right in 1976;¹¹⁶ certain moral rights in 1990;¹¹⁷ and digital performance rights in sound recordings in 1992.¹¹⁸ Such additional rights could not possibly represent an incentive to the original copyright owners to create their works; and so, by petitioners’ logic, Congress should never have been able to add to the rights in such works already in existence. Yet it is absurd to assume that Congress does not have the power to make periodic adjustments to the scope of existing copyrights.

113. *See id.*

114. *See* 90 Stat. at 2573.

115. *See* 17 U.S.C. § 111 (2000).

116. *See id.* § 106(5).

117. *See id.* § 106A.

118. *See id.* § 106(6).

Congress has “decreased” the public domain (in the sense that it has passed laws slowing the rate at which works go into the public domain) in many other ways besides the extension of the copyright term. For example, many more works have traditionally gone into the public domain as a result of failure to use the copyright notice, failure to register, or failure to renew, than have gone into the public domain because of expiration of copyright.¹¹⁹ When Congress in 1988 eliminated the copyright notice and registration requirements as part of its obligations under the Berne Convention,¹²⁰ and when in 1992 it provided for automatic renewal of copyrights still in their first terms, it rescued many more existing works from going into the public domain than it did when it passed the CTEA. Again, by petitioners’ logic, these “assaults” on the public domain should never have been allowed. The fact that Congress has continually readjusted not only the term of copyright, but also the scope of rights in existing copyrights, and has abandoned the requirement of formalities, also for existing copyrights, demonstrates that Congress simply is not limited in the novel way suggested by petitioners.

3. The “Progress of Science and useful Arts” involves dozens of considerations beyond merely the devolution of copyrighted works into the public domain

- a. *international considerations*

One of the major accomplishments in U.S. copyright in the latter part of the twentieth century was the internationalization of copyright standards, prompted to a large extent by the internationalization of trade and technology. The 1790 Act protected only U.S. authors.¹²¹ It was not until 1891 that foreign authors were granted at least some minimal level of protection, though that protection, because of copyright formalities, was often more illusory than real. In 1952, the United States was instrumental in convincing much of the world to adopt the Universal Copyright Convention, which allowed a U.S.-

119. If, as petitioners assert in their brief, only thirteen percent of copyrighted works were generally renewed, then eighty-seven percent of the works went into the public domain when they were not renewed. See Petitioners Brief, *supra* note 21, at 7.

120. See Berne Convention, *supra* note 66, at 40.

121. See § 1, 1 Stat. at 124.

inspired international copyright system to exist alongside the Berne Convention that governed most of the rest of the world.¹²² The situation was an embarrassment within the international copyright community, and undermined the ability of U.S. trade negotiators to encourage other countries to enhance their copyright protection of foreign—including U.S.—books, music, movies, and computer programs. Finally, in 1988, the United States joined the rest of the world by adhering to the Berne Convention.¹²³

The Berne Convention provides that all member countries must protect copyright for a minimum term of life of the author plus fifty years,¹²⁴ and eliminate all formalities as prerequisites to copyright.¹²⁵ The extension of copyright to life plus fifty years, as provided in the major overhaul of U.S. copyright law in 1976, and the elimination of formalities in the Berne Implementation Act of 1988, were therefore absolute prerequisites to U.S. adherence to Berne.

Not only does Berne require a term of life of the author plus fifty years, but it also requires that member countries grant that term to all works that have not already gone into the public domain in a particular country.¹²⁶ As provided in Article 18(1): “This Convention shall apply to all works which, at the moment of its coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection.”¹²⁷ Thus, the term extension for existing works still under copyright protection was an absolute necessity for joining Berne under Article 18(1).¹²⁸

122. See Universal Copyright Convention, Sept. 6, 1952, 6 U.S.T. 2731.

123. See ILLUSTRATED STORY, *supra* note 110, at 230-48.

124. See Berne Convention, *supra* note 66, at 41.

125. See *id.* art. 5(2).

126. See *id.* art. 7.

127. *Id.* art. 18(1).

128. There is a limited exception in Article 18(2), which provides that “[i]f, however, through the expiry of the term of protection which was previously granted, a work has fallen into the public domain of the country where protection is claimed, that work shall not be protected anew.” *Id.* art. 18(2). In addition, under Article 18(3), there is some room for member countries to determine “the conditions of application of this principle.” *Id.* art. 18(3). There was a vigorous debate at the time of U.S. adherence to Berne whether Article 18 required the United States to “restore” copyright in works that had gone into the public domain as the result of a failure to meet the notice and registration formalities. See *U.S. Adherence to the Berne Convention: Hearing on the Implications Both Domestic and International, of U.S. Adherence to the International Union for the Protection of Literary and Artistic Works Before the S.*

The 1998 extension, from life of the author plus fifty years to life of the author plus seventy years, was not required under international obligations. However, it was designed to match the term of copyright recently adopted throughout the European Union and by other countries. Under Article 7(8) of the Berne Convention, countries with the life-plus-70-year term do not have to recognize the rights of foreign authors whose works have expired in their own countries.¹²⁹

Since the United States is a net exporter of copyrighted works, it certainly made sense for the United States to grant the longer term, and thereby allow U.S. authors to take advantage of the longer term available abroad. Furthermore, since the United States was simply matching the longer term available in other countries, it is not likely that Congress, absent the strong international considerations, will extend the U.S. term of copyright yet again. Petitioners' suggestion that Congress will continue to grant further extensions whenever the copyright industries ask for them is simply not a likely scenario.

The petitioners suggest that the drafters of the Constitution would be horrified at a term of life plus seventy years, or ninety-five years for existing works. In 1790, the term of copyright adopted by Congress matched the British, and what would become the international standard of the day. Would the framers of the Constitution be shocked to learn that Congress had, over the years, extended the term of copyright to match the expanding international norm? It is more

Subcomm. on Patents, Copyrights and Trademarks of the Comm. on the Judiciary, 99th Cong. 493 (1987) (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, 587 (1986) (discussing retroactivity provisions of Article 18 of the Berne Convention). A consensus developed that the United States did not necessarily have to restore such works. *See id.* at 592-94.

While Article 18 arguably allowed the United States not to restore works that had fallen into the public domain because of a failure of copyright formalities, the term extension for existing works still under copyright protection was an absolute necessity for joining Berne. The United States was apparently able under subsection (3) to determine that it would comply with Article 18 by granting a fixed term of seventy-five years to existing copyrights (on average the equivalent of life plus fifty years). There was at least some argument that the seventy-five-year term in some cases yielded less than the life-plus-50-year term required by Berne; the life-plus-70-year term of the CTEA thus shored up United States law against any challenge based upon this argument.

129. *See* Berne Convention, *supra* note 66, art. 7(8).

likely that they would be shocked if we had not done so. Were Madison to view the state of international trade and technology today, he might well conclude, as he did about the individual state statutes in 1790, that one country “cannot separately make effectual provision” for copyright, and that most countries today have “anticipated the decision of this point” by passing laws in conformity with international standards.¹³⁰

b. other considerations

While the exact contours of the “Progress of Science and useful Arts” are not clear, many of the major theories and limitations of copyright adopted over the years were intended to, and do in fact, promote such progress.

For example, the Supreme Court has recognized the “First Amendment protections already embodied in the Copyright Act’s distinction between copyrightable expression and uncopyrightable facts and ideas, and the latitude for scholarship and comment traditionally afforded by fair use.”¹³¹ Works of utility are not covered by copyright, but are free for the taking.¹³² The first sale doctrine,¹³³ the numerous compulsory licenses, the limitations in section 110 protecting various performances, and the exclusion of protection for government works¹³⁴ all carve out major limitations that promote the progress of science and arts. The limitation of copyright protection to “original works of authorship,”¹³⁵ the special rules for library photocopying,¹³⁶ the many definitional limitations in section 101, and the fact that copyright does not prevent all uses of copyrighted works, but only those enumerated in the exclusive rights sections 106 and 106A, all in their own way foster the “Progress of Science and useful Arts.” There is hardly a principle of copyright that does not reflect a careful balance between the rights of copyright owners and copyright users. Presumably, it is precisely because the balance is so

130. THE FEDERALIST, *supra* note 69, at 279.

131. Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 560 (1985).

132. See 17 U.S.C. § 101 (2000) (definition of “pictorial, graphic and sculptural works”).

133. See *id.* § 109.

134. See *id.* § 105.

135. *Id.* § 102.

136. See *id.* § 108.

intricate and delicate that the framers of the Constitution assigned to Congress the task of setting copyright policy.

c. the CTEA

In enacting the CTEA, Congress again gave careful consideration to balancing the interests of copyright owners and copyright users. For example, Congress coupled copyright term extension with the so-called “Fairness in Music Licensing Act,” which, in amending section 110(5) and adding section 513, put severe limitations on the enforcement of public performance rights by music copyright holders. Responding to the concerns raised by library representatives, Congress added a new subsection 108(h), which provides for an expanded library exemption for the reproduction of copyrighted works during the last twenty years added by the Act.¹³⁷

As previously explained, old unpublished works were slated to go into the public domain after December 31, 2002.¹³⁸ As originally proposed, the CTEA would have extended the protection of such works by an extra ten years.¹³⁹ Responding to the concerns raised in the committee hearings, however, Congress determined that no extension should be given for the protection of these works (although Congress did extend by twenty years, to 2047,¹⁴⁰ the “extra” protection granted to such works as an inducement to get them published by the end of 2002). Thus, thousands, or millions, of unpublished works, including private letters dating back to the early history of the United States, will first go into the public domain after December 31, 2002, demonstrating Congress’s sensitivity to the value of the public domain.

As with the 1976 term extension, Congress was concerned that the authors or their heirs, rather than the copyright licensees, be the ones to receive the benefit of the twenty-year term extension. Accordingly, Congress provided a new termination right in section 304(d) for authors or heirs who did not previously take advantage of the termination provided in section 304(c).¹⁴¹

137. *See id.* § 108(h).

138. *See supra* Part II.A.2.b.

139. *See* S. REP. NO. 104-315, at 5-6 (1996).

140. *See* 17 U.S.C. § 303 (2000).

141. *See id.* § 304(d).

Congress did not provide, either in 1976 or in 1998, for a termination right in works-for-hire. However, in the CTEA, Congress did take the extraordinary step of adopting a sense that owners of audiovisual works should make arrangements to share the value of the additional twenty-year extension with those who participated in the creation of the works.¹⁴² Section 105 of the CTEA provides:

It is the sense of the Congress that copyright owners of audiovisual works for which the term of copyright protection is extended by the amendments made by this title, and the screenwriters, directors, and performers of those audiovisual works, should negotiate in good faith in an effort to reach a voluntary agreement or voluntary agreements with respect to the establishment of a fund or other mechanism for the amount of remuneration to be divided among the parties for the exploitation of those audiovisual works.¹⁴³

Although this sense of Congress does not have the force of law, it presumably puts the industry on notice that, should such negotiations not be forthcoming, Congress might consider enacting legislation to force the copyright owners to share the benefits of the copyright term extension (assuming, of course, that the Supreme Court does not bar Congress from making ongoing adjustments to existing rights of copyright).

Thus, it is clear that Congress in the 1998 legislation continued doing what it has been doing for the full 212 years of copyright in this country: promoting the “Progress of Science and useful Arts” by carefully balancing the interests of copyright owners and copyright users.

d. copyright balances

In their amicus brief filed with the Supreme Court petitioning for certiorari, the law professors in support of the petitioners speculated about the impact the appellate court’s ruling might have on the DMCA, the restoration of foreign copyrights under section 104A, various other recent enactments, and potential enactments that have

142. See Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, § 105, 112 Stat. 2827, 2829 (1998).

143. *Id.*

not yet even been considered by Congress.¹⁴⁴ The professors were concerned about the impact on court interpretations of the DMCA, particularly involving potential idea/expression and fair use arguments.¹⁴⁵ The law professors did not stress the point in their filing on the merits, and I did not include the following analysis in my own amicus brief.

In deciding whether the CTEA is constitutional or not, the Supreme Court must make an all-or-nothing choice. Congress, on the other hand, is the proper body for weighing competing considerations and coming up with a “compromise” that protects the interests of all parties. That is exactly what it did in the CTEA when it expanded the library exemption during the added twenty-year term, and when it limited the scope of the musical performance right by various amendments placing restrictions on performing rights societies.

In the future, Congress might adopt any number of other compromises to assure the continued “Progress of Science and useful Arts.” Congress might conclude that the longer term is not appropriate for some categories of works, and adopt a shorter term for such works as works of applied art, as is allowed under the Berne Convention. If Congress is concerned about the availability of older works that are still the subject of copyright, it might adopt a compulsory license to cover the situation, much as it provided for a compulsory license for the continued use of derivative works by reliance parties based upon works whose copyright was restored under section 104A.¹⁴⁶ For example, the Connecticut statute of 1783 provided that, if an author “shall neglect to furnish the public with sufficient editions thereof, or shall sell the same at a price unreasonable,” then a court was empowered to grant a complainant “a full and ample licence [sic] to re-print and publish such book, pamphlet, map or chart, in such numbers and for such term as said court shall judge just and reasonable.”¹⁴⁷

I do not advocate such a compromise, but the fact remains that there are plenty of ways, short of judicially throwing works into the

144. See Brief of Intellectual Property Law Professors as Amici Curiae Supporting Petitioners, *Eldred v. Ashcroft*, No. 01-618 [hereinafter Intellectual Property Professors Brief Supporting Petitioners].

145. See *id.* at 26-27.

146. See *supra* Part I.D.

147. COPYRIGHT ENACTMENTS, *supra* note 23, at 2-3.

public domain, to protect any legitimate copyright user and First Amendment concerns. The copyright laws do *not* raise such constitutional concerns as they currently exist, precisely because Congress and the courts *have* seen fit to impose the idea/expression, fair use, compulsory license, and other limitations on the rights of copyright. It is not necessary or appropriate to speculate whether any future copyright law, no matter how absurd, might be unconstitutional. The only issue is whether Congress, in passing the law it did, acted within its constitutional authority, including promoting the “Progress of Science and useful Arts,” properly understood to incorporate a wide range of concerns. That is precisely the role that Congress is situated to play, and that is presumably the reason that the Constitution grants Congress the power to set the parameters of copyright law.

The reason I cut this argument from my amicus brief was that it might have seemed to suggest that there was some less drastic alternative that Congress could have passed, such as ones containing the above-contemplated compulsory license, and that the Supreme Court should declare the law unconstitutional until Congress adopts the balance that the Court deems preferable. But if there are less drastic alternatives, or if there are other ways of promoting the legitimate interests of the public domain, by compulsory licenses or other devices, then we should all go back to Congress and discuss those suggestions. The public domain literature has certainly served its purpose of highlighting concerns that may not have been adequately voiced before, and for that reason much of the literature does make a valuable contribution, despite my criticisms here and elsewhere. I do not think that it would be appropriate, however, for the Supreme Court to make the ultimately legislative decision about what compulsory licenses or limiting doctrines should be adopted in each context.

4. The briefs—conclusion

The Copyright Act is a series of compromises and balances among competing interests. It would be unfair, and perhaps impossible, to unravel one part of this Act without upsetting the careful balance that only Congress is in a position to achieve. The point was well made by Ralph Oman, former Register of Copyrights, in a letter to the editor of the *Washington Post* on March 11, 2002:

During the past 90 years, to solve political controversies
and to hand out economic freebies to sympathetic

supplicants, Congress has sweet-talked authors into giving up their right to say yes or no to a use of their works—the essence of a property right—in exchange for a longer term. A long list of special pleaders now gets free use of copyrighted works, including small businesses, veterans' groups, bars, scholars, restaurants, fraternal groups, marching bands, Boy Scout troops, nursing homes, libraries, radio broadcasters and home tapers. Another long list of powerful industries gets to use copyrighted works in exchange for a small government-set fee, whether the author likes it or not: cable and satellite companies, record companies, juke-box operators, public broadcasters and, most recently, Internet companies.

The authors went along with this coerced subsidization because Congress held out the promise of a longer term of protection. It would be a switch-a-roo worthy of Lucy yanking away Charlie Brown's football if the Supreme Court removed the carrot and left the authors with the dirty end of the stick.¹⁴⁸

C. Rebuttal

There are several misrepresentations or mischaracterizations in the petitioners' presentation of the case. Most of what follows are responses I make in the footnotes of my amicus brief.

1. The number of copyright extensions

Petitioners state throughout their brief that Congress has extended the term of copyright “eleven times in the past forty years.”¹⁴⁹ This is a statement that also appears throughout Lawrence Lessig's most recent book,¹⁵⁰ and that many public domain advocates seem to enjoy repeating. These statements are misleading, if not downright disingenuous. In the past ninety years (since the 1909 Act established a maximum duration of fifty-six years), the term has been basically extended only twice, to life of the author plus fifty years in

148. Ralph Oman, Letter to Editor, *A Whittling Away of Copyrights*, WASH. POST, Mar. 11, 2002, at A20, available at <http://www.washingtonpost.com/ac2/wp-dyn/A5785-2002Mar10>.

149. See, e.g., Petitioners Brief, *supra* note 21, at 2.

150. See generally LESSIG, *supra* note 19 (discussing copyright term).

1978, and to life of the author plus seventy years in 1998. The other nine extensions were interim extensions for roughly one or two-year periods, enacted between 1962 and 1974, so that copyrighted works would not go into the public domain pending adoption of the new seventy-five-year term for existing copyrights.¹⁵¹ In no case did the extension exceed the seventy-five-year term that was ultimately adopted by Congress in the 1976 Act.

Congress has hardly been headstrong in extending the term of copyright. In 1909 and throughout the twentieth century, many advocates of copyright proposed rejection of the “outmoded” structure of the Statute of Anne, and adoption of the life-plus-50-year system that prevailed in most of the rest of the world. Had Congress adopted the more modern term in 1909, instead of 1976, there would have been only two term extensions in the last 170 years (since the extension to a maximum of forty-two years in 1831), instead of the last ninety years.

2. The belittling of international considerations

In his book, *The Future of Ideas*, Lawrence Lessig explains the “repeated” extensions of copyright as being a power-grabbing ploy of the giant corporations.¹⁵² At various websites on the *Eldred* case, the slogan “Free the Mouse” is prominently displayed, and public domain advocates seem to enjoy calling the CTEA the “Mickey Mouse Act.”¹⁵³ In his book, Lessig pretty much dismisses the international considerations that were at the heart of copyright term extension.¹⁵⁴ The briefs belittle the international considerations.

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

152. See generally LESSIG, *supra* note 19 (discussing copyright extension).

153. The slogan used to be accompanied by a stylized “logo” looking like Mickey Mouse with lines through it, but they have recently dropped that logo. See, e.g., Eldred v. Ashcroft website at <http://eldred.cc/> (last visited Aug. 8, 2002) (site compiling information regarding the *Eldred v. Ashcroft* case).

154. One of Lessig’s proposals is that the United States adopt a copyright system of five-year terms subject to renewals. In a footnote, Lessig concedes that “[s]ome of the changes I propose here would require changes to or the ab-

Some of the public domain literature argues that the international considerations are irrelevant to the issue, since the rest of the world obviously is not subject to the United States Constitution, as is Congress. However, although the laws of other countries may reflect different cultures and different histories, it is nevertheless instructive to consider how other nations have set about dealing with common problems of enforcing copyright in an emerging global technology. As stated by Justice Breyer in *Printz v. U.S.*:¹⁵⁵

Of course, we are interpreting our own Constitution, not those of other nations, and there may be relevant political and structural differences between their systems and our own. . . . But their experience may nonetheless cast an empirical light on the consequences of different solutions to a common legal problem¹⁵⁶

3. The arguments against “harmonization”

It is true that the adoption of the CTEA did not result in complete harmonization with foreign copyright laws. A lot of the “disharmony” that petitioners and several amici observe results from measuring new copyrights from the date of the author’s death, while measuring old, and some new, copyrights from the date of publication. Petitioners try to make much of the inevitable disparity. For example, they state that “[a]s applied to an author who produced throughout a long lifetime in the pattern of Irving Berlin, the current rule would produce a term of 140 years.”¹⁵⁷ The statement is misleading. The 140-year term would apply only to Berlin’s early works; works produced shortly before his death would endure only for a little over seventy years under the CTEA. In any event, most of the disharmonies, both between the laws of different countries and internally within U.S. law, result from other decisions made about other aspects of copyright, such as the treatment of works-for-hire.

rogation of some treaties,” particularly the Berne Convention, the TRIPS/WTO agreement, and the two WIPO treaties. LESSIG, *supra* note 19, at 330 n.14. But to “change or abrogate” major international copyright law is hardly a simple matter, and could cause untold hardships to some American copyright industries.

155. 521 U.S. 898,977 (1997) (Breyer, J., dissenting).

156. *Id.* at 977 (citation omitted) (discussion in context of the Brady Act).

157. Petitioners Brief, *supra* note 21, at 3.

If there are problems in the nonuniform treatment of those aspects, then those aspects should be addressed separately.

4. The stationers' company acts

Several briefs in favor of petitioners link the Statute of Anne to the prior history of monopolies under the Stationers' Companies Licensing Acts. About this linkage, I refer to my book:

Some modern critics of the expansion of copyright delight in emphasizing the embarrassing precursor to the Statute of Anne, suggesting that copyright has been forever tainted by the fact that it evolved from what were essentially censorship laws. However, there was a critical gap in protection, from 1694 through 1710, and the new Statute of Anne was not simply an extension of the previous law. Parliament seems not to have been guided by the complaints of the publishers, who in 1709 had lobbied for a return to the old licensing acts. Instead, they were obviously influenced by the pleas of several famous authors for the recognition of rights not of printers, but of authors

One way of putting the Stationers' Licensing Acts into perspective is to realize that they were not the spiritual precursors to copyright at all. However, because the crown and the publishers had found a way to protect the rights of publishers, and the publishers were accordingly willing to pay authors for their creations, a satisfactory solution had been worked out that eased the pressure for a more direct copyright law to protect authors. Once the stopgap measure was removed, the need for the protection of authors' rights came to the fore.¹⁵⁸

5. Quotes supporting short copyright terms

It is not hard to find quotations in the public discourse that advocate a shorter term of copyright. As stated in the reports to accompany the 1976 Act, "[t]he debate over how long a copyright should last is as old as the oldest copyright statute and will doubtless

158. See ILLUSTRATED STORY, *supra* note 110, at 16-17.

continue as long as there is a copyright law.”¹⁵⁹ The petitioners and their amici supply dozens of quotes from one side of this debate to create the impression that there was general consensus on the shortest possible copyright term. One can only marvel at the audacity of Professor Ochoa and others, who attach to their brief a seven-page appendix of an anonymous letter strenuously advocating one side of this debate almost 300 years ago.¹⁶⁰ The “consensus” that actually developed over the years in this country, in England, and throughout the European Union is a copyright term of life plus seventy years.

6. The relevance of the Internet

Although the issue before the Supreme Court does not directly involve the Internet or other new technologies, petitioners and several amici in favor of petitioners suggest that their interests are allied with the Internet, and that a decision against them will somehow inhibit the development of this new technology. For example, petitioners suggest that Eldred’s website is simply the Internet equivalent of a public library, and that he should be entitled to some online equivalent of the first sale doctrine.¹⁶¹

If Eldred wants to “compile” a “collection” of Robert Frost books, he is perfectly free to do so under the first sale doctrine. But if petitioners think that posting HTML versions of those works on their Internet website is or should be the online equivalent of the Derry New Hampshire Public Library’s lending of a particular copy to members of their community, then they are fundamentally wrong. The Derry library maintains individual copies of their books; when they are lent out, they are unavailable to others. Works that are “posted” on the Internet, on the other hand, can be viewed simultaneously by hundreds or thousands of users, copied instantaneously to their computers, and redistributed in multiple copies around the world. As demonstrated by the Audio Home Recording Act of 1992,¹⁶² the Digital Performance Right in Sound Recordings Act of

159. S. REP. NO. 94-473, at 133 (1975); *see also* H.R. REP. NO. 94-1476 (1976).

160. *See* Brief Amici Curiae Tyler T. Ochoa et al. in Support of Petitioners (Historians Brief), *Eldred v. Ashcroft*, No. 01-618.

161. *See* Petitioners Brief, *supra* note 21, at 5-6.

162. Audio Home Recording Act of 1992, Pub. L. No. 102-563, 106 Stat. 4237 (codified at 17 U.S.C., ch. 10 (1992)).

1995,¹⁶³ and the DMCA,¹⁶⁴ the proper congressional response to the digitization and posting of works is not a blanket exemption, but a careful balancing of interests. Even with the first sale doctrine, libraries are also subject to the elaborate provisions of section 108 to ensure that their copies are not systematically used to make copies of works.¹⁶⁵

If petitioners want a “first sale” equivalent for the Internet, they will have to convince Congress of its advisability. Their ability or inability to get a special exemption during the life of a particular copyright, however, should have nothing to do with the issue before the Supreme Court: Whether Congress acted within its constitutional authority when it extended the duration of copyright in the CTEA.

Petitioners argue that their view of the public domain is made more urgent by the development of new markets for creative works, particularly the Internet.¹⁶⁶ The response by Congress to the development of new markets, however—particularly new technologies for exploiting copyrighted works—is generally to give the copyright owners or the original creators or their heirs an opportunity to get some benefit from that new market. Sometimes this is achieved through a compulsory license, such as the compulsory license provided in the Audio Home Recording Act of 1992.¹⁶⁷ Sometimes it is achieved by creating new rights, such as was provided in the Digital Performance Right in Sound Recordings Act of 1995.¹⁶⁸ Sometimes when it expands rights to include new markets, Congress allows new parties to participate. For example, in the Audio Home Recording Act, Congress for the first time provided that some of the compulsory licensing fees be set aside for the benefit of artists who had

163. Digital Performance Right in Sound Recording Act of 1995, Pub. L. No. 104-39, 109 Stat. 336 (codified as amended in scattered sections of 17 U.S.C. (1996)).

164. Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended at 17 U.S.C. §§ 101, 104 and adding 17 U.S.C., ch. 12 (1998)).

165. See 17 U.S.C. § 108 (2000).

166. See Petitioners Brief, *supra* note 21, at 38.

167. 106 Stat. at 4237.

168. 109 Stat. at 336. And sometimes Congress chooses not to extend the rights of existing parties to new technologies. For example, the Sound Recording Amendment of 1971 applied only to recordings made after its effective date in 1972 and did not create rights in recordings already made. See Sound Recording Amendment of 1971, Pub. L. No. 92-140, 85 Stat. 391.

helped to create the recordings, regardless of their underlying contracts.¹⁶⁹ And in the 1995 legislation (amended in 1998) that created a compulsory license for certain webcasting on the Internet, performing artists were also allotted a substantial portion of the proceeds.¹⁷⁰

This desire to give copyright owners an opportunity and an incentive to exploit the new market represented by the Internet was specifically considered by Congress when it adopted the CTEA.¹⁷¹ Congress did not restore the copyright in any works that had already gone into the public domain. But it certainly was a legitimate concern to give some additional period of time for current copyright owners to exploit their works using the new media and technologies. It would otherwise seem ironic, perhaps unfair, to some copyright owners that their rights in creative works should expire just as the Internet made possible the development of new means for realizing some value from those works.

7. Copyright's quid pro quo

Petitioners recognize in their brief the “quid pro quo requirement of the Copyright Clause.”¹⁷² Under copyright law from 1790 through 1977, publication was generally the prerequisite for federal copyright. Since 1978, the only requirement has been “fixation” of an original work “in a tangible medium of expression.”¹⁷³ Even

169. See 17 U.S.C. § 1006(b) (2000).

170. See *id.* § 114(g).

171. As stated in S. REP. NO. 104-315, at 6 (1996):

[U]nprecedented growth in technology, including the advent of digital media and the development of the National Information Infrastructure (NII) and the Global Information Infrastructure (GII), have dramatically enhanced the marketable life of creative works, as well as the potential for increased incentives to preserve existing works.

As recited at page 12 of that report, the Register of Copyrights noted before the Committee in 1995:

Technological developments clearly have extended the commercial life of copyrighted works. Examples include video cassettes, which have given new life to movies and television series, expanded cable television, satellite delivery, which promise up to 500 channels thereby creating a demand for content, the advent of multimedia, which also is creating a demand for content, and international networks such as Internet, i.e., the global information highway. The question is who should benefit from these increased commercial uses?

172. See Petitioners Brief, *supra* note 21, at 23.

173. 17 U.S.C. § 102(a) (2000).

though copyrighted works are thus protected from the date of their creation, it is the genius of the copyright system that copyright owners only profit by making their works available to others, so they (and their publishers) still have an incentive to publish. Thus, while the particular expression may be protected, the ideas and facts and other noncopyrightable aspects of the works are made available to the public.¹⁷⁴

The quid pro quo is for the volitional acts of creating and publishing works. If part of the social “contract” is that works ultimately go into the public domain, then that aspect of the “bargain” is something of an adhesion contract for the authors. They have no choice whether or when their work goes into the public domain, and can hardly be said to have acquiesced to any particular duration for protection of their works.

To continue the contract analogy, the contract with the author is not something that comes to an end upon creation, or even upon first publication of a work. Rather, the rights and incentives are more in the nature of an executory contract, with ongoing incentives to continue to distribute the work for the entire period of the copyright owner’s exclusive rights.

8. Mischaracterization of effect of automatic renewal

Petitioners argue that the problems they associate with the copyright term extension are compounded by the fact that “renewal” has been “automatic” since 1992.¹⁷⁵ They argue that 375,000 copyrights have been “blocked” in order to “protect” 77,000 commercially viable works.¹⁷⁶ They then argue that “under current law,” as a result of automatic renewal, “3.35 million works would be blocked to protect 77,000.”¹⁷⁷ That is a mischaracterization of the effects of the law. The 1992 amendment that made renewal automatic applies to works that were created between 1964 and 1977, inclusive. The only works created between 1923 and 1963 that were still under copyright, and therefore subject to the 1998 term extension, were those that were in fact renewed by the copyright owners. Those works published between 1923 and 1963 that were not registered for

174. See *supra* Part II.B.3.b.

175. See Petitioners Brief, *supra* note 21, at 7, 30 n.13.

176. See *id.* at 7.

177. *Id.*

renewal have already gone into the public domain, and were not extended by the CTEA.

9. Mischaracterization of fair use cases

The petitioners' intellectual property law professors' brief states that "[o]ne of the most troubling aspects of copyright in recent years is that the limitations on copyright liability, including the idea-expression distinction and fair use, have been steadily shrinking via judicial construction."¹⁷⁸ This statement is absolutely wrong. The Supreme Court's clarification of the wide scope of fair use in a parody context, *Campbell v. Acuff-Rose Music, Inc.*,¹⁷⁹ has been embraced by the lower courts.¹⁸⁰ In the context of new technologies, the Supreme Court held in *Sony Corp. of America v. Universal City Studios, Inc.*,¹⁸¹ that fair use included the "time-shifting" of television programs through the use of home video recorders. The Supreme Court's holding in *Feist Publications, Inc. v. Rural Telephone Service Co.*,¹⁸² while not an "idea/expression" case, was founded upon the related fact/expression distinction. *Computer Associates International, Inc. v. Altai, Inc.*¹⁸³ and similar cases have resulted in a "thin" copyright for computer programs, based upon concepts related to the idea/expression distinction and the works of utility doctrine. The holding in *Recording Industry Ass'n of America v. Diamond Multimedia Systems, Inc.*¹⁸⁴ that the Audio Home Recording Act of 1992 does not apply to the popular RIO MP3 music player, while decided on the technicalities of that statute, was a major victory in what might be considered a fair use context. It is hard to imagine how the copyright law professors can conclude that the basic limitations of copyright have not been doing their historical job of balancing the rights of copyright owners and users.

178. Intellectual Property Professors Brief Supporting Petitioners, *supra* note 144, at 26.

179. 510 U.S. 569 (1994).

180. *See, e.g.*, *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257 (11th Cir. 2001); *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109 (2d Cir. 1998).

181. 464 U.S. 417, 455 (1984).

182. 499 U.S. 340 (1991).

183. 982 F.2d 693 (2d Cir. 1992).

184. 180 F.3d 1072, 1081 (9th Cir. 1999).

10. Economic efficiency analysis

a. the economists' brief

The petitioners' economists' brief begins with the statement: "One possibility is that Congress sought a policy that confers a net economic benefit, after subtracting the expected costs."¹⁸⁵ This is a pretty telling statement, since it sets up the entire brief as based upon a policy that it does not even say Congress adopted.

Despite the attempts by some scholars to test all copyrights on the Procrustean bed of economic efficiency analysis, Congress has simply never limited itself to such an approach. The moral rights provided in section 106A, the termination rights of sections 203 and 304(c), and dozens of other rights and limitations do not lend themselves to economic evaluation.

One of the basic problems with an efficiency analysis of copyright is that many of the variables involved in the copyright industries simply are not quantifiable. For example, in making the argument that increased revenues for the copyright industries will not result in any greater investment in future works, the economists blithely suggest that "[i]n general, a profit-maximizing producer should fund the set of projects that have an expected return equal to or greater than their cost of capital."¹⁸⁶ One is reminded of the proverbial critic who, upon being told that only one out of ten movies makes money, responded, "[t]hen only invest in the ones that make money." Of course, if one knew in advance which multi-million-dollar movies would be successful, one would have no difficulty making money.

The fact is that the copyright industries are based upon products that usually have, at the outset, an undeterminable value. One book sells, another does not; one movie is a blockbuster, the other a disaster. If one were to do an economic analysis, one would probably conclude that, given the unlikelihood of success, it is hardly ever worth publishing a book or producing a play or a movie. It is precisely because the chance of success is so small that we have to make the reward for success great. The copyright industries are made up,

185. Brief of George A. Akerlof et al. as Amici Curiae in Support of Petitioners (Economist Brief) at 2, *Eldred v. Ashcroft*, No. 01-618.

186. *Id.* at 9.

to a large extent, of what the economists call “sub-par projects,” and it would be a mistake to leave to the economists the choice of which works to subsidize.

b. the petitioners’ brief

Petitioners make an argument similar to that contained in the economists’ brief, that the cost to society of “withholding” lots of copyrighted works exceeds the “gain” to be realized by those few copyright holders who have “surviving works” (defined by petitioners as “works that continue to earn a royalty”).¹⁸⁷ The argument is fallacious.

The petitioners effectively divide all works into two categories: those that have commercial viability, and those that do not. For those that do not have commercial viability after dozens of years—the vast majority of works—there really is not much cost in tying them up in copyright or otherwise. We might as well leave them in the control of people who have a sentimental or other noncommercial interest in them, since such people are more likely to preserve or disseminate the works. The works that second-comers are most interested in reproducing, however, are precisely the same surviving works that have commercial viability to the original creators or their heirs. Assuming that a given work has some remaining commercial viability, then, it is a worthwhile question to ask: Is it more “fair” to grant whatever value there may be to the creators, their heirs, or the company that absorbed the initial cost and took the initial risk in creating the work, or to pass the remaining commercial value to the free-rider who waits until a work’s commercial success is proven, and then jumps in to take advantage? But, of course, economic analysis does not factor in what is fair. Maybe that is why Congress does not particularly limit itself to economic analysis in deciding who should control the further dissemination of creative works.

Many or most of the works that petitioners want to distribute are of course the “successful” works that are already available to the public. For example, Kahlil Gibran’s *The Prophet*, which, we are told, Dover anxiously wants to publish,¹⁸⁸ is already available in many editions, including a new hardcover copy on amazon.com for

187. Petitioners Brief, *supra* note 21, at 7.

188. *See id.* at 3.

\$10.50, or a paperback edition for \$5.98.¹⁸⁹ Some works are indeed out of print in this country; petitioners' intellectual property law professors' brief highlights the out-of-print status of H. G. Wells's 1933 novel, *The Shape of Things to Come*.¹⁹⁰ However, they seem not to appreciate the ease with which copies of even out-of-print books can be obtained in the days of the Internet. Amazon U.K. lists a paperback edition for £4.79.¹⁹¹ Under the Supreme Court's ruling in *Quality King Distributors, Inc. v. L'anza Research International, Inc.*,¹⁹² it is not a violation of anyone's copyright to order individual copies of copyrighted works from other countries.

Indeed, under the first sale doctrine, copies of works that have been legitimately sold in this country may be resold, and even out-of-print works may be obtained at specialty sites such as abe.com ("Advanced Book Exchange").¹⁹³ As of the middle of June, abe.com listed ninety-five available copies of *The Shape of Things to Come*, including some for as little as \$7, and forty-five from U.S. sources for as little as \$10.¹⁹⁴

11. Congressional hearings

Petitioners' law professors quote the Register of Copyrights suggesting that anti-copyright forces may not have shown up at the Copyright Office hearings of 1993, perhaps because "legislation did not appear on the horizon."¹⁹⁵ The implication of the quote is that somehow the bill slipped its way through the legislative process without a complete review of the issues. By the time the bill was reported to Congress, however, it had been given a very complete review, totaling over 1000 pages of statements and appendices presented in hearings. The Senate Judiciary Committee held hearings in

189. See amazon.com website, at www.amazon.com/exec/obidos/search-handle-form/102-6988454-2850526 (last visited Aug. 17, 2002).

190. See Intellectual Property Professors Brief Supporting Petitioners, *supra* note 144, at 2-3.

191. See amazon.co.uk website, at www.amazon.co.uk/exec/obidos/search-handle-form/026-8911185-2293237 (last visited Aug. 17, 2002).

192. 523 U.S. 135 (1998).

193. See abebooks.com website, at <http://www.abe.com> (last visited Aug. 8, 2002).

194. See *id.*

195. Intellectual Property Professors Brief Supporting Petitioners, *supra* note 144, at 3.

1995 solely on the issue of term extension.¹⁹⁶ The House Judiciary Committee's Subcommittee on Courts and Intellectual Property held hearings in 1995 in Los Angeles, Washington, D.C, Nashville, and online.¹⁹⁷ Many of the same law professors who participated in the preparation of the brief also presented a statement opposing term extension; and the Senate Report contained minority views. The minority view of Senator Brown extensively recites some of the same arguments presented in the *Eldred* case, so it can hardly be argued that Congress was not fully informed of the opposition to term extension.

Petitioners and several amici suggest that Congress passes whatever legislation the entertainment industries ask them to pass. This would come as news to these industries. For example, James Lardner documents how the movie industries were rebuffed by Congress in their efforts to get either a home-taping royalty or an exemption from the first sale doctrine to cover movie rentals.¹⁹⁸

III. CONCLUSION

The various extensions of copyright over the years, balanced by careful limitations on the rights of copyright owners, are not the result of some nefarious scheme by corporations to cheat the public of their rights. Rather, they are part of the remarkable system envisioned by the framers of the Constitution, and implemented by the Congress and the President, to "promote the Progress of Science and useful Arts"¹⁹⁹ by doing exactly what the Constitution says they are supposed to do, "by securing, for limited Times, to Authors and Inventors, the exclusive Right to their respective Writings and

196. See *The Copyright Term Extension Act of 1995: Hearing on S. 483 Before the Subcomm. on Courts and Intellectual Property of the Comm. on the Judiciary*, 104th Cong. (1995).

197. See *Copyright Term, Film Labeling, and Film Preservation Legislation, June 1 & July 13, 1996: Hearing on H.R. 989, H.R. 1248 and H.R. 1734 Before the Subcomm. on Courts and Intellectual Prop. of the Comm. on the Judiciary*, 104th Cong. (1995); *Pre-1978 Distribution of Recordings Containing Musical Compositions; Copyright Term Extension; and Copyright per Program Licenses: Hearing Before the Subcomm. on Courts and Intellectual Property of the Comm. on the Judiciary*, 105th Cong. (1997).

198. See JAMES LARDNER, *FAST FORWARD: HOLLYWOOD, THE JAPANESE, AND THE ONSLAUGHT OF THE VCR* (1987).

199. U.S. CONST. art. I, § 8, cl. 8.

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Discoveries.”²⁰⁰ The Supreme Court should not accept petitioners’ novel theory that would limit Congress in its ability to continue balancing the interests of copyright owners with the interests of copyright users.

200. *Id.*