THIS CASE IS SCHEDULED FOR ORAL ARGUMENT ON MARCH 10, 2005

IN THE
UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 04-5240

LUCK'S MUSIC LIBRARY, INC.
AND MOVIECRAFT, INC.,

Plaintiffs-Appellants,

v.

JOHN D. ASHCROFT, ATTORNEY GENERAL OF THE UNITED STATES AND MARYBETH PETERS,
REGISTER OF COPYRIGHTS, COPYRIGHT OFFICE OF THE UNITED STATES,

Defendants-Appellees.

On Appeal from the United States District Court
for the District of Columbia (D.D.C. No. 01-2220)

BRIEF FOR APPELLANTS

Of Counsel:

JONATHAN L. ZITTRAIN
THE BERKMAN CENTER FOR
INTERNET & SOCIETY
1563 Massachusetts Avenue
Cambridge, MA 02138
(419) 831-9295

GEOFFREY S. STEWART
DANIEL H. BROMBERG
CARMEN M. GUERRICAGOITIA
SABRINA UNDERWOOD
JONES DAY
51 Louisiana Avenue, N.W.
Washington, DC 20001
(202) 879-3939
(202) 626-1700 (fax)

Counsel for Appellants Luck's Music Library, Inc. and Moviecraft, Inc.

CERTIFICATE AS TO PARTIES, RULING, AND RELATED CASES

Plaintiffs-appellants Luck's Music Library, Inc. and Moviecraft, Inc. respectfully submit, pursuant to Circuit Rule 28(a)(1), the following certificate as to parties, rulings, and related cases.

A. Parties and Amici

The parties appearing in the District Court were plaintiffs Luck's Music Library, Inc. and Moviecraft, Inc. and defendants John D. Ashcroft and Marybeth Peters. There were no intervenors or amici.

Luck's Music Library, Inc. is a corporation organized under the laws of the State of Michigan that rents and sells orchestral sheet music. It has no parent companies, and no publicly held company has a ten percent or greater ownership interest in Luck's Music.

Moviecraft, Inc. is a corporation organized under the law of the State of Illinois. It operates a commercial film archive, which preserves, restores, and sells films and other footage. It has no parent companies, and no publicly held company has a ten percent or greater ownership interest in Moviecraft.

B. Ruling under Review

This appeal is from an Order of June 10, 2004 issued by the Honorable Ricardo M. Urbina dismissing appellants' claims and a related memorandum opinion issued that same day and amended on June 16, 2004. The official citation for the opinion is 321 F. Supp. 2d 107.

C. Related Cases

There are no related cases pending in any court in the District of Columbia or in any other United States court of appeals.

Respectfully submitted,

Daniel H. Bromberg
Geoffrey S. Stewart
Carmen M. Guerricagoitia
Sabrina Underwood
JONES DAY
51 Louisiana Avenue, N.W.
Washington, D.C. 20001
(202) 879-3939
(202) 626-1700 (fax)

Attorneys for Appellants
Luck's Music Library, Inc. and Moviecraft, Inc.

Dated: November 23, 2004

TABLE OF CONTENTS

Page

TABLE OF CONTENTS
(continued)

Page

TABLE OF CONTENTS
(continued)

Page

TABLE OF AUTHORITIES

Page

CASES

* Authorities principally relied upon.

TABLE OF AUTHORITIES
(continued)

Page

* Authorities principally relied upon.

TABLE OF AUTHORITIES
(continued)

Page

STATUTES

* Authorities principally relied upon.

TABLE OF AUTHORITIES
(continued)

Page

LEGISLATIVE HISTORY

MISCELLANEOUS

* Authorities principally relied upon.

TABLE OF AUTHORITIES
(continued)

Page

* Authorities principally relied upon.

TABLE OF AUTHORITIES
(continued)

Page

* Authorities principally relied upon.

TABLE OF AUTHORITIES
(continued)

Page

* Authorities principally relied upon.

GLOSSARY

GATT	General Agreement on Tariffs and Trade
NIE	Notice of Intent to Enforce
URAA	Uruguay Round Agreements Act

INTRODUCTION

Section 514 of the Uruguay Round Agreements Act, 17 U.S.C. § 104A, grants copyright protection over certain foreign works dedicated by previous copyright laws to the free use and enjoyment of the public. As a result, thousands, if not millions, of works have been removed from the public domain, including a trove of twentieth century Russian music, novels from Joseph Conrad and George Orwell, paintings from Picasso, drawings, photographs, and films. This copyright "restoration" provision is unprecedented and unconstitutional. The Constitution's Intellectual Property Clause, which contains the most carefully circumscribed grant of power in the Constitution, requires that all works subject to patent or copyright protection eventually be dedicated to the public. As the Supreme Court recognized nearly forty years ago in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), once a work enters this public domain and becomes the common property of the public, Congress cannot remove it from that domain.

Although the lower court recognized the prohibition on removing works from the public domain in the patent context, it nonetheless upheld the constitutionality of Section 514 on the ground that the prohibition applies only to patents and not to copyrights. This was error. The Intellectual Property Clause governs copyrights as well as patents. In addition, the language in the Clause prohibiting removal of works from the public domain, the historical origins and underlying purpose of the Clause, and the nature of the rights it confers upon the public all apply to copyrights as well as patents. Thus, the Clause prohibits copyright laws that remove works from the public domain, and Section 514 violates that prohibition. Accordingly, the decision below should be vacated, and this case remanded for further proceedings.

JURISDICTIONAL STATEMENT

The District Court had subject matter jurisdiction under 28 U.S.C. §§ 1331 & 1361 because this action seeks a declaration that portions of a federal statute are unconstitutional and

an injunction against its enforcement. The District Court granted defendants' motion to dismiss and entered final judgment on June 10, 2004. A timely notice of appeal was filed on June 25, 2004. This Court has appellate jurisdiction under 28 U.S.C. § 1291.

STATEMENT OF THE ISSUE

Whether the provisions of the Uruguay Round Agreements Act granting copyrights over works in the public domain violate the Intellectual Property Clause and are therefore unconstitutional.

PERTINENT CONSTITUTIONAL AND STATUTORY PROVISIONS

The Intellectual Property Clause grants Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const., art. I, § 8, cl. 8. Section 514 of the Uruguay Round Agreements Act provides in pertinent part that "[c]opyright subsists . . . in restored works," 17 U.S.C. § 104A(a)(1), which are defined as certain works "in the public domain in the United States." *Id.* § 104A(h)(6). The complete text of Section 514 and the texts of other statutes cited in this brief are reprinted in the addendum.

STATEMENT

A. The URAA's Copyright Restoration Provisions

Section 514 of the Uruguay Round Agreements Act ("URAA"), Pub. L. No. 103-465, 108 Stat. 4976-81 (1994) (codified at 17 U.S.C. § 104A), implements Article 18 of the Berne Convention. According to that article, the 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." Berne Convention for the Protection of Literary and Artistic Works, July 24, 1971, art. 18(1), 828 U.N.T.S. 221, 251. When the United States joined the Berne Convention in 1988, Congress found that "[t]he question of whether and,

if so, how Congress might provide retroactive protection to works now in the public domain raises difficult questions, possibly with constitutional dimensions." H.R. Rep. No. 100-609, at 51 (1988). Accordingly, invoking its discretion under the Convention, *see* Berne Convention, art. 18(3), 828 U.N.T.S. at 251, Congress declined to confer copyrights upon works in the public domain in this country. *See* Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 12, 102 Stat. 2853, 2860 (1988).

In 1994, in connection with the Uruguay Round negotiations of the General Agreement on Tariffs and Trade (GATT), Congress decided to confer such protection. It did not do so because it believed the United States was obligated under the Berne Convention to "restore" foreign copyrights. *See Joint Hearing on H.R. 4894 and S. 2368 before the Subcomm. on Intellectual Property and Judicial Administration and the Subcomm. on Patents, Copyrights, and Trademarks*, 103d Cong., Aug. 12, 1994, at 2 (1994) [hereinafter *URAA Hearing*]. Nor did it consider whether restored copyrights are constitutionally permissible. Indeed, there was no mention of the constitutionality of copyright "restoration" in the House and Senate reports, or the Statement of Administrative Action submitted by the Clinton Administration, *see* 4 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 18.06[C][2], at 18-77 to 18-81 (2004), and only one witness before Congress testified briefly on the issue. *See URAA Hearing* at 187-89.

Congress focused instead on the trade benefits of restoring copyrights. A representative of the Office of the Trade Representative, which drafted Section 514, testified that many American works were in the public domain in other countries and that the United States had "little credibility" in requesting copyright protection for these works without offering similar protection to foreign works in the public domain here. *Id.* at 131, 137. Noting that over $2 billion a year were being lost in countries such as Russia, Turkey, and Saudi Arabia, *see id.* at

241, 248-51, 253-58, industry representatives similarly urged Congress to "restore" foreign copyrights to "set [] a standard in the GATT for how our trading partners must implement their obligations to protect these important and valuable copyrights." *Id.* at 246.

Following these recommendations, Congress enacted Section 514 of the URAA, which provides that "[c]opyright subsists . . . in restored works, and vests automatically on the date of restoration." 17 U.S.C. § 104A(a)(1). Section 514 defines a "restored work" to be a work which was first published abroad by a foreign author, whose term has not expired in its source country, and which is in the public domain here for one of three reasons:

> (i) noncompliance with formalities imposed at any time by United States copyright law, including the failure of renewal, lack of proper notice, or failure to comply with any manufacturing requirements;
>
> (ii) lack of subject matter protection in the case of sound recordings fixed before February 15, 1972; and
>
> (iii) lack of national eligibility . . . .

Id. § 104A(h)(6). Section 514 also requires the holder of a "restored" copyright to provide parties who used a work before its removal from the public domain with a notice of intent to enforce the restored copyrights (NIE) before claiming infringement. *See id.* § 104A(d)(2) & (h)(4).

Section 514 removes thousands, if not millions, of works from the public domain. JA 8. It covers, for example, all Russian works published before 1973 because those works lacked "national eligibility" until the Soviet Union afforded American authors copyright protection in that year. *See* U.S. Copyright Office, *Circular 38a -- International Copyright Relations of the United States* at 9, *available at* http://www.copyright.gov/circs/circ38a.html. Section 514 also covers all foreign sound recordings published before the United States afforded copyrights to such recordings in 1971. *See* Sound Recordings Act of 1971, Pub. L. No. 92-140, 85 Stat. 391. Finally, it covers numerous foreign works – including paintings by Picasso; drawings by M.C. Escher; novels by Joseph Conrad, George Orwell, J.R.R. Tolkien, H.G. Wells, and Virginia

Woolf; and T.S. Elliot's *The Wasteland* – in the public domain here due to failure to satisfy formalities such as notice and registration previously required by American copyright law. JA 7-8. It should come as no surprise then that over 45,000 NIEs have been filed with the Copyright Office. *See* Notices of Restored Copyrights, *available at* http://www.copyright.gov/gatt.html (listing notices).

B. Plaintiffs Luck's Music and Moviecraft

Plaintiff Luck's Music Library, Inc. is a family-owned business that sells sheet music to orchestras ranging from the elementary to the operatic. JA 9. Before the URAA, the Luck's Music catalog included works from Russian composers such as Stravinsky, Prokofiev, and Shostakovitch, which were very popular. JA 9-10. After the URAA, Luck's Music received NIEs for several hundred works, primarily by Russian composers. JA 10. Because Luck's Music cannot afford to contest the validity of these notices, it has stopped selling these works. JA 10-11. Since then, the price of these works has skyrocketed: indeed, the cost of renting a score for a single performance is now more than Luck's Music charged for selling it outright. JA 10. As a result, many community orchestras have been forced to drop from their repertoires the pieces previously sold by Luck's Music. JA 11.

Plaintiff Moviecraft, Inc. is a film archive that specializes in preserving public domain films. JA 11-12. Its archive contains approximately 40,000 titles and 200,000 elements such as negatives and reels, including theatrical and industrial films, shorts, newsreels, historical subjects, and television features. JA 11. Many of these films are in need of expensive restoration and preservation. *Id.* To pay for this, Moviecraft sells footage for use in features, documentaries, and commercials. *Id.* The URAA prevents Moviecraft from using thousands of foreign films in this manner. JA 12. Even though Moviecraft has not received many NIEs, it cannot sell foreign footage for use in new films because it cannot afford to clear that footage of

potential infringement claims. JA 12-13. Consequently, Moviecraft cannot afford to restore and preserve most of the foreign films in its archive, and those films may be lost forever. *Id.*

C. The Proceedings Below

In October 2001, Luck's Music and Moviecraft sued the Attorney General and the Register of Copyrights in their official capacities for, among other things, a declaration that Section 514 is unconstitutional. JA 14. Defendants filed a motion to dismiss, which was stayed pending the Supreme Court's decision in *Eldred v. Ashcroft,* 537 U.S. 186 (2003). After that decision was issued – and without holding oral argument – the district court granted the motion on the ground that Section 514 is a constitutional exercise of Congress' authority under the Intellectual Property Clause. *See* JA 23-34; *see also* JA 34-35 (finding no First Amendment violation).

The court held that Section 514 does not violate the Intellectual Property Clause based upon a "history of retroactive copyrighting . . . tracing back to the founding of the United States." JA 24. In particular, the court found that the Copyright Act of 1790, which conferred copyright over already printed books, maps, and charts, removed works from the public domain because not all states had operative copyright statutes at that time, and there was no common law copyright. JA 25-27. The court also reasoned that 1919 and 1941 statutes, extending the time to register works published abroad during the World Wars, removed works from the public domain because works published abroad are "automatically part of the public domain." JA 27-29.

In concluding that Congress can remove works from the public domain, the district court did not examine the language of the Intellectual Property Clause, its history, or the nature of the public domain. In addition, although it acknowledged that the Supreme Court's decision in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), forbids Congress from issuing patents that restrict access to materials in the public domain, JA 29-30, it found *Graham* "concerns specific

requirements unique to patent law," namely, the "patent statute's novelty requirement, which differs fundamentally from the copyright statute's requirements." JA 30-31.

SUMMARY OF ARGUMENT

The lower court erred in upholding the constitutionality of the copyright restoration provisions in Section 514 of the URAA. Those provisions violate the Intellectual Property Clause and are therefore unconstitutional because they purport to confer exclusive rights over works dedicated to the public by prior copyright laws.

1. In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Supreme Court recognized that the Intellectual Property Clause prohibits Congress from enacting laws that remove materials from the public domain. As numerous courts have observed, this prohibition applies to copyrights as well as patents.

The prohibition against removing works from the public domain is implicit in the text of the Intellectual Property Clause. That Clause specifies both the goal of patent and copyright laws – stimulating creativity – and the means by which to accomplish that goal – granting exclusive rights (which provides financial incentives to create new works) and limiting the duration of those rights (which reduces the cost of creating new works by creating a public domain of freely usable works). Laws that remove works from the public domain violate these requirements. First, such laws do not stimulate creativity. Rewarding an author with exclusive rights over existing works does not change the costs and benefits of creating new works and therefore does not provide a significant incentive creating such works. In addition, removing existing works from the public domain and assigning exclusive rights to them increases the cost of creating new works because literary and scientific works are never entirely original and therefore always build upon prior works. Second, even if in some unusual, roundabout fashion a law removing works from the public domain were to stimulate the creation of new works, it

would not do so through the means mandated by the Intellectual Property Clause because it would not provide financial incentives to create new works and would contract rather than expand the public domain. Thus, laws that remove works from the public domain violate the Intellectual Property Clause.

This conclusion is supported by the history and underlying purpose of the Intellectual Property Clause. The Founders drafted the Clause against the historical backdrop of the English Crown's abuse of its power to grant monopolies. Although that power was initially used for the salutary purpose of fostering new industries, the Crown eventually began to grant monopolies over existing goods and industries to generate revenue and reward court favorites. Just as the courtiers in Elizabethan England had an inherent advantage in dealing with the Crown, private interests seeking to remove works from the public domain have a systematic advantage in the legislative process. As a consequence, Congress cannot be trusted to identify the presumably very rare cases in which removing works from the public domain will stimulate creativity and promote the public interest. Moreover, because copyright legislation is reviewed very deferentially, courts cannot be expected to strike down copyright laws that unwisely remove works from the public domain in the absence of a bright line rule against such laws. Thus, a blanket prohibition against removing works from the public domain is a needed structural safeguard.

The prohibition against removing works from the public domain is also supported by the nature of the public's interest in works in that domain. As the Supreme Court has recognized, when a work fails to qualify for patent or copyright protection, or the duration of that protection expires, the work enters the public domain, and the right to use the work passes to the public. Because works in the public domain are owned by the public in common and not by the

government – and because free access to such materials encourages both artistic creativity and scientific innovation – Congress should not be permitted to remove works from that domain.

2. Section 514 of the URAA plainly violates the prohibition against removing works from the public domain by conferring copyrights over "restored works" that by definition are "in the public domain." Section 514 also demonstrates the wisdom of the prohibition against removing works from the public domain: even though the URAA removes thousands, if not millions, of works from that domain, Congress did not even consider the effect of the statute on the public domain and the incentives for creating new works.

3. The lower court erred in upholding the constitutionality of Section 514. Most importantly, it failed to offer any persuasive reason why *Graham*'s prohibition on removing works from the public domain should be applied to patents but not copyrights. The court clearly erred in asserting that *Graham* is based upon the patent statute's novelty requirement: *Graham* derived the prohibition against removing works from the public domain from the Intellectual Property Clause, not the patent statute. Moreover, far from suggesting otherwise, *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), recognizes that the policies underlying that Clause applies to copyrights as well as patents.

The lower court also erred in finding a consistent and unchallenged congressional practice of removing works from the public domain. The Copyright Act of 1790 did not remove works from the public domain. Although it conferred copyrights over previously published works, in keeping with contemporaneous recognition of common law copyright, the Act assumed that those works were protected by copyright. In addition, there was no public domain for purposes of the Intellectual Property Clause when the 1790 Act was passed because that domain is created when works are dedicated to the public by federal copyright laws. The 1919 and 1941

statutes cited below also did not remove any works from the public domain: although both statutes amended the 1909 Copyright Act, neither altered Section 7 of that act, which specifically prohibited conferring copyright over works in the public domain. Even more importantly, there clearly was no consistent and unchallenged congressional tradition of removing works from the public domain. As the 1831, 1909, and 1976 Copyright Acts demonstrate, Congress traditionally has prohibited removal of works from the public domain. Furthermore, Congress' authority to remove works from the public domain has been challenged for more than 175 years.

4. The copyright restoration provisions in Section 514 are not saved by either the Treaty Power or the Commerce Clause. Statutes implementing international treaties are subject to the same constitutional prohibitions as other statutes, and the Commerce Clause cannot be used to circumvent the specific restrictions imposed by the Intellectual Property Clause.

STANDARD OF REVIEW

The lower court's order granting the Government's motion to dismiss is reviewable *de novo*. *See, e.g., Wilson v. Pena*, 79 F.3d 154, 160 n.1 (D.C. Cir. 1996).

ARGUMENT

I. THE INTELLECTUAL PROPERTY CLAUSE PROHIBITS CONGRESS FROM GRANTING COPYRIGHTS OVER WORKS IN THE "PUBLIC DOMAIN" CREATED BY PRIOR COPYRIGHT LAWS

Nearly forty years ago the Supreme Court recognized that "Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available." *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966). Other courts – including this one – have recognized that this prohibition on removing works from the public domain applies to copyrights as well as patents. *See, e.g., Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 192 (1896) (noting that, once a book's copyright has expired, "the public shall be entitled *ever afterwards* to the unrestricted use of the book") (quotation

omitted) (emphasis added); *see also Eldred v. Reno*, 239 F.3d 372, 377 (D.C. Cir. 2001) ("Applied *mutatis mutandis* to the subject of copyright, [*Graham*] would indeed preclude the Congress from authorizing under [the Intellectual Property Clause] a copyright to a work already in the public domain."), *aff'd*, 537 U.S. 186 (2003).[1] In holding that Congress may "restore" copyrights to works committed to the public by prior copyright laws, the lower court sharply – and erroneously – departed from this precedent.

A. The Intellectual Property Clause Imposes Stringent Restrictions Upon Congress' Power to Grant Copyrights, Which Prohibit Laws Removing Works from the Public Domain

Congress' authority to grant patents and copyrights is governed by the Intellectual Property Clause, which gives Congress the power "[t]o promote the Progress of Science and useful Arts by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const., art. I, § 8, cl. 8. This is "both a grant of power and a limitation." *Graham*, 383 U.S. at 5. Indeed, the Intellectual Property Clause contains the most textually circumscribed grant of power in the Constitution: while some other grants specify the purpose for which a power may be exercised,[2] or restrict the manner in which

---

1 *Accord Mayhew v. Allsup*, 166 F.3d 821, 822 (6th Cir. 1999) (if a work was published without a proper notice, it "*irretrievably* entered the public domain.") (emphasis added); *Dolman v. Agee*, 157 F.3d 708, 713 (9th Cir. 1998) (if work failed to satisfy the Copyright Act's requirements, it "was injected *irrevocably* into the public domain") (emphasis added); *Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162, 1166 (9th Cir. 1996) (work published without proper notice "fell into the public domain, precluding *forever* any subsequent copyright protection of the published work.") (emphasis added); *Dow Jones & Co. v. Bd. of Trade of City of Chicago*, 546 F. Supp. 113, 116 n.5 (S.D.N.Y. 1982) ("[W]hen a work has been injected into the public domain, all of its copyright protection is lost permanently."); *Letter Edged in Black Press, Inc. v. Park Bldg. Comm'n of Chicago*, 320 F. Supp. 1303, 1310 (N.D. Ill. 1970) (finding work "forever lost to the public domain") (emphasis added); *Merriam v. Holloway Publ'g Co.*, 43 F. 450, 451 (C.C.E.D. Mo. 1890) (Miller, J.) (upon expiration of book's copyright, "the public shall be entitled *ever afterwards* to the unrestricted use of the book") (emphasis added); *Thompson v. Haight*, 23 F. Cas. 1040, 1047 (C.C.S.D.N.Y. 1826) (noting that Congress "cannot deprive the public of what it possesses, to give it to an individual"). *See also infra* pp. 40-41 (citing treatises recognizing this prohibition).

2 *See* U.S. Const., art. I, § 8 cl. 15 (permitting the militia to be called to execute federal laws, suppress insurrections, and repel invasions); *id.*, art. I, § 8, cl. 1 (providing that taxes, duties, imposts, and excises may only be imposed for the "general Welfare of the United States").

a power may be exercised,[3] no other constitutional provision requires Congress to exercise a power for such a specific goal while using such precisely delineated means. Moreover, laws purporting to remove works from the public domain do not satisfy these requirements.

1. The Intellectual Property Clause Requires Copyright Laws to Serve the Goal of Stimulating Creativity

The Intellectual Property Clause authorizes Congress to enact copyright laws to promote the progress of "Science," U.S. Const., art. I, § 8, cl. 8, by which the Founders meant knowledge or learning. *See* Edward C. Walterscheid, *The Nature of the Intellectual Property Clause: A Study in Historical Perspective* 125 (2002). In light of this goal, any benefit that copyright laws confer upon authors is "a secondary consideration." *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948). The primary consideration is instead "to induce release to the public of the products of [the author's or artist's] creative genius." *Id.* (citing *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932)). Thus, the "ultimate aim" of copyright law is "'to stimulate artistic creativity for the general public good.'" *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 526-27 (1994) (quoting *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975)); *see also Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 450 (1984) ("The purpose of copyright is to create incentives for creative effort.").

2. The Intellectual Property Clause Requires Copyright Laws To Stimulate Creativity Through Two Mechanisms

In addition to requiring copyright laws to stimulate the production of new creative works, the Intellectual Property Clause specifies the "means to achieve" that goal. *Goldstein v. California*, 412 U.S. 546, 555 (1973). It requires copyright laws to confer upon "Authors and

3 *See* U.S. Const. art. I, § 8, cl. 1 (requiring uniform duties, imposts, and excises); *id.* cl. 4 (requiring uniform bankruptcy laws); *id.* cl. 12 (requiring military appropriations to be for less than two years).

Inventors the exclusive Right to their respective Writings and Discoveries," and to restrict such rights to "limited Times." U.S. Const., art. I, § 8, cl. 8.

a. Granting Exclusive Rights. The first mechanism required by the Intellectual Property Clause, granting exclusive rights to authors, stimulates creativity by providing a financial incentive for creating new works. When an author (either by himself or through a publisher) sells a book, he incurs both the cost of creating the work and the cost of producing and distributing copies of it. *See, e.g.*, William M. Landes & Richard A. Posner, *The Economic Structure of Intellectual Property Law* 37 (2003). If permitted to copy an author's work, competitors would incur only production and distribution costs and might therefore be able to charge much less for the work. *See id.* at 40. If this cost advantage were great enough, it would prevent the author from recouping the cost of creating the work, in which case a rational author would choose not to create new works in the first place. *See id.* Thus, by granting authors exclusive rights over their works, copyright laws help to "secure a fair return for an 'author's' creative labor" and thereby encourage the creation of new works. *Twentieth Century Music Corp.*, 422 U.S. at 156; *accord Sony Corp.*, 463 U.S. at 450.

b. Limiting the Duration of Copyrights and Creating a Public Domain. The second mechanism required by the Intellectual Property Clause, limiting the duration of exclusive rights, stimulates creativity by reducing the cost of creating new works. By permitting exclusive rights to be granted for only "limited Times," the Clause prevents an author, and anyone claiming rights under her, from excluding others from using a work once a copyright expires. *See, e.g.*, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33-34 (2003). Similarly, when a work fails to qualify for exclusive rights, the public is free to use the work. *See, e.g.*, *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964). Thus, the Intellectual Property

Clause requires that any work subject to the exclusive rights conferred by copyright law eventually be dedicated to the public's free use and enjoyment.

The public domain created in this fashion reduces the cost of producing new works. As Judge Kozinski has observed, "[n]othing today . . . is genuinely new: Culture, like science and technology, grows by accretion, each new creator building on the works of those who came before." *White v. Samsung Elecs. Am. Inc.*, 989 F.2d 1512, 1514 (9th Cir. 1993) (Kozinski, J., dissenting from the denial of rehearing en banc); *see also* Northrop Frye, *Anatomy of Criticism: Four Essays* 97 (1957) ("[p]oetry can only be made out of other poems; novels out of other novels"). Thus, "[c]reating a new expressive work typically involves borrowing or building on material from a prior body of works, as well as adding original expression to it." Landes & Posner, *The Economic Structure of Intellectual Property Law* 66-67. By limiting the duration of the exclusive rights conferred by copyright laws and requiring Congress eventually to dedicate covered works to public use, the Intellectual Property Clause creates a public domain from which artists may freely draw, thereby stimulating creativity by reducing the cost of producing new works. *See id.*

This public domain plays a crucial role in the creation of certain works. *See id.* at 69. Although the fair use doctrine and the idea/expression distinction permits limited borrowing from works protected by copyright, artists often need to borrow more to create certain works. For example, some authors rework prior works and vastly improve them. Shakespeare borrowed plots, characters, and sometimes even language from existing plays, histories, and biographies. *See, e.g.*, Emrys Jones, *The Origins of Shakespeare* 123-24 (1977); *see also* Landes & Posner, *The Economic Structure of Intellectual Property Law* 58-59 (discussing Anthony's funeral oration in *Julius Caesar*). Chaucer borrowed stories from prior authors, *see* Landes & Posner,

The Economic Structure of Intellectual Property Law 60, and other noted artists such as T.S. Eliot, John Milton, and James Joyce have based works upon large scale (and therefore unprotected) borrowings from prior authors. *See id.* at 59-61.

Other art forms are also frequently based upon large scale borrowing. Plays are often made out of novels, musicals out of plays, and movies out of musicals (as well as books, plays, and other movies), and vice versa. *See id.* at 68. Musicians routinely perform pieces composed by others, often adding their own arrangements or improvisations. *See, e.g.*, J. Michael Keyes, *Musical Musings: The Case for Rethinking Music Copyright Protection*, 10 Mich. Telecomm. Tech. L. Rev. 407, 426-30 (2004). Classical composers used folk melodies or dances in their compositions, *see* Landes & Posner, *The Economic Structure of Intellectual Property Law* 67, and rap music frequently "samples" existing music. *See, e.g.*, Jason H. Marcus, *Don't Stop that Funky Beat: The Essentiality of Digital Sampling to Rap Music*, 13 Hastings Comm. & Ent. L.J. 767, 770 (1991). Finally, using hypertext technology, scholars and historians combine books, diaries, letters, posters, songs, recorded interviews and other works into multimedia art forms. *See, e.g.*, *Documenting the American South*, *available at* http:\\docsouth.unc.edu. Limiting the duration of copyright encourages the creation of these derivative works by enabling authors to assemble them without devoting crippling time and expense to clearing copyrights for the works from which they borrow.

Free access to prior works also plays a crucial role in the development of science and technology. Scientific and technological innovation "consists to a substantial extent of a recombination of conceptual and physical materials that were previously in existence." Richard R. Nelson & Sidney G. Winter, *An Evolutionary Theory of Economic Change* 130 (1982). For example, computer software, which is generally copyrightable, *see* 1 Raymond T. Nimmer, *Law*

of Computer Technology § 1.3, at 1-9 to 1-10 (2003), is usually developed "via a mix of new coding, modifications to some existing modules, and subroutines, and either literal or functional reuse of others." Julie E. Cohen & Mark A. Lemley, *Patent Scope and Innovation in the Software Industry*, 89 Cal. L. Rev. 1, 41 (2001). Consequently, when computer programmers have free access to existing software, the cost of developing new software is reduced, and the rate of innovation increased, dramatically. *See, e.g.*, James Bessen, *Open Source Software: Free Provision of Complex Public Goods* at 4-8, *available at* http://www.researchoninnovation.org/online.htm#oss. Recognizing this, companies such as IBM and Microsoft are now investing millions of dollars each year in developing "open code" software, in which the source code that governs the software is shared on the understanding that users will share any patches or other modifications they make. *See* Steve Lohr, *Speech Code from I.B.M. to Become Open Source*, N.Y. Times, Sept. 13, 2004, at C4; Ina Fried, *Microsoft goes open source,* Silicon.com, 2004 WL 77881565 (May 14, 2004).[4] Thus, a public domain of works freely accessible to the public spurs scientific and technological innovation as well as contributing to the development of a rich and vibrant culture.

4 The powerful effect that free access can have on innovation is demonstrated by the rapid development of the Internet. *See, e.g.*, Lawrence Lessig, *The Future of Ideas* 36-72 (2001). The basic protocols for the Internet were developed by government officials and have always been in the public domain, *see id.* at 55, and the developer of the World Wide Web, the set of protocols for serving, retrieving, and displaying documents on Internet websites, released those protocols into the public domain *See id.* at 41-44. Other key software governing Internet servers, mail routing, manipulation of text, and identification of users has similarly been developed through "open code" projects in which users are allowed free access to the source code for that software. *See id.* at 55-56; *see also id.* at 54-55 (discussing the Linux system). The free availability of this information lowered the barriers to entry for innovators and allowed the Internet to develop quickly and freely in ways that could not have been anticipated when the original protocols for the system were developed. *See id.* at 68-72.

3. Copyright Laws that Remove Works from the Public Domain Neither Serve the Goal of Stimulating Creativity Nor Employ the Mechanisms Prescribed by the Intellectual Property Clause

Copyright laws that remove works from the public domain violate the Intellectual Property Clause because they do not stimulate creativity. Although such laws reward authors for past creations, they do not provide significant incentives for new creations. When an author is dead, or has lost his muse and is no longer interested in creating new works, providing exclusive rights over an existing work will not encourage new works, no matter how economically valuable those rights may be. Moreover, even where an author is alive and still at the height of his or her creative powers, rewarding prior work will not provide any significant incentive to create new works because it will not change the costs and benefits of doing so. *See, e.g.*, William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law,* 18 J. Legal Stud. 325, 343 (1989). On the other hand, by taking works out of the public domain and assigning exclusive rights over them, copyright restoration laws deny future authors free access to those works, thereby increasing the cost of creating new works. *See id.* Thus, far from encouraging creativity, laws removing works from the public domain discourages it.

For similar reasons, laws removing existing works from the public domain violate the Intellectual Property Clause because they do not employ either of the mechanisms prescribed by the Clause. As just noted, such laws do not offer any reward for creating new works, and far from dedicating works to the public, copyright restoration laws take works out of the public's hands and place them in private hands empowered to exclude the public and extract rents from it. Thus, even if in some roundabout way a law removing works from the public domain were to encourage future creativity, it would be unconstitutional because it does not employ the mechanisms prescribed by the Intellectual Property Clause.

B. The Prohibition Against Laws Removing Works from the Public Domain Safeguards Against the Abuses that Led the Founders to Impose the Intellectual Property Clause's Strict Limits

The history and underlying purpose of the Intellectual Property Clause support a bright line rule against removing works from the public domain because such a rule provides a structural safeguard against the abuses that prompted the Founders to impose the Clause's stringent restrictions on Congress' power to grant patents and copyrights.

1. In England, the Crown's Initially Beneficial Practice of Granting Monopolies Was Perverted When Applied to Existing Goods and Industries

The Founders did not restrict Congress' power to grant patents and copyrights because they were concerned about authors and inventors receiving their just rewards. They did so to avoid the abuses associated with the English Crown's practice of "granting monopolies to court favorites in goods or businesses which had long before been enjoyed by the public." *Graham*, 383 U.S. at 5.

In England, monopolies were initially granted for the salutary purpose of fostering new industries. *See* Harold G. Fox, *Monopolies and Patents* 43-56 (1947). Because England lagged behind continental Europe economically, the Tudor monarchs offered foreign artisans royal protection and then monopoly privileges to induce them to introduce their arts to England. *See id.* at 43-45. Eventually, however, the Crown began granting monopolies (through "letters patent") to generate revenue or to reward royal favorites, and "the system of monopolies, designed originally to foster new arts tended to become degraded into a system of plunder." *Id.* at 65-66, 70; *accord* William Hyde Price, *The English Patents of Monopoly* 13-17 (1906). These new monopolies were granted over existing goods and industries, including such everyday necessities as salt, soap, beer, paper, pots, bottles, brushes, leather, and woolen cloth. *See* Fox, *Monopolies and Patents* 63, 71 & n.58, 314-17; George Ramsey, *The Historical Background of*

Patents, 18 J. Pat. Off. Soc'y 6, 7 (1936); Price, *The English Patents of Monopoly* 145-51. Because they were exploited in a "mercenary and extortionate manner," Price, *The English Patents of Monopoly* 17, these monopolies created "shortages and inflated prices for items that would otherwise be easily and cheaply available." *Lasercomb America, Inc., v. Reynolds*, 911 F.2d 970, 974 (4th Cir. 1990). In addition, the availability of these monopolies created a "race for favors" in which the powerful competed for "lucrative new monopolies in old industries," leaving industrial innovations to the "poor and often chimerical inventors." Price, *The English Patents of Monopoly* 16.

The Crown's practice of issuing monopolies over existing goods and industries caused "deep and universal discontent." Fox, *Monopolies and Patents* 74. Indeed, the protests against these monopolies were so vehement that Queen Elizabeth was eventually forced to acknowledge some were "grievous to her subjects" and to revoke them. *Id.* at 74-78. Moreover, when her successor James I turned to monopolies to raise revenues, *see* Price, *The English Patents of Monopolies* 25-31, his use of monopolies became a major cause of the English Civil War. *See, e.g.*, Christine MacLeod, *Inventing the Industrial Revolution: The English Patent System 1660-1800*, at 16 (1988).

Printing and publishing were subject to similar, and in some respects worse, abuses. The Crown issued printing patents over popular books such as the Bible as well as almanacs, school books, and prayer books. *See* Fox, *Monopolies and Patents* 314-17; Lyman R. Patterson, *Copyright in Historical Perspective* 79 & n.5 (1968). It also granted the sole right to print in the absence of a printing patent to the Stationer's Company, a London guild of printers and publishers, which conferred exclusive rights to publish a "copy" to the member that purchased the work from its author. *See* Patterson, *Copyright in Historical Perspective* 28-32. Like the

other monopolies granted by the English Crown, the printing patents and the Stationer's Company copyrights harmed the public. In addition to creating higher prices and preventing the issuance of corrected editions, the printing patents and copyrights were used to censor political and religious opposition. *See id.* at 114-42. Indeed, the Stationer's Company was chartered for the express purpose of promoting sound religious doctrine, *see id.* at 29-30, and for many years its orders were enforced by the infamous Star Chamber. *See id.* at 115-26.

Because of the abuse of monopolies in England, the Founders had "an instinctive aversion to monopolies." *Graham*, 383 U.S. at 7; *see also* 2 Joseph Gales, *Annals of Congress* 1917 (1791) (statement of Rep. Jackson) ("What was it drove our forefathers to this country? Was it not the ecclesiastical corporations and *perpetual monopolies* of England and Scotland?") (emphasis added). For example, though both a writer and an inventor, Thomas Jefferson opposed granting Congress any power to issue patents and copyrights on the ground that such power is "in practice . . . inseparable from abuse." Letter from Thomas Jefferson to Jeudy de l'Hommande, Aug. 9, 1787, *reprinted in* 12 *The Papers of Thomas Jefferson* 11 (J. Boyd, *et al.* eds., 1956). James Madison similarly viewed government granted monopolies as "justly classed among the greatest nu[i]sances in Government." Letter from James Madison to Thomas Jefferson, Oct. 17, 1788, *reprinted in* 14 *The Papers of Thomas Jefferson* 21 (J. Boyd, *et al.* eds., 1958). Accordingly, at the Constitutional Convention, Madison recommended that authority to grant copyrights (but not patents) be limited to the power to "secure to literary authors their copy rights for a limited time," James Madison, *Notes of Debates in the Federal Convention of 1787*, at 477 (2d ed. 1987), and the Committee of Eleven recommended that the power to issue patents be limited as well. *See id.* at 579-80.

2. A Bright Line Rule Against Laws Removing Works from the Public Domain Safeguards Against the Abuses Associated With the English Monopolies

In light of the Founders' aversion to monopolies, the Intellectual Property Clause should be interpreted to prohibit laws that remove works from the public domain. Although the Clause contains provisions, such as a requirement that patents and copyrights be granted only to authors and inventors for their works, which protect against many of the Crown's abuses, a bright line rule against removing works from the public domain nonetheless provides a needed structural safeguard.

Just as the English Crown could not be trusted to grant socially beneficial monopolies over existing goods and industries, Congress cannot be trusted to issue patents and copyrights over existing goods and services because there is a "persistent asymmetry" in the legislative process. Landes & Posner, *The Economic Structure of Intellectual Property Law* 408. Authors, and the large entertainment companies to which authors frequently assign their rights, know the value of works in the public domain. They therefore have a clear and focused interest in obtaining exclusive rights over those works and are willing to invest considerable time and money in lobbying for such rights. *See* Yochai Benkler, *Through the Looking Glass: Alice and the Constitutional Foundations of the Public Domain*, 66 L. & Contemp. Prob. 173, 196 (2003). By contrast, there are few, if any, individuals interested in lobbying against such legislation because the costs of removing works from the public domain are widely diffused and are likely to be sharply felt only in the future by individuals unaware of their need at the time of the legislation. *See id.* at 196-97. Accordingly, when Congress entertains copyright "restoration" legislation, it gives little consideration to the effect of such legislation on innovation and the public domain. *See* 4 *Nimmer on Copyright* § 18.06[C][1], at 18-76 ("Instead of serving to 'promote the progress of science and the useful arts', copyright would seem now to bow to a new

master – the exigencies of world trade.") (internal quotation omitted); Peter A. Jaszi, *Goodbye to All That – A Reluctant (and Perhaps Premature) Adieu to a Constitutionally-Grounded Discourse of Public Interest in Copyright Law*, 29 Vand. J. Transnat'l. L. 595, 597-600 (1996) (same).

Moreover, courts cannot be relied upon to strike down laws that unwisely remove works from the public domain in the absence of a bright line rule against such laws. The Supreme Court has held that Congress' exercise of discretion under the Intellectual Property Clause can be reviewed only for rationality, even where it is "forcefully urge[d] that Congress pursued very bad policy." *Eldred v. Ashcroft*, 537 U.S. 186, 204-205 & n.10, 222 (2003); *see also id.* at 242 (Stevens, J., dissenting) (noting that "Congress' actions under the Copyright/Patent Clause are, for all intents and purposes, judicially unreviewable"). Consequently, so long as Congress can rationally claim that a law removing works from the public domain encourages artistic creativity, no matter how tenuously, courts will likely be obliged to uphold the law. Only a bright line rule against removing works from the public domain can prevent Congress from enacting copyright "restoration" laws that remove works from the public domain for the benefit of powerful special interests at the expense of the public's interest in fostering future creativity through a rich and vibrant public domain.

C. The Prohibition Against Laws Removing Works from the Public Domain is Also Supported by the Nature of the Public's Interest in Such Works

A bright line rule against removing works from the public domain is also supported by the nature of the public's interest in works in the public domain created by prior copyright laws.

When a work enters the public domain, it becomes the property of the people in their individual capacities. As previously noted, *see supra* p. 14, when a work fails to qualify for copyright protection or copyright protection expires, the author no longer has any exclusive right

over the work, and the nonexclusive right to use and enjoy it "passes to the public," which "may use the invention or work at will." *Dastar*, 539 U.S. at 33; *see also Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964) (noting that upon expiration of a patent "the right to make the article . . . passes to the public"); 2 Joseph Story, *Commentaries on the Constitution of the United States* § 1152, at 83 (1891) (observing that patent and copyright laws must "admit the people at large, after a short interval, to the full possession and enjoyment of all writings and inventions without restraint"). Consequently, as the Supreme Court observed in first recognizing the public domain, when a work enters that domain, it does not become sovereign property from which the government can exclude the public. It becomes "common property," or "*publici juris*," which each member of the public has a (non-exclusive) right to use. *Singer Mfg. Co.*, 163 U.S. at 194 (quotation omitted); *see also Black's Law Dictionary* 1229 (6th ed. 1990) (defining "*publici juris*" to refer to a thing that "is common property, so that any one can make use of it who likes").

Intellectual property is well-suited to such common ownership. As Thomas Jefferson poetically explained,

> [i]f nature has made any one thing less susceptible than all others of exclusive property, it is the action of the thinking power called an idea . . . . Its peculiar character [] is that no one possesses the less, because every other possesses the whole of it. He who receives an idea from me, receives instruction himself without lessening mine; as he who lights his taper at mine, receives light without darkening me.

Letter from Thomas Jefferson to Isaac McPherson, Aug. 13, 1813, *reprinted in* 13 *The Writings of Thomas Jefferson* 333-34 (A.A. Lipscomb, *et al.* eds., 1903). In other words, ideas (and expressions as well) are nonrivalrous: there is no need to assign the right to publish a literary or artistic work to a particular individual to prevent it from being depleted. *See, e.g.*, Landes & Posner, *An Economic Analysis of Copyright Law*, 18 J. Leg. Stud. at 362. Exclusive rights are

needed only to ensure that such works are created in the first place, a concern that largely disappears once a work has been produced. *See id.* In addition, as even the strongest defenders of property rights acknowledge, there is "economic value" in making intellectual property available for common use. *See* Landes & Posner, *The Economic Structure of Intellectual Property Law* 14-15. Some works, such as popular songs or plays, become more socially valuable the more widely known and shared they are. *See, e.g.*, Carol Rose, *The Comedy of the Commons: Custom, Commerce, and Inherently Public Property*, 53 U. Chi. L. Rev. 711, 766-71 (1986) (discussing "scale returns" and "interactive" effects). In addition, computer software and scientific knowledge in general may develop more quickly and in more varied and economically productive ways when prior works are freely shared, unhindered by the commercial interests of their authors. *See, e.g.*, Rebecca Eisenberg, *Patents and the Progress of Science: Exclusive Rights and Experimental Use*, 56 U. Chi. L. Rev. 1017, 1058-59 (1989); Lawrence Lessig, *The Future of Ideas* 85-99 (2001). Thus, once created, intellectual property is well-suited to common ownership.

Because copyright law confers upon the public common ownership of works dedicated to the public domain, Congress should not be permitted to deprive the public of that interest by granting copyrights over such works. The Takings Clause prohibits the government from taking property owned by private individuals for public use without paying just compensation. *See* U.S. Const., art. I, § 8, cl. 8. By analogy, the government should also be prohibited from taking property owned by members of the public in common and transferring it to private individuals for their exclusive use, at least without providing just compensation. *See, e.g.*, Richard A. Epstein, *The Dubious Constitutionality of the Copyright Term Extension Act*, 36 Loy. L.A. L. Rev. 123, 156 (2002). As laws removing works from the public domain rarely benefit the public,

see supra pp.17-18, and it is difficult to contemplate what would constitute just compensation even if they do, it makes good sense to impose a bright line rule against removing works from the public domain.

Thus, like the text and historical origins of the Intellectual Property Clause, the nature of the public's interest in the public domain created by patent and copyright laws supports the prohibition against laws removing works from that domain.

II. THE URAA'S COPYRIGHT "RESTORATION" PROVISIONS VIOLATE THE INTELLECTUAL PROPERTY CLAUSE BECAUSE THEY REMOVE WORKS FROM THE PUBLIC DOMAIN

Section 514 of the URAA violates both the letter and the spirit of the Intellectual Property Clause. The section confers copyrights over "restored works," 17 U.S.C. § 104A(1)(a), which are in turn defined as works originally published abroad that for certain reasons are "in the public domain." *Id.* § 104A(h)(6)(C) (emphasis added). Thus, Section 514 explicitly confers copyrights over works in the public domain and therefore plainly violates the Intellectual Property Clause's prohibition against such laws.

Indeed, Section 514 demonstrates the wisdom of this prohibition. Section 514 removes thousands, if not millions, of works from the public domain, including virtually every copyrightable work produced prior to 1973 in Russia and every foreign sound recording from the last century. *See supra* p. 5. The works removed include masterpieces such as novels by Joseph Conrad, George Orwell, J.R.R. Tolkein, H.G. Wells, and Virginia Woolf; paintings by Picasso; and the music of twentieth century Russian composers such as Prokofiev, Shostakovitch, and Stravinsky. *See id.* As a result, writers, playwrights, and movie directors are no longer free to create derivative pieces based upon these works. Public domain publishers like Luck's Music are no longer able to sell affordable scores of popular works such as Prokofiev's *Peter and the Wolf* and Shostakovich's *Symphony No. 5*, and the price of performing these works has

skyrocketed so much that smaller community and regional orchestras can no longer afford to play them. JA 10-11. Historians are prevented from using the restored works in anthologies, scholarly websites and other works. And film archives such as Moviecraft can no longer sell foreign films even though the owners of these films are unknown and the films will likely be lost forever. JA 12-13.

There is little, if any, public benefit counterbalancing these losses. There is no reason to believe that Section 514 provides any encouragement to future creativity. It does not require, for example, that the windfall created by the "restoration" of copyrights be devoted to creating new works, and the testimony before Congress failed to explain why creativity would be stimulated. Indeed, the URAA's legislative history displayed a "shocking" disregard for the public domain and the constitutional issues raised by removing works from it. 4 *Nimmer on Copyright* § 18.06[C][3][a], at 18-80. Congress was instead concerned with helping the entertainment industry by placing the United States in a better position to persuade countries such as Russia, Turkey, and Brazil to grant retroactive protection to American works in the public domain there. *See supra* pp. 3-4. These uncertain benefits have nothing to do with the Intellectual Property Clause's goal of stimulating creativity, are ephemeral at best and do not counterbalance the broad and concrete harm caused by removing thousands, if not millions, of works from the public domain. Thus, Section 514 demonstrates how intellectual property legislation can be hijacked by special interests when permitted to address existing matters and thus underscores the wisdom of the Intellectual Property Clause's bright line rule against laws removing works from the public domain.

III. THE TRIAL COURT ERRED IN UPHOLDING THE URAA'S COPYRIGHT RESTORATION PROVISIONS

In upholding the constitutionality of Section 514, the lower court did not analyze the text of the Intellectual Property Clause, examine its historical origins, or consider the public's interest in the public domain. Instead, observing that "a page of history is worth a volume of logic," JA 24 (quotations omitted), the court upheld Section 514 based solely upon what it viewed as a consistent and unchallenged congressional practice of removing works from the public domain. JA 24-31. In fact, however, there is no such tradition. Furthermore, the lower court's attempt to distinguish *Graham* and explain why patent but not copyright laws are prohibited from removing works from the public domain is utterly unpersuasive.

A. The Intellectual Property Clause's Prohibition on Laws Removing Works from the Public Domain Applies to Copyright as Well as Patent Laws

The lower court acknowledged, as it had to, that in *Graham*, the Supreme Court recognized that "Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available." JA 30 (quoting *Graham*, 383 U.S. at 5-6). The court asserted, however, that this prohibition applies only to patents and not to copyrights. JA 30-31. Not so. As *Graham* itself makes clear, the prohibition on removing works from the public domain is derived from the Intellectual Property Clause, which governs copyrights as well as patents.

There is no principled basis for prohibiting patent but not copyright laws from removing knowledge from the public domain. As demonstrated above, the prohibition on removing works from the public domain is drawn from the language and structure of the Intellectual Property Clause, *see supra* pp.12-17, its historical origin and purposes, *see supra* pp.18-22, and the nature of the public's interest in the public domain. *See supra* pp. 22-25. Each of these points applies to copyrights as well as patents. First, although the Clause does not treat patents and copyrights

exactly the same, referring to "Authors" and "Writings" on the one hand and "Inventors" and "Discoveries" on the other, U.S. Const., art. I, § 8, cl. 8, the same basic structure applies to both patents and copyrights. In addition, the provisions from which the public domain prohibition is drawn – the goal of "promoting Progress" and the specified means of awarding an "exclusive Right" for "limited Times" – apply to both patents and copyrights. Second, the historical concerns that led the Founders to impose these restrictions – namely, the Crown's abuse of its prerogative to grant monopolies over existing goods – apply to both patents and copyrights; indeed, Madison's proposal to the Constitutional Convention limited Congress' power to grant copyrights but not patents. *See supra* p. 20. Moreover, the "persistent asymmetry" in the legislative process affects copyrights as well as patents. Third, the public has as much interest in literary works after the expiration of a copyright as it does in inventions after the expiration of a patent. Thus, there is no principled way to limit the Intellectual Property Clause's prohibition on removing works from the public domain to patents.

Moreover, far from suggesting any distinction between patents and copyrights, the Court has repeatedly recognized that the same constitutional principles apply to patents and copyrights. For example, in *Dastar*, the Supreme Court explicitly equated patents and copyrights in explaining how works enter the public domain: "The right to copy, and to copy without attribution, once *a copyright* has expired, *like the right to make an article whose patent has expired* . . . passes to the public . . . the public may use the invention or work at will." 539 U.S. at 33-34 (quotation omitted) (emphasis added). Similarly, in *Compco*, 376 U.S. 234, the Court held that, "when an article is unprotected by a patent *or a copyright*, state law may not forbid others to copy that article" because of the "federal policy, found in Art. I, § 8, cl. 8 of the Constitution, and in the implementing federal statutes, of allowing free access to copy whatever

the *patent and copyright* laws leave in the public domain." *Id.* at 237 (emphasis added). The Court also relied upon copyright cases when it first recognized the public domain. *See Singer Mfg. Co.*, 163 U.S. at 191-92 (relying upon *Merriam v. Holloway Pub. Co.*, 43 Fed. Rep. 450 (1890)); *see also G. & C. Merriam Co. v. Syndicate Publ'g Co.*, 237 U.S. 618, 622-23 (1915) (holding *Singer* "applicable to the expiration of a copyright"). Accordingly, this Court has observed that *Graham*, "[a]pplied *mutatis mutandis* to the subject of copyright, . . . would indeed preclude Congress from authorizing under [the Intellectual Property] Clause a copyright to a work already in the public domain." *Eldred*, 239 F.3d at 377.

The lower court attempted to distinguish *Graham* on the ground that it "concerns specific requirements unique to patent law" and therefore is based "on the rigors of the patent statute's novelty requirement." JA 30-31. That is just wrong. *Graham* was not analyzing a patent statute when it discussed the prohibition on removing material from the public domain: it was discussing the "specific *constitutional* provision" from which "the federal patent power stems." 383 U.S. at 5 (emphasis added). Observing that "the Intellectual Property Clause is both a grant of power and a limitation" which Congress "may not overreach," the Court observed that "Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain or to restrict free access to materials already available." *Id.* at 6. Thus, the context plainly demonstrates that this passage deals with constitutional, not statutory, restrictions.

The Supreme Court's decision in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), does not help the lower court. Contrary to the suggestion below, JA 31, *Bonito Boats* mentions *Graham*'s prohibition on removing materials from the public domain in discussing the Intellectual Property Clause. *See* 489 U.S. at 146. Moreover, it later references

"the federal policy, found in Art. I, § 8, cl. 8 of the Constitution" of allowing free access to copy whatever the federal patent *and copyright* laws leave in the public domain." *Bonito Boats*, 489 U.S. at 153 (quoting *Compco*, 376 U.S. at 237) (emphasis added). Thus, far from suggesting that *Graham*'s prohibition on removing material from the public domain is based on the patent statute, *Bonito Boats* explicitly recognizes that it is based on the Constitution and that the relevant constitutional policies apply to copyrights as well as patents.

B. There is No Consistent and Unchallenged Congressional Practice of Granting Copyrights to Works in the Public Domain

The lower court found a "tradition of restoring copyrights retroactively without constitutional challenge" based upon statutes passed in 1790, 1919, and 1941. JA 24-29. These statutes provide no precedent for Section 514: far from removing thousands of works from the public domain like Section 514, these statutes did not remove any works from the public domain. Even more importantly, the major copyright acts have consistently acknowledged that works may not be removed from the public domain, and the prohibition on removing works from the public domain has been recognized by courts and commentators, for the better part of two centuries. Thus, there is no consistent and unchallenged tradition of removing works from the public domain.

1. The 1790 Copyright Act Did Not Remove Works from the Public Domain

The lower court relied primarily on the first federal copyright law, which was enacted in 1790. It argued that this statute removed works from the public domain because it conferred copyrights on already printed works, and because those works were not all protected by either statutory or common law copyrights. JA 25-27. The court was correct in observing that the Copyright Act of 1790 "granted copyright protection to all books, maps and charts 'already printed within these United States' at the time of enactment," JA 25 (quoting 1 Stat. 124), and

that not all states had operative copyright laws at that time. JA 25-26. It erred, however, both in finding that there was no common law copyright and in concluding therefore that the 1790 Act removed works from the public domain.

By the time that the 1790 Act was passed, common law copyright had been recognized in England. English courts recognized common law protections for unpublished works early in the eighteenth century, *see, e.g.*, *Forrester v. Waller*, 98 Eng. Rep. 216 (1741); *Webb v. Rose*, 96 Eng. Rep. 184 (1732), and in 1769 Lord Mansfield held that published books were also protected "because it is just, that an author should reap the pecuniary profits of his own ingenuity and labour." *Millar v. Taylor*, 98 Eng. Rep. 201, 252 (1769). Although five years later the House of Lords rejected a claim of common law copyright, apparently on the ground that it was preempted by a statute limiting the term of copyrights, a majority of English common law judges informed the Lords that there was a common law copyright in published works. *See Donaldson v. Becket*, 98 Eng. Rep. 257, 258-262 (1774). *See generally* Patterson, *Copyright in Historical Perspective* 168-79.

Based upon *Millar* and reports of the judges' opinions in *Donaldson*, the Founders believed that common law copyright protected published works. According to James Madison, "[t]he copyright of authors has been solemnly adjudged, in Great Britain, to be a right of the common law." *The Federalist No. 43*, at 338 (James Madison) (Clinton Rossiter ed., 1875); *see also The American Magazine* (Noah Webster ed., 1788) (noting that, "by a solemn adjudication in the courts of Westminster, it is determined that an action will lie at common law for publishing books, pamphlets, &c. without the consent of the author or proprietor"). Joseph Story also recognized a common law copyright, *see* 2 Story, *Commentaries on the Constitution* § 1152, at 83 ("The copyright of authors in their works had, before the revolution, been decided in Great

Britain to be a common law right . . . ."), as did other treatises such as the first American edition of Blackstone's *Commentaries*. *See* 2 William Blackstone, *Commentaries on the Laws of England* *406-*07 (Robert Bell ed., 1773) (reporting that in *Millar* it was determined that "an exclusive copyright in authors subsists by common law"); Robert Maugham, *A Treatise on the Law of Literary Property* 7-10, 31-32 (1828) (noting that most judges considering the issue have "decided that, by the common law, an author was entitled to the exclusive enjoyment of his copyright in perpetuity"); George Curtis, *A Treatise on the Law of Copyright in Books* 75-76, 81 (1847) (noting that there was common law copyright in England and that copyright "had been regarded as a common law right in several of the states, before the adoption of the constitution of the United States").

Colonial copyright statutes also recognized the existence of common law copyright. Three such statutes explicitly referred to common law copyright. *See Copyright Office Bulletin No. 3: Copyright Enactments: Laws Passed in the United States Since 1783 Relating to Copyright* 21 (1963) (New York) (providing that "nothing in this act shall extend to effect, prejudice, or confirm the rights which any person may have to the printing or publishing of any book or pamphlet, *at common law*, in cases not mentioned in this act") (emphasis added); *id.* at 18 (Georgia) (same); *id.* at 3 (Connecticut) (same). In addition, following Lord Mansfield, another four statutes acknowledged the natural rights of authors upon which common law copyright was based. *Id.* at 4 (Massachusetts) (stating that "security of the fruits of [an author] study and industry" is "one of the natural rights of all men"); *id.* at 8 (New Hampshire) (same); *id.* at 9 (Rhode Island) (same); *see also id.* at 15 (North Carolina) ("nothing is more strictly a man's own than the fruit of his study").

Finally, the 1790 Act implicitly recognized that "already printed" works were protected by copyright. Section 1 of that Act conferred exclusive rights upon authors who have "not transferred to any other person the *copyright*" in their works. 1 Stat. 124 (emphasis added). The Act also provided that the copyright should be awarded to "executors, administrators, or assigns" who have "purchased or legally acquired the *copyright*" in a map, chart, or book. *Id.* (emphasis added). Thus, the 1790 Act clearly assumed that "already printed" works were protected by copyright. Nor is the Act's treatment of such works surprising: because common law copyrights were perpetual, the 1790 Act needed to address existing works in order to limit the term of their protection and ensure their eventual entrance into the public domain.

The lower court found that there was no common law copyright because in its view *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), "ruled that a common law copyright did not exist in the United States." JA 26. In fact, however, *Wheaton* considered only whether there was common law copyright in Pennsylvania, *see Wheaton*, 33 U.S. at 658-59, and although it expressed doubt whether the common law copyright recognized in England had been adopted in the "wilds of Pennsylvania," *id.* at 660, it rested its decision on the "more conclusive" ground that any common law copyright had been preempted by federal copyright law. *See id.* at 660-62. Furthermore, the views expressed by the Supreme Court in *Wheaton* in 1834 shed little light on what Congress thought in 1790, especially in light of the overwhelming evidence that the Founders understood published works to be protected by common law copyright.

Finally, even if there had been no common law copyright, works printed before the 1790 Act still would not have been in the public domain for purposes of the Intellectual Property Clause. The Clause does not prevent Congress from protecting works simply because they were previously unprotected by federal copyright law. To the contrary, where Congress has not

enacted a copyright law addressing an area – such as sound recordings prior to 1972 (*see supra* p. 4) – even states are free to restrict public access to works in that area. *See Goldstein*, 412 U.S. at 569-70 (upholding state law forbidding "pirated" sound recordings). The Intellectual Property Clause only prevents state and federal governments from conferring exclusive rights over a work when the right to use that work has passed to the public, which occurs when a work fails to qualify for federal copyright protection or the protection conferred upon that work expires. *See supra* p. 13. In other words, the public domain is created when, pursuant to the Intellectual Property Clause, federal copyright law dedicates a work to the public. Because the 1790 Act was the first federal copyright law, no works were dedicated to the public in this way prior to the statute, and the Act therefore could not have removed works from the public domain for purposes of the Intellectual Property Clause.

2. The 1919 and 1941 Statutes Cited Below Did Not Remove Works from the Public Domain

In addition to relying upon the 1790 Act, the lower court also cited two twentieth century statutes – a 1919 amendment to the Copyright Act of 1909, *see* 41 Stat. 368 (1919), and a 1941 statute amending that Act, 55 Stat. 732 (1941) – as well as various proclamations issued pursuant to them. JA 26-27. This reliance is also misplaced: like the 1790 Act, neither of these statutes removed works from the public domain.

a. The 1919 Amendment. In 1919, recognizing that World War I had prevented many foreign authors from complying with deadlines for registration and complying with other formalities, *see* S. Rep. No. 66-329, at 3 (1919), Congress amended the 1909 Copyright Act to extend the time for registering of works "first produced or published abroad" during the war. 41 Stat. at 369. Noting that this extension was available only to authors from countries recognized by the President as affording American authors similar

protections, *id.*, the lower court asserted that the amendment "gave the president the power to restore copyrights to foreign authors." JA 27-28. That is incorrect. Section 7 of the 1909 Copyright Act explicitly prohibited Congress from conferring copyrights upon works in the public domain:

> no copyright shall subsist in the original text of any work which is in the public domain, or in any work which was published in this country or any foreign country prior to the going into effect of this Act and has not been already copyrighted in the United States . . . .

35 Stat. 1075, 1077 (1909). The 1919 amendment did not amend this provision; rather, it amended Sections 8 and 21 of the Act. 41 Stat. at 369. As a consequence, the amendment cannot be interpreted to implicitly repeal Section 7 and permit the removal of works from the public domain. *See, e.g.*, *Cook County v. United States*, 538 U.S. 119, 132-34 (2003) (noting the "cardinal rule" that "repeals by implication are not favored") (quotation omitted); *see also J.E.M. AG Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124, 143-44 (2001) ("[W]hen two statutes are capable of coexistence, it is the duty of the courts, absent a clearly expressed congressional intention to the contrary, to regard each as effective.") (quotation omitted).

The lower court argued that the 1919 Amendment must have removed works from the public domain because the works covered by the amendment were published in their home countries without complying with registration and other formalities of American copyright laws. JA 28-29. In support of this argument, the court cited Judge Learned Hand's famous decision in *National Comic Publications, Inc. v. Fawcett Publications*, 191 F.2d 594 (2d Cir. 1951). JA 28-29. That decision does not, however, deal with foreign publications. Moreover, five years earlier, Judge Hand joined a decision holding that publication abroad does *not* constitute publication in the United States. *See Heim v. Universal Pictures Co.*, 154 F.2d 480, 486-87 (2d Cir. 1946); *accord Twin Books Corp v. Walt Disney Corp.*, 83 F.3d 1162, 1165-67 (9th Cir.

1996); *United Dictionary Co. v. G. & C. Merriam Co.*, 208 U.S. 260, 264-66 (1908). Thus, the lower court incorrectly assumed that foreign works covered by the 1919 Amendment were in the public domain because they had been published abroad.

The lower court's reliance upon the proviso in the 1919 amendment is also misplaced. According to the lower court, this proviso "protected individuals who relied on the fact that [] works were in the public domain before the proclamations restored their copyrights." JA 29. In fact, however, the proviso states that "nothing herein contained shall be construed to deprive any person of any right which he may have acquired by the republication of such foreign work in the United States prior to the approval of this Act." 41 Stat. at 369. Since republication in the United States constitutes publication for purposes of American copyright law, the proviso simply recognizes that works published *in the United States* without complying with the requirements of American copyright law enter the public domain. Consequently, far from demonstrating that the 1919 Amendment authorized the removal of works from the public domain, the provision underscores that it did not.

b. The 1941 Act. The lower court also invoked a 1941 statute that, much like the 1919 Amendment, authorized the President to extend the time to comply with the conditions and formalities of American copyright law for foreign authors unable to satisfy those requirements due to the "disruption or suspension of formalities essential for such compliance." Emergency Copyright Act of 1941, 55 Stat. 732 (1941). Like the 1919 amendment, the 1941 statute amended Section 8 of the 1909 Copyright Act and left untouched the prohibition on removing works from the public domain in Section 7. The lower court nonetheless argued that the statute removed works from the public domain because it contained a proviso for "lawful uses made or acts done prior to the effective date," 55 Stat. 732, which the legislative history stated was

intended "'to protect the rights lawfully exercised by American users or publishers of copyrighted works[,] protection of which has lapsed [into the public domain].'" JA 29 (quoting H.R. Rep. No. 77-619, at 2 (1941)). The legislative history does not, however, state that the works in question were legally usable because they were in the public domain. Indeed, the legislative history of the bill, which is extremely limited, does not even mention the public domain, much less consider whether the Constitution permits Congress to remove works from that domain. As a consequence, the 1941 Emergency Act does not provide any clear precedent for removing works from the public domain and certainly does not indicate any considered decision by Congress that the Intellectual Property Clause permits it to remove works from that domain.

3. Congress Has Not Consistently Removed Works from the Public Domain, and Its Ability to Do So Has Long Been Challenged

Even if the 1941 Emergency Act had authorized the removal of some works from the public domain, it would not justify the "patently unconstitutional" practice of removing works from the public domain. *Eldred*, 537 U.S. at 235 (Stevens, J., dissenting) (discussing private laws extending expired patents). As the Supreme Court has recognized, "no one acquires a vested or protected right in violation of the Constitution by long use." *Marsh v. Chambers*, 463 U.S. 783, 790 (1983) (quotation omitted); *see also United States v. Martinez-Fuerte*, 428 U.S. 543, 566 n.19 (1976) ("neither long-standing congressional authorization nor widely prevailing practice justifies a constitutional violation"). The Court therefore has refused to defer to constitutionally dubious legislative practices unless they are "uniform, long-continued and undisputed." *United States v. Curtiss-Wright*, 299 U.S. 304, 329 (1936); *see also Eldred*, 537 U.S. at 194-202 (citing and discussing eight previous instances of copyright extension stretching continuously back to the 1790 Act). That is plainly not the case here.

First, Congress has not continuously removed works from the public domain. To the contrary, as just noted, the 1909 Copyright Act explicitly provided that "no copyright shall subsist in the original text of any work which is in the public domain." 35 Stat. at 1077. Its statutory predecessor, the 1831 Copyright Act, recognized the same principle in providing that it "shall not extend to any copyright heretofore secured, the term of which has already expired." 4 Stat. 436, 439 (1831). And the current copyright act explicitly states that it "does not provide copyright protection for any work that goes into the public domain" prior to its effective date. Copyright Act of 1976, Pub. L. No. 94-553, § 103, 90 Stat. 2599 (1976). Thus, if the 1919 Amendment removed works from the public domain, it sharply departed from traditional congressional practice.

Second, Congress' authority to remove works from the public domain has long been challenged. The Supreme Court explicitly rejected any congressional authority to remove material from the public domain in the patent context in *Graham*, *see* 383 U.S. at 5-6, and it has reaffirmed this principle several times since then. *See, e.g.*, *Bonito Boats*, 489 U.S. at 146; *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 61 (1969). As noted above, numerous other courts have done so as well. *See supra* p. 11 & n.1. Indeed, courts have been questioning Congress' power to remove works from the public domain since at least 1826. In that year, the Circuit Court for the Southern District of New York opined that a private bill renewing a patent that had expired "was a nullity." *Thompson v. Haight*, 23 F. Cas. 1040, 1047 (C.C.S.D.N.Y. 1826). It reasoned that the invention had already become "public property," or "*publici juris*," and that "the enjoyment of it can never again be made exclusive, in the hands of an individual" because "the legislature has no right to give to [a patentee] what has become the property of others." *Id.* While riding circuit in 1890, Justice Miller similarly recognized that,

after the expiration of a book's copyright, "the public shall be entitled *ever afterward* to the unrestricted use of that book." *Merriam v. Holloway Pub. Co.*, 43 F. 450, 451 (C.C.E.D. Mo. 1890)) (emphasis added).

Commentators also have long recognized that the Intellectual Property Clause prohibits Congress from removing works from the public domain. For example, in 1917 Professor Arthur Weil wrote that laws removing works from the public domain are unconstitutional because they do not promote progress:

> Congress could not, constitutionally, allow copyright in works in that "domain," since, as such works are for[] anyone to use, [] allowing anyone, even their author, a copyright therein, after they became free to the public, could not possibly "promote" that "progress of science and the useful arts" for which Congress may legislate.

Arthur W. Weil, *American Copyright Law with Especial Reference to the Present United States Copyright Act* 183 (1917). Similarly, in 1925, Richard DeWolf, a former Assistant Register of Copyright, commented that the 1909 Act's prohibition on removing to works from the public domain codified "a view which would seem fairly obvious in any case, which was already law by virtue of judicial decision." Richard C. DeWolf, *An Outline of Copyright Law* 13, 80 (1925).[5] Contemporary copyright scholars have taken the same view. *See, e.g.*, 1 *Nimmer on Copyright* § 1.05[A][2], at 1-100 ("it seems clear that the Copyright Clause would not permit the granting of copyright to works that have theretofore entered the public domain"); Lyman R. Patterson, *Copyright and the "Exclusive Right" of Authors*, 1 J. Intell. Prop. L. 1, 19 (1993) ("Once a work is in the public domain, it is not subject to recapture by copyright.").

---

5 *See also* Herbert A. Howell, *The Copyright Law: An Analysis of the Law of the United States Governing Registration and Protection of Copyright Works, Including Prints and Labels* 42 (3d ed. 1945) ("It is doubtful whether even a special law of Congress could effectively restore copyright status to a work which has fallen into the public domain either from lapse of time or failure to observe statutory formalities; and certainly not to the extent of disturbing equities."); 13 Corpus Juris *Copyright and Literary Property* § 92, 1011-12 (1917) ("Works already in the public domain are not the subject of copyright . . . .").

In short, even if the 1919 Amendment and the 1941 Emergency Act had removed works from the public domain, they would not represent a continuous and unchallenged congressional practice. Instead, they would be ill-considered departures from ordinary congressional practice, at odds with the views of courts and leading copyright scholars. As a consequence, these statutes deserve little weight in construing the Intellectual Property Clause, especially in light of the Clause's text and structure, its history and purpose, and the nature of the rights conferred by it, all of which undermines the lower court's reliance on these statutes.

IV. THE URAA'S COPYRIGHT RESTORATION PROVISIONS ARE NOT SAVED BY EITHER THE TREATY POWER OR THE COMMERCE CLAUSE

No doubt recognizing the weaknesses in its interpretation of the Intellectual Property Clause, the Government argued below that Section 514 was a valid exercise of Congress' power to enact laws implementing treaties and to regulate international commerce. *See* Def. Mem. in Support of Motion to Dismiss at 20-22, 24; *see also* JA 23-24 (not reaching this argument). This argument is meritless. Neither the Treaty Power nor the Commerce Clause authorizes Congress to issue copyrights that violate the restrictions imposed by the Intellectual Property Clause.

It is hornbook law that "treaties are subject to the constitutional limitations that apply to all exercises of federal power . . . ." Louis Henkin, *Foreign Affairs and the United States Constitution* 185 (2d ed. 1996); *accord* 1 Ronald D. Rotunda & John E. Nowak, *Treatise on Constitutional Law: Substance & Procedure* § 6.5, at 573-74 (3d ed. 1999). The Supreme Court has long recognized that the Treaty Power does not "extend[] so far as to authorize what the constitution forbids." *De Geofroy v. Riggs*, 133 U.S. 258, 267 (1890); *accord Asakura v. City of Seattle*, 265 U.S. 332, 341 (1924); *The Cherokee Tobacco*, 78 U.S. 616, 620 (1870); *Doe v. Braden*, 57 U.S. (16 How.) 635, 657 (1853). Moreover, in *Reid v. Covert*, 354 U.S. 1 (1957), the Court specifically held that "no agreement with a foreign nation can confer power on the

Congress, or on any other branch of Government, which is free from the restraints of the Constitution." 354 U.S. at 16 (plurality op.); *see also id.* at 17 ("It would be manifestly contrary to the objectives of those who created the Constitution . . . to construe Article VI as permitting the United States to exercise power under an international agreement without observing constitutional prohibitions."). Thus, the Treaty Power cannot excuse a statute such as Section 514 from violating the Intellectual Property Clause's prohibition on removing works from the public domain.

The Commerce Clause does not authorize Congress to ignore those restrictions either. Although the Commerce Clause confers broad authority, it does not authorize Congress to circumvent restrictions on more specific powers. *See Ry. Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457, 468-69 (1982) (holding that Congress could not invoke its Commerce Clause power to provide for payments to creditors in violation of the Bankruptcy Clause's uniformity requirement). Indeed, a portion of the URAA was recently struck down on this very ground. *See United States v. Martignon*, 2004 WL 2149105, at *8-*9 (S.D.N.Y. Sept. 24, 2004) (holding that the Commerce Clause cannot justify an antibootlegging provision that violates the Intellectual Property Clause's "limited Times" requirement). As the court observed in doing so, "'[t]he distinction, between a government with limited and unlimited powers, is abolished, if those limits do not confine the persons on whom they are imposed . . . .'" *Id.* at *8 (quoting *Marbury v. Madison*, 5 U.S. 137, 177 (1803)). For the same reason, the Commerce Clause cannot justify Section 514's violation of the limits on Congress' power to issue copyrights imposed by the Intellectual Property Clause.

CONCLUSION

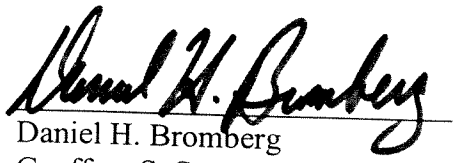
For the reasons stated above, the copyright restoration provisions in Section 514 of the URAA are unconstitutional. The decision below should therefore be reversed, and this case remanded for further proceedings.

Of Counsel:

Jonathan L. Zittrain
The Berkman Center for
Internet & Society
1563 Massachusetts Avenue
Cambridge, MA 02138
(419) 831-9295

November 23, 2004

Respectfully submitted,



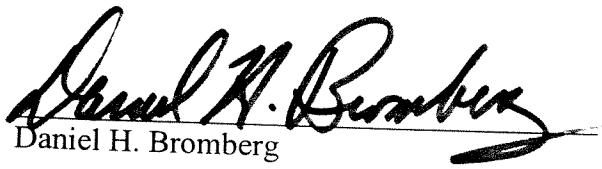
Daniel H. Bromberg
Geoffrey S. Stewart
Carmen M. Guerricagoitia
Sabrina Underwood
Jones Day
51 Louisiana Avenue, N.W.
Washington, DC 20001-2113
(202) 879-3939

Counsel for Appellants Luck's Music Library, Inc. and Moviecraft, Inc.

CERTIFICATE OF COMPLIANCE

Pursuant to Fed. R. App. P. 32(a)(7) and D.C. Circuit Rule 32(a), I hereby certify that the foregoing Brief for Appellants is proportionally spaced, is in a 12-point Times New Roman typeface, and contains 13,587 words.

Dated: November 23, 2004



Daniel H. Bromberg

Counsel for Appellants Luck's Music Library, Inc. and Moviecraft, Inc

CERTIFICATE OF SERVICE

I hereby certify that on this 23d day of November, 2004, I caused two (2) copies of the foregoing Brief of Appellants and one (1) copy of the joint appendix to be served by first-class mail, postage pre-paid, upon the following individual:

John Koppel
Department of Justice
Civil Appellate Division
Patrick Henry Building
601 D Street, N.W.
Washington, D.C. 20530
(202) 514-2495

Daniel H. Bromberg