

[CASE ARGUED ON OCTOBER 5, 2000,
AND DECIDED ON FEBRUARY 16, 2001]

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 99-5430

ERIC ELDRED, *et al.*,

Plaintiffs-Appellants,

v.

JOHN D. ASHCROFT, in his official capacity as Attorney General,

Defendant-Appellee.

Appeal From The United States District Court
For The District Of Columbia (D.D.C. No. 99-0065 (JLG))

**APPELLANTS' PETITION FOR REHEARING AND
SUGGESTION FOR REHEARING *EN BANC***

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3 Joseph Story, *Commentaries on the Constitution of the United States*
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CONCISE STATEMENT OF THE ISSUES AND THEIR IMPORTANCE

The Framers of our Constitution imposed only one real obligation on Congress with respect to what we now call “intellectual property”: that there shall be, at the federal level, a public domain supported by creative works. Congress has no obligation to enact copyright statutes; its only obligation is that if it establishes “exclusive Right[s]” for “Authors,” then those rights can extend for “limited Times” only. U.S. Const., art. I, § 8, cl. 8. The Constitution thus commands not copyrights, but a public domain — and not simply the public domain that results from copyright protecting expression rather than ideas, *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 556 (1985), or from copyright’s inability to reach “facts.” *Feist Publ’n v. Rural Tel.. Serv. Co.*, 499 U.S. 340, 345 (1991). The public domain that the Framers envisioned, as Justice Story explained, comprises creative works that “after a short interval” fall to the “people at large” “without restraint.”³ Joseph Story, *Commentaries on the Constitution of the United States* § 1147 (1833) (emphasis added).

Congress has found a clever way around this simple constitutional requirement. While adhering to the rule that copyright terms be definite, rather than perpetual, Congress has adopted the practice of perpetually extending definite terms. Eleven times in the past forty years, Congress has extended the term of subsisting copyrights. *Eldred v. Reno*, 239 F.3d 372, 381 (D.C. Cir. 2001) (copy annexed hereto at A-1 to A-13). The latest such extension extends the term of subsisting copyrights by 20 years, and the term of copyrights not yet fixed by 20 years as well. Sonny Bono Copyright Term Extension Act of 1998 (“CTEA”), Pub. L. No. 105-298, 112 Stat. 2827. Because of this law and its predecessors, creative works produced in 1923 under the expectation that they would fall into the public domain at the latest in 1980 will not do so until at least 2019.

A panel of this Court has now given judicial sanction to this congressional fix. Over the dissent of Judge Sentelle, the panel held that under this Court’s decision in *Schnapper v. Foley*, 667 F.2d 102 (D.C. Cir. 1981), the expressly stated purpose of the Copyright Clause — to “promote the

Progress of Science and useful Arts” (U.S. Const., art. I, § 8, cl. 8) — imposes no constraint on Congress’ power whatsoever. Likewise, the panel has interpreted this Court’s decision in *United Video, Inc. v. FCC*, 890 F.2d 1173 (D.C. Cir. 1989), to establish a “categorical immun[ity]” for copyright statutes under the First Amendment. As Judge Sentelle warned in dissent, there is no “stopping point” to the rule that the panel has embraced. *Eldred*, 239 F.3d at 381. Under its decision, Congress’ power to restrict the public domain is essentially unlimited.

The effect of these rulings, should they be allowed to stand, on the scope and vibrancy of the public domain cannot be overstated. The most immediate effect will be to exclude the work of America’s famed “lost generation” — Faulkner, Fitzgerald, Frost, Gershwin, Hemingway, Hughes, West, and others — from the public domain for at least another 20 years. More importantly, the panel’s opinion gives the green light to Congress’ practice of extending the length of copyright protection despite the Framers’ clear contrary intent. Especially when new technologies, such as the Internet, are making the public domain more important than ever to commercial and non-commercial entities alike, this Court should not be creating formulaic “immunities” from judicial review. For these reasons alone, the panel’s opinion warrants reconsideration by the entire Court.

But it is the supervisory role of this Court that makes *en banc* review especially appropriate, for three specific reasons: (1) the panel’s application of the Copyright Clause plainly conflicts with Supreme Court authority; (2) the panel’s application of the First Amendment fundamentally misinterprets the scope of the precedent upon which it relies; and (3) the panel has announced a new rule of waiver that is inconsistent with Circuit rules.

1. By interpreting this Court’s decision in *Schnapper* to hold that the “introductory language” to the Copyright Clause imposes absolutely no “limit on congressional power,” *Eldred*, 239 F.3d at 378, the majority opinion creates a conflict with Supreme Court authority. In *Graham v. John Deere Co.*, the Supreme Court expressly found the Copyright and Patent Clause “both a grant of power and a limitation” and held that Congress’ power under that clause is “limited to the

promotion of advances in the ‘useful arts’” – a limitation taken from the language of the clause. *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966); accord *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989); *Trade-Mark Cases*, 100 U.S. 82, 94 (1879). At oral argument, the panel expressly recognized this tension between *Schnapper* and *Graham*, Transcript of Oral Arg. at 19-22 (excerpts annexed hereto at A-20 to A-23), but concluded that *Schnapper* “may be revisited only by the court sitting *en banc*.” 239 F.3d at 380; *see also id.* at 384 (Sentelle, J., dissenting) (also noting the possibility of *en banc* review). Given this conflict, *en banc* review is appropriate.

2. The panel also decided “that copyrights are categorically immune from challenges under the First Amendment.” 239 F.3d at 375. It based that conclusion on this Court’s decision in *United Video*. But *United Video* merely recognized that First Amendment review is limited in “cases in which a first amendment *defense* is raised to a copyright *claim*,” 890 F.2d at 1190 (emphasis added). The panel has now expanded this rule to *claims* as well as *defenses*, and to challenges of the *Copyright Act* as well as challenges to the exercise of a *particular copyright*. Such “First Amendment immunity” has no precedent in the Supreme Court and conflicts with the expansive First Amendment protections granted by this Court in other contexts.

3. The majority introduced a new rule of waiver that is unprecedented in this Circuit and conflicts with Circuit rules. Under the majority’s decision, a party waives arguments offered by supporting *amici* if the party does not expressly adopt those arguments in its brief. 239 F.3d at 378. Because this new rule is unsupported by the rules promulgated by this Court as a whole, and because it will encourage confusion and gamesmanship, this Court should review it *en banc*.

STATEMENT

The Constitution grants Congress the power “To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors exclusive Right to their respective Writings and Discoveries.” U.S. Const., art. I, § 8, cl. 8. Exercising its power under this clause, Congress enacted the Sonny Bono Copyright Term Extension Act of 1998 to extend the term of

subsisting copyrights and copyrights not yet fixed by 20 years. *See* 239 F.3d at 373. Thus, for works created since 1978, the term is extended from the life of the author plus 50 years to the life of the author plus 70 years, and for works created before that time, the term for copyrights of known authors is extended from a maximum of 75 to 95 years. *See id.* at 374.

Plaintiffs are individuals and entities that depend upon the public domain for their livelihood. *See* 239 F.3d at 375. In 1998, they filed this action challenging the constitutionality of the CTEA. Plaintiffs argued, among other things, that (1) the retrospective extension of the term of subsisting copyrights exceeded Congress' power under the Copyright Clause, and (2) by regulating what plaintiffs and others may copy and use, either directly or derivatively, the CTEA imposed a content-neutral restriction on their speech that fails to advance any important governmental interests and therefore is unconstitutional under ordinary First Amendment standards. *See id.*

After the district court dismissed these challenges on the pleadings, plaintiffs appealed. A panel of this Court (Ginsburg, Sentelle, and Henderson, JJ.) affirmed the district court's dismissal. Although the panel found that plaintiffs had standing to challenge the constitutionality of the CTEA, *see* 239 F.3d at 375, it rejected plaintiffs' First Amendment challenge. *Id.* at 376. A majority of the panel also rejected plaintiffs' Copyright Clause challenge based upon this Court's prior decision in *Schnapper*. *See id.* at 378. The majority held that the reference to the promotion of progress in the first portion of the Clause did not restrict Congress' power under that clause. *See id.* The majority did not consider whether a narrower view of *Schnapper* was correct. That argument, the majority held, had been waived by plaintiffs because it was raised by *amici*, and plaintiffs had not expressly endorsed the arguments of *amici* in their brief. *See id.*¹

¹ Plaintiffs did not, orally or in writing, reject the argument of *amici*. Indeed, at oral argument, in response to a question from the Court, plaintiffs began to enumerate the arguments of the *amici* supported by plaintiffs. Transcript of Oral Arg. 17-18 (A-18 to A-19). That response was cut short

Finding that the majority had adopted an “unlimited view of the copyright power,” Judge Sentelle dissented from the portion of the majority opinion upholding the retroactive extension of copyrights under the Copyright Clause. *See* 239 F.3d at 381. Drawing upon the Supreme Court’s analysis of the Commerce Power in *United States v. Morrison*, 529 U.S. 598 (2000), and *United States v. Lopez*, 514 U.S. 549 (1995), Judge Sentelle concluded that the Copyright Clause did not permit the CTEA’s retrospective extension of copyrights because “[t]he government has offered no tenable theory as to how retrospective extension can promote the useful arts.” *Id.* at 382. The rationale accepted by the majority did not have “any stopping point,” Judge Sentelle found, and would permit Congress to extend copyright protection indefinitely “through the guise of progressive extension of existing copyrights.” *Id.*

In reaching this conclusion, Judge Sentelle questioned the majority’s reliance upon *Schnapper*. Although Judge Sentelle found it erroneous to treat the promotion of progress language in the Copyright Clause as “merely introductory,” he recognized that the holding in *Schnapper* controls “unless and until that holding is changed by this Court *en banc* or by the higher authority of the Supreme Court.” 239 F.3d at 382. Judge Sentelle found, however, that language upon which the majority relied for the broad proposition that the first portion of the Copyright Clause imposed no restriction upon the power granted by that clause was *dicta*. *See id.*

ARGUMENT

I. THIS COURT SHOULD RECONSIDER *EN BANC* WHETHER THE COPYRIGHT CLAUSE PERMITS CONGRESS TO EXTEND THE TERM OF SUBSISTING COPYRIGHTS

Plaintiffs argued that the “introductory” language to the Copyright Clause — granting Congress the power “to promote the Progress of Science” — should guide this Court in its

by the panel’s question whether “is there any place in which you have adopted them, in your briefs?” *Id.*

interpretation of the term “limited Times.” Specifically, plaintiffs argued that even if this introductory clause were not an independent, substantive limit on individual *copyrights* granted under a copyright statute, it is plainly relevant to interpreting the proper scope of Congress’ power under the Copyright Clause. The majority, however, refused even to consider this language in construing the scope of the Copyright Clause, because it found any such argument foreclosed by this Court’s prior decision in *Schnapper v. Foley*, 667 F.2d 102 (D.C. Cir. 1982). Because this ruling conflicts with decisions of the Supreme Court, because *Schnapper* does not justify the panel’s determination, and because the panel’s ruling will have a profound effect on the public interest, this Court should reconsider that ruling *en banc*.

1. The majority held that the “introductory language” of the Copyright Clause does not “constitute[] a limit on congressional power.” 289 F.3d at 378. This holding is flatly contradicted by Supreme Court authority cited to the panel. *See* App. Br. at 20-22.

In the very first case interpreting the Copyright Clause, the Supreme Court made clear how that clause should be read. As the Court stated, the words of the Copyright Clause must be interpreted in light of the “words and sentences with which it stands connected.” *Wheaton v. Peters*, 33 U.S. (8 Peters) 591, 661 (1834). Consistent with *Wheaton*, the Court has long recognized that the power granted by that Clause is limited by the requirement that the power “promote the Progress of Science”—precisely the requirement that the panel rejected. Thirty-five years ago, the Supreme Court observed that the clause is

both a grant of power and a limitation. This qualified authority, unlike the power often exercised in the sixteenth and seventeenth centuries by the English Crown, is *limited to the promotion of advances in the “useful arts.”*

Graham v. John Deere Co., 383 U.S. 1, 6 (1966) (emphasis added). The Court unanimously reaffirmed this position more than a decade ago, *see Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989), and the Government has cited no intervening authority drawing this position into doubt.

In keeping with this authority, the Supreme Court has read the terms of the Copyright and Patent Clause more restrictively than those terms would have been read, absent the “introductory language” to the clause. For example, though the Copyright Clause says nothing about “originality,” the Supreme Court has narrowed the scope of “Writings” and “Authors” to those works that are “original” — excluding, for instance, facts from the scope of copyright protection, as well as matters in the public domain. *Feist Publ’n v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991); *Graham v. John Deere Co.*, 383 U.S. at 6; *Eldred*, 239 F.3d at 787 (“these teachings would indeed preclude the Congress from authorizing under that Clause a copyright to a work already in the public domain.”). Absent the “promote [] progress” language, this narrowing of these otherwise expansive terms would make *no sense*. “Originality” instead reflects the Supreme Court’s consistent reading of “Authors” and “Writings” in light of the “words and sentences with which it stands connected.” *Wheaton*, 33 U.S. at 661.

This same understanding underlies the *Trade-Mark Cases*, in which the Court found the Copyright and Patent Clause could not sustain a federal trademark law. Trademarks, the Court noted, were often granted for expression “already in existence.” *Trade-Mark Cases*, 100 U.S. 82, 94 (1879). That fact, the Court held, put trademarks beyond the scope of the “Authors” and “Writings” intended by the Copyright Clause. Even though these marks were plainly, at one point at least, “writings” by some “author,” the Court rejected this literal reading of the terms of the clause, and instead narrowed the scope of those terms to “Writings” and “Authors” that would promote progress. *Id.* (“And while the word *writings* may be liberally construed, . . . it is only such as are *original*, and are founded in the creative powers of the mind. . . .” (emphasis in original)). That restriction makes no sense unless the promotion of progress language in the first portion of the clause restricts the interpretation of “Authors” and “Writings.” Thus, the panel’s refusal to consider the “introductory” language of the Copyright Clause in construing the rest of the clause conflicts with the Supreme Court’s decisions construing that clause.

2. Although the panel relied upon this Court’s decision in *Schnapper*, Judge Sentelle correctly found that that case does not support such an expansive reading.

The plaintiff in *Schnapper* claimed that a copyright granted to the government was invalid under the Copyright Clause because protection of the work in question did not “promote the progress of Science.” See 667 F.2d at 111-12. In other words, the claim before this Court in *Schnapper* was that the first portion of the clause requires a court to decide whether *each copyright issued* satisfied the “promote progress” requirement. In *Mitchell Brothers Film Group v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979), the Fifth Circuit considered and rejected a similar claim on the ground that the clause simply “require[s] that Congress shall promote those ends,” not that every individual writing copyrighted do so. *Mitchell*, 604 F.2d at 859-60 (quotation omitted). Adopting this same rationale, this Court rejected the claim before it in *Schnapper*:

[T]he Fifth Circuit applied that standard to conclude that Congress need not “require that *each copyrighted work* be shown to promote the useful arts” [*Mitchell*,] 604 F.2d at 860. That being so, we cannot accept appellants’ argument that the introductory language of the Copyright Clause constitutes a limit on congressional power.

667 F.2d at 112 (emphasis added).

The panel has now expanded *Schnapper* to mean not only that the clause does not restrain individual copyrights, but also that it does not “require[] that Congress shall promote” progress. *Mitchell*, 604 F.2d at 859-60. As Judge Sentelle found, however, since the issue before the Court in *Schnapper* was whether the Copyright Clause requires each copyrighted work to promote progress, this statement was “simply *dicta* . . . and not binding on future panels.” 239 F.3d at 383. Indeed, because *Schnapper* failed to offer any justification for its sweeping assertion that the “words and sentences” in the Copyright Clause should be ignored by this Court, this statement was ill-considered *dicta*.

3. The panel did not — and could not — offer any justification for its refusal to require that a term extension “promote [] progress.” Indeed, as Judge Sentelle recognized, the Government

failed to offer even a “tenable theory” as to how a *retrospective* extension “can promote the useful arts.” 239 F.3d at 382. While a prospective extension might in theory increase the incentives to produce new work, incentives are in their nature forward-looking. Not even Congress can today increase the incentives to produce works authored in the past. Thus, a retrospective extension simply extends the monopoly control of a work “already in existence” and does not in any way meet “progress” requirements of the Copyright Clause. *Trade-Mark Cases*, 100 U.S. at 94; *see also United Christian Scientists v. Christian Science Bd. of Dir.*, 829 F.2d 1152, 1168 n.84 (D.C. Cir. 1987) (“A grant of copyright protection after the author’s death to an entity not itself responsible for creating the work provides scant incentive for future creative endeavors.”) (*dicta*).

Calling this a “crabbed view,” the majority asserted that a retrospective extension of the copyright term would provide an incentive to “preserve older works, particularly motion pictures in need of restoration” and therefore did promote progress by “[p]reserving access to works that would otherwise disappear.” 239 F.3d at 379. Whether or not such an argument might sustain a statute precisely targeted to decaying films, it cannot begin to justify the wholesale retrospective extension of all subsisting copyrights. If the mere claim that some “writing” would not exist but for monopoly protection sufficed, then the Supreme Court’s decision in *Feist* would be wrong. In that case, Rural Telephone Services Co. argued that copyright protection was necessary to give it sufficient incentive to produce phone books. *See Resp’t Br., Feist Publ’n v. Rural Tel. Co.*, No. 89-1909, 1990 WL 513113, at *7 (U.S. Dec. 17, 1990). Copyright, it argued, was therefore necessary to preserve, in the words of the panel, “access to works that would otherwise disappear.” *Eldred*, 239 F.3d at 379. The Supreme Court, however, rejected Rural Telephone Service’s argument. The “necessary justification” for the “monopoly” that the copyright law provides is “protecting and encouraging *the creation of ‘writings’ by ‘authors.’*” *Feist*, 499 U.S. at 354 (emphasis added) (citing 1 M. Nimmer & D. Nimmer, COPYRIGHT § 3.04, at 3-23 (1990)).

If any *possible* incentive to *preserve* sufficed under the Copyright Clause, then, as Judge Sentelle found in this case, there would be no “stopping point” to the monopoly protections that Congress might grant. The Framers, however, plainly intended a far narrower power, Judge Sentelle found. *See* 239 F.3d at 380. Thus, whether or not Judge Sentelle’s view of the Copyright Clause is “crabbed,” it is the Constitution’s view as interpreted by the Supreme Court.

II. THE PANEL’S CREATION OF A COPYRIGHT EXCEPTION TO THE FIRST AMENDMENT SHOULD BE RECONSIDERED *EN BANC*.

The panel held that “copyrights are categorically immune from challenges under the First Amendment” so long as copyright protects expression and not ideas. 239 F.3d at 375. Because this extraordinary rule is an unwarranted extension of Circuit and Supreme Court authority, with obvious and profoundly harmful effects on the public domain, it should be reconsidered by this Court *en banc*.

The panel reached its conclusion of “categorical[] immunity” in three steps:

(1) The panel viewed a challenge to the Copyright Act *as equivalent* to the assertion of “a first amendment right to express [oneself] using the copyrighted materials of others.” *United Video*, 890 F.2d at 1190; *Eldred*, 239 F.3d at 376.

(2) The panel found that the assertion of a first amendment right to use the copyrighted works of another — in effect a First Amendment right to trespass — had been rejected by the Supreme Court in *Harper & Row Publishers Inc. v. Nation Enterprises*, 471 U.S. 539 (1985), and by this Court in *United Video*. *See Eldred*, 239 F.3d at 375.

(3) Therefore, the panel concluded that a First Amendment challenge to a *Copyright Act* must also have been rejected by *Harper* and *United Video*. *See id.* at 376.

The panel has made a fundamental mistake that, if left uncorrected, will have profound effects on the continued viability of First Amendment protections for the public domain. The panel’s premise — that there is no First Amendment right to trespass, on tangible or intangible property — is certainly correct. But its conclusion — that therefore one cannot challenge the state action that creates the property right at stake — is obviously incorrect. That *private actors* are “immune” from First

Amendment challenges to the exercise of their state-granted rights does not entail that *the state* is immune from First Amendment challenges to the creation of those rights.

The abortion protest cases demonstrate the panel’s error. As this Circuit has recognized in the context of challenges to judicial orders crafting limitations on the rights of abortion protesters to block abortion facilities, “there is no . . . First Amendment right to trespass.” *NOW v. Operation Rescue*, 37 F.3d 646, 655 (D.C. Cir. 1994). But no court has ever suggested that abortion protesters therefore have no “First Amendment interest” in challenging the property rules, enforced by a court, that limit their ability to reach their intended audience. In *NOW v. Operation Rescue*, for example, this Court did not conclude that because Operation Rescue has no “First Amendment right to trespass,” Operation Rescue has no First Amendment interest in challenging the rules that define the property upon which the trespass occurs. Instead, this Court engaged in a careful First Amendment analysis of what it considered content-neutral regulations restricting Operation Rescue’s access to abortion clinics. *See id.* at 654-58.

Precisely the same point is at issue in this case, but applied now to intangible, rather than real, property. Plaintiffs do not assert a First Amendment right *against private actors* to get access to *otherwise legitimately copyrighted material*. Plaintiffs assert a First Amendment challenge to *Congress’ law* granting copyrights to already-created material. While courts have rightly exempted private actors from First Amendment limitations on the exercise of a properly granted copyright, there is *no basis* for the panel’s conclusion that Congress is exempt from First Amendment review of its copyright legislation. In every case that the Government and the panel cite, the issue was whether the holder of an otherwise legitimate copyright could be restrained by the First Amendment in the exercise of that copyright. The claim adjudicated was never that the copyrights at issue were invalid under the First Amendment *per se*.

This Court’s decision in *United Video* does not suggest otherwise. The petitioners in that case were not challenging the copyrights of the underlying work, or the right of Congress to protect

the works at issue. Instead, they wanted the right to broadcast otherwise legitimately copyrighted material. Their claim was that FCC rules affecting their access to that copyrighted material should be reviewed under *United States v. O'Brien*, 391 U.S. 367 (1968).

This Court rightly rejected their claim. “[C]ases in which a first amendment *defense* is raised to a copyright *claim* do not utilize an *O'Brien* analysis.” *United Video*, 890 F.2d at 1190 (emphasis added) (Wald, C.J.). Because the petitioner was not challenging the law that granted the copyrights at issue, the “petitioners are therefore in the position of claiming that they have a first amendment right to express themselves using the copyrighted materials of others.” *Id.* This “crucial fact distinguish[ed]” *United Video* from cases warranting normal First Amendment scrutiny. *Id.* Because there was no challenge to the underlying copyrights, the petitioners were left demanding a First Amendment right to trespass.

The panel in the instant case has ignored this “crucial fact.” Plaintiffs are not asking for the right to use otherwise legitimately copyrighted materials; plaintiffs assert that the copyrights at issue are not constitutionally granted. The panel has thus expanded the *United Video* rule far beyond the facts in that case — to include not only first amendment *claims* as well as “*defenses*,” but also challenges to the *Copyright Act* as well as to “*a copyright claim*.”

There is no authority for this extraordinary rule. The panel relied upon the *Supreme Court's* decision in *Harper & Row Publishing, Inc. v. Nation Enterprises*, but that case points to precisely the opposite conclusion. The issue in *Harper* was whether Harper & Row could assert its copyright against The Nation magazine. The Nation had used, without Harper & Row's permission, otherwise legitimately copyrighted material. The Court rejected the Nation's “First Amendment defense.” A “definitional balance,” the Court explained, existed between the First Amendment and copyrights. *See Harper*, 471 U.S. at 556. So long as the copyright protected expression only, there was no First Amendment right to use it against the will of the legitimate copyright holder. *See id.* The Court said

nothing about the right to challenge the Copyright Act itself; its concern was whether the First Amendment restricted the property right granted by the Copyright Act.

Indeed, to the extent that any intent about the matter can be inferred from *Harper*, it flatly contradicts the panel's conclusion. As is well recognized, the Supreme Court in *Harper* adopted the "definitional balance" suggested by Professor Melville Nimmer in his seminal article, *Does Copyright Abridge The First Amendment Guarantees Of Free Speech And Press?*, 17 UCLA L. Rev. 1180 (1970). *See Harper*, 471 U.S. at 556; *see also id.* at 548-68 (citing Professor Nimmer's treatise 20 times throughout opinion). In that same article, however, Professor Nimmer *expressly considered* a First Amendment challenge to a retrospective extension of copyright. Nimmer concluded, his "definitional balance" notwithstanding, that such an extension is inconsistent with the First Amendment. *See Nimmer, supra*, at 1194-95. Thus, Nimmer at least never meant this balance to preclude ordinary First Amendment review of changes to the Copyright Act, and there is nothing in *Harper* suggesting that the Court adopted a different rule.

Harper and *United Video* do nothing more than extend to intangible property the ordinary rule that applies to real property — that there is no "First Amendment right to trespass." *NOW v. Operation Rescue*, 37 F.3d 646, 655 (D.C. Cir. 1994); *Lloyd Corp. v. Tanner*, 407 U.S. 551, 568 (1972). But that meager holding cannot now be extended to immunize Congress from First Amendment review of its copyright laws generally.

It may well be that the Supreme Court will craft a special First Amendment rule for copyright laws passed by Congress. Given the extraordinary expansion in the importance of the public domain effected by the Internet, plaintiffs would argue strongly against such exemption from ordinary First Amendment review. Especially in light of the expanded First Amendment protection that this Court has granted new media, in light of technological changes, *see, e.g., Time-Warner Entm't v. FCC*, 240 F.3d 1126 (D.C. Cir. 2001), it would be unprincipled at best to exempt a class of affected speakers

from the protections of the First Amendment under a rule that grants more First Amendment immunity to intangible property than to tangible property.

But that is an argument for a different court. This panel had no authority or basis for crafting a “categorical immunity” for Congress from ordinary First Amendment review, in this context or in any other. This Court should therefore review the panel’s decision *en banc*.

III. THE PANEL’S REFUSAL TO CONSIDER ARGUMENTS ADVANCED BY AMICI SHOULD BE RECONSIDERED *EN BANC*.

The majority refused to consider certain arguments advanced by *amici* in support of plaintiffs’ position because those arguments had not been expressly adopted in plaintiffs’ briefs. *See* 239 F.3d at 378. This rule is without precedent, and is inconsistent with this Circuit’s own rules. As Judge Sentelle found, the *amici* brief in question did not raise a new issue. Instead, it addressed a claim indisputably raised by plaintiffs — whether the retrospective aspect of the CTEA was a constitutional exercise of Congress’ copyright power. The *amici* simply offered a new argument for that claim, one not expressly offered by plaintiffs.

Citing *Ashwander v. Tennessee Valley Authority*, 297 U.S. 288, 346 (1936) (Brandeis, J., concurring), the majority refused to consider the argument of *amicus* because it was not adopted in plaintiffs’ brief. There is no basis for this waiver rule. As Judge Sentelle noted, the Rules of this Court require that *amici* offer arguments that are not merely repetitive of the arguments made by the party they support. *See* 239 F.3d at 384; *see also* D.C. CIR. R. 29(a) (providing that *amicus* briefs “must avoid repetition of facts or legal arguments made in the principal ... brief, and *focus on points not made or adequately elaborated upon in the principal brief*”) (emphasis added). More significantly, under local rules, it may well be impossible for a party to endorse the arguments made in an *amicus* brief. The brief of an *amicus* is filed after the party’s brief. *See* D.C. CIR. R. 29(c); FED. R. APP. P. 29(e). Thus, an appellee would never have an opportunity expressly to endorse the arguments of *amici*, and because a “new” argument may not be raised in a reply brief, *see, e.g.*,

McBride v. Merrell Dow and Pharm., Inc., 800 F.2d 1208, 1210-11 (D.C. Cir. 1986), the appellant would not be permitted to endorse an argument of *amicus* in its reply. For these reasons, the Court *en banc* should reconsider and reject the panel's new rule of waiver.

CONCLUSION

For the reasons stated above, appellants' petition for rehearing and suggestion for rehearing *en banc* should be granted, and the panel's opinion reconsidered by this Court sitting *en banc*.

Dated: April 2, 2001

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Copyright's Commons*

CERTIFICATE OF SERVICE

I hereby certify that on this 2nd day of April, 2001, I caused a true and correct copy of the foregoing Petition for Rehearing and Suggestion for Rehearing *En Banc* to be served by first-class mail, postage pre-paid, on each of the following:

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ADDENDUM

**CERTIFICATE AS TO PARTIES AND AMICI
AND DISCLOSURE STATEMENT**

Pursuant to Circuit Rules 26.1, 28(a)(1)(A) and 35(c), undersigned counsel for Appellants hereby state that the following parties and *amici curiae* appeared before the district court and the panel of this Court:

Eric Eldred;

Eldritch Press: Eldritch Press is a non-profit unincorporated association that posts literary works on the Internet to make them freely available to the entire world. It has no parent companies and no publicly-held company has a 10% or greater ownership interest in the entity;

Higginson Book Company: Higginson Book Company is a for-profit sole proprietorship that reprints books based on consumer demand in fields such as genealogy, historic maps, local and county history, and the Civil and Revolutionary Wars. It has no parent companies and no publicly-held company has a 10% or greater ownership interest in the entity;

Jill A. Crandall;

Tri-Horn International: Tri-Horn International is a corporation in the business of developing and selling products involving the history and traditions of golf. It has no parent companies and no publicly-held company has a 10% or greater ownership interest in the entity;

Luck's Music Library: Luck's Music Library, Inc. is a corporation in the business of selling and renting classical orchestral sheet music. It has no parent companies and no publicly-held company has a 10% or greater ownership interest in the entity;

Edwin F. Kalmus & Co., Inc.: Edwin F. Kalmus & Co., Inc. is a corporation in the business of publishing orchestral sheet music. It has no parent companies and no publicly-held company has a 10% or greater ownership interest in the entity;

American Film Heritage Association: American Film Heritage Association is a non-profit film preservation group that was established to represent documentary film makers, film

preservationists, scholars, commercial archives and non-profit archives. It has no parent companies and no publicly-held company has a 10% or greater ownership interest in the entity;

Moviecraft, Inc.: Moviecraft, Inc. is an incorporated commercial film archive. It has no parent companies and no publicly-held company has a 10% or greater ownership interest in the entity;

Dover Publications, Inc.: Dover Publications, Inc. is an incorporated large-scale commercial book publisher. It has no parent companies and no publicly-held company has a 10% or greater ownership interest in the entity;

Copyright's Commons: Copyright's Commons serves as a collective voice for students, professors, archivists and other members of the public who are concerned about the negative effects of copyright term extensions on the public domain. It has no parent companies and no publicly-held company has a 10% or greater ownership interest in the entity;

Janet Reno, in her official capacity as Attorney General of the United States; and

The Sherwood Anderson Literary Estate Trust; The Sherwood Anderson Foundation; American Society of Composers, Authors, and Publishers; AmSong, Inc.; Association of American Publishers, Inc.; Broadcast Music, Inc.; Motion Picture Association of America, Inc.; National Music Publishers Association, Inc.; Recording Industry Association of America, Inc.; and The Songwriters Guild of America (*amici curiae* for Defendant-Appellee).

The following *amici curiae* did not appear in the district court but did appear before the panel of this Court:

L. Ray Patterson, Laura N. Gasaway, Edward Walterscheid, Eagle Forum Education, and
Legal Defense Fund (*amici curiae* for Plaintiffs-Appellants).

Dated: April 2, 2001

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