

**UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA**

ERIC ELDRED, ELDRITCH PRESS,	)	
HIGGINSON BOOK COMPANY,	)	
JILL A. CRANDALL,	)	
TRI-HORN INTERNATIONAL,	)	)
LUCK'S MUSIC LIBRARY, INC.,	)	
EDWIN F. KALMUS & CO., INC.,	)	
AMERICAN FILM HERITAGE	)	
ASSOCIATION, MOVIECRAFT, INC.,	)	
DOVER PUBLICATIONS, INC.,	)	
and COPYRIGHT'S COMMONS,	)	
	)	
Plaintiffs,	)	
	)	
v.	)	Case No. 1:99CV00065 JLG
	)	
JANET RENO, in her official capacity	)	
as Attorney General of the	)	
United States,	)	
	)	
Defendant.	)	
)		

**PLAINTIFFS' REPLY MEMORANDUM IN SUPPORT OF MOTION FOR  
JUDGMENT ON THE PLEADINGS OR IN THE ALTERNATIVE  
FOR SUMMARY JUDGMENT**

## TABLE OF CONTENTS

<b>TABLE OF AUTHORITIES</b> .....	ii
<b>ARGUMENT</b> .....	3
I. The Issue Presented by This Case Is One of First Impression. ....	3
II. Both the Prospective and Retrospective Aspects of the CTEA Violate the Free Speech and Press Clauses of the First Amendment. ....	8
A. Ordinary First Amendment Analysis Applies to a Challenge to the Duration of Copyright. ....	8
1. First Amendment Challenges to Copyright's Substantive Scope Are Not on Point. ....	9
2. The "Idea/Expression" Distinction Does Not Apply to Questions of Copyright Duration. ....	11
3. Ordinary First Amendment Analysis Should Therefore Govern Challenges to Copyright Duration. ....	14
B. The Government Has Not Met Its Burden under Intermediate Scrutiny for the Prospective Aspect of the CTEA. ....	15
III. The Retrospective Aspect of the CTEA Violates the Limited Times Clause of the Progress of Science and Useful Arts Clause. ....	18
A. "Limited Times" Must Be Read in Light of the Stated Purposes of the Copyright Clause. ....	18
B. The CTEA Does Not Secure Rights to "Authors." ....	21
C. The Authority that the Government Cites to Uphold Congress' Power to Increase Terms Retrospectively Is Plainly Not on Point. ....	22
IV. The Public Trust Doctrine Should Be Construed as a Constitutional Constraint upon Federal Law. ....	23
<b>CONCLUSION</b> .....	25

## TABLE OF AUTHORITIES

### CASES

<u>Burrow-Giles Lithographic Co., v. Sarony</u> , 111 U.S. 53 (1884) .....	5, 6
<u>Central New Orleans Broad. Assoc., Inc. v. United States</u> , 119 S.Ct. 1923 (1999) .....	16
<u>Century Communications Corp. v. Federal Communications Comm'n</u> , 835 F.2d 292 (D.C. Cir. 1987) .....	10
* <u>Feist Publications, Inc. v. Rural Telephone Service Co., Inc.</u> , 499 U.S. 340 (1991) .....	2, 19, 20
<u>Florida Prepaid Postsecondary Educ. Expense Bd. v. College Sav. Bank</u> , 119 S.Ct. 2199 (1999) .....	24-25
<u>Greater New Orleans Broad. Assoc., Inc. v. United States</u> , 119 S.Ct. 1930 (1999) .....	16
* <u>Harper &amp; Row Publishers, Inc. v. Nation Enterprises</u> , 471 U.S. 539 (1985) .....	7, 10, 11, 12, 13, 16, 20
<u>Hudson Gas &amp; Elec. Corp. v. Public Serv. Comm'n</u> , 447 U.S. 557 (1980) .....	16
<u>International Techns. Consultants, Inc. v. Pilkington PLC</u> , 137 F.3d 1382 (9th Cir. 1998) .....	25
<u>Ladd v. Law &amp; Tech Press</u> , 762 F.2d 809 (9th Cir. 1985) .....	20
<u>Marbury v. Madison</u> , 5 U.S. (1 Cranch) 137 (1803) .....	1
<u>McClurg v. Kingsland</u> , 42 U.S. (1 How.) 202 (1843) .....	3, 4
<u>Pennock &amp; Sellers v. Dialogue</u> , 27 U.S. (2 Pet.) 1 (1829) .....	4, 5
<u>Schnapper Public Affairs Press v. Foley</u> , 667 F.2d 102 (D.C. Cir. 1981) .....	18
* <u>Sony Corp. v. Universal City Studios, Inc.</u> , 464 U.S. 417 (1984) .....	13, 16, 20
* <u>Turner Broadcasting System, Inc. v. Federal Communications Comm'n</u> , 520 U.S. 180, 189 (1997) .....	15, 16, 17

* <u>United Christian Scientists v. Christian Science Bd. of Dirs.</u> , 829 F.2d 1152 (D.C. Cir. 1987) .....	2, 7
<u>United States v. 1.58 Acres of Land</u> , 523 F. Supp. 120 (D.Mass. 1981) .....	23
* <u>United States v. O'Brien</u> , 391 U.S. 367 (1968) .....	10, 15, 16, 17
<u>United Video Inc. v. Federal Communications Comm'n</u> , 890 F.2d 1173 (D.C. Cir. 1989) .....	7, 9, 10, 11

**STATUTES AND OTHER LEGISLATIVE AUTHORITY**

*United States Constitution, Article I, § 8, cl. 8 .....	passim
*United States Constitution, First Amendment .....	passim
Sonny Bono Copyright Term Extension Act of 1998 ("CTEA"), Pub. L. No. 105-298, 112 Stat. 2827 .....	passim
Act of February 2, 1831, §§ 1-2, 4 Stat. 35 .....	2
Act of March 4, 1909, § 4, 35 Stat. 1075 .....	2

**OTHER AUTHORITIES**

Patry, William, <u>The Failure of the American Copyright System: Protecting the Idle Rich</u> , 72 Notre Dame L. Rev. 907 (1997) .....	21
Story, J., <u>Commentaries on the Constitution of the United States</u> § 502 .....	24-25

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

ERIC ELDRED, *et al.*,

Plaintiffs,

v.

JANET RENO, in her official capacity  
as Attorney General of the  
United States,

Defendant.

Case No. 1:99CV00065 JLG

**PLAINTIFFS' REPLY MEMORANDUM IN SUPPORT OF MOTION FOR  
JUDGMENT ON THE PLEADINGS OR IN THE ALTERNATIVE  
FOR SUMMARY JUDGMENT**

To read the Government's and Amici's brief, you would think that plaintiffs were asking this Court to overturn Marbury v. Madison. "Two centuries" of Congressional practice, in the words of the Government, Government's Memorandum ("Gov. Mem.") at 4, and repeated "holdings" by the Supreme Court and Court of Appeals, in the words of Amici, see infra at 6-8, make plaintiffs' claims "revolution[ary]." Amici's Memorandum ("Am. Mem.") at 1. Our argument (that Congress' power under the "limited Times" clause is, well, "limited") is drawn, the Government argues, from "whole cloth," Gov. Mem. at 1, and our complaint, in the words of Amici, is nothing short of a "manifesto." Am. Mem. at 1.

With all due respect, this rhetoric is out of line. There is nothing so dramatic in this case. The Government and Amici write as if the issues present have already been resolved elsewhere by other courts. They have not. No decision cited by the Government or Amici has considered (let alone "held") that Congress is absolutely

free to extend retrospectively the terms of copyright. Nor has any decision cited by the Government or Amici suggested (let alone “held”) that copyright legislation is not subject to the same First Amendment that all other speech-regulating legislation is.<sup>1</sup> Plaintiffs’ claims are of first impression, but there is nothing “revolutionary” in asking this Court to apply well-established First Amendment doctrine to the legislation of Congress, or in asking this Court to read the claim in light of the Supreme Court’s unanimous holding in Feist Publications, Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340 (1991), narrowly interpreting the Copyright Clause power.

If there is revolution here, it is in the recent practice by Congress. In the first 100 years after the first Copyright Act, Congress extended the term of copyright just once. Act of February 2, 1831, §§ 1-2, 4 Stat. 36. In the next fifty years, Congress extended the term of copyright just once again. Act of March 4, 1909, §4, 35 Stat. 1075, 1076. But in the last thirty-seven years, Congress has extended the term of subsisting copyrights at least eleven times. See Plaintiffs' Memorandum ("Pl. Mem.") at 11 n.7, 12, 13.

At bottom, this case comes to this: Under the Government's and Amici's reading of the Copyright Clause, Congress is free to extend the terms of subsisting copyrights indefinitely; and Congress is free to extend the terms of copyright prospectively without limit. Plaintiffs submit that the “limited Times” clause of the

---

<sup>1</sup> Though where the Court of Appeals did consider it in dicta, it was not encouraging of retroactive extension. See United Christian Scientists v. Christian Science Bd. of Dirs., 829 F.2d 1152, 1169 n.84 (D.C. Cir. 1987) (retroactive extension provides “scant incentive for future creative endeavors”).

framers' constitution had no such meaning, and that it cannot have such a meaning in light of well established First Amendment law.

## ARGUMENT

### I. The Issue Presented by This Case Is One of First Impression.

Plaintiffs argue (1) that the retrospective and prospective increase of the Sonny Bono Copyright Term Extension Act of 1998, Pub. L. No. 105-298, 112 Stat. 2827 ("CTEA"), violates the Free Speech and Press Clause of the First Amendment, and (2) that the retrospective extension of a copyright term by the CTEA, in light of the First Amendment values that it implicates, violates the terms of the Copyright Clause. The Government and Amici respond with a parade of citations that they suggest decide the questions raised by plaintiffs' complaint. Indeed, Amici go so far as to claim that certain "holdings" by the Supreme Court and Court of Appeals resolve plaintiffs' claim. See infra at 6-8.

The Government and Amici are abusing the authority they cite. In none of the cases cited by Amici were either the Supreme Court or the Court of Appeals asked to address the questions presented here. They therefore not only did not hold, as Amici suggest, plaintiffs' claims invalid; their opinions are not even directed at the claims we raise. Similarly, the Government, too, relies upon authority that neither resolves nor even addresses the issues presented by this case.

For example:

- The Government asserts that McClurg v. Kingsland, 42 U.S. (1 How.) 202 (1843), "specifically reaffirms Congress's authority to enact laws under the Patent and

Copyright Clause that are ‘retrospective in their operation.’” Gov. Mem. at 4-5. What the Court actually said was “the powers of Congress to legislate upon the subject of patents is plenary.” McClurg, 42 U.S. (1 How.) at 206 (emphasis added). The Court did not address (1) the question of copyright nor did it address (2) the question of a general retrospective extension of the term of patent protection. The Government asserts that “plaintiffs offer no principled reason” to distinguish patents from copyrights. Gov. Mem. at 5 n.1. That is simply false. Plaintiffs explicitly addressed the distinction in our opening brief, Pl. Mem. at 82-84. We argued for the “principled distinction” drawn by copyright scholar Melville Nimmer — that Congress’s power under the Copyright Clause, in light of the free speech interests that it regulates, is constrained by the First Amendment, while patent law (ordinarily) is not. The distinction between the reach of Congress’ power over speech and the reach of its power over action is nothing new: The same Commerce Clause gives Congress very different powers over the Washington Post than over the Washington Redskins. The difference is a difference in the interests being regulated, even if the constitutional text is the same.<sup>2</sup>

- The Government suggests that “Pennock & Sellers v. Dialogue, 27 U.S. (2 Pet.) 1, 16 [sic] (1829)” stands for the idea that Congress’s “discretion,” id. at 17, is

---

<sup>2</sup> The Government relies upon McClurg to suggest that Congress has an unconstrained power to change copyright law retrospectively. But the very next paragraph after the one the Government cites, apparently overlooked by the Government, belies the claim. While acknowledging the retrospective aspect of the statute at issue, the Court went on to state “this repeal, however, can have no effect to impair the right of property then existing . . . .” 42 U.S. (1 How.) at 206. The authority for this limitation was judicial. Clearly that Court acknowledged limitations on Congress’ retrospective power just as plaintiffs assert such limitations here.



unconstrained. This must be the purpose of the Government’s citation, because obviously plaintiffs have not argued that Congress has no discretion in setting copyright’s terms. But in fact Pennock & Sellers has nothing to do with the scope of Congress’ discretion, and indeed, does not address the scope of the “limited Times” clause at all. Pennock & Sellers more accurately stands for a principle that plaintiffs fully endorse: That the patent act be interpreted against the background of its animating constitutional principle — namely that

[w]hile one great object was, by holding out a reasonable reward to inventors, and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius; the main object was "to promote the progress of science and useful arts;" and this could be done best, by giving the public at large a right to make, construct, use, and vend the thing invented, at as early a period as possible . . . .

Id., at 19 (emphasis added).

- The Government and Amici argue that Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53 (1884), makes a "consistent, longstanding interpretation of the Copyright Clause by the Congress, which has controlled the rights of copyright holders for two centuries . . . in and of itself, ‘almost conclusive.’” Gov. Mem. at 5. Indeed, Amici chide plaintiffs for failing to acknowledge that “the history of the Copyright Acts of 1790, 1831, 1909, and 1976” make its interpretation of the Copyright Clause “almost conclusive” in light of “the holding” of the Supreme Court in Burrow-Giles. Am. Mem. at 4-5 & n.4.

But again, the Government and Amici abuse the authority. Burrow-Giles does not “hold” that a long standing practice is “almost conclusive[ly]” constitutional. What Burrow-Giles actually says is that the

construction placed upon the constitution by the first act of 1790 and the act of 1802, by the men who were contemporary with its formation, many of whom were members of the convention which framed it, is of itself entitled to very great weight, and when it is remembered that the rights thus established have not been disputed during a period of nearly a century, it is almost conclusive.

111 U.S. at 57 (emphasis added). Burrow-Giles is about the authority that comes from the framing generation, not from long-standing Congressional practice.

Plaintiffs have not checked, but we doubt that there were any “members of the convention” sitting in Congress in 1831. We are certain that there were none in Congress in 1909, much less in 1976. Thus, the only relevant “construction,” under Burrow-Giles, is the construction of the Act of 1790. Plaintiffs acknowledge that Act did reach existing publications. But we vigorously deny that that alone establishes the principle that retrospective copyright extension was unremarkable to the framers. The first Congress confronted a preemption problem with copyright — existing state law granted copyrights which the Federal Act was intended to cover. The initial reach of the Act clarified that state vs. federal conflict. It certainly alone cannot stand for the proposition advanced by the Government that the retrospective power of Congress is unconstrained.

- But finally, it is the repeated assertions by Amici that the Supreme Court has “held” one way or the other that plaintiffs object to most forcefully. Amici assert that the Supreme Court has “held” that copyright law is not to “be tested by First Amendment standards,” Am. Mem. at 7, 9; that the “dichotomy between idea and expression prevents copyrights from violating the First Amendment (as Harper & Row and United Video hold),” id. at 8; and that the argument that “the First

Amendment restricts the scope of copyright law” is contrary to the “holdings of the Supreme Court and the Court of Appeals in Harper & Row and United Video.” Id. at 8 n.8.

With all due respect to Amici, these are not holdings. A court cannot “hold” with respect to issues that it was not asked to address. Neither Harper & Row Publishers v. Nation Enterprises, 471 U.S. 539 (1985), nor United Video Inc. v. Federal Communications Commission, 890 F.2d 1173 (D.C. Cir. 1989), addresses the general question whether “the First Amendment restricts the scope of copyright law”; they do not address the proper First Amendment analysis to apply to changes in copyright duration; and they certainly do not “hold” (or even imply) that the First Amendment does not apply to copyright law. Indeed, such a “holding” is unimaginable. If Congress granted copyright to Republicans, but not Democrats, or if it restricted the copyright of those who criticize the government, or if it granted extensions of copyright to only one type of organization and not another, then certainly the Supreme Court and the Court of Appeals would quickly invoke the First Amendment to nullify such copyright laws. Nothing in the authority of the Supreme Court or the Court of Appeals, let alone in their holdings, has said anything to the contrary.

There is just one incontrovertible fact about this case: No Court has reviewed the constitutionality of a copyright term, whether retrospective or prospective.<sup>3</sup> The

---

<sup>3</sup> Though as plaintiffs have noted, the Court of Appeals has considered such a case, but resolved it on Establishment Clause grounds. See United Christian Scientists v. Christian Science Bd. of Dirs., 829 F.2d 1152 (D.C. Cir. 1987).

question presented here must therefore be answered by drawing from the existing authority principles that might guide.

**II. Both the Prospective and Retrospective Aspects of the CTEA Violate the Free Speech and Press Clauses of the First Amendment.**

**A. Ordinary First Amendment Analysis Applies to a Challenge to the Duration of Copyright.**

Neither the Government nor Amici deny plaintiffs' core claim: that copyright law is a regulation of speech. They argue instead that the only First Amendment limitation on this regulation of speech is the one crafted by Congress, namely, that copyrights protect "expression" only, and not "ideas." Gov. Mem. at 15; Am. Mem. at 8. So long as the Copyright Act maintains that distinction, the Government and Amici argue, the Act must survive any First Amendment challenge.

This simply cannot be the law, and the Supreme Court has never said so. Again, if Congress made a viewpoint-based judgment in granting copyright protection — if it protected Democratic speech rather than Republican, or pro-government speech only — then there can be no doubt but that the First Amendment would invalidate such a copyright law, even if that law protected "expression" only. This is because the "idea/expression" distinction suffices to protect some First Amendment values in the context of copyright's substantive scope, but does not adequately protect all First Amendment values in all contexts of copyright's reach.

The proper question, then, is whether the "idea/expression" distinction protects First Amendment values in the context of a challenge to a copyright term.

Neither the Government nor Amici offer this Court any argument for finding that it does. Instead, they argue both that a copyright's duration cannot be distinguished from a copyright's scope (Am. Mem. at 8) and, in contradiction, that duration and scope are distinct. Compare Am. Mem. at 8, with Gov. Mem. at 17-18.

Plaintiffs maintain (1) that the question of duration is distinct from the question of copyright's substantive scope (where the Supreme Court and the Court of Appeals have applied the "idea/expression" distinction); (2) that the "idea/expression" distinction cannot sensibly be applied to the question of duration; and (3) that ordinary First Amendment analysis should therefore be applied to challenges to the duration of copyright.

1. *First Amendment Challenges to Copyright's Substantive Scope Are Not on Point.*

The Government and Amici cite several cases where the Supreme Court and Court of Appeals have rejected what amounts to a "first amendment defense" to a copyright infringement action, such as United Video, which found that Congress had adequately protected First Amendment interests through the "idea/expression" distinction and the guarantee of "fair use". Gov. Mem. at 15; Am. Mem. at 8. From these cases about the substantive scope of copyright, the Government and Amici infer that the only First Amendment issue raised by the copyright act is whether copyright protects expression (rather than ideas) only. Plaintiffs have already shown that this inference is flawed. Moreover, the question in the cases the Government and Amici cite is fundamentally distinct from the question of a copyright's duration.

At stake in each of these cases was the right of a non-copyright holder to use

otherwise validly copyrighted material without the permission of the copyright holder. The question was not whether a copyright was valid; instead, the question was whether a particular use could be compelled, copyright notwithstanding. These cases therefore address copyright's substantive scope and are plainly distinct from the question plaintiffs raise: Our claim is not that we have a right to use otherwise validly copyrighted material. Our claim is that the material at issue is not validly (i.e., constitutionally) copyrighted.

Thus, in Harper & Row, the Nation claimed that if an excerpt from President Ford's biography, scooped from a national publication, were not "fair use" under the Copyright Act, then it was entitled to a defense against an infringement suit under the First Amendment. 471 U.S. at 555-56. The Nation was not arguing that President Ford's biography should not otherwise be copyrighted; it was arguing simply about the scope of an otherwise valid copyright. The First Amendment gave it, the Nation argued, a right to use the excerpt it selected, the otherwise valid copyright notwithstanding.

Likewise, in United Video, petitioners argued that they had a First Amendment right to rebroadcast copyrighted television shows across the cable system. They asked the Court of Appeals to test the Federal Communications Commission's rules restricting the rebroadcast under the standards of United States v. O'Brien, 391 U.S. 367 (1968). The Court of Appeals refused to apply O'Brien, even though it had applied O'Brien earlier in the "must carry" case, Century Communications Corp. v. Federal Communications Commission, 835 F.2d 292 (D.C.

Cir. 1987). United Video, 890 F.2d at 1190-91. As Judge Wald distinguished the two cases, the “petitioners [in United Video] are ... in the position of claiming that they have a first amendment right to express themselves using the copyrighted materials of others. This crucial fact distinguishes the case from Century Communications.” Id. at 1190 (emphasis added). Like Harper & Row, petitioners were challenging the scope of an otherwise valid copyright, and the Court of Appeals refused to apply the First Amendment directly to police that challenge.

These cases are fundamentally distinct from the issues here. Plaintiffs are not “claiming that they have a first amendment right to [use] the copyrighted materials of others.” We claim the CTEA improperly extends the copyright term to these materials.

2. *The “Idea/Expression” Distinction Does Not Apply to Questions of Copyright Duration.*

Neither the Supreme Court nor the Court of Appeals has limited its First Amendment review of copyright legislation solely to the “idea/expression” distinction. Nor has either court ever applied the distinction outside the context of a challenge to the substantive scope of copyright. The distinction has thus been limited to a single context testing copyright’s reach.

Nonetheless, both the Government and Amici contend that the “idea/expression” distinction should be extended to questions about copyright duration. Yet, neither suggests why extending the test would make sense of First Amendment values.

Plaintiffs submit that it would not make sense of the Supreme Court’s First

Amendment doctrine to extend this special application of the First Amendment beyond the narrow class of cases to which the Supreme Court and lower courts have applied it. This is because (1) to do so would conflict with the Supreme Court’s understanding of the coherence of copyright law and the First Amendment and (2) unlike the “idea/expression” distinction, and “fair use,” Congress has not adopted duration requirements while self-consciously reckoning the First Amendment values at stake.

(1) As both the Government and Amici assert, if the “idea/expression” distinction were used to test copyright duration, then every duration would survive this test. Gov. Mem. at 17-18; Am. Mem. at 8. But under the Supreme Court’s reasoning, not every duration is consistent with the First Amendment. Under the principles it has outlined for reckoning Congress’ copyright power with the First Amendment, while some copyright durations plainly are consistent with First Amendment values, others plainly are not. The “idea/expression” distinction cannot separate these consistent cases from the inconsistent cases and, therefore, is an inappropriate First Amendment test.

Harper & Row states these principles most simply. In explaining why copyright does not conflict with the First Amendment generally, the Supreme Court observed what commentators had long argued: that because copyright law ordinarily functions as “an engine of free expression,” 471 U.S. at 558, it does not ordinarily function to “abridg[e]” speech. While it may restrict some speech for “limited Times,” this restriction enables the production of more creative speech generally.



That is the copyright clause’s aim, perfectly consistent with the First Amendment: “to motivate the creative activity of authors and inventors . . . and to allow the public access . . . after the limited period of exclusive control has expired.” Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984).

But not every increase in a copyright term increases the “creative activity of authors and inventors.”<sup>4</sup> And where an increase in a copyright term cannot increase “creative activity,” it cannot be justified by the Harper & Row principles. An increase in a copyright term that produces no increase in creative activity would function as a brake on free expression, not as an engine — a brake because by definition, the increase would be reducing the resources available to other others, while not increasing creative production in exchange.

An obvious example is a retrospective increase in a copyright term: Increasing the term of protection in 1998 for works created in 1923 obviously cannot increase the incentive to produce works in 1923. See Varian Aff. ¶ 12 (attached to Pl. Mem. at Ex. B). One cannot incent backwards. Thus a retrospective increase in a copyright term cannot be justified under a principle that requires that speech restrictions be justified by an increase in “creativity activity.”

Significantly, the Government does not contest plaintiffs claim about the effect of retrospective term extension. It argues instead that inducing creative

---

<sup>4</sup> Amici accuse us of arguing for a standard that would require that each copyright be shown to create an incentive to produce. Plaintiffs make no such argument. Under the standards of intermediate scrutiny, it is enough if the system of protection that Congress enacts creates a sufficient incentive, and that changes in that system that constrain more speech be shown to increase incentives to produce.

activity is not the only legitimate purpose under the Copyright Clause. Gov. Mem. at 9-13. But whether there are other purposes under the Copyright Clause is irrelevant to the First Amendment analysis. The First Amendment inquiry is whether a restriction on speech can be said to induce more creative speech. With respect to the retrospective portion of the CTEA, there is no remaining dispute of a material fact: the Government effectively concedes, as plaintiffs argue, that it does not.

Thus there is at least one important class of changes to duration of copyright that is inconsistent with the principles the Supreme Court has articulated for integrating copyright and the First Amendment. But the “idea/expression” distinction cannot distinguish that class of changes in duration from any other. It is therefore an inadequate test for determining whether a change to the duration of copyright is consistent with the First Amendment. Another test is therefore needed.

(2) Plaintiffs also submit that it would be inappropriate to defer to Congress’ judgment about the relationship between the duration of copyright and First Amendment values, because unlike the “idea/expression” distinction, or the codification of “fair use,” Congress has not shown a sensitivity to First Amendment values in extending the term of copyright. It was because the “idea/expression” distinction and “fair use” were self-consciously grafted onto the Copyright Act in light of First Amendment values that courts initially deferred to Congress’ device for protecting free speech values. But there is no similar appreciation in the context of copyright duration. Congress has not attempted to balance in the structure of the

statute itself First Amendment interests affected by copyright duration; there is no reason for this Court to defer to a judgment Congress did not make.

3. *Ordinary First Amendment Analysis Should Therefore Govern Challenges to Copyright Duration.*

Thus, it is apparent that (a) neither the Supreme Court nor Court of Appeals has held that the only First Amendment review of copyright legislation is the review of the “idea/expression” distinction, (b) the only cases applying that limited First Amendment analysis are cases challenging the substantive scope of a copyright, and (c) the limited review of the “idea/expression” distinction cannot distinguish changes in duration that advance legitimate First Amendment interests from changes in duration that do not. Consequently, plaintiffs submit, there is no reason to extend the category of cases that get this exceptional form of First Amendment review. Instead, the Court should apply ordinary First Amendment review to changes in the copyright term.

**B. The Government Has Not Met Its Burden under Intermediate Scrutiny for the Prospective Aspect of the CTEA.**

As plaintiffs argued in their opening brief, under ordinary First Amendment analysis, copyright legislation is a content-neutral regulation of speech. Pl. Mem. 38-40. As such, it survives First Amendment scrutiny only if the Government can show that its speech regulation “[1] advances important governmental interests unrelated to the suppression of free speech and [2] does not burden substantially more speech than necessary to further those interests.” Turner Broadcasting Sys., Inc. v. Federal Communications Comm'n, 520 U.S. 180, 189 (1997) (“Turner II”); see

also O'Brien, 391 U.S. at 377.<sup>5</sup>

The Government argues that the CTEA survives intermediate scrutiny first because it advances “important governmental interests” beyond creating an incentive to produce, and second because (at least prospectively) the CTEA actually does create an incentive to produce by creating “a ‘general anticipation of familial benefit.’” Gov. Mem. at 18-19 n.5.

The Government has not met its burden under O'Brien. First, plaintiffs submit that the only “important governmental interest[ ] unrelated to the suppression of free speech,” O'Brien, 391 U.S. at 377, is the interest recognized by Sony Corp., and harmonized in Harper & Row: the interest in “motivating creative activity,” Sony Corp., 464 U.S. at 429, that renders the copyright clause an “engine of free expression.” Harper & Row, 471 U.S. at 558. This, plaintiffs argue, and the Government does not contest, the retrospective aspect of the CTEA plainly does not advance. And, as we argued above, whether these other “interests” are legitimate or

---

<sup>5</sup> Plaintiffs have applied the heightened scrutiny of O'Brien, but the same analysis would follow if the Court considered this a regulation of commercial speech. As the Supreme Court recently applied that test,

"At the outset, we must determine whether the expression is protected by the First Amendment. For commercial speech to come within that provision, it at least must concern lawful activity and not be misleading. Next, we ask whether the asserted governmental interest is substantial. If both inquiries yield positive answers, we must determine whether the regulation directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest."

Greater New Orleans Broad. Assoc., Inc. v. United States, 119 S.Ct. 1923, 1930 (1999) (quoting Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n, 447 U.S. 557, 566 (1980)). The speech at issue in this case (plaintiffs' speech) would clearly be protected speech; in principle the government's interest is substantial. The question is resolved using the same inquiry as in Turner II.

not, they are not properly speech interests. The government may pursue them; it just cannot pursue them through the suppression of speech.

Second, even if these other interests were legitimate speech interests, the Government only meets its burden under O'Brien if it can demonstrate that these interests are also “important” governmental interests. The Government argues that they are because they are “expressly included in the powers conferred upon Congress.” Gov. Mem. at 18 n.5. Plaintiffs don’t find the power to “harmonize” national law with international law “expressly included” in the powers conferred upon Congress. Instead, if that power is within Congress’ power, it is because it is properly understood to be within the scope of the Copyright Clause power. But if that is the basis for determining whether an interest is an “important governmental interest,” then the Government has confused “important” with “any”. Obviously Congress may not legislate beyond its enumerated powers. But the intermediate scrutiny of the First Amendment requires that speech be suppressed only if the Government can identify an “important” interest to justify that suppression. The ipse dixit of the Government does not an “important” interest make, and the Government cites no authority establishing that the interests it identifies as “important” have been so recognized by the Supreme Court or Court of Appeals.

Third, even if these interests were “important,” and even if the prospective aspect of the CTEA did in theory create an additional incentive, the Government has not even addressed the second test of O'Brien: showing that the CTEA “does not burden substantially more speech than necessary to further those interests.” Turner

II, 520 U.S. at 189. Since the Government has made no effort to meet this burden, judgment against it is required.<sup>6</sup>

**III. The Retrospective Aspect of the CTEA Violates the Limited Times Clause of the Progress of Science and Useful Arts Clause.<sup>7</sup>**

**A. “Limited Times” Must Be Read in Light of the Stated Purposes of the Copyright Clause.**

Plaintiffs argued in their opening brief that the term “limited Times” must be read in light of the stated purposes of the Copyright Clause and that, so understood, changes to the copyright term that restrict the speech of some, but that do not increase incentives to produce, are ultra vires.

The Government and Amici respond by arguing that there are many purposes that Congress might pursue under the Copyright Clause, not just the two that plaintiff identify, and that the CTEA is justified by these other purposes. Gov.

---

<sup>6</sup> The Government also relies upon the testimony of songwriter Alan Mencken before the Senate Judiciary Committee. As Mencken said,

"There comes a point in most people's lives when one must make a practical decision about the choice of career. The continuing ability to provide for one's family both during and after one's lifetime would certainly be a factor."

Gov. Mem. at 8 n.2 (quoting Senate CTEA Hearings at 44). Plaintiffs applaud Mencken's "practical" perspective. We submit, however, that few "practical" songwriters choose their career based upon whether their great-great grandchildren will continue to enjoy the monetary benefits (whatever they will be) of a 140 year old song — few, and certainly not enough to outweigh the general and pervasive suppression of speech effected by the restrictions of CTEA.

<sup>7</sup> Plaintiffs' First Amendment argument challenges both the retrospective and prospective aspects of the CTEA. Our Copyright Clause argument challenges the retrospective aspect of the CTEA only. Thus the Government's arguments about the prospective effect of the CTEA are irrelevant to this part of plaintiffs' claims.

Plaintiffs have argued that the retrospective aspect of the CTEA cannot be severed from the prospective, and that a finding that one part is unconstitutional would require the striking of the whole. Pl. Mem. at 87-89. The Government does not respond to that argument.

Mem. at 18-19 n.5; Amici Mem. at 9 n.9. Applying a rational basis test, the Government and Amici maintain that these other purposes suffice.

The Government and Amici have simply missed the point. We do not argue that the Purpose Clause is an independent constraint on the scope of Congress' copyright power. That was the issue in Schnapper Public Affairs Press v. Foley, 667 F.2d 102 (D.C. Cir. 1981), and plaintiffs do not question the holding in that case. What we argue is that this Court must interpret the term "limited Times" in light of the plain purposes stated in the text of the Constitution. Whether or not the Purpose Clause of the Progress of Science and useful Arts Clause is an independent limitation on Congress' power, there can be no doubt about the "limited Times" clause. It plainly was intended as — and its meaning clearly is — a constraint on the scope of Congress' Copyright Clause power.

The only question is the meaning of that constraint. Our argument is that between two plain readings of that text — one the Government's, that essentially permits Congress to increase the copyright terms perpetually, and the other offered by the plaintiffs, which understands "limited Times" in the same sense as "term limits," setting a time which cannot then be extended — that this Court should select the reading that makes sense of the stated purpose. We have explained why our reading makes better sense of the stated, and understood, purpose of the clause. Pl. Mem. at 28-33. The Government has not responded to that argument.

Nonetheless, we do reject the Government's and Amici's assertion that Congress is free to select whatever purpose it likes in enacting copyright legislation,

and that a court must review Congress' choice under rational basis. That was not the Court's understanding of its role in Feist, where a strong view of the constitutional limitations operating upon Congress lead it to read the Copyright Act narrowly. If rational basis were the only limit, then the limitations, both express and implied, in Feist would make no sense. Nor has it been the Court's understanding in practically every major Copyright and Patent Clause case that it has decided: Consistently, its view has been that the purposes of the Progress of Science and useful Arts Clause are limited. See, e.g., Harper & Row, 471 U.S. at 546-49 (interpreting Copyright Act in light of limited grant of "limited Times" clause); Sony Corp., 464 U.S. at 429; Ladd v. Law & Tech. Press, 762 F.2d 809, 812 (9th Cir. 1985) (describing primary purpose of "limited Times" clause as "to promote the arts and sciences for the public good, not to grant an economic benefit to authors and inventors"); see also Feist, 499 U.S. at 346-47 (finding originality requirement to be based in "limited Times" clause, the "source of Congress's power to enact copyright laws").

This is a feature of the copyright clause, not a mistake. It was designed to restrict the scope of Congress' monopoly power, not to set monopoly-making free. The purpose of copyright's "monopoly privilege," as the Supreme Court described it in Sony Corp., it is not

primarily . . . to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors . . . and to allow the public access to the products of their genius after the limited period of exclusive control has expired.

464 U.S. at 429 (emphasis added). These, plaintiffs believe, are the legitimate ends



that this “monopoly privilege” must serve. They are consistent with the restrictions of the First Amendment, and make sense of the framers’ purpose.

The Government and Amici want to add to this list of purposes, but they have cited no case where the Supreme Court recognized the power of Congress to suppress speech independently of these primary purposes. Obviously, a copyright act is not rendered unconstitutional merely because it pursues purposes in addition to the purpose “to motivate the creativity of authors and inventors . . . and to allow the public access . . . after [a] limited period.” But it must at least serve those purposes. And these purposes the retrospective aspect of the CTEA does not advance.

**B. The CTEA Does Not Secure Rights to “Authors.”**

Plaintiffs have also argued that the CTEA secures rights other than to “Authors.” By its terms, the CTEA grants some authors the right to terminate copyright assignments, or transfers. But with respect to authors who terminated their assignment under the 1976 Act, the CTEA explicitly denies those authors the right of termination. Pub. L. No. 105-298, § 102(d)(1)(D), 112 Stat. 2827, 2828. For copyrights where a transfer was terminated under the 1976 Act, the CTEA by its terms grants its extension to people other than authors.

The Government defends this scheme by arguing that it was the author, not the Government, that made the initial assignment that denies her any benefit of extension and that, in making that assignment, the author would have benefited from any subsequent extensions of the subsisting copyrights. Gov. Mem. at 14-15.

This argument is fundamentally misleading. The CTEA is unprecedented in its treatment of the right to terminate. In every major extension of subsisting copyrights, Congress has either vested the right in the Author or her heirs directly, or granted the Author a right to terminate. See William Patry, The Failure of the American Copyright System: Protecting the Idle Rich, 72 Notre Dame L. Rev. 907, 908 (1997). The CTEA is the first time that Congress has expressly denied an author a right to terminate after an extension. For copyrights created by authors who assigned their copyright after exercising the right to terminate under the 1976 Act, the CTEA by design grants an “exclusive right” in someone other than the author.

The Government argues that an author would have received the benefit of an extension ex ante, by negotiating a price that would have included the expectation of an extension. Gov. Mem. at 13-14. But again, this is plainly misleading. If every time before the CTEA, Congress either vested an extension in authors, or gave authors the right to terminate, then there is no reason to expect authors would have been able to secure any premium for future extensions.<sup>8</sup>

---

<sup>8</sup> An example will make the point. Imagine an Author in 1954 renews her copyright (originally granted in 1926) and assigns it to a publisher. At the time of assignment, the copyright is scheduled to last for 28 more years, until 1982, and imagine Publisher pays Author \$2800, or \$100 per year, for the entire renewal term. In 1976, Congress added another 19 years to the renewal term, and it gave the author the option to terminate the last 19 years. Assume she does so in 1982. Assume then the Publisher offers the Author \$1900 for the remainder of the copyright term, and the author accepts. The copyright is scheduled to expire in 2001, but in 1998, the CTEA extends it to 2021. By the terms of the CTEA, however, the full benefit of this extension is given to the Publisher, not to the Author.

**C. The Authority that the Government Cites to Uphold Congress' Power to Increase Terms Retrospectively Is Plainly Not on Point.**

Citing authority interpreting Congress' power under the Patent Clause, the Government argues that the courts have already recognized Congress' power retrospectively to increase the term of copyrights. Gov. Mem. at 4-5. Plaintiffs have already pointed out the distinction between Congress' power over patents, and its power over copyrights. See supra at 4. But even if this power were the same, the authority the Government cites is not on point. The Government has not cited a case where any court considered the constitutionality of Congress' power to extend retrospectively the general term of patents, nor even a case where a court has determined the constitutionality of Congress' power to extend retrospectively a patent term for a limited range of patents.<sup>9</sup>

**IV. The Public Trust Doctrine Should Be Construed as a Constitutional Constraint upon Federal Law.**

The Government disputes that the public trust doctrine constrains federal law. But the cases cited by the Government are off point. Gov. Mem. at 19-20. They concern conflicts between state and federal uses of public trust land, and stand only for the unsurprising proposition that the federal government may put state public trust property to (federal) public use. They do not stand for the proposition that the

---

<sup>9</sup> Plaintiffs have acknowledged that there are early 19th century cases that assume Congress' power to act equitably by changing the term of a patent retrospectively. Pl. Mem. at 82 & n.28. The Government does not cite these cases, and even if it did, they would not support the much stronger claim that the Government and Amici make: that the Court has considered and affirmed the power of Congress to increase retrospectively the general term of all patents or copyrights.

federal government may put public trust property to private use (without just compensation to the public), which is what the plaintiffs argue the public trust doctrine proscribes in this case. Moreover, the one court that has adjudged whether the public trust doctrine bars the federal government from alienating public property free and clear of the public trust has ruled that it does. See United States v. 1.58 Acres of Land, 523 F. Supp. 120, 124-25 (D. Mass. 1981). Finally, while plaintiffs grant the Government's premise that the public trust doctrine "is a judicially developed doctrine derived from the common law," Gov. Mem. at 19, plaintiffs disagree with its conclusion that the doctrine should therefore not be construed as a constitutional principle. To the contrary, plaintiffs have specifically argued that the deep common law roots of the public trust doctrine render it suitable for incorporation into the Due Process Clause. See Pl. Mem. at 66-67.

As to Amici's argument that copyrighted works should not be considered public property in the first place, it is a simple matter of logic that, since copyrights may be granted only for a limited term, every grant of a copyright necessarily guarantees the public a right to use the copyrighted work after the term's expiration. In this sense, the public has a vested remainder interest in copyrighted works. See Pl. Mem. at 58-61. Amici further argue that, even if the public trust doctrine did forbid Congress from alienating the public's remainder interest in copyrighted works without a compensating public benefit, this Court must accept Congress' findings that the CTEA will in fact produce such a benefit. Yet the public trust doctrine is intended to prevent the courts from turning just such a blind eye.

Where the legislature transfers public assets to private hands, with apparently no significant public benefit being generated in return, the courts are needed to ensure that the transfer is not being made primarily for a private purpose, to the detriment of the public. See Pl. Mem. at 61-63.

\* \* \*

Plaintiffs' claims are no more revolutionary than the framers' vision of Congress' power under the copyright clause. As Justice Story described it, authors were to be granted an exclusive right for a limited time, and that "after a short interval," the public was to be granted "the full possession and enjoyment of all writings and inventions without restraint." Florida Prepaid Postsecondary Educ. Expense Bd. v. College Sav. Bank, 119 S.Ct. 2199, 2212 (1999) (Stevens, J., dissenting) (quoting J. Story, Commentaries on the Constitution of the United States § 502, p. 402 (R. Rotunda & J. Nowak eds. 1987)); see also International Techns. Consultants, Inc. v. Pilkington PLC, 137 F.3d 1382, 1392 (9th Cir. 1998) ("The founding fathers recognized a critical difference between intellectual and other forms of property. . . ."). The CTEA is unconstitutional because, with its 95 years, it is anything but "a short interval" and because the public must be granted "full possession and enjoyment" after that short interval, which the repeated increases of subsisting terms has effectively denied.

## CONCLUSION

For the foregoing reasons, plaintiffs' motion for judgment on the pleadings or, in the alternative, for summary judgment, should be granted, and judgment

should be entered in favor of plaintiffs.

Dated: September 10, 1999

ERIC ELDRED, ELDRITCH PRESS,  
HIGGINSON BOOK COMPANY, JILL A.  
CRANDALL, TRI-HORN  
INTERNATIONAL, LUCK'S MUSIC  
LIBRARY, INC., EDWIN F. KALMUS & CO.,  
INC., AMERICAN FILM HERITAGE  
ASSOCIATION, MOVIECRAFT, INC.,  
DOVER PUBLICATIONS, INC., and  
COPYRIGHT'S COMMONS,

By their attorneys,

---

Geoffrey S. Stewart (DC Bar No. 287979)  
William G. McElwain (DC Bar No. 397553)  
HALE AND DORR LLP  
1455 Pennsylvania Avenue, NW  
Washington, DC 20004  
Tel: (202) 942-8400

---

Charles R. Nesson (admitted *pro hac vice*)  
Lawrence Lessig (admitted *pro hac vice*)  
Jonathan L. Zittrain (DC Bar No. 452558)  
THE BERKMAN CENTER FOR INTERNET  
& SOCIETY  
1563 Massachusetts Avenue  
Cambridge, Massachusetts 02138  
Tel.: (617) 495-7547

OF COUNSEL:

James B. Lampert  
HALE AND DORR LLP  
60 State Street

**Boston, Massachusetts 02109**  
**Tel.: (617) 526-6000**