

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLORADO**

Civil Action No. 01-B-1854

LAWRENCE GOLAN, *et al.*,

Plaintiffs,

vs.

JOHN ASHCROFT, in his official capacity as Attorney General of the United States,

Defendant.

**PLAINTIFFS' MEMORANDUM IN OPPOSITION TO
DEFENDANT'S MOTION TO DISMISS**

Lawrence Lessig
Edward Lee
STANFORD LAW SCHOOL
FOR INTERNET AND SOCIETY
Crown Quadrangle
559 Nathan Abbott Way
Stanford, CA 94305-8610
Telephone: (650) 736-0999
Facsimile: (650) 723-8440

Hugh Q. Gottschalk
Carolyn J. Fairless
WHEELER TRIGG & KENNEDY, P.C.
1801 California Street, Suite 3600
Denver, CO 80202
DC Box 19
Telephone: (303) 292-2525
Facsimile: (303) 294-1879

Jonathan L. Zittrain
Charles R. Nesson
1525 Massachusetts Ave.
Cambridge, MA 02138
Telephone: (617) 495-7547

Attorneys for Plaintiffs

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Plaintiffs Lawrence Golan, Richard Kapp, S.A. Publishing Co. d/b/a ESS.A.Y Recordings, Symphony of the Canyons, Ron Hall, and John McDonough, through their undersigned counsel, file this memorandum in opposition to the motion to dismiss filed by defendant John Ashcroft, Attorney General of the United States. For the reasons set forth below, defendant's motion should be denied.

INTRODUCTION

This case is about whether the Constitution imposes *any* constraints on Congress's power to set the terms of copyrights. Apparently, Congress and the government believe that it does not, for Congress has prolonged the terms of copyrights – repeatedly – and even resorted to removing thousands of works from the public domain without any regard for the harms done to artists and the public.

Plaintiffs are individuals who pursue and promote the arts in this country. This lawsuit challenges two amendments to the Copyright Act. The Sonny Bono Copyright Term Extension Act (CTEA), Pub. L. No. 105-298 (1998) (codified at 17 U.S.C. §§ 301-304), extends the term of future and existing copyrights by another 20 years, thus preventing *any* work from entering the public domain in this country due to the expiry of term until the year 2019. Section 514 of the Uruguay Round Agreements Act (URAA), Pub. L. No. 103-465 (1994) (codified at 17 U.S.C. §§ 104A, 109(a)), goes a step further: it *removes* thousands of works from the public domain and retroactively grants them copyrights, thereby depriving the public of its ability – and right – to freely use materials that were, for many years, open to all. These laws have greatly harmed plaintiffs' artistic endeavors, and their ability to perform, teach, and disseminate works to the public.

Despite the Constitution’s requirement that terms be “limited,” the government takes the extreme view that Congress’s copyright power is unlimited and the exercise of its power immune from all constitutional challenge, regardless of whether it harms artistic pursuits or damages the public domain as plaintiffs allege in their Complaint. Indeed, the position now advanced by the government is much more extreme than the principal authority on which it relies, Eldred v. Reno, 239 F.3d 372 (D.C. Cir. 2001), the first case to consider the constitutionality of the CTEA. In Eldred, while the court of appeals, in a 2-1 decision, concluded that Congress could extend the term of copyrights both prospectively and retrospectively to subsisting copyrights, the court still recognized that Congress could not revive copyrights for works in the public domain. Id. at 377. But now, the government argues not only is there no restraint for extending the terms of existing and future copyrights, the government repudiates even the restriction on Congress’s power recognized in Eldred.

The government does not stop there. It even claims that this Court has absolutely no authority to review plaintiffs’ challenges because they involve “policy” debate reserved exclusively for Congress. In the government’s view, Congress has *carte blanche* authority to enact *any* copyright law. And it is this Court’s “duty” to just “apply and enforce settled law” enacted by Congress. Gov’t Mem. 2.

The government, however, is simply mistaken. This case is not about “policy.” It is about interpreting and applying the Constitution. Of course, “[i]t is emphatically the province of the judicial department to say what the law is.” Marbury v. Madison, 5 U.S. (1 Cranch) 137, 177 (1803). And that is particularly true for copyright and patent laws, which derive their creation from Article I, § 8, clause 8 of the Constitution. That Clause, as the Supreme Court has

consistently recognized, imposes *limits* on Congress's grant of power. See, e.g., Graham v. John Deere Co., 383 U.S. 1, 5 (1966); Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 349-50 (1991). And the Tenth Circuit has recognized these limits as well. See, e.g., Blish, Mize & Silliman Hardware v. Time Saver Tools, Inc., 236 F.2d 913, 915 (10th Cir. 1956); Gates Rubber Co. v. Bando Chem. Industr., Ltd., 9 F.3d 823, 834-39 (10th Cir. 1993). These limits are both implicated and violated here.

The government's motion to dismiss must, therefore, be rejected. Contrary to the government's argument, the issue is *not* whether plaintiffs' Complaint *proves* that a constitutional violation has occurred on the merits. That issue must wait for trial. The *only* issue on this motion to dismiss is whether the Complaint states a colorable legal claim that Congress's grant and exercise of power is subject to constitutional review. It clearly does. A colorable claim is simply one that is not "wholly insubstantial or frivolous." Bernstein v. U.S. Dep't of State, 922 F. Supp. 1426, 1433 (N.D. Cal. 1996). Plaintiffs have alleged more than sufficient legal grounds and allegations of harm to satisfy the liberal standards of pleading. Sutton v. Utah State School for Deaf & Blind, 173 F.3d 1226, 1236 (10th Cir. 1999) ("A 12(b)(6) motion should not be granted 'unless it appears *beyond doubt* that the plaintiff can prove no set of facts in support of his claim which would entitle him to relief.'" (emphasis added)). Given the importance of the constitutional challenges they raise, plaintiffs should not be deprived of an opportunity to develop a complete factual record to illuminate the full extent of the many harms created by the challenged laws and to contest the (spurious) historical and economic claims asserted by the government in support of these laws. See Reno v. ACLU, 521 U.S. 844, 849

(1997) (factual “findings provide the underpinnings of the legal issues” for constitutional challenge). The government’s motion should be denied.

STATEMENT OF THE CASE

“Creativity is impossible without a rich public domain. * * * Culture, like science and technology, grows by accretion, each new creator building on the works of those who came before. Overprotection [of intellectual property] stifles the very creative forces it’s supposed to nurture.” White v. Samsung Elec. America, Inc., 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc); accord Cardtoons, L.C. v. Major League Baseball Players Ass’n, 95 F.3d 959, 970 (10th Cir. 1996) (citing favorably Judge Kozinski’s dissent from denial of rehearing in White).

On September 19, 2001, plaintiffs filed this lawsuit to challenge the constitutionality of two laws that do great damage to the public domain, the CTEA and Section 514 of the URAA. The CTEA adds 20 more years of copyright protection both prospectively and retrospectively to subsisting works. For works published before 1978, the renewal term is extended from 47 to 67 years, thus giving a total term of protection of 95 years. For works created in 1978 or later, the CTEA extends the term of copyright from the life of the author plus 50 years to the life of the author plus 70 years. For works created in 1978 or later that are works-made-for-hire (or anonymous or pseudonymous works), the CTEA extends the term from 75 to 95 years from the year of publication or from 100 to 120 years from the year of creation, whichever comes first. Pub. L. No. 105-298. The CTEA depletes the supply of works from the public domain by *preventing* any work from entering the public domain for 20 years until the year 2019, at the earliest.

The URAA is even more sweeping: it *removes* thousands of works from the public domain and *deprives* the public of its free access to these public domain works. To get a sense of the sheer number of works removed from the public domain by the URAA alone, one need look no further than the thousands of Notices of Intent to Enforce (NIEs) restored copyrights filed in the Copyright Office after the enactment of the URAA. Compl. ¶¶ 46-47. Numerous NIEs have been filed for music, films, paintings, books, literary works, photographs, and other artistic works. And these NIEs do not tell the full story, since they are entirely optional: no registration is even required for copyright restoration. *Id.* ¶ 46. But for the CTEA and URAA, thousands of more works would be available in the public domain. This wholesale depletion of works from the public domain significantly harms plaintiffs, as well as artistic pursuits in this country.

Plaintiffs are individuals who have devoted their lives to the pursuit and promotion of the arts in this country. They originate from all parts of the country, ranging from Denver, Colorado; Kanab, Utah; Fargo, North Dakota; Shorewood, Minnesota; and Hastings on Hudson, New York. In their artistic pursuits, they depend on the public domain as a vital source of materials to teach, perform, and disseminate to the public. Without free access to materials in the public domain, their ability to promote learning and knowledge in this country is severely impaired.

Lead plaintiff Lawrence Golan is the Director of Orchestral Studies, Conductor, and Professor of Conducting at the University of Denver's Lamont School of Music. Compl. ¶ 6. Golan is an acclaimed conductor and violinist, whose professional mission is to bring classical music to new audiences, both young and old. At the University of Denver, Golan teaches students in orchestral music and conducting. He conducts the school's Lamont Symphony

Orchestra, which has 67 student members and which performs 6 free symphonic concerts and 1 opera each year in Denver. Id. ¶ 49.

Golan's ability to select and teach many great classical works has been severely hampered by the CTEA and URAA. Id. ¶¶ 55-57. The extension and restoration of copyrights make many works – which either had been or would have been in the public domain already, and thus free for all to use and copy – simply cost prohibitive. Id. For orchestral works, a copyright allows the copyright holder to exact considerable control over the dissemination of material. Copyrighted works are not sold; they are *rented* and for a *single* performance. Each time an orchestra wants to perform a copyrighted work, the orchestra must rent it and then return it back to the copyright holder. Id. ¶ 54. Under this rental scheme, an orchestra with a limited budget (like Lamont Symphony) simply cannot afford the rental of many copyrighted works. That is why the availability of works in the public domain is vital to Golan's ability to teach his students.

Because of the CTEA and URAA, however, Golan has much fewer materials from the public domain to teach his students than he had before. Just this past semester, Golan was forced to forgo teaching several notable works – including Shostakovich's *Symphony No. 5* and Prokofiev's *Symphony No. 1* – because the URAA has revived copyrights in these formerly public domain works. Had the URAA not been enacted, Golan would have been able to teach his students these important foreign works, which he believes are important for their education and training. Id. ¶ 57.

Other musicians around the country have experienced these same harms. Plaintiffs Richard Kapp and ESS.A.Y Recordings, for example, have been harmed by the CTEA's 20-year extension and the URAA's removal of works from the public domain. Kapp is the renowned

conductor of the Philharmonia Virtuosi, which he founded in 1968. Kapp's orchestra performs between 60 to 80 public performances each year in places worldwide. *Id.* ¶¶ 7, 61. Kapp also founded ESS.A.Y Recordings, a record label that records and sells classical music to the public. *Id.* ¶ 8.

The CTEA, however, keeps numerous important classical works from the post World War I era from entering the public domain. These works – written by such luminaries as Ravel, Stravinsky, and Jean Sibelius – would have entered the public domain soon or already, had it not been for the 20-year retrospective extension of their copyrights. *Id.* ¶ 64. In practical terms, this means that Kapp must pay hundreds of dollars simply to rent the copyrighted music for a single performance of works that would have been available for purchase at a modest price had those works entered the public domain (as they should have under pre-CTEA law). *Id.* ¶ 65.

The URAA has increased even more dramatically the costs of formerly public domain works. These works, which were once available to all for purchase at a relatively low price, now costs Kapp hundreds of dollars simply to rent. *Id.* ¶ 67. Copyright restoration has also imposed royalty costs on Kapp and ESS.A.Y Recordings for their prior recording of Stravinsky's sextet *Apollon Musagete*. When Kapp recorded this work, it was in the public domain. Kapp chose this work to record specifically because no royalties would have to be paid. But, now, with copyright restoration in the work, royalties are required. The retroactive copyright here destroys Kapp's reasonable investment-backed expectations. *Id.* ¶ 71. Because of copyright restoration, Kapp and ESS.A.Y recordings have started to forgo recording foreign works subject to copyright restoration altogether. *Id.* ¶ 72. It is now even more costly for Kapp's orchestra to perform *Peter and the Wolf* (by Prokofiev) for young children in New York because this work, which is a

favorite among children, has been removed from the public domain and restored to copyright protection. Id. ¶¶ 69-70.

The impact of the CTEA and the URAA has been just as severe on plaintiff Symphony of the Canyons, which is a not-for-profit community orchestra based out of Kanab, Utah. Kortney Stirland is the conductor of the Symphony of the Canyons, whose members range in age from 12 to 70 years old. Id. ¶ 73. Because of its limited budget, nearly 80 percent of the music Symphony of the Canyons performs is public domain works. Id. ¶ 74. Symphony of the Canyons greatly anticipated the entry of the works of George Gershwin (such as *Rhapsody in Blue*, *Concerto in F*, *Cuban Overture*, and *I Got Rhythm*) and Aaron Copland (such as *Piano Concerto*) into the public domain. Many of these works would have been in the public domain soon or already, had it not been for the CTEA. Because the copyrights to these works have been prolonged for another 20 years, Symphony of the Canyons cannot afford to rent or perform the music. Id. ¶ 75. Many members of the Symphony of the Canyons will get *no* opportunity to learn or play these important American works. To wait another 20 years for them might as well be forever.

The challenged laws have also harmed plaintiffs Ron Hall and John McDonough, who sell public domain films to the public. Id. ¶¶ 78, 84. Because of the CTEA, they cannot sell whole classes of silent and early sound films from 1923 on – such as Harold Lloyd’s *Safety Lost* (1923), which was selected by the American Film Institute as one of the Top 100 Most Thrilling Movies ever made. Id. ¶¶ 81, 87. Nor will plaintiffs be able to add any more “new” public domain works (i.e., works whose copyrights have just expired and thus just entered the public domain) for sale until the year 2019. This loss of supply of new works to the public domain is

devastating to plaintiffs. Just imagine maintaining a business that can sell no new products for at least 20 more years. Plaintiffs have also been severely harmed by the URAA. Because of the URAA, whole stockpiles of their foreign titles (including classic movies by Alfred Hitchcock and other renowned directors) have been rendered valueless because they are subject to the exclusive control of the restored copyright holder. *Id.* ¶¶ 78-90. Because the URAA even purports to abrogate the first sale doctrine (which allows a purchaser of a copyrighted work the right to sell or rent that particular copy), 17 U.S.C. § 109(a), plaintiffs cannot even sell or rent the copies of the works that they now own. *Compl.* ¶ 41. The CTEA and URAA also impair plaintiffs’ ability to preserve old films (which are made on material that deteriorates over time). Many old films are “orphan works” because the copyright holders no longer exist, much less care for the preservation of the works. *Id.* ¶ 89.

And perhaps the greatest loss of all is to the American public, which can enjoy much fewer artistic and literary works from the public domain. *Id.* ¶¶ 35-48, 60, 77, 89-90. These many harms to plaintiffs and the public provide the underpinnings of plaintiffs’ constitutional challenge.

ARGUMENT

I. THE CTEA IS UNCONSTITUTIONAL

The Sonny Bono Copyright Term Extension Act (CTEA) extends the term of U.S. copyrights, future and subsisting, by another 20 years. It marks the eleventh time in the past 40 years that Congress has extended the term of copyrights.¹ Though just enacted in 1998, the

¹ In addition to the CTEA, there were 10 other extensions of subsisting and future copyrights that still affect current works. *See* Pub. L. No. 87-668 (1962) (increasing maximum term of subsisting copyrights from 56 to 59 years); Pub. L. No. 89-142 (1963) (from 59 to 61

CTEA has already kept numerous works published in 1923, 1924, 1925, and 1926 from entering the public domain. These works were created during the important post World War I era, and include some of the finest works from this country and abroad, such as George Gershwin's *Rhapsody in Blue* and Harold Lloyd's film classic *Safety Lost*. When coupled with the 10 previous term extensions, the CTEA has effectively prevented works published in 1923 through 1945 from entering the public domain. But for these repeated extensions, many of these works would have already entered the public domain – and thus be free for the public's unlimited use. Now, the public must wait until at least the year 2019, if not more.

In its brief, the government goes to great lengths to justify this dramatic expansion of the term of copyrights. It invokes “international harmonization,” posits a “national tradition” of such copyright term extensions dating back to the First Congress, and asserts that copyright terms – and indeed copyright law as presently written – are beyond challenge under the Copyright Clause or the First Amendment. It fails to discuss relevant and contrary authorities from the Supreme Court, and fails even to cite contrary authorities from the Tenth and other circuits. The Government even adopts a more extreme position than the one it advanced to the Supreme Court in its brief opposing the petition for certiorari in Eldred v. Reno.

There is a stopping point to all these arguments. And that is the Constitution. As shown below, the CTEA's 20-year extension of the term of copyrights cannot be justified under the Constitution: it violates the limits on Congress imposed by the Copyright Clause, as well as the

years); Pub. L. No. 90-141 (1967) (from 61 to 62 years); Pub. L. No. 90-416 (1968) (from 62 to 63 years); Pub. L. No. 91-147 (1969) (from 63 to 64 years); Pub. L. No. 91-555 (1970) (from 64 to 65 years); Pub. L. No. 92-170 (1971) (from 65 to 66 years); Pub. L. No. 92-566 (1972) (from 66 to 68 years); Pub. L. No. 93-573 (1974) (from 68 to 70 years); Pub. L. No. 105-298 (1976) (from 70 to 75 years).

First Amendment and substantive due process. Plaintiffs have alleged more than adequate legal grounds in their challenge of the CTEA in Counts 1 through 3. The government's motion should be denied.

A. The CTEA Violates the Copyright Clause

The CTEA extends the terms of copyrights both *prospectively* to future copyrights for works produced after the CTEA became effective and *retrospectively* to copyrights that were already in existence. Pub. L. No. 105-298 (1998). In Count 1, Plaintiffs' challenge is limited to the CTEA's retrospective extension of the terms of copyrights already in existence before the CTEA. This retrospective extension violates three separate limitations of the Copyright Clause.² Compl. ¶¶ 91-100.

Article I, § 8, clause 8 of the Constitution states:

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

U.S. CONST. art. I, § 8, cl. 8. This Clause is unique among the grants of power in Article I in setting forth not only the grant of power, but also the *means* by which the grant of power is to be exercised. Congress is given the power *to do Y by means of X*. Specifically, Congress is granted the power *to promote progress by means of securing limited copyrights to authors*. Congress cannot go beyond either the grant of power or the specified means.

The CTEA's retrospective extension, however, violates both. It does not "promote the Progress of Science and useful Arts" – which, under the law of the Supreme Court and Tenth Circuit (and directly contrary to the D.C. Circuit), imposes limits on what Congress may do. Nor

does it satisfy the requirement of “securing for limited Times” copyrights to authors. It also violates the constitutional requirement of originality. Although the government relies heavily on Eldred v. Reno, 239 F.3d 372 (D.C. Cir. 2001), that is not the law of this Circuit. Tenth Circuit case law does not support the Eldred decision or the government’s argument (which cites only *one* Tenth Circuit case and just in passing in its entire brief, Gov’t Mem. 10).

1. Standard of Review

The standard of review for plaintiffs’ challenge to the CTEA’s retrospective extension is, as explained below, whether (1) the CTEA’s retrospective extension promotes progress, (2) whether it is for “limited Times” in light of the grant of power, and (3) whether it satisfies the originality requirement. Contrary to the government’s apparent assumption, rational basis review is not the standard for the Copyright Clause. If it were, then there could be no originality requirement – which is contrary to the Supreme Court’s ruling in Feist, 499 U.S. 340 (1991). There, in interpreting the Copyright Clause, the Court held that originality (some modicum of creativity) is a constitutional requirement to obtain a copyright. Id. at 346-48. The Court looked not to the *possible* benefits of allowing compilations of fact to be copyrighted, but to whether it in fact promoted progress. Id. at 350 (originality requirement “is the means by which copyright advances the progress of science and art”).

2. The CTEA Does Not “Promote the Progress of Science”

Article I, § 8, clause 8 of the Constitution states that Congress has 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, §

² Of course, to survive a motion to dismiss, plaintiffs need only establish that one

8, cl. 8. That Clause is, as the Supreme Court has repeated, “both a grant of power and a *limitation*.” Graham v. John Deere Co., 383 U.S. 1 (1966) (emphasis added). A central limitation is imposed by the words “[t]o promote the Progress of Science and useful Arts.” By these words, Congress’s power is “qualified” and “*limited* to the promotion of advances in the ‘useful arts’” and progress of science. Id. at 5 (emphasis added).³ “This is,” as the Court admonished, “*the* standard expressed in the Constitution and it may not be ignored.” Id. at 6 (emphasis added).

But the government proposes here to do just that, to ignore the text of the Constitution and turn the phrase “to promote the Progress of Science and useful Arts” into mere surplusage. To justify this extreme position, the government relies principally on Eldred v. Reno, 239 F.3d 372 (D.C. Cir. 2001), reh’g en banc denied, 255 F.3d 849 (2001), in which the D.C. Circuit, in a 2-1 decision, upheld the constitutionality of the CTEA. (A petition for certiorari is pending in the case, No. 01-618.) In the government’s view, as long as the term of copyright has a finite number – 10, 100, or presumably even 1,000 years – Congress can do whatever it wants. Gov’t Mem. 6-7. Under the Clause, Congress may extend the terms of already existing copyrights, regardless of whether it “promotes the Progress of Science,” because in the government’s (and D.C. Circuit’s view) the express purpose of the Copyright and Patent Clause imposes no limit on Congress’s power. Id. at 9.

legal ground is sufficient to state a claim under the Copyright Clause.

³ The Court in Graham was dealing with the Patent Code, so focused on the “useful Arts” to which patents are aimed. The phrase “Progress of Science” refers to the aim of copyright, which is to promote learning. See Edward Walterscheid, “Defining the Patent and Copyright Term: Term Limits and the Intellectual Property Clause,” 7 J. INTELL. PROP. L. 315, 353-54, 392-93 (2000) (describing parallel structure of the Clause).

The law of the D.C. Circuit, however, is clearly not the law of the Tenth Circuit. Under the settled law of the Tenth Circuit *and* the Supreme Court – both of which the government wholly ignores – the phrase “to promote the Progress of Science and useful Arts” imposes *limits* on Congress’s power. Graham, 383 U.S. at 6 (emphasis added); Blish, Mize & Silliman Hardware v. Time Saver Tools, Inc., 236 F.2d 913, 915 (10th Cir. 1956).⁴ These limits include both express limits imposed by the text of the Copyright and Patent Clause, and implied limits emanating therefrom, such as the requirement of originality. See Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991).⁵

The Tenth Circuit has adopted the approach of Graham in recognizing that “to promote the Progress of Science” imposes limits on Congress. Indeed, even before the Supreme Court decided Graham, the Tenth Circuit foreshadowed the position eventually adopted by the Court. In Blish, Mize & Silliman Hardware Co. v. Time Saver Tools, Inc., 236 F.2d 913 (10th Cir. 1956), the Tenth Circuit held that Congress did not – and indeed “*could not*” – enact a patent law that abrogated or diminished the standard of patentability that had been long recognized by courts. As the Court of Appeals explained, “that concept is *inherent* in the constitutional purpose ‘To promote the Progress of Science and useful Arts.’” Id. at 915 (emphasis added). That is precisely the conclusion reached by the Supreme Court in Graham, when it stated: “Innovation, advancement, and things which add to the sum of useful knowledge from the public domain are

⁴ See also Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 460 (1984) (“The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed 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 by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.”).

inherent requisites in a patent system *which by constitutional command must ‘promote the Progress of * * * useful Arts.’*” Graham, 383 U.S. at 6 (emphasis added). Thus, Congress is forbidden from giving a patent for simple (and obvious) advancements to existing inventions because it would not promote the useful arts. And the reason is manifest: giving patents to inventions that are “obvious” does not build upon the existing knowledge at all; the public already has the know-how to build the “obvious.”

The Tenth Circuit also relied on “[t]o promote the Progress of Science and useful Arts” in adopting the abstraction-filtration-comparison test for infringement of computer software. Gates Rubber Co. v. Bando Chem. Industr., Ltd., 9 F.3d 823 (10th Cir. 1993). The court of appeals drew upon the merger doctrine, another judicial doctrine that has roots in the Copyright Clause. Courts (not Congress) developed this doctrine “as a prophylactic device to ensure that courts do not unwittingly grant protection to an idea by granting exclusive rights to the only, or one of only a few, means of expressing that idea.” Id. at 838. The merger doctrine was necessary because “[i]f protection were granted to these expressions, it would so increase the cost of creation for others who seek to build on the work that it would impede progress in the arts. *Such a result is contrary to the goals of copyright as embedded in the Constitution.*” Id. (citing U.S. CONST. art. I, § 8, cl. 8) (emphasis added). Based in part on these constitutional goals, id. at 839, the Tenth Circuit adopted the abstraction-filtration-comparison test for infringement of computer software. Id. at 834 (“an effective test can be formulated from *constitutional* and statutory *constraints*”) (emphasis added). See also Mitel, Inc. v. Iqtel, Inc., 124 F.3d 1366, 1372 (10th Cir. 1997) (abstraction-filtration-comparison test is consistent with constitutional goal of copyright law,

⁵ For a discussion of this implied limit, see, infra, at pp. 29-30.

which is designed “to secure ideas for [the] public domain and to set apart an author’s particular expression for further scrutiny to ensure that copyright protection will ‘promote the * * * useful Arts’”).

Since Time Saver Tools and Gates Rubber are the law of this Circuit, the government’s argument (based on Eldred) here is simply foreclosed. As the Tenth Circuit long ago recognized, there are limits on the grant of power to Congress that are *inherent* in the words “To promote the Progress of Science and useful Arts.” To find these limits one need look no further than the *text* of the Constitution.⁶

As Judge Sentelle argued in dissent in Eldred, the text of Article I, section 8, imposes limits on what Congress may do. Eldred, 239 F.3d at 380 (Sentelle, J., dissenting in part). Thus, “the same language that serves as the basis for the affirmative grant of congressional power also serves to limit that power.” Kimel v. Florida Bd. of Regents, 528 U.S. 62, 81 (2000) (interpreting § 5 of the 14th Amendment). In determining those limits, as Judge Sentelle explained, courts should “follow the lead of the United States Supreme Court in United States v. Lopez, 514 U.S. 549 (1995), and ‘start with first principles.’” Eldred, 239 F.3d at 381. “The governing first principle in Lopez and in the matter before us is that ‘[t]he Constitution creates a Federal Government of enumerated powers.’” Id. Accordingly, in Lopez, the Court looked to the

⁶ The Fifth Circuit has also recognized that copyright laws must satisfy the requirement “to promote the Progress of Science and useful Arts.” Mitchell Bros. Film Group v. Cinema Adult Theater, 604 F.2d 852, 860 (5th Cir. 1979) (“Congress’ power * * * under [the Copyright] Clause is limited to action that promotes the useful arts.”). And at least four other circuits have relied on the language “to promote the Progress of Science” to limit applications or interpretations of copyright and patent law. See Frantz Mfg. Co. v. Phenix Mfg. Co., 457 F.2d 314, 327 n.48 (7th Cir. 1972) (Stevens, J.); Aalmuhammed v. Lee, 202 F.3d 1227, 1235 (9th Cir. 1999); Rosemont Enter. Inc. v. Random House, Inc., 366 F.2d 303, 307 (2d Cir. 1966); Greenberg v. Nat’l Geographic Soc’y, 244 F.3d 1267, 1271 (11th Cir. 2001).

text of the Commerce Clause in order to define the “outer limits” of Congress’s commerce power. 514 U.S. at 553 (“limitations on the commerce power are inherent in the very language of the Commerce Clause”). The Court rejected the government’s arguments that would, if accepted, render Congress’s power limitless. *Id.* at 564. In a system of enumerated powers, there must be a stopping point to what Congress may do.

Although Lopez involved a commerce clause challenge, the same type of analysis should apply here. Both the Copyright Clause and the Commerce Clause are grants of power under Article I, § 8. While each clause gives Congress discretion to enact laws, that discretion is subject to the textual limitations built into the particular clause. Indeed, the Copyright Clause presents an even stronger textual basis for discerning those limits because it, unlike other grants, expressly defines the goal of its grant – to promote the Progress of Science and useful Arts.⁷ Cf. Gibbons v. Ogden, 22 U.S. (9 Wheat.) 1, 188-89 (1824) (“If * * * there should be serious doubts respecting the extent of any given power, it is a well settled rule, that the objects for which it was given, especially when the objects are expressed in the instrument itself, should have great influence in the construction.”).

As Judge Sentelle further explained, “this concept of ‘outer limits’ to enumerated powers applies not only to the Commerce Clause, but to *all* enumerated powers, including the Copyright Clause.” Eldred, 239 F.3d at 381. Just as in Lopez, a court must examine “the extension of

⁷ The government’s argument, if accepted, would effectively treat the Copyright Clause different from any other grant of power to Congress as precluding any judicial review or imposition of limits. Cf. Lopez, 514 U.S. at 553 (commerce clause); Railway Labor Executives’ Ass’n v. Gibbons, 455 U.S. 457, 465-66 (1982) (uniformity requirement in bankruptcy clause); Blatchford v. Native Village of Noatak, 501 U.S. 775, 779 (1991) (11th Amendment); Kimel, 528 U.S. at 81 (§ 5 of the 14th Amendment)

congressional authority to areas beyond the core of the enumerated power with a goal of determining whether the rationale offered in support of such an extension has *any stopping point* * * *.” Id. (emphasis added). A court must reject views that have no stopping point and that give Congress essentially *unlimited* power.

Here, that is undeniably the case. The government’s proffered justifications give Congress unfettered discretion. In the government’s own words: “Congress alone must determine what best promotes artistic progress,” and “the decision on how best to effectuate copyright protection is committed by the Constitution to Congress alone.” Gov’t Mem. 9. But this is plainly incorrect. As Judge Sentelle explained in Eldred:

[The Copyright] Clause empowers the Congress to do one thing, and one thing only. That one thing is “to promote the progress of science and useful arts.” How may Congress do that? “By securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.” The clause is not an open grant of power to secure exclusive rights. It is a grant of power to promote progress. * * *

Returning to the language of the clause itself, it is impossible that the Framers of the Constitution contemplated permanent protection, either directly obtained or attained through the guise of progressive extension of existing copyrights. * * * Extending existing copyrights is not promoting useful arts, nor is it securing exclusivity for a limited time.

Eldred, 239 F.3d at 381 (Sentelle, J., dissenting in part).

The CTEA is, therefore, unconstitutional. It gives retroactive extensions to existing works (many of whose authors are long dead) without any benefit to the public in the further creation or dissemination of works. This windfall grant of protection – a *quid* for no *quo* – impedes, not promotes, progress. For “once a work is published * * * extending the copyright term does absolutely nothing to induce further creativity by the author – and how could it? The

work is already published * * *.” Eldred, 255 F.3d at 855 (Sentelle, J., dissenting from denial of rehearing).

3. The Government’s Arguments About “Promote the Progress of Science” Are Meritless

In addition to asserting that “to promote the Progress of Science and useful Arts” provides no limit on Congress – a position that is contrary to both Supreme Court and Tenth Circuit authority – the government makes a series of arguments to avoid the plain meaning of these words in the Copyright Clause. None of these arguments has merit.

a. The Framers Did Not Sanction Extensions of Copyright Terms to Subsisting Copyrights

The government purports to find a “national tradition” of extending the terms of subsisting copyrights dating all the way back to the First Congress and first Copyright Act. Gov’t Mem. 2, 14-15. But that argument is wrong on both the facts and the law, and does not provide a legitimate ground for dismissal.

First, it is simply false to characterize the first Copyright Act as an “extension” of copyright terms. As the Supreme Court has already stated: “Congress * * * by this act, instead of sanctioning an existing right * * *, created it.” Wheaton v. Peters, 33 U.S. 591, 660 (1834); Fox Film Corp. v. Doyal, 286 U.S. 123, 127 (1932) (“the Congress did not sanction an existing right, but created a new one”). Before the Copyright Act of 1790, there were *no* federal statutory copyrights that could be “extended” for the simple reason that none existed until the Act. The Copyright Act of 1790 thus can tell us nothing about *extensions* of copyright terms because the creation of a new federal right does not amount to an extension of a subsisting copyright. In Eldred, the government conceded as much, asserting in its brief to the D.C. Circuit: “No court

has ever equated extending a subsisting copyright to granting a new copyright.” Gov’t Eldred Brief of Appellee at 35.

Second, the historical background to both the Copyright Act of 1790 and the Copyright Clause demonstrate that the First Congress’s intent in granting copyrights to works already printed was to *limit*, not to extend, the term of all copyrights. By subjecting all works to federal copyright, the first Copyright Act could effectively limit the potentially perpetual term of common law copyrights.

The government misunderstands the significance of common law copyright to the development of our federal copyright law. The creation of our federal copyright system occurred closely following the resolution of an important debate in England over the Statute of Anne (1710) and its effect on common law copyrights, which were considered to be perpetual. See Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1260 (11th Cir. 2001) (describing the Framers’ reliance on development of copyright law in England and the Statute of Anne in drafting Copyright Clause); Walterscheid, 7 J. INTELL. PROP. L. at 318-347. In Millar v. Taylor, 4 Burr. 2303, 98 Eng. Rep. 201 (1769 K.B.), the English court held that common law copyright was perpetual and survived publication as well as the Statute of Anne. That decision, however, was overruled in Donaldson v. Becket, 4 Burr. 2408 (1774). The House of Lords held that the Statute of Anne divests the author of any common law copyright upon publication of the work. See 1 NIMMER ON COPYRIGHT § 4.13, at 4-13 to 4-14; Walterscheid, 7 J. INTELL. PROP. L. at 344. This limited statutory copyright thus was meant “to encourage creativity and ensure that the public would have free access to information by putting an end to ‘the continued use of copyright as a device of censorship.’” Suntrust Bank, 268 F.3d at 1260.

This debate undoubtedly influenced the drafters of the Copyright Clause, which expressly requires a limited term, and the First Congress, which adopted an initial term of copyright of 14 years just as in the Statute of Anne. See Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884); Suntrust Bank, 268 F.3d at 1260; Walterscheid, 7 J. INTELL. PROP. L. at 351, 381. Indeed, Madison acknowledged the development of copyright at common law in Great Britain. FEDERALIST NO. 43 (“The copyright of authors has been solemnly adjudged in Great Britain, to be a right of common law.”); see also 3 STORY’S COMMENTARIES 48 (“The copyright of authors in their works had, before the revolution, been decided in Great Britain to be a common law right, and it was regulated and limited under statutes passed by parliament upon that subject”).

As Edward Walterscheid, a leading historian on the Copyright Clause, notes:

[I]t was unclear to the Framers whether there was in fact a perpetual common law property right in copyright or whether the Statute of Anne had limited the copyright term as set forth therein. What is clear is that both Pinckney and Madison did not want a perpetual copyright term but rather wanted something along the lines set forth in the Statute of Anne, that is to say, a limited term.

Walterscheid, 7 J. INTELL. PROP. L. at 353.

Thus, before enacting the Copyright Act of 1790, the First Congress faced the same problem posed in England before the enactment of the Statute of Anne. As the government concedes, before the Founding, a huge debate existed over whether “works of art should be protected in perpetuity or for a more limited duration. * * * The Continental Congress apparently did not object to the issuance of perpetual copyright terms.” Gov’t Mem. 7. Although the Framers ultimately adopted a limitation of “securing [copyrights] for limited Times,” that left the

problem of existing state common law copyrights.⁸ If the Copyright Act of 1790 did not apply to existing works, those works could obtain potentially perpetual copyrights under common law. The solution was simple: the Copyright Act of 1790 applied to all eligible works, including those “already printed.” In this way, the common law copyright could be curtailed.

The government, therefore, is simply wrong in its claim that the Copyright Act of 1790 established a “national tradition” of extending the terms of subsisting copyrights. It did no such thing. If anything, the Copyright Act of 1790 *shortened* the terms of copyrights by precluding any possibility that common law copyrights could extend perpetually for published works (as they did in England). The Copyright Act of 1790 presented a unique problem in establishing the first federal copyright system among a patchwork of state copyright statutes,⁹ and common law copyright. The more accurate historical view is that the Copyright Act of 1790 resolved a transitional problem unique to the initial creation of our federal copyright system. See Lyman Ray Patterson, COPYRIGHT IN HISTORICAL PERSPECTIVE 181 (1968). Had the first federal Copyright Act not subjected all works to the federal standards of copyright, any state could conceivably have allowed existing works to obtain perpetual protection – a result that is anathema to the progress of science.

⁸ Until at least 1834, if not longer, considerable confusion existed over common law copyrights. Compare Wheaton, 33 U.S. at 661 (suggesting that common law copyrights under Pennsylvania law would not follow English common law, “which was involved in doubt as to divide the most learned jurists of England”) with id. at 690 (Thompson, J., dissenting) (arguing that Pennsylvania law incorporated English common law, including its approach to copyright).

⁹ Twelve of the thirteen original states enacted state copyright statutes between 1783 and 1786, although some may never have gone into operation. Walterscheid, 7 J. INTELL. PROP. L. at 349.

The government’s reliance on copyright extensions in 1831, 1870, 1909, and 1976 is similarly misplaced. They tell us nothing about the Framers’ view, since no Framers were even in these Congresses.¹⁰ The dicta in Burrow-Giles, on which the government relies (but selectively quotes), Gov’t Mem. 4, is expressly limited to “[t]he construction placed upon the Constitution *by the first act of 1790 and the act of 1802.*” 111 U.S. at 57 (emphasis added). And, in all events, the fact that a law or congressional practice has gone unchallenged does not render it constitutional. See U.S. v. Martinez-Fuerte, 428 U.S. 543, 566 n.19 (1976) (“neither long-standing congressional authorization nor widely prevailing practice justifies a constitutional violation”); Illinois State Employees Union v. Lewis, 473 F.2d 561, 568 n.14 (7th Cir. 1972) (Stevens, J.) (“if the age of a pernicious practice were a sufficient reason for its continued acceptance, the constitutional attack on racial discrimination would, of course, have been doomed to failure”). The government cites no case – and we know of none – that even considered the constitutionality of these prior extensions.

b. The Government’s Debate About the “Optimal Length of Copyright” Is Irrelevant

The government engages in several pages of economic debate about the “optimal length of protection” in an attempt to show that such a “policy” debate must be entrusted exclusively to Congress. Gov’t Mem. 9-11. The government would have this Court believe that to resolve

¹⁰ For example, an impetus behind the term extension in the Act of Feb. 3, 1831, 4 Stat. 436, was Noah Webster’s efforts to make copyright terms *perpetual*. See Noah Webster, COLLECTIONS OF PAPERS ON POLITICAL, LITERARY, AND MORAL SUBJECTS 175-77 (1843) (petitioning Congress to “pass a new act” stating that “an author has, by common law, or natural justice, the sole and *permanent* right to make profit”); House Report, 7 REGISTER OF DEBATES IN CONGRESS APP. CXX (1830) (“Upon first principles of proprietorship in property, an author has an exclusive *and perpetual right*, in preference to any other, to the fruits of his labor.”) (emphasis added).

plaintiffs' challenge would require messy and inherently irresolvable economic policymaking because "[i]dentifying the optimal length of protection, so that authors have enough incentive to create and yet works still fall into the public, appears impossible." *Id.* at 11. But the government simply misstates the nature of plaintiffs' Copyright Clause challenge, which is limited to the *retrospective* extension of the term of subsisting copyrights. Compl. ¶¶ 96-98. For *retrospective* extensions of the term of copyrights to existing works, there is no irresolvable economic policymaking at all. Contrary to the government's assertion, this Court will not be called upon to "identify[] the optimal length of protection, so that authors have enough incentive to create." All the authors here (many of whom are dead) clearly *had* enough incentive to create. Their works already exist; *res ipsa loquitur*.

Thus, the government's discussion is simply beside the point. The real issue is whether the retrospective extension of the terms of subsisting copyrights for works that have already been created promotes the Progress of Science. It does not. If the work already exists, by definition, sufficient economic incentive already existed to produce the work. *See* William M. Landes & Richard A. Posner, "An Economic Analysis of Copyright Law," 18 J. L. STUD. 325, 362 (1989) ("a strong argument against making increases in copyright term retroactive" exists because, for an extension that applies both prospectively and retrospectively, any increase in incentive to create "will be limited to a subset of the affected works (those not produced), while the increase of the cost of expression will apply to borrowing from all works, existing and not yet produced"); Melville B. Nimmer, "Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?," 17 UCLA L. REV. 1180, 1194-95 (1970) (concluding that "a serious question exists as to the constitutional validity" of extending existing copyrights because "[i]t

can hardly be argued that an author’s creativity is encouraged by such an extension, since the work for which the term is extended has already been created”); see also Stephen Breyer, “The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs,” 84 HARV. L. REV. 281, 323-29 (1970) (concluding that even a *prospective* extension of 20 years would not increase incentives to create because “to increase protection by twenty years would increase the present value of [the] manuscript by less than four one-hundredths of one percent, hardly enough to affect [the] decision to write in the first place”). There is no way a retrospective extension can supply *more* economic incentive to create works if they already exist. Eldred, 255 F.3d at 855 (Sentelle, J., dissenting from denial of reh’g). What the CTEA gives retrospectively is a pure windfall award to authors and their estates.

c. Copyright “as a Whole” Cannot Shield an Unconstitutional Provision

The government also asserts – without citing a single case to support its position – that “copyright law as a whole, not individual amendments, must ‘promote the Progress of Science and useful Arts.’” Gov’t Mem. 12. The government contends that “the copyright law as a whole” promotes progress because it guarantees copyrights and thereby “allow[s] authors an opportunity to recover their expenses.” Id.

There is simply no authority to support the government’s slippery-slope reasoning. To the contrary, the case law is clear that “to promote the Progress of Science and useful Arts” may apply to individual provisions of copyright and patent law. For example, in Time Saver Tools, the Tenth Circuit analyzed the patent provision of nonobviousness, 35 U.S.C. § 103, and held that the provision must be limited to the judicially created standards of inventiveness because those standards were constitutionally required “by the constitutional purpose ‘To promote the

Progress of Science and useful Arts,” 236 F.2d at 915, which is the same position embraced by the Supreme Court in Graham v. John Deere.

If the government’s position were the law (and it is not), both the Tenth Circuit and the Supreme Court would have been wrong in their analysis. Instead of focusing on one provision of patent law, the government’s approach would look to patent law “as a whole.” And patent law would, as a whole, promote the useful arts as long as it secured inventors “an opportunity to recover their expenses” (Gov’t Mem. 12). The government’s approach would thus lead to the astounding result that Congress could enact blatantly unconstitutional provisions (such as an abrogation of the originality requirement for copyrights or the nonobviousness requirement for patents) as long as the whole statute secured authors and inventors “an opportunity to recover their expenses.” That proposition, however, is untenable.

d. The Government’s Bare Assertions of Harmonization, Creation of Works, and Extra Compensation Are Incorrect and Provide No Basis for Dismissal

The government conjures up several purported justifications for the CTEA in an attempt to establish that the CTEA actually promotes the progress of science and the creation of artistic works. Gov’t Mem. 13-16. These unsubstantiated justifications are not only baseless, they are inappropriate for resolution on a motion to dismiss. All that plaintiffs need *allege* is a theory of relief sufficient to state a claim. Whether defendant can allege a different theory or set of facts is irrelevant for a motion to dismiss.

Plaintiffs are fully prepared to contest the government’s bare assertions at trial or an evidentiary hearing. See Century Fed., Inc. v. City of Palo Alto, 579 F. Supp. 1553, 1561 (N.D. Cal. 1984) (denying motion to dismiss First Amendment challenge to franchise system because

factual issues existed and plaintiffs could disprove state's asserted justifications for regulation). At trial, plaintiffs will demonstrate: (1) that the CTEA does not harmonize U.S. law with the EU Directive; (2) the CTEA's retrospective extension of subsisting copyrights does not stimulate the creation or reinvestment of new works; (3) that the purported "damage done to copyright protection by new infringing technologies" (Gov't Mem. 16) does not justify the CTEA; and (4) that none of the government's proffered justifications has merit or promotes the Progress of Science. The government's affirmative case for the CTEA is based on the faulty premise that providing financial reward to authors and their estates is the ultimate goal of the Copyright Clause. Not so. "[P]romoting broad public availability in literature, music, and the other arts" is. Twentieth Century Corp. v. Aiken, 422 U.S. 151, 156 (1975).

4. The CTEA Violates the Requirement of "Securing for Limited Times"

The CTEA's retrospective extension of existing copyrights also violates the requirement of "limited Times." To begin, the government is wrong to focus only on the word "limited" in isolation from all else. As the Supreme Court has admonished in interpreting this Clause: "There is no mode by which the meaning affixed to any word or sentence, by a deliberative body, can be so well ascertained, as by comparing it with the words and sentences with which it stands connected." Wheaton v. Peters, 33 U.S. at 661.

Thus, the operative language is not the word "limited," but the language "*To promote the Progress of Science and useful Arts, by securing for limited Times to authors * * * the exclusive right to their respective Writings.*" Under the principle of Wheaton, "to promote the Progress of

Science” must inform the interpretation of “limited Times.” Thus, the only constitutionally permissible “limited Times” are those that “promote progress.”¹¹

The Supreme Court’s interpretation of the Copyright Clause in Feist, 499 U.S. 340 (1991), is instructive. In Feist, the Court held that originality is a constitutional requirement to obtain a copyright. Id. at 346-48. Even though a compilation of facts might require much effort and expense to create; it could not be copyrighted unless it had a minimal degree of originality. That result, the Court said, is “a constitutional requirement” because “[t]he primary objective of copyright is not to reward the labor of authors, but ‘to promote the Progress of Science and useful Arts.’” Id. at 349.

Under the interpretation of the Copyright Clause in Feist, the words contained in the means provision (such as “Writings” and “Authors”) are to be informed – and indeed, limited by – the opening language in the grant of power (“to promote the Progress of Science”). The Court did not focus solely on whether a compilation of facts constitutes a “Writing” under the Copyright Clause. Instead, it relied on the express grant of power “to promote the Progress of Science” to limit “Writings” to works that are original. See id. at 350 (originality requirement “is the means by which copyright advances the progress of science and art”). Only “Writings” that are original – as required to promote progress – fall within the grant of power.

¹¹ This interpretation differs slightly from the first one offered at pp. 13-19. There, plaintiffs argue that “to promote the Progress of Science” imposes an independent limitation on Congress’s power to grant “exclusive rights,” meaning that a copyright statute could grant “exclusive rights” for a properly “limited Time[]” but still fail to “promote progress.” Here, plaintiffs argue in the alternative that the grant of power (to promote progress) guides the interpretation of the balance of the clause, such that the only constitutionally permissible “limited Times” are those that “promote progress.” By either interpretation, the CTEA’s retrospective extension fails.

The Feist Court’s holistic approach to interpreting the Copyright Clause has a long pedigree dating back over a hundred years. The Feist Court relied on The Trademark Cases, 100 U.S. 82, 94 (1879) which recognized that “writings” are limited to original writings, Feist, 499 U.S. at 346, because of the limitation of promoting progress. As the Supreme Court explained in Higgins v. Keufel, 140 U.S. 428 (1891):

It was so held in Trade-Mark Cases, 100 U.S. 82, where the court said that, 'while the word 'writings' may be literally construed, as it has been, to include original designs for engravings, prints, etc., it is only such as are original, and are founded in the creative powers of the mind.' It does not have any reference to labels which simply designate or describe the articles to which they are attached, and which have no value separated from the articles, *and no possible influence upon science or the useful arts*. . . . The use of such labels upon those articles has *no connection with the progress of science and the useful arts*. So a label designating ink in a bottle . . . has *nothing to do with such progress*. It cannot, therefore, be held by any reasonable argument that the protection of mere labels is *within the purpose of the clause in question*.

Id. at 431 (emphasis added).

That same mode of interpretation applies here to the words “limited Times.” Just as “Writings” must be limited to *original* writings so as to promote progress, “limited Times” must be limited to copyright terms that promote progress as well. The CTEA’s retrospective extension, however, does not.

By the government’s reasoning, Congress could prolong the term of copyrights *ad infinitum*, just tacking on more years to existing copyrights whenever it wants (as it already has 11 times in the past 40 years). This result cannot be squared with the Constitution’s grants of enumerated powers. As Judge Sentelle explained in Eldred:

[T]here is no apparent substantive distinction between permanent protection and permanently available authority to extend originally limited protection. The Congress that can extend the protection of an existing work from 100 years to 120 years, can extend that protection from 120 to 140; and from 140 to 200; and from

200 to 300 * * * . This, in my view, exceeds the proper understanding of enumerated powers reflected in the Lopez principle of requiring some definable stopping point.

239 F.3d at 382.

This Court should also reject the government’s attempt to minimize the significance – and even number – of the 10 previous extensions to subsisting copyrights before the CTEA. In its brief (at p. 7 n.1), the government suggests that instead of 10, there was only *one* previous term extension – the switch to 75 years for existing works found in the 1976 Act. To dispose of the 9 other extensions, the government asserts that Congress “had already decided” on 75 years as the term for copyrights in the 1960s, but reached that number only through “numerous interim extensions” culminating in the 1976 Act. Gov’t Mem. 7 n.1. This proposition is untenable. Congress can only “decide” through *legislation*, which must satisfy the constitutional requirements of bicameralism and presentment to the President. See INS v. Chadha, 462 U.S. 919, 946-51 (1983). To say that Congress can “decide” things without passage of law through both Houses and presentment to the President would eviscerate our principle of separation of powers. The 10 previous extensions are directly relevant here because they all retrospectively extended the terms of copyright for many of the same works, published in 1923 through 1945. But for these extensions, many of these works would have entered the public domain already.

The government’s view of “limited Times” also creates the untenable result that the public can never know with certainty when works will enter the public domain, since the terms of existing works can change right before they were to enter the public domain. This goes against a central tenet of our copyright system. See Fogerty v. Fantasy, Inc., 510 U.S. 517, 527 (1994) (“Because copyright law ultimately serves the purpose of enriching the general public

through access to creative works, it is peculiarly important that the boundaries of copyright law be demarcated as clearly as possible.”).

It also undermines any notion that Congress has “secur[ed]” copyrights “for limited Times.” The Framers were quite specific that Congress must “secur[e] for limited Times” – in other words, not just to provide,¹² to establish,¹³ or to grant¹⁴ for limited Times, but to *secure* for limited Times. The verb to “secure” means “to make certain.” OXFORD ENGLISH DICTIONARY 852 (2d ed. 1989) (“to make secure or certain”); see Wheaton v. Peters, 33 U.S. at 660 (“secure” means “to protect, insure, save, ascertain, etc”). This meaning is consistent with how the grant of power was described in the Journal of Convention when it was first introduced in two clauses: (1) “To secure to literary authors their copy rights for a limited time”; and (2) “To secure to authors exclusive rights for a certain time.” 2 THE RECORDS OF THE FEDERAL CONVENTION OF 1787, at 321-22 (Max Farrand ed., 1911). This is to be contrasted with early English patent law, which allowed the King to grant a patent “for some reasonable time.” Walterscheid, 7 J. INTELL. PROP. L. at 323. The First Congress was quite specific in stating that the Copyright of 1790 was “an Act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, *during the times therein mentioned.*” Act of May 31, 1790 (emphasis added).

The history thus suggests that the Framers desired to have both certainty and a short duration in copyright terms. The only way Congress can “*secure* for limited Times” copyrights

¹² Cf. U.S. CONST. art. I, § 8, cl. 6 (power “To provide for the Punishment of counterfeiting Securities and current Coin of the United States”).

¹³ Cf. id. art. I, § 8, cl. 7 (power “To establish Post Offices and post Roads”).

is to enact limited terms of copyright that are certain and unchanging over time. Although Congress may alter the term of copyrights, it may only do so prospectively. For a term of an existing copyright that changes over time is, by no means, secured or certain. Quite the opposite: if the terms of existing copyrights keep changing – as it has 11 eleven times in the past 40 years – and is always subject to further change by Congress (as the government argues), those terms are *insecure*.

A useful analogy to consider is the enactment of a term limit for elected officials. That term limit would be neither “limited” nor “secured” if the legislature could simply go back and modify the law for current officials to allow them another term. And the law would be even less “limited” or “secured” if the legislature could do so repeatedly for the same current officials, prolonging their terms 11 times. Such a “term limit” would be wholly illusory. And so it is with the CTEA: the extension of the terms of existing copyrights circumvents the whole purpose of “securing for limited Times.” It would allow, in essence, Congress to achieve a perpetual copyright term “on the installment plan.” Statement of Prof. Peter Jaszi, *The Copyright Term Extension Act of 1995: Hearings on S.483 Before the Senate Judiciary Comm.*, 104th Cong. (1995), [available at](#) 1995 WL 10524355, at *6.

5. The CTEA Violates the Requirement of Originality

The CTEA also violates the requirement of originality, which is constitutionally required under *Feist*, 499 U.S. 340 (1991). There must be “at least some minimal degree of creativity” in the work to obtain copyright protection. *Id.* at 345. According to the government, originality is

¹⁴ Cf. *id.* art. I, § 8, cl. 11 (power “To declare War, grant Letters of Marque and Reprisal, and make Rules concerning Captures on Land and Water”).

satisfied as long as it is satisfied once when the work was created. Gov't Mem. 17. But this simply ignores how originality erodes over time.

To accept the government's argument would mean that the works of Plato, Aristotle, and even Homer could now obtain U.S. copyright protection because they were once "original." But that surely cannot be correct. When a work falls into the public domain, it necessarily becomes unoriginal material that is free to use and copy. See, infra, at pp. 48-50. Thus, if the same author attempted to republish the public domain work with slight variations, the originality requirement would bar another copyright. Why? Because neither the first publication nor the second has originality at the later point in time, when additional copyright protection is sought.

That same principle applies here as well. All of the existing works subject to the CTEA's retrospective 20-year extension possessed lengthy terms of protection (e.g., 75 years or life of the author plus 50 years), nearly triple the maximum term (28 years) under the first copyright act. If Congress chooses to change and extend the terms for existing works, the works should be subject to the originality requirement again. Here, they fail: the works are merely the same as materials already in circulation.

B. The CTEA Violates the First Amendment

In Count 2, Plaintiffs allege that the CTEA abridges their freedom of speech in *both* its retrospective and prospective extension of the term of copyrights. Compl. ¶¶ 102-107. By extending the term of copyrights, the CTEA effectively restricts for 20 more years what words or speech can be used if they are copyrighted. As such, it is a speech restriction that should be subject to First Amendment scrutiny.

1. Standard of Review

As explained below, copyright statutes are subject to intermediate scrutiny. As such, the regulation passes scrutiny if “(1) it furthers an important or substantial government interest; (2) if the governmental interest is unrelated to the suppression of free expression; and (3) if the incidental restriction on alleged First Amendment freedoms is no greater than is essential to the furtherance of that interest.” Turner Broad. Sys. v. FCC, 512 U.S. 622, 662 (1994) (quoting United States v. O’Brien, 391 U.S. 367 (1968)).

2. The Government Misconstrues *Harper & Row* and Ignores Circuit Court Authority Recognizing That Copyright Law Is Subject to First Amendment Scrutiny

The government takes the extraordinary position that copyright statutes are immune from all First Amendment scrutiny. Gov’t Mem. 19. This is even more extreme than the position the government took in Eldred, where, apparently in an effort to avoid Supreme Court review, the government conceded that copyright law would be subject to First Amendment review if there is viewpoint discrimination. Gov’t Eldred Opp. to Pet. for Cert. 20. In its brief to the Supreme Court in Eldred, the government did not adopt the D.C. Circuit’s position that “copyrights are *categorically* immune from challenges under the First Amendment,” 239 F.3d at 375 (emphasis added). Cf. Gov’t Eldred Opp. to Pet. for Cert. 22 (“copyrights are largely immune from First Amendment challenges”).

The extreme position the government now stakes out here is flatly inconsistent with the law of the Second, Fourth, and Eleventh Circuits, and, most importantly, inconsistent with the Tenth Circuit. Although the Tenth Circuit has not squarely considered the issue, its rulings strongly indicate that it would adopt the majority view.

To begin, the government simply misconstrues the Supreme Court’s decision in Harper & Row, Inc. v. Nation Enters., 471 U.S. 539 (1985). In Harper & Row, the Nation Magazine obtained and then published parts of President Ford’s unreleased autobiography without his or his publisher’s consent. As a defense to a copyright infringement claim, the Nation Magazine asked the Court to recognize a special First Amendment exception for reporting of news of public importance. Id. at 542, 556-60. It did *not* argue that Ford’s autobiography lacked a copyright. It simply sought a First Amendment right to trespass on Ford’s copyright in the interest of news reporting. See id. at 549 (“The Nation effectively arrogated to itself the right to first publication”).

In rejecting this argument, the Court saw “no warrant for expanding the doctrine of fair use to create what amounts to a public figure exception to copyright.” Id. at 560. Copyright, the Court explained, functions as an “engine of free expression,” id. at 558, by giving incentives for people to create speech that might not otherwise be produced. Because copyright had First Amendment protections embodied in the idea-expression distinction and fair use doctrine, id. at 560, the Court found no need for recognizing a public figure exception or First Amendment right to trespass on copyrights.

The government takes the limited holding of Harper & Row and attempts to transform it into a categorical shield for copyright law from all First Amendment scrutiny. But that cannot be correct. There is a difference between a challenge to the enforcement of a particular copyright as in Harper and a challenge – like the one here – to the *statutes* under which copyrights are established. Just as in the context of real property, that an individual has no First Amendment right to trespass on another person’s property does not prevent a First Amendment challenge to

the law establishing the property right. Although the D.C. Circuit did not agree, its view is directly contrary to the law of the Second, Fourth, and Eleventh Circuits, all of which have applied intermediate First Amendment scrutiny to recent enactments to copyright law. See Universal City Studios, Inc. v. Corley, 2001 WL 1505495, *12-14 (2d Cir. Nov. 28, 2001) (intermediate scrutiny to Digital Millennium Copyright Act, which is codified in the Copyright Act at 17 U.S.C §§ 1201 *et seq.* and which provides copyright holders rights against “circumvention” of access control technology); Satellite Broad. & Comm. Ass’n v. FCC, 2001 WL 1557809, at *10-*13 (4th Cir. Dec. 7, 2001) (intermediate scrutiny to Satellite Home Viewer Act, which is codified in part in the Copyright Act at 17 U.S.C. § 122 and which gives satellite carriers a right to compulsory licenses for certain copyrighted network programming delivered to private homes); CBS Broad., Inc. v. Echostar Comm. Corp., 265 F.3d 1193, 1210-11 (11th Cir. 2001) (intermediate scrutiny to Satellite Home Viewer Act).¹⁵

The majority view is the better law. There is no sound reason for treating copyright law differently than any other law that regulates speech. To the contrary, because copyright law affects the creation and dissemination of speech, copyright enactments should be subject to more searching review. See Neil Weinstock Netanel, “Locating Copyright Within the First Amendment Skein,” 54 STAN. L. REV. 1, 70-74 (2001) (arguing that intermediate scrutiny of Turner should apply to copyright laws, including the CTEA).

By all indications, the Tenth Circuit would adopt the majority view and apply intermediate First Amendment scrutiny to plaintiffs’ challenge. Although this Circuit has not

¹⁵ The government conceded in Eldred that Echostar involved a First Amendment challenge to “a copyright statute.” Gov’t Eldred Brief in Opp. to Pet. for Cert. 22.

squarely considered the issue, it has spoken on a First Amendment challenge in the context of the right to publicity under state law. In recognizing a First Amendment right to parody, the Court of Appeals expressed great concern about the impact intellectual property laws have on speech.

Writing for the Court of Appeals, Judge Tacha cautioned:

Intellectual property, unlike real estate, includes the words, images, and sounds that we use to communicate, and “we cannot indulge in the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process. Restrictions on the words or images that may be used by a speaker, therefore, are quite different than restrictions on the time, place, or manner of speech.” * * *

One of the primary goals of intellectual property law is to maximize creative expression. The law attempts to achieve this goal by striking a proper balance between the right of a creator to the fruits of his labor and the right to future creators to free expression. Underprotection of intellectual property reduces the incentive to create; overprotection creates a monopoly over the raw material of creative expression.

Cardtoons, L.C. v. Major League Baseball Players Ass’n, 95 F.3d 959, 971 (10th Cir. 1996).

The court then applied a form of intermediate scrutiny to the state statute “balanc[ing] the magnitude of the speech restriction against the asserted governmental interest in protecting the intellectual property.” *Id.* at 972. The court held that the statute could not, consistent with the First Amendment, be applied to parody cards. *Id.* at 976.

Although *Cardtoons* did not involve federal copyright law, the Tenth Circuit’s concern about restrictions of speech applies much more broadly to “intellectual property” law, *id.* at 971, not simply to the state right of publicity. Moreover, this District has declined to permit federal copyright law to chill the freedom of speech. *See RTC v. FACT Net, Inc.*, 901 F. Supp. 1519, 1527 (D. Colo. 1995) (declining to grant injunction for alleged copyright infringement because it “would silence the Defendants as participants in an ongoing debate involving matters of

significant public controversy”). Accordingly, this Court should reject the government’s argument that copyright law is immune from First Amendment scrutiny. That is not the law of this Circuit.

3. Plaintiffs Have Stated a Sufficient First Amendment Claim

If this Court agrees with plaintiffs (and three federal circuits) that First Amendment challenges to copyright statutes are subject to intermediate scrutiny, then plaintiffs have stated a sufficient legal claim, and the government’s motion must be denied. Accordingly, plaintiffs are entitled to conduct discovery and develop a complete factual record for this Court’s application of intermediate scrutiny. See Reno, 521 U.S. at 849; Turner, 512 U.S. at 665 (opinion of Kennedy, J.) (reversing summary judgment of First Amendment challenge to statute because “paucity of evidence” to support government’s asserted interest and lack of factual findings on “the actual effects of [statute] on * * * speech,” which are “critical” for intermediate scrutiny). District courts have recognized the need for developing a factual record for constitutional challenges. Bernstein, 922 F. Supp. at 1437 (denying motion to dismiss First Amendment challenge of federal statute regulating importation of defense articles); Century Federal, 579 F. Supp. at 1561 (denying motion to dismiss First Amendment challenge to franchise system “because there exist important factual issues that cannot be decided on pleadings alone”). Of course, the government “bears the burden of showing that the remedy it has adopted ‘does not burden substantially more speech than is necessary.’” Turner, 512 U.S. at 665.

C. The CTEA Violates Substantive Due Process

In Count 3, Plaintiffs challenge the CTEA’s retrospective grant of 20 years to the terms of existing copyrights as an unconstitutionally retroactive law that violates substantive due

process. Compl. ¶¶ 108-119. The government seeks dismissal of this Count on two grounds, neither of which has merit.

First, the government quotes a passage from McClurg v. Kingsland, 42 U.S. (1 How.) 202, 206 (1843), to suggest that Congress can enact retroactive legislation for patents or copyrights “without violating the Constitution.” Gov’t Mem. 19. But, to the extent the government means that all retroactive copyright legislation is beyond challenge under substantive due process, it is simply wrong. The dicta it quotes does not purport to give Congress power to enact retroactive laws that violate the Constitution. Modern Supreme Court jurisprudence has already rejected the government’s unlimited reading of McClurg and instead recognizes limits to Congress’s power. Graham, 383 U.S. at 6 (“*Within the scope established by the Constitution*, Congress may set out conditions and test for patentability.”) (citing McClurg, 42 U.S. at 206) (emphasis added).

Nor does McClurg purport to speak on retroactive term extensions, what is at issue here. The case instead involved the Patent Act of 1836. But the Act expressly did *not* apply retroactively to pre-existing patent suits (the “repeal * * * can have no effect to impair the right of property then existing in a patentee,” id. at 206). The only retrospective provisions were limited to codifying essentially the Supreme Court’s standard of “public use” set forth in Pennock v. Dialogue, 27 U.S. 1 (1829). McClurg, 42 U.S. at 207 (“[t]his Act is an affirmation of the principles laid down by this court”).

Second, the government attempts to use the *application* of the rational basis test under substantive due process as a reason for dismissal. Gov’t Mem. 20. But this, again, is improper for a motion to dismiss. Unless there is Tenth Circuit authority foreclosing plaintiffs’

substantive due process challenge to the CTEA (and there is not), the government's argument is premature: it must wait for trial. See Waste Mgmt. Holdings, Inc. v. Gilmore, 64 F. Supp. 2d 537, 548 (E.D. Va. 1999) (denying motion to dismiss equal protection claim based on rational basis review, even where "odds of success on these claims is not favorable," because plaintiffs should be permitted discovery); Fialkowski v. Shapp, 405 F. Supp. 946, 959 (E.D. Pa. 1975) (same); Ben Oehrleins & Sons and Daughters, Inc. v. Hennepin Co. Minn., 867 F. Supp. 1430, 1435 (D. Minn. 1994) (denying motion to dismiss substantive due process claim).

Plaintiffs have clearly stated a cognizable challenge. First, the CTEA applies retroactively to affect the rights of plaintiffs. The test for retroactivity is "whether the new provision attaches new legal consequences to events completed before its enactment." Landgraf v. USI Film Products, 511 U.S. 244, 269-70 (1994). A retroactive statute is one that "takes away or impairs vested rights acquired under existing laws, or creates a new obligation, imposes a new duty, or attaches a new disability." Sturges v. Carter, 114 U.S. 511, 519 (1885); see Lohf v. Casey, 330 F. Supp. 356, 359 (D. Colo. 1971) (retroactive legislation "take[s] away or impair rights acquired under prior law or * * * creates new disabilities with respect to past transactions"), aff'd, 466 F.2d 618 (10th Cir. 1972). This inquiry is be guided by "considerations of fair notice, reasonable reliance, and settled expectations." Landgraf, 511 U.S. at 270.

In extending the terms of existing copyrights, the CTEA operates retroactively. It places an additional disability on existing copyrighted works that members of the public have legitimately purchased by depriving the public's right to copy those works for another 20 years. Cf. Vornado Air Circulation Sys., Inc. v. Duracraft Corp., 58 F.3d 1498, 1505 (10th Cir. 1995) (recognizing "the clear and continuing trend [of Supreme Court precedent] in favor of the

public's right to copy"); Marobie-Fl., Inc. v. National Ass'n of Fire Equip. Distrib., 2000 WL 1053957, at *5 (N.D. Ill. July 31, 2000) ("The right to copy matter in the public domain is based upon Article 1, § 8 of the United States Constitution and the federal copyright laws."). This 20-year impairment on the public's right to copy certainly did not exist before the CTEA, when the public purchased existing copyrighted works. It arose only because of the CTEA's retroactive extension. And it is no answer for the government to say that the public domain works may be common to others besides plaintiffs. Gov't Mem. 20. As long as plaintiffs' right to copy has been impaired, they have standing. Nothing precludes plaintiffs from raising a facial challenge to the CTEA, as they have, in addition to an as applied challenge. Compl. ¶¶ 5, 118.

Finally, plaintiffs have alleged sufficient facts to state a claim of substantive due process. In this case, the degree of retroactive effect is quite severe. The CTEA, which is the single largest extension of subsisting copyrights ever enacted, prevents *any* copyrighted work from entering the public domain due to the expiry of the term until the year 2019. Individuals, such as plaintiffs Ron Hall and John McDonough, whose very livelihood depends on the sale of public domain materials, have been adversely affected in their businesses because they no longer have any "new" public domain works to offer. Compl. ¶¶ 80-81, 86-87. For these plaintiffs, the CTEA has already deprived them of their ability to sell many important films dating from 1923 through 1926. Id. ¶¶ 81, 87. The CTEA also impairs the ability of orchestras and musicians to publicly perform works that would have been in the public domain, since the rental of copyrighted music is often cost prohibitive. Id. ¶¶ 52-53, 55, 62-65, 75. Even assuming for the sake of argument that the proffered reasons for the CTEA were legitimate (and there are reasons to doubt that they were), the means chosen is simply arbitrary. It is irrational to grant existing

copyrights an additional 20 years of protection when the overriding goal of our copyright system is – and must be – the broad public availability of works. Aiken, 422 U.S. at 156. The government’s motion should be denied.

II. THE URAA’S REMOVAL OF WORKS FROM THE PUBLIC DOMAIN IS UNCONSTITUTIONAL

By removing thousands of foreign works from the public domain and subjecting them to “restored copyrights,” the URAA restricts the public’s free access to materials that were once available to it. This law is clearly unconstitutional. Indeed, it goes against the settled law of the Supreme Court. In Graham v. John Deere Co., the Court stated in no uncertain terms: “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.” 383 U.S. at 6. That principle of law, which the Court enunciated in interpreting the limitations imposed by the Copyright and Patent Clause, is controlling here. Indeed, although the URAA was not at issue in Eldred, the D.C. Circuit there readily acknowledged that “[a]ppplied *mutatis mutandis* to the subject of copyright, these teachings would indeed preclude the Congress from authorizing under that Clause a copyright to a work already in the public domain.” 239 F.3d at 377.

Even the government in Eldred recognized problems with Congress’s removal of works from the public domain. There, the government asserted that the originality requirement was not violated by extending the terms of subsisting copyrights because “[o]nly if documents become part of the public domain by lapse of copyright would ‘originality’ become a relevant concept.” Gov’t Eldred Brief of Appellee 35.

But the government now changes suit and advances a much more extreme position – that the removal of works from the public domain is authorized by the Copyright Clause, and the originality requirement is irrelevant. That extreme view, however, has no basis in law. And the government fares no better under the Treaty Clause, which is subject to the limitations found in other clauses of the Constitution. Because plaintiffs have stated ample grounds to support their claims in Counts 4 through 6 that the URAA is unconstitutional, the government’s motion must be denied.

A. The URAA Violates the Limits Imposed by the Copyright Clause

1. The URAA Does Not Promote the Progress of Science and Is Directly Contrary to *Graham v. John Deere Co.*

The URAA is unconstitutional because it does not “promote the Progress of Science and useful Arts”¹⁶ and is directly contrary to Graham v. John Deere Co., 383 U.S. 1 (1966). The Supreme Court stated there unequivocally that the phrase “to promote the Progress of Science and useful Arts” imposes limits on Congress, including forbidding Congress from removing existent material from the public domain – precisely what the URAA purports to do here. *Id.* at

6. As the Court stated:

*The Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose. Nor may it enlarge the patent monopoly without regard to the innovation, advancement or social benefit gained thereby. Moreover, Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict access to materials already available. Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must “promote the Progress of * * **

¹⁶ As explained in Part I, the standard of review for Copyright Clause challenges based on “to promote the Progress of Science” is whether the statute promotes progress or learning.

useful Arts. *This is the standard expressed in the Constitution and it may not be ignored.*

Id. at 5-6 (emphasis added).¹⁷

The URAA, however, violates this constitutional restriction by removing numerous works from the public domain under the guise of copyright restoration. Although the rule of Graham was elaborated in a patent case,¹⁸ it necessarily applies to copyright laws because Congress's power is restricted in both cases by the same constitutional provision, Article I, § 8, clause 8. See Sony Corp., 464 U.S. at 429 (“The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit.”); Trade-Mark Cases, 100 U.S. 82, 94 (1879) (Congress cannot grant trademarks under Copyright Clause because the subject matter of trademarks is “something already in existence”).¹⁹

That conclusion is supported by the D.C. Circuit's analysis in Eldred, a case upon which the government (at least elsewhere) heavily relies. Although the D.C. Circuit did not consider the constitutionality of the URAA (the only statute at issue was the CTEA), the court nevertheless stated that the Graham rule, when applied to copyright, would prevent Congress from doing what it has done here. As the court explained, “[a]ppplied *mutatis mutandis* to the

¹⁷ See also Frantz Mfg. Co., 457 F.2d at 327 n.48 (Stevens, J.) (“The source and purpose of the statutory monopoly must be kept in mind. An Author's ‘Writing’ or an inventor's ‘Discovery’ can, in the constitutional sense, only extend to that which is his own. *It may not be broadened to include matters within the public domain.* The congressional power to grant monopolies for ‘Writings and Discoveries’ is likewise limited to that which accomplishes the stated purpose of promoting ‘the Progress of Science and useful Arts.’”) (emphasis added).

¹⁸ The Court held that Congress's enactment of the standard of “nonobviousness” in the Patent Act of 1952 codified the *constitutional* standard of patentability that had been elaborated by the Court in earlier precedent. 383 U.S. at 3-4.

¹⁹ Since the Tenth Circuit in Time Saver Tools adopted the same position on nonobviousness (that it is constitutionally based) as later adopted by the Supreme Court in Graham, it is reasonable to conclude that Graham represents the law of this Circuit.

subject of copyright, these teachings would indeed preclude the Congress from authorizing under that Clause a copyright to work already in the public domain.” Eldred, 239 F.3d at 376 *94.

The URAA effectively destroys huge segments of the public domain. It removes thousands of works from the public domain by “restoring” them to copyright. Compl. ¶¶ 46-47. Many of these works had been in the public domain for decades in the United States – potentially going back to the early 1920s. Before the URAA was enacted, these works were public domain works, which meant that they could be disseminated and performed freely by anyone in the public. Now, they cannot. The URAA prevents the public from freely disseminating and performing these works.

For example, conductors Lawrence Golan and Richard Kapp, as well as the small community-based orchestra Symphony of the Canyons, have all had to forgo the public performance of many great foreign classical works that had been in the public domain for many years. Compl. ¶¶ 53-54, 57, 59-60, 66-72, 76-77. These include the works of the Russian composers Stravinsky, Prokofiev, and Shostakovich. Id. ¶ 56. For example, just this past fall, Golan would have liked the Lamont Symphony Orchestra to perform Shostakovich’s *Symphony No. 5* or Prokofiev’s *Symphony No. 1*, because learning to perform such foreign works is essential to the training of his students. Before the URAA was enacted, Golan would have been able to obtain copies of these works for purchase at a relatively inexpensive price. Now, however, Golan cannot afford to rent the sheet music for such works because it is too expensive for Lamont Symphony’s limited budget. Id. ¶ 57. Because of the URAA, his students will not learn these great foreign works during their study at the Lamont School of Music. Compounding

the injury, much of the Denver public (and no doubt other cities as well, see id. ¶¶ 66-68, 76-77) will not be able to hear a public performance of these great foreign works.

There is absolutely no way that this depletion of the public domain can be said to “promote the Progress of Science.” This phrase means the promotion of learning. See Suntrust Bank, 268 F.3d at 1261. The URAA, however, removes existent knowledge from the public domain and restricts access to material once available to the public. The consequence is palpable. For Golan’s students, they will be able to learn *less*, not more, because of the URAA. The communities, such as Denver, where plaintiffs perform will have *less*, not more, access to performances of foreign classical works. The customers of plaintiffs who sell public domain films will have a *lesser*, not greater, selection of foreign works. And the public in general will have many fewer works available in the public domain. This is the destruction of learning, not its promotion.

2. The URAA Violates the Constitutional Requirement of Originality

The URAA also violates the constitutional requirement of originality. A work must bear “some minimal degree of creativity” when granted copyright protection. Feist, 499 U.S. at 345. By definition, works in the public domain are *unoriginal*. As the Tenth Circuit explained in the context of the test for copyright infringement, “a court must filter out all *unoriginal* elements of a program, *including those elements that are found in the public domain.*” Gates Rubber Co., 9 F.3d at 837-38 (emphasis added); id. at 838 (characterizing elements in the public domain as “unoriginal elements”); Mitel, 124 F.3d at 1372 (test for infringement “excludes from protection expression that is in the public domain, otherwise unoriginal”). Thus, if an entire work is in the public domain, then mere copies of that work are unoriginal. See L. Batlin & Son, Inc. v.

Snyder, 536 F.2d 486, 491 (2d Cir. 1976) (concluding that a work based on a public domain work “must contain ‘an original contribution not present in the underlying work of art’ and be ‘more than a mere copy’”) (citing 1 M. Nimmer, § 20.2).²⁰ It is axiomatic that material “already in the public domain * * * cannot be subject to copyright protection.” Country Kids ’N City Slicks, Inc. v. Sheen, 77 F.3d 1280, 1287 (10th Cir. 1980). The public domain is thus the repository of all that is unoriginal. See Jessica Litman, “The Public Domain,” 39 EMORY L.J. 965, 998 (1990) (“The realm protected by copyright is privately owned; the unprotected realm is the public domain. What we rely on in place of physical borders to divide the privately-owned from the commons and to draw lines among the various parcels in private ownership, is copyright law’s concept of originality.”).

Here, the URAA purports to grant copyrights retroactively to works that have been in the public domain for many years. As public domain works, the works granted restored copyright protection are unoriginal. Once they entered the public domain, they lost their originality and became free for all to use and copy. The URAA is, therefore, unconstitutional since it grants copyrights to public domain works, which lack originality.

The government virtually conceded this point in Eldred. Distinguishing the CTEA’s extension of subsisting copyrights from granting copyrights to public domain works, the government argued: “They [the works under the CTEA] have never been in the public domain.

²⁰ Although the D.C. Circuit in Eldred did not squarely consider the issue, it noted that Feist supported the argument “that a work in the public domain lacks the originality required to qualify for a copyright.” Eldred, 239 F.3d at 377. The court stated: “That is certainly not inconsistent with [Feist]: A work in the public domain, is by definition, without a copyright; where the grant of a copyright is at issue, so too is the work’s eligibility for copyright, and thus the requirement of originality comes into play.” Id.

Only if documents become part of the public domain by lapse of copyright would ‘originality’ become a relevant concept.” Gov’t Eldred Brief of Appellee 35. Even more: “The United States’ flag is in the public domain. It is not subject to copyright because it is not original.” Id. at 47. But, if, as the government conceded in Eldred, the flag is not original, it is not because Dolly Madison stole it from someone else. It is only because it entered the public domain.

Now, however, the government retreats. It asserts the untenable position that originality does not matter for public domain works. In the government’s view, originality can be satisfied perpetually. Gov’t Mem. 29-30. Thus, if a work is original when first created, it is original “with the passage of time” (id. at 30), even years after it has entered the public domain. But that view is nonsense. To embrace the government’s position would allow Congress to “restore” copyrights to every single work in the public domain, including the works of Shakespeare, Milton, and even the Bible – since, by the government’s reasoning, they were original at creation. But that is not the law. Once a work enters the public domain, it is lost forever. Letter Edged in Black Press, Inc. v. Public Building Comm’n of Chicago, 320 F. Supp. 1303, 1310 (N.D. Ill. 1970) (holding that Picasso’s maquette was “forever lost to the public domain” when published without statutory notice and a larger sculpture of the work “could not be copyrighted for it was a mere copy * * * of [Picasso’s] maquette, a work already in the public domain”); see Dolman v. Agee, 157 F.3d 708, 713 (9th Cir. 1998) (“If the owner failed to satisfy the [1909] Act’s requirements, the work was injected irrevocably into the public domain.”).

3. The Framers Did Not Sanction the Removal of Works From the Public Domain

As it did in the case of the CTEA, the government asserts that the Copyright Act of 1790 provides historical precedent to justify Congress's action, this time the removal of works from the public domain. But, once again, the government is simply mistaken.

First, the government's bare allegations of fact are wholly inappropriate for resolution on a motion to dismiss. To assert that the Copyright Act of 1790 "restored copyrights to public domain works" (Gov't Mem. 24) is an assertion of fact that is wholly unsubstantiated. If the government wants to offer evidence of the titles of works that it believes were removed from the public domain (the government points to none, and we know of none), it must wait for a later day. On a motion to dismiss, the government's version of facts is irrelevant.

Second, the government's bare assertions can be easily refuted. Indeed, the government's own argument shows the error of its ways. In defending the CTEA, the government asserted that the Act of 1790 extended the terms of copyrights for works "already printed" – with the clear assumption being that copyrights existed for those works before the Act of 1790. Gov't Mem. 4, 24. Now, in defending the URAA, the government takes the completely contradictory position that "[w]orks already in existence had not been protected in the United States previous[]" to the Act of 1790. *Id.* at 23. The government cannot have it both ways.

The government simply misunderstands the Copyright Act of 1790. It seizes upon the fact that the Copyright Act of 1790 gave copyrights to certain works "already printed within these United States," but there is no reason to believe such works were in the public domain. As explained above, copyright existed under state copyright statutes even before the first federal copyright act. Common law copyright also provided (potentially perpetual) protection. Thus,

the works “already printed” in the U.S. covered by the Copyright Act of 1790 could have always claimed copyright protection under common law.

Third, the government is flat wrong in its assertion that the URAA is “factually indistinguishable” from the Copyright Act of 1790. Gov’t Mem. 24. To begin, the text of the statutes are remarkably different: the URAA expressly grants “restored copyrights” to works “in the public domain,” 17 U.S.C. § 104A(h)(6); the Act of 1790 does not even speak of works in the public domain, much less restoring them to copyright. The Copyright Act of 1790 was a transitional statute that was designed to address a unique problem of creating a federal copyright system. To speak of works existing in the “public domain” before the Copyright Act of 1790 is simply an anachronism. The public domain gains meaning only after the adoption of the Constitution and upon the creation of the federal copyright system.

The URAA, by contrast, was enacted over 200 years after the first federal Copyright Act. Since that time, the Supreme Court has elaborated constitutional principles clearly stating that (1) the public must have free access to material in the public domain and (2) that Congress cannot remove existent knowledge from the public domain or material already available. See Bonito Boats, Inc. v. Thunder Boats, Inc., 489 U.S. 141, 153 (1989); Graham, 383 U.S. at 6. Relying upon these bedrock principles, plaintiffs and no doubt many others in this country used, disseminated, and performed public domain works. Unlike the first Copyright Act, the URAA expressly removes numerous works from the public domain, immediately harms artists (such as plaintiffs) in their creative pursuits, and directly flouts Supreme Court precedent.

The harm effectuated by copyright “restoration” is precisely the kind of harm feared by the Framers. The Framers drafted the Copyright and Patent Clause “against the backdrop of the

practices – eventually curtailed by the Statute of Monopolies – of the [British] Crown in granting monopolies to court favorites *in goods or businesses which had long before been enjoyed by the public.*” Graham, 383 U.S. at 5 (emphasis added). Here, the URAA purports to authorize precisely what the Framers intended to forbid – the removal of materials that have long before been enjoyed by the public.

4. The Government’s Reliance on Pennock v. Dialogue Is Misplaced

Apparently attempting to divert attention from the rule of Graham, the government devises the theory that a case decided close to 150 years earlier, Pennock v. Dialogue, 27 U.S. 1 (1829) should be read to qualify, *sub silentio*, the rule of Graham. In the government’s view, what the Court really meant to say in Graham is that “Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain,” *except* in cases where the work entered the public domain due to lack of either national eligibility or compliance with formalities. These latter exceptions, the government asserts, effectively denied the foreign author (or inventor) a “choice” of obtaining U.S. protection. Gov’t Mem. 24-25.

The government’s theory is entirely meritless, both on its own terms and in its reading of the cases. At least since 1891 when U.S. copyright law applied to foreign authors (see Act of March 3, 1891, § 4952 (abrogating citizenship requirement)), foreign authors have had the choice to gain U.S. copyright protection. Authors from countries that had copyright agreements with the U.S. (which totaled nearly 100 even before it joined the Berne Convention) could obtain copyrights by compliance with U.S. law. See Berne Convention Implementation Act of 1988, S. Rep. No. 100-352, reprinted in 1988 U.S.C.C.A.N. 3706, 3707. Authors from countries that did

not have such agreements with the U.S. could always choose to comply with U.S. law or to simply move here (as Igor Stravinsky and no doubt others did).

More importantly, neither Pennock nor Graham supports the government's theory. If anything, Pennock only further buttresses our point that the phrase "to promote the Progress of Science" imposes a substantive limit on Congress. At issue in the case was the interpretation of the Patent Act, which then allowed the patenting of inventions "not known or used before the application." 27 U.S. at 17. Writing for the Court, Justice Story interpreted this phrase to mean "not known or used before *by the public*." Id. at 19. A patent could not issue for any invention that became known or used by the public.

In reaching this conclusion, Justice Story offered two rationales that are directly applicable here. First, he concluded that a "public use" bar would best serve the Patent Clause, whose "main object [is] 'to promote the progress of science and useful arts'" because it would give "the public at large a right to make, construct, use and vend the thing invented, at as early as possible." Id. at 19. Second, Justice Story contended that "public use" would be a bar even where the use occurs without the knowledge of the inventor (as long as not due to fraud). Once the public gains possession of the invention, such that it was "already in * * * common use," no patent should be available because, in Justice Story's view, "[t]here would be no *quid pro quo* – no price for the exclusive right or monopoly conferred upon the inventor for fourteen years." Id. at 23.

These principles demonstrate the constitutional infirmity of the URAA. The URAA purports to grant copyright protection for works that are already in common use and legitimately owned by the public. But, once the public legitimately gains possession of a work such that is

“already in common use,” Congress has no power to grant a copyright because there is no *quid pro quo* for material already available to the public. This windfall grant of protection is unconstitutional.

B. The Treaty Power Does Not Cure the URAA’s Unconstitutionality

The government also seeks to justify the URAA “as an implementation of the Berne Convention, signed pursuant to the treaty power and implemented pursuant to the Necessary and Proper Clause.” Gov’t Mem. 22. The government’s analysis simply assumes that the Copyright Clause *permits* the removal of works from the public domain and imposes *no* restrictions on Congress. *Id.* at 31 n.2. However, as shown above, that assumption is contrary to settled Supreme Court case law. The cases clearly recognize that the Copyright and Patent Clause is both a grant of power and a *limitation*. And one of those limitations is that Congress cannot remove existent materials from the public domain. Thus, the appropriate question to consider is whether, assuming that the URAA cannot be justified as an exercise of the Copyright Clause, it may nevertheless be justified under the Necessary and Proper Clause as an exercise of Congress’s implementation of a treaty. The short answer is no.

Neither the Treaty Power nor the Necessary and Proper Clause can be used to circumvent substantive limitations imposed by other constitutional provisions.²¹ The Supreme Court has long recognized that courts may annul treaties that “violate the Constitution of the United

²¹ Nor can the Foreign Commerce Clause be used to circumvent limitations on Congress’s power. See Printz v. U.S., 521 U.S. 898, 923-24(1997) (recognizing that a law enacted pursuant to Commerce Clause that violated notions of state sovereignty embodied in other constitutional provisions could not be justified under Necessary and Proper Clause); Railway Labor Executives’ Ass’n, 455 U.S. at 468-69 (“if we were to hold that Congress had the power to enact nonuniform bankruptcy laws pursuant to the Commerce Clause, we would

States.” Doe v. Braden, 57 U.S. 635, 657 (1853). See also United States v. Minnesota, 270 U.S. 181, 207-208 (1926); Holden v. Joy, 84 U.S. 211, 242-243 (1872); The Cherokee Tobacco, 78 U.S. 616, 620-621 (1870). Thus, the Treaty Power does not give the government the power to do something that another part of the Constitution forbids.

The treaty power, as expressed in the constitution, is in terms unlimited, except by those restraints which are found in that instrument against the action of the government, or of its departments * * *. It would not be contended that it extends so far as to authorize what the constitution forbids * * *.

Geofroy v. Riggs, 133 U.S. 258, 267 (1890).

The same holds true of Congress’s power under the Necessary and Proper Clause. It is not “proper” for Congress to enact a law that violates a constitutional limitation. Under the Necessary and Proper Clause, Congress may only enact statutes “which are appropriate, which are plainly adapted to that end, [and] which are not prohibited, but consist with the letter and spirit of the Constitution.” M’Culloch v. Maryland, 17 U.S. (4 Wheat.) 316, 421 (1819); see Printz, 521 U.S. at 923 (“[w]hen a ‘La[w] * * * for carrying into Execution’ the Commerce Clause violates the principle of state sovereignty reflected in the various constitutional provisions * * *, it is not a ‘La[w] * * * proper for carrying into Execution the Commerce Clause’”).

The government’s reliance on Missouri v. Holland, 252 U.S. 416 (1920), is misplaced. There, the Court held that the Migratory Bird Treaty Act did not violate the Tenth Amendment. Id. at 433-34. That holding was premised on the conclusion that “[t]he treaty in question does not contravene any prohibitory words to be found in the Constitution.” Id. The Court found no

eradicate from the Constitution a limitation on the power of Congress to enact bankruptcy laws”).

limitations present “by some invisible radiation from the general terms of the Tenth Amendment.” Id.²²

In Reid v. Covert, 354 U.S. 1 (1957), by a plurality decision, the Court made clear that the holding in Missouri v. Holland was limited to a treaty that “was not inconsistent with any specific provision of the Constitution.” Id. at 19. In Reid the Court held that a U.S. citizen could not be tried in a military tribunal pursuant to a treaty because it would deny her Fifth and Sixth Amendment rights. Justice Black explained in his opinion:

There is nothing in this language which intimates that treaties and laws enacted pursuant to them do not have to comply with the provisions of the Constitution. Nor is there anything in the debates which accompanied the drafting and ratification of the Constitution which even suggests such a result. * * * It would be manifestly contrary to the objectives of those who created the Constitution, as well as those who were responsible for the Bill of Rights – let alone alien to our entire constitutional history and tradition – to construe Article VI as permitting the United States to exercise power under an international agreement without observing constitutional prohibitions. * * * The prohibitions of the Constitution were designed to apply to all branches of the National Government and they cannot be nullified by the Executive or by the Executive and the Senate combined.

Id. at 16-17 (opinion of Black, J.).

In this case, the Copyright Clause (as well as the First Amendment and substantive due process) provides substantive limitations on Congress’s power. Congress “may not overreach the restraints imposed by the stated constitutional purpose” of the Copyright Clause. Graham, 383 U.S. at 5-6. Accordingly, Congress cannot remove existent knowledge from the public domain or restrict access to material already available. Id. Nor can Congress give copyright protection to works that are not original. Feist, 499 U.S. at 345. The URAA violates these

²² The Court’s Tenth Amendment jurisprudence has undergone a sea change in the past decade. See Printz, 521 U.S. at 919; New York v. United States, 505 U.S. 144, 156-159

constitutional restrictions, however, and is unconstitutional. See Paul J. Heald & Suzanna Sherry, “Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress,” 2000 UNIV. ILL. L. REV. 1119, 1182-1183 (2000) (concluding that the URAA is unconstitutional and cannot be saved by an international treaty or the Treaty Power).

The government’s argument, if accepted, would eviscerate the Constitution. What if the United States agreed to a treaty that denied copyright protection to all Nazi material and made the sale of such material illegal (as some European countries do)? Or if the U.S. agreed to a treaty that gave copyright protection to unoriginal works in contravention to Feist? By the government’s reasoning, Congress could implement such laws in this country as “necessary and proper” to implement a treaty. But this evasion of the limits imposed by other Clauses of the Constitution is clearly impermissible.

C. The Berne Convention Does Not Render the URAA Constitutional

The government asserts that the URAA promotes the progress of science insofar as it implements the Berne Convention, an international agreement that the U.S. joined in 1989. Gov’t Mem. 27. But the government again simply posits its own view of the facts. That is improper in a motion to dismiss. The only issue here is whether plaintiffs raise a colorable – nonfrivolous – challenge under the Copyright Clause.

They clearly have. Plaintiffs have alleged numerous concrete harms that they have suffered as a result of copyright restoration. These allegations of harm clearly establish that copyright restoration – and its attendant removal of thousands of works of literature, music,

(1992).

movies, and other arts from the public domain – do not advance learning in this country or “the cause of promoting broad public availability of literature, music, and the other arts” as required by the Copyright Clause. Aiken, 422 U.S. at 156. Plaintiffs are no longer able to distribute to the American public whole classes of foreign film, such as the works of Alfred Hitchcock and movies starring Laurence Olivier, Ingrid Berman, Richard Burton, Douglas Fairbanks, Orson Welles, Vivian Leigh, and Rex Harrison. Compl. ¶¶ 83, 88. Nor are plaintiffs able to perform publicly numerous classical works of Stravinsky, Prokofiev, Shostakovich, and other foreign composers, because the cost of renting such works is, in many cases, prohibitive. Id. ¶¶ 57, 59, 64-70, 76. As a consequence, the public has a diminished supply of artistic works it can enjoy from the public domain. Plaintiffs’ allegations, which must be accepted as true and in the light most favorable to plaintiffs, more than adequately state a legal claim.

The government’s assertions to the contrary must wait for a trial. Plaintiffs are fully prepared to offer evidence and testimony refuting the government’s assertions about implementation of the Berne Convention and its purported effect on promoting progress.

D. The URAA Violates the First Amendment

The URAA also violates the First Amendment by preventing the plaintiffs (and many others) from publishing and disseminating works that had been in the public domain, but now are subject to copyright restoration. Contrary to the government’s assertion, the “idea/expression” dichotomy does not immunize copyright laws from First Amendment scrutiny. As a restriction of speech, an enactment to the Copyright Act is subject to First Amendment scrutiny. See, supra, at pp. 35-39. Because plaintiffs have stated a sufficient First Amendment claim, the government’s motion must be denied.

Plaintiffs should be allowed to develop a factual record to assist this Court's application of intermediate scrutiny (which is, as explained above in Part I, the standard of review). Plaintiffs intend to show that, under intermediate scrutiny, the URAA fails. The URAA's restoration of copyright and attendant removal of thousands of works from the public domain is not narrowly tailored to serve a significant government interest. Of course, the government ultimately bears the burden of proof. Turner, 512 U.S. at 665. The government here makes no attempt to explain, much less justify, the wholesale removal of thousands of works from the public domain. That depletion of the public domain has prevented plaintiffs and no doubt many others from disseminating, publishing, or using numerous artistic works. It has dramatically curbed their artistic expression and pursuits. The government simply ignores plaintiffs' allegations of harm.

E. The URAA Violates Substantive Due Process

The URAA is a retroactive law that violates substantive due process. First, there can be no serious question that the URAA's "restoration" of copyrights has a retroactive effect. Over the years, plaintiffs have purchased artistic works that had been in the public domain in the United States. Compl. ¶¶ 140-41. At the time of the purchase of these public domain works, the law was well settled that plaintiffs were free to copy, perform, sell, and make derivative works from these public domain works *without restraint*. At the time, plaintiffs had absolutely no notice that these works would some day become off-limits and essentially stripped of their inherent value. And how could they have notice? The law was clear that public domain works were for the *public's* unlimited use. See Compco Corp. v. Day Brite Lighting, Inc., 376 U.S. 234, 237 (1964) (recognizing 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”).

Plaintiffs reasonably relied on the law to mean what it says (or then said). They purchased public domain works with the legitimate expectation that they would be able to use them freely. They even staked their businesses and artistic endeavors on the ability to use freely public domain works. For example, plaintiffs Hall and McDonough entered the business of selling public domain films. Compl. ¶¶ 78, 84. In choosing this line of work, they made investments of time and capital in securing foreign public domain films. *Id.* ¶¶ 80-82, 86-88. However, the URAA has shattered Hall’s and McDonough’s expectations and stripped them of their ability to sell numerous foreign works, including many popular titles of Alfred Hitchcock and other renowned directors. *Id.* ¶¶ 82-83, 88. The restoration of copyright effectively attaches new legal consequences to the plaintiffs’ prior purchase of public domain works by saddling the works with new legal constraints (copyright) that render those works virtually valueless. The URAA, in other words, “takes away vested rights acquired under existing law, * * * [and] attaches a new disability” on plaintiffs’ works. *Sturges*, 114 U.S. at 519. This effect is plainly retroactive if that word is to have meaning at all.

Accordingly, plaintiffs have clearly stated a colorable challenge. Even assuming the government’s asserted goal of international harmonization is legitimate, the URAA’s removal of thousands of works from the public domain is both arbitrary and irrational. It immediately harms plaintiffs and many others in their artistic endeavors and strips them of their ability to exploit their own copies of public domain works, which they legitimately purchased but now cannot freely perform or sell to the public. *Cf. In re Rodrock*, 3 B.R. 629, 633 (Bank. Ct. Colo. 1980)

(“legislation which effects the total deprivation of a substantive right in specific property antedating the statute is unreasonable” and unconstitutionally retroactive).

The URAA also purports to jettison retroactively a host of copyright laws that have long established the ground rules for our copyright system. These well-established rules of law include: (1) Congress cannot remove existent knowledge from the public domain, or materials already available to the public, Graham 383 U.S. at 5-6; (2) works in the public domain cannot be copyrighted and are free for all to use and copy, Bonito Boats, 489 U.S. at 153 and Country Kids, 77 F.3d at 1287; (3) general publication of a work under the 1909 Copyright Act without compliance with the Act’s formalities irrevocably injected the work into the public domain, Dolman, 157 F.3d at 713; and (4) under the first sale doctrine, an owner of a lawfully made and purchased copy of a work can sell, rent, or otherwise dispose of it at will, Bobbs-Merrill Co. v. Straus, 210 U.S. 339, 350 (1908).

The URAA has even had the astounding effect of invalidating – retroactively – a district court decision from 1965. In Scandia House Enters., Inc. v. Dam Things Establishment, a federal district court declared that the U.S. copyrights to troll dolls manufactured by a Danish company were invalid and thus the dolls in the public domain in the U.S. 243 F. Supp. 450, 454 (D.D.C. 1965) (“[n]o copyright can subsist in Dolls in the public domain”). In reliance upon this judgment, a U.S. company began making and selling dolls in the U.S. based on the original troll dolls – which under the law before the URAA was clearly permissible because they were in the public domain. See Dam Things from Denmark v. Russ Berrie & Co., 173 F. Supp. 2d 277 (D. N.J. 2001). But, now, the Danish company has asserted “restored copyrights” in the dolls and has obtained an injunction against their continued manufacture in the U.S. Id. Come February

13, 2002, when the injunction is to take effect, children in this country will have fewer troll dolls because of the URAA.

It is both arbitrary and irrational to “harmonize” U.S. copyright law with an international convention in a way that not only tramples on the property rights of U.S. artists and diminishes their ability to promote learning in this country, but also attempts to eviscerate so many settled principles of law. The removal of thousands of works from the public domain goes simply too far.²³

III. PLAINTIFFS SHOULD BE ALLOWED TO CONDUCT DISCOVERY AND BE AFFORDED AN EVIDENTIARY HEARING

A motion to dismiss is proper if and only if it is *beyond doubt* that a legal claim cannot be stated. Sutton, 173 F.3d at 1236. In this case, plaintiffs have pointed to substantial authorities that support the legal sufficiency of their claims. Their allegations far surpass the low threshold of establishing a “nonfrivolous” constitutional claim.

And the government – while relying heavily on Eldred – does not come close even in removing the doubt about the extreme positions it advances. The Tenth Circuit has long taken a different view of “To promote the Progress of Science and useful Arts” than the D.C. Circuit. For the Tenth Circuit, the words have meaning, and they expressly limit what Congress may do. That position is what the Supreme Court adopted in Graham, a case the government simply ignores. Moreover, three federal circuit courts have recognized that copyright laws are subject to intermediate First Amendment scrutiny – a position that, by all indications, the Tenth Circuit

²³ Removing works from the public domain in the name of “harmonization” is akin to “burning the house to roast the pig.” Cf. Reno v. ACLU, 521 U.S. at 882. Congress had plenty of less restrictive and less arbitrary ways of obtaining “harmonization” than the wholesale removal of thousands of works from the public domain.

would embrace. And the Eldred court acknowledged that removing works from the public domain (which the URAA does) is beyond Congress's copyright power.

Given the importance of the constitutional issues raised to both artists and the public, plaintiffs should be afforded the opportunity to conduct discovery and to develop a complete factual record. That is particularly so because in Eldred the government has attempted to use the lack of an evidentiary record to foreclose Supreme Court review of the CTEA. There, the government argued that the case would be "particularly inappropriate" for Supreme Court review "[b]ecause the case was decided on cross-motions for judgment on the pleadings, [and] the parties have not developed an extensive record regarding the extent to which extending copyrights might reasonably be thought to promote progress in the useful arts." Gov't Eldred Brief in Opp. to Pet. for Cert. 19 n.4. Here, however, the government asks this Court to deny plaintiffs of their ability to develop a record. The government's "whipsaw" tactic should be rejected.

Discovery and an evidentiary hearing will allow the plaintiffs to illuminate for this Court: (1) the full extent of the harms suffered by plaintiffs, other artists, and the public because of the CTEA and URAA; (2) historical data related to the Copyright Clause and early copyright laws that bear on the challenges to the CTEA and URAA; (3) the number of works that have been affected by the CTEA and URAA; and (4) how the creative process and artistic endeavors suffer because of these laws.

For example, plaintiffs anticipate presenting testimony from Edward Walterscheid to refute the government's historical claims about the Copyright Act of 1790. The government purports to rely on Walterscheid's article for its historical argument (Gov't Mem. 8). But

plaintiffs intend to show that Walterscheid himself, a leading historian on the Copyright Clause, believes that the government's "history" is wholly inaccurate.

Finally, because the government has injected several arguments based on foreign law (such as the law of the EU and the Berne Convention), plaintiffs request the opportunity to present testimony and other evidence to assist this Court's inquiry. See FED. R. CIV. P. 44.1 ("[t]he court, in determining foreign law, may consider any relevant material or source, including testimony"); Access Telecom, Inc. v. MCI Telecomm. Corp., 197 F.3d 694, 713 (5th Cir. 1999) ("expert testimony accompanied by extracts from foreign legal material is the basic method by which foreign law is determined."). At trial, plaintiffs intend to present evidence to rebut the government's many unsupported assertions, which posit international harmonization, greater income streams for American authors, and safeguards for authors' investments (Gov't Mem. 13, 29) as justifications for the CTEA or URAA. These justifications, we submit, will not be able to withstand scrutiny.

CONCLUSION

For the foregoing reasons, the government's motion to dismiss should be denied, and plaintiffs afforded the opportunity to proceed to discovery and develop a factual record in support of their claims. Plaintiffs respectfully request a hearing on this motion.

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Hugh Q. Gottschalk
Carolyn J. Fairless
WHEELER TRIGG & KENNEDY, P.C.
1801 California Street, Suite 3600

Denver, CO 80202
DC Box 19
Telephone: (303) 292-2525
Facsimile: (303) 294-1879

Attorneys for Plaintiffs