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GOLAN V. GONZALEZ: THE STALEMATE BETWEEN THE FIRST AMENDMENT AND COPYRIGHT CONTINUES

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In the wake of a long history of copyright decisions that have been sparse in terms of First Amendment analysis, the Tenth Circuit in Golan v. Gonzales *clearly addresses the First Amendment. This Recent Development analyzes the decision in* Golan *and argues that while the First Amendment concerns were properly recognized, the ultimate resolution of the Tenth Circuit was incorrect. The remand to the district court solely on the issue of whether the Uruguay Round Agreements Act is a content-based or content-neutral restriction of free speech leaves the district court with too narrow of a test for the First Amendment issue in* Golan. *This Recent Development presents an alternative solution to the issue presented in* Golan *and discusses the relevant factors to be considered upon remand to the district court.*

I. INTRODUCTION

Project Gutenberg[2] is an online repository of books currently containing over 100,000 books that can be downloaded at no charge.[3] Since books on Project Gutenberg are in an electronic format ("eBooks"), dozens of classics such as *Pride and Prejudice* by Jane Austen, *The Raven* by Edgar Allen Poe, and *The Adventures of Sherlock Holmes* by Sir Arthur Conan Doyle can be easily downloaded.[4] Though it might seem silly to provide books

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[2] Project Gutenberg, http://www.gutenberg.org (last visited Feb. 8, 2008) (on file with the North Carolina Journal of Law & Technology).

[3] *See id.*

[4] *See id.*

in an electronic format, considering that reading a book on a computer screen is hardly as comfortable as curling up on a couch, improved technologies, such as personal digital assistants ("PDAs"), have created the ability to read them anywhere, just like a paperback book.

Project Gutenberg succeeds partly because many of the works are part of the public domain and, therefore, have no copyright restrictions.[5] Often, copyrights can strictly limit the way a work can be used, such as preventing the user from downloading the work onto a PDA or other device for reading. For example, Adobe eBook Reader, a computer program that can display eBooks, stores the user's library of eBooks on his or her computer.[6] While Adobe eBook Reader currently does not have the functionality to move eBooks onto a PDA,[7] once the functionality is added, the program and the licensing scheme could work together to strictly limit the use of the eBooks stored in the program, possibly preventing transfers of eBooks to a PDA.[8] This limitation does not exist with eBooks obtained from Project Gutenberg.

Another benefit of Project Gutenberg is its cost. Downloading and reading eBooks from Project Gutenberg is completely free. Curious readers can explore books from an author or genre that they may not have read had they been forced to pay. In contrast to situations where cost may be prohibitive, Project Gutenberg's selection of free books allows readers to be adventurous and read books they know nothing about, perhaps based on little more than a whim. Further, free and equal access to knowledge contained in

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[5] Gutenberg: No Cost or Freedom?, http://www.gutenberg.org/wiki/Gutenberg:No_Cost_or_Freedom%3F (last visited Feb. 8, 2008) (on file with the North Carolina Journal of Law & Technology).

[6] LAWRENCE LESSIG, FREE CULTURE 151 (Penguin Books 2005) (2004). Now, Adobe makes and distributes an eBook reader program called Adobe Digital Editions. *See* Adobe Digital Editions, http://www.adobe.com/products/digitaleditions (last visited Feb. 27, 2008) (on file with the North Carolina Journal of Law & Technology).

[7] Adobe Digital Editions: FAQ, http://www.adobe.com/products/digitaleditions/faq (last visited Feb. 27, 2008) (on file with the North Carolina Journal of Law & Technology).

[8] *See* LESSIG, *supra* note 6, at 151.

eBooks can empower individuals who simply cannot afford to purchase books.

Other similar projects that make extensive use of works in the public domain have met mixed success. LibriVox, for example, is a successful online effort to create audio versions of all the books in the public domain.[9] The International Music Score Library Project ("IMSLP") attempted to collect musical scores of works in the public domain until it was stopped under threat of a lawsuit.[10] Created by a Canadian student, known as Feldmahler, in his spare time, IMSLP was the largest collection of public domain musical scores in the world.[11] A problem, however, arose with IMSLP due to the difference in copyright term lengths in different countries. In particular, Austria's copyright terms are twenty years longer than Canada's; therefore, some of the works which had become part of the public domain in Canada were still protected under Austrian copyright.[12] As the musical scores were made available over the Internet to worldwide users, IMSLP arguably violated the rights of the Austrian copyright owners.[13] Universal Edition of Austria, owners of some of the relevant copyrights, sent Feldmahler a cease and desist letter that led to his decision to remove the works from his website. He lamented the end to this project, stating:

> On Saturday October 13, 2007, I received a second Cease and Desist letter from Universal Edition . . . . [A]fter lengthy discussions with very knowledgeable lawyers and supporters, I became painfully aware of the fact that I, a normal college student, has [sic] neither the energy nor the money necessary to deal with this issue in any other way than to agree with the cease and desist, and take down the entire site. I cannot

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[9] LibriVox, http://librivox.org/ (last visited Feb. 8, 2008) (on file with the North Carolina Journal of Law & Technology).

[10] IMSLP, http://www.imslp.org/ (last visited Feb. 8, 2008) (on file with the North Carolina Journal of Law & Technology).

[11] *See* Michael Geist, *Music Copyright in the Spotlight*, BBC NEWS, Nov. 2, 2007, http://news.bbc.co.uk/2/hi/technology/7074786.stm (on file with the North Carolina Journal of Law & Technology).

[12] IMSLP, *supra* note 10.

[13] *Id.*

> apologize enough to all IMSLP contributors, who have done so much for IMSLP in the last two years.[14]

In a fraction of the time that it took to build the collection, the threat of a lawsuit shut down one of the greatest repositories of musical works available in the world.

Lawrence Golan, a teacher and performer of foreign musical works,[15] also ran afoul of the copyright laws in a similar situation. Some of the more recognizable composers among the musical works that Golan performs include Sergei Prokofiev, Dmitri Shostakovich, and Igor Stravinsky.[16] Golan relied upon, and believed, that the works should be in the public domain, and he was partly correct.[17] In the United States, they would have been in the public domain.[18] However, because Congress passed section 514 of the Uruguay Round Agreements Act[19] ("URAA"), the

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[14] Feldmahler, *Open Letter*, IMSLP, Dec. 23, 2007, http://imslp.on-wiki.net/Open_letter (on file with the North Carolina Journal of Law & Technology).

[15] Golan v. Gonzales, 501 F.3d 1179, 1182 (10th Cir. 2007).

[16] *Id.*

[17] *Id.*

[18] *Id.*

[19] Pub. L. No. 103-465, 108 Stat. 4809, 4976–80 (1994) (codified at 17 U.S.C. §§ 104A, 109 (2000)). Section 104A provides:

> (a) Automatic protection and term.—
> (1) Term.—
> (A) Copyright subsists, in accordance with this section, in restored works, and vests automatically on the date of restoration. . . .
> (h) Definitions.—For purposes of this section and section 109(a): . . .
> (6) The term "restored work" means an original work of authorship that—
> (A) is protected under subsection (a);
> (B) is not in the public domain in its source country through expiration of term of protection;
> (C) is in the public domain in the United States due to—
> (i) noncompliance with formalities imposed at any time by United States copyright law, including failure of renewal, lack of proper notice, or failure to comply with any manufacturing requirements;
> (ii) lack of subject matter protection in the case of sound recordings fixed before February 15, 1972; or
> (iii) lack of national eligibility;

works were figuratively lifted out of the public domain and had their copyrights in the United States restored. For Golan and others similarly situated, the restoration of the copyrights meant that certain works could not be performed without paying a licensing fee. Often, the fee was high enough to be prohibitive of their musical expression.[20]

The Tenth Circuit Court of Appeals heard the case resulting from Golan's story.[21] The court recognized a conflict between the copyrights in question and Golan's right to free speech.[22] Though not always obvious, "[c]opyright law restricts speech."[23] It can control creative expression and does so regularly—"[i]t restricts what writers may write, what painters may paint, what musicians may compose."[24] Therefore, anytime copyright law is used to prevent someone from expressing himself or herself in a particular way, that person should ask whether his or her constitutional right to freedom of speech has been inappropriately restrained.

The court decided that there was a valid free speech issue and remanded the case to the district court to decide whether the restraint on free speech, in this case the URAA, was a content-based restriction or a content-neutral restriction in order to determine the appropriate level of scrutiny.[25] This Recent Development discusses the soundness of the court's decision to remand the case in *Golan v. Gonzales*, and argues that the standard provided for the lower court to resolve the issue was not the appropriate standard. Part II of this Recent Development provides

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> (D) has at least one author or rightholder who was, at the time the work was created, a national or domiciliary of an eligible country, and if published, was first published in an eligible country and not published in the United States during the 30-day period following publication in such eligible country[.]

[20] *Golan*, 501 F.3d at 1183.

[21] *Id.* at 1182.

[22] *Id.* at 1196 (remanding the case to the district court to analyze the First Amendment concerns).

[23] Eugene Volokh & Brett McDonnell, *Freedom of Speech and Independent Judgment Review in Copyright Cases*, 107 YALE L.J. 2431, 2431 (1998).

[24] *Id.*

[25] *Golan*, 501 F.3d at 1196.

an overview of the relevant cases leading up to *Golan*. Part III discusses the positive aspects of the *Golan* decision. Part IV critiques the resolution of the issue by the *Golan* court and proposes a different method to resolve the matter. Finally, Part V highlights some concerns that may surface upon remand.

II. BACKGROUND

A. *Genesis of Copyright*

Copyright law has been around for hundreds of years.[26] Long before copyright law developed, however, the public domain has existed. If a work is in the public domain, anyone may freely use the work in any way without asking permission.[27] Typically, what causes a work protected by copyright to move into the public domain is a passage of time sufficient for the copyright term to expire.[28] Under the current United States copyright scheme, copyrights usually expire seventy years after the author's death.[29] While the switch from a work that is copyrighted to one in the public domain should be painless, it is often met with resistance. For example, when the public domain was first *officially* created after 1774 in England, the copyright owners and the public disagreed as to whether the creation of the public domain was appropriate.[30] The public favored the public domain because "[f]or the first time in Anglo-American History, the legal control over creative works expired, and the greatest works in English history—including those of Shakespeare, Bacon, Milton, Johnson, and Bunyan—were free of legal restraint."[31] On the other hand, the content owners opposed the creation of the public domain because it wiped out the value of their previously copyrighted content.[32] A recount of the event stated, "By the above decision . . . near

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[26] The first formal copyright statute was the Statute of Anne, which was established in 1710. *See* LESSIG, *supra* note 6, at 86.

[27] *Golan*, 501 F.3d at 1189–90.

[28] *See* 17 U.S.C. § 302(a) (2000).

[29] *Id.*

[30] *See* LESSIG, *supra* note 6, at 92.

[31] *See id.* at 93.

[32] *See id.*

200,000 pounds worth of what was honestly purchased at public sale, and which was yesterday thought property is now reduced to nothing."[33] Despite the protests of copyright holders regarding limited copyright terms and the entrance of works into the public domain, the copyright system that has evolved protects creative expression for "limited Times" and upon expiration of the copyright, moves the work into the public domain.[34]

B. *Eldred*

In 2003, *Eldred v. Ashcroft*[35] asked whether Congress had the power to extend the term of copyrights under the Copyright Term Extension Act ("CTEA") for an additional twenty years.[36] In addition to extending the term for newly created works, the CTEA retroactively extended the term for works that had already received copyright protection.[37] The authority arguably came from the Constitution's Progress Clause which states, "Congress shall have Power . . . [t]o promote the Progress of Science . . . by securing [to Authors] for limited Times . . . the exclusive Right to their . . . Writings . . . ."[38] At issue in the case was the phrase "limited Times," which Eldred argued was not being obeyed by Congress's multiple extensions of copyright terms.[39] The Supreme Court reasoned that, technically, even a copyright term for the life of the author plus seventy years is still "limited," even when retroactively applied, and thus Congress had acted within its power in promulgating the CTEA.[40]

More relevant to this discussion, the *Eldred* Court also had to grapple with the question of whether an extension of the copyright term inappropriately abridged the First Amendment's guarantee of free speech.[41] Since any expressive work is considered speech,

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[33] *See id.*
[34] U.S. CONST. art. I, § 8, cl. 8.
[35] 537 U.S. 186 (2003).
[36] *See id.* at 204.
[37] *See id.*
[38] U.S. CONST. art. I, § 8, cl. 8.
[39] *See* LESSIG, *supra* note 6, at 218.
[40] *Eldred*, 537 U.S. at 204.
[41] *See id.* at 218–19.

anything that limits the expressive work, even when copying someone else's work, is a regulation of speech.[42] The Court addressed this question in two ways. First, the Court acknowledged that First Amendment rights of free speech are protected through the copyright law's built-in protections of the idea-expression dichotomy[43] and fair use.[44] Second, in what some consider the "key holding,"[45] the Court stated that "when ... Congress has not altered the *traditional contours* of copyright protection, further First Amendment scrutiny is unnecessary."[46] The logical inference of this statement is that if Congress does alter the "traditional contours of copyright protection,"[47] then further First Amendment scrutiny is necessary. In other words, the built-in protections of copyright law may not be enough to preserve an individual's First Amendment rights in certain situations that alter

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[42] Volokh & McDonnell, *supra* note 23, at 2431.

[43] The idea-expression dichotomy means that copyright law protects the actual expression, but not the underlying ideas. *See* Harper & Row Publ'rs v. Nation Enters., 471 U.S. 539, 556 (1985). For example, a painter may paint a picture that depicts flowers. The actual expression, the painting, would be protected under copyright law, whereas the underlying idea, the flowers, would not be protected. *See id.* This principle would allow others to freely paint pictures of flowers without infringing the first individual's copyrights.

[44] *See* 17 U.S.C. § 107 (2000).

[45] Jack Balkin, *Is the Digital Millennium Copyright Act Unconstitutional Under* Eldred v. Ashcroft*?*, BALKINIZATION, Jan. 17, 2003, http://balkin.blogspot.com/2003/01/is-digital-millennium-copyright-act.html (on file with the North Carolina Journal of Law & Technology).

[46] *Eldred*, 537 U.S. at 221 (emphasis added); *see also* Jennifer Garick, *Free Speech Sometimes Trumps Copyright*, WIRED, Sept. 11, 2007, http://www.wired.com/politics/onlinerights/commentary/circuitcourt/2007/09/circuitcourt_0911 (on file with the North Carolina Journal of Law & Technology). Garick comments on *Kahle v. Gonzalez*, 487 F.3d 697 (9th Cir. 2007), which asks whether the shift from an "opt-in" to an "opt-out" system of copyright is a change in the traditional contours of copyright protection:

> In *Kahle*, the issue is Congress' change from a self-selecting system of copyright, where people had to register and give notice to indicate that they wanted copyright protection .... This change from an opt-in to an opt-out system has produced generations of "orphan works"—creative works that are still under copyright, but for which owners are absent or prohibitively expensive to find.

Id.

[47] *Eldred*, 537 U.S. at 221.

copyright's "traditional contours."[48] What exactly does the phrase "traditional contours" mean? *Golan v. Gonzalez* presses this question.

C. *Golan*

With the "key holding"[49] of *Eldred* in place, *Golan* explored the meaning of the Supreme Court's phrase, "traditional contours of copyright protection."[50] Lawrence Golan, a performer of foreign works in the public domain, was unable to legally express the same musical pieces that he once could.[51] Other plaintiffs in *Golan* used works in the United States public domain to create derivative works.[52] The URAA, however, resulted in the restoration of the copyrights of some of the works that Golan and the other plaintiffs used to make a living. For Golan, it meant that his expression was barred. For the other plaintiffs, it meant their new derivative works were no longer protectable since they made unlawful use of copyrighted works.[53] Golan and the other plaintiffs challenged § 104A of the Copyright Act, which enacted section 514 of the URAA,[54] on grounds that the URAA altered a "traditional contour[]" and therefore conflicted with the First Amendment.[55]

Essentially, the URAA states that some works in the United States which may have fallen into the public domain can have their copyright status restored so long as several conditions are met:

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[48] *Id.*

[49] Balkin, *supra* note 45.

[50] Golan v. Gonzalez, 501 F.3d 1179, 1185–86 (10th Cir. 2007).

[51] *See id.* at 1182.

[52] *See id.* at 1193. A derivative work is defined as:

> A . . . work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work."

17 U.S.C. § 101 (2000).

[53] *See* 17 U.S.C. § 103.

[54] *See id.* § 104A.

[55] *Golan*, 501 F.3d at 1185–86.

(1) the work must be of foreign origin,[56] (2) the work must be "in the public domain in the United States,"[57] (3) the work must still be protected under copyright law of the country that the work originated from,[58] and (4) the reason the work is in the public domain of the United States must be "due to . . . noncompliance with formalities" that United States copyright law required to invoke copyright protection.[59] If these conditions are met, then the work is lifted out of the public domain and has its copyright status restored in the United States.[60] As a result, the work, which could previously be used by the public without restriction, once again has full copyright protection.

The district court in *Golan* decided "that Congress acted within its authority" when enacting the URAA.[61] Particularly persuasive for the lower court was the notion that Golan and the other plaintiffs were "free to contract with copyright holders for permission to disseminate the works."[62] This reasoning was sufficient for the district court to find against the plaintiffs.[63]

When Golan and the other plaintiffs appealed the decision, the Tenth Circuit Court of Appeals saw the case differently. The Tenth Circuit sought to address the question of what constitutes "traditional contours of copyright protection."[64] The court reasoned that "one of these traditional contours is the principle that once a work enters the public domain, no individual—not even the creator—may copyright it."[65] The Tenth Circuit neither upheld the URAA, nor struck it down. Instead, the Tenth Circuit remanded the case to the district court and ordered that the district court determine whether § 104A is an appropriate regulation of free

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[56] *See* § 104A(h)(6)(B)–(C).
[57] *Id.* § 104A(h)(6)(C).
[58] *Id.* § 104A(h)(6)(B).
[59] *Id.* § 104A(h)(6)(C)(i).
[60] *See id.* § 104A(h)(6).
[61] Golan v. Gonzalez, No. 01-B-1854, 2005 U.S. Dist. LEXIS 6800, at *43 (D. Colo. Apr. 19, 2005).
[62] *Id.* at *48.
[63] *See* Golan v. Gonzales, 501 F.3d 1179, 1182 (10th Cir. 2007).
[64] *Id.* at 1183.
[65] *Id.* at 1184.

speech.[66] The district court will base its decision upon whether the regulation of free speech is content-based[67] or content-neutral.[68] Previous case law teaches that "[c]ontent-based restrictions on speech are those which 'suppress, disadvantage, or impose differential burdens upon speech because of its content.' "[69] By deduction, regulation that is not content-based is content-neutral since it "only incidentally burden[s] speech."[70] The classification of content-based or content-neutral then dictates the applicable level of scrutiny.[71]

In previous Supreme Court decisions such as *Eldred*, the Court has rejected the argument that additional First Amendment review of laws affecting free speech is necessary beyond the traditional copyright safeguards of fair use and the idea-expression dichotomy.[72] *Golan*, on the other hand, stands for the proposition that the traditional copyright law safeguards of First Amendment values are inadequate when works are removed from the public domain.[73]

III. A PERFECT 10[TH CIRCUIT]

In *Golan*, the Tenth Circuit handed down a well-reasoned analysis of the URAA and its relationship to "traditional contours" of copyright law.[74] The Tenth Circuit realized that the Supreme Court left open the question of whether legislation that alters the

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[66] *Id.* at 1196.

[67] *See* Grace United Methodist Church v. City of Cheyenne, 451 F.3d 643, 657 (10th Cir. 2006) ("Content-based restrictions on speech, those which suppress, disadvantage, or impose differential burdens upon speech because of its content are subject to the most exacting scrutiny." (quoting Z.J. Gifts D-2, L.L.C. v. City of Aurora, 136 F.3d 683, 686 (10th Cir. 1998))).

[68] *See Grace United Methodist Church*, 451 F.3d at 657 ("[C]ontent neutral regulations that only incidentally burden speech are subject to intermediate scrutiny.").

[69] *Golan*, 501 F.3d at 1196 (quoting *Grace United Methodist Church*, 451 F.3d at 657).

[70] *Grace United Methodist Church*, 451 F.3d at 657.

[71] *See id.*

[72] Eldred v. Ashcroft, 537 U.S. 186, 219 (2003).

[73] *Golan*, 501 F.3d at 1188.

[74] *Id.* at 1187.

"traditional contours of copyright protection" is subject to additional First Amendment scrutiny.[75] Recognizing the need to determine the plain meaning of a "traditional contour[]" of copyright law,[76] the court saw the historical treatment of copyrights by Congress as relevant to the inquiry.[77] By allowing the removal of works from the public domain, the court decided that the URAA does change a traditional contour.[78] In other words, the Tenth Circuit used the history of copyright law as a standard of expectation. Traditionally, the expectation was that once a work enters into the public domain it stays there.[79] Thus, the court concluded that the URAA changed that standard of expectation.

Particularly relevant to the discussion is the natural progression of the life of a copyright, which determines part of the "traditional contours."[80] The basic lifecycle of a copyright involves the "progress[ion] from 1) creation; 2) to copyright; 3) to the public domain."[81] In the context of the URAA, "the copyright sequence no longer necessarily ends with the public domain: indeed, it may begin there."[82] Since the URAA offers copyright protection to "works in the public domain, the URAA has altered the ordinary copyright sequence."[83]

It should be clear that the alteration of the copyright sequence is indeed a significant departure from the traditional standard of expectation of copyright law for two reasons: (1) society relies on the natural progression of copyright law, and (2) alterations to the natural progression affect the all-important public domain.[84]

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[75] *Id.* at 1188.
[76] *Id.* at 1189.
[77] *Id.*
[78] *Id.* at 1192.
[79] *Id.* at 1187.
[80] *Id.* at 1189.
[81] *Id.*
[82] *Id.*
[83] *Id.*
[84] *See* Eldred v. Ashcroft, 537 U.S. 186, 224–25 (2003) (Stevens, J., dissenting).

With regard to society's reliance on this natural progression of copyrights,[85] § 104A would cause the copyright lifecycle to potentially involve an additional stage: creation to copyright to public domain, followed once again by copyright protection. One of the safe assumptions, or "bedrock principle[s]" of intellectual property is the notion "that works in the public domain remain in the public domain."[86] Since the beginning of copyright law in the United States, entrance into the public domain has been a bright line for when copyright protection ends.[87] The role of the public domain transcends copyright law as other areas of intellectual property also acknowledge its importance.[88] Regarding potential liability for infringement, the public domain is a safe harbor. One is not required to ask permission to make use of works in the public domain. The safe harbor of the public domain is the reason that theaters can perform Shakespeare's immortal *Romeo and Juliet*, Bach's legendary *Brandenburg Concertos*, or orchestras can perform Mozart's *Don Giovanni* without worrying whether such an act infringes the copyrights of others. For the same reason, websites like Project Gutenberg[89] should be able to thrive and be certain that their efforts will not be in vain, as far as copyright infringement is concerned. Unquestionably, the URAA changes this certainty, and the Tenth Circuit is correct in recognizing that the change alters the "traditional contours" of copyright law.

Furthermore, the change caused by the URAA legislation is significant not only because it shifts the public's expectation regarding a traditional certainty, but the change also arguably

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[85] *Id.*

[86] *Golan*, 501 F.3d at 1192.

[87] *Id.* at 1194 n.4 ("[T]he public domain likely presented a 'bright line' because once '[s]omething . . . has already gone into the public domain [] other individuals or companies or entities may then have acquired an interest in, or rights to be involved in disseminating [the work.]'" (second and subsequent alterations in original) (citation omitted)).

[88] *See* Graham et al. v. John Deere, 383 U.S. 1, 5–6 (1966) ("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.").

[89] *See* Project Gutenberg, *supra* note 2.

targets an integral part of copyright law: the public domain.[90] The Tenth Circuit recognized that a key interested party is the public.[91] It noted, "The immediate effect of our copyright law is to secure a fair return for an 'author's' creative labor."[92] Further, "the *ultimate aim* is, by this incentive, to stimulate artistic creativity *for the general public good*."[93] At the passage of the Copyright Act of 1909, Congress noted "that copyright was not designed 'primarily' to 'benefit' the 'author' or 'any particular class of citizens, however worthy' . . . . Rather, under the Constitution, copyright was designed 'primarily for the benefit of the public[.]' "[94] The URAA, with the ability to lift works out of the public domain, creates a rift in a standard to which the public has grown accustomed, and then damages the public by denying the free use of works formerly in the public domain.

Finally, the Tenth Circuit appropriately disregards the district court's reasoning that plaintiffs can contract around the URAA as a valid protection of free speech. The Tenth Circuit was correct since the district court's reasoning belittles or even ignores the First Amendment concerns altogether. Golan could obtain the rights to perform the works he wanted by a licensing agreement, but this rationale ignores that a valid protection of First Amendment rights would not require a party to ask permission at all. Asking permission to say what an individual has the constitutional right to say would be, contrary to the district court's opinion, "too onerous a constraint upon their free expression of ideas."[95]

While the Tenth Circuit correctly acknowledged the change in the "traditional contours of copyright protection," it seems

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[90] *Eldred,* 537 U.S. at 224–25 (Stevens, J., dissenting).

[91] *Golan*, 501 F.3d at 1188.

[92] *Id.* (quoting Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975)).

[93] *Id.* (emphasis added).

[94] *Eldred*, 537 U.S. at 247 (Breyer, J., dissenting).

[95] Golan v. Gonzalez, No. 01-B-1854, 2005 U.S. Dist. LEXIS 6800, at *48 (D. Colo. Apr. 19, 2005).

uncertain as to what the next step should entail.[96] Instead of deciding the constitutionality of the URAA, the Tenth Circuit remanded the case to the district court to decide whether the URAA is a content-based or content-neutral regulation of free speech.[97]

IV. THE COPYRIGHT DECISION

A. *First Amendment vs. Copyright*

On remand, if the district court determines the URAA to be a content-based regulation of free speech, then strict scrutiny applies.[98] Under strict scrutiny, the URAA must be narrowly tailored to the ends it proposes to achieve.[99] However, if the URAA is found to be content-neutral, then intermediate scrutiny applies.[100] Under intermediate scrutiny, a less exacting law than a narrowly tailored one would suffice.[101] One consequence of the Tenth Circuit decision is that the remand limits the district court only to the narrow question of whether the regulation is content-based or content-neutral.[102] The order by the Tenth Circuit is deficient because it only provides the option of choosing between "content-based" and "content-neutral" classification when, in the face of the First Amendment, copyright law demands a more

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[96] Orin Kerr, Golan v. Gonzales *and First Amendment Limits on Copyright Law*, VOLOKH CONSPIRACY, Sept. 6, 2007, http://volokh.com/archives/archive_2007_09_02-2007_09_08.shtml#1189051800 (on file with the North Carolina Journal of Law & Technology) ("The Tenth Circuit concluded that the Act did in fact alter those traditional contours by taking material that had been in the public domain and then subjecting them to copyright. But the panel wasn't really sure what to do next; they remanded to the district court to figure out how to 'subject' the law to 'further' First Amendment scrutiny.").

[97] *Golan*, 501 F.3d at 1196.

[98] *Id.*

[99] *See* Grace United Methodist Church v. City of Cheyenne, 451 F.3d 643, 657 (10th Cir. 2006).

[100] *Id.*

[101] *Id.*

[102] *Golan*, 501 F.3d at 1196.

complex analysis than a simple two-tiered test based on whether the URAA targets specific content.[103]

It is undeniable that a tension exists between the First Amendment and copyright law: "Copyright law restricts speech .... If your speech copies ours, and if the copying uses our 'expression,' ... the speech can be enjoined and punished, civilly and sometimes criminally."[104] The right of one person to control his or her own creative expression will directly overlap another's right to "speak" that same expression. In *Golan*, the Tenth Circuit determined that the URAA requires First Amendment scrutiny beyond the typical analysis of fair use and the idea-expression dichotomy.[105] The court realized that in reality, there are situations where fair use and the idea-expression dichotomy are insufficient to protect all of the instances where free speech and copyright may intersect. For example, "[d]uring the first year anniversary of the 9-11 attacks, people [publicly] read aloud the Gettysburg Address ... and they did so because they believed that it was the best way to convey what they felt at the time."[106] These people, much like Golan, believed that, "[s]ometimes the best way to express your point is through using the words of others, or ... expanding on the words of others."[107] Arguably, one powerful way to teach foreign musical works involves access to performances of these works. Another poignant instance where copyright protections overlapped with free speech involved the film clip capturing the assassination of former President John F. Kennedy: "It is hard to imagine a

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[103] *See* Jack Balkin, Golan v. Gonzales—*How the First Amendment Limits Copyright Law*, BALKINIZATION, Sept. 5, 2007, http://balkin.blogspot.com/2007/09/golan-v-gonzales-how-first-amendment.html (on file with the North Carolina Journal of Law & Technology) ("Copyright law does not fit into tiers of scrutiny analysis. It is more like libel law which is clearly content based but has never been thought to be subject to scrutiny analysis.").

[104] Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 165–66 (1998).

[105] *Golan*, 501 F.3d at 1184.

[106] Jack Balkin, *Mickey in Chains, Part II, or Why the Court Got It Wrong in* Eldred v. Ashcroft, BALKINIZATION, Jan. 15, 2003, http://balkin.blogspot.com/2003/01/mickey-in-chains-part-ii-or-why-court.html (on file with the North Carolina Journal of Law & Technology).

[107] *Id.*

more compelling case for requiring free access to a copyrighted work."[108] With the nation's President assassinated, "[t]o have a meaningful public debate, it seemed crucial to test and illustrate opposing theories against the actual visual record of the events."[109] The United States bubbled with speculation as to what exactly happened to its President, and "bare ideas and facts" would not be enough to test those theories.[110] The public needed direct access to the raw facts, but the only source of facts available, a movie clip, was copyrighted material.

B. *The Appropriate Test*

While the Tenth Circuit recognized that there are instances where the built-in protections of copyright law are insufficient, the court was too narrow in its thinking as to what sort of scrutiny should by applied when First Amendment rights must be considered.[111] Of course the content-based and content-neutral distinction is one way of scrutinizing regulations of speech, but the Tenth Circuit was arguably incorrect in stating that the URAA must fit into one of these two categories. The appropriate treatment of copyright law requires more than the simple content-based or content-neutral test outlined by the Tenth Circuit.[112]

Whether a law is content-based or content-neutral is a nuanced inquiry because of the danger that the term "content-based" may be confused with the idea of being solely "viewpoint-based."[113] To determine whether a law is content-based, the court must ask whether it is either viewpoint-based or subject-matter-based.[114] If it is either of these, the law will be considered content-based.[115] For example, if a law were passed that specifically restricted all

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[108] Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CAL. L. REV. 283, 300–01 (1979).

[109] *Id.*

[110] *Id.* Fair use actually justified access to the frames, but the First Amendment could have been used as well. *See id.*

[111] *See* Balkin, *supra* note 103.

[112] *Id.*

[113] *See* Lemley & Volokh, *supra* note 104, at 186.

[114] *See* ERWIN CHEMERINSKY, CONSTITUTIONAL LAW PRINCIPLES AND POLICIES 934 (2d ed. 2002).

[115] *Id.* at 934–35.

copyrighted material that contained references to enemy countries of the United States, then this law would be considered content-based because it regulates based on a particular viewpoint—a bias against enemy countries. This law would likely be considered subject-matter-based as well, but being viewpoint-based is sufficient for the law to be considered content-based.[116] As a result, strict scrutiny will apply.

Most, if not all, laws affecting copyrights will not be considered viewpoint-based as long as no bias exists.[117] However, the inquiry cannot stop with this determination. The courts must also decide whether a law like the URAA is subject-matter-based and therefore content-based. This distinction is crucial to prevent applying de facto intermediate scrutiny to all copyright law that is subject to First Amendment analysis and being overly permissive of unconstitutional restrictions on free speech.

The further question here is not only whether the law is content-based or content-neutral, but whether a simple two-prong classification is even appropriate. It is not: "Because virtually all human interaction takes place through speech, the First Amendment cannot offer all speech the same degree of protection. Rather, judges must apply different protective presumptions in different contexts[.]"[118] A more elaborate test than the two-pronged one chosen by the Tenth Circuit should be implemented because of the role of the public domain. In *Golan*, the public domain was the source of the speech that the plaintiff wanted to express.[119] The public domain served as a repository of creative expression. Few other contexts of free speech involve the public domain, a repository that legally belongs exclusively to the public. Arguably, the public domain represents both free speech and creativity. While the analysis of the URAA and its effect on free speech can be an independent inquiry, its potential effect on creativity is clear. For Golan, the inability to teach through performance means the quality of musical education could be

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[116] *See id.*
[117] *See id.*
[118] Garcetti v. Ceballos, 126 S. Ct. 1951, 1973 (2006) (Breyer, J., dissenting).
[119] *See* Golan v. Gonzales, 501 F.3d 1179, 1182 (10th Cir. 2007).

adversely affected. For the plaintiffs who created derivative works from restored foreign works, their creative contributions will no longer be protected since they made an unlawful use of the restored works—a use which was previously lawful.[120] This potential harm to creativity should be taken into account to determine the appropriate level of scrutiny.

C. *A New Test*

The following is a better solution for determining the appropriate level of scrutiny to be used. Using some of the fair use factors as a model,[121] a balancing test should be implemented to determine the scrutiny for examining copyright law subject to First Amendment concerns. The balancing test should weigh: (1) the purpose and character of the legislation, (2) the degree of deviation from the traditional contour, and (3) the reliance of the public on the affected speech. The purpose and character inquiry should examine whether the law was enacted to the obvious detriment of either copyright law or the First Amendment. Part of the purpose of the law should also be the furtherance of an established copyright policy. Regarding prong two, the greater the deviation, the more likely the law should be carefully scrutinized to ensure First Amendment rights are not impermissibly abridged. Finally, examining reliance by the public on the affected speech would reveal any damage inflicted upon the First Amendment's guarantee of free speech. If it is determined that the law's purpose is questionable, the degree of deviation from the traditional contour is great, and the public heavily relies on the speech in question, then strict scrutiny should apply. If fewer of these factors are an issue, a lower standard of scrutiny, such as intermediate or rational-basis, would be appropriate. A balancing test has the benefit of forcing the courts to keep the public domain in mind, primarily through prong three. Additionally, the fair use balancing test is a useful model because it represents a compromise. Fair use is a compromise between absolute copyright protection and allowing certain uses that have sound policy purposes, such as education or

[120] *See* 17 U.S.C. § 103 (2000).
[121] *See id.* § 107.

news reporting.[122] Similarly, the proposed test would be a compromise between absolute copyright control and absolute First Amendment protection. Compromise is necessary since it is certain that copyright and free speech may overlap. After all, when the Constitution demands that we "promote the Progress of Science," that progress is meant to be made with the public in mind.[123]

Under the proposed test, the URAA would likely be subject to strict scrutiny. The purpose and character of the law works to the obvious detriment of First Amendment interests. Simply because parts of the public domain have not yet been "spoken" does not mean it is unworthy of First Amendment protection. The degree of deviation from the traditional contours in this case is significant as it usurps the public's standard of expectation regarding the public domain. Lastly, the reliance of the public is clear since the plaintiffs in *Golan* rely on what they thought were public domain works to educate others and create derivative works. Because the three factors fall in favor of closer scrutiny, the URAA would be subject to strict scrutiny under the proposed test.

V. THE REMAND

Upon remand, the lower court could go either way on whether the URAA is content-based or content-neutral legislation. The Tenth Circuit supplied the test the district court must apply, stating "[c]ontent-based restrictions on speech are those which 'suppress, disadvantage, or impose differential burdens upon speech because of its content.' "[124] To determine whether the URAA is content-based, the lower court will also ask whether it is either viewpoint-based or subject-matter-based.[125] The URAA will likely not be held to be viewpoint-based because the URAA does not restore copyrights based on the substantive content of the public domain

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[122] *Id.*

[123] Eldred v. Ashcroft, 537 U.S. 186, 247 (2003) (Stevens, J., dissenting) (quoting U.S. CONST. art. I, § 8, cl. 8).

[124] *Golan*, 501 F.3d at 1196 (quoting Grace United Methodist Church v. City of Cheyenne, 451 F.3d 643, 657 (10th Cir. 2006)).

[125] *See* Perry Educ. Ass'n v. Perry Local Educators' Ass'n, 460 U.S. 37, 45 (1983).

material. However, it is uncertain whether the URAA could be considered subject-matter-based. It targets only public domain materials that have fallen into the public domain because the works failed to meet particular copyright formalities. Thus, the works are selected on the basis of a technicality as opposed to the subject matter of the works. On the other hand, the URAA targets solely public domain works of foreign origin, which is arguably a form of selection based on the copyrighted material's subject matter. If the URAA is held to be based on subject matter, then it will be considered content-based and will have to pass strict scrutiny to be upheld.[126] Conversely, if deemed content-neutral, intermediate scrutiny will apply.[127] The URAA should fail strict scrutiny as it is over-inclusive in its reach by restoring copyrights in works that have little or no commercial value and works where the author may not truly care to restore the copyright of the work.[128] However, even if the URAA would fail strict scrutiny analysis, it has a good chance of passing intermediate scrutiny which is a less exacting standard.

Beyond the remand, the most worrisome aspect of the URAA's impact on the public domain is the prospect that the analysis regarding "traditional contours" is inconsequential for two reasons: (1) the "traditional contours" test itself may be doomed,[129] and (2) Congress's treaty power may be enough to uphold the law irrespective of First Amendment concerns.[130] First, some scholars have speculated that the "traditional contours" test expounded by the Tenth Circuit actually works against the public domain and will therefore eventually lead to more expansive copyright law and fewer protections of free speech.[131] It is even possible that the

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[126] *Grace United Methodist Church*, 451 F.3d at 657.

[127] *Id.*

[128] *See Eldred*, 537 U.S. at 248 (Breyer, J., dissenting).

[129] Balkin, *supra* note 103.

[130] Golan v. Gonzales, 501 F.3d 1179, 1196 n.5 (10th Cir. 2007).

[131] *See, e.g.*, Balkin, *supra* note 103. Balkin observes:

> The problem is that if we interpret the "traditional contours of copyright law" to require only that copyright laws basically resemble previous versions, only with longer terms and more constricted exemptions, the "traditional contours" test will not do much work. That is, if defenders of expansive copyright laws are able to show that

"traditional contours" test was never meant to have the sort of force and "broad meaning" that the Tenth Circuit believes.[132] Second, even if "traditional contours" have been altered by the URAA, the treaty power of Congress could be seen as a source of authority to allow the URAA to stand.[133] A policy recognized in the past to justify copyright legislation on several occasions involves "an American effort to conform to an important international treaty like the Berne Convention."[134] The same reasoning could be applied in this case since § 104A was also passed pursuant to the Berne Convention.[135]

VI. CONCLUSION

Despite the Supreme Court's expansive copyright decision in *Eldred*, the Tenth Circuit in *Golan* manages to use part of *Eldred* to give hope to those who advocate for a safe public domain where works remain forever for the benefit of future authors and creators to make use of those works.[136] In *Golan*, the Tenth Circuit made it clear that one of the "bedrock principle[s]" of copyright law is that works moving to the public domain are traveling with a one-way ticket with no hope of return.[137] The public can confidently use works in the public domain when a bright-line rule determines what works are part of the public domain, as opposed to a more complex scheme involving restoration of works from the public domain to copyrighted status once again.

When the Tenth Circuit remanded the case to the district court, it provided a narrow test that will require the district court to

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> new laws create differences only in degree rather than kind, and that they are part of a gradual historical progression of increased copyright protection, arguments from traditional contours may be more difficult to make.

Id.

[132] Kerr, *supra* note 96.

[133] *Golan*, 501 F.3d at 1196 n.5 ("Although not mentioned by the parties, Congress's treaty, commerce, and takings powers may provide Congress with the authority to enact § 514.").

[134] Eldred v. Ashcroft, 537 U.S. 186, 259 (2003) (Breyer, J., dissenting).

[135] *See Golan*, 501 F.3d at 1182.

[136] *See* Balkin, *supra* note 103.

[137] *Golan*, 501 F.3d at 1192.

categorize the URAA as either content-based or content-neutral. Given the unique qualities of copyright law, which involve the public domain, a more nuanced test should be applied. Copyright law should not be left with such a simple test for the purposes of determining the appropriate level of First Amendment scrutiny.

Be warned though—the Tenth Circuit left several questions open that may ultimately vitiate the First Amendment concerns in *Golan*.[138] In addition to the question of what level of scrutiny should apply, the Tenth Circuit hints that even in the face of exacting scrutiny, the treaty power of Congress may provide the district court with a way to avoid the conflict altogether.[139] But for now, long live the public domain.

[138] *Id.* at 1196.
[139] *Id.* at 1196 n.5.