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Recommended Citation

Dennis D. Crouch and Ted Wright, Copyright Versus the Public Domain: Does the Constitution Allow Congress to Take Works from the Public Domain and Replace Those with Private Exclusive Rights?, 39 *Preview of United States Supreme Court Cases* 46 (2011). Available at: <https://scholarship.law.missouri.edu/facpubs/775>

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Copyright Versus the Public Domain: Does the Constitution Allow Congress to Take Works from the Public Domain and Replace Those with Private Exclusive Rights?

CASE AT A GLANCE

This case arose out of U.S. treaty obligations to restore copyright to foreign authors who had failed to comply with the pre-1989 formalities in the law. Section 514 of the Uruguay Round Agreement Act (URAA) restores those copyrights and, in doing so, allowed thousands of widely disseminated works to be removed from the public domain. Petitioners challenge the law—arguing that the law overreaches constitutional authority and violates speech rights protected by the First Amendment.

Golan v. Holder
Docket No. 10-545

Argument Date: October 5, 2011
From: The Tenth Circuit

by Dennis Crouch and Ted Wright
University of Missouri School of Law, Columbia, MO

ISSUES

Does the Copyright Clause of the United States Constitution prohibit Congress from taking works out of the Public Domain?

In Section 514 of the Uruguay Round Agreement Act of 1994, Congress revived copyright protection for millions of works that had fallen into the public domain. Does Section 514 violate the First Amendment of the United States Constitution?

FACTS

Statutes and Treaties at Issue

The Berne Convention for the Protection of Literary and Artistic Works is an international treaty originally signed in 1886. However, it was not until 1989 that the United States joined the Convention. In the preceding years, Congress had taken several steps to substantially conform US law to the Berne Convention requirements. These steps included elimination of the requirement to register a copyright in order to receive protection (1976) and elimination of the requirement to place a copyright notice on published works (such as the © symbol) to avoid copyright forfeiture (1988).

As the final step in complying with the Berne Convention, the United States was required to revive the copyright of works by foreign authors that had entered the public domain due to failure to comply with formalities, such as registration or notice. That step was further required as part of the negotiated 1994 Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) that was agreed to by members of the World Trade Organization (WTO). TRIPS also allowed WTO members to challenge other member's implementation failures through the WTO dispute settlement procedure. In the Uruguay Round Agreement Act (URAA), Congress implemented the

requirements of the TRIPS agreement. In particular, § 514 of the URAA, at issue in this case, enacted the copyright restoration required by the Berne Convention.

Section 514 restored the copyright to numerous culturally and commercially important works that had been considered within public domain for decades. These works include Pablo Picasso's *Guernica*, Fritz Lang's film *Metropolis*, the works of Igor Stravinsky, Prokofiev's *Peter and the Wolf*, as well as works by C. S. Lewis, Virginia Woolf, H. G. Wells, Federico Fellini, Alfred Hitchcock, Jean Renoir, and M. C. Escher.

There are several caveats to the copyright restoration that somewhat soften its impact. No damages are available for unlicensed copies made while the work was in the public domain; a limited grace period was made available for individuals who had previously relied on the public domain works; and previously created derivative works can continue to be used upon payment of a compulsory licensing fee. In addition, fair use principles continue to apply as they do with all uses of copyrighted works in the United States.

Parties

"Petitioners are orchestra conductors, educators, performers, film archivists, and motion picture distributors who depend upon the public domain for their livelihood." (Petitioners merits brief, pg. 10.) In particular, Lawrence Golan is an educator at the University of Denver and professional orchestra conductor. Other parties include Richard Kapp, an orchestra conductor (since deceased), and Ron Hall and John McDonough, who distribute public domain films.

The respondent, the attorney general of the United States, was sued by the petitioners in his official capacity.

In addition to the parties, two dozen others filed nonparty briefs as friends of the court. These include Google, ACLU, and Creative Commons (all in support of the petitioners) and the ABA, MPAA, and the Intellectual Property Owners Association (all in support of respondent). None of the authors whose copyrights have been restored directly filed briefs in the case.

Case History

Petitioners filed this suit originally in 2001 in the federal district court for the District of Colorado. Petitioners claimed that § 514 exceeded the power of Congress under the Copyright Clause, and violated their First Amendment rights. The district court granted summary judgment for the government on both claims and dismissed the suit.

The petitioners appealed the decision of the district court. While the case was on appeal before the Tenth Circuit Court of Appeals, the Supreme Court decided another copyright case, *Eldred v. Ashcroft*, 537 U.S. 186 (2003). *Eldred* involved was a challenge to the Sonny Bono Copyright Term Extension Act (CTEA). The plaintiffs in that case claimed that the CTEA, which extended the copyright term an additional 20 years, violated the Copyright Clause and the First Amendment. The Supreme Court rejected those claims and held that First Amendment scrutiny of changes in the copyright law is unnecessary when “Congress has not altered the traditional contours of copyright protection.”

Following *Eldred*, the Tenth Circuit agreed with the district court that § 514 did not violate the Copyright Clause. However, the Tenth Circuit reversed and remanded the case with regard to the First Amendment. The court found that in light of *Eldred*, § 514 must be subjected to further First Amendment scrutiny because it altered the traditional contours of copyright protection by removing works from the public domain.

On remand, the district court reversed its prior holding and instead found that § 514 violated the First Amendment because it was not sufficiently narrowly tailored to achieve the government’s interest in enacting it, that being compliance with article 18 of the Berne Convention. The case was appealed again to the Tenth Circuit. The Tenth Circuit reversed the district court, finding that while § 514 is subject to First Amendment scrutiny, it passes that scrutiny as sufficiently narrowly tailored.

The petitioners appealed the Tenth Circuit’s decision to the Supreme Court, and the Supreme Court granted certiorari to determine whether § 514 violates either the Copyright Clause or the First Amendment.

CASE ANALYSIS

There are three competing legal interests that come to a head in this case: the value of strong copyright protection; the value of an open public domain; and the value of international cooperation and harmonization. The Constitution empowers Congress to create a copyright system based upon the notion that the promise of exclusive rights provides authors with a powerful incentive to create those works. The Constitution also guarantees the freedom of speech and freedom of the press, and these freedoms include the notion that ideas and works within the public domain are free for all to use. Finally, the Constitution recognizes the importance of cooperation amongst nations and gives power to Congress to ratify and implement international treaties.

Prior to § 514, the leading treatise on U.S. copyright law was clear: “neither the copyright clause nor the First Amendment would permit the granting of copyright to works which have theretofore entered the public domain.”

First Amendment Threshold Inquiry

A first hurdle for petitioners is based upon the Supreme Court’s analysis in *Eldred v. Ashcroft*. In that case, the Court recognized the conflict between copyright and free-speech law, but refused a complete First-Amendment analysis because the 20-year term extension at issue did not alter the traditional contours of copyright protection. Petitioners argue that the copyright restoration at issue here is different because it fundamentally alters the “integrity of the public domain.” The government responds by pointing to a number of prior instances Congress removed works from public domain. Petitioners argue the constitutionality of those limited prior instances “remains questionable.”

Passing the first hurdle opens the door for a full-fledged First Amendment challenge that would consider whether the copyright restoration passes a heightened level of scrutiny.

Important Government Interest

Petitioners argue that an intermediate level of scrutiny is appropriate in this case and that the court should query whether the challenged copyright restoration “furthers an important government interest in a way that is substantially related to that interest.” The government argues that “Section 514 furthers at least three important government interests.”

Taking these in turn, the government first argues that the copyright restoration ensures compliance with international obligations. Petitioners respond that compliance with an international treaty cannot justify violation of the U.S. Constitution and that there was no threat of the U.S. benefits being jeopardized. The government counters that the restoration requirement is now enforceable under the World Trade Organization’s “formal and binding dispute resolution proceedings, which can result in (among other things) the imposition of trade sanctions.”

The government’s second identified interest is in securing “greater protections for American authors abroad.” The basis for this argument is that U.S. compliance with the treaty in granting rights to foreign authors will lead other countries to grant rights to U.S. authors. Petitioners respond that this “potential” of securing rights abroad for private individuals should be given only little weight as compared with the actual and identifiable deprivation of vested interests in the public domain. “Congress was giving away vested public speech rights on the bare possibility that it might someday create private economic benefits for U.S. authors.”

The government’s third identified interest is in “correcting historical inequalities facing foreign authors.” Petitioners respond that “there is no inequity to correct, because U.S. authors were subject to the same formalities” as foreign authors. Further, petitioners argue, “the government cannot claim any legitimate interest in sacrificing the speech rights of the American public to benefit foreign authors”—especially by providing “windfalls to authors of existing works that entered the public domain long ago.”

However, the significant interest step is not the only burden for the government under a First Amendment analysis. If the government is successful in identifying a significant government interest for implementing § 514, the law may still be held to violate free speech rights if the law is not sufficiently tailored to satisfy that interest. Petitioners point to the fact that the copyright restoration goes beyond what was required by the international treaties and argue that it is not narrowly tailored to achieve the stated government interests. In particular, petitioners point to the fact that the Berne Convention permits: (1) negotiated exceptions to the restoration requirement; (2) permanent protection for individuals who have relied upon the works being in the public domain; and (3) shorter copyright terms for certain restored works.

Copyright Clause

As a separate justification for invalidity, petitioners argue that the copyright restoration invalidates the Constitution's Copyright Clause. Article I of the U.S. Constitution bestows Congress with the power to "promote the Progress of Science ... by securing for limited Times to Authors ... the exclusive Right to their respective Writings." Petitioners argue that both this text and its associated tradition of interpretation confirm a constitutionally protected public domain which is both "permanent and stable." In particular, the Constitution only allows the grant of copyright for "limited times"—a term that petitioners interpret as a "fixed and predictable period." In that light, the ability of Congress to, at its own discretion, remove works from the public domain means that the associated copyrights would not be so limited. Petitioners write, "[r]emoving works from the public domain violates the 'limited [t]imes' restriction by turning a fixed and predictable period into one that can be reset or resurrected at anytime, even after it expires." The government argues that a better interpretation of "limited times" is simply "confined within certain bounds" or "restrained." Focusing on the law being challenged, the government argues that the restoration is still for a limited time because the restored copyrights will expire on a date certain. This response parallels the government's successful defense of the copyright term extension at issue in *Eldred*.

SIGNIFICANCE

Cases involving the public domain may be more important than ever because the marketplace is ready to use, distribute, and repurpose available content at a level never before seen. As Google wrote in its amicus brief:

Uncertainty about the stability of public domain status is especially harmful today, because it undercuts ongoing efforts, spurred by new technology and the widespread public use of the internet, to make creative and productive use of public domain materials. For a small company, or a university or other nonprofit institution, the risk that public domain materials may in the future be the subject of new copyright claims deters investment in public domain resources. Even for a large company like Google, the possibility that works in the public domain will be legislatively deemed copyrighted in the future is a daunting and complicating prospect. A newly recognized congressional power to withdraw materials from the public domain—decades after the fact—will reduce incentives to make public domain works available to

the public, efforts that often require large upfront investments (scanning entire libraries of old, oddly shaped books is expensive).

Google's concern is primarily related to future congressional action that would further narrow the public domain. In an interesting brief, cinema professor Peter Decherney discussed the long history of Hollywood's reliance on the public domain in films such as *Snow White*, *Pinocchio*, and *The Ten Commandments*.

Several amicus briefs focused on the narrow issue of the copyrights at issue in this case. The Conductors Guild and Music Library Association both conducted surveys and reported that the majority of their members now avoid using works that were previously in the public domain. The brief includes a narrative from a university orchestra conductor who "noted that his student ensemble no longer can perform Prokofiev's *Peter and the Wolf* or Stravinsky's *Soldier's Tale*, among other titles. The loss of *Soldier's Tale* is particularly troubling, as it is considered an essential piece for conductors training to become professionals."

Although it is can be difficult to guess how the justices may vote, Justice Breyer in particular has taken a special interest in copyright law and dissented in *Eldred*. Further complicating the situation, Justice Kagan has recused herself and therefore the case will be decided by only eight members of the court; the petitioners will lose in the case of a 4-4 tie.

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PREVIEW of United States Supreme Court Cases, pages 46–49.
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