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A TALE OF TWO GINSBURGS: TRADITIONAL CONTOURS IN *ELDRED* AND *GOLAN*

*Elizabeth Townsend Gard**

INTRODUCTION

> "[W]hen, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary."[1]

A. A Short, Brief Life?

Born in 2003 as a simple, off-handed phrase, "traditional contours of copyright protection" was the creation of Justice Ginsburg in *Eldred v. Ashcroft*.[2] The phrase never quite developed, at least until Judge Henry in *Golan v. Gonzales* took an interest in the phrase in his Tenth Circuit opinion.[3] But in 2012, in *Golan v. Holder*, not only did Justice Ginsburg disapprove of Judge Henry's interpretation of her phrase, she very much tried to limit its usefulness entirely.[4] "Traditional contours" lived a short, unloved, and troubled life. And yet, the potential for greatness was there.

"Traditional contours of copyright protection"—what was it exactly? Did it define the underlying system of copyright itself? Did it mean only the parameters of safeguards that triggered First Amendment analysis? Did it only apply to copyright law, or were there "traditional contours" in other areas of intellectual property (IP) law,

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1. Eldred v. Ashcroft, 537 U.S. 186, 221 (2003).
2. *Id.*
3. *See* Golan v. Gonzales, 501 F.3d 1179 (10th Cir. 2007).
4. *See* Golan v. Holder, 132 S. Ct. 873, 890 n.29 (2012).

for instance patents (sharing the same origin point in the Copyright Clause), or even law in general? Was it a poor man's "text, precedent, and history," and therefore redundant and unnecessary? In the end, was it a mistake of birth, never wanted, its life shortened before being fully defined? Or is it a phrase we should take more seriously? Could "traditional contours" have been an analytic mechanism to keep in check the balance of our copyright system in changing times?

B. My Never-Ending Relationship with "Traditional Contours"

I did not intend to write a piece about "the tale of two Ginsburgs." I already explored *Golan* in its pre-Supreme Court days and extensively examined the statute connected to the case, § 104A of the Copyright Act of 1976 (1976 Act),[5] both in writing and in practice.[6] I also explored in detail the theoretical underpinnings of the phrase as articulated by Judge Henry in the Tenth Circuit, again in two separate pieces. I had seen my work as complete. I was happy to move on to other topics, and in fact I had. Then, Justice Ginsburg delivered her opinion in *Golan v. Holder*. The contradictions with *Eldred* and the tone of Justice Ginsburg's *Golan v. Holder* opinion, combined with the dismissive footnote regarding Judge Henry's work, all surprised me. Her whole opinion seemed out of sorts. I found myself back in the thicket of "traditional contours," this time seeking to understand the differences between Justice Ginsburg in 2003 with *Eldred* and Justice Ginsburg in 2012 with *Golan v. Holder*. Justice Ginsburg instilled meaning into the phrase twice. This Article seeks to understand what she means by "traditional contours" each time. But it also goes further.

In all my years of study, I had in some ways danced around the phrase. For instance, the practical side of my work looked into the components of § 104A, while the more theoretical work looked to understand the continuity and differences in triggering federal protection for copyright works under the Copyright Act of 1909 (1909 Act)

5. *See* Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541.

6. *See* Elizabeth Townsend Gard, *Copyright Law v. Trade Policy: Understanding the* Golan *Battle Within the Tenth Circuit*, 34 COLUM. J.L. & ARTS 131, 134 (2011); Elizabeth Townsend Gard, *In the Trenches with § 104A: An Evaluation of the Parties' Arguments in* Golan v. Holder *as It Heads to the Supreme Court*, 64 VAND. L. REV. EN BANC 199, 200 (2011), http://www.vanderbiltlawreview.org/content/articles/2011/10/Townsend_Gard_64_Vand_L_Rev_En_Banc_199.pdf; W. Ron Gard & Elizabeth Townsend Gard, *Marked by Modernism: Reconfiguring the "Traditional Contours of Copyright Protection" for the Twenty-First Century*, *in* MODERNISM AND COPYRIGHT 155, 159–60 (Paul K. Saint-Amour ed. 2011) [hereinafter *Marked by Modernism*]; W. Ron Gard & Elizabeth Townsend Gard, *The Present (User-Generated Crisis) Is the Past (1990 Copyright Act): An Essay Theorizing the "Traditional Contours of Copyright" Language*, 28 CARDOZO ARTS & ENT. L.J. 455, 461–62 (2011).

and the 1976 Act.[7] I held the belief that traditional contours existed, and that it was only a matter of working out the details—what is tradition? What is a contour? But Justice Ginsburg in 2012 upset that apple cart. This development called for returning to *Eldred* as the origin point and comparing it with the new incarnation of traditional contours. Indeed, Justice Ginsburg seemed to question whether the phrase had any use at all.

In the aftermath of *Golan v. Holder*, I delved deep into the research, looking at every piece of scholarship written on *Eldred*, as well as the cases following *Eldred*. How had scholars written about *Eldred*, and what other complimentary work would help illuminate what Justice Ginsburg meant in 2003? How had that changed in 2012? I looked to other areas of intellectual property. I looked into First Amendment literature. I was on a quest: What does the phrase "traditional contours" mean? So many scholars had written that Justice Ginsburg in *Eldred* left "traditional contours of copyright protection" undefined. I had always believed that to be true. But as I revisited the opinion itself, I began to disagree. My main research for the past few years has focused on flowcharting copyright law around the world for coding purposes.[8] I found myself putting Justice Ginsburg's 2003 argument into a flowchart, and voilà—the argument seemed to hold a clear map. Doing the same with her 2012 decision brought into view a different topography. The question was how to read the two decisions, the two mappings of traditional contours of copyright protection.[9]

In the process of researching traditional contours, this Article has taken many unexpected turns. My doctoral chair long ago told me that an article is only the tip of an iceberg of discarded research and many drafts. That is certainly true of this piece, which at one point had a full section devoted to patent law and traditional contours. In the end, however, I think the goal of this Article has become understanding the two words "traditional contours" as used by Justice Ginsburg in 2003, debated for ten years, and then used again by Justice Ginsburg. Ultimately, this piece has very modest goals. But I also felt an obligation. It is likely that no one will spend as much time as I have with these two words—no one should. This Article is the result

7. *See generally* Copyright Act of 1909, ch. 320, 35, Stat. 1075; Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541.

8. The Durationator® Copyright Experiment has produced over 220 flowcharts as underlying research, all of which are on file with author.

9. This idea of mapping is significantly influenced by Pam Samuelson's work on mapping the public domain. *See* Pam Samuelson, *Mapping the Digital Public Domain: Threats and Opportunities*, 66 LAW & CONTEMP. PROBS. 147 (2003).

of years of thinking—intentionally and as a consequence of larger work that intersected with *Golan v. Holder*—on what traditional contours could possibly mean, and if there was a reason or usefulness to having such an inquiry as part of copyright law.

On the one hand, traditional contours *could* exist, and such a concept would fit into the larger scheme of understanding copyright law. On the other hand, adding a dimension of *altering traditional contours* is complicated, and I suspect too difficult to practically or meaningfully implement. But finally, after delving into traditional contours, I have strangely become a follower, a believer in its power—I see my thinking about contemporary issues helped by my own understanding of traditional contours, and now I feel comfortable letting go of previous assumptions in some instances and embracing or demanding assumptions in other instances based on this understanding. In the end, I have found that traditional contours is a source of stability in a fast-paced, changing world.

C. (Re)Exploring Traditional Contours

The analysis of copyright through the lens of traditional contours forces us to look into what makes us who we are—why we function the way we do and how our underlying expectations inform the choice we must make in the moment. It requires a serious look at history—not as a simple question of what the founders did, but an investigation of what really informs our laws and the origins of what we believe (and whether it is presently applicable). Traditional contours had the opportunity to spawn a doctrine that employed a strategic plan, with bedrock principles and a larger vision of what the system means and why or how it should function beyond the issue at hand.

Few ever really embraced the phrase.[10] Many seemed embarrassed or even downright angered by it.[11] So, in the aftermath of *Golan v. Holder*, those who believed in traditional contours are left to wonder where to go next. In fact, we see evidence of traditional contours having seeped into our consciousness. Moreover, unconsciously, we may all be practicing traditional contours as we struggle to understand our place of what we know and expect in an ever-changing world.

Part II of this Article explores how the phrase traditional contours originated, and the context in which Justice Ginsburg wrote the (in)famous sentence. Part III then turns to the phrase's lackluster de-

10. *See* Kevin Smith, *Big Victory for the Public Domain*, DUKE UNIV. LIBRARIES (Apr. 6, 2009), http://blogs.library.duke.edu/scholcomm/2009/04/06/big-victory-for-the-public-domain.

11. *See Conversations with Renowned Professors and Practitioners on the Future of Copyright*, 14 TUL. J. TECH. & INTELL. PROP. 1, 72–73 (2011) [hereinafter *Future of Copyright*].

velopment over the subsequent decade, looking specifically at two cases: *Kahle v. Gonzales* and *Silvers v. Sony Pictures Entertainment, Inc.* Part IV examines *Golan v. Gonzales*, in which Judge Henry attempted to breathe life into the phrase. The effort was short-lived due to Justice Ginsburg's second attempt at defining the phrase.

While the first half of this Article focuses on a close reading of *Eldred* and *Golan v. Holder*, the second half is more experimental. It tries to imagine what traditional contours could have been. Whereas the first half maps the various versions of traditional contours, working as a detective to piece together clues, the second half tries to move outside of *Eldred* and *Golan v. Holder* to explore when the phrase might be needed within IP and how it will be applied.

Part V thus explores what traditional contours might look like, focusing on deeper discussions of function, history, and principles. What are the traditional contours of our system, and how do we define what constitutes the system, be it copyright or IP in general? Finally, the conclusion suggests how to understand Justice Ginsburg's new interpretation of traditional contours following *Golan v. Holder* in light of her earlier interpretation in *Eldred.*

II. THE BIRTH OF TRADITIONAL CONTOURS

"Traditional contours of copyright protection" originated with the 2003 Supreme Court case *Eldred v. Ashcroft.*[12] Justice Ginsburg summed up her analysis that First Amendment scrutiny of the Copyright Term Extension Act (CTEA) was unnecessary by noting that the amendments to the 1976 Act did not "alter[ ] the traditional contours of copyright protection."[13] Her placement of that phrase was curious, significant, and potentially forceful, at least until 2012.

After extensive research, it appears from the record that the phrase originated with Justice Ginsburg herself. First, the phrase had not been used in any previous Supreme Court or other federal court cases.[14] Second, neither the *Eldred* plaintiff's brief nor the government included "traditional contours" as a phrase. The government, however, discussed "Congress's traditional authority to extend copyright terms,"[15] and the government referred to "traditional copyright

12. Eldred v. Ashcroft, 537 U.S. 186, 221 (2003).

13. *Id.*

14. A search revealed that *Eldred* was the first case to use the phrase "traditional contours of copyright protection." *See also* Kahle v. Gonzalez, 474 F.3d 665, 667 (9th Cir. 2007), *reh'g denied and superseded by* 487 F.3d 697, 698–99 (9th Cir. 2007) (en banc).

15. "As an initial matter, Congress's traditional authority to extend copyright terms for both subsisting and future works enables Congress to select *shorter terms* in the first instance (as it did

considerations" and "traditional safeguards of free speech."[16] If Justice Ginsburg had adopted either of these statements, the implication of the term "traditional contours" would be far more limited. One would have to identify the traditional safeguards for free speech, and whether idea/expression and fair use satisfied the needed traditional safeguards. The discussion would be over. But Justice Ginsburg used the phrase "traditional contours of copyright protection."[17] Surely, this distinction was not meaningless.

A. Text, History, and Precedent

Eldred considered whether the twenty-year extension of the copyright term for existing published works was constitutional. From the beginning, Justice Ginsburg framed the argument as a constitutional question: "This case concerns the authority the Constitution assigns to Congress to prescribe the duration of copyrights."[18] Justice Ginsburg concluded that "Congress acted within its authority and did not transgress constitutional limitations."[19] She explained that text, history, and precedent "confirm that the Copyright Clause empowers Congress to prescribe 'limited Times' for copyright protection and to secure the same level and duration of protection for all copyright holders, present and future."[20] To this point, there is nothing unusual in the opinion.

B. Traditional Contours of Copyright Protection

The second half of the opinion turned to the First Amendment argument raised by the petitioners. It is in this portion of the opinion that Justice Ginsburg mentioned "traditional contours of copyright protection." The goal of this Part is to understand the context in which she wrote that phrase.

Justice Ginsburg began by noting that the adoption of the Copyright Clause and the First Amendment came close in time.[21] Because

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in 1831, 1909, and 1976), since those shorter terms can be replaced if they prove inadequate." Brief for Respondent at 27, Eldred v. Ashcroft, 537 U.S. 186 (2003) (No. 01-618).

16. *Id.* at 7, 27 n.18.

17. *Eldred*, 537 U.S. at 221.

18. *Id.* at 192.

19. *Id.* at 194.

20. *Id.* at 199.

21. *Id.* at 219. This harkens back to work done in the 1970s in Melville Nimmer's and Paul Goldstein's early articles exploring the relationship of the First Amendment and copyright law. *See* Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983, 1005 (1970); Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180, 1181 (1970).

of this timing and their location in the same larger document, they must somehow work together, rather than be in conflict. This is the starting point for most discussions regarding the relationship between the First Amendment and copyright law. Again, this is not unusual or new.

Then Justice Ginsburg turned her attention to *Harper & Row Publishers, Inc. v. Nation Enterprises*, another oft-cited starting point for analyzing copyright and the First Amendment.[22] She quoted, "'[T]he Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas.'"[23] Here, the idea is that copyright provides protection to authors that create works, and therefore provides protection of *the author's* First Amendment rights. The underlying system protects an author's right to speak and not have her words purloined.

The opinion then took a structural turn to how copyright protects *others'* First Amendment rights in relation to a copyrighted work through safeguards, specifically the idea/expression dichotomy.[24] These safeguards assure that third parties can use parts of the work, even while the work is protected by copyright. Thus, third parties and the copyright holder are both protected. According to Justice Ginsburg, safeguards are not limited to fair use and idea/expression. She provided two examples: (1) a library's ability to create preservation, scholarship, or research copies of works in the last twenty years of the copyright if no commercial copy is available; and (2) the restaurant "homestyle" exception, which allows restaurants and other establishments to play copyrighted music under certain conditions without the requirement of a license.[25] These seem like two very arbitrary choices—one was added with the CTEA, and the other is merely part of the 1976 Act. However, they stand as two very different examples of additional safeguards to the First Amendment interests of third parties in copyrighted works.

Justice Ginsburg's opinion could be read to suggest that the copyright system itself takes the First Amendment into account in its very structure. For example, § 106, which grants exclusive rights to authors, gives authors the freedom to create,[26] and authors have a rem-

22. *See* Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 564 (1985).
23. *Eldred*, 537 U.S. at 219 (quoting *Harper & Row Publishers, Inc.*, 471 U.S. at 558).
24. *See id.* at 219–20; *see also* 17 U.S.C. §§ 102(b), 107 (2006).
25. *See Eldred*, 537 U.S. at 220.
26. 17 U.S.C. § 106 (2006).

edy for infringement under § 501.[27] The 1976 Act, however, balances the needs of both the author and the public. Section 102(b) contains a nonexhaustive list of elements that are non-copyrightable, limiting the subject matter of any particular copyright,[28] and §§ 107–122 contain the exemptions from and defenses to infringement for activities that are allowable without permission from the copyright holder during the life of the copyright.[29] What is strange is that Justice Ginsburg called the library and homestyle exception "supplements to the traditional First Amendment safeguards" of fair use and idea/expression.[30] She described §§ 102(b) and 107 as "traditional" safeguards,[31] and then included two examples from §§ 108–122 as additional supplements to the safeguards.[32]

To summarize, copyright law, starting with the Copyright Clause, creates a bargaining system in which copyright holders gain limited exclusive rights to the works they create and the public benefits from the creation of those works through both third-party use of the work under statutory exceptions and, eventually, the work's addition to the public domain. Justice Ginsburg noted that several sections of the 1976 Act protect First Amendment interests—both the owner's and the public's speech rights. She did not limit those safeguards—at least not until *Golan v. Holder*—to fair use and idea/expression. The Court then considered the CTEA, and the twenty-year extension of the copyright term to existing and future works. Here, the Court found that no one was being forced to reproduce speech: "Instead, [the CTEA] protects authors' original expression from unrestricted exploitation. Protection of that order does not raise the free speech concerns present when the government compels or burdens the communication of particular facts or ideas."[33] The Court explained, "The First Amendment securely protects the freedom to make—or decline to make—one's own speech; it bears less heavily when speakers assert the right to make other people's speeches."[34]

Justice Ginsburg then scolded the D.C. Circuit: "We recognize that the D.C. Circuit spoke too broadly when it declared copyrights 'categorically immune from challenges under the First Amendment.'"[35]

27. *Id.* § 501.
28. *Id.* § 102(b).
29. *Id.* §§ 107–22.
30. *See Eldred*, 537 U.S. at 220.
31. *See id.* at 219–20.
32. *See id.* at 220.
33. *Id.* at 220–21.
34. *Id.* at 221.
35. *Id.* (quoting Eldred v. Reno, 239 F.3d 372, 375 (D.C. Cir. 2001)).

This led to the grand finale: "But when, as in this case, Congress *has not altered the traditional contours of copyright protection*, further First Amendment scrutiny is unnecessary."[36]

Justice Ginsburg provided a clue as to what she meant by altering traditional contours in the two citations that follow the phrase.[37] *Harper & Row* addressed a purloined manuscript written by President Ford. The Court found that President Ford had the right to determine when and where to publish his work, and thus another magazine's preemptive publication was not a fair use.[38] President Ford had the right to speak when he wished, and the First Amendment protection came in the form of copyright law's "right of first publication."[39] This follows the traditional scope of what we think a copyright does and how it protects the copyright holder.

In the other case she cited, *San Francisco Arts & Athletics v. United States Olympic Committee*, the Supreme Court found that the First Amendment did not prohibit granting an exclusive use to the word "Olympic."[40] The case concerned the Amateur Sports Act of 1978, which authorized the U.S. Olympic Committee (USOC) "to prohibit certain commercial and promotional uses of the word "Olympic."[41] Petitioner was a California nonprofit that wanted to use the term "Gay Olympic Games" for a nine-day event in San Francisco.[42] The Court reviewed the legislative history and found that the statute was meant to give exclusive control of the word "Olympic" to the USOC, "without regard to whether use of the word tends to cause confusion."[43] The Court noted that the protection of "Olympic" differed

36. *Eldred*, 537 U.S. at 221 (emphasis added).

37. *See id.* Some see the juxtaposition as a mistake; others see it as a non-starter because *San Francisco Arts & Athletics, Inc.* never reached a First Amendment conclusion. However, this close reading takes Ginsburg's words and choices seriously. For additional discussion of the two references, see J. Matthew Miller III, Comment, *The Trouble with Traditions: The Split over* Eldred*'s Traditional Contours Guidelines, How They Might Be Applied, and Why They Ultimately Fail*, 11 TUL. J. TECH. & INTELL. PROP. 91, 98–99 (2008). He posited two possibilities of how to read the Court's analysis:

> If *San Francisco Arts* serves as a guide, then one "traditional contour" could be the equal application of law to copyrightable works. In other words, whatever the copyright laws, they are to be the same for all works of the same type.... Another interpretation is "traditional contours of copyright" modifies "protection." In other words, the Court may have been talking about the traditional protections, or exclusive rights, granted by copyright.

Id. at 98–99.

38. *See* Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 564 (1985).

39. *Id.*

40. *See* S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm., 483 U.S. 522, 534 (1987).

41. *Id.* at 524 (internal quotation marks omitted).

42. *Id.* at 525 (internal quotation marks omitted).

43. *Id.* at 530.

from normal trademark protection because the statute did not require likelihood of confusion, so the normal trademark defenses were not available.[44]

The question then became whether the restriction of the use of the word "Olympic" restricted expressive speech, and "whether [these] incidental restrictions on First Amendment freedoms [were] greater than necessary to further a substantial governmental interest."[45] The government interests advanced included the promotion and participation of amateur athletes, along with international goodwill. "Section 110 primarily applies to all uses of the word 'Olympic' to induce the sale of goods or services."[46] Congress is not limited to the terms of the Lanham Act, but can enact what it deems necessary, which in this case included restricting unauthorized commercial uses and promotional uses of athletic or theatrical events.

What clues does this send regarding traditional contours? We learn from her examples that (1) an alteration of traditional contours appears to be when Congress goes outside the normal expectations of the system (locking up the word "Olympics," for example); (2) copyrights, trademarks, and, presumably, patents all appear to have traditional contours; and (3) Congress has powers beyond a particular statute to enact laws that affect a particular area of IP. While a First Amendment analysis might be necessary if Congress alters the traditional contours of copyright protection, the alteration itself does not preclude the new amendments or addition to the law.

It was only after many years of working on traditional contours that I could clearly see the work that Justice Ginsburg had done. Justice Ginsburg's opinion contained all of the elements needed to understand that she was trying to preserve the system itself, to explain that copyright law worked by balancing the author's rights on the one hand and third-party rights as safeguards on the other. When an alteration, inside or outside of copyright law, violates this balance, only then should the judiciary step in to evaluate its effect on First Amendment interests.

For Justice Ginsburg in *Eldred*, traditional contours referred to the system itself—how one protects an author's work and safeguards a third party's use of the work during the life of the copyright. A First Amendment analysis is triggered only when the basic structure of the system is violated. No such violation occurred with the enactment of

44. *Id.*

45. *Id.* at 537.

46. *S.F. Arts & Athletics, Inc.*, 483 U.S. at 539.

the CTEA.[47] Extending the term of copyright an additional twenty years did not violate the "limited Times" clause of the Constitution because the term is not perpetual and the system had been used to extend terms many times in its history.[48] As she laid out in *Eldred*, extensions of terms have frequently been applied for both future works and existing works.[49]

Justice Ginsburg concluded *Eldred* by referencing the Framers: "As we read the Framers' instruction, the Copyright Clause empowers Congress to determine the intellectual property regimes that, overall, in that body's judgment, will serve the ends of the Clause."[50] This harkens back to Justice Ginsburg's earlier discussion in the opinion, in which she explained, "The 'constitutional command,' we have recognized, is that Congress, to the extent it enacts copyright laws at all, create[s] a 'system' that 'promote[s] the Progress of Science.'"[51] Again, the system is the traditional contours and the First Amendment comes into play only when Congress alters that traditional system. When Congress ventures beyond its duties prescribed in the Copyright Clause, the judiciary will step in. Traditional contours then could be an analysis of the boundaries for legislation in the Copyright Clause context.

In the months and years surrounding *Eldred*, scholars began to discuss traditional contours. In September 2003, Michael Birnhack wrote, "As copyright law continues to expand into new territories and in unpredictable ways, and as new bills are introduced at a staggering rate to further the scope of the rights of copyright owners, it is crucial that we study the contours of copyright law."[52] A year after *Eldred*, Marshall Leaffer wrote,

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47. *See* Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, § 102, 112 Stat. 2827 (1998) (codified as amended at 17 U.S.C. § 302 (2006)).

48. *See Eldred v. Ashcroft*, 537 U.S. 186, 208–10 (2003).

49. *See id.* at 194–96.

50. *Id.* at 222.

51. *Id.* at 212 (alteration in original).

52. Michael D. Birnhack, *Copyright Law and Free Speech After* Eldred v. Ashcroft, 76 S. CAL. L. REV. 1275, 1276 (2003) (footnotes omitted). For more on built-in First Amendment mechanisms, see sources cited *supra* note 21. More recently, Joseph P. Liu noted that

> these "built-in free speech safeguards" are among the most uncertain and ill-defined doctrines in all of copyright law. The line between protectible expression and unprotectable idea is notoriously vague. No less an authority than Learned Hand wrote that "[n]obody has ever been able to fix the boundary, and nobody ever can." The fair use doctrine is, if anything, even more uncertain in scope. It is a multi-factor, equitable defense that gives much discretion to courts. Outcomes are often difficult to predict with any degree of certainty. The doctrine has been called "the most troublesome in the whole law of copyright."

> In my opinion, the First Amendment issue in *Eldred* ultimately may have more impact on the future of copyright law than the Court's status quo, inherently deferential reading of Article I. . . . [W]hat Justice Ginsburg said about the interplay of copyright and the First Amendment indicates real constraints on the scope of copyright law.[53]

For Leaffer, Justice Ginsburg's "traditional contours of copyright protection" phrase was potentially powerful in the future, and "may be the most important feature of the Court's opinion on future devel-

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Joseph P. Liu, *Copyright and Breathing Space*, 30 COLUM. J.L. & ARTS 429, 429 (2007) (footnotes omitted). Many other key pieces were written during or just after *Eldred*. *See, e.g.*, LAWRENCE LESSIG, FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY 213, 215, 220 (2004); Diane Leenheer Zimmerman, *Is There A Right to Have Something to Say? One View of the Public Domain*, 73 FORDHAM L. REV. 297, 299 (2004); Alfred C. Yen, Eldred, *the First Amendment, and Aggressive Copyright Claims*, 40 HOUS. L. REV. 673, 682 (2003); Yochai Benkler, *Through the Looking Glass: Alice and the Constitutional Foundations of the Public Domain*, LAW & CONTEMP. PROBS., Winter/Spring 2003, at 173, 175; William W. Van Alstyne, *Reconciling What the First Amendment Forbids with What the Copyright Clause Permits: A Summary Explanation and Review*, LAW & CONTEMP. PROBS., Winter/Spring 2003, at 225, 226; Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After* Eldred, 44 Liquormart, *and* Bartniki, 40 HOUS. L. REV. 697, 701 (2003); Timothy Wu, *Copyright's Communications Policy*, 103 MICH. L. REV. 278, 278–81 (2004); David McGowan, *Why the First Amendment Cannot Dictate Copyright Policy*, 65 U. PITT. L. REV. 281, 283 (2004); Daniel A. Farber, *Conflicting Visions and Contested Baselines: Intellectual Property and Free Speech in the "Digital Millenium"*, 89 MINN. L. REV. 1318, 1322–23 (2005); Thomas B. Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272, 277 (2004); Jed Rubenfeld, *The Freedom of Imagination: Copyright's Constitutionality*, 112 YALE L.J. 1, 4–5 (2002); Rebecca Tushnet, *Copy this Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535, 537 (2004); Alan E. Garfield, *The Case for First Amendment Limits on Copyright Law*, 35 HOFSTRA L. REV. 1169, 1169–72 (2007); Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 150 (1998); Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354, 358–60 (1999); Neil Weinstock Netanel, *Market Hierarchy and Copyright in Our System of Free Expression*, 53 VAND. L. REV. 1879, 1886 (2000); Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1, 5 (2001); Alan E. Garfield, *The First Amendment as a Check on Copyright Rights*, 23 HASTINGS COMM. & ENT. L.J. 587, 590 (2001); Lawrence Lessig, *Copyright's First Amendment*, 48 UCLA L. REV. 1057, 1070–71 (2001); C. Edwin Baker, *First Amendment Limits on Copyright*, 55 VAND. L. REV. 891, 899 (2002); Erwin Chemerinsky, *Balancing Copyright Protections and Freedom of Speech: Why the Copyright Extension Act Is Unconstitutional*, 36 LOY. L.A. L. REV. 83, 85 (2002); Lackland H. Bloom, Jr., *Copyright Under Siege: The First Amendment Front*, 9 COMPUTER L. REV. & TECH. J. 41, 42 (2004); Raymond Shih Ray Ku, *F(r)ee Expression? Reconciling Copyright and the First Amendment*, 57 CASE W. RES. L. REV. 863, 863, 865–66 (2007); Adrian Liu, *Copyright as Quasi-Public Property: Reinterpreting the Conflict Between Copyright and the First Amendment*, 18 FORDHAM INTELL. PROP., MEDIA & ENT. L.J. 383, 389 (2007); Jennifer E. Rothman, *Liberating Copyright: Thinking Beyond Free Speech*, 95 CORNELL L. REV. 463, 477 (2010); Edmund T. Wang, *The Line Between Copyright and the First Amendment and Why Its Vagueness May Further Free Speech Interests*, 13 U. PA. J. CONST. L. 1471, 1474–76 (2011); Miller III, *supra* note 37, at 91–92.

53. Marshall Leaffer, *Life After* Eldred*: The Supreme Court and the Future of Copyright*, 30 WM. MITCHELL L. REV. 1597, 1604–05 (2004).

opments in copyright law."[54] He was compelled to ask, "When does legislation alter those 'traditional contours?'"[55] Many would ask the same question. Brett Frischmann acknowledged that the phrase could be interpreted in many ways: "Traditionally, it at least evokes historical consideration. But of what exactly? What are the relevant contours?"[56] Moreover, how would we apply a traditional contours analysis to the problems of the day?

Scholars recognized some potential importance but, like me, did not see the simplicity and utter beauty of the phrase. Few took on the task of defining traditional contours over the following ten years, and confusion set in—did it mean the system itself, or did it somehow relate only to the First Amendment? But Justice Ginsburg had given us the map: her traditional contours preserved the copyright system itself, which was created to support patents and copyrights under the Copyright Clause (and presumably trademarks under the Commerce Clause).[57]

To summarize, *Eldred* is a starting point where traditional contours referred to (1) the subject matter protected by the area of IP; (2) the exclusive rights given to the author or holder of the right; (3) the safeguards for third party use of the system; and (4) the duration of the limited monopoly requirement. As long as the expectations fell in line

54. *Id.* at 1605.

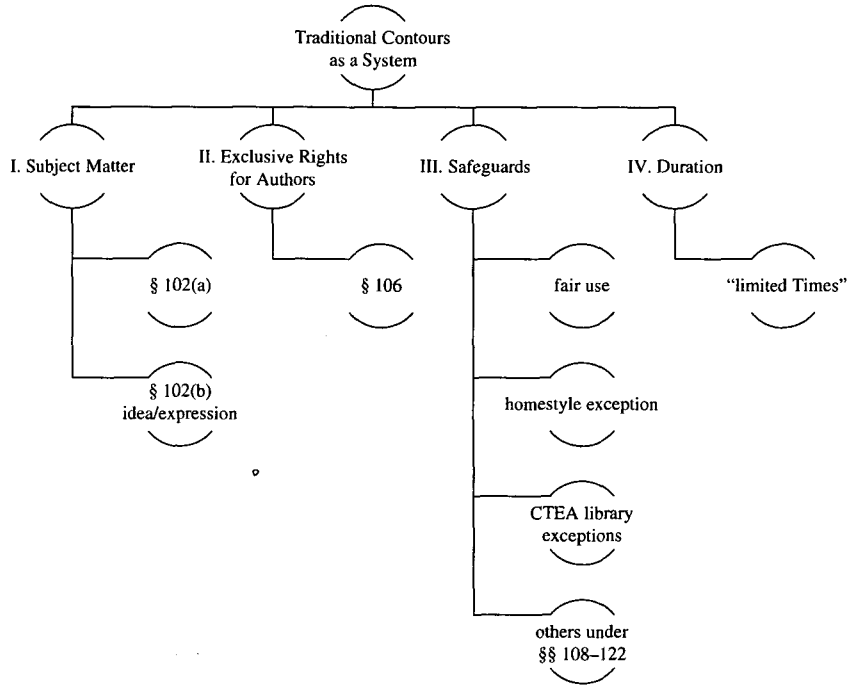
55. *Id.*; *see also* Niels Schaumann, *Copyright, Containers, and the Court: A Reply to Professor Leaffer*, 30 WM. MITCHELL L. REV. 1617, 1624 (2004); Arnold P. Lutzker & Susan J. Lutzker, *Altering the Contours of Copyright—The DMCA and the Unanswered Questions of* Paramount Pictures Corp. v. 321 Studios, 21 SANTA CLARA COMPUTER & HIGH TECH. L.J. 561, 561–62 (2005); Jonathan N. Schildt, Note, *One's Own Speech: First Amendment Protection for the Use of Public Domain Works in* Golan v. Gonzales, 58 DEPAUL L. REV. 219, 221 (2008).

56. Hugh C. Hansen, Diane Zimmerman, Robert Kasunic & Brett Frischmann, Panel Two, *The Death or Rebirth of Copyright?*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1095, 1110 (2008) (remarks of Brett Frischmann).

57. The feeling that "traditional contours" serves something crucial to evaluating the system continued through *Golan v. Gonzales*. David Lange, along with his students, Risa J. Weaver and Shiveh Roxana Reed, analyzed "traditional contours" within the context of the U.S. Supreme Court review of *Golan v. Gonzales*. They asked: "What are we to understand the 'traditional contours' of copyright to be? What does it mean when we speak of these contours in the context of the First Amendment? And why should it matter?" David L. Lange, Risa J. Weaver & Shiveh Roxana Reed, Golan v. Holder: *Copyright in the Image of the First Amendment*, 11 J. MARSHALL REV. INTELL. PROP. L. 83, 122 (2011). They saw the questions as "enormously" important: "Whatever the traditional configurations of copyright may be, they are surely relevant to the more important question of copyright's potential for conflict with freedom of expression." *Id.* They believed that the "doctrinal safeguards are presumably close to the center of whatever Justice Ginsburg may have meant when she spoke in passing of copyright's 'traditional contours.' But copyright's doctrines and contours define the nature of their conflict with the First Amendment, not an excuse for wishing it away." *Id.* They saw the Uruguay Round Agreement Act's (URAA) removal of works from the public domain as "anything but traditional." *Id.* at 123.

with what was traditionally considered part of the system, no First Amendment analysis was necessary.

FIGURE 1: "TRADITIONAL CONTOURS" AS THE COPYRIGHT SYSTEM: JUSTICE GINSBURG'S ANALYSIS IN *ELDRED*



In placing Justice Ginsburg's *Eldred* opinion into a flowchart, one starts to see the dynamics. It is the copyright system itself, the Copyright Clause in action. When an alteration affects the balance or strays from these categories, the First Amendment steps in as a tool to evaluate the two-hundred-year-old balance of copyright protection and free speech. As long as the traditional contours are not altered, the 1976 Act renders First Amendment analysis unnecessary. What might fall outside of the system? Many have speculated.[58] Anti-circumvention, safeguards for online service providers, anti-bootlegging legislation, and even the proposed Google book settlement all operate outside our traditional expectations of the system. Under Justice Ginsburg's system, one would look to see if the built-in safeguards or additional safeguards specific to the issue address First Amendment concerns. If not, then the Court would evaluate the issue, as in *San Francisco Arts & Athletics.*

58. *See, e.g., Future of Copyright, supra* note 11, at 72–73.

In this reading, traditional contours is a fairly conservative term—it means that as long as what is being proposed fits within the expected structure of copyright law, no First Amendment issue is raised. In Justice Ginsburg's structure of traditional contours, the system seems easily identifiable. It becomes a placeholder for the system itself. But, strangely, traditional contours was not interpreted that straightforwardly. Instead, when something new was introduced, the issue was whether it fit within the traditional contours. In other words, the focus shifted to defining "traditional" and "contours."

III. TRADITIONAL CONTOURS IN POST-*ELDRED* CASE LAW

In the decade between Justice Ginsburg's opinions in *Eldred* and *Golan v. Holder*, only a handful of cases included traditional contours as an argument for why modification of the 1976 Act should receive First Amendment scrutiny.[59] Although no cases successfully demonstrated that traditional contours had been altered, two cases in particular are helpful in describing the Courts' construction of the phrase.

The first case, *Kahle*, addressed the Copyright Renewal Act of 1992, which granted automatic renewal to works published between 1964 and 1977.[60] Previously, works protected under the 1909 Act required an affirmative act of renewal in the twenty-eighth year.[61] After the Copyright Renewal Act, as long as the notice requirements had been met, automatic renewal occurred, giving the published work protection for seventy-five years following its original publication.[62] Plaintiffs believed this shift to automatic renewal altered the traditional contours of copyright protection.[63] The Court responded,

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59. *See, e.g.*, Golan v. Gonzales, 501 F.3d 1179 (10th Cir. 2007); Kahle v. Gonzales, 487 F.3d 697 (9th Cir. 2007) (en banc); Silvers v. Sony Pictures Entm't, Inc., 402 F.3d 881 (9th Cir. 2005). *Eldred* was part of four test cases promulgated by Larry Lessig "to challenge various aspects of a decade-long expansion of copyright—and corresponding diminution of the public domain—enacted by Congress in the 1990s." Tyler T. Ochoa, *Is the Copyright Public Domain Irrevocable? An Introduction to* Golan v. Holder, 64 VAND. L. REV. EN BANC 123, 125 (2011), http://www.vanderbiltlawreview.org/content/articles/2011/10/Ochoa_64_Vand_L_Rev_En_Banc_1233.pdf. The 1990s saw the enactment of the Copyright Renewal Act (1992), the URAA (1994), the CTEA (1998), and the Digital Millennium Copyright Act (1998), to name the most famous. Each of these started to garner suspicion that perhaps they did not fit into the spirit of the 1976 Act, and Justice Ginsburg's "traditional contours" language could test or even unravel this new set of legislation.

60. 17 U.S.C. § 303 (2006).

61. *See id.* § 101.

62. The CTEA would extend the term by twenty years in 1998.

63. Kahle v. Ashcroft, No. C-04-1127 MMC, 2004 WL 2663157, at *3 (N.D. Cal. Nov. 19, 2004), *aff'd sub nom* Kahle v. Gonzalez, 474 F.3d 665 (9th Cir. 2007) (en banc), *reh'g denied and superseded by* 487 F.3d 697 (9th Cir. 2007) (en banc).

> The Supreme Court has not identified the entire universe of protections that it considers to be within such "traditional contours." . . . The concepts of copyright law that the Supreme Court suggests fall within those contours—the idea/expression dichotomy and the fair use exception—each relate to the scope of copyright protection.[64]

The district court found, however, that registration, renewal, and deposit focused on the procedures for obtaining copyright protection—"mere formalities"—rather than the scope of protection and, therefore, did not fall under traditional contours of copyright protection.[65] "Because changes to requirements of this nature do not alter the substantive rights granted by copyright, this Court finds that the challenged amendments do not alter the 'traditional contours' of copyright protection."[66] No substantive changes occurred, and so no violation of traditional contours occurred. The Ninth Circuit affirmed the decision.[67]

Under *Kahle*, subject matter, ownership, duration, infringement, and defenses would then be included as traditional contours. Formalities, including registration, renewal, notice, and deposit would not fall under traditional contours and, therefore, would not be subject to analysis under a traditional contours framework. This fits in many ways with the structure established by Justice Ginsburg in *Eldred*.

Another Ninth Circuit case, *Silvers*, also reviewed traditional contours. In that case, Nancey Silvers wrote a script as a work-for-hire, but she was assigned the right to sue.[68] The Court found that in order to bring suit, the plaintiff must have a legal or beneficial interest in the copyright, and Silvers failed to show such an interest.[69] The Court looked to patent law and other circuits for support.[70]

The dissent defined traditional contours as a tool available to sustain the careful balance between "the interests of authors and inventors in the control and exploitation of their writings and discoveries on the one hand, and society's competing interest in the free flow of ideas, information, and commerce on the other hand."[71] The dissent concluded, "I see nothing in the assignment of accrued claims of Frank & Bob Films for infringement of a work *created* by Sil-

64. *Kahle*, 2004 WL 2663157, at *17.

65. *Id.*

66. *Id.*

67. Kahle v. Gonzalez, 474 F.3d 665 (9th Cir. 2007) (en banc), *reh'g denied and superseded by* 487 F.3d 697 (9th Cir. 2007) (en banc).

68. Silvers v. Sony Pictures Entm't, Inc., 402 F.3d 881, 883 (9th Cir. 2005).

69. *Id.* at 889–90.

70. *See id.* at 887–90.

71. *Id.* at 893 (9th Cir. 2005) (Berzon, J., dissenting) (internal quotation marks omitted).

vers *to* Silvers that violates these background principles."[72] The phrase "background principles" would not gain traction, but could be seen as another version of traditional contours. The *Silvers* dissent closely aligns with Justice Ginsburg's development of traditional contours in *Eldred.* A few other cases would include a traditional contours argument, but, on the whole, traditional contours remained under-utilized.

IV. *GOLAN*'S VERSION(S) OF "TRADITIONAL CONTOURS"

A. Luck's Music Library: *Foreshadowing Justice Ginsburg's* Golan v. Holder *Opinion*

Two cases would be brought to challenge section 514 of the Uruguay Round Agreements Act (URAA), a statutory amendment that restored copyright protection to foreign works that had entered the public domain in the United States, but were still under copyright in their home country. The first was *Luck's Music Library v. Gonzales*[73] in the D.C. Circuit, and the second was *Golan v. Holder*,[74] which was heard before the Supreme Court. Section 514 was enacted as part of the implementing legislation for the United States joining the World Trade Organization (WTO)[75] and appears in the 1976 Act as § 104A.[76]

Section 104A creates an interesting conflict. On the one hand, because the United States has a duty to fulfill treaty obligations, it was required as a new member to the Berne Convention to restore works covered thereunder.[77] Some of these works had not qualified for copyright protection under the U.S. laws before the United States joined Berne, and thus had come into the public domain in the United States. Upon joining Berne, the United States had to comply with Article 18, which required that works still under copyright in their home country be restored as part of joining Berne.[78] Russian paintings and music from the 1940s, for example, were in the public domain in the United States because Russia and the United States had no treaty relations until 1972, yet these works were restored by the URAA. Joining Berne required two major areas of restoration: works for which no treaty relationship had existed, as in the case of Russia, and works

72. *Id.*
73. *See* Luck's Music Library, Inc. v. Gonzales, 407 F.3d 1262 (D.C. Cir. 2005).
74. *See* Golan v. Holder, 132 S. Ct. 873 (2012).
75. *See* Uruguay Round Agreements Act, Pub. L. 103-465, 108 Stat. 4809 (1994).
76. 17 U.S.C. § 104A (2006).
77. Berne Convention Implementation Act of 1988, Pub. L. 100-568, 102 Stat. 2853.
78. *Id.*

that had not met the very complicated formality requirements in the United States, including notice and renewal.[79]

On the other hand, restoring works was something very strange to our system; suddenly works that had been in the public domain and free to use for sometimes ninety years or more were re-copyrighted, with new restrictions. The plaintiffs in *Golan v. Gonzales* and *Luck's Music* claimed that recopyrighting works violated the First Amendment by altering the traditional contours—the traditional expectations—of copyright protection.

The United States joined the Berne Convention in 1988, but did not include any legislation to restore foreign works in the Berne Convention Implementation Act.[80] In joining the WTO, however, the question arose again. The conflict arose based on how § 104A was implemented and whether the amendment went too far. In *Luck's Music* and *Golan v. Gonzales*, the plaintiffs asserted that § 104A violated the traditional contours of copyright law because the amendment removed works from the public domain and the safeguards that were provided by § 104A were insufficient.

The district court in *Luck's Music* found section 514 of the URAA to be within the traditional contours of copyright protection because the amendment contained built-in safeguards for those who had previously used the work when it was in the public domain, creating a class of users known as reliance parties.[81] Further, the district court found that § 104A did not overstep congressional power or violate the First Amendment, and therefore granted the defendant's motion to dismiss.[82] Because Justice Ginsburg's actions in *Golan v. Holder* nearly a decade later paralleled those of the district court in *Luck's Music*, it is useful to review the structure of the district court's argument.

The district court began by noting the need to implement Article 18 of the Berne Convention.[83] So too would Justice Ginsburg in *Golan v. Holder*.[84] The court noted that section 514 not only restores works as required by Article 18 but also includes additional safeguards for those who relied on the work when it was in the public domain.[85] The court then turned to the specifics of the plaintiffs' arguments in *Luck's Music*.

79. A third category of foreign sound recordings was also included: works previously protected by state common law, but not federal law.

80. Berne Convention Implementation Act of 1988, Pub. L. 100-568, 102 Stat. 2853.

81. *See* Luck's Music Library, Inc. v. Ashcroft, 321 F. Supp. 2d 107, 119 (D.D.C. 2004).

82. *See id.*

83. *See id.* at 109.

84. Golan v. Holder, 132 S. Ct. 873, 877 (2012).

85. *Luck's Music Library, Inc.*, 321 F. Supp. 2d at 109.

Luck's Music, a family business, sold and repackaged public domain classical orchestral sheet music "to more than 7,000 orchestras ranging from elementary to operatic and to 12,000 individuals worldwide."[86] A good deal of their catalog included works whose authors had not been eligible for copyright protection due to lack of treaty relations, namely Russia before 1972.[87] Luck's Music received 200–300 notices of Intent to Enforce restored copyrights and had one year, according to the statute, to sell off its inventory before they were subject to a lawsuit for copyright infringement.[88] Luck's Music, however, was unable to sell all of its inventory during the one-year period.[89] Moviecraft, the other plaintiff in *Luck's Music*, was in the same situation: a family business that operated a film archive of public domain works, including foreign works that had not met formality requirements.[90] These works, which Moviecraft had preserved, were now restored and unusable without permission from the copyright holder.[91]

The court addressed the legal standard for interpreting the Copyright Clause, particularly in light of *Eldred*, including the fact that the judiciary "defers substantially to Congress for its policy decisions on [c]opyright law."[92] Next the court considered its analysis of section 514, which it titled "Congress has Traditionally Exercised Restorative Copyright Powers."[93] The defendants argued that Congress had restored works before, while the plaintiffs argued that any restoration of works was an unusual case.[94] To sort these arguments out, the court

86. *Id.* at 110.

87. *See id.*

88. *See id.*

89. *Id.*

90. *Id.* at 110–11.

91. *Luck's Music Library, Inc.*, 321 F. Supp. 2d at 111.

92. *Id.* at 112 (citing Eldred v. Ashcroft, 537 U.S. 186, 212 (2003)). "The courts will not find that Congress has exceeded its powers so long as the means adopted by Congress for achieving a constitutional end are 'appropriate' and 'plainly adapted' to achieving that end." Schnapper v. Foley, 667 F.2d 102, 112 (D.C. Cir. 1981) (citing Mitchell Bros. Film Grp. v. Cinema Adult Theater, 604 F.2d 852, 860 (5th Cir. 1979)). Further, "[courts] are not at liberty to second-guess congressional determinations and policy judgments of this order, however debatable or arguably unwise they may be." Eldred v. Ashcroft, 537 U.S. 186, 220 (2003).

93. *Luck's Music Library, Inc.*, 321 F. Supp. 2d at 113.

94. *Id.* ("The defendants seek to establish that Section 514 is constitutional by demonstrating a history of retroactive copyrighting based on previous acts and proclamations tracing back to the founding of the United States. The defendants assert that the [1790 Act] . . . established retroactive copyright, and several presidential declarations continued the tradition of restoring copyrights retroactively without constitutional challenge. The plaintiffs also contend that the presidential proclamations only applied to copyright holders who could not meet statutory formality requirements during times of war. The plaintiffs' arguments, however, are unpersuasive." (citations omitted)).

turned to history and tradition.[95] The court conducted a historical analysis and discovered an "unbroken practice of granting retroactive copyrights and removing works from the public domain since the founding of the Constitution."[96] This is an interesting way of framing the issue. It presupposed that restoration of works is the norm, and that the plaintiffs had the burden of proving that it was not an "unbroken practice." As a result, we see this new phrase entering into the traditional contours framework.

The court's analysis of the historical practices of restoration in the United States was the first of its kind. It appeared again in *Golan v. Holder* and the amicus briefs. In some ways, determining what constitutes an unbroken practice or traditional contour becomes a battle of history. First, the court examined the Copyright Act of 1790 (1790 Act) and wrote, "The plaintiffs' interpretation that the 1790 Act merely codified existing copyright law requires the assumption that either all states had copyright statutes enacted or that a common-law of copyright existed in the United States."[97] Again, this is an interesting position: the plaintiffs had to prove that the 1790 Act did not retroactively restore copyright.

> If neither of these bodies of law existed, then Congress' implementation of the 1790 Act would have created copyright law and granted retroactive copyrights to works already in the public domain. A review of state statutes before the ratification of the Constitution and the enactment of the 1790 Act reveals that the plaintiffs' argument is flawed.[98]

The court then delved into state copyright laws and the Articles of Confederation. Because the Articles of Confederation did not vest Congress with the power to enact intellectual property laws, the task fell to each state.[99] Three states did not enact copyright laws: Delaware, Maryland, and Pennsylvania.[100] Because no copyright protection existed for works in those states, "Congress' actions with the enactment of the 1790 Act created retroactive copyrights for works published by the citizens of these three states."[101] The court, citing

95. *Id.* "To comprehend the scope of Congress' power under the [Copyright Clause], a page of history is worth a volume of logic." *Id.* (internal quotation marks omitted). "A consistent congressional exercise of its power under the [Copyright Clause] since the forming of the [C]onstitution 'is entitled to very great weight.'" *Id.* (internal quotation marks omitted).

96. *Id.* at 113.

97. *Id.*

98. *Id.*

99. *Luck's Music Library, Inc.*, 321 F. Supp. 2d at 113.

100. *Id.* at 114.

101. *Id.*

Wheaton v. Peters, also found that a common law copyright did not exist in states without copyright statutes.[102] The court wrote,

> In *Wheaton*, the Court interpreted the words "by securing" in the IP clause to mean that the Constitution gave Congress the power to create a new right through the 1790 Act. The Court explained that "securing" had to refer to the creation of a new right, since the Constitution includes both copyright and patent law in the same clause, and patent law had no existing common law equivalent in England. The Court further reasoned that any other interpretation would render the IP clause mere surplusage because the result would be a "vest[ing] of a right already vested." Thus, "Congress, . . . by [the 1790 Act], instead of sanctioning an existing right[,] created it." Because not every state had a copyright statute and because no common law right to copyright existed, the plaintiffs' argument that the 1790 Act merely codified existing common law fails.[103]

The court then turned to the 1919 and 1941 amendments, which allowed foreigners from specific countries extra time to retroactively register works published during the war years.[104] The court found that both amendments further demonstrated a practice of restoring works.[105] "For instance, Presidents Wilson and Harding issued proclamations in 1920 and 1922 respectively that effectively restored copyright to British and German works published during World War I."[106] A similar restoration occurred after World War II, which included Australia, Austria, Finland, Germany, and the United Kingdom.[107]

The turn to history becomes a battle of interpretation. But this is not the best use of a traditional contours argument—one should not simply reach back to the past, and say, "See, they did it this way." But in *Luck's Music*, the court exemplified this problem. It found that the evidence showed that restoration had previously occurred. Later, this Article will show that traditional contours could be much more than a throwback to the past. It is an evaluation of the past within the context of the present. Nonetheless, *Luck's Music* presents a clear articulation of one way to look at history.

The court found that the Copyright Clause itself did not impose a limitation on the public domain, and that the nature of patents is so

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102. *Id.* at 114 (citing Wheaton v. Peters, 33 U.S. 591, 659–61 (1834)).

103. *Id.* (alteration in original) (citations omitted). This is a fairly interesting use of *Wheaton*, a case that usually stands for the premise that a common law right of "first publication" exists, and then is extinguished *upon first publication* because federal law trumps the common law. *Cf., e.g.*, Jon M. Garon, *Normative Copyright: A Conceptual Framework for Copyright Philosophy and Ethics*, 88 CORNELL L. REV. 1278, 1305 (2003).

104. *See Luck's Music Library, Inc.*, 321 F. Supp. 2d at 114.

105. *See id.* at 115.

106. *Id.*

107. *See id.*

different that patent law cases in this area do not transfer to copyright.[108] Again, this issue of when patent law and copyright law can support one another is a larger question, but we have evidence that courts do rely on copyright law to support patent law and vice versa. Here, however, the court explicitly rejected the application of a patent decision to copyright.[109]

Next, the court considered the First Amendment issue. The plaintiffs argued that "Section 514 violates the First Amendment because it restricts the freedom of expression of works already in the public domain."[110] The next sentence is one of the more interesting in the opinion: "The defendants argue—and the Court agrees—that *Eldred* bars this argument."[111]

The court relied on *Eldred* to explain that when copyright protection "raises First Amendment concerns, copyright law contains built-in accommodations for First Amendment speech such as through the idea/expression dichotomy and the fair use doctrine."[112] It should be noted that the court used "such as" instead of "i.e."[113] The court then reiterated the famous phrase: "When Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary."[114] Gone is the reference to *San Francisco Arts & Athletics, Inc.*; traditional contours were thus narrowed.

Using this reasoning, the court analyzed section 514 and explained in one paragraph that no alteration of traditional contours occurred.[115] First, the court explained, section 514 does not alter fair use or idea/expression.[116] Moreover, section 514 "supplements First Amendment protections by protecting parties who already have exploited the restored copyrighted work while in the public domain."[117] Interestingly, the simplification of the reliance issue is a basic retelling of what is included in the statute—there is no deeper analysis of the reliance issues. So *Luck's Music* is a case of reliance—one year was too short to sell off merchandise, and restoring the works from the public domain dramatically altered the business itself. In other words,

108. *See id.* at 116. Of course, this is ironic, given that we just saw the Court use patent to justify copyright.

109. *See id.*

110. *Luck's Music Library, Inc.*, 321 F. Supp. 2d at 118.

111. *Id.*

112. *Id.*

113. *See id.* Justice Ginsburg altered her own construction in *Golan v. Holder* to a closed list that only includes fair use and idea/expression by using "i.e."

114. *Id.* at 119 (quoting Eldred v. Ashcroft, 537 U.S. 186, 221 (2003)).

115. *See id.*

116. *See Luck's Music Library, Inc.*, 321 F. Supp. 2d at 119.

117. *Id.*

the expectations associated with copyright law were changed, which economically impacted a way of life, a business entity, and a family. This was entirely ignored. Instead, the court wrote that section 514 failed to encroach on fair use or idea/expression and included additional "protections" (but not the word "safeguards" as used in *Eldred*), therefore, no additional scrutiny under the First Amendment was necessary.[118]

Luck's Music is a disappointment on a number of levels: the court did a poor job of using history, traditional contours itself was not analyzed, and the safeguards at issue were not actually discussed. Nevertheless, it also gives us a clue into what was meant at the time by traditional contours. *Luck's Music* comes closer to Justice Ginsburg's opinion in *Golan v. Holder* than her own opinion in *Eldred*. It is the first indication that this version of history would prevail, and that traditional contours would continue to remain an undeveloped, simple concept.

The D.C. Circuit affirmed the *Luck's Music* decision without further discussion.[119] The district court in *Golan* also did not find any violation of traditional contours of copyright protection with regard to section 514 of the URAA,[120] but the Tenth Circuit took up the same question and came to the opposite conclusion.

B. The Game-Changing Tenth Circuit Decision

The *Golan* suit was filed in September 2001, a month before *Luck's Music* and two years before *Eldred* was decided by the Supreme Court. Ten years later, the Supreme Court would again be confronted with the question of "traditional contours of copyright law" in *Golan v. Holder*. A decade in the making, *Golan*, in all its versions, gives us the most thorough vision of traditional contours, adding the functional ("contours") and historical (the modifier "traditional" to contours) elements.[121]

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118. *Id.*

119. *See* Luck's Music Library, Inc. v. Gonzales, 407 F.3d 1262, 1266 (D.C. Cir. 2005).

120. Golan v. Gonzales, Civ. 01-B-1854(BNB), 2005 WL 914754 (D. Colo. Apr. 20, 2005), *aff'd in part, remanded in part* 501 F.3d 1179 (10th Cir. 2007). The district court ruled on a motion for summary judgment. There was no mention of the phrase "traditional contours of copyright protection," although the court did look at historical precedent, comparison to patents, and discussion of various copyright acts. *Id.* at *3–14.

121. Golan v. Gonzales, 501 F.3d 1179, 1189 (10th Cir. 2007). After the plaintiff's initial complaint and the defendant's motion to dismiss, the district court stayed *Golan* when the Supreme Court accepted *Eldred*. Once *Eldred* was decided, plaintiffs filed an amended complaint, and the defendants filed a renewed motion to dismiss. The district court released its opinion in 2004, a year after *Eldred*. Golan v. Ashcroft, 310 F. Supp. 2d 1215 (D. Colo. 2004).

Judge Henry, in the Tenth Circuit, was the first judge to find that something had violated the traditional contours of copyright protection, and, therefore, he remanded the case for First Amendment scrutiny.[122] It was a big moment for traditional contours, and one could argue that, had Judge Henry not stepped down from the bench to enter academia, we might have had a different ending to the traditional contours story, at least at the appellate level.[123] Judge Henry took seriously the question of what constitutes "traditional contours of copyright protection," finding that restoring foreign works from the public domain altered the traditional contours of copyright protection.[124] Thus, while Congress has the power to enact such legislation, First Amendment scrutiny was necessary.[125]

The court engaged in a two-part analysis. First, Congress had the authority to enact the URAA. Judge Henry wrote,

> We agree it would be troubling if Congress adopted a consistent practice of restoring works in the public domain in an effort to confer perpetual monopolies. But this argument is similar to one the *Eldred* plaintiffs raised, and, like the *Eldred* Court, we are mindful that "a regime of perpetual copyrights is clearly not the situation before us."[126]

Here, the works restored had "limited Times" in that their new copyright had an expiration date. The plaintiffs relied on *Graham v. John*

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122. *Golan*, 501 F.3d at 1188–89.

123. On a personal level, I came to know traditional contours shortly after the Tenth Circuit decision. My work in the fall of 2007 began to look into § 104A, and the decision was released in September 2007. For most of the time of my work, traditional contours was controlled by Judge Henry's reading, and, therefore, became significantly influential in the direction of my work.

124. For a particularly good account of the public domain and the impact of restoration, see Ochoa, *supra* note 59, at 144 and Zimmerman, *supra* note 52, at 298. Writing about *Golan* on the eve of oral arguments before the Supreme Court, Ochoa explained the future impact of the decision on the public domain:

> Ultimately, what is at stake in *Golan* is nothing less than the entire corpus of works in the public domain, and even the entire concept of a public domain. If the Court holds that the Patent and Copyright Clause or the First Amendment prohibits removal of material from the public domain, then the public domain will indeed be irrevocable, and the public will have a bright-line constitutional safeguard against future incursions by Congress.
>
> If the Court holds that material may be removed from the public domain, but only for specified reasons or only within certain limits, then any future congressional action regarding the public domain will at least be subject to constitutional challenge. But if the Court holds that Congress has the discretion to remove material from the public domain whenever it chooses, the potential future consequences will be staggering.
>
> If Congress can validly take any work out of the public domain and put it back under copyright protection, then there is nothing to keep Congress from taking *all* works out of the public domain and putting them back under copyright protection.

Ochoa, *supra* note 59, at 144.

125. *See Golan*, 501 F.3d at 1188–89.

126. *Id.* at 1186.

Deere Co. of Kansas City for the proposition that works in the public domain cannot be patented or, in this case, copyrighted.[127] The court then invoked *Luck's Music*, which distinguished patents from copyrights: "The Court concludes that plaintiffs have thrust onto *Graham* a burden it was never intended to bear. We decline to read *Graham* as standing for the proposition that, in the context of copyright, the public domain is a threshold that Congress may not 'traverse in both directions.'"[128] It is interesting that Judge Henry was not willing to go so far as to preclude Congress from recopyrighting public domain works, rejecting the opportunity to apply *Graham*.[129] "Here, we do not believe that the decision to comply with the Berne Convention, which secures copyright protections for American works abroad, is so irrational or so unrelated to the aims of the Copyright Clause that it exceeds the reach of congressional power."[130]

But Judge Henry did not stop there: "Nevertheless, legislation promulgated pursuant to the Copyright Clause must still comport with other express limitations of the Constitution. Thus, even if Congress has not exceeded its Article I authority, § 514 may still be subject to First Amendment review."[131] Here is the crux of the distinction: Article I powers of Congress versus the relationship between copyright and the First Amendment. Thus, while Congress may have the authority to enact section 514, the law may still be subject to First Amendment review. This is the second prong of his analysis and is an interesting structural move. The First Amendment comes into play as another area of law, separate from Congress's authority, which creates an external hurdle to copyright law. It may be that the laws enacted by Congress and interpreted by the courts comport with the Copyright Clause but do not comport with the First Amendment.

Judge Henry began the heart of his analysis regarding traditional contours with the heading "Congress's Removal of Works from the Public Domain Alters the Traditional Contours of Copyright Protection and Requires First Amendment Scrutiny."[132] He began again with *Eldred*: "[W]e address the *Eldred* Court's holding that the CTEA's extension of existing copyrights did not require First Amendment scrutiny and discuss the Court's suggestion that an act of Congress would only be subject to First Amendment review if it 'altered

127. *See id.*

128. *Id.* at 1187.

129. *See id.*

130. *Id.* Most do not remember this part of the Tenth Circuit decision.

131. *Golan*, 501 F.3d at 1187

132. *Id.*

the traditional contours of copyright protection.'"[133] "Based on the *Eldred* Court's analysis, we examine the bedrock principle of copyright law that works in the public domain remain there and conclude that § 514 alters the traditional contours of copyright protection by deviating from this principle."[134] Thus, while Congress can create laws, they still may violate the traditional contours and require additional scrutiny.

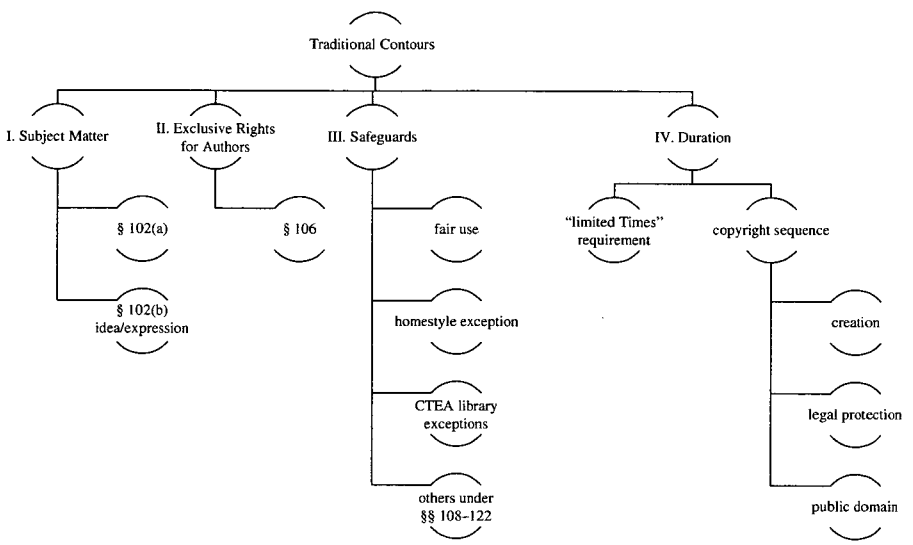
Judge Henry noted that *Eldred* did not define "traditional contours," and that it did not appear in any other federal authority.[135] This raised an interesting point. Justice Ginsburg seemed to set out "the traditional contours" as a system that included scope of protection, exclusive rights, and safeguards. She did not concentrate on defining "traditional contours" as a phrase in its own right, but Judge Henry set that as his task.

Judge Henry recognized that "the term seems to refer to something broader than copyright's built-in free speech accommodations."[136] He then identified both a functional and historical component to traditional contours.[137] First, he referenced the dictionary definition for "contours," finding it to mean "outline" or "the general form of something."[138] This is reminiscent of *Eldred*, in which Justice Ginsburg found an underlying "system" based on the requirements of the Copyright Clause. Here, "contours" fulfills the same requirement.[139] "Because the term copyright refers to a process as well as a form of intellectual property rights, we assess whether removing a work from the public domain alters the ordinary procedure of copyright protection."[140] Judge Henry then turned to the word "traditional," which modifies "contours."[141] He believed this phrasing "suggest[ed] that Congress's historical practice with respect to copyright and the public domain must inform [the court's] inquiry."[142] Judge Henry concluded "that the traditional contours of copyright protection includes the principle that works in the public domain remain there and that § 514 transgresses this critical boundary."[143]

133. *Id.*
134. *Id.* at 1187–88.
135. *Id.* at 1188–89.
136. *Id.* at 1189.
137. *Golan*, 501 F.3d at 1189.
138. *Id.* (internal quotation marks omitted).
139. *See supra* Part III.A.
140. *Golan*, 501 F.3d at 1189.
141. *Id.*
142. *Id.*
143. *Id.*

Eldred and *Golan v. Gonzales* both concerned a question of time—when are works protected by copyright and when are they in the public domain? In *Eldred*, the question was whether extending a term of copyright protection violated traditional contours, to which the Court answered no. Then the *Golan* court was asked whether restoring copyright protection to works currently in the public domain violated traditional contours and expectations. The concept of the public domain, then, fits as part of the fourth element of traditional contours, as shown in Figure 2.

FIGURE 2: TRADITIONAL CONTOURS FOR COPYRIGHT PROTECTION IN *ELDRED* AND *GOLAN V. GONZALES*



Justice Ginsburg gave us an outline for the traditional contours of copyright, then Judge Henry started to give us a way to evaluate when those traditional contours might have been altered by reviewing the phrase "traditional contours" itself. He focused his attention on the fourth element of traditional contours: duration and what he refers to as the copyright sequence.

C. The Fourth Element: Duration

Judge Henry first took up the contours by looking at the functional aspects of duration and the idea of a copyright sequence.[144] The process of copyright begins when an author creates a work. Whether under previous systems or the 1976 Act,

144. *Id.*

> Until § 514, every statutory scheme preserved the same sequence. A work progressed from (1) creation; (2) to copyright; (3) to the public domain. Under § 514, the copyright sequence no longer necessarily ends with the public domain: indeed, it may begin there. Thus, by copyrighting works in the public domain, the URAA has altered the ordinary copyright sequence.[145]

The *contours*, the system, had been upset. This is a fairly underappreciated portion of Judge Henry's argument. While most will later concentrate on the "traditional," he began with the contours, the functional. Justice Ginsburg argued that just because it has been the usual sequence, it does not have to be. Judge Henry would likely agree; where they differ is that Judge Henry believed, based on *Eldred*, that when what has been usual—the traditional contours—is altered, then one takes the next step and analyzes the change through First Amendment scrutiny.

Next, Judge Henry analyzed the idea of the "public domain." He looked to the copyright sequence in combination with the *principle* of the public domain.[146] Judge Henry wrote, "The significance of the copyright sequence, combined with the principle that no individual may copyright a work in the public domain, is that ordinarily works in the public domain stay there."[147] Otherwise, the removal of a work from the public domain contravenes the contours of the system.[148] Judge Henry's language raises several questions: What other "principles" of copyright law exist? How does one get to the principles? Are they influenced by history, by the contours of the system, or by both? In short, where do the principles come from? Interestingly, this particular principle could also fall under subject matter limitations. In fact, the question of subject matter is where Justice Ginsburg placed the issue, and she would take the side of those who believed that the original 1790 Act removed works from the public domain and allowed the works to be copyrighted. Her argument, in essence, would be to contest the basic principle that public domain works are not eligible as copyrightable subject matter. That, in fact, is the heart of the disagreement between Justice Ginsburg and Judge Henry.

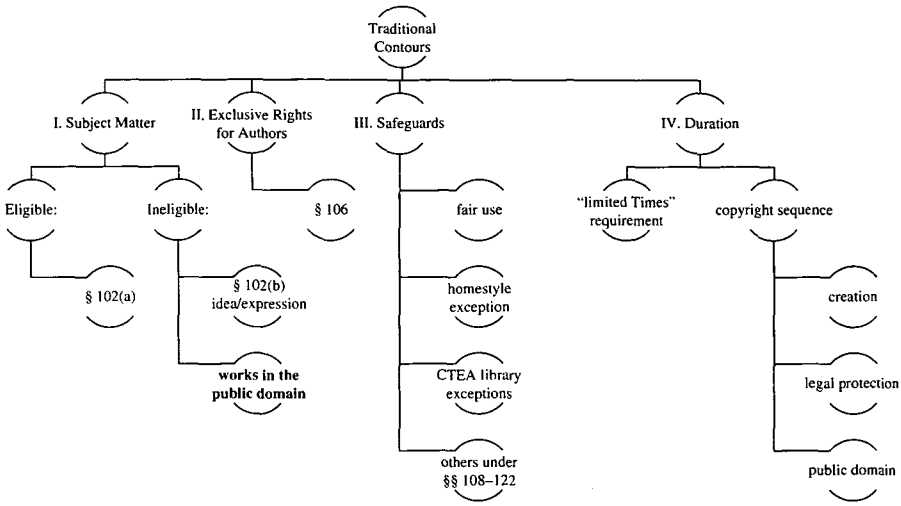
145. *Id.*

146. *Golan*, 501 F.3d at 1189

147. *See id.*

148. *See id.* at 1189–90.

FIGURE 3: JUSTICE GINSBURG'S TRADITIONAL CONTOURS IN *ELDRED* AS MODIFIED BY JUDGE HENRY IN *GOLAN V. GONZALES*



After reviewing the "contours," Judge Henry turned to the modifier "traditional." He wrote, "The history of American copyright law reveals no tradition of copyrighting works in the public domain."[149] To evaluate the tradition of the principle, Judge Henry used the past practices of Congress and the Framers, but after reviewing the 1790 Act he agreed with the plaintiff that preexisting works had been protected by state common law and thus were not removed from the public domain when they were federalized under the new system.[150] This would become a key point debated between parties and amicus briefs when the case headed to the Supreme Court in 2011.[151] According to Judge Henry, although we cannot know the Framers' view on removing works from the public domain, "[g]iven the scarcity of historical evidence, we cannot conclude that the Framers viewed removal of

149. *Id.* at 1190.

150. *Id.*

151. *See, e.g.*, Brief for American Society of Composers et al. as Amici Curiae Supporting Respondents at 16–17, Golan v. Holder, 132 S. Ct. 873 (2012) (No. 10-545); Brief for The Motion Picture Association as Amicus Curiae Supporting Respondents at 15, Golan v. Holder, 132 S. Ct. 873 (2012) (No. 10-545); Brief for American Bar Association as Amicus Curiae Supporting Respondents at 17–18, Golan v. Holder, 132 S. Ct. 873 (2012) (No. 10-545); Brief for Creative Commons Corporation as Amicus Curiae Supporting Petitioners at 15, Golan v. Holder, 132 S. Ct. 873 (2012) (No. 10-545); Brief for Information Society Project at Yale Law School Professors and Fellows as Amici Curiae Supporting Petitioners at 16, Golan v. Holder, 132 S. Ct. 873 (2012) (No. 10-545); Brief for H. Tomas Gomez-Arostegui and Tyler Ochoa as Amici Curiae Supporting Petitioners at 14, Golan v. Holder, 132 S. Ct. 873 (2012) (No. 10-545).

works from the public domain as consistent with the copyright scheme they created. Nor do we discern at the dawn of the Republic any burgeoning tradition of removing works from the public domain."[152] It appears, then, that once a court identifies a principle, it should analyze how the principle works both functionally and within the past practices. History then becomes the question: Has this been done before? If it has, no alteration has occurred. If it is new to the system, First Amendment analysis is required.

Judge Henry then examined the history of congressional grants of copyright protection to works in the public domain, where he noted that a "series of private bills" restored copyright in a few cases:

> But "[t]hese private bills do not support the [government's] historical gloss, but rather significantly undermine the historical claim." Far from providing evidence that copyrighting works in the public domain is within the traditional contours of copyright protection, the fact that individuals were forced to resort to the uncommon tactic of petitioning Congress demonstrates that this practice was *outside* the normal practice.[153]

Wartime acts also point to restoration as being out of the normal system or practice: "[A] review of the historical record reveals that these emergency wartime bills, passed in response to exigent circumstances, merely altered the means by which authors could comply with the procedural rules for copyright; these bills were not explicit attempts to remove works from the public domain."[154] Judge Henry continued, "The statutory context of these acts reveals that they were, at most, a brief and limited departure from a practice of guarding the public domain."[155] He noted that the 1919 Wartime exception allowed Americans to use the work:

> Congress emphasized that it was not attempting to interfere with the rights of Americans who had relied on the foreign works. . . . [T]he 1919 Act stated that "nothing herein contained shall be construed to deprive any person of any right which he may have acquired by the republication of such foreign work in the United States prior to approval of this Act." One of the Acts to which the 1919 Act referred was the 1909 Copyright Act. That Act made clear that "no copyright shall subsist in the original text of any work which is *in the public domain*."[156]

152. *Golan*, 501 F.3d at 1191.

153. *Id.* (alteration in original) (citations omitted).

154. *Id.* at 1191–92.

155. *Id.* at 1192.

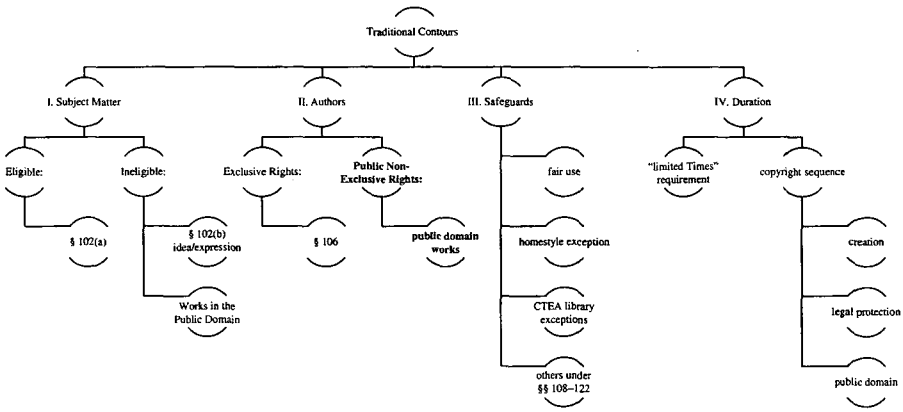
156. *Id.* (citations omitted).

He concluded that removal of works from the public domain was an exception rather than a traditional contour.[157]

> In sum, by extending a limited monopoly to expressions historically beyond the pale of such privileges, the URAA transformed the ordinary process of copyright protection and contravened a bedrock principle of copyright law that works in the public domain remain in the public domain. Therefore, under both the functional and historical components of our inquiry, § 514 has altered the traditional contours of copyright protection.[158]

Once he established that section 514 *altered* the traditional contours of copyright protection, Judge Henry turned to the plaintiff's First Amendment interests.[159] Here, we find the effect of the principle and how altering the principle affects ownership issues. We see a change in how we might think about authorship.

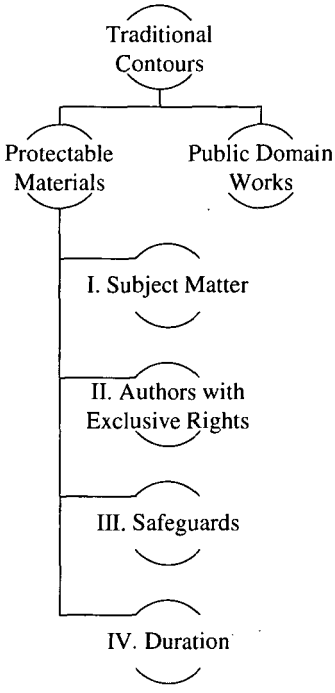
FIGURE 4: JUDGE HENRY'S READING OF JUSTICE GINSBURG'S TRADITIONAL CONTOURS



First, "works in the public domain belong to the public," giving the plaintiff a nonexclusive right and a First Amendment interest in the unrestrained and unrestricted use of the work.[160] Here is a change again in our flowchart.

157. *Id.*
158. *See Golan*, 501 F.3d at 1192.
159. *See id.*
160. *Id.* at 1192–93.

FIGURE 5: ANOTHER WAY TO VIEW JUDGE HENRY'S ARGUMENT IN *GOLAN V. GONZALES*



The built-in First Amendment safeguards discussed in *Eldred*, namely fair use and idea/expression, are inadequate once a work enters the public domain: "[T]he threat to free expression lies not in what is being copyrighted, but in the fact that the works are being removed from the public domain."[161] Structured in this manner, Figure 5 demonstrates *why* fair use and idea/expression are inadequate: they no longer apply.

Judge Henry confirmed:

> Once a work has entered the public domain, however, neither the author nor the author's estate possesses any more right to the work than any member of the general public. Because § 514 bestows copyrights upon works in the public domain, these built-in safeguards are not adequate to protect plaintiffs' First Amendment interests.[162]

Judge Henry then turned to idea/expression: "The idea/expression dichotomy is simply not designed to determine whether Congress's grant of a limited monopoly over an expression in the public domain

161. *Id.* at 1194.

162. *Id.* at 1195.

runs afoul of the First Amendment."[163] As with idea/expression, fair use is not a safeguard that is appropriate once a work is in the public domain, as the public is entitled to use *all of a work* without seeking permission. These two safeguards concern works that are still under copyright, not works in the public domain.[164]

D. Remanded District Court Decision

Judge Henry remanded the case to the district court to determine whether to apply a content-neutral or content-based standard of review.[165] On remand, Judge Babcock, who had decided the first district court decision upholding the statute, found that the URAA's provision for restoration was broader than necessary to achieve the government's interest.[166] To date—and even after Justice Ginsburg's opinion in *Golan v. Holder*—Judge Babcock's opinion stands as the first and only attempt at applying a First Amendment analysis to § 104A.

After reviewing the Tenth Circuit's understanding of the relationship between copyright and the First Amendment, Judge Babcock explained that, because the traditional contours were altered, the Tenth Circuit asked how the alterations impacted the plaintiff. Judge Babcock explained that before the works were removed from the public domain, the plaintiffs

> had, subject to constitutionally permissible restraints, a non-exclusive right to "unrestrained artistic use of these works" that was protected by the First Amendment. . . . "[O]nce the works at issue became free for anyone to copy, plaintiffs in this case had vested First Amendment interests in the expressions, and § 514's interference with plaintiff's rights is subject to First Amendment scrutiny."[167]

Section 514 interfered with that right by restoring copyright to public domain works and, in some cases, "by making the cost of using the works prohibitive."[168] Judge Babcock then noted that neither the built-in First Amendment protections nor specific supplemental section 514 safeguards adequately addressed the problem.[169]

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163. *Id.* at 1194.

164. *Golan*, 501 F.3d at 1195. Justice Ginsburg oddly rejected this analysis, insisting that fair use and idea/expression are adequate safeguards, even once a work enters the public domain.

165. *Id.* at 1196.

166. *See* Golan v. Holder, 611 F. Supp. 2d 1165, 1177 (D. Colo. 2009), *rev'd*, 609 F.3d 1076 (10th Cir. 2010), *aff'd*, 132 S. Ct. 873 (2012).

167. *Id.* at 1169 (quoting Golan v. Gonzales, 501 F.3d 1179 (10th Cir. 2007)).

168. *Id.*

169. *See id.* 1169–70.

Judge Babcock then began the First Amendment analysis—the first court to actually engage in such analysis within a "traditional contours of copyright protection" framework. He quickly agreed with the parties that the restriction was content neutral: "Here, the speech restricted is a general category of speech—namely, speech created by foreign authors. The justification for the restriction lies in the protection of the authors' interests in the expressions themselves, not the ideas the works encompass."[170] Because the restriction was content neutral, the next determination was whether the restriction advanced an important government interest, and whether the restriction was broader than necessary to protect that interest,[171] which was the focus of the remainder of the opinion. To determine whether the restriction was overbroad, Judge Babcock weighed the government's interests against the plaintiff's.[172] He found that section 514 violated the First Amendment because the government's interests were not well supported and the amendment was broader than necessary to protect those interests. Therefore, the amendment violated the First Amendment.[173]

Here, the flowchart includes, for the first time, what occurs if there is a violation or alteration of the traditional contours of copyright protection. The actual First Amendment analysis plays a sideline role in the *Golan* case, and is not included in Justice Ginsburg's opinion, because, as in *Luck's Music*, she did not find an alteration of traditional contours, and, therefore, a First Amendment analysis was not necessary.

E. Appealed Tenth Circuit Decision

On appeal, the Tenth Circuit did not analyze or even mention "traditional contours," but instead focused on the second part of the First Amendment analysis from the district court—whether there was a legitimate government interest to support the regulation, which the Court found there was.[174]

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170. *Id.* at 1170. The Yale amicus brief would argue that it is content-based. Brief for Information Society Project at Yale Law School Professors and Fellows as Amici Curiae Supporting Petitioners, *supra* note 151, at 4.

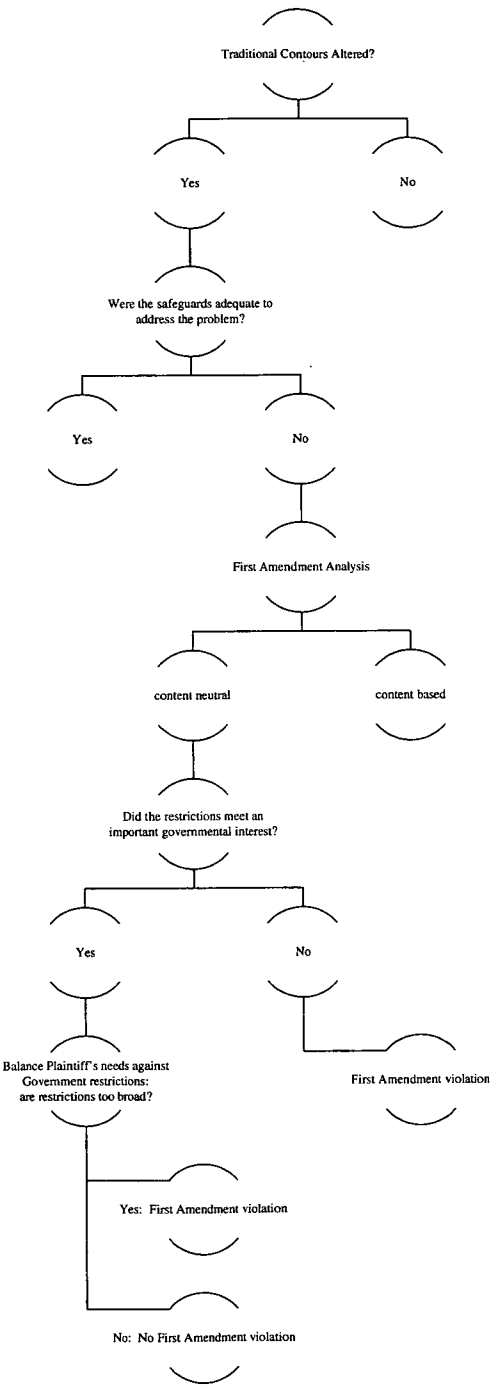
171. *See Golan*, 611 F. Supp. 2d at 1170.

172. *See id.* at 1172–77.

173. *Id.* at 1177.

174. *See* Golan v. Holder, 609 F.3d 1076, 1095 (10th Cir. 2010).

FIGURE 6: FLOW CHART FOR DETERMINING WHETHER TRADITIONAL CONTOURS HAVE BEEN ALTERED



F. The U.S. Supreme Court

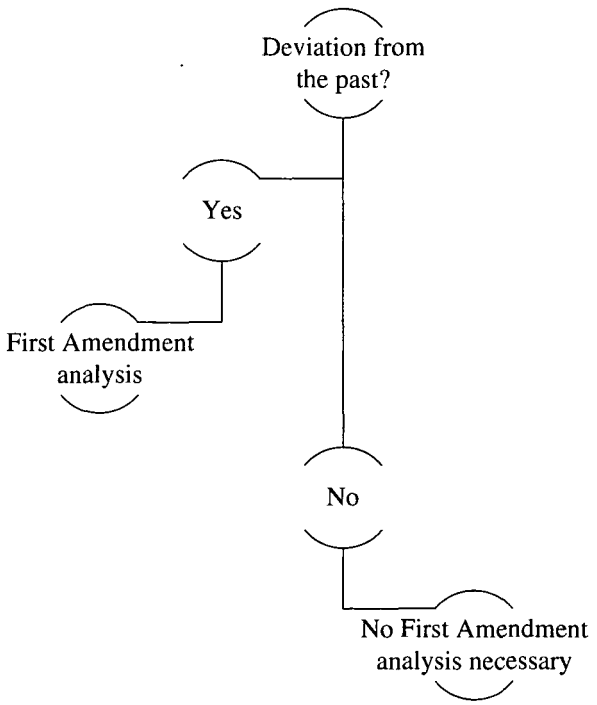
1. The Briefs

The Supreme Court granted certiorari in *Golan v. Holder* in 2011.[175] The petitioners' brief framed the *Golan v. Holder* traditional contours argument by starting with *Eldred.*

> The Court reasoned that although statutes conforming to "historical contours" may be presumed constitutional because of that historical compatibility, substantial deviations from those "traditional contours" cannot be presumed constitutional on that basis, and must be assessed under ordinary First Amendment review.[176]

The use of "historical" is interesting: what comes before requires no First Amendment review.

FIGURE 7: PETITIONERS' ARGUMENT IN *GOLAN V. HOLDER*



This seems to be a weaker place to begin, privileging the past over the present. It could be read as cautioning against change: when change occurs we need the First Amendment's help. This, perhaps, is

175. Petition for Writ of Certiorari, Golan v. Holder, 131 S. Ct. 1600 (No. 10-545).

176. Brief for the Petitioners at 42–43, Golan v. Holder, 131 S. Ct. 1600 (2011) (No. 10-545) (citing Eldred v. Ashcroft, 537 U.S. 186, 221 (2003)).

the most basic understanding of traditional contours—a deviation from the past.[177]

The petitioners then asserted two elements of the argument. First, restoring foreign works from the public domain deviates from tradition and history, and second, in doing so, restoration violates a "bedrock principle" of copyright that once works enter the public domain, they remain there.[178] The petitioners examined the bedrock principle, along with the speech interest that is harmed by the deviation. "Unlike the term extension statute that was before the Court in *Eldred*, section 514 takes away vested and established public speech rights."[179] The "vested" language was seen in the remanded district court decision. The petitioners explained, "The 'federal right to copy and use' material in the public domain is not simply a 'traditional contour of copyright protection.' It is a defining feature of American copyright law, and an essential safeguard that ensures copyright remains 'compatible with free speech principles.'"[180] Here, we see the petitioners attempting to define the sanctity of the public domain as a safeguard of the system. "Section 514 departs from the time-honored tradition of leaving the public domain intact, and dismantles the speech protections that tradition provided to both petitioners and the public. It cannot escape First Amendment scrutiny."[181] Modifying the chart of the *Eldred* opinion, the petitioners asserted that the public domain itself is a safeguard. One could also see Judge Henry's reorientation at play in the petitioners' brief, of traditional contours being protectable, copyrightable materials and public domain materials.

In sum, the petitioners reiterated Judge Henry's notion of a "bedrock" principle that is included in traditional contours of copyright protection and argued that section 514 of the URAA violated that principle, thus triggering First Amendment scrutiny.[182] The petitioners looked to history and tradition—the expectations associated with copyright for over two hundred years—as a way to define traditional contours.[183]

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177. *Cf.* Stephen M. McJohn, Eldred*'s Aftermath: Tradition, the Copyright Clause, and the Constitutionalization of Fair Use*, 10 MICH. TELECOMM. & TECH. L. REV. 95, 118 (2003) ("[L]egislation that goes beyond the traditional contours of copyright would be subject to First Amendment scrutiny. This does not mean that non-traditional copyright protection will be invalid; it just means that it will be subject to a higher level of scrutiny than traditional protection.").

178. Brief for the Petitioners, *supra* note 176, at 42–43.

179. *Id.* at 45.

180. *Id.* at 47 (citation omitted).

181. *Id.* (citation omitted).

182. *Id.* at 41–43.

183. *See id.* at 43.

FIGURE 8: PETITIONERS' VERSION OF TRADITIONAL CONTOURS

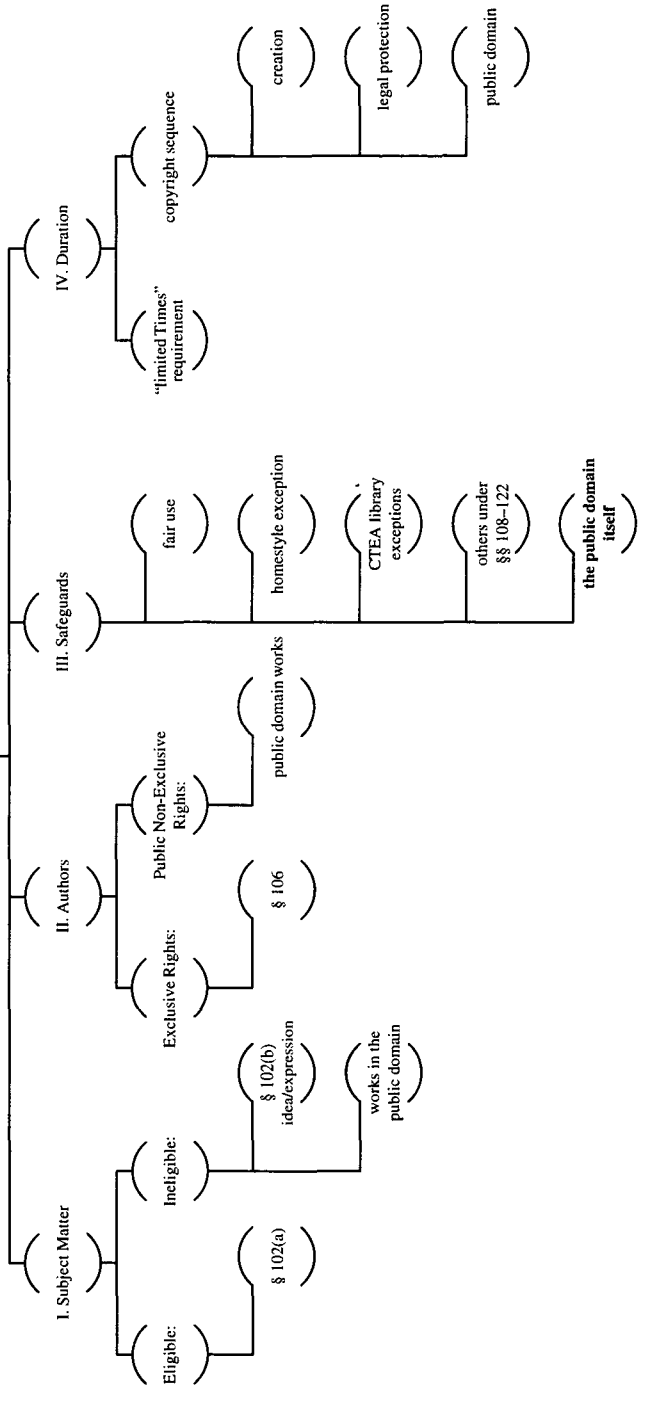
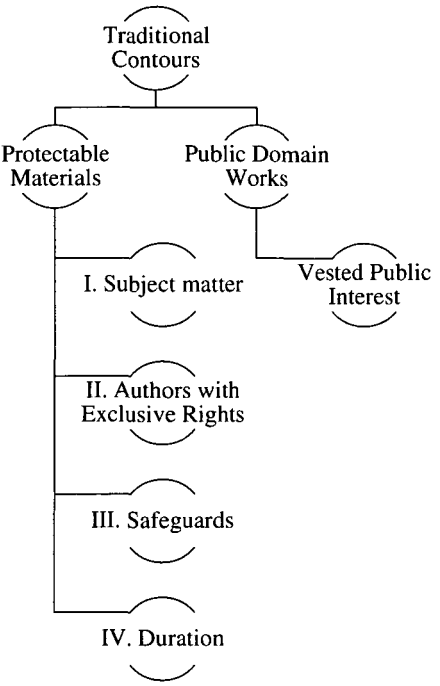


FIGURE 9: JUDGE HENRY'S REORIENTATION AS SEEN IN PETITIONERS' BRIEF



The government responded that the appellate court erred when it found section 514 violated the traditional contours of copyright protection.[184] "Section 514 does not alter the traditional balance between protected and prohibited conduct that is built into the Copyright Act. The idea/expression dichotomy and the 'fair use' defense apply fully to exploitation of restored works subject to Section 514."[185]

The petitioners' reply brief approached the question of how *Eldred* should be interpreted head on: "The government tries to avoid First Amendment scrutiny by insisting the only 'traditional contours' that

184. *See* Brief for the Respondents at 12, Golan v. Holder, 131 S. Ct. 1600 (2011) (No. 10-545) ("The court of appeals erred in holding that Section 514 alters the 'traditional contours of copyright protection' and is therefore subject to heightened scrutiny. In *Eldred*, this Court discussed the various features of traditional copyright law that ensured its consistency with the First Amendment. Those features include the 'idea/expression dichotomy,' the 'fair use' defense, and the fact that traditional copyright protections restrict only the unauthorized exploitation of other people's expression. So long as Congress legislates in a manner consistent with those traditional features of copyright law, the First Amendment inquiry is essentially at an end.").

185. *Id.*

trigger it are the fair use doctrine and the 'idea/expression dichotomy.'"[186] The petitioners' brief continued:

> But *Eldred* implies no such limitation. It recognized these doctrines represent two "built-in First Amendment accommodations" or "safeguards" that are "generally adequate" to address First Amendment concerns. It does not say or suggest these are the *only* "accommodations" or "safeguards," or that any specific set of "accommodations" or "safeguards" exhaust the "traditional contours of copyright protection."[187]

The petitioners' reply explained that *Eldred* concentrated on the limits necessary when works are still under copyright protection.[188]

> The public's right to copy and use works in the public domain is a third safeguard that attaches once that period ends, and is designed to provide complete and permanent protection for all First Amendment interests. Copyright's protection of First Amendment interests has always progressed from *partial* protection to *complete* protection of those interests. The government's suggestion that Congress can reverse that sequence at will is precisely the departure from tradition that triggers First Amendment scrutiny.[189]

Here we see Judge Henry's distinction of protectable work and public domain at play, and we also see Judge Henry's idea of principles regarding the copyright sequence, specifically in relation to the public domain. The nature of the safeguards changes when a work crosses over to the public domain. Each area has its own traditional contours—traditional contours of an idea, traditional contours of copyright protection, and traditional contours of the public domain. Each may include principles *about* the public domain, but the public domain itself, as a category, presents unique needs and safeguards.

As to the amici briefs, some mentioned "traditional contours of copyright protection," but most did not analyze what that would entail. Tomas Gomez-Arostegui and Tyler Ochoa did not directly address traditional contours, but framed the question more narrowly as whether there was precedent for removing works from the public domain.[190] This seems to indirectly speak to the traditional contours

186. Reply Brief for the Petitioners at 15, Golan v. Holder, 131 S. Ct. 1600 (2011) (No. 10-545).

187. *Id.* (citations omitted).

188. *See id.*

189. *Id.* at 16.

190. *See* Brief of H. Tomas Gomez-Arostegui and Tyler T. Ochoa as Amici Curiae in Support of Petitioners, *supra* note 151, at 2 ("The chief issue this brief addresses is whether, in enacting the 1790 Act, the First Congress restored works from the public domain, thereby creating a First Congress precedent for the URAA. The parties and the lower courts disagree on this point. This brief discusses the historical record and concludes that the record does *not* support the view that the First Congress believed it was removing works from the public domain. If anything, it is

question on the historical side of the argument, and perhaps maybe even the functional. Has Congress done this before, and how did they do it? The Google amicus brief stated that the power asserted by Congress in enacting section 514 "goes far outside the 'traditional contours' of copyright law."[191] One wonders why more careful attention is not paid to "traditional contours" at this opportune moment.

2. *Justice Ginsburg in* Eldred *Versus Justice Ginsburg in* Golan v. Holder

On January 18, 2012, Justice Ginsburg delivered the opinion in *Golan v. Holder*, a 6–2 decision, with Justice Kagan taking no part. Justice Ginsburg's *Golan v. Holder* opinion is fascinating when compared to her opinion in *Eldred*, and slightly troubling because the entire basis of her decision is built on faulty law.

In *Eldred*, Justice Ginsburg did not leave us with a clear map of "traditional contours of copyright protection," but she left clues, which I have organized to permit a systematic analysis. She considered the fair use and idea/expression dichotomy as built-in mechanisms to protect the First Amendment, and she identified other safeguards, including library exceptions and the homestyle music exception for restaurants. That was in 2003. From her construction and discussion, this Article framed traditional contours into four elements: subject matter, exclusive rights for authors, safeguards, and duration. Nearly a decade later, in *Golan v. Holder*, we see a different Justice Ginsburg—one anxious to put the traditional contours discussion back into Pandora's box. It is as if she sought to turn back time—to revise *Eldred*. She had not meant to start "traditional contours of copyright protection." In *Golan v. Holder*, she tried to stop it.

Justice Ginsburg began her opinion with a discussion of the Berne Convention, and stated that the URAA did not "transgress constitutional limitations of Congress' authority."[192] This holding affirmed the Tenth Circuit opinion, thus no change occurred. But with her next conclusion, Justice Ginsburg dramatically *altered the traditional contours of copyright protection*: "Neither the Copyright and Patent Clause nor the First Amendment, we hold, makes the public domain, in any and all cases, a territory that works may never exit."[193]

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more likely that members of the First Congress believed that they were limiting and preempting preexisting copyrights based on the common law.").

191. Brief for Google, Inc. as Amicus Curiae in Support of Petitioners at 11, Golan v. Holder, 132 S. Ct. 873 (2012) (No. 10-545).

192. Golan v. Holder, 132 S. Ct. 873, 878 (2012).

193. *Id.*

In both the party briefs and amicus briefs, the fight in *Golan v. Holder* had been over history—whether we had previously seen the removal of works in the public domain. Each side had vigorously shown how history sided with their version. They were reacting to the "tradition" in traditional contours and asking what history could tell us about removal. Justice Ginsburg took a far more radical approach, extending herself further than necessary to uphold the law. She could have traveled the path of the government's brief to find that the removal was necessary and, therefore, did not violate the First Amendment. Or she could have limited her decision to exceptions that had occurred throughout history—with the first U.S. Copyright Act in 1790 (if you believe that version of history), after wars, and now in harmonizing global copyright. But she chose neither of these more limited routes. Nor did she "kill" the concept of "traditional contours of copyright protection."

Discussing Congress's authority to remove works from the public domain, Justice Ginsburg wrote, "Installing a federal copyright system and ameliorating the interruptions of global war, it is true, presented Congress with extraordinary situations."[194] Following this line of thinking, a traditional contour is removal for extraordinary situations. Nonetheless, she did not follow this line of reasoning: "Yet the TRIPS accord, leaving the United States to comply in full measure with Berne, was also a signal event. Given the authority we hold Congress has, we will not second-guess the political choice Congress made between leaving the public domain untouched and embracing Berne unstintingly."[195] This would have been a sufficient argument, but she did not stop there.

She then directed her argument to the Tenth Circuit's "bedrock principle that once works enter the public domain, they do not leave."[196] Justice Ginsburg had a number of choices. She could have found that the government had satisfied its burden to overcome the First Amendment. She could have found that § 104A had enough protection for reliance parties, similar to *Luck's Music*. She could have found that "traditional contours" did not apply because most of the issues involved in *Golan v. Holder* were procedural, rather than substantive, as in *Kahle*. She could have found that the balance between author and society had not been altered, as in the *Silver* dissent.[197]

194. *Id.* at 887.
195. *Id.* (citations omitted).
196. *Id.* at 883.
197. Silvers v. Sony Pictures Entm't, Inc., 402 F.3d 881, 893 (9th Cir. 2005).

Instead, she wrote, "We next explain why the First Amendment does not inhibit the restoration authorized by § 514."[198] She began with an analysis of *Eldred*: "We then described the 'traditional contours' of copyright protection, *i.e.*, the 'idea/expression dichotomy' and the 'fair use' defense." Both are recognized in our jurisprudence as "built-in First Amendment accommodations."[199] The language is interesting. Why does she quote "traditional contours" and not the "traditional contours of copyright protection"—the complete phrase from *Eldred*? I would suggest that she is signaling something about "traditional contours." Moreover, she used "i.e.," which translates to "that is." She has limited "traditional contours" to mean idea/expression and fair use. But she had not done so in *Eldred.* In that opinion, as we have already learned, she included "other safeguards" as well. Why the shift? What happened to the 2003 Justice Ginsburg?

Returning to her language in *Eldred*, after discussing fair use and idea/expression, she wrote:

> The CTEA itself supplements these traditional First Amendment safeguards in two prescriptions: The first allows libraries and similar institutions to reproduce and distribute copies of certain published works for scholarly purposes during the last 20 years of any copyright term, if the work is not already being exploited commercially and further copies are unavailable at a reasonable price, § 108(h); the second exempts small businesses from having to pay performance royalties on music played from licensed radio, television, and similar facilities, § 110(5)(B).[200]

Then, the famous phrase concluded her analysis: "When, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary."[201]

In *Golan v. Holder*, Justice Ginsburg seemed to limit "traditional contours" to idea/expression and fair use, and did not mention the other two safeguards. But in the next instance, she turned to what she was now calling "the transitional elements" of section 514—the protections for reliance parties. She noted that they are included, but with no follow-up commentary.[202] We are left to wonder if they protect traditional contours too. This feels more like *Luck's Music* than the fuller discussions in the lower courts' *Golan* opinions.

The petitioner, in line with the remanded district court opinion, argued that once a work enters the public domain, the public gains

198. *Id.* at 889.
199. *Golan*, 132 S. Ct. at 890 (footnotes omitted).
200. Eldred v. Ashcroft, 537 U.S. 186, 220 (2003).
201. *Id.* at 221.
202. *See Golan*, 132 S. Ct. at 891.

"vested rights," and that idea/expression and fair use are "no substitute for the unlimited use they enjoyed before § 514's enactment."[203] Justice Ginsburg disagreed and wrote that the public domain is not untouchable by Congress, and that the "vested rights" argument is "backwards."[204] This is where she went unnecessarily far:

> Rights typically vest at the *outset* of copyright protection, in an author or a rightholder. Once the term of protection ends, the works do not revest in any rightholder. Instead, the works simply lapse into the public domain. Anyone has free access to the public domain, but no one, after the copyright term has expired, acquires ownership rights in the once-protected works.[205]

Justice Ginsburg completely sidestepped the idea that the public has an interest in public domain works. She then noted that at times copyright law has expanded its scope of what is protected to works already in the public domain. "If Congress could grant protection to the works without hazarding heightened First Amendment scrutiny, then what free speech principle disarms it from protecting works prematurely cast in the public domain for reasons antithetical to the Berne Convention?"[206] What is interesting is that Justice Ginsburg in *Golan v. Holder* would use additional subject matter as an example of how Congress can expand copyright law, and for her, this did not require First Amendment scrutiny. But all of the examples that Justice Ginsburg gave had no retroactive protection. For instance, the inclusion of architectural buildings as copyrightable subject matter not only was not retroactive—it applied only to buildings created after the enactment of the amendment—but additional safeguards were also put in place. For example, a third party can take a photograph of a building without resulting infringement if the building can be seen from a public space. This fits into the framework Justice Ginsburg set up in *Golan v. Holder*. When new elements are added to the copyright system, one should make sure the system is still in balance, and that is done, I suggest, through a traditional contours analysis.

Justice Ginsburg belittled the petitioners' argument that fair use and idea/expression are very different than using an entire work, and that equity requires foreigners to not have their work available at "an artificially low (because royalty-free) cost."[207] She wrote that we have moved away from a "traditional contours" argument entirely: "By fully implementing Berne, Congress ensured that most works,

203. *Id.* at 892.
204. *Id.*
205. *Id.* (citations omitted).
206. *Id.*
207. *Id.* at 893.

whether foreign or domestic, would be governed by the same legal regime."[208] This is simply not true. Foreign works and domestic works of the same era are *now* treated dramatically different, for the same reason in some cases—failure to follow formalities.

3. *Traditional Contours Flowchart After* Golan v. Holder

Justice Ginsburg's opinion in *Golan v. Holder* is a disappointment because she did not actually engage in the discussion set out by the petitioners, the Tenth Circuit, or even the government. Her views focused on the Berne Convention, but without much depth, even ignoring in some instances the fact that the law actually does not implement the Berne Convention's requirements. The Berne Convention required that works be restored to the minimum term of life plus fifty.[209] The majority of works restored in the United States under § 104A were restored under the anti-Berne Convention (pro-Universal Copyright Convention) system based on the publication date, rather than the life of the author.[210] This restoration, then, is still in noncompliance with the Berne Convention, and the United States is still subject to a WTO dispute. The fears of noncompliance that Justice Ginsburg discussed are still very much alive. This seems careless. She should have addressed the problem in the opinion if she was going to rely and concentrate on the need to comply with Article 18 of the Berne Convention as the justification. It seems faulty reasoning to uphold a statute that did not actually fix the problem, but rather kept the United States in noncompliance.

What is most disturbing is her neglect and carelessness regarding traditional contours. Perhaps that was not intentional. She may not want traditional contours growing into a viable doctrine, and she seems to try to muffle it without the courage to kill it entirely. But she cannot let go of it—she uses it herself for justification. In that sense, "traditional contours," as she wrote in *Golan v. Holder*, or "traditional contours of copyright protection," as she wrote in *Eldred*, lives on.

Justice Ginsburg in 2012, however, was also significantly narrower. She first noted that copyright law has some restrictions on expression. These are §§ 102(a) and 106, presumably: what is copyrightable and the scope of the rights. In *Golan v. Holder*, she limited safeguards to §§ 102(b) and 107. Then she included "transitional measures from a national scheme to an international copyright scheme," the reliance

208. *Golan*, 132 S. Ct. at 893.

209. Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886, July 14, 1967, Art. 7.

210. 17 U.S.C. § 304 (2006).

party provisions in § 104A.[211] What is interesting is that the "transitional measures" in this case were for international adjustments, but Justice Ginsburg also discussed transitional measures for the CTEA, presumably the library exceptions. However, that leaves § 110(5), the homestyle exception, completely unaccounted for. Transitional measures are meant to protect First Amendment interests when the new amendment comes into effect.[212]

In charting her opinion, we see a dramatic change in structure. Now, the focus is the First Amendment itself, rather than traditional contours, with the first step being restriction on expression as embodied in §§ 102(a) (copyrightable subject matter) and 106 (exclusive rights) of the 1976 Act. We then look to the safeguards of the system, namely traditional contours of idea/expression and fair use on the one hand and transitional measures on the other. It is a tool that focuses only on applying the questions to a particular part of the system—the issue at hand. Traditional contours does not account for the whole system, as it did in *Eldred*. It focused on the First Amendment requirements that copyright must meet, while in *Eldred* it had been a self-contained system that only looked outward to the First Amendment when the system itself had encountered significant deviation from expected norms.

Justice Ginsburg in 2012 had a very different scheme in mind indeed. She reoriented what is needed to protect First Amendment interests, while her *Eldred* opinion seemed to focus on identifying traditional contours itself.

4. *Justice Breyer's Dissent: Traditional Contours Versus "Text, History, and Precedent"*

The dissent, written by Justice Breyer, did not directly discuss traditional contours. However, he once again employed the phrase, "text, history, and precedent,"[213] the exact phrase used in his *Bilski v. Kappas* concurrence.[214] He also asserted, "By removing material from the public domain, the statute, in literal terms, 'abridges' a preexisting freedom to speak," an argument discussed in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*[215] It will be interesting to see if

211. *Golan*, 132 S. Ct. at 891.

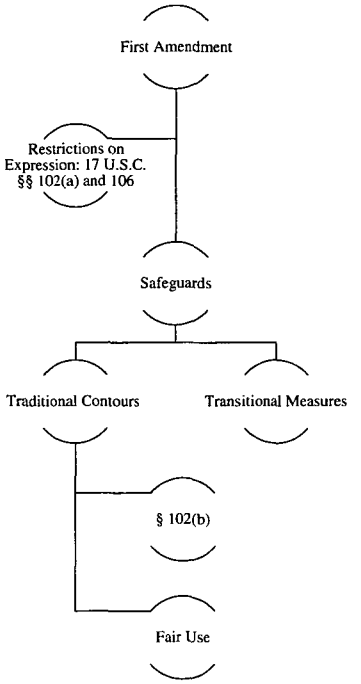
212. *Id.*

213. *Id.* at 903 (Breyer, J., dissenting).

214. *See* Bilski v. Kappos, 130 S. Ct. 3218, 3257 (2010).

215. *Golan*, 132 S. Ct. at 907. *See generally* Elizabeth Townsend Gard, Golan *and* Prometheus *as Misfit First Amendment Cases?*, *in* CATO SUPREME COURT REVIEW 2011–2012, at 359 (2012), *available at* http://www.cato.org/sites/cato.org/files/serials/files/supreme-court-review/2012/9/scr-2012-gard.pdf.

FIGURE 10: JUSTICE GINSBURG'S *GOLAN V. HOLDER* ANALYSIS OF TRADITIONAL CONTOURS



courts in future years will pick up on this line of thinking—the "freedom to speak" and the "freedom to think." It appears that increased property rights in patents and copyrights put these questions at the forefront.

5. *Evaluating Justice Ginsburg*

At the moment, some believe "traditional contours" as a concept is dead on arrival. But let's see if we can understand what happened with Justice Ginsburg. I would suggest that one could read *Golan v. Holder* as the clash between traditional contours of U.S. law and the introduction of a different set of traditional contours from the Berne Convention. The question becomes what is going to give. I think there is less of a clash than Justice Ginsburg's opinion suggests, and she did not have to dramatically alter the traditional contours of copyright protection within the U.S. system to achieve compliance internationally.

First, Justice Ginsburg could have limited the opinion to the actual requirements of Article 18. Restoration under Article 18 is designed to be a "one-time" compliance adjustment and not the notion that

works can come and go in the public domain.[216] She could have written that the traditional contours of copyright protection must adjust to the pressures of joining an international treaty long in progress.

Second, she could have analyzed § 104A itself. Did it achieve the proposed goals? It did not. We are still *not* in compliance with Article 18 of the Berne Convention, nor are we in compliance with in-copyright works (not restored) from foreign authors. We are still figuring out the term on a publication date-based system for pre-1978 works, and this violates the Berne Convention for foreign works. We should have transitioned *all* foreign works to a life system upon joining Berne. I think this is the most disappointing aspect of the opinion. Justice Ginsburg championed the Berne Convention, and yet § 104A does not bring the United States into compliance.

So, where does "traditional contours of copyright protection" stand after *Golan v. Holder*? In a footnote, Justice Ginsburg told us that the Tenth Circuit did not get it right, but we do not get any further guidance.[217] We see her try to narrow traditional contours to idea/expression and fair use, but she also acknowledges additional safeguards or transitional measures that contribute to the decision that a First Amendment analysis is not necessary. I would suggest that Justice Ginsburg in 2003 and Justice Ginsburg in 2012 could be read as the following: *Eldred* looks at the internal workings of a domestic system with a long tradition of expansion of the duration of copyright law. *Golan v. Holder*, in contrast, is looking to bridge the gap between U.S. visions of copyright law and the requirements of joining the international community in the form of the Berne Convention. It is a clash, in some ways, of the traditional contours of two different systems, one based on the civil law and the other on common law principles. She struggled with this transition, and perhaps this is why she began the opinion with a discussion of the Berne Convention. Traditional contours, ironically, might have helped her explain the transitions, and why, in this case, removal was an exception to the ordinary, rather than making statements that destabilize the public domain in general.

6. *What Justice Ginsburg Could Have Done While Reaching the Same Conclusion*

Justice Ginsburg could have found that § 104A did not meet our treaty requirements because it did not actually institute the minimum standards required by the Berne Convention. This would have

216. Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886, July 14, 1967, Art. 18.

217. *See Golan*, 132 S. Ct. at 890 n.29.

demonstrated the integrity of the argument. She could have also suggested that § 104A, like other instances of restoration, was a specific act to correct errors, without commenting on the nature of the public domain. Her argument undermines any idea of stability in the public domain without gaining much in return. Justice Ginsburg could have continued to structure traditional contours in the same manner as *Eldred* without refocusing and restricting the term. The new structure contradicts *Eldred* without providing additional usefulness. Only if idea/expression or fair use are somehow impeded would traditional contours even potentially come into play. The opinion takes what could have been a very useful doctrine in sorting out new technologies and global questions, and restricts its usefulness almost entirely. For someone who has studied traditional contours for a long time, this was the most disappointing and unnecessary part of the opinion.

V. BEYOND JUSTICE GINSBURG: PLAYING WITH TRADITIONAL CONTOURS IN FUNCTION, PRINCIPLES, AND HISTORY

The first half of this Article conducted a close reading of the major cases associated with traditional contours. The second half is more *playful*, imagining what traditional contours could have been, or might be one day. With Justice Ginsburg's latest opinion, we saw a narrowing and reorientation of traditional contours. We also saw that the battle for history was fought over the interpretation of what happened in three instances: the enactment of the 1907 Act, private bills for copyright and patent, and the wartime amendments. I think this is a rather narrow vision of what traditional contours entails. This Part reimagines the possibilities of what traditional contours could have been, first reviewing how scholars interpreted and used the term before *Golan v. Holder*, and then further theorizing traditional contours beyond its roots.

A. Evaluating and Applying Traditional Contours

Before *Golan v. Holder*, some scholars started to see the application of or need for traditional contours of copyright protection language in the context of specific problems in copyright law. This Part provides examples of approaches to the question of traditional contours from slightly differently views, suggesting both its flexibility and the difficulty in pinning down a common understanding. Below are four examples of the use of traditional contours.

The most ambitious article regarding traditional contours was Professor Christopher Sprigman's piece in the *Stanford Law Review*, *Reform(aliz)ing Copyright*, in which he argued that formalities

constructed a key element of the copyright system, and by doing away with formalities for works published between 1964 and 1978 the system dramatically altered the traditional contours.[218] The move from a conditional to unconditional system deeply upset the balance.[219] Sprigman's article suggested a way to reincorporate formalities into the system back to one that includes formalities without running into problems with the Berne Convention.[220] Sprigman's approach to traditional contours is particularly interesting in that he critiqued the *whole* copyright system and the effect of the removal of a part of the system in its imbalance.[221] In many ways, Sprigman argued for evaluating changes by looking to the system as a whole. In the end, this Article argues for just such an evaluation, and that *Eldred* was signaling us to conduct such evaluations. Sprigman was one of the first scholars to take the call seriously, and his work stands as an example of evaluating change in the context of traditional contours of the system.

In 2007, Robert Kasunic described a judicial system operated by traditional contours. Along the way, he identified an additional principle, something that was not contemplated or discussed within the *Golan* litigation: "lawful access."[222] Kasunic addressed the question of what courts should do when Congress alters the traditional contours of copyright protection.[223] First, he identified elements of traditional contours, namely "judicially created safeguards" that may eventually become statutory, as in the case of fair use or the idea/expression dichotomy.[224] He noted that, "although Congress has full authority to create the law, the contours of the law or the limits of the law have been shaped by the courts in ways that avoid conflict with

218. *See* Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485, 538 (2004).

219. *See id.* at 489–90 ("In such circumstances copyright is radically unbalanced . . . .").

220. *See id.* at 546–47.

221. *See id.* at 568.

222. *See* Robert Kasunic, *Preserving the Traditional Contours of Copyright*, 30 COLUM. J.L. & ARTS 397, 407 (2007) ("Lawful access to a work is generally a condition precedent to lawful *use* of the expression.").

223. *See Copyright and Freedom of Expression*, 30 COLUM. J.L. & ARTS 319, 319 (2007) (remarks of Robert Kasunic) ("Essentially, I read the *Eldred* opinion to stand for two propositions regarding the First Amendment. First, the internal First Amendment safeguards of copyright law, the idea/expression dichotomy and the fair use doctrine prevent First Amendment conflicts. In terms of judicial surprises, this is not really news, but what is surprising is the second proposition in *Eldred*: that this could change, that the traditional contours could be altered. And in my talk today, I'm going to focus on the second proposition. In particular, how might the traditional contours of copyright change, and what would happen if Congress altered the traditional contours? In other words, what should courts do?").

224. *See id.* at 320.

the First Amendment."[225] This was straight *Eldred*. He believed that a court has a number of options in any case in which Congress has altered traditional contours. A court could look to see if Congress created First Amendment safeguard mechanisms.[226] If no safeguards were found, the court "could seek to construe the statute in a manner that would avoid the result the statute appears to demand" in order to comply with First Amendment safeguards.[227]

I think this is close to what Justice Ginsburg did in her 2012 interpretation of traditional contours. A court could also apply heightened First Amendment scrutiny (which is what the *Golan* remanded district court did). Courts could also create equitable limiting principles, as they have with fair use and idea/expression. Kasunic surely agrees.[228] He noted that courts might want to look at equitable approaches not only from the owner's perspective, but also the user's perspective. "Courts would be free to fashion factors to address the problems that they come across and find ways to balance the needs of a user with legitimate interests of copyright owners on a case-by-case basis."[229]

Kasunic then turned to an example. Interestingly, he identified a principle at play that interacts with the question of traditional contours—"lawful access" within the copyright system. He referred to section 12 of the 1976 Act, the Digital Millennium Copyright Act: "In particular factual situations, § 1201 could have the capacity to disrupt the traditional contours of copyright law," in part, because fair use and other non-infringing uses may be precluded in the inability to circumvent technology.[230] But Kasunic suggested that the *principle of lawful access* has always been part of the traditional contours of copyright, and § 1201 is no different. So, here we see an addition to concepts associated with traditional contours: lawful access. The question then becomes whether there are instances in which unlawful access

225. *Id.*

226. *See id.* at 321.

227. *Id.*

228. *Id.* at 322 ("I believe nothing stands in the way [of a new limiting doctrine], and I believe this would be an optimal approach.").

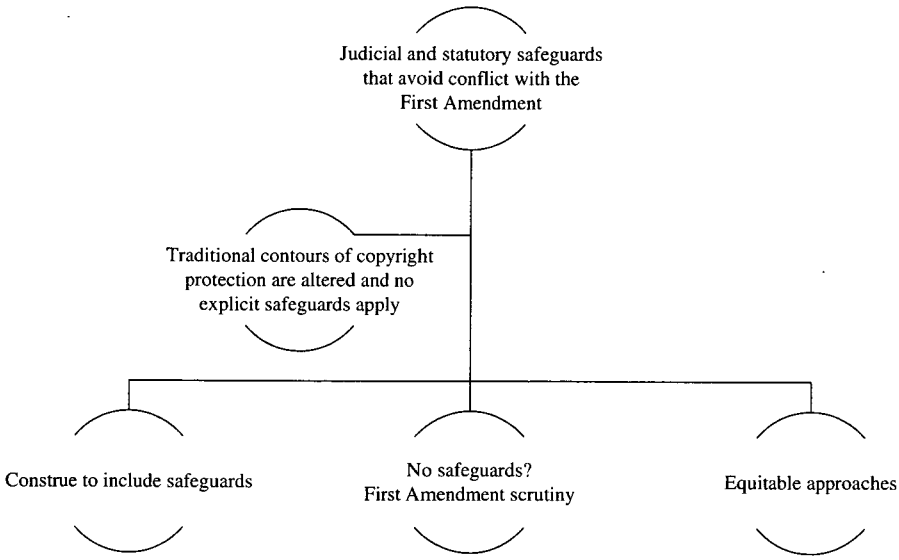
229. *Copyright and Freedom of Expression*, *supra* note 223, at 323. His analysis focused on how traditional contours can be used to protect First Amendment rights. Kasunic explicitly believed that "traditional contours" should extend beyond a historical analysis:

> If you look at that language, that one phrase within that opinion, it comes after many pages that are dealing with two free speech safeguards, fair use and the idea/expression dichotomy. I think that it was a mistake even to use that term "traditional," because now we are looking at "traditional" in terms of historical changes, and that is just not the right approach.

Hugh C. Hansen, Moderator, *Panel II: The Death or Rebirth of the Copyright?*, 18 FORDHAM INTELL. PROP., MEDIA & ENT. L.J. 1095, 1134 (2008) (remarks of Robert Kasunic).

230. Kasunic, *supra* note 222, at 406.

FIGURE 11: KASUNIC'S VERSION OF TRADITIONAL CONTOURS



under § 1201 would be necessary. "It is, in fact, relatively difficult to create a hypothetical in which § 1201 alters the traditional contours, and few factual situations have arisen that actually implicate real First Amendment concerns."[231] But he suggested another scenario of a whistleblower, in which circumventing technology is necessary to gain access to documents. In this case, idea/expression and fair use would be stifled, raising the possibility of a First Amendment violation.[232] Kasunic's reading of traditional contours has two components: (1) safeguards within the system to evaluate (2) a basic principle.

Alfred Yen, on the other hand, focused on a particular principle and argued that the expansion of the system triggered a need for traditional contours analysis. In particular, Yen discussed traditional contours in the context of expanding copyright to news aggregation: "[L]egislation that treats news aggregation as copyright infringement changes the traditional contours of copyright in ways that expose copyright to serious First Amendment scrutiny."[233] Here, a new technology is disrupting old expectations in a dying news industry. Aggregators pull headlines and the first sentence or two of a story from news sources to create new sites for readers, and so readers see ads at the aggregators' sites rather than at the site of the original news

231. *Id.* at 407.

232. *Id.* at 406.

233. Alfred C. Yen, *A Preliminary First Amendment Analysis of Legislation Treating News Aggregation as Copyright Infringement*, 12 VAND. J. ENT. & TECH. L. 947, 947 (2010).

source. The Huffington Post is one example of a news aggregator. Congress could use copyright law to stop such activity. Yen saw the application of the First Amendment as a critical step, and his analysis provided an example of how traditional contours can assist in sorting through new technologies, old and new interests, speech interests, and copyright law.

As scholars and courts before, Yen returned to *Eldred* as a starting point for traditional contours. Noting that the Court saw idea/expression and fair use as limits on restricting speech, Yen wrote, "This did not mean, however, that Congress had complete freedom to rewrite copyright as it pleased. To the contrary, copyright legislation could escape more searching First Amendment scrutiny only if 'Congress has not altered the traditional contours of copyright protection.'"[234] His interpretation of traditional contours is a balancing test, in which the need of further incentivization is the focus. If Congress weakened or eliminated idea/expression, for example, "courts should apply elevated scrutiny to such a change in copyright's traditional contours in order to make sure that copyright's incentives still justify its restrictions on speech."[235] Yen explained,

> Brief reflection reveals further traditional contours that Congress should not be able to alter without exposing copyright to elevated scrutiny. Weakening or eliminating fair use would restrict speech in ways that the *Eldred* Court considered important to the copyright/First Amendment balance. Additionally, extending copyright protection to unoriginal material would have an effect similar to the elimination or weakening of the idea/expression dichotomy. People presently have the freedom to use unoriginal material in the same manner as ideas because both are in the public domain. Extending copyright protection to unoriginal material would therefore burden speech just as eliminating or weakening the idea/expression dichotomy would. Finally, consider what would happen if Congress began adding entirely new substantive rights to copyright. Each of those new rights would prohibit free uses of works that people presently enjoy, uses that would otherwise be considered free speech.[236]

Because aggregator-control legislation would introduce new subject matter, First Amendment scrutiny would be required.[237] Under traditional contours, then, a court would be required to "make sure that copyright's encouragement of speech outweighs its suppression of

234. *Id.* at 963 (citing Eldred v. Ashcroft, 537 U.S. 186, 221 (2003)).

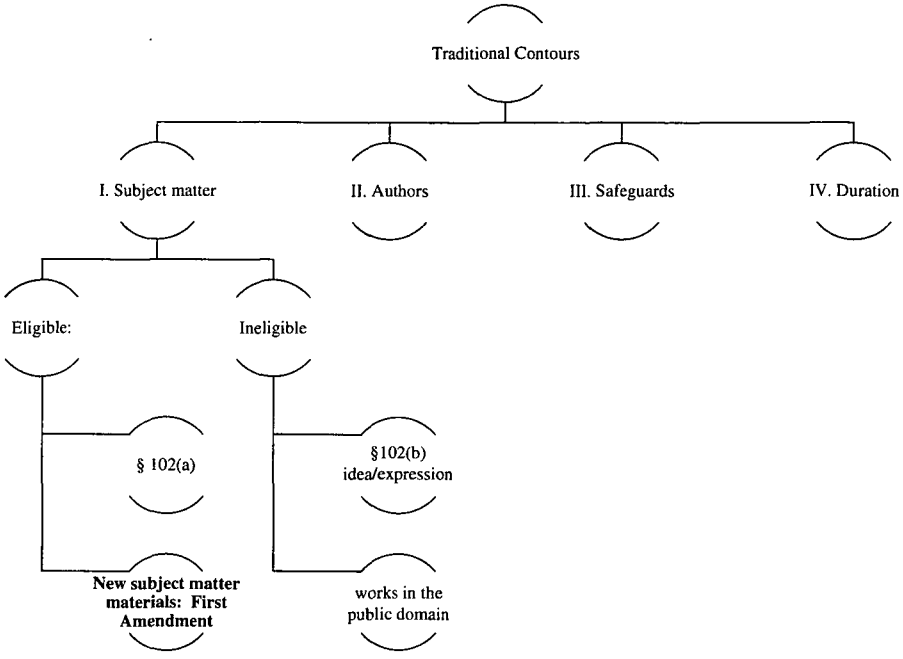
235. *Id.*

236. *Id.* at 963–64.

237. *See id.* at 964. "Making newspaper headlines and lead sentences copyrightable subject matter would push copyright beyond the boundaries that the idea/expression dichotomy and originality set." *Id.*

speech."[238] This would have been true for architectural works as well, which were added as a copyrightable subject in 1990.[239] Yen's analysis fits within Justice Ginsburg's original *Eldred* construction (naturally, as *Golan v. Holder* was decided after his piece).

FIGURE 12: YEN'S TRADITIONAL CONTOURS



Here, Yen suggested that when subject matter categories are expanded, traditional contours are altered.[240] Interestingly, however, Justice Ginsburg used expansion of subject matter as an example of an area in which traditional contours are not affected. But she also incorrectly stated that new subject matter is retroactively included. The addition of architecture and sound recordings as protectable subject matter had no such retroactive protection and, in fact, each explicitly only included works created after its enactment.[241] Yen suggested that new categories, like added protections for newspapers against news aggregation, would require a First Amendment review because

238. *Id.*

239. Architectural Works Copyright Protection Act, Pub L. No. 101-650, 104 Stat. 5089, 5133 (1990).

240. Yen, *supra* note 233, at 964.

241. Act of Oct. 15, 1971, Pub. L. No. 92-140, 85 Stat. 391; Architectural Works Copyright Protection Act, Pub L. No. 101-650, 104 Stat. 5089, 5133 (1990).

the expansion of subject matter would trigger the alteration of traditional contours.[242]

Another example of the use of traditional contours is seen in the work of Jessica Litman, who discussed traditional contours in relation to her work on personal uses.[243] In *Real Copyright Reform*, Litman referenced "traditional contours of copyright protection" in her discussion of what true copyright reform might look like, particularly in the face of a user-generated generation, and noted that the general public might for the first time have a personal stake in copyright law.[244] In her discussion of "reader empowerment," she analyzed the relationship between the First Amendment and copyright law:

> Copyright laws regulate expression more directly than most laws that routinely undergo First Amendment review. The key to the paradox is that copyright laws have traditionally encouraged expression while preserving the liberty to read, listen, and view the expression copyright protects. The importance of reading, listening, and viewing is a vital reason that copyright laws get special treatment. The freedom to read, listen, and view are essential attributes of human freedom, so much so that we take them for granted. They are inextricable from the freedom to think. The liberties to read, listen, and view are crucial foundational liberties on which all copyright systems are built. Without those liberties, no copyright system makes any sense.[245]

Litman identified a principle in traditional contours different from those described by *Golan v. Holder*. She identified "white spaces," which she described as

> part of the traditional contours the Supreme Court mentioned in *Eldred*—they advance copyright's goals and the First Amendment by securing liberty to read, listen, look at, and think. In *Lawful Personal Use*, I called these reader, listener, and viewer rights "copyright liberties." They have been embedded in the fabric of U.S. copyright law since its early history and are essential to its design.[246]

Here we see the development of a principle—an underlying concept that was traditionally thought of as functionally essential. Under a traditional contours rubric, then, a law that abridged that principle would come under First Amendment scrutiny. Under a *Golan v. Holder* reading, I suggest, one would have to ask: does idea/expression or fair use allow for the "white spaces" traditionally allowed for the right to read, listen, and view a copyrighted work, and, if a new

242. Yen, *supra* note 233, at 970–71.

243. *See* Jessica Litman, *Real Copyright Reform*, 96 IOWA L. REV. 1 (2010).

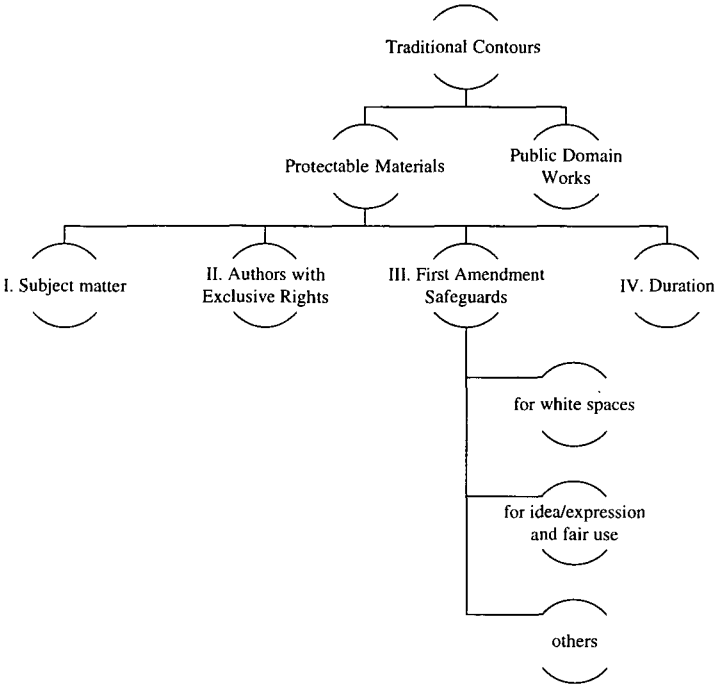
244. *See id.* at 6–7.

245. *Id.* at 37–38.

246. *Id.*

amendment is enacted, what additional safeguards or transitional elements are included?

FIGURE 13: LITMAN'S TRADITIONAL CONTOURS



All of these scholars are well respected in their fields, saw the possibility of how traditional contours could be used, and applied traditional contours in a different context. I suggest that the concept of traditional contours—placing something new within the context of a larger historical and functional system and making sure that whatever is new does not impede on First Amendment rights—has many applications and possibilities.[247]

247. There are other scholars who studied the application of traditional contours. For example, the traditional contours argument has been contemplated in at least two instances related to moral rights. In a student comment, Matt Williams applied traditional contours to the Visual Artists Rights Act of 1990 (VARA), calling for heightened First Amendment scrutiny because requiring attribution parallels the "must-carry" provisions of cable companies seen in *Turner Broadcast*, which were found unconstitutional because they compelled speech. *See* Matt Williams, Comment, *Balancing Free Speech Interests: The Traditional Contours of Copyright Protection and the Visual Artists' Rights Act*, 13 UCLA ENT. L. REV. 105, 107 (2005). Arlen W. Langvardt and Tara E. Langvardt suggested that the recent *Salinger* preliminary injunction case stems from a moral-rights-like argument that he should be able to control all aspects of his characters, more than merely a derivative-work right.

> In this sense, Salinger went beyond what copyright law normally contemplates even in its recognition that copyright owners may choose not to prepare derivative works and

B. *Theorizing Traditional Contours*

This Part seeks to further theorize and tease out traditional contours as a useful tool. To do this, I propose a few steps. First, this Part takes a deeper look at what "traditional" might encompass by using my previous work with W.R. Gard, as well as looking to patent law. Second, this Part expands to include other theories on copyright to see how this additional work can add to the concept and framework of traditional contours, particularly in defining the underlying "principles" of traditional contours. I seek not one cohesive way to interpret traditional contours, but suggest many exciting and useful ways of understanding not merely the phrase, but the very system of copyright itself.

1. *Tradition and History in Patent Law*

The Tenth Circuit suggested that traditional contours had two components: historical (traditional) and functional (contours). In our previous work, W.R. Gard and I discussed the need to more fully define history and function.[248] History can be defined in a narrow sense to encompass a reading of the Constitution, Framer's intent, and precedent. It can be defined as encompassing a long view of hundreds of years of history, or a short view of the past thirty years. For the Gards, the evaluation of copyright history includes both a long view of history (beginning before the Statute of Anne for larger principles) and a more modernist history influenced by the change in capitalism (beginning with the turn of the twentieth century).[249] Defining history becomes key because, when conducting a traditional contours test, each person is free to determine those boundaries. But the beauty of traditional contours is that the court stops to analyze what traditionally has been done in the field, and does not merely adopt long-established principles without careful review. This leads to more thoughtful approaches to new problems and does away with elements in the system that are found unnecessary as circumstances change. In many ways, one does not become blindly beholden to history, but

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may decline others' requests for such a license. Salinger's apparent focus on preserving the integrity of *Catcher* and the Caulfield character suggests a moral-rights-like objective for the requested preliminary injunction. Moral rights, however, have not been part of the "traditional contours" of U.S. copyright law.

Arlen W. Langvardt & Tara E. Langvardt, *Caught in the Copyright Rye: Freeing First Amendment Interests from the Constraints of the Traditional View*, 2 HARV. J. SPORTS & ENT. L. 99, 138 (2011).

248. *See* Gard & Townsend Gard, *Marked by Modernism*, *supra* note 6, at 157–58.

249. *See id.*

more aware of its place. In other ways, one recognizes the need for the continuity and stability that history provides.

Take, for instance, recent work in patent law—in particular, patentable subject matter. In many ways, the current battle for what should be patent eligible is a battle of interpretation of history. Are we to view patent-eligible subject matter as a continuing line of eligible versus non-patentable subject matter, with case law supporting such a view? Justice Breyer adopted this view in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*[250] Is it a discussion of recent history, of the overexpansion of eligible subject matter, beginning with *Diamond v. Chakrabarty*[251] and culminating in the Federal Circuit's *State Street Bank & Trust Co. v. Signature Finance Group, Inc.* decision?[252] The concurrence in *Bilski* seemed to take this view.[253] Are we to see the last forty years as a mistake, as Menell suggested in a recent article?[254]

A further look into the debate in patent law may be constructive. Five pieces in particular seem to be trying to sort out the traditional contours of patentable subject matter, without using that language, of course. Each piece is trying to sort out the recent *Bilski* decision, a patentable subject matter case. For our purposes, *Bilski* asked whether the machine-or-transformation standard was required to be met to have patentable subject matter.[255] Justice Kennedy found machine-or-transformation to be a good measure, but not the only test, leaving open the possibility of using other mechanisms to determine patent-eligible subject matter.[256]

Life After Bilski, authored by Mark A. Lemley, Michael Risch, Ted Sichelman, and R. Polk Wagner for a Stanford Law Review Symposium on *Bilski*, exemplifies a traditional contours framework in its purest form. The article begins by identifying the problem: boundaries. It suggests that patentable subject matter serves the *functional* purpose of an overclaiming test:

> [W]e suggest a new way to understand the exclusion of abstract ideas from patentable subject matter. No class of invention is inherently too abstract for patenting. Rather, the rule against patenting abstract ideas is best understood as an effort to prevent inventors from claiming their ideas too broadly. By requiring that patent

250. *See* Mayo Collaborative Servs. v. Prometheus Labs., Inc., 132 S. Ct. 1289, 1293 (2012).
251. Diamond v. Chakrabarty, 447 U.S. 303 (1980).
252. State St. Bank & Trust Co. v. Signature Fin. Grp. Inc., 149 F.3d 1368 (Fed. Cir. 1998).
253. *See* Bilski v. Kappos, 130 S. Ct. 3218, 3258 (2010) (Breyer, J., concurring).
254. *See infra* notes 277–83 and accompanying text.
255. *See Bilski*, 130 S. Ct. at 3223.
256. *See id.* at 3226–27.

> claims be limited to a specific set of practical applications of an idea, the abstract ideas doctrine both makes the scope of the resulting patent clearer and leaves room for subsequent inventors to improve upon—and patent new applications of—the same basic principle.[257]

Justice Breyer adopted this view in *Prometheus* and, again, it fits within a traditional contours framework, as established by Justice Ginsburg: intellectual property requires spaces untouched by privatization in order to fulfill its mission.

What is most interesting about that article is its framing of history. The authors' analysis of history begins in the 1970s.[258] This is a short view of history, tracing the development of patenting software as the crux of the machine-or-transformation test ultimately adopted in *Bilski* in the Federal Circuit.[259] They traced the erosion of the "requirement that a software invention be tied to a particular machine" through *State Street* in 1998.[260] They saw patentable subject matter after *State Street* as "effectively a dead letter," until the *Bilski* en banc Federal Circuit decision.[261]

In the aftermath of *Bilski*, these authors noted that two elements of patentable subject matter had survived: that the inventor must fit within the § 101 categories of patentability[262] and not fall into any one of the three judge-made exceptions.[263] They wrote, "*Bilski* makes clear that while the Supreme Court has no intention of abandoning these old exceptions, neither does it intend to provide further guidance. Perhaps even worse, the guidance we have from the machine-or-transformation test isn't helping. *A principled theory is needed.*"[264] They began with prior theories of patentable subject matter. "The traditional way academics think about patentable subject matter is as a gatekeeper: a means of excluding certain types of inventions entirely

257. Mark A. Lemley, Michael Risch, Ted Sichelman & R. Polk Wagner, *Life After* Bilski, 63 STAN. L. REV. 1315, 1317 (2011).

258. *See id.*

259. *See In re* Bilski, 545 F.3d 943, 962 (Fed. Cir. 2008).

260. Lemley et al., *supra* note 257, at 1317–18.

261. *Id.* at 1318. After *Bilski*, courts continue to mostly rely on the "machine-or-transformation" test, although they found that *Research Corp. Technologies v. Microsoft Corp.*, a Federal Circuit case, had not done so. These authors found the machine-or-transformation test functionally problematic. They felt it was filled with ambiguities, including whether it applied only to processes, or whether a general purpose computer qualified as a "specific machine." They also found that it led to restrictive, overinclusive, and bizarre results, and gave examples of each. After reviewing its flaws as a functional doctrine, the authors turned to the theory of patentable subject matter. *Id.* at 1323–25.

262. 35 U.S.C. § 101 (2006).

263. *See* Lemley et al., *supra* note 257, at 1325. The three judge-made exceptions are abstract ideas, laws of nature, and natural phenomena. *Id.*

264. *Id.* at 1326 (emphasis added).

from the scope of patent protection."[265] The authors believe this has proved "unsatisfactory" because such an approach leads to bright-line rules. We see tradition re-evaluated, which is exactly what should happen with a traditional contours test. We see the authors address the underlying value—the real traditional contour: "The core mission of patent law is to create incentives for the production, disclosure, and commercialization of socially valuable inventions. The flexibility of any subject matter requirement is paramount given the rapidly changing nature of technology."[266] The authors considered the theory—the contours—of why patentable subject matter is necessary: the tension between the individual and society.

> Understood in this way, the abstract ideas doctrine is not about finding a conceptual category of inventions that is entitled to no protection at all, nor about determining the quality of the disclosure. Instead, it is about encouraging cumulative innovation and furthering societal norms regarding access to knowledge by preventing patentees from claiming broad ownership over fields of exploration rather than specific applications of those fields. Boiling these principles down to a practical test is a more difficult task. The abstract ideas exception should disallow those claims to ideas unmoored to real-world applications, taking into account the extent to which the claim forecloses after-arising embodiments of the idea, the nature and extent of the prior art, and the level of disclosure by the inventor.[267]

To my mind, this is what an analysis of traditional contours, whether by scholars or the courts, should encompass: stepping back and evaluating the system as a whole, not merely the issue at hand.[268]

Another article, by Pamela Samuelson and Jason Schultz, also written in the aftermath of *Bilski*, but before *Prometheus*, searched for "clues" from Kennedy's opinion in *Bilski* to develop a framework for a jurisprudence of abstractness.[269] Bright-line tests do not work, according to the Supreme Court. Is the "clues" approach another way of describing traditional contours? The "clues" that they identify are

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265. *Id.*

266. *Id.*

267. *Id.* at 1329.

268. Lemley and his colleagues also looked to the historical context for the theory they espoused. Again, this seems like a traditional contours approach to the problem. First, they looked at "historic cases" and modern cases to "illustrate how excluding abstract ideas limits claim scope" in support of their idea that patentable subject matter should take an overclaiming approach. *Id.* at 1332. Looking at the historical (including modern history) and functional approaches to patentable subject matter led them to suggest a new test. This is how traditional contours should work—it should help to sort through key elements and lead to new results.

269. *See generally* Pamela Samuelson & Jason Schultz, *"Clues" for Determining Whether Business and Service Innovations Are Unpatentable Abstract Ideas*, 15 LEWIS & CLARK L. REV. 109 (2011).

(1) case law, particularly Supreme Court jurisprudence;[270] (2) the Constitution;[271] and (3) the history and structure of the Patent Act.[272] These clues look like traditional contours—at least the primary sources for traditional contours.

Also written in the wake of *Bilski* was Joshua Sarnoff's work on the history and theory of patent-eligible subject matter. Sarnoff believed in patentable subject matter, even though it finds itself in a bit of an identity crisis. In *Patent-Eligible Inventions After* Bilski*: History and Theory*, he "supplies a history and theory of subject matter eligibility to guide" what he sees as the necessary "line drawing."[273] The key for him was the idea that the "Patent Act [for both eligibility and patentability] has always required, and still requires, creative, human invention *in the application* of such categorically excluded discoveries."[274] Interestingly, Sarnoff set out to place the current questions regarding line drawing within a historical and theoretical context. Although he did not call it "traditional contours," it looks very much like the "historical and functional" categories from the Tenth Circuit's decision in *Golan v. Gonzales*. He wanted to put into context why patentable subject matter is necessary, and then provide a workable framework so that decisions made in different areas, such as genetics, business methods, and the like are consistent and made with a solid rationale. This is the essence of why traditional contours may provide usefulness in creating tests, evaluating new laws, and sorting through difficult questions.

Michael Risch has written a good deal regarding patentable subject matter. In *Everything Is Patentable*, he argued that patentable subject matter is an unnecessary part of patent law, as courts generally rely on other elements of the patent process to reject a patent, and not solely on patentable subject matter.[275] When revisiting this article, I wondered whether he was making that claim within a traditional contours framework. The answer was a resounding yes! He conducted a historical analysis of the case law and then offered his functional reasoning for why patentable subject matter is unnecessary. Risch's conclusion is particularly telling:

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270. *Id.* at 112–15.

271. *Id.* at 115–17.

272. *Id.* at 117–19.

273. Joshua D. Sarnoff, *Patent-Eligible Inventions After* Bilski*: History and Theory*, 63 HASTINGS L.J. 53, 53 (2012).

274. *Id.* (emphasis added).

275. *See* Michael Risch, *Everything Is Patentable*, 75 TENN. L. REV. 591, 598 (2008) ("Virtually all of the important historical patentable subject matter cases may be explained by applying each of the other requirements for patentability.").

> Abandoning judicial subject matter restrictions will not answer all of the difficult patentability questions that have arisen and may yet arise as our nation's inventors and researchers continue to discover new technologies. Those difficult questions, however, should be answered by the general criteria that Congress has established—criteria that have worked for over 150 years—to determine whether a particular patent claim should be allowed.
>
> The exact contour of the trade-offs between innovation and patent protection are largely unknown. Therefore, the PTO and courts should focus on answering specific questions about how to best apply rigorous standards of novelty, nonobviousness, utility, and specification with a scalpel rather than simply eliminating broad swaths of innovation with a machete.[276]

He analyzed the case law and stated that the function of patentable subject matter actually was not what most thought. He suggested scrapping it altogether and relying on the other four elements of patentability. There was both a historical (although it rejected history) and functional aspect to his argument.

Finally, Peter Menell offers a different definition of history. Menell contextualized the *Bilski* decision as a hoped-for opportunity for clarifying the boundaries of patentable subject matter.[277] He pinpointed the "turn" into wandering with *Diamond v. Diehr* and *Chakrabarty*.[278] He wrote:

> The past forty years of patentable subject matter jurisprudence harkens back to the Israelites wandering through the wilderness following the exodus from Egypt. But unlike Moses's leadership, which brought the Israelites to the Promised Land by year forty, the Supreme Court's *Bilski* decision has left the patent community in the wilderness.[279]

So, how would he proceed? He engaged in a historical discussion of patentable subject matter, followed by a functional discussion. He did not call it "traditional contours," but that is exactly what it is, as evidenced by the language he uses to describe his conclusion: "Part IV

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276. *Id.* at 657–58.

277. *See* Peter S. Menell, *Forty Years of Wandering in the Wilderness and No Closer to the Promised Land:* Bilski*'s Superficial Textualism and the Missed Opportunity to Return Patent Law to Its Technology Mooring*, 63 STAN. L. REV. 1289 (2011).

278. Peter Menell explained the "turn" quote as follows:

> *Diehr* reversed course and opened the software patent floodgates. The Patent and Trademark Office (PTO), Federal Circuit, lower courts, and patent community have struggled mightily since that time to make sense of those decisions.
>
> . . . The Supreme Court's *Chakrabarty* decision approved the patentability of non-naturally occurring, genetically altered microorganisms, but the Court has yet to confront the patentability of human-isolated, naturally occurring DNA molecules and medical diagnostic tests.

Id. at 1291 (footnotes omitted).

279. *Id.* (footnotes omitted).

points the way toward a coherent, historically faithful, dynamic, and pragmatic framework for delineating the boundaries of patentable subject matter."[280] His reading of history views the last forty years as a period of mistakes beginning with *Diehr*.[281]

Menell's solution also looks like traditional contours:

> The proper interpretive path for patentable subject matter—from constitutional, jurisprudential, and pragmatic standpoints—requires courts to integrate the constitutional and jurisprudential traditions surrounding patentable subject matter with statutory construction principles and forthright recognition of the challenges of applying historic doctrines to unforeseeable technological developments. This can be done only by understanding the historical context for the various provisions and doctrines of patent law.[282]

He further wrote:

> Since the founding of our nation, courts have evolved these doctrines within a hybrid constitutional/common law tradition. . . . By failing to explicate the framework for delineating the scope of patentable subject matter or its contours, the Court shirked its larger constitutional responsibility, thereby contributing to a pathological political dynamic that undermines the patent system.[283]

Patent law, in particular the struggle surrounding patentable subject matter, helps to clarify the same struggles occurring in copyright law: boundaries, changing functionality, and the interpretation of history. These are the issues that traditional contours brings to the forefront of the conversation. Do we need the label to have the conversation? Of course not. The discussion regarding patentable subject matter demonstrates that the concerns of traditional contours is being debated without the use of the term. I would suggest, however, that a more transparent and structured discussion—a traditional contours discussion—would make the reading and discourse about the issues at hand more of a dialogue. A court, a practitioner, or a scholar would address the traditional contours of the particular area of law, and how the times, technology, or new amendment alters our previous expectations. We would see continuity and change in comparable form. We would discuss the underlying principles of a system, the "clues," and the history. We would battle for a particular traditional contour.

Bilski illustrates the struggle with how to define history, and, in doing so, where the boundaries of patentable subject matter might stand. *Bilksi* could be read as an *Eldred* version of traditional contours, as

280. *Id.* at 1292.
281. *Id.* at 1307–08.
282. *Id.* at 1308 (footnotes omitted).
283. Menell, *supra* note 277, at 1307–08.

Justice Kennedy struggled to understand the role of new technologies within the larger tradition of patentable subject matter. We also see this struggle in the scholarship in the search for principles, "clues," theory, and history. Traditional contours demands this kind of work be done and, as a historian and a legal scholar, this is why I have come to believe in its value. It provides an affirmative, transparent place for the discussion of such issues within common law, aside from text, history, and precedent, which usually focused only on the narrow issue at hand. In many ways, traditional contours can be seen as a place for scholars to influence the courts—to explain and study how the system works, and for the courts to acknowledge the importance of continuity of thought on the larger questions in our changing world. Right now, the ideas seep into the system as courts adopt or include the thinking of a particular scholar on a particular issue. My vision of traditional contours is a more explicit call to include a discussion of *why* the system looks the way it does as its own analysis, and whether the changes violate those traditional contours, requiring a First Amendment analysis. It is a separate analysis, aside from the particulars of the issue at hand. It seems to bring balance to an ever-changing world, and demands that we stop and think about the implications of those changes.

We see similar uses of history—a short version of history—with David Olson's interpretation of traditional contours. Interestingly, Olson works on both patentable subject matter and traditional contours, possibly influencing his perspective. Olson's work looked to the vast changes in copyright law over the past thirty years to follow legislative changes to the public domain.[284] His argument that the continuity of the system has been disrupted by the last thirty years is reminiscent of the struggles in patentable subject matter. Olson believed that First Amendment protection must be expanded beyond mere idea/expression and fair use:

> [D]ue to the significant changes to the traditional contours of copyright, which have resulted in a vastly-diminished public domain, the idea/expression dichotomy and fair use doctrines cannot come close to adequately protecting the public's interests in speech that once would have entered the public domain quickly and is now locked up for a century or more.[285]

He read *Eldred* as a statement of judicial economy:

> *Eldred* makes two simple and straightforward assumptions. First, the copyright laws that have developed over the last 200-plus years in the United States have adequately protected speech interests,

284. David S. Olson, *First Amendment Interests and Copyright Accommodations*, 50 B.C. L. REV. 1393 (2009).

285. *Id.* at 1413.

> and are therefore constitutional. Second, if a copyright law conforms to these "traditional contours of copyright protection" developed over the last 200 years, a court may presume that the law adequately protects speech interests, and may forgo First Amendment review. But where a copyright law does not conform to longstanding historical practice, no presumption of First Amendment compliance can be made.[286]

Thus, more recent history and events in copyright put greater pressure on the First Amendment.

What Olson's work on traditional contours and the other examples of patentable subject matter show is that the definition of history is key and occurs regardless of whether one labels it the "traditional" part of a traditional contours argument. If we have a more transparent and overt discussion about the role history plays in framing of the contours, we potentially debate more carefully and deeply regarding just what that history comprises.

C. Cultural Context as Traditional Contours

1. History

So far, all of the examples of history focus on previous history within the topic itself—whether works had been previously restored, or what patentable subject matter covered in the past. But W.R. Gard and I have suggested that traditional contours could extend to include much more. We see the defining of "traditional" as a historical analysis of the conditions that led to the creation of the laws.[287] *How did* and *why does* the particular law arise? Is that same condition still part of the system, or has it become an empty tradition? How do we keep the system healthy in times of change? Is it a balance of tradition (and understanding those traditions) and change, or an alteration of traditions? When an alteration occurs, we should make sure that the new additions (or what will become new traditions) do not interfere with First Amendment interests.

For our previous work, we looked into the differences in mechanisms of protection under the 1909 Act compared to the 1976 Act, to understand the trigger from creation to protection.[288] One was a system of publication, the other automatic upon creation. How were we to understand this shift, and did it alter the traditional contours of copyright protection? We looked into what categories obtained protection (works for sale) and what works put pressure on the system

286. *Id.* at 1414 (footnotes omitted).

287. *See* Gard & Townsend Gard, *Marked by Modernism*, *supra* note 6, at 157–58.

288. *See id.* at 161–62.

(works that only gave access and not fungible copies, such as movies, radio shows, and television shows).[289] We saw the concept of protection shifting—how the turn of the nineteenth century had seen copyrighted works as "things," and how the twentieth century changed that notion into experiences with cultural works.[290] The 1976 Act dramatically altered the trigger of protection—adopting a Berne Convention life system. Both, however, had at their core the question of protection. To comprehend their different understandings of protection, we focused on the Marxist notion of circulation—that copyright protects a cultural work in its circulation, allowing it to have legal protection and, therefore, value.[291] For the 1909 Act, value came from publication, which had to be altered with an additional category of "works not for sale" for film, television and radio.[292] For the 1976 Act, value and potential circulation came from the moment of creation.[293] Nonetheless, the underlying theory remained the same—the tradition of protecting what was valuable for circulation.

What we hoped to demonstrate with those earlier pieces was the value of deeper cultural and historical analysis of the cultural conditions that created the particular laws, and the value of including such debate within "traditional" and "contours." Unfortunately, the debate regarding restoration never reached this level with the *Golan v. Holder* decision. Why did we enact the wartime extensions? What does it matter if works were in the public domain or restored under the 1790 Act? We hoped that the answer was not merely, "See, it has been done before"; that is not very interesting. Rather, what were the circumstances that led to the amendment and are those circumstances occurring again, or are they different to the extent that they require a tweaking of traditional contours? It is a deeper way to think about history, a way to not take precedent as existing within a historical vacuum, but to evaluate the importance of continuity and change.

We are not the only ones to think a deeper sense of history may be beneficial. In *The Struggle for Music Copyright*, Michael Carroll began by referencing *Eldred* and the traditional contours language as a means of including specific history related to music within the current copyright debates:

> Importantly, the *Eldred* Court signaled that copyright history would continue to supply relevant authority in future cases, particularly

289. *See id.* at 165–67.

290. *See id.* at 167.

291. *See id.* at 162.

292. *See id.* at 167.

293. Gard & Townsend Gard, *Marked by Modernism*, *supra* note 6, at 168.

> with respect to any limits the First Amendment might place on rights under copyright. Since disputes about music copyright rank among the most pressing issues of the day in contemporary intellectual property law, it is time that the nuances of music copyright's evolution be better understood. If the question presented in future cases entails copyright's governance of music, copyright law's traditional contours should be ascertained with acknowledgment and understanding of the distinct evolution of music copyright.[294]

He further explained that "[d]efining copyright law's 'traditional contours,' necessarily will require a recitation and reliance upon copyright history."[295] His work does so, presenting a contextual history of the relationship of music and copyright law.[296] This is but one example of a scholar engaged in a deeper understanding of the historical context of a particular area of copyright law, in this case music. Carroll's work parallels the Gards' in that both want the examination of history expanded to better understand how laws were previously enacted and how traditions occur.

2. *Function in Copyright*

Our focus in earlier pieces was on not only the historical, but also the functional element of traditional contours. The question then becomes how functional elements of the system interact with the temporal nature of the system. We know that "limited Times" triggered the move from protected by copyright to the public domain. But we wanted to understand what triggered the first move from creation to protection, particularly when that mechanism changed from the 1909 Act (publication) to the 1976 Act (creation itself). As discussed above, we came to understand that each step in the sequence had to have an underlying theory to justify its functionality. We found that circulation (in a Marxist sense) was the trigger point for creation to protection, and that both the means of circulation (mass industrialization into the twentieth century) and the concept of what constituted circulation had changed (technological changes including radio, television, and film, which no longer required the actual circulation of products themselves but still provided access to the products). The 1909 Act felt the pressure of these new forms of circulation, which resulted in protection for "works not reproduced for sale."

The functional element also provides analysis outside of the distinct problem being argued. It allows the court to bring in additional, rele-

294. Michael W. Carroll, *The Struggle for Music Copyright*, 57 FLA. L. REV. 907, 911–12 (2005).

295. *Id.* at 911–12 n.22 (citations omitted).

296. *See id.* at 912.

vant information, and carefully consider problems that might not have an obvious solution. Functional analysis includes both the larger system, based on the Copyright Clause, and the expectations built into the system over time. If one alters the system, how do the expectations—the balance within each principle—change? What is expected to happen, and how does the effect of the alteration dramatically change those expectations? The functional question harkens back to Lessig's statements regarding *Kahle*: "[W]hat it does mean is that, if Congress changes the fundamental architecture of the system, then the First Amendment ought to apply. That analysis would ask, 'Are you restricting speech more than necessary to achieve whatever legitimate purpose you are trying to advance?'"[297]

We believe, like Justice Ginsburg in *Eldred*, that there is an underlying copyright system that supports the First Amendment. We also believe that for the system to work we must have predictable, knowable patterns to ensure that legislation fits the expectations of the past. This does not mean we are "stuck" with history or that we have to be slaves to it. Rather, we must understand the choices made in the past, the underlying rationale, and then decide how that does or does not fit our current human condition. Ours is a thoughtful use of history within the context of change.

We believed traditional contours could have offered such an opportunity. Our focus was not to frame history as static, but rather to incorporate a larger cultural analysis of the history and function of what is being debated, and to challenge and understand how a particular tradition was created. One recent example of this kind of analysis occurred in *Viacom v. YouTube*,[298] in which the court considered the "contours" of § 512(c) of the 1976 Act.[299] Evident in the opinion is the court's attempt to understand new areas of copyright law and its review of the system for clues. Is specific knowledge of infringement required to trigger the red flag or actual knowledge exception to the online service provider safe harbor? The court said yes because copyright law is premised on specific infringement.[300]

297. Lawrence Lessig, The Second Annual Distinguished Lecture in Intellectual Property and Communications Law, *Creative Economics*, 2006 MICH. ST. L. REV. 33, 42. In another address, Professor Lessig discussed the role of judicial scrutiny:

> This rule ratifies a tradition; it focuses judicial scrutiny upon changes in that tradition. It thus permits the consequences of this loss in institutional balance to be recognized, against a background built by a different practice, and different institution. . . . But *Eldred* means that it may continue to constrain Congress, indirectly.

Lawrence Lessig, Address, *The Balance of Robert Kastenmeier*, 2004 WIS. L. REV. 1015, 1033.

298. *See* Viacom Int'l, Inc. v. YouTube, Inc., 676 F.3d 19, 25 (2d Cir. 2012).

299. *See* 17 U.S.C. § 512(c) (2006).

300. *See Viacom Int'l, Inc.*, 676 F.3d at 30–32.

D. *The Underlying Principles of Traditional Contours*

We have seen how we theorize traditional contours from a cultural history and theory perspective and how other scholars have discussed and theorized tests for traditional contours. This last *playful* Part considers how scholarship outside of traditional contours might be applied to understand the underlying principles of traditional contours. If traditional contours is to survive, we have to start to define more carefully the categories and corresponding underlying theories. The Ninth Circuit discussed "unbroken practices" in *Luck's Music*,[301] and the Tenth Circuit discussed "bedrock principles" in *Golan v. Gonzales*.[302] The question is how do we more systematically understand the underlying components of the system in order to analyze whether they have been altered? One could follow Justice Ginsburg's construction in *Eldred* or *Golan v. Holder*, but the lower courts seem to look outward for more assistance. This Part conceptualizes traditional contours in an additional alternative—as a set of "bedrock principles" that make up the system through "unbroken practices." The question in this version of traditional contours is how do we determine these unbroken practices or principles?

The Tenth Circuit's analysis of a "bedrock principle" considered only one principle identified by Judge Henry: once a work came into the public domain, it stayed in the public domain.[303] Are there other principles? Surely there are more, and surely if there are principles, there should be a more systematic method in place to identify those principles. Moreover, we have recently seen a need for getting back to "principles" in two significant works: Robert Merges's *Justifying Intellectual Property*[304] and Pamela Samuelson's *Copyright Principles Project*.[305] This Part first looks at both of these works, and then considers how they could be applied to evaluate traditional contours, and when they have been altered.

In *Justifying Intellectual Property*, Robert Merges set out to evaluate and structure a theory of intellectual property. He began with the metaphor that intellectual property "is one of those sprawling, chaotic megacities of the developing world."[306] His goal was to understand a foundational structure for the sprawl and "to make sure that with each

301. *See* Luck's Music Library, Inc. v. Ashcroft, 321 F. Supp. 2d 107, 113 (D.D.C. 2004).

302. *See* Golan v. Gonzales, 501 F.3d 1179, 1187–88 (10th Cir. 2007).

303. *See id.* at 1184.

304. ROBERT P. MERGES, JUSTIFYING INTELLECTUAL PROPERTY (2011).

305. Pamela Samuelson & Members of the CPP, *The Copyright Principles Project: Directions for Reform*, 25 BERKELEY TECH. L.J. 1175 (2010).

306. MERGES, *supra* note 304, at 1.

new extension of the old city, basic themes and motifs from the historical core are picked up, replicated, and carried forward. As the city grows, [he] want[s] it to retain its essential character."[307] From the beginning, his work seems as though it would complement a "traditional contours" reading of intellectual property. However, he did not identify his work within a "traditional contours" perspective.

Instead, Merges views his work as conceptual. He wrote, "[I]n extending property to intangible items, what are the best justifications, and how do they shape the contours and limits of the field? In other words, what are the conceptual patterns, the basic formative ideas, that have inspired and animated the 'cityscape' I am surveying?"[308] Translated into a traditional contours discussion, Merges enlightens with just this one sentence. Traditional contours, it seems, could be seen as both the shape of the field and the limits.[309] Merges's language also suggested that traditional contours could be the conceptual patterns, the basic formative ideas, and, most importantly, the spirit behind the laws as they stand—what inspired them in the first place. All of these concepts fit neatly into the functional and historical components of traditional contours, but they could also form the elements of traditional contours on their own.

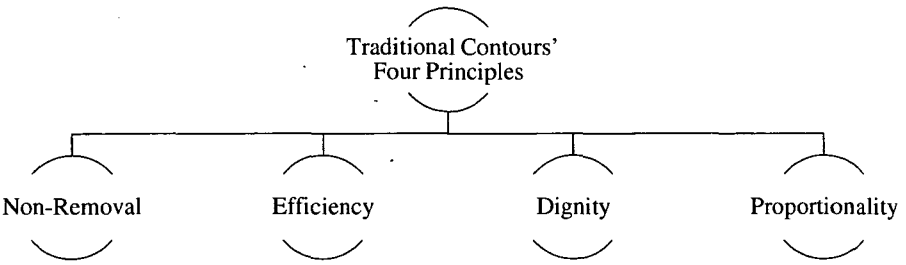
His work is interesting because of its flexibility. The core of his intellectual property system consists of four mid-level principles: efficiency, non-removal, proportionality, and dignity.[310] Notice that his work incorporates all of intellectual property. He explained that his mid-level principles can be applied to any underlying theory of *why* for intellectual property.[311] He demonstrated using three major theories of property—Locke, Kant, and Rawls.[312] The goal of the mid-level principles is to bring disparate visions together to agree on basic understandings of intellectual property. These mid-level principles thus form the basic core of what the intellectual property system sets out to accomplish.

Merges's work suggests the possibility of a balancing, fair use-like test. One could imagine four factors that are relevant to a determination of whether a particular law alters the traditional contours of copyright or patent law. Take Merges's own categories: non-removal, proportionality, dignity, and efficiency[313]: a plaintiff could argue that a

307. *Id.* at 2.
308. *Id.*
309. This is what the *Silver* court had interpreted traditional contours to mean.
310. *See* Merges, *supra* note 304, at 135.
311. *See id.* at 13.
312. *See id.* at 13, 31–138.
313. *See id.* at 7–8.

particular law did not meet the traditional contours of copyright because it violated the non-removal principle.[314] Alternatively, the defendant could raise the defense that the law violates or alters the traditional contours and use the four elements or any combination thereof to prove that assertion. A court could do a four-part traditional contours analysis to better understand whether a law alters the traditional contours. Finally, Congress could write new legislation, to address the traditional contours of prior legislation and better guide courts in future conflicts.

FIGURE 14: MERGES'S TRADITIONAL CONTOURS



We can use the *Golan v. Holder* fact pattern as an example. Applying Merges's categories and translating them into traditional contours, we can see that the principle of non-removal was violated, and therefore just that principle would trigger a First Amendment analysis. Restoring all foreign works may or may not be seen as efficient, and would thus require additional briefing by the parties. Justice Ginsburg, in some ways, seemed to suggest a dignity argument for foreign authors, that restoration in part makes them whole on a personal level. At the same time, the petitioners seemed to say that being forced to ask for licenses and not having the money to pay once a work is restored interferes with their dignity. Additionally, proportionality seemed to be at issue—what is fair on either side in restoring a work? Was the cost of removal of millions of works from the public domain proportional to the benefit? Did it make up for lost time? Did it hurt or help society? Some of these questions were discussed in the remanded district court decision and its subsequent appeal.

Pamela Samuelson headed the Copyright Principles Project (CPP), which gathered together scholars and industry experts in copyright law to discuss what core elements are needed for a model copyright

314. Of course, the inherent problem with this argument is that Justice Ginsburg announced in *Golan v. Holder* that non-removal is not a principle of copyright law, but we will put that aside for the moment.

law. Released in September 2010 and "[c]rafted over three years by a group of legal academics, private practitioners, and corporate attorneys, the report examines several ways to improve and update the law in an era of rapid technological change."[315] Samuelson's project sets out to review the system as a whole, as well as its parts. A traditional contours framework addresses the principles of the system, allowing for a discussion of the larger picture and working parts. So, what would the CPP's traditional contours look like?

The document begins with the importance of how copyright functions: the contours of copyright law. "A well-functioning copyright law carefully balances the interests of the public and of copyright owners."[316] Copyright provides access to knowledge, facilitates education, enriches culture, and functions as a public good. It also allows for the recoupment of investment. Copyright law is thus a balance between the public good and return on investment. "At this level of generality, agreement is easy to reach. Disagreements tend to arise over how to implement these goals in statutory language and actual practice."[317] Samuelson and her colleagues see this basic balance under stress—from technology, from the Internet, from the globalization of copyright, and from user-generated content. Stress also comes from the age of the 1976 Act, which emphasizes the need for reform. This is the most hopeful version of traditional contours to date. If we can agree about the underlying elements of the system—the functional and necessary historical continuities—we may all be able to move forward to solve some of the more pressing problems in copyright.

The project begins with seven guiding principles, with sub parts. The first principle could be labeled the copyright "ecosystem": "Copyright law should encourage and support the creation, dissemination, and enjoyment of works of authorship in order to promote the growth and exchange of knowledge and culture."[318] In order to achieve such goals, the laws must be "clear and sensible, yet flexible enough to apply in a changing environment."[319]

How would this apply to § 104A? One could argue that the law itself was never clear, sensible, or flexible, and, therefore, violated basic principles. The structure of the law would be called into question.

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315. Press Release, Berkeley Law, Top Legal Experts Explore Reforms to Copyright Law (Sep. 28, 2010), *available at* http://www.law.berkeley.edu/9463.htm.

316. Pamela Samuelson et al., *supra* note 305, at 1175.

317. *Id.* at 1181.

318. *Id.*

319. *Id.*

Did the law promote a healthy "ecosystem?" Did the law promote growth and exchange of knowledge and culture?

The second principle focuses on the need for exclusive rights, reminiscent of Justice Ginsburg in *Eldred*.[320] The third principle focuses on clear rules of ownership and infringement, to encourage investment and certainty for copyright holders and authors.[321] The fourth principle focuses on the exclusive rights of the copyright holder and their ability to license or assign their work, including under open licensing models.[322] The fifth principle focuses on limitations on the rights of copyright owners, including an articulation of § 102(b).[323] The sixth principle concerns technology and the seventh principle addresses the globalized reality of the world.[324] The seventh principle is particularly helpful in the context of *Golan v. Holder*, about which I have argued that Justice Ginsburg seems in conflict over traditional contours in a domestic versus international context. The CPP wrote:

> 7. Copyright law should recognize that the system in which creative activity occurs and in which creative works are circulated is increasingly global.
>
> 7.1. The United States should develop its copyright law in a manner that respects the global system in which creative activity occurs.
>
> 7.2. The United States should seek to ensure that international law leaves room to allow domestic laws to fully comport with these principles.[325]

The tension between domestic and international principles is articulated. At once, we must respect that we are not in an isolated space. Yet, we must recognize that international laws cannot overtake the domestic system and that our system is based on sound principles. I would argue that Justice Ginsburg did not take into account the full measure of principle seven in her *Golan v. Holder* decision and, instead, anxiously sought to "conform" to international treaty obligations. The irony, of course, is that § 104A *did not conform* to the United States' Article 18 treaty obligations and, moreover, could have been tailored in a less destructive fashion.[326] The seventh principle should have been applied in *Golan v. Holder*—recognizing the tensions between international treaties and norms, and our domestic law, and engaging in a discussion of how those new pressures impact our

320. *Id.*

321. *See id.*

322. *See* Pamela Samuelson et al., *supra* note 305, at 1181.

323. *Id.* at 1182.

324. *Id.* at 1182–83.

325. *Id.*

326. Townsend Gard, *In the Trenches with § 104A: An Evaluation of the Parties' Arguments in* Golan v. Holder *as It Heads to the Supreme Court*, *supra* note 6.

domestic traditional contours. Instead, Justice Ginsburg radically changed the basic premises of our system.

In many ways, the principles articulate the same concerns and system as Justice Ginsburg did in *Eldred*—essentially, copyright ownership with exclusive rights and limitations on those rights. That is the basis of the copyright system. Technology and the global world necessarily impact that balance. The principles show the need for balance between copyright holders and the public through clear but flexible rules.

The principles describe an uncontroversial system that allows copyright law to function. After identifying the key principles, they are then applied to copyright law: subject matter and limits (including idea/expression), authorship, duration, formalities, exclusive rights (including remedies for infringement), and safeguards, including fair use.[327] They also included a category specifically for technology.[328] The CPP recommended twenty-five specific reform proposals, all emanating from the original principles. For these purposes, the CPP discussed specific reforms with regard to the public domain, and also idea/expression and fair use, among other elements. One recommendation is particularly interesting: "Limitations and exceptions to copyright law ought to be based on principles, rather than being largely the product of successful lobbying."[329] This is the essence of traditional contours, particularly with a set of principles identified. Here, they use the example of an exemption for horticultural fairs, but not other kinds of fairs.[330]

Turning back to Justice Ginsburg's decision in *Golan v. Holder*, the CPP principles might have helped guide her. She would have had a principle to allow her concerns regarding compliance with the Berne Convention, but she would have also been able to use a principle to make sure international law within a domestic setting comports with the larger principles of the system. Again, looking to Justice Ginsburg's decision in *Golan v. Holder*, the principles might have led to a more constructive discussion on the exclusive rights and limitations of copyright holders' rights.

VI. CONCLUSION

In many ways, Justice Ginsburg's opinion in *Eldred* stood as a pure, accessible way to understand traditional contours. She set up the no-

327. Pamela Samuelson et al., *supra* note 305, at 1183–96.
328. *Id.* at 1193–95.
329. *Id.* at 1234.
330. *Id.*

tion of a copyright system, and only when something did not fit within the traditional expectations of that system would one evaluate the change against the First Amendment. In Justice Ginsburg's world, the system is based on exclusive rights and safeguards. As long as the issues lie within the traditional categories of copyright, traditional contours have not been altered. But there is an inherent problem: when does something alter the traditional contours? How are we to know when something does not fit within the system? It is the idea of principles that may help.

The CPP, formulated in another structure, covers much of the same territory, adding technology and globalization into the structure. Here, we see disparate interests coming together to agree on seven principles with further suggestion of reform. Merges's work looks slightly different with his four principles, but one can see that the essence of the system, however defined, seems to be fairly stable. And so, I would posit that traditional contours is in our language already, and by assigning categories, structure, or principles, we form a language of continuity and change to facilitate further discussion.

And so what are the traditional contours of copyright protection? We begin with the Copyright Clause. How has the copyright system been devised to support the requirements of this Clause? What principles can we extract from the system(s) created over time? This informs why the system is in place, and helps us measure when new areas threaten the basic principles of the system. If a new legislative amendment or judge-made doctrine alters the traditional expectations or traditional contours of copyright protection, only then do we turn to a First Amendment analysis.

So what does one do when something does not fit into the principles or preset categories? One could turn directly to the First Amendment, but that seems unlikely, as we have rarely seen the courts analyze copyright issues within a First Amendment context. Perhaps we could adopt Kausinic's ideas and look for ways to adjust the alteration through additional safeguards, First Amendment scrutiny, or equitable solutions.

Justice Ginsburg dramatically limited the scope and usefulness of traditional contours when she wrote *Golan v. Holder*. She appeared to re-orient the analysis from a larger concept of a working system to an analysis specifically focused on the needs of the First Amendment under copyright law through fair use and idea/expression, even when works are in the public domain, and then any additional *transitional* elements of a particular amendment. Gone is the more expansive

view of *Eldred*, which looked to the larger system as a means of evaluation.[331]

Traditional contours, however, is bigger than Justice Ginsburg. Traditional contours defines the battles of our times—over how we want our system to look and what can fall by the wayside as times change. Several arms of IP law seem to be in a battle over the definition of traditional contours, as demonstrated by the cases over the last year and the academic writing on the subject. As the world continues to change—new amendments, new technologies, and new international issues—it places tangible pressure on domestic systems. Traditional contours allows us to pull back from the specifics of the issue (the text, history, and precedent) and think about what our system is and why it is that way. It does not force us to stay with the past, but does require us to at least think about why the system looks the way it does.

Traditional contours, however, was never popular, and *Golan v. Holder* may be its last moment of discussion. It had the promise of including deeper theoretical discussion and more significant cultural and historical analysis as part of the legal process, especially in the context of dramatic changes. Traditional contours allows us to look at the whole system to understand the impact of the change, and to make sure that changes do not abridge First Amendment rights. Traditional contours reminds us that there is a common language, a system, a reasoning. Traditional contours gives us pause to stop and think in this ever-changing world.

And so with the *Golan v. Holder* decision, we end a chapter on traditional contours, and wait to see if others resurrect its usefulness. Seeing the structure of an argument through a traditional contours lens—whether an *Eldred* or *Golan v. Holder* reading—identifies the kinds of arguments being made and brings an awareness of the kind of history being used, the kind of evidence being used for "text, history, and precedent," and how the functional argument is being constructed. It gives one a larger view of how the arguments being made fit within the thinking of a larger system. In the end, traditional contours helps us to be more aware of what we are doing—how are we using history, what history are we using, and are we arguing for or against history.

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331. We never did see the application of traditional contours beyond copyright to trademarks and patents, but as this Article sought to demonstrate, the same issues of boundaries and definitions in changing times affect those areas of the law as well, and using either traditional contours reading—*Eldred* or *Golan v. Holder*—one could see the application of the analysis.

Traditional contours could be defined as a functional and historical analysis of a particular issue or law within the context of the underlying principles of the copyright system, a system that supports the underlying purpose of the Copyright Clause. We will have to wait and see if the concept of traditional contours is resurrected or was merely a short-lived, accidental experiment in the history of copyright law. Regardless, there are lessons to take away even from a failed experiment. There is a need out there to define the system. Even the recent Second Circuit decision in *Viacom v. YouTube*, in its first sentence, defined its task as finding the "contours" of § 512 of the Copyright Act.[332] Prominent scholars, too, are searching for principles and clues.

In the end, Justice Ginsburg had it right with the first definition of traditional contours, and her use of the word meant something at the time. She was trying to sort through the elements of a system and determine when boundaries had been crossed. She simply needed to add a principle to adjust for the relationship between international and domestic copyright law.

But, of course, the larger question is whether we want more battles over history, over principles, and over contours. As Graeme Austin phrased it, traditional contours "may provoke a battle of 'traditions'—my tradition is better or more venerable than yours. If you win the battle of traditions, you've probably got a better chance of also winning the constitutional battle."[333] This will require, in Austin's opinion, defining the system itself. This in fact is the great hope of the phrase. In an age of increasing pressures from technology and global influences, "the stakes involved in identifying fundamental principles—now 'traditional contours'—are increasingly heightened."[334] Austin saw traditional contours as playing a role in molding the "stories we tell."[335] In 2004, he believed that the "debate over the meaning of copyright's traditional contours is likely to continue."[336]

The question, nearly a decade later, is whether debate over the meaning of traditional contours *will* continue. Great work has been done looking into principles and the larger theories of copyright, work far beyond the scope of this Article. Merges and the CPP stand as two examples. We can see the possibilities of building a common language, a common understanding of what copyright law is, and traditional contours playing a part in that development. But, after *Golan*

332. Viacom Int'l, Inc., v. YouTube, Inc., 676 F.3d 19, 25 (2d Cir. 2012).
333. Graeme W. Austin, *Keynote Address*, 28 COLUM. J.L. & ARTS 397, 400–01 (2005).
334. *Id.* at 403.
335. *Id.* at 418.
336. *Id.*

v. Holder, that path is uncertain. Traditional contours may have survived, but it will take a great deal to revive its usefulness as a term, at least in the courts. Nevertheless, I hope we take away the idea that traditional contours—named or unnamed as such—reminds us that in copyright, in intellectual property, in life, there is an underlying system, rationale, history, tradition, and contours, both in a domestic and international context.