

Boston College Law Review

Volume 50

Issue 5 *Publicity, Privacy, and Intellectual Property*

Meet the First Amendment


Article 5

11-1-2009

First Amendment Interests and Copyright Accommodations

David S. Olson

Follow this and additional works at: <http://lawdigitalcommons.bc.edu/bclr>

 Part of the [First Amendment Commons](#), and the [Intellectual Property Law Commons](#)

Recommended Citation

David S. Olson, *First Amendment Interests and Copyright Accommodations*, 50 B.C.L. Rev. 1393 (2009), <http://lawdigitalcommons.bc.edu/bclr/vol50/iss5/5>

This Article is brought to you for free and open access by the Law Journals at Digital Commons @ Boston College Law School. It has been accepted for inclusion in Boston College Law Review by an authorized administrator of Digital Commons @ Boston College Law School. For more information, please contact nick.szydowski@bc.edu.

FIRST AMENDMENT INTERESTS AND COPYRIGHT ACCOMMODATIONS

DAVID S. OLSON*

Abstract: Copyright law exists to encourage the creation of works of authorship by granting exclusive rights. But copyright's incentive function seems in tension with the public's First Amendment interests to use and freely hear copyrighted speech. Conventional wisdom holds, however, that copyright law serves to encourage much more speech than it discourages, and resolves First Amendment concerns with protections internal to copyright law like the fair use defense and the idea/expression dichotomy. This Article argues that the conventional wisdom no longer holds given the unprecedented expansion of copyright's scope and corresponding drastic diminution of the public domain in the last three decades. This Article extends the U.S. Supreme Court's reasoning in *Eldred v. Ashcroft*, which rejected the notion that courts should never subject copyright laws to First Amendment analysis, to read First Amendment accommodations into copyright laws where use of copyrighted materials implicates significant speech interests.

INTRODUCTION

American legal scholars have discussed the interaction of the First Amendment and copyright for quite some time.¹ A number of articles

* © 2009, David S. Olson, Assistant Professor, Boston College Law School. For helpful comments and ideas I thank Lawrence Lessig, David Levine, Joseph Liu, Sheila Olson, Mary-Rose Papandrea, Diane Ring, Christopher Sprigman, Elizabeth Townsend-Gard, Alfred Yen, and the participants at the Boston College Law School Symposium: *Publicity, Privacy, and Intellectual Property Meet the First Amendment*. My thinking on the issues discussed in this paper also benefited enormously from my time as a resident fellow at the Stanford Law School Center for Internet and Society and the Fair Use Project. Specifically, I thank Jennifer Granick, Lauren Gelman, Anthony Falzone, and Julie Ahrens for numerous enlightening discussions of these and similar issues. I am also grateful for the able research assistance of Juliet DeFrancisco and Tyler McKinley. This project was made possible in part by generous funding from the Boston College Law School Fund. Some descriptive parts of this Article appeared in earlier form in David S. Olson, *First Amendment Challenges to Copyright Laws: Kahle v. Gonzales and Golan v. Gonzales*, 9:2 Engage 75 (2008).

¹ See, e.g., Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CAL. L. REV. 283 (1979); Alan E. Garfield, *The Case for First Amendment Limits on Copyright Law*, 35 HOFSTRA L. REV. 1169 (2007) (collecting numerous sources); Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983 (1970);

have been written on the potential conflicts between the two areas of law, and about how copyright law has been shaped and adapted by courts to accommodate First Amendment interests.² Some courts and commentators have argued that copyright law is now structured in such a way that it can deal internally with all First Amendment interests, and thus scrutiny of a copyright law using the First Amendment is never appropriate.³ Others have argued that although copyright law has some built-in protections of speech, the First Amendment should nevertheless be applied directly in certain copyright cases.⁴

Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180 (1970).

² See *supra* note 1; see also *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (establishing that parody is covered by fair use); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349–50 (1991) (“[C]opyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship.”) (internal citation omitted); *Fisher v. Dees*, 794 F.2d 432, 435 (9th Cir. 1986) (“The fair-use doctrine was initially developed by courts as an equitable defense to copyright infringement. In effect, the doctrine creates a limited privilege in those other than the owner of a copyright to use the copyrighted material in a reasonable manner without the owner’s consent.”); *Toro Co. v. R & R Prods. Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986) (“The case law embodying the idea/expression dichotomy, which traces its roots back to *Baker v. Selden*, 101 U.S. 99 (1880), holds that copyright protection extends only to the expression of a particular idea, not the idea itself. The doctrine is grounded both in a presumed legislative intent to grant an author a monopoly only in his expressions—not his ideas—and in the First Amendment interest in the free exchange of ideas.”).

³ Some cases have implied, or even said directly, that copyright law incorporates all needed First Amendment protections internally. See, e.g., *Religious Tech. Ctr. v. Henson*, No. CV-96-20271-RMW (EAI), 1999 WL 362837, *1 (9th Cir. June 4, 1999) (holding that the First Amendment “argument fails in light of *Harper & Row, Publishers, Inc. v. Nation Enters.*,” 471 U.S. 539 (1985), in which the [Supreme] Court stated that the laws of the Copyright Act already embrace First Amendment concerns”); *A&M Records, Inc. v. Napster*, 114 F. Supp. 2d 896, 922 (N.D. Cal. 2000) (quoting *Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65, 74 (2d Cir. 1999)) (holding First Amendment interests “are protected by and coextensive with the fair use doctrine”); *L.A. Times v. Free Republic*, 54 U.S.P.Q.2d 1453, 1472 (C.D. Cal. 2000) (holding that First Amendment interests “are subsumed within the fair use [a]nalysis”).

⁴ See, e.g., Garfield, *supra* note 1, at 1173–74; Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1, 37–46 (2001); Alfred C. Yen, Eldred, *the First Amendment, and Aggressive Copyright Claims*, 40 HOUS. L. REV. 673, 695 (2003) (“Eldred signals an end to the practice of ignoring the First Amendment in copyright, and . . . proper recognition of the First Amendment improves judicial evaluation of aggressive copyright claims”); Alfred C. Yen, *A First Amendment Perspective on the Construction of Third Party Copyright Liability*, 50 B.C. L. REV. 1481, 1584 (arguing that First Amendment concerns militate for limits on presumed damages arising from copyright claims for third-party liability); W. Warren Hamel, Note, *Harper & Row v. The Nation: A First Amendment Privilege for News Reporting of Copyrightable Material?*, 19 COLUM. J.L. & SOC. PROBS. 253, 290–91 (1985).

In the 2003 case, *Eldred v. Ashcroft*, the U.S. Supreme Court held that generally copyright law does accommodate First Amendment interests in such a way that direct First Amendment scrutiny is not needed.⁵ But the Court also said that those who believe that a copyright law need never be scrutinized under the First Amendment are wrong.⁶ The Court held that where a copyright law hews to the “traditional contours of copyright,” no First Amendment scrutiny is needed.⁷ The logical corollary, therefore, is that if a copyright law does not fall within the traditional contours of copyright, it should not be spared from First Amendment scrutiny, where such scrutiny would be appropriate under normal First Amendment law.

This approach by the Court recognizes that speakers have an interest in making use of and building on the work of others.⁸ It also comports with judicial recognition that it is not just the speaker’s interest that is protected by the First Amendment. The Supreme Court has emphasized in a number of cases that the First Amendment also protects a community right to hear.⁹ This community right to hear is protected in cases of both political and artistic expression, regardless of whether the speaker’s motive is economic.¹⁰

There is inherent tension between the First Amendment’s community right to hear and copyright law, which gives the speaker the exclusive right to distribute her speech on terms that she deems acceptable, or not to distribute her speech at all.¹¹ Courts and commentators have traditionally argued that the tension exists more in theory than in practice because, although copyright does give exclusive rights to authors, these rights incentivize authors to produce many more works than would be produced absent the copyright regime.¹² Thus, the ar-

⁵ 537 U.S. 186, 219, 221 (2003).

⁶ *Id.* at 221.

⁷ *Id.*

⁸ *Id.* at 205–08.

⁹ See Goldstein, *supra* note 1, at 989 n.29 (citing *Rosenblatt v. Baer*, 383 U.S. 75, 94–95 (1966) (Black, J., concurring and dissenting); *Lamont v. Postmaster Gen.*, 381 U.S. 301 (1965); *Roth v. United States*, 354 U.S. 476, 484 (1957); *Stromberg v. California*, 283 U.S. 359, 369 (1931)).

¹⁰ See *id.* at 989 & nn.30–31.

¹¹ See *id.* at 991, 995.

¹² See, e.g., Ariel L. Bendor, *Prior Restraint, Incommensurability, and the Constitutionalism of Means*, 68 FORDHAM L. REV. 289, 325 (1999) (“[I]ntellectual property, and in particular copyright, is characterized by the fact that one of its purposes is to encourage freedom of speech and democratic values. Intellectual property restricts certain aspects of freedom of speech in order to promote freedom of speech in general.”) (internal citation omitted); Ellen P. Goodman, *Media Policy and Free Speech: The First Amendment at War with Itself*, 35 HOFSTRA L. REV. 1211, 1234 (2007) (“Courts view copyright as a specialized economic

gument goes, copyright law, on net, greatly encourages the production of speech.¹³ And this additional production of speech is thought to adequately counterbalance the individual restrictions on speech that copyright owners impose by charging for copies of their works, or even withholding their works.¹⁴

But the amount of speech restricted by copyright as compared to the amount of speech copyright encourages has changed dramatically in the last three decades. Historically in the United States, most eligible works were never copyrighted, and of those works that were copyrighted, the vast majority were out of copyright within twenty-eight years.¹⁵ Changes to copyright law in the last three decades have altered this landscape enormously.¹⁶ Now, due to the elimination of registration requirements and formalities, every eligible work is automatically protected for the life of the author plus seventy years (or ninety-five years for works made for hire and anonymous works).¹⁷ This has drastically increased the restriction on the ability to transmit, comment upon, and reuse speech, while providing a negligible additional incentive to produce speech.¹⁸

Thus the ratio between the amount of speech encouraged by copyright as compared to the amount burdened by copyright has shifted decisively towards greater speech restriction. So, whereas the traditional justification for not applying First Amendment law to copyright cases was that copyright gave us much more speech than it restricted, the

regulation consistent with the conventional view that copyright exists to provide incentives for creation. Accordingly, litigants can easily characterize highly protective copyright law as a reasonable attempt to structure the market for expressive works to ensure optimal levels of expressive contribution.”); 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, 387 (2008) (“Copyright’s speech-limiting effects are justified by the broader and ultimately speech-enhancing purpose of encouraging the creation of copyrighted works.”).

¹³ See, e.g., Bendor, *supra* note 12, at 325; Goodman, *supra* note 12, at 1234; Liu, *supra* note 12, at 387.

¹⁴ See, e.g., Bendor, *supra* note 12, at 325; Goodman, *supra* note 12, at 1234; Liu, *supra* note 12, at 387.

¹⁵ See Netanel, *supra* note 4, at 23.

¹⁶ See *id.* at 23–24.

¹⁷ 17 U.S.C. § 302(a) (2006).

¹⁸ *Eldred*, 537 U.S. at 255–56 (Breyer, J., dissenting) (noting that the CTEA creates a copyright term worth 99.8% of the value of a perpetual copyright); see also LAWRENCE LESSIG, *FREE CULTURE* 232 (2004) (“The economists, as the list of Nobel winners demonstrates, spanned the political spectrum. Their conclusions were powerful: There was no plausible claim that extending the terms of existing copyrights would do anything to increase incentives to create. Such extensions were nothing more than ‘rent-seeking’ —the fancy term economists use to describe special-interest legislation gone wild.”).

much-greater current restrictions on speech from copyright should now serve to encourage the reevaluation of how well recent copyright law achieves First Amendment interests on its own. This Article argues that due to the drastic lock-up of speech from increased copyright coverage, First Amendment scrutiny must be applied to copyright law with renewed vigor, and that in a number of areas, accommodations must be made in copyright law to protect First Amendment interests that are no longer adequately protected by copyright law acting alone.¹⁹

Part I of this Article reviews the Supreme Court's recent decision in *Eldred*, in which the Court affirmed that First Amendment scrutiny can be appropriate in copyright cases.²⁰ It discusses the rule set out by the Court in *Eldred*: that First Amendment scrutiny generally is not needed when a copyright law does not "alter[] the traditional contours of copyright protection."²¹ Conversely, First Amendment scrutiny should be applied when a copyright law does alter the traditional contours of copyright protection. The Article then discusses and rejects the argument made by some courts that the traditional contours of copyright protection are no more than the idea/expression dichotomy and the fair use exception.²² Rather, I agree with a recent case from the U.S. District Court of Colorado, *Golan v. Holder*, which holds that changes to copyright law that significantly alter the public's interaction with copyrighted and public domain works implicate interests deserving scrutiny under the First Amendment.²³

Part II of this Article then extends the logic found in the *Eldred* and *Golan* cases to argue that the elimination of registration requirements and other formalities has significantly altered the traditional contours of copyright by greatly decreasing the public domain.²⁴ Due to this alteration of the traditional contours of copyright, Part III asserts that First Amendment scrutiny is needed in a number of areas.²⁵ I argue that judges applying First Amendment scrutiny to copyright laws in light of the changes in copyright law that vastly diminish the public domain will in some cases be constitutionally required to read accommodations of First Amendment interests into the copyright law cases

¹⁹ See *infra* notes 131–176 and accompanying text.

²⁰ See *infra* notes 28–83 and accompanying text.

²¹ See 537 U.S. at 221; *infra* notes 28–43 and accompanying text.

²² See *supra* note 3.

²³ *Golan v. Holder (Golan II)*, 611 F. Supp. 2d 1165, 1177 (D. Colo. 2009).

²⁴ See *infra* notes 86–130 and accompanying text.

²⁵ See *infra* notes 131–176 and accompanying text.

that they are deciding.²⁶ Part III concludes by describing several adjustments in copyright remedies that may be necessary when First Amendment scrutiny is applied.²⁷

I. APPLICATION OF FIRST AMENDMENT SCRUTINY TO COPYRIGHT LAWS

The U.S. Supreme Court addressed the question of when First Amendment scrutiny should apply to copyright laws most recently in 2003 in *Eldred v. Ashcroft*.²⁸ The plaintiffs in *Eldred* challenged the Sonny Bono Copyright Term Extension Act of 1998 (the "CTEA").²⁹ The CTEA added twenty years to the term of copyright protection, so that for works produced after January 1, 1978, copyright protection lasts for the life of the author plus seventy years.³⁰ For works for hire and works published before 1978 and still in copyright at the time of the CTEA, copyright was extended to ninety-five years.³¹ Plaintiffs in *Eldred* argued that extensions of copyright terms for new and previously published works impacted the speech interests of those who would make use of work that would otherwise fall into the public domain.³² Thus, plaintiffs argued, First Amendment scrutiny should be applied to the CTEA, and such scrutiny should result in the CTEA being held unconstitutional.³³

After losing at the district and circuit court levels, plaintiffs argued their case before the Supreme Court.³⁴ The Supreme Court affirmed the lower courts and rejected the plaintiffs' argument that the CTEA violated the First Amendment.³⁵ The Court did "recognize that the D.C. Circuit spoke too broadly when it declared copyrights 'categorically immune from challenges under the First Amendment.'"³⁶ But, said the Supreme Court, when Congress passes copyright legislation that does not "alter[] the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary."³⁷ The Court noted

²⁶ See *infra* notes 131–160 and accompanying text.

²⁷ See *infra* notes 161–176 and accompanying text.

²⁸ See 537 U.S. 186, 218 (2003).

²⁹ Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified as amended in scattered sections of 17 U.S.C.).

³⁰ 17 U.S.C. § 302(a) (2006).

³¹ *Id.* § 302(c).

³² *Eldred*, 537 U.S. at 193.

³³ *Id.*

³⁴ *Id.* at 194.

³⁵ *Id.* at 194, 221.

³⁶ *Id.* at 221 (citing *Eldred v. Reno*, 239 F.3d 372, 375 (D.C. Cir. 2001)).

³⁷ *Id.* (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985); *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522 (1987)).

two important features of copyright law that protect First Amendment interests—the idea/expression dichotomy and fair use.³⁸ The idea/expression dichotomy strikes a First Amendment balance in copyright law by allowing protection only of an author’s expression of her ideas, but not of the ideas themselves.³⁹ Likewise, the fair use exemption to copyright protection allows use of copyrighted works, including direct copying and quotation, “for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research,”⁴⁰ and for purposes of parody.⁴¹ The Supreme Court also noted that the CTEA included specific additional protections for First Amendment interests, including the rights of libraries, archives, and similar organizations to make certain uses of works during their last twenty years of copyright for purposes such as preservation, scholarship, or research,⁴² and exemptions for small businesses and restaurants from paying performance royalties for playing televisions or radios in their businesses.⁴³

The Supreme Court’s *Eldred* decision was a defeat for the plaintiffs, but it was not a total defeat. The converse of the Court’s holding that First Amendment scrutiny is not necessary where a statute does not “alter[] the traditional contours of copyright protection”⁴⁴ is that, when a statute does alter those traditional contours, First Amendment review should apply.

But what are the “traditional contours” of copyright protection? The Court left this unanswered in *Eldred*. Are the traditional contours of copyright protection present so long as the idea/expression dichotomy and fair use protections remain in the Copyright Act? Or are the traditional contours of copyright protection altered whenever a statute passed under the copyright clause differs significantly from historical precedent?⁴⁵

³⁸ *Eldred*, 537 U.S. at 219–20.

³⁹ *Id.* at 219.

⁴⁰ *Id.* at 220 (quoting 17 U.S.C. § 107).

⁴¹ *Id.* (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994)).

⁴² *Id.* (citing 17 U.S.C. § 108(h)).

⁴³ *Id.* (citing 17 U.S.C. § 110(5)(B)).

⁴⁴ *Eldred*, 537 U.S. at 221 (internal citation omitted).

⁴⁵ A number of recent articles have grappled with these questions. Many commentators see a role for First Amendment inquiry beyond the protections built into the copyright statute. See, e.g., David Kohler, *This Town Ain’t Big Enough for the Both of Us—or Is It? Reflections on Copyright, the First Amendment, and Google’s Use of Others’ Content*, 2007 DUKE L. & TECH. REV. 0005, ¶ 51; Liu, *supra* note 12, at 439 (taking the view that the current conflict between copyright and free speech is inaccurate and instead “needs to be analyzed in terms of the copyright owner’s property interest versus the other party’s speech interest”); Christopher A. Mohr, *Traditional Contours of Copyright: Silver Lining or Storm Clouds?*, 1 No. 1

The U.S. Court of Appeals for the Tenth Circuit in 2007, in *Golan v. Gonzales*, addressed whether a specific change to copyright laws altered a traditional contour of copyright, thus necessitating First Amendment review.⁴⁶ Plaintiffs in *Golan* challenged section 514 of the 1994 Uruguay Round Agreements Act (“URAA”), which provided copyright protection to foreign works that were still in copyright in their country of origin, but were in the public domain in the United States because their authors failed to comply with U.S. copyright law formalities, or because the United States did not recognize copyright from the author’s nation at the time the work was created.⁴⁷ By agreeing to section 514 of the

LANDSLIDE 30, 34 (2008); Daniel Choi, Recent Development, *Golan v. Gonzalez* [sic]: *The Stalemate Between the First Amendment and Copyright Continues*, 9 N.C. J. L. & TECH. 219, 233–41 (2008); Carrie Claiborne, Comment, *Golan v. Gonzales and the Changing Balance Between the First Amendment, Copyright Protection, and the Rest of the World*, 86 DENV. U. L. REV. 1113, 1128–32 (2009); Krystal Joy Gallagher, Note, *Golan v. Gonzales: An Opportunity to Re-examine the Relationship Between First Amendment Rights and Copyright Protection*, 9 NEV. L. J. 453, 453 (2009); William McGinty, Comment, *First Amendment Rights to Protected Expression: What Are the Traditional Contours of Copyright Law?*, 23 BERKELEY TECH. L.J. 1099, 1140 (2008) (advocating the application of First Amendment review to all amendments made to the copyright laws, arguing that only then will First Amendment interests be protected and suggesting that this review should take into account the “depth of the transgression” from the traditional contours of copyright law to determine what level of scrutiny is appropriate); Matthew Miller, III, Note, *Golan v. Gonzales: How Copyright Restoration Alters the Ordinary Copyright Sequence and Invites First Amendment Review*, 10 TUL. J. TECH. & INTELL. PROP. 353, 362 (2007); J. Blake Pinard, Note, *Defending the Public Domain—The First Amendment, the Copyright Power, and the Potential of Golan v. Gonzales*, 61 OKLA. L. REV. 395, 424 (2008); Recent Case, *Golan v. Gonzales*, 501 F.3d 1179 (10th Cir. 2007), 121 HARV. L. REV. 1945, 1946, 1949 (2008) (arguing that *Golan*, though consistent with *Eldred*’s traditional contours language, is flawed because “*Golan*’s history-based test . . . overlooks changes in copyright doctrine that undermine the assumption that copyright and the First Amendment are automatically compatible,” and by adopting a broad interpretation of historical tradition, can forgo all First Amendment scrutiny, and advocating an interpretation of *Eldred* that “require[s] First Amendment analysis whenever new legislation impairs speech interests in a manner that copyright’s internal protections cannot prevent or cure”). Others, like Marybeth Peters, the Register of Copyrights, continue to believe that all needed First Amendment speech protection is internal to the copyright statute. See Marybeth Peters, *Constitutional Challenges to Copyright Law*, 30 COLUM. J. L. & ARTS 509, 529 (2007) (arguing that no First Amendment review is appropriate in copyright cases and stating “[w]hile the persons challenging the laws in each of these cases had something serious to say about whether the particular law reflected good policy or was otherwise flawed, there is nothing about any of these [copyright] statutes that takes them outside of Congressional power to legislate. What the courts are telling us is ‘if you don’t like the current state of the law, don’t complain to us. Talk to Congress.’”).

⁴⁶ *Golan v. Gonzales* (*Golan I*) 501 F.3d 1179, 1182 (10th Cir. 2007). I had a very minor role in this appeal as one of the attorneys for the plaintiffs. I emphasize that the opinions expressed in this Article are mine and mine alone.

⁴⁷ Pub. L. No. 103-465, 108 Stat. 4809, 4976–80 (1994) (codified at 17 U.S.C. §§ 104A, 109 (2006)).

URAA, the United States accepted Article 18 of the Berne Convention for the Protection of Literary and Artistic Works (“Berne Convention”), which it had previously refused to join for more than one hundred years.⁴⁸ The Berne Convention requires member countries to give equal copyright treatment to foreign and domestic authors. It also does away with copyright formalities and requires that signatory countries grant copyright protection to foreign works if those foreign works still have copyright protection in their countries of origin.⁴⁹ Thus, when the United States enacted legislation to comply with section 514 of the URAA, the legislation granted copyright status to certain foreign works that were previously in the public domain in the United States due either to copyright holders’ failure to comply with U.S. copyright formalities or failure to renew their copyrights.⁵⁰

Plaintiffs in *Golan* each relied on artistic works in the public domain for their livelihood.⁵¹ The plaintiffs included orchestra conductors, educators, performers, publishers, archivists, and others who made use of works in the public domain.⁵² Many of the plaintiffs made use of these works because they could not afford to pay copyright licenses for uses that were often local or non-profit.⁵³ Others had created derivative works based on foreign works in the public domain.⁵⁴ The plaintiffs claimed that the URAA unconstitutionally interfered with their protected First Amendment interests in making use of public domain works.⁵⁵

The district court disagreed, and held both that “Congress has historically demonstrated little compunction about removing copyrightable materials from the public domain” and that the plaintiffs had no First Amendment interests in the now-copyrighted foreign works.⁵⁶ The plaintiffs appealed to the Tenth Circuit, which took a different view.⁵⁷

The Tenth Circuit held that the URAA’s validity under the Copyright Clause did not make it immune to challenges based on other pro-

⁴⁸ Berne Convention Implementation Act, Pub. L. No. 100-568, 102 Stat. 2853 (1988); *Golan I*, 501 F.3d at 1182 n.2.

⁴⁹ 17 U.S.C. §§ 104A, 109; *Golan I*, 501 F.3d at 1189.

⁵⁰ 17 U.S.C. §§ 104A, 109.

⁵¹ 501 F.3d at 1183.

⁵² *Id.* at 1181.

⁵³ *Id.* at 1182.

⁵⁴ *Id.*

⁵⁵ *Id.* at 1182–83.

⁵⁶ *Id.* at 1183 (quoting *Golan v. Gonzales*, No. Civ. 01-B-1854 (BNB), 2005 WL 914754, at *14 (D. Colo. Apr. 20, 2005)).

⁵⁷ *Golan I*, 501 F.3d at 1183.

visions of the Constitution, such as the First Amendment.⁵⁸ The Tenth Circuit began by addressing the Supreme Court's statement in *Eldred* that copyright laws should get the presumption of constitutionality vis-à-vis the First Amendment, so long as the laws do not "alter[] the traditional contours of copyright protection."⁵⁹ After a detailed examination of the history of copyright laws in the United States, the Tenth Circuit concluded that "the traditional contours of copyright protection include the principle that works in the public domain remain there and that § 514 [of the URAA] transgresses this critical boundary."⁶⁰

The Tenth Circuit analyzed how this alteration of the traditional contours of copyright affected the First Amendment interests of the plaintiffs.⁶¹ The court found two First Amendment interests that plaintiffs had in the formerly public domain foreign works.⁶² First, it held that everyone has a non-exclusive right to use material in the public domain.⁶³ Second, it held that "the First Amendment protects plaintiffs' right to unrestrained artistic use of these works."⁶⁴

Thus, according to the Tenth Circuit, "at the moment that Dmitri Shostakovich's *Symphony No. 5* entered the public domain, Plaintiff John Blackburn had a right to create a derivative work for a high school

⁵⁸ *Id.* at 1187 (citing *Saenz v. Roe*, 526 U.S. 489, 508 (1999); *Buckley v. Valeo*, 424 U.S. 1, 132 (1976)).

⁵⁹ *Eldred*, 537 U.S. at 221.

⁶⁰ *Golan I*, 501 F.3d at 1189. The D.C. Circuit came to the opposite conclusion—that removal of works from the public domain had been done several times in the past under federal copyright laws. See *Luck's Music Library, Inc. v. Gonzales*, 407 F.3d 1262, 1265–66 (D.C. Cir. 2005). But the Tenth Circuit's analysis seems better-reasoned. The Tenth Circuit noted that the government's purported examples of copyright laws that removed works from the public domain—such as the first Copyright Act passed in 1790, various laws allowing registration of foreign works that could not be registered during World War II, and a handful of private bills—were at best exceptions to the traditional rule in copyright that works in the public domain stay there. *Golan I*, 501 F.3d at 1192.

⁶¹ *Golan I*, 501 F.3d at 1192.

⁶² *Id.* at 1192–93.

⁶³ *Id.* at 1192.

⁶⁴ *Id.* at 1193. The court noted that "[t]he Supreme Court has emphasized that the right to artistic expression is near the core of the First Amendment." *Id.* The Tenth Circuit explained that:

Music is one of the oldest forms of human expression. From Plato's discourse in the Republic to the totalitarian state in our own times, rulers have known [music's] capacity to appeal to the intellect and to the emotions, and have censored musical compositions to serve the needs of the state. . . . The Constitution prohibits any like attempts in our own legal order. Music, as a form of expression and communication, is protected under the First Amendment.

Id. (quoting *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989)).

band to perform at an event commemorating 9/11.”⁶⁵ Once created, the First Amendment protected Blackburn’s right to perform his derivative work.⁶⁶ Section 514 of the URAA impinged on Blackburn’s and the other plaintiffs’ First Amendment rights because the owners of the now-copyrighted original material could now charge fees for the performance of plaintiffs’ derivative works.⁶⁷ The court found the plaintiffs’ First Amendment interests greater than those of the plaintiffs in *Eldred*, because plaintiffs in *Eldred* had never enjoyed unfettered access to the works in question.⁶⁸ The *Golan* plaintiffs, by contrast, used works in the public domain as the bases for public performances and to make derivative works of their own. Thus, by removing works from the public domain, the court held that section 514 of the URAA “hampers free expression and undermines the values the public domain is designed to protect.”⁶⁹

The Tenth Circuit also held that “copyright’s built-in free speech safeguards are not adequate to protect the First Amendment interests at stake.”⁷⁰ The court held that neither the idea/expression dichotomy nor the fair use defense were adequate to protect plaintiffs’ First Amendment interests in making use of the formerly public domain works.⁷¹ Although the idea/expression dichotomy protects speech interests by allowing an author to copyright only her expression of an idea, but not the idea itself, in this case plaintiffs had previously had rights to the whole of the now-copyrighted works. The idea/expression dichotomy did not serve to protect these rights.⁷² Likewise, although fair use allows the use of a portion of a work for certain purposes such as “criticism, comment, news reporting, teaching . . . , scholarship, or

⁶⁵ *Id.*

⁶⁶ *Id.*

⁶⁷ See 17 U.S.C. § 104A(d)(3) (allowing creator of derivative work created while foreign work was in public domain to continue using work if reasonable compensation was paid to copyright owner, which compensation is determined via normal infringement damages analysis); *Golan I*, 501 F.3d at 1193. If the creator of the derivative work cannot pay the fee to the copyright owner, not only would he not be able to use his derivative work, but if the holding of cases such as *Anderson v. Stallone* is followed, the owner of the copyright in the original work could use the derivative work at will, and is the only party who could license others to use the derivative work. See, e.g., No. 87-0592 WDKGX, 1989 WL 206431 (C.D. Cal. Apr. 25, 1989) (giving copyright owner exclusive rights to derivative work created without authorization).

⁶⁸ *Golan I*, 501 F.3d at 1193.

⁶⁹ *Id.* at 1193–94 (citing *Meade v. United States*, 27 Fed. Cl. 367, 372 (Fed. Cl. 1992)).

⁷⁰ *Id.* at 1196.

⁷¹ *Id.* at 1194.

⁷² *Id.*

research,” it could not serve to protect plaintiffs’ interests in using the whole of the works that had been removed from the public domain.⁷³

In addition, the court noted that unlike the CTEA, the URAA did not supplement the traditional First Amendment safeguards of copyright law.⁷⁴ When Congress passed the CTEA, it gave additional protections to certain users of the works whose terms were extended. The CTEA gave certain rights to libraries, archives, and similar institutions for their actions related to preservation, scholarship, or research in the last twenty years of a work’s copyright. The CTEA also exempted small businesses and restaurants from paying performance royalties for music or television programs played from the radio, television, or the like.⁷⁵ Unlike the CTEA, the URAA provided no supplemental First Amendment protections, other than a one-year safe harbor for using a restored work.⁷⁶

The Tenth Circuit remanded the case to the district court for consideration of whether section 514 of the URAA is content-based or content-neutral and whether it passes constitutional muster under the appropriate level of scrutiny.⁷⁷ On remand the district court held that the URAA is content neutral,⁷⁸ and thus applied intermediate scrutiny.⁷⁹ Under intermediate scrutiny, the court held that the URAA violated plaintiffs’ First Amendment interests.⁸⁰ The district court held:

Congress has a legitimate interest in complying with the terms of the Berne Convention. The Berne Convention, however, affords each member nation discretion to restore the copy-

⁷³ *Id.* at 1195–96 (quoting 17 U.S.C. § 107).

⁷⁴ *Golan I*, 501 F.3d at 1196.

⁷⁵ *Id.* at 1195–96 (citing *Eldred*, 537 U.S. at 220 (quoting 17 U.S.C. § 108(h))).

⁷⁶ *Id.* at 1196 (citing 17 U.S.C. § 104A(d)(2)).

⁷⁷ *Id.*

⁷⁸ *Golan v. Holder (Golan II)*, 611 F. Supp. 2d 1165, 1170 (D. Colo. 2009) (“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. Accordingly, Section 514 must be reviewed under the ‘content-neutral’ standard.”) (internal citation omitted).

⁷⁹ *Id.* at 1170–71. The district court stated:

While a content-neutral restriction must be “narrowly tailored to serve a significant government interest” unrelated to the suppression of free speech, it “need not be the least restrictive or least intrusive means of doing so.” The requirement of narrow tailoring is satisfied so long as the restriction promotes a substantial government interest that would be achieved less effectively absent the restriction.

Id. (citing *Ward*, 491 U.S. at 791, 798–99).

⁸⁰ *Id.* at 1177.

rights of foreign authors in a manner consistent with that member nation's own body of copyright law. In the United States, that body of law includes the bedrock principle that works in the public domain remain in the public domain. Removing works from the public domain violated Plaintiffs' vested First Amendment interests. In light of the discretion afforded it by the Berne Convention, Congress could have complied with the Convention without interfering with Plaintiffs' protected speech. Accordingly—to the extent Section 514 suppresses the right of reliance parties to use works they exploited while the works were in the public domain—Section 514 is substantially broader than necessary to achieve the Government's interest.⁸¹

In determining that the URAA was not sufficiently narrowly tailored, the district court may have considered footnote five of the Tenth Circuit's opinion. There the Tenth Circuit noted that in complying with the Berne Convention, the copyright laws of the United Kingdom, Canada, Australia, and India give parties who incurred any expenditure or liability in making use of a formerly public domain work the right to continued use of that work even after the work is covered by copyright.⁸² The copyright owner can only stop the relying party from using the work if the copyright owner pays compensation to the user of the work, in an amount determined by negotiation or arbitration.⁸³ Thus, the district court had concrete examples of more narrowly tailored means to serve the Government's interest in complying with the Berne Convention.

II. SUBJECTING COPYRIGHT LAW TO FIRST AMENDMENT SCRUTINY AFTER *ELDRED*

The discussions of the First Amendment and copyright in *Eldred v. Ashcroft* and *Golan v. Gonzales* raise the question: are there other areas of current copyright law that should be subject to First Amendment scrutiny? I believe that the answer is yes. Specifically, the abandonment of formalities and registration requirements that has occurred in the last three decades is a huge change to the traditional contours of copy-

⁸¹ *Id.*

⁸² *Golan I*, 501 F.3d at 1197 n.5.

⁸³ *Id.* (citing Irwin Karp, *Final Report, Berne Article 18 Study on Retroactive United States Copyright Protection for Berne and Other Works*, 20 COLUM.-VLA J.L. & ARTS 157, 178 (1996)).

right.⁸⁴ These changes have shifted the traditional balance between First Amendment interests and copyright interests in ways that significantly impair First Amendment interests. Thus, certain adjustments to copyright may now be constitutionally required, even though they were not required in the past. Some of these necessary accommodations are discussed below.

As described earlier, the interests of speakers and listeners under the First Amendment are in tension with copyright law's grant of exclusivity to authors.⁸⁵ The traditional argument has been that copyright encourages much more speech than it restricts,⁸⁶ and only limits other's rights to use copyrighted speech and the community's right to hear copyrighted speech for a reasonably limited time.⁸⁷ But the elimination of registration requirements and formalities, along with term extensions in the last three decades, call this balance between First Amendment and copyright law into question and require First Amendment scrutiny and additional accommodations on the part of copyright law.

In the following paragraphs I briefly describe the changes to the traditional contours of copyright that have occurred in the last three decades.⁸⁸ It is well known that the ways in which we create, distribute, critique, imitate, and copy writings and graphic arts have changed enormously in the three decades since the advent of the personal computer.⁸⁹ Much ink has been spilled and many pixels lighted detailing the powerful changes computers, cheap memory, digitization, the Internet, and increasing broadband adoption have wrought in the way that content is created and copyright enforcement challenged.⁹⁰ But at

⁸⁴ See *supra* notes 48–50 and accompanying text.

⁸⁵ See Goldstein, *supra* note 1, at 991, 995.

⁸⁶ See, e.g., Bendor, *supra* note 12, at 325; Goodman, *supra* note 12, at 1234; Liu, *supra* note 12, at 387.

⁸⁷ See, e.g., Bendor, *supra* note 12, at 325; Goodman, *supra* note 12, at 1234; Liu, *supra* note 12, at 387.

⁸⁸ I am by no means the first to describe how vastly copyright law has changed in recent decades. See, e.g., LESSIG, *supra* note 18, 130–73; Garfield, *supra* note 1, at 1206; Joseph P. Liu, *Copyright and Time: A Proposal*, 101 MICH. L. REV. 409, 413–25 (2002); Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485, 491–93 (2004). I believe I am, however, the first to frame this change as a massive alteration to the traditional contours of copyright necessitating First Amendment scrutiny in light of *Eldred* and *Golan*.

⁸⁹ See generally LAWRENCE LESSIG, *REMIX: MAKING ART AND COMMERCE THRIVE IN THE HYBRID ECONOMY* (2008).

⁹⁰ See Note, *Visual Artists' Rights in a Digital Age*, 107 HARV. L. REV. 1977, 1979 (1994). Commentators suggest:

Digital technology is likely to bring about several changes, both positive and negative, in the art world. First, by enabling the making of perfect copies of copyrighted works for little cost, digital technology threatens to undermine

least as important as technological changes are the profound changes to copyright law itself that have resulted in an unprecedented increase in the number of works copyrighted and the length of time copyright endures. In 1976—the same year that the Apple I personal computer was created⁹¹—Congress changed copyright law from an “opt-in” registration system, in which less than half of all new works were copyrighted each year and the average copyright lasted less than three decades,⁹² to a longer-term automatic copyright system from which it is relatively difficult to “opt-out.”⁹³

Prior to the 1976 Copyright Act, authors had to comply with formalities and register their works in order to receive copyright protection.⁹⁴ The result was that about half of otherwise-qualifying works were never registered.⁹⁵ In addition, the copyright term was fairly short be-

the current entertainment product distribution systems and increase unauthorized use of copyrighted works. Second, digital technology increases the public's access to others' creations by enabling entertainment producers to create and distribute products of all kinds in a single (digital) format.

See id. (internal citation omitted). *See generally* LAWRENCE LESSIG, CODE 2.0 (2006) (detailing the rise of digital technologies); Ben Depoorter, *Technology and Uncertainty: The Shaping Effect on Copyright Law*, 157 U. PA. L. REV. 1831 (2009) (examining technology and copyright law); Mary L. Mills, Note, *New Technology and the Limitations of Copyright Law: An Argument for Finding Alternatives to Copyright Legislation in an Era of Rapid Technological Change*, 65 CHI.-KENT L. REV. 307 (1989) (describing challenges copyright law faces in light of changing technologies).

⁹¹ Steve Wozniak and Steve Jobs created the Apple I computer in March 1976, and founded Apple Computer, Co. on April Fools' Day, 1976. *See* Lev Grossman, *80 Days That Changed the World: April 1, 1976*, TIME.COM, Mar. 23, 2003, <http://www.time.com/time/80days/760401.html>. In March 1977, they created the Apple II computer, which many consider to have been the first affordable and easily-usable personal computer. *See* Inventor of the Week Archive, Steve Jobs & Steve Wozniak, The Personal Computer, <http://web.mit.edu/invent/iow/apple.html> (last visited Sept. 28, 2009).

⁹² *See* Sprigman, *supra* note 88, at 491–93.

⁹³ *See* Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended in scattered sections of 17 U.S.C.).

⁹⁴ 1909 Copyright Act, ch. 320, § 4, 35 Stat. 1075 (repealed 1976).

⁹⁵ *See* Lisa M. Brownlee, *Recent Changes in the Duration of Copyright in the United States and European Union: Procedure and Policy*, 6 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 579, 600–02 (1994) (explaining that works created before January 1, 1978, were subject to statutory formalities that, if not met, caused works to fall into the public domain, and consequently, a large number of works governed by the 1909 Act are out of copyright due to failure to comply with the 1909 Act's formalities); Sprigman, *supra* note 88, at 519. Professor Sprigman explains:

Until it was eliminated by the 1976 Act (for pre-1978 works) and the Copyright Renewal Act (for all other works), the renewal formality served as another filter, one that operated later in the lifecycle of the copyrighted work as an ex post test of commercial viability. . . . Historically, approximately 15% of works were renewed, meaning that 85% of works moved into the public do-

fore 1976, lasting only fourteen years at first,⁹⁶ and eventually extending to twenty-eight years.⁹⁷ If an author wanted to renew his copyright, he had to pay a fee and officially renew the work.⁹⁸ Approximately eighty-five percent of copyrighted works were never renewed.⁹⁹ This regime meant that for the entirety of U.S. history prior to the 1976 Copyright Act, (1) many works of authorship were never covered by copyright at all, and (2) the vast majority of copyrighted works lost copyright protection within fourteen to twenty-eight years.¹⁰⁰

The 1976 Copyright Act worked a sea change on the practice of copyright in the United States. The Act included two important alterations. It extended copyright terms to life of the author plus fifty years, and it did away with the registration requirement and all formalities for achieving copyright protection for a work.¹⁰¹ Thus, since January 1, 1978, virtually every bit of expression set down in a “tangible medium” has automatically received copyright protection for life of the author plus fifty years and seventy-five years for certain older works and works made for hire.¹⁰² Subsequently, the CTEA extended all copyright terms

main—by consent of rightsholders—after a relatively short term of protection.

Sprigman, *supra* note 88, at 519.

⁹⁶ 1790 Copyright Act, ch. 15, § 1, 1 Stat. 124 (repealed 1831).

⁹⁷ 1870 Copyright Act, ch. 230, § 90, 16 Stat. 198 (repealed 1909); R. Anthony Reese, Note, *Reflections on the Intellectual Commons: Two Perspectives on Copyright and Duration and Reversion*, 47 STAN. L. REV. 707, 716 (1995) (describing that the 1870 Copyright Act provided for a bipartite copyright term: a twenty-eight-year original term followed by a fourteen-year renewal term; the 1909 Copyright Act granted an author a copyright that lasted for an original term of twenty-eight years, and provided for a renewal and extension of an additional twenty-eight years, extending the maximum copyright term to fifty-six years).

⁹⁸ Sprigman, *supra* note 88, at 493 (“[A]t its inception the American copyright system required compliance with a series of formalities that included registration, deposit, and notice via both marking and published announcement.”).

⁹⁹ *Id.* at 519.

¹⁰⁰ *Id.* at 522; *see also* Stewart v. Abend, 495 U.S. 207, 217 (1990) (“Since the earliest copyright statute in this country, the copyright term of ownership has been split between an original term and a renewal term.”).

¹⁰¹ *See* Netanel, *supra* note 4, at 23.

¹⁰² If an author does not want the full extent of copyright protection, he must affirmatively opt-out of the default maximum copyright protection. An author may either disclaim copyright in his work or choose to reserve only limited rights via licenses such as those provided by Creative Commons. *See, e.g.*, Licenses, Creative Commons, <http://creativecommons.org/about/licenses> (last visited Sept. 25, 2009). Only a small percentage of authors disclaim copyright or limit their copyright interest in their works, however, resulting in a vast majority of material that is automatically covered for the maximum term of copyright. *See* Sprigman, *supra* note 88, at 491 (explaining that an opt-out system provides that many “dead” works remain “locked-up” and unavailable for public use).

to life of the author plus seventy years and to ninety-five years for certain older works and works made for hire.¹⁰³

Congress made these changes out of concern for copyright owners and to comply with the Berne Convention for the Protection of Literary and Artistic Works, which mandated that formalities could not be used to bar copyright in many circumstances.¹⁰⁴ Congress may also have been independently concerned that copyright owners were losing their copyrights due to carelessness in complying with copyright formalities.¹⁰⁵ Eliminating the formalities eliminated the problem. Likewise, when Congress extended copyright terms after intense lobbying from corporate copyright owners like the Walt Disney Company, Congress was concerned with keeping valuable intellectual property in U.S. companies' hands.¹⁰⁶ What Congress does not seem to have focused on is the interest of users of copyrighted works. Making copyright owners register and renew their copyrights put the burden of attaining and keeping copyright—which was already low—on the copyright owners, who had the best information as to copyright value and thus were the least cost avoiders. Likewise, although copyright term extension benefited a select group of copyright owners who owned works that had long-term value, it denied the public the right to unrestricted use of both commercially valuable and non-valuable copyrighted works for an additional twenty years.

The significance of these copyright law changes on those who would quote, copy, or otherwise use another's pre-existing work should not be underestimated. A researcher working before 1978 would safely assume that things published more than fifty-six years ago were in the public domain and could be used freely. He would also likely assume that anything out of print and published longer than twenty-eight years ago was in the public domain, and he would be correct about eighty-five percent of the time. Finally, if a work bore no copyright notice, he would know immediately that the work was not covered by copyright and that he could freely use it.

¹⁰³ 17 U.S.C. §§ 102, 302 (2006).

¹⁰⁴ Berne Convention Implementation Act, Pub. L. No. 100-568, 102 Stat. 2853 (1988). The Berne Convention is available at http://www.wipo.int/treaties/en/ip/berne/trtdocs_wo001.html (last visited Oct. 21, 2009).

¹⁰⁵ See William M. Landes & Richard A. Posner, *Indefinitely Renewable Copyright*, 70 U. CHI. L. REV. 471, 500 (2003) (“[W]e cannot dismiss the possibility that some fraction of nonrenewals are due to simple oversight, or careless failure to comply with required formalities.”).

¹⁰⁶ See *id.* at 483 (noting “Disney’s successful efforts to lobby for the Sonny Bono [Copyright Term Extension] Act”).

Today's would-be user of copyrighted material faces a different scenario entirely. He knows that anything published since 1978 is automatically copyrighted for the life of the author plus seventy years. He knows that he may only safely use materials published over eighty-five years ago—prior to 1923.¹⁰⁷ For works published between 1923 and 1976, he must trace the history of registration and renewal to determine copyright status.¹⁰⁸ Although the pre-1976 Act researcher could make use of the vast majority of materials from just a generation or two earlier without running afoul of copyrights, today's researcher may need to seek copyright permission to use many materials from the last three or four generations. The researcher of 2108 will need to seek permission to use all materials created in the preceding seventy years and many works that are over one hundred years old will remain covered by copyright.

Some may see little cause for concern because use of others' work has a flavor of theft to it—one thinks of college students lobbying for the destruction of copyright so that they may download music freely. But an ever-growing body of literature points out that the more one looks at the concepts of novelty and originality in authorship, the more one realizes that, one way or another, there truly is (as Ecclesiastes tells us) “nothing new under the sun.”¹⁰⁹ For instance, in Judge Richard Posner's recent book, *The Little Book of Plagiarism*, Posner discusses the fact that Shakespeare could not have created his brilliant plays without extensive—and uncredited—use of numerous, and often recent, historical, and literary sources.¹¹⁰ Likewise, only a couple of generations ago, it was expected that persons of letters would quote without attribution from the works of others.¹¹¹ Such allusions were the mark of a well-read person.

¹⁰⁷ Works published prior to 1923 are in the public domain because prior to the 1976 Copyright Act, the 1909 Copyright Act provided a maximum term of fifty-six years (twenty-eight-year original term plus twenty-eight-year renewal term). See 17 U.S.C. § 24 (repealed 1976). The 1976 Act only extended copyright terms for works still in copyright. See 17 U.S.C. § 304 (2006). Thus, those works published before 1923 that had already entered the public domain remain there.

¹⁰⁸ See 17 U.S.C. § 304.

¹⁰⁹ See Oren Bracha, *The Ideology of Authorship Revisited: Authors, Markets, and Liberal Values in Early American Copyright*, 118 YALE L.J. 186, 188 n.4 (2008) (collecting numerous sources); Dan L. Burk & Mark A. Lemley, *Inherency*, 47 WM. & MARY L. REV. 371, 411 (2005) (arguing with regard to patented inventions that “in a very real sense there is nothing new under the sun”).

¹¹⁰ See RICHARD A. POSNER, *THE LITTLE BOOK OF PLAGIARISM* 51–74 (2007).

¹¹¹ *Id.* at 54–64.

But even when a user of copyrighted materials seeks to document each quote assiduously and to add value to a work rather than to divert sales, copyright law can stymie non-exploitative use of copyrighted material. The 2007 case of *Shloss v. Estate of James Joyce* is a good example.¹¹² In that case, Carol Shloss, a Stanford professor and James Joyce scholar, wrote a book on Joyce's relationship with his daughter Lucia and the way that relationship and Lucia's artistic work impacted Joyce's book, *Finnegans Wake*.¹¹³ Shloss's book in no way competed for sales with *Finnegans Wake* or any of the other materials from which she quoted. If anything, her book served as a complementary good that increased interest in *Finnegans Wake*. Nevertheless, because the copyright in Joyce's works is controlled by his grandson (Joyce died in 1941), who refused any discussion of licensing his grandfather's work for research into his aunt's life, Shloss's book was gutted of many of the supporting quotations before publication.¹¹⁴ After receiving pro bono representation from Lawrence Lessig and the Stanford Law School Center for Internet and Society's Fair Use Project, Shloss sued for a declaratory judgment of fair use in order to post the supporting quotations on her academic website. After a period of intense litigation, Shloss won her right to quote Joyce's work as needed for her project.¹¹⁵ The story ended happily for Shloss, though only after much time and aggravation. But she never would have had to fight that fight under the pre-1976 Act regime. And many authors never would have found the resources to fight.

Copyright does not only affect those wanting to quote written materials. Because dramatic arts such as music, choreography, and plays are also copyrighted, under the post-1976 Act regime, a community theater may not use dramatic works without license.¹¹⁶ Thus, many of the works of the last eighty-five years are off-limits to those who cannot pay a license fee. In practical effect, this also makes many works off-limits to the audiences of these community theaters and similar establishments, who now will not hear as many works from the last century. And going forward copyright will only be more restrictive, so that the majority of works from the previous century will be copyrighted.

The 1976 Copyright Act's elimination of formalities had other profound effects. As discussed above, prior to 1978, over ninety percent of

¹¹² 515 F. Supp. 2d 1083 (N.D. Cal. 2007). I served as counsel for Professor Shloss in this case. Accordingly, I emphasize that the opinions expressed here are my own.

¹¹³ See CAROL LOEB SHLOSS, *LUCIA JOYCE: TO DANCE IN THE WAKE* (2003).

¹¹⁴ *Shloss v. Estate of James Joyce*, 515 F. Supp.2d 1068, 1073 (N.D. Cal. 2007).

¹¹⁵ *Shloss*, 515 F. Supp. 2d at 1085–86.

¹¹⁶ 17 U.S.C. § 102(a) (2006).

works were in the public domain by the time of their renewal.¹¹⁷ Approximately half of all published works had never been copyrighted, and about eighty-five percent of copyrighted works did not have their copyrights renewed.¹¹⁸ Of the small percentage of works whose copyrights were renewed, determining who owned the copyright was fairly straightforward.¹¹⁹ Not only did the work have to be published with notice and registered, but upon renewal the copyright owner was on record again.¹²⁰ Thus, if one wanted to use a copyrighted work, generally one could quickly and easily determine with whom one should be negotiating. The abandonment of formalities and automatic term renewal has changed all of this and created a huge number of “orphan works.”

“Orphan works” is a term used to describe the many works that are now in copyright but are out of print, and for which it is difficult to determine the copyright owner.¹²¹ Because copyright now lasts so long, even when the original creator of a work can be easily identified, it may be very difficult to determine who owns the copyright after the originator has died. Although the ownership of copyrights in valuable works by famous authors is usually established at the time of death when other assets are divided, ownership of the copyrights of more ordinary people is less likely to be determined upon death. Thus, such rights likely pass with the residue of the estate.¹²² And once copyright ownership has passed beyond the original author, it may continue to be sold, given, or

¹¹⁷ See *supra* notes 1–3 and accompanying text.

¹¹⁸ See Jessica Litman, *Sharing and Stealing*, 27 HASTINGS COMM. & ENT. L.J. 1, 15 (2004).

¹¹⁹ See *id.*

¹²⁰ See *id.*

¹²¹ U.S. REGISTER OF COPYRIGHTS, REPORT ON ORPHAN WORKS I (2006), available at <http://www.copyright.gov/orphan/orphan-report-full.pdf>.

¹²² See LESSIG, *supra* note 18, at 223. Professor Lessig explains why the determination of ownership for lesser-known works is difficult:

As I've already described, there's no list of copyright owners. There are authors' names, of course, but their copyrights could have been assigned, or passed down in an estate like Grandma's old jewelry. To know who owns what, you would have to hire a private detective. The bottom line: The owner cannot easily be located. And in a regime like ours, in which it is a felony to use such property without the property owner's permission, the property isn't going to be used.

Id.; see also Lee-Ford Tritt, *Liberating Estates Law from the Constraints of Copyright*, 38 RUTGERS L.J. 109, 112 (2006) (“Current copyright law, however, imposes a unique restraint on the testamentary freedom of authors. The Copyright Act of 1976 . . . permits a statutorily designated group of heirs—ones not necessarily selected by the author—to control the disposition of the author's copyright interests after death.” (internal citations omitted)).

devised in a series of private, non-centrally recorded transactions. The puzzle of ownership can take significant time and energy to sort out, if the ownership interests can be sorted at all without an opinion from a court.¹²³

Given that the traditional contours of copyright law worked to create a large public domain of recent works, how should First Amendment scrutiny be applied to our modern copyright law regime of a much-diminished public domain? First, the U.S. Court of Appeals for the Tenth Circuit is plainly correct in holding that the traditional contours of copyright protection must extend farther than the idea/expression dichotomy and the fair use defense.¹²⁴ Although these traditional safeguards do much to protect First Amendment interests, one can easily imagine legislation passed under the 1976 Copyright Act that would impinge on First Amendment interests notwithstanding the idea/expression dichotomy and the fair use defense. Plaintiffs in the 2007 case of *Kahle v. Gonzales*—which challenged copyright law, in part, under the First Amendment—provide one such example.¹²⁵ Noting that “copyright law has traditionally been viewpoint neutral,” plaintiffs set forth the following scenario: “Imagine the European Union decided to deny copyright protection to ‘hate speech,’ and Congress, in an effort to ‘harmonize’ international copyright law, did the same.”¹²⁶ The plaintiffs asked whether, in such a case, First Amendment review would be appropriate. It obviously would.

Likewise, due 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. Indeed, affirming that First Amendment review of copyright laws may be necessary in cases such as these does no more than affirm the general rule that legislation drafted under one constitutional provision must be consistent with the remainder of the Constitution.¹²⁷

¹²³ See Tritt, *supra* note 122, at 112.

¹²⁴ *Golan v. Gonzales (Golan I)*, 501 F.3d 1179, 1182 (10th Cir. 2007).

¹²⁵ See 487 F.3d 697, 700 (9th Cir. 2007) (rejecting plaintiffs’ First Amendment challenge to the Copyright Term Extension Act based in part on *Eldred*).

¹²⁶ Petition for Writ of Certiorari, *Kahle*, No. 07-189, 2007 WL 2323450, at *15 (Aug. 10, 2007).

¹²⁷ See *Saenz v. Roe*, 526 U.S. 489, 508 (1999). The *Saenz* Court noted that:

Eldred should not be understood as a case defining when the Copyright Clause trumps the First Amendment, or holding that a couple of safeguards within copyright law are sufficient to protect all First Amendment interests that might arise under any conceivable copyright law. Rather, *Eldred* is better understood as setting forth a simple rule of judicial economy. *Eldred* makes two simple and straightforward assumptions.¹²⁸ First, the copyright laws that have developed over the last 200-plus years in the United States have adequately protected speech interests, and are therefore constitutional.¹²⁹ 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.¹³⁰ But where a copyright law does not conform to long-standing historical practice, no presumption of First Amendment compliance can be made.

III. COPYRIGHT LAW ACCOMMODATIONS OF FIRST AMENDMENT INTERESTS

As I have discussed above, the overall landscape of copyright law is now very different than it has been for most of the history of the United States.¹³¹ The contours of copyright law going forward will consist of a virtually non-existent public domain for works published in the last seventy to one hundred fifty years. Compared to the landscape before registration and formalities were eliminated in 1976—in which many works were never copyrighted and the vast majority were out of copyright within twenty-eight years—the current contours of copyright are about as untraditional as one could imagine.¹³² Moreover, the ability of the public to make use of, and hear, copyright-eligible speech has been severely impacted. This significant change to the traditional contours of copyright law permeates and affects copyright law generally. The balance between First Amendment speech interests and individuals’ inter-

Article I of the Constitution grants Congress broad power to legislate in certain areas. Those legislative powers are, however, limited not only by the scope of the Framers’ affirmative delegation, but also by the principle that they may not be exercised in a way that violates other specific provisions of the Constitution.

Id. (internal quotations omitted).

¹²⁸ See *Eldred v. Ashcroft*, 537 U.S. 186, 208, 218–20 (2003).

¹²⁹ See *id.* at 208, 218.

¹³⁰ *Id.* at 218–20.

¹³¹ See *supra* notes 30–130 and accompanying text.

¹³² See *supra* notes 15–18 and accompanying text.

ests in commenting on, using, or hearing copyright-eligible speech has been changed so severely as to have been, in practical effect, upended. This upending so thoroughly affects individuals' First Amendment interests that numerous accommodations are needed to restore the balance so that copyright law encourages speech as much as it restricts it.

I will now discuss how copyright law should be scrutinized under the First Amendment and some of the accommodations that taking First Amendment scrutiny of copyright law seriously will entail. The best place to begin is with the changes to copyright law in the 1976 Copyright Act that eliminated registration and formalities.¹³³ Should these changes to copyright law be subjected to First Amendment scrutiny, and if so, can they withstand such scrutiny?

A. Accommodations to Registration/Formalities Regime

I should note at the outset that the elimination of formalities has never been scrutinized under the First Amendment. It is true that the U.S. Court of Appeals for the Ninth Circuit in the 2007 case of *Kahle v. Gonzales* held that the retroactive elimination of formalities did not raise the need for First Amendment scrutiny.¹³⁴ But the court there explicitly limited its consideration to the challenge to retroactivity rather than to whether the elimination of copyright formalities alters the traditional contours of copyright.¹³⁵ Indeed, although the court acknowledged that the change from opt-in copyright to opt-out copyright is very significant,¹³⁶ it never directly dealt with the constitutionality of formalities because it focused on the fact that the plaintiffs only challenged the elimination of formalities retroactively during a limited period.¹³⁷ Thus the Ninth Circuit addressed only the question of whether Congress had power to apply copyright laws retroactively, which *Eldred*

¹³³ See Copyright Act of 1976, Pub. L. No. 94-553 (codified as amended in scattered sections of 17 U.S.C.).

¹³⁴ See 487 F.3d 697, 699 (9th Cir. 2007).

¹³⁵ The plaintiffs characterized this as a change from an "opt-in" copyright system to an "opt-out" system. *Id.* Under the previous, opt-in system, formalities were required to gain copyright protection, and most copyrighted works were not renewed. Thus, the opt-in system created a large public domain. *See id.*

¹³⁶ The court accepted that renewal requirements both limited orphan works and made it so that "only a small percentage" of creative works were under copyright for the maximum term. *Id.* The court also acknowledged that "[e]liminating the renewal requirement dramatically increased the average copyright term and correspondingly decreased the number of works currently entering the public domain." *Id.*

¹³⁷ The plaintiffs in *Kahle* limited their challenge to the elimination of renewal requirements for works created between 1964 and 1977. They did not challenge the elimination of the renewal requirement or of other formalities generally. *See id.* at 699–700.

v. Ashcroft had held it did.¹³⁸ The question of whether eliminating formalities is a change in the traditional contours of copyright such that First Amendment scrutiny should be applied therefore has not yet been raised or decided. This Article attempts to answer that question.

In evaluating the constitutionality of the 1976 Copyright Act's elimination of formalities, the first issue to address is whether the act is already beyond reproach under the First Amendment. After all, in many areas of life and law, three decades is a long enough time for a change in law to become a "traditional contour." Indeed, a young generation of authors has grown up without any need to concern itself with formalities. Is this enough to qualify the elimination of formalities as constitutional under the First Amendment without need for further inquiry? The answer seems almost certainly no. Because the *Eldred* rule is best thought of as one of judicial economy, and because the elimination of formalities worked such a significant change to the nearly two centuries of copyright law that came before, the elimination of formalities should not be held to be a traditional contour of copyright such that it prima facie is immune to any First Amendment review.

Once First Amendment review is deemed appropriate, the First Amendment interests at stake must be identified. The interests are the ones that have already been identified in this Article—the public's interest in not having its rights to use and hear copyright-eligible materials drastically reduced for a very long time. Indeed, the First Amendment interests of the public in having a rich public domain of recent works are significantly and negatively affected by the elimination of formalities.¹³⁹

Of course, under an intermediate scrutiny analysis, the public's First Amendment interests that are negatively affected by the change in the law may have to give way if the elimination of formalities is nevertheless "narrowly tailored to serve . . . substantial government inter-

¹³⁸ Instead of delving into whether the elimination of the renewal requirement changed the traditional contours of copyright law, the court treated the question as whether Congress could place existing copyrighted work in parity with future works by eliminating the renewal requirement for both, and held that *Eldred* summarily disposed of this question. *See id.* at 700. According to the Ninth Circuit, the U.S. Supreme Court had already ruled "that when Congress passed the CTEA, it 'placed existing and future copyrights in parity. In prescribing that alignment . . . Congress acted within its authority and did not transgress constitutional limitations.'" *Id.* (quoting *Eldred v. Ashcroft*, 537 U.S. 186, 194 (2003)). Thus, a broad reading of the Ninth Circuit's reasoning in *Kahle* would mean that under *Eldred* any retroactive change in copyright law is constitutional so long as the change is aimed at providing parity for existing and future works.

¹³⁹ *See infra* notes 153–160 and accompanying text.

est.”¹⁴⁰ Thus, to properly analyze the validity of the 1976 Act’s elimination of formalities under the First Amendment, one must determine the government interests at stake.¹⁴¹ There are three government interests potentially served by the elimination of formalities. First, the government has an interest in harmonizing domestic copyright law with international law, and thus has an interest in complying with the Berne Convention.¹⁴² Second, eliminating formalities and extending copyright terms gives greater protection to all written work, and could thus be said to further incentivize authorship, although the amount of additional incentive is economically miniscule.¹⁴³ Finally, the government can point to its equitable interest in preventing the loss of copyright for authors who fail to achieve copyright on their works due solely to technical missteps that prevent them from complying with copyright formalities.¹⁴⁴

Although each of these interests may seem significant, the question is whether the complete elimination of formalities is “narrowly tailored” to serve these interests. Taking the last two interests first, there surely are ways to incentivize authorship without eliminating formalities. In fact, Congress has engaged in just such incentivization by increasing copyright terms repeatedly.¹⁴⁵ Thus, the complete elimination of formalities does not seem narrowly tailored to incentivize authorship.

Likewise, the government’s interest in ensuring that authors do not forfeit all rights to their works due to inadvertent failure to comply with formalities does not demand a complete elimination of all formalities. Rather, limited rights for authors to revive inadvertently-lost copyrights could serve this interest with a much narrower fit.

When it comes to the government’s interest in complying with the Berne Convention, however, because the Convention demands the elimination of formalities that affect the enjoyment and exercise of economic rights related to copyright, it seems at first glance that there is no more narrowly tailored way to comply with the Convention than through the elimination of formalities.¹⁴⁶

¹⁴⁰ See *Ward v. Rock Against Racism*, 491 U.S. 781, 798–99 (1989).

¹⁴¹ *Cf. Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 70 (1983) (“We must . . . determine whether the Government’s interest . . . is a substantial one.”).

¹⁴² *Golan v. Holder (Golan II)*, 611 F. Supp. 2d 1165, 1177 (D. Colo. 2009).

¹⁴³ *Golan v. Gonzales (Golan I)*, 501 F.3d 1179, 1188 (10th Cir. 2007).

¹⁴⁴ *Golan II*, 611 F. Supp. 2d at 1177.

¹⁴⁵ See Netanel, *supra* note 4, at 23.

¹⁴⁶ Berne Convention Implementation Act, Pub. L. No. 100-568, 102 Stat. 2853 (1988).

But first impressions can be deceiving. Christopher Sprigman has written extensively about how a system of voluntary compliance with formalities and registration could be adopted in the United States that would comply with the Berne Convention but better protect the interests of the public in using and hearing copyright-eligible material, especially when it comes to orphan works.¹⁴⁷ Sprigman proposes that the United States adopt “new-style formalities” that “preserve formally voluntary registration, notice, and recordation of transfers (and reestablish a formally voluntary renewal formality) for all works . . . but then incent compliance by exposing the works of noncompliant rightsholders to a ‘default’ license that allows use for a predetermined fee.”¹⁴⁸

The 1976 Copyright Act already contains an incentive that encourages registration of copyrighted works. If an author does not register her work within three months of publication, she is not eligible to seek attorney’s fees or statutory damage awards in infringement cases.¹⁴⁹ This is a considerable incentive because statutory damages range from \$750 to \$30,000 per work infringed,¹⁵⁰ and can be increased to \$150,000 per work infringed if a court finds that the defendant’s infringement was willful.¹⁵¹ One might think that requiring registration to be eligible for statutory damages would encourage widespread registration of copyrighted works, but this is not the case. Although large commercial entities holding valuable copyrighted works do scrupulously register their copyrights,¹⁵² smaller entities and individual authors often do not register within the required three months from publication.¹⁵³ In addition, many works that are thought to be of little commercial value are never registered. Moreover, even works that are initially registered are not immune from becoming orphan works. Because copyright now subsists for such a long period of time, the lack of any requirement to renew or register transfers creates orphan works.¹⁵⁴ For the person who would like to make use of that work but cannot locate the copyright holder, the

¹⁴⁷ See Sprigman, *supra* note 88, at 555.

¹⁴⁸ *Id.*

¹⁴⁹ 17 U.S.C. §§ 408(f), 412 (2006).

¹⁵⁰ 17 U.S.C. § 504(c)(1) (2006).

¹⁵¹ *Id.* § 504(c)(2).

¹⁵² See Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 WM. & MARY L. REV. (forthcoming Nov. 2009) (manuscript at 12, available at <http://ssrn.com/abstract=1375604>) (describing the registration requirement as “a substantial boon to major copyright industry players”).

¹⁵³ See *id.* (“Because individual authors and small firms do not typically register their copyrights within three months of publication, they rarely qualify for statutory damages or attorney’s fee awards.”); see also Sprigman, *supra* note 88, at 496.

¹⁵⁴ See *supra* notes 121–123 and accompanying text.

fear of a statutory damages award will often chill even a use that has First Amendment value and that would cause little or no actual damage to the copyright holder.

Thus, Sprigman's suggestion that we incentivize authors not only to register their works initially, but also to renew their works and register ownership changes makes sense.¹⁵⁵ I do not believe that we have to go as far as giving only low predetermined fines to copyright owners who do not register their works, however. Rather, simply tying the availability of statutory damages to renewing and registering ownership changes would go a long way toward lifting some of the excessive chill of First Amendment speech that the current copyright regime creates, especially when it comes to works that were originally registered but whose current rightsholders are unknown.¹⁵⁶

The First Amendment may require that some system such as Sprigman's be adopted to limit the effect of the abandonment of formalities and provide additional protection to the First Amendment interests of those who would use or hear copyrighted speech. Thus, First Amendment interests may require that absent voluntary registration and renewal, only default royalty payments or license rates may be charged against infringers rather than actual damages. Or use of unregistered works could make a user liable only for payment of a predetermined fee, somewhat like the compulsory mechanical license available for use of composition copyrights.¹⁵⁷

Another accommodation of First Amendment interests would be achieved by adopting Joseph Liu's proposal that "the older a copyrighted work is, the greater the scope of fair use should be."¹⁵⁸ Liu bases his proposal on one of the same issues that concerns this Article: that copyright term extension has left us with a greatly diminished public domain.¹⁵⁹ Liu argues that increasing the scope of fair use as a work ages both serves the public's increasing interest in being able to reuse older works, and does not excessively diminish incentives to produce copyrighted works.¹⁶⁰ This suggestion, although sensible in its own right, also comports with First Amendment interests in using older

¹⁵⁵ Sprigman, *supra* note 88, at 555 (arguing for a system that would "preserve formally voluntary registration, notice, and recordation of transfers . . . but then incent compliance by exposing the works of noncompliant rightsholders to a 'default' license that allows use for a [low] predetermined fee").

¹⁵⁶ *Cf id.*

¹⁵⁷ See 17 U.S.C. § 115 (2006).

¹⁵⁸ See Liu, *supra* note 88, at 410.

¹⁵⁹ *Id.* at 411.

¹⁶⁰ *Id.* at 412.

works that once would have been available to the public but now will remain in copyright for many additional decades.

B. *Accommodations in Copyright Remedies*

First Amendment analysis of the current copyright law regime may also necessitate adjustments to remedies available against copyright defendants. The vastly different contours of current copyright law may require changes and lessening of damages in certain kinds of copyright cases. Current copyright law gives plaintiffs the option to pursue statutory damages instead of actual damages.¹⁶¹ Statutory damages can be extremely high, up to \$150,000 per infringement.¹⁶² Moreover, statutory damages may be imposed in the absence of any proof of actual damages.¹⁶³ Courts may even award statutory damages that are many multiples above any actual damages in order to deter copyright infringement that may be either difficult to detect or expensive to prosecute.¹⁶⁴ Instances of the application of statutory damages in the current copyright regime—in which members of the public have much greater need to make use of copyrighted works because the public domain has been so diminished—should be scrutinized under the First Amendment to determine whether such damages unduly burden First Amendment interests in a way not narrowly tailored to significant government interests.¹⁶⁵

¹⁶¹ See 17 U.S.C. § 504(a) (2006). Note that to qualify for statutory damages, an author must have registered her work within three months of publication. 17 U.S.C. §§ 408(f), 412 (2006).

¹⁶² See 17 U.S.C. § 504(c)(1).

¹⁶³ See, e.g., Special Verdict Form at 17–20, *Capitol Records Inc. v. Thomas-Rasset*, No. 06-CV-1497 (MJD/RLE), 2009 WL 1717117 (D. Minn. June 18, 2009) (finding defendant who shared music files using peer-to-peer software liable for willful copyright infringement and awarding \$80,000 per song); Jury Verdict Form at 2–8, *Sony BMG Music Entm't v. Tenenbaum*, Nos. 03-CV-11661-NG, 07-CV-11446-NG, 2009 WL 2390631 (D. Mass. June 15, 2009) (finding defendant liable for \$22,500 per act of willful infringement for sharing music files using peer-to-peer technology); *Capitol Records Inc. v. Thomas*, 579 F. Supp. 2d 1210, 1213 (D. Minn. 2008) (ordering new trial in peer-to-peer file sharing case after jury found defendant liable for statutory damages in the amount of \$9,250 per each act of infringement without a showing of actual distribution of infringing works).

¹⁶⁴ See Ben Sheffner, *Oy Tenenbaum! RIAA Wins \$675,000, or \$22,500 per Song*, ARS TECHNICA (July 31, 2009), <http://arstechnica.com/tech-policy/news/2009/07/o-tenenbaum-riaa-wins-675000-or-22500-per-song.ars> (describing plaintiff's satisfaction with award of statutory damages because it "recogni[zes] the impact of illegal downloading on the music community"); cf. *Thomas*, 579 F. Supp. 2d at 1227 (urging Congress to reexamine copyright liability and damages in peer-to-peer file-sharing cases because high statutory damages are not a deterrent).

¹⁶⁵ Indeed, large awards of statutory damages may raise constitutional concerns in addition to the First Amendment concerns discussed in this Article. Pamela Samuelson and Tara Wheatland have a forthcoming article arguing that a number of statutory damage

In other words, under the modern and non-traditional regime of copyright law, we should be at least as worried about speech-chilling overdeterrance from statutory damages as we are about risks of underdeterrence.

This is not to say that an application of the First Amendment requires doing away with all statutory damages. In some cases high statutory damages continue to make sense. For instance, commercial piracy of copyrighted works can be highly profitable and has only gotten easier in the digital age.¹⁶⁶ To deter repeat offenders, both large damages and criminal sanctions, including prison time, may be necessary.¹⁶⁷ But in other cases the availability of statutory damages and the uncertainty of their application serve to unduly chill First Amendment expression, as many commentators have noted.¹⁶⁸ Judges in copyright cases should thus take First Amendment concerns into account when crafting damages awards, and should be constrained by the First Amendment from granting damages in excess of actual damages in some cases. Examples of where the First Amendment may act to bar statutory damages are close cases of infringement when the defendant raises reasonable arguments of noninfringement (e.g. idea/expression, merger, derivative work) or a reasonable fair use defense. At a minimum, in such cases consideration of the need for copyright law to balance First Amend-

awards in copyright cases have been made at multiples above actual damages that are significantly higher than damages multiples that the Supreme Court has struck down in other areas of law as violating constitutional due process protections. See Samuelson & Wheatland, *supra* note 152, at 32–41.

¹⁶⁶ See, e.g., *Thomas*, 579 F. Supp. 2d at 1227 (“The myriad of copyright cases cited by Plaintiffs and the Government, in which courts upheld large statutory damages awards . . . have limited relevance in this case. All of the cited cases involve corporate or business defendants and seek to deter future illegal *commercial* conduct.”) (emphasis added).

¹⁶⁷ See *id.*

¹⁶⁸ See, e.g., Garfield, *supra* note 1, at 1206. Professor Garfield states that:

If copyright damages raise the specter of plaintiffs receiving punitive-like damages—because of the risk of high statutory damages awards, particularly if an infringement is found to be willful—then many parties will avoid using copyrighted works even if they believe that their use is a fair use or will only result in minimal harm to a copyright owner. In these instances, the First Amendment should place limits on statutory damages so that parties making limited use of copyrighted works will not be deterred by the threat of these damages.

Id.; accord Celia Goldwag, Note, *Copyright Infringement and the First Amendment*, 79 COLUM. L. REV. 320, 336 (1979) (“Certain aspects of copyright’s remedial scheme are more troublesome from a first amendment standpoint. . . . When statutory damages exceed what would be necessary to compensate the copyright holder, they have the effect of penalizing the infringer’s speech.”).

ment interests may prohibit awards of statutory damages far in excess of actual damages.

Some courts are already doing a good job of considering First Amendment interests when awarding statutory damages. In *Warner Brothers v. RDR Books*, the defendant relied on a fair use defense in creating and seeking to publish an encyclopedia of J.K. Rowling's Harry Potter series.¹⁶⁹ The U.S. District Court for the Southern District of New York held that the defendant's encyclopedia did not qualify for fair use because the defendant used too much of Rowling's work without enough transformation of the material.¹⁷⁰ But the court also recognized the value of reference guides and that the defendant was not unreasonable in relying on a fair use defense.¹⁷¹ Accordingly, the court awarded the minimum statutory damages per work.¹⁷² Likewise, in *Doehrer v. Caldwell*, in 1980, the U.S. District Court for the Northern District of Illinois awarded minimum statutory damages against a politician who used a cartoonist's work in his campaign mailings.¹⁷³

Other courts do a poor job of accommodating First Amendment interests when awarding statutory damages. In *Los Angeles Times v. Free Republic*, in 2000, the U.S. District Court for the Central District of California awarded statutory damages of \$1 million against a nonprofit conservative website whose users posted full news articles from the *Washington Post* and the *Los Angeles Times* in an attempt to show liberal media bias.¹⁷⁴ Free Republic plainly had a First Amendment interest in using the newspaper articles to make its argument. The court ultimately denied the fair use defense, but the imposition of such extreme statutory damages serves to overly chill speech serving undeniable First Amendment interests.¹⁷⁵ Even if the website took too much and was too aggressive in its invocation of fair use, large statutory damage awards such as these serve to chill speech that is in the grey zone, or even on the margin of the grey zone, between infringing and fair uses. Because the pub-

¹⁶⁹ See *Warner Bros. Entm't Inc. v. RDR Books*, 575 F. Supp. 2d 513, 539 (S.D.N.Y. 2008). I very briefly represented Steven Vander Ark, the author of the Harry Potter Lexicon at issue in this suit, in a matter collateral to this litigation. I emphasize that the views expressed here are entirely my own.

¹⁷⁰ *Id.* at 544, 547.

¹⁷¹ *Id.* at 545.

¹⁷² *Id.* at 554 (awarding \$750 for each of the seven instances of infringing use, for a total of \$6,750).

¹⁷³ 207 U.S.P.Q. 391, 394 (N.D. Ill. 1980) (awarding \$250 in damages).

¹⁷⁴ 56 U.S.P.Q.2d 1862, 1864 (C.D. Cal. 2000).

¹⁷⁵ See *L.A. Times v. Free Republic*, 54 U.S.P.Q.2d 1453, 1455-65, 1473 (C.D. Cal. 2000) (granting plaintiff's motion for summary judgment with respect to fair use).

lic has a First Amendment interest in hearing such speech, which must be balanced against the incentive effect of copyright law, the overly punitive application of statutory damage awards fails to adequately accommodate First Amendment interests. Courts should avoid the constitutional question as to whether damage awards such as this one are unconstitutional under the First Amendment by using their discretion to award more minimal statutory damages when a significant speech interest is in the balance against the copyright owner's interest.¹⁷⁶

CONCLUSION

Judges should keep First Amendment interests in the forefront of their minds in deciding copyright cases in the modern, non-traditional copyright world. A number of accommodations of First Amendment interests likely need to be made in specific cases. This Article has suggested several such First Amendment accommodations that courts might make in individual copyright cases. Courts should award low damages to copyright holders of orphan works or holders who have not otherwise given notice as to their ownership of a copyright pre-infringement. Additionally, courts could grant broader fair use rights as copyrighted works age. When it comes to works eligible for statutory damages, courts should balance any First Amendment interest in the use made of a copyrighted work, and any reasonable arguments regarding non-infringement or fair use, against the copyright holder's interest in receiving a large statutory award. In cases where the First Amendment interest in using the work is high, or where non-infringement or fair use arguments are strong, courts should award damage amounts closer to actual damages or the minimum statutory amount. Courts should seriously consider the accommodations discussed in this Article, and be open to other accommodations to copyright law in order to restore the balance between the public's First Amendment interests in using and listening to speech found in copyright-eligible work and the incentive function of copyright. It is only by restoring this balance that the constitutional interests protected by both the First Amendment and the Copyright Clause can be fully realized.

¹⁷⁶ The case ultimately settled for \$10,000. *See* Arthur Bright, Citizen Media Law Project, *LA Times v. New Republic*, <http://www.citmedialaw.org/threats/la-times-v-free-republic> (last visited Sept. 26, 2009).

