

No. 10-\_\_\_\_10-545      OCT 20 2010

---

---

In The OFFICE OF THE CLERK  
**Supreme Court of the United States**

---

---

LAWRENCE GOLAN, ESTATE OF RICHARD KAPP,  
S.A. PUBLISHING CO., INC. d/b/a ESS.A.Y.  
RECORDINGS, SYMPHONY OF THE CANYONS,  
RON HALL d/b/a FESTIVAL FILMS, and  
JOHN MCDONOUGH d/b/a TIMELESS VIDEO  
ALTERNATIVES INTERNATIONAL,

*Petitioners,*

v.

ERIC H. HOLDER, JR., in his Official  
Capacity as Attorney General of the United States, and  
MARYBETH PETERS, in her Official Capacity as Register  
of Copyrights, Copyright Office of the United States,

*Respondents.*

---

---

**On Petition For A Writ Of Certiorari  
To The United States Court Of Appeals  
For The Tenth Circuit**

---

---

**PETITION FOR A WRIT OF CERTIORARI**

---

---

HUGH Q. GOTTSCHALK  
CAROLYN J. FAIRLESS  
WHEELER TRIGG  
O'DONNELL LLP  
1801 California Street  
Suite 3600  
Denver, CO 80202-2617

ANTHONY T. FALZONE  
*Counsel of Record*  
JULIE A. AHRENS  
SARAH H. PEARSON  
STANFORD LAW SCHOOL  
CENTER FOR INTERNET  
AND SOCIETY  
559 Nathan Abbott Way  
Stanford, CA 94305-8610  
Telephone: (650) 736-9050  
anthony.falzone@stanford.edu

**Blank Page**

---

## QUESTIONS PRESENTED

Section 514 of the Uruguay Round Agreements Act of 1994 (Section 514) did something unique in the history of American intellectual property law: It “restored” copyright protection in thousands of works that the Copyright Act had placed in the Public Domain, where they remained for years as the common property of all Americans. The Petitioners in this case are orchestra conductors, educators, performers, film archivists and motion picture distributors, who relied for years on the free availability of these works in the Public Domain, which they performed, adapted, restored and distributed without restriction. The enactment of Section 514 therefore had a dramatic effect on Petitioners’ free speech and expression rights, as well as their economic interests. Section 514 eliminated Petitioners’ right to perform, share and build upon works they had once been able to use freely.

The questions presented are:

1. Does the Progress Clause of the United States Constitution prohibit Congress from taking works out of the Public Domain?
2. Does Section 514 violate the First Amendment of the United States Constitution?

**PARTIES TO THE PROCEEDINGS AND  
CORPORATE DISCLOSURE STATEMENT**

Petitioners are Lawrence Golan, Estate of Richard Kapp, S.A. Publishing Co., Inc., d/b/a ESS.A.Y. Recordings, Symphony Of The Canyons, Ron Hall, d/b/a Festival Films, and John McDonough, d/b/a Timeless Video Alternatives International. Petitioners certify that they have no parent corporation, nor do any publicly held corporations own 10% or more of their stock. Respondents are Eric H. Holder, Jr., in his official capacity as Attorney General of the United States, and Marybeth Peters, in her official capacity as Register of Copyrights.

## TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED .....	i
PARTIES TO THE PROCEEDINGS AND CORPORATE DISCLOSURE STATEMENT .....	ii
TABLE OF AUTHORITIES .....	vi
PETITION FOR A WRIT OF CERTIORARI .....	1
OPINIONS BELOW.....	1
JURISDICTION.....	1
CONSTITUTIONAL AND STATUTORY PRO- VISIONS INVOLVED.....	2
STATEMENT OF THE CASE.....	3
REASONS FOR GRANTING THE WRIT .....	10
I. This Case Raises Issues Of Exceptional Public Importance, Which This Court Should Decide Now.....	10
A. Section 514 Departs From Two Cen- turies Of Tradition And Creates New Uncertainty Over The Boundaries Of Copyright Protection .....	11
B. This Court Should Not Wait To An- swer The Questions This Case Pre- sents Because The Tenth Circuit's Decision Threatens Core Speech Rights And Settled Business Expecta- tions .....	14

## TABLE OF CONTENTS – Continued

	Page
II. The Tenth Circuit’s Decision Conflicts With This Court’s Prior Decisions, Which Demonstrate Congress Has No Power To Remove Material From The Public Domain To Create Private Economic Wind-falls .....	19
A. Limited Times.....	20
B. Public Purpose.....	24
III. The Tenth Circuit’s Decision Conflicts With This Court’s Prior Decisions By Creating An Unprecedented Government Interest In Sacrificing Public Speech Rights To Create Private Economic Wind-falls .....	28
A. The Government Has No Legitimate Interest In Taking Away Public Speech Rights Simply To Create Private Economic Benefits .....	29
B. The Tenth Circuit’s Decision Ignores The Fact There Was No Evidence Of Any Real Harm To Cure, Or That Section 514 Would Advance The Interest The Court Identified .....	34
CONCLUSION.....	37

## TABLE OF CONTENTS – Continued

	Page
APPENDICES	
Opinion of the U.S. Court of Appeals for the Tenth Circuit, June 21, 2010 (609 F.3d 1076).....	App. 1-42
Memorandum Opinion and Order of the U.S. District Court for the District of Colorado, April 3, 2009 (611 F. Supp. 2d 1165) .....	App. 43-69
Opinion of the U.S. Court of Appeals for the Tenth Circuit, September 4, 2007 (501 F.3d 1179) .....	App. 70-109
Order of the U.S. District Court for the District of Colorado, April 20, 2005 (2005 WL 914754) .....	App. 110-152
Order of the U.S. District Court for the District of Colorado, March 15, 2004 (310 F. Supp. 2d 1215) .....	App. 153-165
Order of the U.S. Court of Appeals for the Tenth Circuit, January 4, 2008 .....	App. 166-167
Judgment of the U.S. District Court for the District of Colorado, August 17, 2010.....	App. 168-170
Judgment of the U.S. District Court for the District of Colorado, May 12, 2005.....	App. 171-172
17 U.S.C.A. § 104A, Copyright in restored works .....	App. 173-185
17 U.S.C.A. § 109, Limitations on exclusive rights: Effect of transfer of particular copy or phonorecord.....	App. 186-190

## TABLE OF AUTHORITIES

	Page
CASES	
<i>Bantam Books, Inc. v. Sullivan</i> , 372 U.S. 58 (1963).....	16
<i>Bilski v. Kappos</i> , 130 S.Ct. 3218 (2010).....	20
<i>Bonito Boats, Inc. v. Thunder Craft Boats, Inc.</i> , 489 U.S. 141 (1989).....	12
<i>Buckley v. Valeo</i> , 424 U.S. 1 (1976).....	33
<i>Chase Securities Corp. v. Donaldson</i> , 325 U.S. 304 (1945).....	22
<i>Citizens United v. FEC</i> , 130 S.Ct. 876 (2010).....	33
<i>Dam Things from Denmark v. Russ Berrie &amp; Co., Inc.</i> , 290 F.3d 548 (3d Cir. 2002) .....	14
<i>Dastar Corp. v. Twentieth Century Fox Film Corp.</i> , 539 U.S. 23 (2003).....	12, 17, 20
<i>Eldred v. Ashcroft</i> , 537 U.S. 186 (2003).....	<i>passim</i>
<i>Elrod v. Burns</i> , 427 U.S. 347 (1976) .....	15
<i>Festo Corp. v. Shoketsu Kinzoku Kogyo Ka- bushiki Co.</i> , 535 U.S. 722 (2002) .....	18
<i>Fogerty v. Fantasy, Inc.</i> , 510 U.S. 517 (1994).....	18
<i>Fox Film Corp. v. Doyal</i> , 286 U.S. 123 (1932) .....	25
<i>Golan v. Gonzales</i> , No. 01-B-1854, 2005 WL 914754 (D. Colo. April 20, 2005) (“ <i>Golan I</i> ”).....	1, 7
<i>Golan v. Gonzales</i> , 501 F.3d 1179 (10th Cir. 2007) (“ <i>Golan II</i> ”).....	<i>passim</i>



## TABLE OF AUTHORITIES – Continued

	Page
<i>Golan v. Holder</i> , 611 F. Supp. 2d 1165 (D. Colo. 2009) (“ <i>Golan III</i> ”).....	<i>passim</i>
<i>Golan v. Holder</i> , 609 F.3d 1076 (10th Cir. 2010) (“ <i>Golan IV</i> ”).....	<i>passim</i>
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966).....	19, 20, 24, 25, 28
<i>Hurley v. Irish-Am. Gay, Lesbian &amp; Bisexual Group of Boston</i> , 515 U.S. 557 (1995).....	16, 32
<i>Kelo v. City of New London</i> , 545 U.S. 469 (2005).....	28
<i>Lovell v. City of Griffin</i> , 303 U.S. 444 (1938).....	17
<i>Luck’s Music Library, Inc. v. Gonzales</i> , 407 F.3d 1262 (D.C. Cir. 2005).....	26
<i>N.Y. Times Co. v. United States</i> , 403 U.S. 713 (1971).....	16, 32
<i>Simon &amp; Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.</i> , 502 U.S. 105 (1991).....	16, 32
<i>Sony Corp. of Am. v. Universal City Studios, Inc.</i> , 464 U.S. 417 (1984).....	12, 20, 25
<i>Stogner v. California</i> , 539 U.S. 607 (2003).....	22
<i>Turner Broad. Sys., Inc. v. FCC</i> , 512 U.S. 622 (1994) (“ <i>Turner I</i> ”).....	29, 34, 35, 36, 37
<i>Turner Broad. Sys., Inc. v. FCC</i> , 520 U.S. 180 (1997).....	37
<i>United States v. Lopez</i> , 514 U.S. 549 (1995).....	13
<i>United States v. Morrison</i> , 529 U.S. 598 (2000).....	13

## TABLE OF AUTHORITIES – Continued

	Page
<i>Vance v. Universal Amusement Co.</i> , 445 U.S. 308 (1980).....	16
<i>Ward v. Rock Against Racism</i> , 491 U.S. 781 (1989).....	16, 32
<i>William Danzer &amp; Co. v. Gulf &amp; Ship Island R. Co.</i> , 268 U.S. 633 (1925).....	22
 STATUTES	
17 U.S.C. § 102(b).....	32
17 U.S.C. § 104(A).....	<i>passim</i>
17 U.S.C. §§ 106(3)-(4).....	15
17 U.S.C. § 109(a).....	2
17 U.S.C. §§ 301-04.....	7
28 U.S.C. § 1254(1).....	2
28 U.S.C. § 1331.....	6
Berne Convention for the Protection of Literary and Artistic Works (Paris Act, 1971).....	<i>passim</i>
Uruguay Round Agreements Act, Section 514....	<i>passim</i>
 CONSTITUTIONAL PROVISIONS	
U.S. CONST., amend. I.....	<i>passim</i>
U.S. CONST., amend. V.....	27
U.S. CONST., Article I, § 8, clause 8.....	<i>passim</i>

## TABLE OF AUTHORITIES – Continued

	Page
OTHER AUTHORITIES	
BOYLE, JAMES, <i>THE PUBLIC DOMAIN: ENCLOSING THE COMMONS OF THE MIND</i> (2008).....	17, 23
LESSIG, LAWRENCE, <i>FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY</i> (2004) .....	18
Litman, Jessica, <i>The Public Domain</i> , 39 Emory L.J. 965 (1990).....	17
Netanel, Neil W., <i>Locating Copyright Within The First Amendment Skein</i> , 54 Stan. L. Rev. 1 (2001).....	33
Pollack, Malla, <i>What Is Congress Supposed to Promote? Defining “Progress” in Article I, Section 8, Clause 8 of the United States Constitution or Introducing the Progress Clause</i> , 80 Neb. L. Rev. 754 (2001) .....	24
Samuelson, Pamela, <i>Challenges in Mapping the Public Domain</i> , <i>THE FUTURE OF THE PUBLIC DOMAIN: IDENTIFYING THE COMMONS IN INFORMATION LAW</i> (P. Bernt Hugenholtz ed., 2006).....	12, 23
Tushnet, Rebecca, <i>Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It</i> , 114 Yale L.J. 535 (2004) .....	17, 32

**Blank Page**

## PETITION FOR A WRIT OF CERTIORARI

Petitioners Lawrence Golan, Estate of Richard Kapp (“Kapp”), S.A. Publishing Co., Inc., Symphony Of The Canyons, Ron Hall, and John McDonough, respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Tenth Circuit in this case.



## OPINIONS BELOW

The District Court’s first decision dismissing all claims (App. 110-152) is unreported and available at 2005 WL 914754 (*Golan I*). The first panel decision of the Court of Appeals affirming in part and reversing in part (App. 70-109) is reported at 501 F.3d 1179 (*Golan II*). The District Court’s decision on remand granting summary judgment to Petitioners and finding Section 514 violates their First Amendment rights (App. 43-69) is reported at 611 F. Supp. 2d 1165 (*Golan III*). The second panel decision of the Court of Appeals reversing the District Court’s grant of summary judgment for Petitioners (App. 1-42) is reported at 609 F.3d 1076 (*Golan IV*).



## JURISDICTION

The judgment of the United States Court of Appeals for the Tenth Circuit was issued on June 21, 2010. No petition for rehearing was filed following that decision. (The Government filed a petition for rehearing *en banc* following the Tenth Circuit’s first

decision in 2007, which the Court denied.) The time within which to file a petition for writ of certiorari was extended by this Court to October 20, 2010. This Court has jurisdiction over this petition pursuant to 28 U.S.C. § 1254(1).

---

◆

### CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The Progress Clause confers upon Congress the power to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. CONST., art. I, § 8, cl. 8.<sup>1</sup>

The First Amendment provides, in pertinent part, that “Congress shall make no law . . . abridging the freedom of speech, or of the press. . . .” U.S. CONST., amend I.

The pertinent provisions of the Copyright Act, 17 U.S.C. §§ 104A, 109(a) (1994) (Sec. 514 of Uruguay Round Agreements Act (URAA)), are reprinted in the appendix. *See* App. 173-190.

---

◆

<sup>1</sup> Article I, § 8, cl. 8 is often referred to as the “Copyright Clause,” “Patent Clause” or “Intellectual Property Clause.” None of these names is especially apt, since the Clause does not contain the words “copyright,” “patent” or “intellectual property.” Petitioners therefore refer to this Clause as the “Progress Clause” as the Tenth Circuit did in its first panel decision. *See Golan II*, 501 F.3d at 1186.

### STATEMENT OF THE CASE

1. Petitioners are orchestra conductors, educators, performers, film archivists and motion picture distributors who depend upon the Public Domain for their work.

2. Section 514 amended the Copyright Act to “restore” protection in certain foreign works, and limit the sale of existing copies of those works. *See, e.g.*, 17 U.S.C. §§ 104A(a)(1)(A), 109(a). It thus removed from the Public Domain a vast number of important works by foreign authors and put them under copyright protection. These included symphonies by Prokofiev, Stravinsky and Shostakovich; books by C.S. Lewis, Virginia Woolf and H.G. Wells; films by Federico Fellini, Alfred Hitchcock and Jean Renoir; and artwork by M.C. Escher and Picasso, including Picasso’s masterpiece “Guernica.”

3. Petitioners relied for years on the free availability of works in the Public Domain, which they performed, adapted and distributed. Petitioners Golan, Symphony of the Canyons, and Kapp’s orchestra once performed Prokofiev’s *Classical Symphony* and *Peter and the Wolf*, Shostakovich’s *Symphony 14*, *Cello Concerto* (Op. 107) and *Piano Concerto* (Op. 35), and Stravinsky’s *Petroushka*; the restoration of copyrights in these works now prevents them from doing so, even as to works for which they own copies of the sheet music. Petitioner S.A. Publishing Co., Inc. invested a great deal of work and money to record, manufacture and distribute a six compact disc

set of Shostakovich's *String Quartets* that was recognized in 1991 by Time Magazine as one of the best recordings in classical music; the restoration of copyrights in these works prevents S.A. Publishing from distributing this recording anymore. Petitioners Hall and McDonough spent time and money identifying and restoring Public Domain films like the 1962 French film, *La Jetée*, a 1940 British film, *Night Train to Munich*, and Hitchcock's 1932 film, *Number Seventeen*, for distribution; copyright restoration prevents them from distributing the films they restored. These are but a few examples of the ways in which Section 514 has affected Petitioners, and many others like them.

4. The enactment of Section 514 had a dramatic effect on Petitioners' free speech and expression rights, and those of the public. It eliminated Petitioners' right to perform, share and build upon works they had once used freely and would continue to use in the future but for Section 514. It had a similarly dramatic effect on their economic interests. In many instances, Petitioners invested time and money in locating these works, and restoring or preparing them for distribution, all on the expectation these works would remain in the Public Domain. Section 514 now prevents Petitioners from enjoying the expected benefits of these investments.

5. The total number of works removed from the Public Domain pursuant to Section 514 is difficult to estimate because restoration is automatic. See 17 U.S.C. § 104A(a)(1)(A). Section 514 permits (but does



not require) owners of restored copyrights to submit a Notice of Intent to Enforce restored copyrights. *See* 17 U.S.C. § 104A(c). Nearly 50,000 such notices have been submitted to the Copyright Office. *See* [www.copyright.gov/gatt.html](http://www.copyright.gov/gatt.html).

6. Section 514 does not apply to works by U.S. authors. This is because the ostensible purpose of Section 514 was to help the U.S. comply with the Berne Convention for the Protection of Literary and Artistic Works (“Berne Convention”). The Berne Convention was originally signed in 1886. The U.S. chose not to participate in the Berne Convention for more than 100 years. For nearly all of that time, the Copyright Act required authors to comply with statutory formalities (such as registration and renewal) in order to obtain and maintain copyright protection. Failure to comply with these statutory formalities rendered a work ineligible for copyright protection, in which case the work became part of the Public Domain. The Copyright Act also excluded from protection works first published in foreign countries that were not parties to a treaty providing copyright protection for U.S. works, and for a long time provided no protection for sound recordings.

7. Article 18 of the Berne Convention provides that countries joining Berne shall provide copyright protection for works that were unprotected in the joining nation for any reason other than the expiration of their copyright terms. Article 18(3) also provides broad latitude to create exceptions to the “restoration” requirement by agreement, or in the

unilateral discretion of the joining nation. First, Article 18(3) permits each Berne member to negotiate “special conventions” – exceptions to restoration. Thus, Article 18(3) provides the potential for the U.S. to accommodate its unique constitutional restrictions by negotiating exceptions to Berne’s restoration requirements. Second, Article 18(3) provides that “the respective countries shall determine, each in so far as it is concerned, the conditions of application of” copyright restoration. So even in the absence of any “special convention” each Berne signatory has wide discretion in deciding *how* to implement restoration and the extent to which it will protect vested speech and expression interests. *Golan v. Holder*, 611 F. Supp. 2d 1165, 1174 (D. Colo. 2009) (“*Golan III*”). Pursuant to this discretion, the U.S. provided limited protection to reliance parties. See 17 U.S.C. § 104(A)(d)(2). This protection is mostly limited to twelve months. See *id.* In the case of derivative works created prior to restoration, the reliance party may continue to exploit the derivative work for longer periods so long as the reliance party pays “reasonable compensation” to the owner of the restored work. See 17 U.S.C. § 104(A)(d)(3).

8. Petitioners filed this lawsuit to challenge the constitutionality of Section 514, alleging it exceeded the scope of Congressional power under the Progress Clause, and also violated the First Amendment. Subject matter jurisdiction was based on 28 U.S.C. § 1331. The Government moved for summary judgment and the District Court dismissed all of Petitioners’

claims. *Golan v. Gonzales*, No. 01-B-1854, 2005 WL 914754 (D. Colo. April 20, 2005) (“*Golan I*”).<sup>2</sup>

9. On appeal, a panel of the United States Court of Appeals for the Tenth Circuit affirmed the dismissal of Petitioners’ Progress Clause challenge, but reversed the District Court’s dismissal of Petitioners’ First Amendment claim. Applying this Court’s decision in *Eldred v. Ashcroft*, 537 U.S. 186 (2003), the Tenth Circuit held that Section 514 represents a substantial departure from the traditional contours of copyright law and regulates speech that is “near the core of the First Amendment.” *Golan v. Gonzales*, 501 F.3d 1179, 1193 (10th Cir. 2007) (“*Golan II*”). The Court observed Section 514 departs from “the bedrock principle of copyright law that works in the Public Domain remain there.” *Id.* at 1187. The Court went on to note that the progression of works from creation, through a period of limited protection, and then into the Public Domain where they can become the building blocks of still other creativity is the “cycle” that “makes copyright ‘the engine of free expression.’” *Id.* at 1183 (quoting *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 558 (1985)). The Court held that by breaking this cycle, Section 514 departs from the traditional contours of copyright and that

---

<sup>2</sup> Petitioners also challenged the constitutionality of the Sonny Bono Copyright Term Extension Act (CTEA), Pub. L. No. 105-298, 112 Stat. 2827 (codified as amended at 17 U.S.C. §§ 301-04 (1998)). Petitioners do not seek review of that question.

the traditional First Amendment safeguards contained in the Copyright Act are not adequate to protect First Amendment interests. *Golan II*, 501 F.3d at 1192, 1195.

10. On this basis, the Tenth Circuit found that Section 514 interferes with Petitioners' "vested First Amendment interests" in the unrestrained use of Public Domain materials, and remanded the case for First Amendment analysis under strict or intermediate scrutiny. *See Golan II*, 501 F.3d at 1194.

11. On remand, the parties agreed, and the District Court determined, that Section 514 is a content-neutral regulation of speech subject to intermediate First Amendment scrutiny. The Government contended Section 514 passes intermediate scrutiny because the Government has an important interest in complying with the Berne Convention, which requires the restoration of certain copyrights, and Section 514 is narrowly tailored to that interest. The District Court rejected that contention and held that while the Government does have a "legitimate interest in complying" with the Berne Convention, the exceptions in Article 18(3) demonstrate that "Congress could have complied with the Convention without interfering with Plaintiffs' protected speech." *Golan III*, 611 F. Supp. 2d at 1177. The District Court also held the Government had presented no evidence sufficient to show that providing protection for foreign works beyond that required by the Berne Convention would generate any additional benefits to U.S. authors, and the Government demonstrated no

important interest in correcting supposed inequitable treatment of foreign authors. *See id.* at 1175-77. On that basis, the District Court concluded that Section 514 violates Petitioners' First Amendment rights, and granted summary judgment in favor of Petitioners. *Id.*

12. On appeal following the remand, a different panel of the Tenth Circuit reversed the judgment of the District Court and held that Section 514 does not violate the First Amendment. *See Golan v. Holder*, 609 F.3d 1076 (10th Cir. 2010) ("*Golan IV*").

13. Applying intermediate scrutiny, the court held the Government has an important interest in securing foreign copyright protection for U.S. authors independent of any interest in complying with Berne. *See id.* at 1084. It concluded that Congress had substantial evidence to conclude that providing enhanced protection for foreign authors in the U.S. **might** induce foreign nations to reciprocate by providing enhanced protection for U.S. authors abroad, whether or not that enhanced protection was required by Berne. *See id.* at 1086-88. The Tenth Circuit acknowledged that Congress might have been able to comply with the Berne Convention while still providing full protection to Petitioners' speech interests. Yet it concluded the actual requirements of the Berne Convention were "beside the point" because Section 514 was narrowly tailored to the broader interest of creating enhanced protection for U.S. authors. *See id.* at 1090-91.

14. The Tenth Circuit therefore upheld the constitutionality of Section 514 based not on the need to comply with the Berne Convention, or any comparable public purpose. Rather, it upheld Section 514 on the premise that the Government has an important interest in giving away vested public speech rights in the hope that might create private economic benefits for U.S. authors on works created long ago.



### **REASONS FOR GRANTING THE WRIT**

The Court should grant certiorari because the Tenth Circuit's decision threatens important public speech rights, creates uncertainty over what used to be settled boundaries of copyright protection, and is inconsistent with this Court's prior decisions interpreting the Progress Clause and the First Amendment.

#### **I. This Case Raises Issues Of Exceptional Public Importance, Which This Court Should Decide Now**

This case raises important questions this Court has never decided. Never before has Congress taken a broad swath of works that were long part of the Public Domain and placed them under copyright protection. As a result, this Court has never had occasion to decide whether Congress has the power to remove works from the Public Domain in this fashion, or what interest would justify doing so.

In *Eldred*, this Court recognized the long-standing historical practice of extending existing copyright terms, but it presumed, as the Government assured, that once a term expired, the Constitution's limits would be respected. In fact, the Government acknowledged that removing works from the Public Domain was a different story altogether; it suggested that doing so crossed a "bright line" that Congress must respect. The Tenth Circuit's decision upsets that balance by inviting Congress to restore copyright in Public Domain works any time there is an important Government interest in doing so. Yet reducing the federal deficit, demonstrating good will to a foreign nation, or helping an aging museum cover operation costs would all appear to be sufficient reasons, on the Government's account, for Congress to give away pieces of the Public Domain. In upholding Section 514, the Tenth Circuit endorsed a dangerous departure from 200 years of tradition, which eliminates important public speech rights, and threatens the integrity of the Public Domain – the common property of all Americans.

**A. Section 514 Departs From Two Centuries Of Tradition And Creates New Uncertainty Over The Boundaries Of Copyright Protection**

For more than 200 years, the Progress Clause, and the intellectual property statutes enacted pursuant to it, have created important public benefits. By providing for a limited term of protection, the

Copyright Act creates private economic benefits to authors that are designed to serve a distinctly public purpose by encouraging the creation of new works of creativity and expression. *See, e.g., Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984).

While the scope and duration of protection has changed over time, one aspect of this system has remained consistent: Once the term of protection ended, or copyright protection in a work was lost for any other reason, it could not be restored and the work became part of the Public Domain. *See Golan II*, 501 F.3d at 1189-92; *see also Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (recognizing the “public’s federal right to copy and to use expired copyrights”) (internal quotations omitted); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 153 (1989) (recognizing the constitutional and statutory policy “of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain”).

In this respect, the Public Domain marked a clear boundary. Works in the Public Domain are the property of everyone. They are free to all for any purpose. Anyone is free to perform, adapt, share or distribute these works. These freedoms create still further public benefits with important First Amendment consequences; they not only enhance access to these works, but pave the way for still further creativity by letting new authors build on familiar and unfamiliar works alike. *See Pamela Samuelson*,



*Challenges in Mapping the Public Domain, in THE FUTURE OF THE PUBLIC DOMAIN: IDENTIFYING THE COMMONS IN INFORMATION LAW* 7, 22 (P. Bernt Hugenholtz ed., 2006).

This is the “bedrock principle” of copyright law the Tenth Circuit recognized in this case. Works in the Public Domain remain in the Public Domain and belong to the public. *Golan II*, 501 F.3d at 1189.

Section 514 upends this bedrock principle. It has taken many thousands of works out of the Public Domain and placed them under copyright protection, often for decades into the future. It thus “deviates from the time-honored tradition of allowing works in the public domain to stay there.” *See Golan II*, 501 F.3d at 1192.

The tradition of leaving Public Domain works in the Public Domain did not develop by accident. It is derived from the express textual limitations of the Progress Clause. If Congress can now evade the requirement that copyright terms be for “limited times” by repeatedly extending existing terms, and now by “restoring” copyrights in Public Domain works, then the Framers’ careful balance between the power to grant a monopoly right and the limits imposed upon that power has been destroyed. As this Court recognized in *United States v. Lopez*, 514 U.S. 549 (1995), and *United States v. Morrison*, 529 U.S. 598 (2000), the Court must interpret enumerated powers to give the express and implied limits on those powers meaning. The decision below renders

the limits in the Progress Clause all but meaningless. It also creates uncertainty about public speech rights: If Congress is free to remove material from the Public Domain at will, then the “public’s federal right to copy and to use” Public Domain material this Court has recognized may evaporate at any time.<sup>3</sup>

**B. This Court Should Not Wait To Answer The Questions This Case Presents Because The Tenth Circuit’s Decision Threatens Core Speech Rights And Settled Business Expectations**

The Tenth Circuit recognized the speech rights the Petitioners assert here are “near the core” of the First Amendment. *See Golan II*, 501 F.3d at 1193. Yet this case was pending for eight years before the

---

<sup>3</sup> The terms of Section 514 itself create an array of murky questions for those who relied on the Public Domain status of restored works. Determining whether a work is eligible for restoration in the first place is not necessarily straightforward. *See Dam Things from Denmark v. Russ Berrie & Co., Inc.*, 290 F.3d 548, 556-60 (3d Cir. 2002) (vacating preliminary injunction, explaining criteria for restoration and analyzing whether copyright in “Danish Good Luck Troll” was eligible for restoration). Even the so-called protections Section 514 provides for reliance parties sow confusion. While they provide limited protection for those who created “derivative works” while a restored work was in the Public Domain, the extent to which a particular creation qualifies for this protection may remain murky. *See id.* at 563-66 (remanding for further analysis to determine which trolls are derivative works and which are not based on more detailed comparison of their features).

District Court vindicated those rights. No other Court of Appeals has addressed the First Amendment claim Petitioners make here. While there is plainly no circuit split on Petitioners' claims, this Court should nonetheless grant certiorari because important public speech rights are at stake. *See Elrod v. Burns*, 427 U.S. 347, 373 (1976) ("The loss of First Amendment freedoms, for even minimal periods of time, unquestionably constitutes irreparable injury.").

The burden on Petitioners' speech rights is obvious and substantial. Lawrence Golan and his orchestra were once free to perform a wide array of symphonic works. S.A. Publishing and Ron Hall were once free to publish and distribute an extensive array of orchestral compositions and feature films. Now that Section 514 has placed these works under copyright protection, Petitioners are no longer free to do these things, and the Copyright Act prohibits these activities expressly. *See* 17 U.S.C. §§ 106(3)-(4) (restricting the right to distribute and perform copyrighted works). In this respect, it acts as an explicit restraint on Petitioners' expressive activities.

The fact that Petitioners are not the original authors of these works does not diminish the strength of Petitioners' First Amendment interests. Petitioners, like all of us, were the owners of the common property that Section 514 removed from the Public Domain. This case does not challenge the extension of a copyright, where this Court has said the First Amendment "bears less heavily when speakers assert the right to make other people's speeches." *Eldred*, 537

U.S. at 221. The “speeches” Petitioners were making here belonged to them. *See Golan II*, 501 F.3d at 1193 (“[T]he speech at issue here belonged to plaintiffs when it entered the public domain.”). Just as the Walt Disney Company’s rights to enforce the copyright to the work of A. A. Milne is not diminished by the fact that *Winnie the Pooh* is not original to Disney, Petitioners’ rights to work in the Public Domain is not diminished by the fact that it is not original to them. It is the public’s right to make “our speeches” that has been eliminated by this statute.

The speech rights that have been eliminated here could hardly be more important. The rights to perform music, distribute a film, or publish a book are critical First Amendment freedoms. *See Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989); *Vance v. Universal Amusement Co.*, 445 U.S. 308, 315-16 (1980); *Bantam Books, Inc. v. Sullivan*, 372 U.S. 58 (1963). They do not become less important just because they involve the expression of another author. *See, e.g., Hurley v. Irish-Am. Gay, Lesbian & Bisexual Group of Boston*, 515 U.S. 557, 570 (1995) (presentation of speech “generated by other persons . . . fall[s] squarely within the core of First Amendment security”); *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 116 (1991) (publishing house that selects authors for publication are “speakers” for First Amendment purposes); *Ward*, 491 U.S. at 790 (recognizing unincorporated association’s First Amendment right to sponsor musical performances by others); *N.Y. Times Co. v. United States*,

403 U.S. 713 (1971) (recognizing newspaper's First Amendment interest in publishing work authored by Government employees); see generally Rebecca Tushnet, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 Yale L.J. 535 (2004).

The First Amendment right to perform or publish the works of Shakespeare or Mozart is no less weighty because these works contain the words or expression of another. The right to perform, copy and disseminate these works widely, cheaply and efficiently is an important First Amendment interest in and of itself. See *Dastar*, 539 U.S. at 34; *Lovell v. City of Griffin*, 303 U.S. 444, 452 (1938) (the “[l]iberty of circulating is as essential . . . as liberty of publishing; indeed, without the circulation, the publication would be of little value”).

But the public speech rights at stake here do not end with the right to perform, copy and disseminate. Public Domain works have long been the building blocks of future creativity in music, art, entertainment and literature. The Public Domain is “the basis for our art, our science, and our self-understanding. It is the raw material from which we make new inventions and create new cultural works.” JAMES BOYLE, *THE PUBLIC DOMAIN: ENCLOSING THE COMMONS OF THE MIND* 39 (2008). By removing thousands of works from the Public Domain, Congress prevents the public from using these works as the ingredients for still further creativity. See Jessica Litman, *The Public Domain*, 39 Emory L.J. 965, 968 (1990) (“The public

domain should be understood not as the realm of material that is undeserving of protection, but as a device that permits the rest of the system to work by leaving the raw material of authorship available for authors to use.”); LAWRENCE LESSIG, *FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY* 22-25 (2004) (noting the array of important cultural works created by Disney that were based principally on material in the Public Domain).

In addition to interfering with important speech rights, Section 514 upsets settled business expectations. Several Petitioners and others like them have invested money and built businesses around locating, preserving and distributing Public Domain works. In doing so, they rely upon the expectation this investment will not be expropriated arbitrarily. A rule that permits Congress to remove works from the Public Domain will destroy the incentive to make these investments, and the incentive to preserve, spread and build upon the content of the Public Domain. In order to preserve these incentives, the boundaries of the Public Domain must be defined clearly and protected from erosion. *See Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 527 (1994) (“Because copyright law ultimately serves the purpose of enriching the general public through access to creative works, it is peculiarly important that the boundaries of copyright law be demarcated as clearly as possible.”); *cf. Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002) (boundaries of intellectual property

monopoly must be clear: “[a] patent holder should know what he owns, and the public should know what he does not”).

Although Section 514 affects important public rights, few members of the public are in a position to fight the long fight Petitioners have fought in this case. The economy of the Public Domain is fragile; the economic reward for exercising the expressive rights at stake here is often slight, precisely because these rights are available equally to all. Those whose rights have been most affected are therefore unlikely to have the resources to litigate these questions, much less for nine years.

If the Court does not take the opportunity to review the important questions presented by this case, they may escape review altogether.

## **II. The Tenth Circuit’s Decision Conflicts With This Court’s Prior Decisions, Which Demonstrate Congress Has No Power To Remove Material From The Public Domain To Create Private Economic Windfalls**

While this Court has never addressed the precise question of whether the Progress Clause permits Congress to remove works from the Public Domain and place them under copyright protection, its previous decisions demonstrate Congress has no such power. This Court has consistently recognized the Progress Clause is “both a grant of power and a limitation.” *Graham v. John Deere Co.*, 383 U.S. 1, 5

(1966); *see also* *Bilski v. Kappos*, 130 S.Ct. 3218, 3252 (2010); (quoting *Graham*, 383 U.S. at 5); *Eldred*, 537 U.S. at 212 (same). At least two limitations are important here. The Tenth Circuit decision largely ignores them, and Section 514 violates them.

### A. Limited Times

First, Congress may only grant copyright protection for “limited times.” U.S. CONST., art. I, § 8, cl. 8; *see Eldred*, 537 U.S. at 199; *Dastar*, 539 U.S. at 37. That is because the ultimate aim of the Progress Clause and the Copyright Act is to “induce release to the public of the products of [an author’s] creative genius.” *Sony*, 464 U.S. at 429. The Progress Clause therefore requires Congress to “allow the public access to the products of [an author’s] genius after the limited period of exclusive control has expired.” *Id.*; *see Graham*, 383 U.S. at 5-6 (“Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the Public Domain, or to restrict free access to materials already available”).

In *Eldred*, this Court held the Progress Clause empowers Congress to *extend* the term of *existing* copyrights. *See Eldred*, 537 U.S. at 200-04. That holding was based largely on tradition – the “unbroken congressional practice of granting to authors of works with existing copyrights the benefit of term extensions so that all [works] under copyright protection will be governed evenhandedly under the same regime.” *Id.* at 200. On this basis, the Court concluded



that term extension for existing copyrights did not violate the “limited times” prescription in the Progress Clause. *See id.* at 200-04.

But even the Government recognized that removing material from the Public Domain would be a different story. At the oral argument in *Eldred*,

Justice Souter asked then-Solicitor General Olsen [sic] whether the Copyright Clause combined with the Necessary and Proper Clause could justify the extension of monopoly privileges to a “copyright that expired yesterday.” [citations omitted] The Solicitor General replied that although such an act was not inconceivable, the public domain likely presented a “bright line” because once “[s]omething . . . has already gone into the public domain [] other individuals or companies or entities may then have acquired an interest in, or rights to be involved in disseminating [the work.]

*Golan II*, 501 F.3d at 1193 n.4.

The Tenth Circuit’s decision in this case permits Congress to cross the “bright line” the Government itself urged.

Section 514 removes a vast body of foreign works from the Public Domain and puts them back under copyright protection, and it specifically includes works that were under copyright, but whose copyright has expired due to lack of renewal. *See* 17 U.S.C. § 104A(h)(6). In doing so, it benefits foreign

authors (and their heirs) at the expense of the vested speech rights of the American public. It limits, for example, the right to show, perform or distribute important works, including symphonies by Prokofiev, Shostakovich and Stravinsky among others, films by Alfred Hitchcock and Fritz Lang, and books by authors such as Virginia Woolf and C.S. Lewis. It also interferes with the specific reliance interests Solicitor General Olson referred to in *Eldred*, because each Petitioner here relied on the Public Domain status of the works they performed, adapted or distributed. See *Golan II*, 501 F.3d at 1193.<sup>4</sup>

The “bright line” Section 514 crosses is particularly important. It protects the integrity of the Public

---

<sup>4</sup> The difference between *extending* the term of *existing* copyrights and *resurrecting* copyrights in works that were already part of the Public Domain parallels the distinction this Court has drawn in other contexts. This Court has, for instance, recognized the legislature may *extend* the statute of limitations for criminal offenses without violating the Ex Post Facto Clause of the Constitution, but cannot *revive* time-barred prosecutions once the statute of limitations has run. See *Stogner v. California*, 539 U.S. 607, 617-18 (2003). One of the bases for this distinction is the reliance interest that vests upon the expiration of the limitations period. See *id.* at 631-32. This Court has recognized a similar distinction in regard to the expiration of civil limitations periods. See *id.* at 632 (citing *Chase Securities Corp. v. Donaldson*, 325 U.S. 304, 312, n.8 (1945); *William Danzer & Co. v. Gulf & Ship Island R. Co.*, 268 U.S. 633, 637 (1925)). If there is an important reliance interest in avoiding prosecution for criminal acts (*Stogner*) or civil liability for the illegal sale of securities (*Chase Securities*), the public’s reliance interest in maintaining the right to lawful expression should be greater still.

Domain – the common property of all Americans. Free and unfettered access to the Public Domain serves the most basic goals of copyright and the First Amendment. The purpose of creating a Public Domain is to lift restrictions on access and dissemination, and to unleash further creativity by permitting everyone to use material in the Public Domain as building blocks for new works of expression. See BOYLE, *supra*, at 41 (“The public domain is the place we quarry the building blocks of our culture. It is, in fact, the *majority* of our culture.”) Protecting the integrity of the Public Domain therefore protects important speech and expression rights, and paves the way for the new creativity that is the ultimate aim of both the Copyright Act and the Progress Clause. See *id.*; Samuelson, *supra*, at 22.

Here, unlike *Eldred*, history and tradition provide no justification for crossing this “bright line.” There is no “unbroken congressional practice” of removing material from the Public Domain. See *Eldred*, 537 U.S. at 200-04. On the contrary, the Tenth Circuit held that “[*the*] **history of American copyright law reveals no tradition of copyrighting works in the public domain**” and Section 514 “deviates from the time-honored tradition of allowing works in the public domain to stay there.” *Golan II*, 501 F.3d at 1190, 1192 (emphasis added).

If Congress can both extend the terms of existing copyright at will and take material out of the Public Domain at will, then there is no effective limit to the duration of copyright protections.

## B. Public Purpose

The second Progress Clause limitation this Court has recognized is based on purpose: the Progress Clause requires Congress to exercise its power for a limited and specific purpose – to “promote the Progress of Science and useful Arts.” U.S. CONST., art. I, § 8. cl. 8. As this Court explained in *Graham*:

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

*Graham*, 383 U.S. at 5-6 (emphasis added).<sup>5</sup>

---

<sup>5</sup> The public welfare the Progress Clause is supposed to “promote” is not limited to invention and creation. The Framers’ original understanding of “[p]rogress” included the wide dissemination and diffusion of knowledge. See Malla Pollack, *What Is Congress Supposed to Promote?: Defining “Progress” in Article I*, (Continued on following page)

Congress must therefore exercise its Progress Clause power to serve public, not simply private, interests. See *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932) (“The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors.”); *Sony*, 464 U.S. at 429 (purpose of copyright restrictions is to stimulate creativity, not simply to “provide a special private benefit”) and n.10 (“The enactment of copyright legislation by Congress under the terms of the Constitution is not based upon any natural right that the author has in his writings, . . . but upon the ground that the welfare of the public will be served.”). So even if Congress were permitted, in some limited circumstances, to cross the “bright line” and remove material from the Public Domain, it must still serve a public purpose in doing so. It cannot do so to create strictly private benefits for authors. See *Sony*, 464 U.S. at 439 and n.10; *Graham*, 383 U.S. at 5-6; *Fox Film*, 286 U.S. at 127.<sup>6</sup>

---

*Section 8, Clause 8 of the United States Constitution, or Introducing the Progress Clause*, 80 Neb. L. Rev. 754, 758 (2001). Protecting the Public Domain is critical to promoting this aspect of “Progress.”

<sup>6</sup> In *Eldred*, this Court explained that its patent decisions may not necessarily extend to the copyright context because the patent bargain differs in some respects from the copyright bargain. See *Eldred*, 537 U.S. at 215-17. Here, no such extension is necessary. This Court’s copyright decisions demand the same public purpose its patent decisions demand. See *Sony*, 464 U.S. at 439 and n.10; *Fox Film*, 286 U.S. at 127.

In its first panel decision, the Tenth Circuit heeded that limitation. In rejecting Petitioners' Progress Clause challenge, it assumed that Section 514 was necessary to comply with the Berne Convention. *See Golan II*, 501 F.3d at 1187 (“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”). In this respect, it shows some parallel to *Eldred*, which found that extending U.S. copyright terms to align them with those specified by the Berne Convention would enhance the creative incentive and thus served the social purpose the Progress Clause demands. *See Eldred*, 537 U.S. at 213.

As it turns out, the Tenth Circuit's assumption was wrong. On remand, the Petitioners proved, and the District Court held, the plain terms of Berne showed that Congress did *not* need to enact Section 514 in its present form in order to comply with Berne, and Congress could have complied with Berne while protecting Petitioners' speech interests. *See Golan III*, 611 F. Supp. 2d at 1174.<sup>7</sup>

---

<sup>7</sup> In *Luck's Music Library, Inc. v. Gonzales*, 407 F.3d 1262 (D.C. Cir. 2005), the Court rejected the claim that Section 514 was unconstitutional under the Progress Clause. In that case, the plaintiffs did not argue that Section 514 failed to protect reliance interests adequately, *see id.* at 1265, or contend that that Congress could have complied with the Berne Convention

(Continued on following page)

In its second panel decision, the Tenth Circuit left that holding undisturbed. It concluded the requirements of Berne were “beside the point” and did not address or decide whether Section 514 was necessary to comply with Berne, or pursued any public purpose. *Golan IV*, 609 F.3d at 1091. Instead, it focused on the strictly *private* benefits Section 514 might create for American authors, ignoring the question of whether Section 514 created any corresponding *public* benefits, such as Berne participation. *See id.* at 1091-94.

If Section 514 were necessary to Berne compliance, it might serve the public function the Progress Clause demands in the same manner *Eldred* identified. Since it was unnecessary to Berne participation, it serves no such purpose and cannot expand the economic incentive that might stimulate greater creativity. At most, Section 514 creates an economic windfall for foreign authors of existing works. For U.S. authors, it creates only a *potential* economic windfall but only as to works created long ago. And the actuality of that windfall depends on whether foreign countries decide to provide reciprocal protection not required by Berne.<sup>8</sup>

---

while protecting reliance interests like those held by the Petitioners. Petitioners raise both of those challenges here.

<sup>8</sup> The distinction between taking property to create public benefits, versus merely private ones, is also one this Court has recognized in other contexts. While the Fifth Amendment may permit the taking of private property in order to serve the public

(Continued on following page)

The Tenth Circuit's decision ignores both Progress Clause limitations this Court has identified, and the fact Section 514 violates both of them. In removing material from the Public Domain, it crosses the "bright line" articulated in *Graham* and recognized in *Eldred*, and does so for distinctly private, not public, purposes. Section 514 takes away important public speech rights not out of any need to participate in the Berne Convention, or any public purpose comparable to the one found sufficient in *Eldred*. It does so simply to put more money in the pockets of U.S. authors whose works were created long ago.

### **III. The Tenth Circuit's Decision Conflicts With This Court's Prior Decisions By Creating An Unprecedented Government Interest In Sacrificing Public Speech Rights To Create Private Economic Windfalls**

By putting the terms of Berne entirely aside, the Tenth Circuit invented an important Government interest in creating private economic benefits for U.S. authors at the expense of vested public speech rights. It also ignored the fact there is no substantial evidence that would permit Congress to conclude there was any need to do so, or that Section 514 would actually create any such benefits. These holdings also conflict with this Court's prior decisions.

---

interest, it does not permit such a taking simply to bestow private economic benefits. See *Kelo v. City of New London*, 545 U.S. 469, 477-8 (2005).



**A. The Government Has No Legitimate Interest In Taking Away Public Speech Rights Simply To Create Private Economic Benefits**

On remand, both Petitioners and the Government agreed that intermediate scrutiny applied to Petitioners' First Amendment challenge. The question before the Court was therefore whether the Government could demonstrate an important interest in removing foreign works from the Public Domain, and whether Section 514 was narrowly tailored to that interest. *See Golan III*, 611 F. Supp. 2d 1165; *Golan IV*, 609 F.3d 1076; *see generally Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622 (1994) ("*Turner I*").

The primary interest the Government asserted was the need to participate in, and comply with, the Berne Convention. *See Golan III*, 611 F. Supp. 2d at 1172; *Golan IV*, 609 F.3d at 1083. While the Government suggested it had an interest in "unquestionable compliance" with Berne, the terms of Berne were the basis of its asserted interest and the critical reference point: The Government denied it went beyond the terms of Berne, while Petitioners contended the Government could have complied with Berne while still protecting Petitioners' reliance interests. The District Court agreed with Petitioners, and held the plain terms of Berne would have permitted the Government to comply with it while providing greater protection for Petitioners' reliance interests. *See Golan III*, 611 F. Supp. 2d at 1174. On this basis, the District Court concluded that Section 514 flunked

intermediate scrutiny because it burdened more speech than necessary to comply with Berne.<sup>9</sup> *See id.*

In reversing the District Court’s decision and concluding the terms of Berne are “beside the point,” the Court declared the Government has an important interest unconnected to Berne – an interest in “securing protections abroad for American copyright holders.” *Golan IV*, 609 F.3d at 1084, 1091. It observed that the U.S. could expect other countries to provide only as much protection for U.S. authors as the U.S. provided to foreign authors, and concluded “the benefit that the government sought to provide to American authors is congruent with the burden that Section 514 imposes on [U.S.] reliance parties.” *Id.* at 1091.

The Tenth Circuit made no attempt to explain how providing these benefits to U.S. authors could or would provide any benefits to the U.S. public, or why it is appropriate for reliance parties like Petitioners to bear any burden on their speech rights for the sake of enriching U.S. authors. That was no accident, because there is no plausible public benefit. Participating in

---

<sup>9</sup> The Government also asserted an interest in correcting for the supposedly inequitable treatment of foreign authors who lost their copyrights because they did not comply with now-discarded copyright formalities like registration and renewal. The District Court held the Government has no such interest, since Section 514 *creates* inequities where none existed before by “extend[ing] protections to foreign authors that are not afforded United States authors, even in their own country.” *Golan III*, 611 F. Supp. 2d at 1177.

and complying with Berne may represent an important Government interest because expanding protection of U.S. works to all 164 Berne signatories may provide additional incentives to create new works. This may provide a pronounced benefit to the U.S. public insofar as it results in the creation of additional works of creativity and expression. But insofar as Section 514 is unnecessary to Berne compliance, it cannot create any such benefit. By definition, it applies only to existing works that were created long ago. Standing alone, Section 514 can do no more than create an economic windfall for foreign authors, and a potential windfall for U.S. authors, by expanding their right to exploit existing works.

The Tenth Circuit tried to avoid this fact by suggesting Section 514 balances the respective speech rights of U.S. authors and reliance parties, and by suggesting the speech interests of reliance parties are diminished insofar as they are simply asserting “the right to make other peoples’ speeches.” *Golan IV*, 609 F.3d at 1084 (quoting *Eldred*, 537 U.S. at 221). But there are no speech rights at stake for U.S. authors. They chose to speak and spoke freely when they created their works. Nothing in Section 514 interferes with those freedoms. The only question Section 514 affects is the extent to which authors will be able to capture additional economic benefits from those works abroad.

Nor are Petitioners’ speech rights diminished on the ground they are making “other peoples’ speeches.” The Tenth Circuit’s first panel decision rejected that

contention outright. It observed the speeches Petitioners were making belonged to them, and held these speech rights are “near the core” of the First Amendment. *See Golan II*, 501 F.3d at 1193. That is undoubtedly true. This Court has repeatedly recognized important First Amendment interests where a speaker performs, publishes or distributes the work of another. *See, e.g., Hurley*, 515 U.S. at 570; *Simon & Schuster*, 502 U.S. at 116; *Ward*, 491 U.S. at 790; *N.Y. Times*, 403 U.S. 713; *see generally* Tushnet, 114 Yale L.J. 535.

Taking vested First Amendment rights away from Petitioners and the public simply to create the chance that U.S. authors might be able to extract additional economic benefits from existing works cannot be a legitimate Government interest. If the Government has an important interest in doing that, it would justify nearly any expansion of copyright restrictions, and conflict with *Eldred* itself. Eliminating the fair use doctrine would presumably further this interest, as would expanding copyright protection to cover facts, “idea[s], procedure[s], process[es], system[s]” or “method[s] of operation” contained in any author’s work. *See* 17 U.S.C. § 102(b). Yet these are the very “First Amendment safeguards” that *Eldred* identified. *See Eldred*, 537 U.S. at 220. In this respect, the Tenth Circuit has adopted by implication the very rule this Court rejected in *Eldred*: it has created a Government interest so broad as to make copyright legislation all but immune from First Amendment scrutiny.

Recognizing an interest as broad as the one the Tenth Circuit announced here would also conflict with critical First Amendment principles this Court has identified in other cases. This Court has recognized the First Amendment does not permit Congress to reallocate speech interests among different speakers. *See Citizens United v. FEC*, at 130 S.Ct. 876, 899 (2010) (Congress interferes with speech rights “[b]y taking the right to speak from some and giving it to others”); *Buckley v. Valeo*, 424 U.S. 1, 48-49 (1976) (“[T]he concept that government may restrict the speech of some elements of our society in order to enhance the relative voice of others is wholly foreign to the First Amendment.”); *see also* Neil W. Netanel, *Locating Copyright Within The First Amendment Skein*, 54 *Stan. L. Rev.* 1, 55-56 (2001) (copyright regulations fall within category of content-neutral regulations that courts must scrutinize more rigorously because they allocate speech entitlements among different classes of speakers). Indeed, this Court has refused to recognize an interest in reallocating speech rights even where its posited purpose is to uphold critical public interests relating to electoral fairness and preventing public corruption. *See Citizens United*, 130 S.Ct. at 904-11. If the Government lacks a proper interest in taking the right to speak from one and giving it to another in order to pursue these important public goals, it certainly has no proper interest in doing so to create nothing more than private economic benefits.

**B. The Tenth Circuit's Decision Ignores The Fact There Was No Evidence Of Any Real Harm To Cure, Or That Section 514 Would Advance The Interest The Court Identified**

The Tenth Circuit went on to compound its error by misapplying the second half of the intermediate scrutiny test, and sowing confusion over the Government's evidentiary burden.

In *Turner*, this Court held the Government must do more than simply identify an important Governmental interest in the abstract. The Government must demonstrate it seeks to cure harms that are "real, not merely conjectural" and show the regulation will alleviate the harm and advance the Government's interest in a direct and material way. See *Turner I*, 512 U.S. at 664. The District Court therefore recognized that:

while Congress's predictive judgments are entitled to substantial deference—a court must "assure that, in formulating its judgments, Congress has drawn reasonable inferences based on substantial evidence." See *id.* at 665-66. When Congress "trench[es] on *first amendment* interests, even incidentally, the government must be able to adduce either empirical support or at least sound reasoning on behalf of its measures." See *id.* at 666 (quoting *Century Comm.'s Corp. v. FCC*, 835 F.2d 292, 304 (D.C. Cir. 1987)). This requires an analysis of evidence speaking to the precise question at issue. See *id.* at

666-67. Without the benefit of specific factual data supporting Congress's reasoning, a court "cannot determine whether the threat is real enough" to constitute an important Government interest, or whether the remedy chosen is sufficiently narrow to overcome a *First Amendment* challenge. *See id.* at 665-67.

*See Golan III*, 611 F. Supp. 2d at 1176.

Even if creating private economic benefits for U.S. authors is an important interest in the abstract, the Government did not meet its burden of demonstrating there was any real harm or threat that would justify imposing any restrictions on the speech rights of Petitioners or the public.

While there may have been substantial evidence suggesting the failure to comply with Berne would subject the United States to trade sanctions and other real harms, there was no evidence to suggest there was any real harm to address or avoid beyond the harm that would occur if the U.S. did not comply with Berne. There was no empirical support or data that suggested U.S. authors were in any financial jeopardy, or that the economic benefits U.S. authors already received on existing works were inadequate to generate sufficient creative incentives. *See Turner I*, 512 U.S. at 664-5 (in order to justify regulations of speech to protect local broadcasters, the Government must show "that the economic health of local broadcasting is in genuine jeopardy and in need of the [new] protections" Congress enacted).

Once divorced from the interest in Berne compliance, the only rationale for trying to increase economic benefits for U.S. authors is “more is better.” But more protection is always better – for copyright owners. It is not always better for the public, especially when it is the public’s speech rights that are being sacrificed to create putative financial benefits for copyright owners. Once Berne is put aside, there simply is no evidence of any threat or potential harm sufficient to justify the infringement of Petitioners’ First Amendment rights. *See Turner I*, 512 U.S. at 667 (remanding where record did not permit Court to determine whether local broadcasters were “at serious risk of financial difficulty” or whether “the threat to broadcast television is real enough” to overcome Petitioners’ First Amendment interests).

Finally, even if there were evidence of a real harm to be addressed, there was no substantial evidence on which Congress could plausibly conclude Section 514 would provide any benefit to U.S. authors independent of Berne. The vast bulk of testimony and evidence Congress had before it regarding Section 514 related to the need to comply with Berne. Little, if any, related to the question of whether Section 514 would create any benefits for U.S. authors apart from Berne compliance. Indeed, all of the evidence the Tenth Circuit points to in satisfaction of the *Turner* standard consists of nothing but highly conclusory statements made in passing. *See Golan IV*, 609 F.3d at 1087-88. In reality, these statements are nothing more than guesses about what unspecified countries



might do someday. *See id.* At best they are predictions, but they are not based on anything like the “empirical support” or “factual predictions” *Turner* demands. *See Turner I*, 512 U.S. at 666. Compare *Turner Broad. Sys., Inc. v. FCC*, 520 U.S. 180, 196-210 (1997) (detailing extensive evidence justifying must-carry provisions, including “years of testimony” and “volumes of documentary evidence and studies offered by both sides”).

---

◆

## CONCLUSION

This Court should grant certiorari to address the exceptionally important constitutional questions this case presents.

October 20, 2010      Respectfully submitted,

ANTHONY T. FALZONE

*Counsel of Record*

JULIE A. AHRENS

SARAH H. PEARSON

STANFORD LAW SCHOOL

CENTER FOR INTERNET AND SOCIETY

559 Nathan Abbott Way

Stanford, CA 94305-8610

Telephone: (650) 736-9050

anthony.falzone@stanford.edu

HUGH Q. GOTTSCHALK

CAROLYN J. FAIRLESS

WHEELER TRIGG O'DONNELL LLP

1801 California Street

Suite 3600

Denver, CO 80202-2617

**Blank Page**