

CONGRESSIONAL AUTHORITY OVER INTELLECTUAL
PROPERTY POLICY AFTER *ELDRED V. ASHCROFT*:
DEFERENCE, EMPTY LIMITATIONS, AND RISKS TO THE
PUBLIC DOMAIN

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I. INTRODUCTION

The United States Supreme Court upheld the Copyright Term Extension Act of 1998¹ (CTEA) in *Eldred v. Ashcroft*.² The Court ruled that Congress had not exceeded its authority under the Copyright Clause³ by extending the copyright term twenty years and applying this extension retroactively to existing copyrighted works that otherwise would have entered the public domain at the end of their current, nonextended terms.⁴ The majority found a rational basis for CTEA and showed great deference to the authority of Congress to set policy that, in its judgment, effectuates the aims of the Copyright Clause.⁵ Although this deference to Congress'

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¹ Pub. L. No. 105-298, 112 Stat. 2827 (codified in scattered sections of 17 U.S.C.; at issue in particular is the provision codified at 17 U.S.C. § 302(a) (2000)).

² 537 U.S. 186, 222 (2003); see also *Kahle v. Ashcroft*, No. C-04-1127 MMC, 2004 WL 2663157, at *15 (N.D. Cal. Nov. 19, 2004) (upholding the Copyright Renewal Act and the Berne Implementation Act as well as CTEA against challenges like those raised in *Eldred*).

³ “The Congress shall have Power . . . [t]o 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. This clause is also called the Patent and Copyright Clause, the Patent Clause, and the Intellectual Property Clause. It will be referred to in this Article, for the most part, as the Copyright Clause.

⁴ *Eldred*, 537 U.S. at 194, 196, 199. A First Amendment challenge against CTEA also failed. The Court said that the “speech-protective purposes and safeguards” embodied in copyright law were sufficient to preclude any heightened scrutiny of CTEA, *id.* at 218–19, but it said that the D.C. Circuit went too far in stating that copyright is “categorically immune from challenges under the First Amendment.” *Id.* at 221 (quoting *Eldred v. Reno*, 239 F.3d 372, 375 (D.C. Cir. 2001)). One commentator stated that because of this decision “[t]he greatest legal restriction of speech in the history of the Republic—putting off-limits every book, poem, film, song and sculpture for another twenty years—can proceed without significant First Amendment review.” James Boyle, *Foreward: The Opposite of Property?*, 66 LAW & CONTEMP. PROBS. 1, 32 (2003).

⁵ *Eldred*, 537 U.S. at 205, 208. For brief casebook commentaries on this deference, see CRAIG JOYCE ET AL., COPYRIGHT LAW 381 (6th ed. 2003). See also Dotan Oliar, *Making Sense*

judgment is not out of the ordinary,⁶ the degree of deference that permeates the majority opinion in *Eldred*⁷ fuels the debate regarding congressional authority under the Copyright Clause and other provisions of the Constitution to alter fundamental principles of United States' intellectual property policy⁸ announced in cases like *Sears, Roebuck & Co. v. Stiffel Co.*; *Compco Corp. v. Day-Brite Lighting, Inc.*; *Graham v. John Deere Co. of Kansas City*; *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*; *TraFFix Devices, Inc. v. Marketing Displays, Inc.*; and *Dastar Corp. v. Twentieth Century Fox Film Corp.*⁹

of the Intellectual Property Clause: Promotion of Progress as a Limitation on Congress's Intellectual Property Power, 94 GEO. L.J. 1771, 1810–16 (2006) (discussing *Eldred* and other recent cases as well as textual transition of the Copyright Clause while it was being drafted and arguing that the Framers intended for the “to promote the Progress of Science and useful Arts” preamble to serve as a limitation on congressional power).

⁶ Marshall Leaffer, *Life After Eldred: The Supreme Court and the Future of Copyright*, 30 WM. MITCHELL L. REV. 1597, 1601 (2004); Peter K. Yu, *The Escalating Copyright Wars*, 32 HOFSTRA L. REV. 907, 926–27 (2004); see also Marci A. Hamilton, *Copyright at the Supreme Court: A Jurisprudence of Deference*, 47 J. COPYRIGHT SOC'Y U.S.A. 317, 322–23 (2000).

⁷ Leaffer, *supra* note 6, at 1601.

⁸ See generally Yochai Benkler, *Constitutional Bounds of Database Protection: The Role of Judicial Review in the Creation and Definition of Private Rights in Information*, 15 BERKELEY TECH L.J. 535 (2000) (analyzing the Copyright Clause and the First Amendment as constraints on Congress' power to enact copyright legislation); Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. ILL. L. REV. 1119 (examining the limits on Congress' power under the Copyright Clause in light of the limitations created by other constitutional provisions); Timothy R. Holbrook, *The Treaty Power and the Patent Clause: Are There Limits on the United States' Ability to Harmonize?*, 22 CARDOZO ARTS & ENT. L.J. 1 (2004) (discussing the extent to which the Patent and Copyright Clause limits Congress with respect to the Treaty Power); Robert Patrick Merges & Glen Harlan Reynolds, Essay, *The Proper Scope of the Copyright and Patent Power*, 37 HARV. J. ON LEGIS. 45 (2000) (arguing that Congress has exceeded its powers under the limitations of the Copyright Clause); Thomas B. Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM L. REV. 272 (2004) (examining the power of Congress to make copyright legislation under the Commerce Clause); William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 GEO. WASH. L. REV. 359 (1999) (discussing Congress' powers under the Copyright Clause and the Constitution and the Supreme Court's limitation and expansion of those powers); Malla Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of Shakespear Co. v. Silstar Corp.*, 18 SEATTLE U. L. REV. 259 (1995) (arguing in favor of a limited congressional power to create copyright extensions); Pamela Samuelson, *The Constitutional Law of Intellectual Property After Eldred v. Ashcroft*, 50 J. COPYRIGHT SOC'Y 547 (2003) [hereinafter Samuelson, *Constitutional Law*] (suggesting that scholarship on Congressional power under, and Supreme Court interpretation of, the Copyright Clause will encourage a more correct view of constitutional powers in this area).

⁹ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989); *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1 (1966); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964); see JOYCE ET AL., *supra* note 5, at 383; Samuelson, *Constitutional Law*, *supra* note 8, at 549–50; David E. Shipley, *What do Flexible Road Signs, Children's Clothes*

In these important decisions the Court addressed the public's right to use inventions and works of authorship that are in the public domain because of an expired or invalid patent, or an expired copyright. It struck down attempts to restrict the copying of public domain works under state unfair competition law and Lanham Act theories of relief.¹⁰ Notwithstanding Congress' authority to enact intellectual property laws, like the Lanham Act, that are beyond the scope of the Copyright Clause,¹¹ the Supreme Court has been troubled by interpretations of trademark and unfair competition law that affords patent-like or copyright-like protection evading the "limited times" restriction on patents and copyrights imposed by the Constitution, and thereby attempts to grant proprietary rights over materials in the public domain.¹² These decisions underscore the Supreme Court's statement in *Bonito Boats* that the Copyright Clause serves as a limitation on congressional authority as well as a grant of power to the legislative branch.¹³ They are consistent with the Court's historic copyright jurisprudence that emphasizes the public purposes embodied in the Copyright Clause instead of focusing on the proprietary interests of authors and/or copyright owners.¹⁴

On the surface, *Eldred* is not at odds with decisions like *Dastar*, *WalMart*, and *TrafFix* because Congress passed CTEA under its Copyright Clause authority and CTEA did not remove works from the public domain.¹⁵ Those decisions involved interpretation of the

and the Allied Campaign in Europe During WWII Have in Common? The Public Domain and The Supreme Court's Intellectual Property Jurisprudence, 13 U. BALT. INTELL. PROP. L.J. 57, 89–100 (2005).

¹⁰ See, e.g., *TrafFix Devices*, 532 U.S. at 34–35; *Sears, Roebuck & Co.*, 376 U.S. at 232–33.

¹¹ The constitutionality of modern trademark laws rests on Congress' authority under the Commerce Clause. Brian Danitz, Comment, *Martignon and KISS Catalog: Can Live Performances Be Protected?*, 15 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1143, 1163 (2005); see also Samuelson, *Constitutional Law*, *supra* note 8, at 552–53 n.24 (discussing *Feist's* reliance on *The Trademark Cases*, 100 U.S. 82 (1879), and noting how this "gave them new life in arguments about the constitutionality of other intellectual property legislation").

¹² David S. Welkowitz, *The Supreme Court and Trademark Law in the New Millennium*, 30 WM. MITCHELL L. REV. 1659, 1689 (2004).

¹³ *Bonito Boats*, 489 U.S. at 146; see also *Graham*, 383 U.S. at 5–6; *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991); Paul J. Heald, *The Vices of Originality*, in 1991 THE SUPREME COURT REVIEW 143, 143–45 (Dennis J. Hutchinson et al. eds., 1991) [hereinafter Heald, *The Vices of Originality*].

¹⁴ Hamilton, *supra* note 6, at 323; see also *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (stating that the copyright law makes reward to the author a secondary consideration).

¹⁵ JOYCE ET AL., *supra* note 5, at 382, 384; Edward Lee, *The Public's Domain: The Evolution of Legal Restraints on the Government's Power to Control Public Access Through Secrecy or Intellectual Property*, 55 HASTINGS L.J. 91, 170 (2003); Samuelson, *Constitutional*

Lanham Act, a statute enacted by Congress under its Commerce Clause authority.¹⁶ *Dastar* even cites *Eldred* for the proposition that Congress cannot create a species of perpetual patent or copyright.¹⁷ Still, given the Supreme Court's expansive statements in *Eldred* about the authority of Congress under the Copyright Clause coupled with its treatment of several of its previous statements on intellectual property policy as well as its general reluctance to strike down legislation,¹⁸ it is appropriate to ask whether there are any limits on the Court's deference to Congress in setting intellectual property policy under the Copyright Clause. Does Congress enjoy a *carte blanche* to legislate on intellectual property matters as it deems appropriate? Has the Court backed away from its posture regarding copyright law expressed in the *Feist* decision¹⁹ to return to a relationship with Congress on copyright law that is deferential to the point of servility?²⁰

Law, *supra* note 8, at 559 (noting the Supreme Court's silence on the public domain in *Eldred*). On the other hand, under *Eldred* Congress holds the power to restrict the flow of material into the public domain. Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON L. REV. 215, 255–56 (2002).

¹⁶ The Lanham Act is also known as the Trademark Act of 1946, ch. 540, 60 Stat. 427 (codified as amended at 15 U.S.C. §§ 1051–72 (2000)).

¹⁷ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (citing *Eldred v. Ashcroft*, 537 U.S. 186, 208 (2003)); see Tom W. Bell, *Misunderestimating Dastar: How the Supreme Court Unwittingly Revolutionized Copyright Preemption*, 65 MD. L. REV. 206, 233 (2006) (explaining that *Dastar* and *Eldred* are not in contradiction because *Eldred* is premised on the fact that CTEA did not create perpetual copyright protection while the reverse passing off claim attacked in *Dastar* had the effect of creating a perpetual copyright); Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademarks Law*, 41 HOUS. L. REV. 263, 267 (2004) (asserting that *Dastar*, which made clear that a work's entry into the public domain precludes resort to the Lanham Act to achieve copyright-like protection, "might [be] see[n] as an act of contrition" by the Supreme Court for having upheld CTEA in *Eldred*).

¹⁸ Christina Bohannon, *Reclaiming Copyright*, 23 CARDOZO ARTS & ENT. L.J. 567, 568, 573 (2006) (noting that constitutional attacks on intellectual property legislation are rarely successful and arguing that statutory construction is superior to constitutional adjudication to combat the special-interest influence over copyright); Leaffer, *supra* note 6, at 1604 (noting only one instance in which courts have declared a copyright bill unconstitutional); cf. Gary Lawson, *The Rise and Rise of the Administrative State*, 107 HARV. L. REV. 1231, 1233, 1236 (1994) (asserting that "the [Supreme] Court has effectively acquiesced in Congress's assumption of general legislative powers").

¹⁹ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 351 (1991). See generally Craig W. Dallon, *Original Intent and the Copyright Clause: Eldred v. Ashcroft Gets it Right*, 50 ST. LOUIS U. L.J. 307, 348–52 (2006) (questioning *Eldred's* language diminishing the public interest rationale of copyright in favor of a private interest based theory).

²⁰ JOYCE ET AL., *supra* note 5, at 383–84 (discussing two views of the history of copyright legislation); Leaffer, *supra* note 6, at 1604; Ruth L. Okediji, *Through the Years: The Supreme Court and the Copyright Clause*, 30 WM. MITCHELL L. REV. 1633, 1638, 1643 (2004); Samuelson, *Constitutional Law*, *supra* note 8, at 557–58; Niels Schaumann, *Copyright, Containers, and the Court: A Reply to Professor Leaffer*, 30 WM. MITCHELL L. REV. 1617, 1617–18 (2004) (arguing that the Court treats the limits on Congress' power in regard to copyright as theoretical). But see Hamilton, *supra* note 6, at 339 (speculating in 2000, before *Eldred*

The answer to these questions might be “yes.” The Court’s deference to Congress coupled with its reliance on the unbroken history of congressional practice granting term extensions,²¹ and statements regarding rewarding copyright owners and the differences between the patent and copyright monopolies²² have been critical in recent decisions upholding section 514 of the Uruguay Round Agreements Act (URAA) that provides for the restoration of copyright protection for certain works by foreign authors that had entered the public domain.²³ Another court, relying on *Eldred*, upheld the Copyright Renewal Act and the Berne Convention Implementation Act as well as CTEA.²⁴ Appropriate deference to Congress also played an important role in several decisions interpreting an anti-bootlegging statute that affords protection to live performances which are recorded without permission of the performers. The cases are split on whether the anti-bootlegging statute violates the Copyright Clause’s “limited times” and “writings” requirements, and over whether the statute can be upheld under the Commerce Clause or the Treaty Power.²⁵

was decided, that *Feist* showed that the Court was no longer inclined to be “deferential to the point of servility”).

²¹ See *Eldred*, 537 U.S. at 200 (discussing the “unbroken congressional practice of granting to authors of works with existing copyrights the benefit of term extensions”). This can be regarded as another reason for deference to the judgment of the legislative branch to set intellectual property policy. Cf. Peter J. Spiro, *Treaties, Executive Agreements, and Constitutional Method*, 79 TEX. L. REV. 961, 965, 1009–10 (2001) (developing a theory of constitutional incremental change in the context of foreign relations law. This flexible approach is accretive and assumes a continuity of constitutional change, denies the possibility of historical return, dismisses the relevance of fidelity as a tool of constitutional determination, and recognizes that even minor controversies and unchallenged congressional practices comprise parts of constitutional standard setting. This theory helps explain the Supreme Court’s reading of the Copyright Clause in *Eldred*). But see Dallon, *supra* note 19, at 354–57 (cautioning against over-reliance upon historical congressional practices as support for constitutional interpretation); L. Ray Patterson, *What’s Wrong with Eldred? An Essay on Copyright Jurisprudence*, 10 J. INTELL. PROP. L. 345, 349, 354–55 (2003) (criticizing the Court’s reliance on past congressional practices instead of focusing on the Constitution’s text).

²² The patent law classic, *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 5–6 (1966), indicates that Congress cannot restore protection to expired patents, but the patent/copyright analogy now may be of limited utility because, according to the majority opinion in *Eldred*, patents and copyrights are not alike even though the statutes derive from the same clause in the Constitution. *Eldred*, 537 U.S. at 216–17; see also Dallon, *supra* note 19, at 352–54 (rejecting the Court’s response to the *quid pro quo* argument).

²³ *Luck’s Music Library, Inc. v. Gonzales*, 407 F.3d 1262, 1263 (D.C. Cir. 2005); *Golan v. Gonzales*, No. Civ. 01-B-1854 (BNB), 2005 WL 914754, at *5–*14 (D. Colo. Apr. 20, 2005), *aff’d in part*, No. 05-1259, 2007 WL 2547974 (10th Cir. Sept. 4, 2007).

²⁴ *Kahle v. Ashcroft*, No. C-04-1127 MMC, 2004 WL 2663157, at *13–*18 (N.D. Cal. Nov. 19, 2004), *aff’d*, 487 F.3d 697 (9th Cir. 2007).

²⁵ *United States v. Martignon*, 346 F. Supp. 2d 413, 416–17 (S.D.N.Y. 2004). But see *KISS Catalog, Ltd. v. Passport Int’l Prods.*, 405 F. Supp. 2d 1169 (C.D. Cal. 2005); *United States v. Moghadam*, 175 F.3d 1269, 1271 (11th Cir. 1999). *Martignon* distinguished *Moghadam*, a

This article discusses these post-*Eldred* decisions, the expansive authority of Congress under the Copyright Clause, the meaning of the Clause's limitations in the face of the Court's deference to congressional authority, and the significant risk of encroachment on the public domain resulting from Congress' exercise of power under the Copyright Clause. Justice Stevens concluded his *Eldred* dissent with this prophetic statement:

By failing to protect the public interest in free access to the products of inventive and artistic genius—indeed, by virtually ignoring the central purpose of the Copyright/Patent Clause—the Court has quitclaimed to Congress its principal responsibility in this area of the law. Fairly read, the Court has stated that Congress' actions under the Copyright/Patent Clause are, for all intents and purposes, judicially unreviewable.²⁶

These recent decisions, applying *Eldred* to uphold challenged legislation, show that it may not be necessary for Congress to turn to its authority under the Commerce Clause or the Treaty Power in order to enact legislation that arguably escapes the limitations in the Copyright Clause.²⁷ Given Congress' exercise of general legislative powers, the Court's deference to Congress' judgment in exercising its considerable power under the Copyright Clause as well as its historic reluctance to strike down intellectual property legislation, the Clause's limitations on congressional authority could become meaningless and this puts the public domain at risk.²⁸

pre-*Eldred* decision that had upheld the anti-bootlegging statute under the Commerce Clause. *Martignon*, 346 F. Supp. 2d at 419; see also Holbrook, *supra* note 8, at 24–29. See generally David Nimmer, Essay, *The End of Copyright*, 48 VAND. L. REV. 1385, 1409–12 (1995) (questioning whether the anti-bootlegging and the restoration provisions in the URAA can be upheld under the Commerce Clause and/or the Treaty Power with help from the Necessary and Proper and the Supremacy Clauses). The Second Circuit vacated and remanded *Martignon* on June 13, 2007, holding that Congress was free to enact the anti-bootlegging statute under the Commerce Clause. *United States v. Martignon*, 492 F.3d 140, 152–53 (2d Cir. 2007).

²⁶ *Eldred*, 537 U.S. at 242 (Stevens, J., dissenting); see also Lawson, *supra* note 18, at 1237 (noting deference to Congressional legislation by the executive branch).

²⁷ Cf. Samuelson, *Constitutional Law*, *supra* note 8, at 557–58, 563 (noting the significant questions raised by *Eldred* and the broad latitude enjoyed by Congress to enact intellectual property legislation); Shipley, *supra* note 9, at 99–100. But see Nimmer, *supra* note 25, at 1409–12 (discussing what Congress might be able to accomplish under the Commerce Clause and Treaty Power and asking whether the affirmative grant of limited powers to Congress in the Copyright Clause is still relevant). This Article will not discuss Congress' authority, or lack thereof, to enact copyright-like legislation under other grants of power in the constitution. There is a considerable amount of scholarly commentary on this topic. See *supra* note 7.

²⁸ Bohannon, *supra* note 18, at 568, 573; Leaffer, *supra* note 6, at 1604; Lee, *supra* note 15,

II. THE PUBLIC DOMAIN, THE COURT'S DEFERENCE TO CONGRESS, AND THE DIFFERENCES BETWEEN PATENTS AND COPYRIGHTS

Much has been written about the public domain.²⁹ There is no single definition of the metes and bounds of this area that is the “outside’ of the intellectual property system, the material that is free for all to use and build upon.”³⁰ It is contended that this vast area, unlike public lands owned by the government, is owned by the public.³¹ The public domain is more than the facts, ideas, and concepts which cannot be protected by copyright³² as well as those discoveries which do not satisfy the rigorous requirements for patent protection. It includes all those once protected inventions and works of authorship for which patent or copyright protection has expired or lapsed. It also contains those sounds, shapes, scenes, characters, plots, and other items “out there” which authors, composers, artists, sculptors, and others combine, reshape, mix, alter, adapt, and transform in preparing new works.³³ This kind of borrowing and recombination “is not parasitism: it is the essence of authorship. And, in the absence of a vigorous public domain, much of it would be illegal.”³⁴

The public domain is essential to the creative efforts of writers, composers, artists, and all other kinds of authors,³⁵ and the

at 99, 170–75 (the author explains how ‘different rules’ may be jeopardizing the continued viability of the doctrine of the public domain); *cf.* Lawson, *supra* note 18, at 1237.

²⁹ See, e.g., THE PUBLIC DOMAIN, 66 LAW & CONTEMP. PROBS. (SPECIAL ISSUE) (James Boyle ed. 2003) (twelve articles in a 480 page volume); Ochoa, *supra* note 15, at 215; Lee, *supra* note 15, at 91.

³⁰ Boyle, *supra* note 4, at 1; *cf.* Pamela Samuelson, *Enriching Discourse on Public Domains*, 55 DUKE L.J. 783, 784 (2006) (discussing the benefits of accepting the existence of multiple public domains as suggested by Professor Boyle).

³¹ Ochoa, *supra* note 15, at 259–60; *cf.* Lee, *supra* note 15, at 97 n.23 (noting that the information in the public domain is a resource that is difficult to exhaust). *But see* DANIEL C.K. CHOW & EDWARD LEE, INTERNATIONAL INTELLECTUAL PROPERTY 112 n.10 (2006) (pointing out that one view of the public domain is that the government has power to define and redefine it—that it can remove works from it because the public domain is what the government does not subject to intellectual property rights).

³² 17 U.S.C. § 102(b) (2007).

³³ Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 966–67 (1990).

³⁴ *Id.* at 967; *see also* Samuelson, *Constitutional Law*, *supra* note 8, at 559–60 (discussing this positive view of the public domain).

³⁵ The term “author” has been defined broadly by the Supreme Court and Congress since the enactment of the first copyright statute in 1790. See, e.g., *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57–58 (1884) (“An author in that sense is ‘he to whom anything owes its origin; originator; maker; one who completes a work of science or literature.’”) (citation omitted).

Supreme Court has held that the public has a constitutional right to copy articles, designs, and other works of authorship and inventions that have entered the public domain.³⁶ The Court made clear in *Sears* and *Compco* that fundamental policy, embodied in the Patent and Copyright Clause, gives the public the right to copy whatever the federal patent and copyright laws leave in the public domain.³⁷ Implicit in the Clause is the principle that “free exploitation of ideas will be the rule, to which the protection of a federal patent is the exception.”³⁸ The Court later interpreted the Copyright Act and the Copyright Clause in *Feist* to strike down copyright protection for data while declaring that “originality” is a constitutional requirement even though that term is not in the Copyright Clause.³⁹ Similarly, in *Dastar*, the Supreme Court rejected an interpretation of the Lanham Act that resulted in the recapture of a work that had entered the public domain.⁴⁰ Trademark law cannot be used as a subterfuge for extending the limited periods of monopoly privilege enjoyed by patent and copyright holders.⁴¹ Congress cannot create a species of perpetual patent or copyright.⁴²

Justice Stevens, dissenting in *Eldred*, relied on the Supreme Court’s decisions in *Graham*, *Sears*, and *Bonito Boats* to underscore the importance of the public domain while arguing that Congress

³⁶ *Feist Publ’ns, Inc., v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350 (1991); *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979); *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 5–6 (1966); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896); Lee, *supra* note 15, at 110–116.

³⁷ *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231 (1964) (finding that a manufacturer may copy any product not protected by patent or trade-mark); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964) (stating that state laws disallowing the copying of articles that are otherwise unprotected by federal patent laws contravene federal policy).

³⁸ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1989); *see also Graham*, 383 U.S. at 5–6; Yochai Benkler, *Through the Looking Glass: Alice and the Constitutional Foundations of the Public Domain*, 66 LAW & CONTEMP. PROBS. 173, 177 (2003) (noting that copyright laws mark a tension between free economics of information exchange and the desire to promote innovation).

³⁹ *Feist Publ’ns*, 499 U.S. at 346, 362; Hamilton, *supra* note 6, at 339; *see also Ochoa, supra* note 15, at 247–56 (discussing several of the Supreme Court’s decisions on patent and copyright law issues in which it has emphasized the importance and constitutional underpinnings of the public domain).

⁴⁰ Samuelson, *Constitutional Law, supra* note 8, at 560–62 (contending that this decision endorses the public’s right to copy works in the public domain and invokes the Constitution to support this right).

⁴¹ *See Shipley, supra* note 9, at 92–93; Welkowitz, *supra* note 12, at 1686–87, 1689.

⁴² *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (citing *Eldred v. Ashcroft*, 537 U.S. 186, 208 (2003)); *see also Welkowitz, supra* note 12, at 1686–87, 1689 (noting that this cite to *Eldred* shows that the Court wants trademark law to be far removed from traditional intellectual property).

could not extend the copyright term retroactively.⁴³ He said it was settled that the Copyright Clause was both a grant of power and a limitation, that Congress could not “overreach the restraints imposed by the stated constitutional purpose” of that Clause,⁴⁴ and that the reasons for preventing a state from extending the life of a patent beyond its expiration date applied to Congress.⁴⁵ If Congress could not extend the life of the patent monopoly, then Congress could not extend the life of a copyright beyond its expiration date.⁴⁶ It was noted that the Constitution’s requirement that the grants of exclusive rights are for “limited [t]imes’ serves the ultimate purpose of promoting the ‘Progress of Science and useful Arts’ by guaranteeing that those innovations will enter the public domain as soon as the period of exclusivity expires”⁴⁷ The “overriding purpose of providing a reward for authors’ creative activity is to motivate that activity and ‘to allow the public access to the products of their genius after the limited period of exclusive control has expired.’”⁴⁸ Accordingly, he contended that CTEA’s retroactive extension of the copyright term, keeping thousands of works from entering the public domain, did not serve the purposes of the Copyright Clause.⁴⁹

The *Eldred* majority disagreed with Justice Stevens. It stated that *Sears* “placed no reins on Congress’ authority to extend a patent’s life” and that “[a] decision thus rooted in the Supremacy Clause cannot be turned around to shrink congressional choices.”⁵⁰ The majority discussed congressional authority over patents, explained that neither *Sears* nor *Bonito Boats* concerned the extension of a patent’s duration, and said that those opinions did not suggest that such an extension might be constitutionally infirm.⁵¹ Moreover, the majority deferred to Congress’ broad power to enact intellectual property laws and quoted *Bonito Boats*, emphasizing that it is for Congress to decide if copyright and patent

⁴³ See *Eldred*, 537 U.S. at 222–42 (Stevens, J., dissenting).

⁴⁴ *Id.* at 234 (quoting *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 5–6 (1966)).

⁴⁵ *Id.* at 222–23.

⁴⁶ *Id.* It was plain to Justice Stevens that “the limitations ‘implicit in the Patent Clause itself’ adequately explain why neither a State nor Congress may ‘extend the life of a patent’” *Id.* at 226 (citation omitted).

⁴⁷ *Id.* at 223.

⁴⁸ *Id.* at 227 (quoting *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984)).

⁴⁹ See *id.* at 241.

⁵⁰ *Id.* at 203 n.8 (Ginsburg, J., majority opinion).

⁵¹ *Id.* at 215–16.

statutes effectuate the goals of the Copyright Clause.⁵²

The *Eldred* majority paid no heed to the statements made in *Graham* which indicated that Congress could not remove existent knowledge from the public domain or restrict free access to materials already publicly available.⁵³ In *Eldred*, there was no need to do so because CTEA did not remove works from the public domain. Instead, the majority emphasized the statements from *Graham* and *Bonito Boats* that Congress may, within the Constitution's limits, "implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim."⁵⁴ Although the *Graham* decision appears to be a clear statement that the public domain is sacrosanct, the *Eldred* majority cited, quoted, and relied upon *Graham* when it explained its deference to Congress' justification for enacting CTEA.⁵⁵ The *Eldred* Court stated, "[t]he wisdom of Congress' action . . . is not within our province to second-guess."⁵⁶

The majority went on to say that the Court's past pronouncements regarding patents do not necessarily apply to copyright because of the substantial differences between the respective rights even though they are derived from the same clause in the Constitution.⁵⁷ It noted that they do not entail the same exchange between the government and the inventor/author, and the *quid pro quo* discussed in patent cases; the grant of the patent monopoly in exchange for the benefits enjoyed by the public from an invention is not part of copyright where disclosure is the objective, instead of something extracted from the author in exchange for the copyright.⁵⁸ "[W]e reject the proposition that a *quid pro quo* requirement stops Congress from expanding copyright's term in a manner that puts existing and future copyrights in parity."⁵⁹

The majority in *Eldred* also explained that the scopes of the patent and copyright monopolies are very different; a patent

⁵² *Id.* at 216.

⁵³ See *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 6 (1966).

⁵⁴ *Eldred v. Ashcroft*, 537 U.S. 1, 213, 216 (2003) (citing *Graham*, 383 U.S. at 6); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 168 (1989).

⁵⁵ See *Eldred*, 537 U.S. at 222.

⁵⁶ *Id.*

⁵⁷ See *id.* at 216.

⁵⁸ *Id.*

⁵⁹ *Id.* at 217. *But see id.* at 246–47 (Breyer, J., dissenting) (discussing the economic foundation for copyright and how the public benefits from the grant of exclusive rights to the author); Heald & Sherry, *supra* note 8, at 1169 ("It is difficult to imagine a more overt violation of the Quid Pro Quo Principle than CTEA.").

prevents full use being made of the knowledge it discloses, while copyright protections would not prevent the reader of a book from using the knowledge he or she may acquire from reading.⁶⁰

In making these statements about the differences between patents and copyrights, the majority seemed to forget that it “had consistently viewed [the Copyright Clause] as authorizing Congress to strike an economic bargain with authors on the public’s behalf.”⁶¹ The statement from *Mazer v. Stein*, that “[t]he economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts,’”⁶² was relegated to a footnote in which the majority emphasized that “copyright law celebrates the profit motive” and that “[t]he profit motive is the engine that ensures the progress of science.”⁶³ There is no doubt that authors and other creators are able to extract recompense for their creativity or labor thanks to copyright’s grant of exclusive rights,⁶⁴ but the *Eldred* majority moved away from the Court’s previous statements that the overriding purpose of this reward for authors’ creative genius is in the release to the public of the products of that genius and in allowing the public access to those products after copyright has expired. The Court instead focused on reward to the copyright owner.⁶⁵

The Supreme Court’s bold statements in *Eldred* about the differences between patents and copyrights also are at odds with statements in other decisions about similarities between the two intellectual property regimes. The Court showed no reluctance after *Eldred* in turning to the patent law rule on inducement of infringement when it held in *Grokster* that “one who distributes a

⁶⁰ *Eldred*, 537 U.S. at 217.

⁶¹ Paul J. Heald, *American Corporate Copyright: A Brilliant, Uncoordinated Plan*, 12 J. INTEL. PROP. L. 489, 490 (2005) [hereinafter Heald, *American Corporate Copyright*]; Shipley, *supra* note 9, at 96–98.

⁶² *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (emphasis added).

⁶³ *Eldred*, 537 U.S. at 212 n.18 (quoting *Am. Geophysical Union v. Texaco, Inc.*, 802 F. Supp. 1, 27 (S.D.N.Y. 1992), *aff’d*, 60 F.3d 913 (2d Cir. 1994)).

⁶⁴ *Cf. Teleprompter Corp. v. Columbia Broad. Sys., Inc.*, 415 U.S. 394, 411 (1974) (explaining how advertisers compensate authors of television programs, not the viewers, creating an indirect recompense).

⁶⁵ Two cases prior to *Eldred* focusing on the public good over the copyright owner are *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984); *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948); *see also Okediji, supra* note 20, at 1653–55; Christopher Ledford, Comment, *The Dream That Never Dies: Eldred v. Ashcroft, the Author, and the Search for Perpetual Copyright*, 84 OR. L. REV. 655, 676–77 (2005).

device with the object of promoting its use to infringe copyright, as shown by clear expression or other affirmative steps taken to foster infringement, is liable for the resulting acts of infringement by third parties.”⁶⁶ Long before *Eldred*, the Court turned to patent law’s traditional “staple article of commerce doctrine” when it held in *Sony* that the manufacturer of the video recorder was not liable for contributory copyright infringement because the device was “capable of [commercially significant] noninfringing uses.”⁶⁷

The Court treated the patent and copyright monopolies alike soon after the *Eldred* decision was announced when it stated in *Dastar* that “[t]he rights of a patentee or copyright holder are part of a ‘carefully crafted bargain,’ . . . under which, once the patent or copyright monopoly has expired, the public may use the invention or work at will and without attribution.”⁶⁸ The Court stated that it did not want to create a “mutant” copyright law limiting the “public’s federal right to ‘copy and to use,’ expired copyrights.”⁶⁹ To hold that the phrase “origin of goods” in section 43(a) of the Lanham Act refers to the author of any idea or concept embodied in a work as well as to the producer of the tangible goods that are offered for sale, “would be akin to finding that § 43(a) created a species of perpetual patent and copyright, which Congress may not do.”⁷⁰ *Eldred* was cited to support these statements. The Court acknowledged a “federal right to ‘copy and to use’ expired copyrights.”⁷¹

So what are the metes and bounds of the public domain recognized by the Supreme Court? It acknowledged in *Eldred* that Congress has a “virtually unlimited power to restrict the flow of new material into the public domain,”⁷² but it has also recognized in *Sears*, *Bonito Boats*, *Feist*, *Dastar*, and other decisions a positive view of the public domain and the public’s constitutionally supported right to copy and use works from the public domain.⁷³

⁶⁶ *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913, 919 (2005).

⁶⁷ *Sony Corp. of Am.*, 464 U.S. at 442.

⁶⁸ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33–34 (2003) (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150 (1989)). See generally Shipley, *supra* note 9, at 81–89 (discussing *Dastar* and its significance).

⁶⁹ *Dastar*, 539 U.S. at 34 (quoting *Bonito Boats*, 489 U.S. at 165).

⁷⁰ *Id.* at 37 (citing *Eldred v. Ashcroft*, 537 U.S. 186, 208 (2003) (emphasis added)).

⁷¹ *Id.* at 34.

⁷² Ochoa, *supra* note 15, at 255–56.

⁷³ Benkler, *supra* note 38, at 177; Lee, *supra* note 15, at 116–17 (the Court “has consistently made clear that the Copyright Clause protects the rights of the public in accessing and using public domain materials”) (emphasis removed); Ochoa, *supra* note 15, at 237–56 (discussing the Supreme Court’s decisions that emphasize the importance and

The Court has not, however, ruled directly on whether Congress has the authority to remove works from the public domain and on the validity of the argument that “limited times” “prohibits perpetual [protection]” but does not “confine[] the [copyright monopoly] to a single and uninterrupted term.”⁷⁴ That argument is at odds with the Court’s statement in *Graham* that “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.”⁷⁵

Although the Court stated in *Eldred* that the copyright and patent monopolies are not identical, there is a strong argument in the copyright context that the public domain cannot be reduced⁷⁶ because there still is a carefully crafted bargain between the grantor of the exclusive rights (the federal government) and the grantee authors and inventors. The bargains may not be identical, but there still is a quid pro quo for patents and copyrights in that both regimes “confer[] . . . and extract[]” “reciprocal rights . . . from copyright and patent owners.”⁷⁷ The differences between the patent and copyright monopolies have not prevented the Supreme Court from turning to its interpretations of patent law to support similar interpretations of copyright law. Accordingly, it is very important that these statutes derive from the same clause in the Constitution, that this clause contains substantive limitations, and that there is a federal right to freely copy and use works that are in the public domain.⁷⁸

The Court has created the “doctrinal underlay of the ‘public domain’” and has policed congressional power to protect the

constitutional underpinnings of the public domain); Samuelson, *Constitutional Law*, *supra* note 8, at 560–62.

⁷⁴ MARSHALL LEAFFER, UNDERSTANDING COPYRIGHT LAW 265 (4th ed. 2005); *see also* Diane Leenheer Zimmerman, *Is There a Right to Have Something to Say? One View of the Public Domain*, 73 FORDHAM L. REV. 297, 299 (2004). The government has argued in support of the copyright restoration statute, 17 U.S.C. § 104A, that Congress can authorize removal of works from the public domain. *See* Lee, *supra* note 15, at 101; *see also* Kevin A. Goldman, Comment, *Limited Times: Rethinking the Bounds of Copyright Protection*, 154 U. PA. L. REV. 705, 738–40 (2006) (providing arguments for making copyright protection renewable indefinitely while narrowing the scope of protection, perhaps under the Copyright Clause or perhaps under the Commerce Clause).

⁷⁵ *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 6 (1966).

⁷⁶ Ochoa, *supra* note 15, at 262 (arguing that there is a constitutional basis for challenging copyright restoration legislation). *But see* LEAFFER, *supra* note 74, at 265 (stating that restoration probably does not violate the “limited times” provision).

⁷⁷ Welkowitz, *supra* note 12, at 1686 (discussing *Dastar*).

⁷⁸ *Bonito Boats, Inc., v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989).

commons.⁷⁹ Perhaps the Supreme Court will reject the argument that the “limited times” provision in the Copyright Clause only prohibits perpetual protection and hold that this limitation also prevents Congress from enacting legislation that reduces the size of public domain. The wild card in making any prediction like this, however, is the degree to which the Court will defer to Congress’ judgment in setting intellectual property policy. If *Eldred’s* deference to Congress and its statements about the differences between patents and copyrights are pushed too far, as in some of the lower court decisions discussed in the next section, then the limitations in the Copyright Clause become almost meaningless⁸⁰ and the public’s rights in the public domain will erode.

II. *ELDRED*, DEFERENCE, WRITINGS, AND LIMITED TIMES IN THE COURTS

A. *The Fixation Requirement and Anti-Bootlegging Legislation*

Authors, composers, and publishers of musical compositions have enjoyed copyright protection for their works for many years, and sound recordings have enjoyed federal protection since 1972. For example, the composer Paul Anka is compensated for public performances of his classic, “I Did It My Way,” plus he receives royalties from the sale of recordings of his composition, whether the recordings are by Frank Sinatra, Elvis Presley, or the Sex Pistols. In addition, copyright protects the many recordings of Anka’s composition against piracy—the duplication of the recordings themselves. Prior to 1994, however, there was no federal protection for a performing artist’s live performance of Anka’s composition. If Willie Nelson performed “I Did It My Way” and Hoagy Carmichael’s “Stardust” at a concert, and a Nelson fan recorded his performance without permission, that Nelson fan would have been able to sell her recordings (audio and audio-visual) so long as she paid appropriate royalties to the holders of copyright on those songs. There was no need for the Nelson fan—the bootlegger—to pay royalties to Willie Nelson or the holders of copyright on Nelson’s

⁷⁹ Okediji, *supra* note 20, at 1646 (citation omitted); Lee, *supra* note 15, at 116–17.

⁸⁰ Schaumann, *supra* note 20, at 1618 (the limitations are “largely theoretical”). *But see* Oliar, *supra* note 5 (arguing that the text of the Copyright Clause serves as a literal, intentional limitation on congressional power).

recordings of “Stardust” and “I Did It My Way.”⁸¹

Copyright law’s fixation requirement has been regarded as the major barrier to legislation affording federal protection against the bootlegging of live performances. Nevertheless, this changed in 1994⁸² when Congress passed the Uruguay Round Agreements Act (URAA) in order to implement the General Agreement on Tariffs and Trade (GATT).⁸³ Section 512 of this Act is an anti-bootlegging statute that bars the unauthorized audio and audio-visual recording of live performances, the unauthorized reproduction of the recordings, and the trafficking in unauthorized recordings. It provides for both civil and criminal penalties but it does not specify a term or duration.⁸⁴ This legislation is the first in United States copyright law to provide a remedy for works that have not been fixed in a tangible medium of expression and to subject violators to copyright-like liability.⁸⁵ It is not surprising that many commentators have questioned the constitutional foundation of this statute.⁸⁶

⁸¹ See Susan M. Deas, *Jazzing Up the Copyright Act? Resolving the Uncertainties of the United States Anti-Bootlegging Law*, 20 HASTINGS COMM. & ENT. L.J. 567, 573–74 (1998); Adam Giuliano, Essay, *Steal This Concert? The Federal Anti-Bootlegging Statute Gets Struck Down, But Not Out*, 7 VAND. J. OF ENT. L. & PRAC. 373, 374 (2005); *United States v. Martignon*, COPYRIGHT L.J., Jan–Feb. 2005, at 10, 11–12.

⁸² LEAFFER, *supra* note 74, at 52; *United States v. Martignon*, *supra* note 81, at 11.

⁸³ JOYCE ET AL., *supra* note 5, at 208. The Agreement on Trade Related Aspects of Intellectual Property (TRIPS) and the World Intellectual Property Organization (WIPO) treaty required member nations to recognize the right of performers to control the recording of their unfixed performances in both sound recordings and videos. *Id.* In 1994, more than one hundred nations signed the final act embodying the results of Uruguay Round of multilateral trade negotiations and thereby adopted TRIPS. *United States v. Martignon*, *supra* note 81, at 11. When Congress approved the URAA, TRIPS became law in the United States. See LEAFFER, *supra* note 74, at 52–53; Deas, *supra* note 81, at 582–99 (discussing the passage of the anti-bootlegging law); *United States v. Martignon*, *supra* note 81, at 11.

⁸⁴ *United States v. Martignon*, *supra* note 81, at 11. The criminal sanctions are provided in 18 U.S.C. § 2319A (2000), and civil liability for bootlegging is in 17 U.S.C. § 1101 (2000); see also Danitz, *supra* note 11, at 1151–58.

⁸⁵ LEAFFER, *supra* note 74, at 53; Nimmer, *supra* note 25, at 1388, 1399–1401. For example, the criminal statute provides fines and imprisonment for anyone who, “without the consent of the performer or performers involved, knowingly and for purposes of commercial advantage or private financial gain—(1) fixes the sounds or sounds and images of a live musical performance in a copy or phonorecord, or reproduces copies or phonorecords of such a performance from an unauthorized fixation; (2) transmits or otherwise communicates to the public the sounds or sounds and images of a live musical performance; or (3) distributes . . . , sells . . . , rents . . . or traffics in any [such] copy or phonorecord” 18 U.S.C. § 2319A (2000). Although this anti-bootlegging legislation was limited to live performances of musical works, it arguably opened the door for extending protection to live performance of dramatic works. LEAFFER, *supra* note 74, at 54.

⁸⁶ Kenneth D. Crews, *Harmonization and the Goals of Copyright: Property Rights or Cultural Progress?*, 6 IND. J. GLOBAL LEGAL STUD. 117, 126–27 (1998) [hereinafter Crews, *Harmonization and the Goals of Copyright*]; Deas, *supra* note 81, at 574–80; Nimmer, *supra*

The Eleventh Circuit upheld this legislation several years prior to the *Eldred* decision in *United States v. Moghadam*.⁸⁷ Its constitutionality was based on Congress' authority under the Commerce Clause.⁸⁸ The defendant, Ali Moghadam, who admitted to knowingly distributing bootleg CDs of live performances by Tori Amos, the Beastie Boys, and other artists, moved to dismiss a criminal indictment because the statute did not fall within Congress' Copyright Clause powers.⁸⁹ The government argued that the statute was valid under the Commerce Clause, the trial court denied Moghadam's motion,⁹⁰ and the Eleventh Circuit affirmed his conviction, saying that the anti-bootlegging statute was a hybrid that resembled copyright in some ways but was distinct in others.⁹¹ The court said that the word "writings" in the Copyright Clause seemed to require some kind of fixation,⁹² but it declined to decide whether that Clause could be expanded to include protection for live performances that were capable of being reduced to tangible form. It assumed, without deciding, that the fixation requirement precluded Congress from turning to the Copyright Clause as the source of its power for enacting the statute.⁹³ It also noted several times that the statute did not have an explicit time limit but pointed out that the defendant had failed to preserve the argument that the statute violated the Copyright Clause's "limited times" provision.⁹⁴

The court turned to the Commerce Clause to support the

note 25, at 1410; Lionel S. Sobel, *Bootleggers Beware: Copyright Law Now Protects Live Musical Performances, But New Law Leaves Many Questions Unanswered*, ENT. L. REP., July 1995, at 6, 11.

⁸⁷ *United States v. Moghadam*, 175 F.3d 1269, 1271 (11th Cir. 1999); see also Danitz, *supra* note 11, at 1169; Angela T. Howe, Note, *United States v. Martignon & KISS Catalog v. Passport International Products: The Anti-Bootlegging Statute and the Collision of International Intellectual Property Law and the United States Constitution*, 20 BERKELEY TECH. L.J. 829, 836-39 (2005); Michael C. Shue, Note, *United States v. Martignon: The First Case to Rule that the Federal Anti-Bootlegging Statute Is Unconstitutional Copyright Legislation*, 60 U. MIAMI L. REV. 131, 131 (2005).

⁸⁸ *Moghadam*, 175 F.3d at 1274-75.

⁸⁹ *Id.* at 1271.

⁹⁰ *Id.*

⁹¹ *Id.* at 1272-73. For instance, it was not clear whether the fair use doctrine or work for hire applied. *Id.*

⁹² *Id.* at 1273-74. The court noted that the Supreme Court said in *Goldstein v. California* that the "writings" requirement had been construed to mean "any physical rendering of the fruits of [the author's] creative [or] intellectual . . . labor[s]." *Id.* at 1274 (quoting *Goldstein v. California*, 412 U.S. 546, 561 (1973)).

⁹³ *Id.* at 1274.

⁹⁴ *Id.* at 1274 n.9, 1281 n.15.

legislation even though Congress had not cited it.⁹⁵ The lack of a jurisdictional element commonly found with criminal statutes passed under the Commerce Clause was not fatal because the court said that the link between the prohibited conduct of making and distributing bootleg CDs and interstate and foreign commerce was self evident.⁹⁶ According to the court, “[t]he more difficult question . . . [was] whether Congress can use its Commerce Clause power to avoid the limitations that might prevent it from passing the same legislation under the Copyright Clause.”⁹⁷ It analyzed cases indicating that the Commerce Clause could be “used . . . to accomplish something that the Copyright Clause might not allow,”⁹⁸ plus it noted strong arguments from other cases to the effect that clause’s limitations “can be said to represent the Framers’ judgment that Congress should be affirmatively prohibited from passing certain types of legislation, no matter under which provision.”⁹⁹

Resolving this tension, we take as a given that there are some circumstances . . . in which the Commerce Clause cannot be used by Congress to eradicate a limitation placed upon Congress in another grant of power. For the reasons that follow, we hold that the instant case is not one such circumstance. We hold that the Copyright Clause does not envision that Congress is positively forbidden from extending copyright-like protection under other constitutional clauses, such as the Commerce Clause, to works of authorship that may not meet the fixation requirement inherent in the term “Writings.”¹⁰⁰

The court then explained why extending copyright-like protection to live performances was not fundamentally inconsistent with the fixation requirement.¹⁰¹

United States v. Martignon, in contrast to *Moghadam*, is a post-*Eldred* decision holding the anti-bootlegging statute was

⁹⁵ *Id.* at 1275 n.10.

⁹⁶ *Id.* at 1275–76.

⁹⁷ *Id.* at 1277.

⁹⁸ *Id.* at 1279.

⁹⁹ *Id.*

¹⁰⁰ *Id.* at 1280.

¹⁰¹ *Id.* at 1281. It did not, however, decide whether the statute was inconsistent with the “limited times” requirement. *Id.* at 1281 n.15. The court said, in closing, that it was not deciding whether the Commerce Clause can provide the source of Congressional power to support the anti-bootlegging statute in some other case in which the “limited times” argument is preserved. *Id.* It also pointed out that *Moghadam* did not make the limited times argument in the district court or on appeal. *Id.*

unconstitutional in violation of the Copyright Clause.¹⁰² Martignon operated a record business with a website and an online store. After an investigation by the Recording Industry Association of America and law enforcement agencies, he was arrested and later indicted for selling unauthorized recordings of live performances.¹⁰³ He moved to dismiss the indictment on the ground that the statute was unconstitutional because it did not set a time limit on a performer's right to bar bootlegging in violation of the "limited times" restriction, and it protected unfixed live performances in violation of the "writings" requirement.¹⁰⁴ The trial court dismissed the indictment, agreeing that the statute violated the Copyright Clause. The court also ruled, contrary to *Moghadam*, that Congress could not avoid those limitations by enacting the statute under its Commerce Clause authority.¹⁰⁵

The court emphasized that *Moghadam* was a narrow holding, pointed out that the Eleventh Circuit assumed, but did not decide, that Congress could not have enacted the statute under its Copyright Clause powers, and explained that it had turned to the Commerce Clause to uphold the legislation. The court also noted that the defendant in *Moghadam* had not challenged the statute under the "limited times" restriction and that the Eleventh Circuit had indicated it might have reached a different conclusion had the defendant raised that argument.¹⁰⁶ Unlike the Eleventh Circuit, the *Martignon* court rejected the government's argument that the anti-bootlegging statute could be upheld by turning to the Commerce Clause. According to Judge Baer, the history of the TRIPS Agreement as well as the legislative history and the plain text of section 2319A showed that it was intended to be a copyright statute, not a statute designed to regulate commerce.¹⁰⁷ Moreover, the anti-bootlegging provisions were codified within the Code's copyright

¹⁰² *United States v. Martignon*, 346 F. Supp. 2d 413, 417 (S.D.N.Y. 2004). *Martignon* was decided before *KISS Catalog*. See Danitz, *supra* note 11, at 1173–76; Giuliano, *supra* note 81, at 374–75; Howe, *supra* note 87, at 839–43; Shue, *supra* note 87, at 142. The Second Circuit vacated and remanded *Martignon* just before this Article went to press. The Second Circuit held that Congress could enact the anti-bootlegging statute under the Commerce Clause. *United States v. Martignon*, 492 F.3d 140, 152–53 (2nd Cir. 2007).

¹⁰³ *Martignon*, 346 F. Supp. 2d at 417. Jean Martignon operated Midnight Records in Manhattan, and marketed recordings through mail order and a website. He was charged with violating 18 U.S.C. § 2319A for selling bootleg recordings. *Id.*

¹⁰⁴ *Id.* at 416–17. He also argued that the statute violated the First Amendment and basic principles of federalism. *Id.* at 417.

¹⁰⁵ *Id.* at 417.

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* at 420–22.

provisions,¹⁰⁸ and the statute's impact on commerce was not determinative because "it is clear that it was enacted primarily to cloak artists with copyright-like protection."¹⁰⁹

The court explained that the anti-bootlegging statute ran "doubly afoul" of the Copyright Clause by providing "seemingly *perpetual protection* for *unfixed* musical performances."¹¹⁰ The government conceded that live musical performances are not writings, and the court said that although the category of protected "writings" ha[d] expanded over time, it has never moved into the realm of unfixed works."¹¹¹ By regulating unfixed live performances the statute was not within Congress' power under the Copyright Clause.¹¹² As for the "limited times" restriction, the court said it was clear that Congress could not grant a perpetual copyright,¹¹³ and it was undeniable that the anti-bootlegging statute ran afoul of this restriction by seeming to grant perpetual protection to live musical performances.¹¹⁴

The court then addressed the issue of whether Congress could evade the limitations in the Copyright Clause by enacting the anti-bootlegging statute pursuant to powers granted by other clauses, such as the Commerce Clause.¹¹⁵ It analyzed the same cases the Eleventh Circuit discussed in *Moghadam* and concluded "that the fixation and durational limitations inherent in the Copyright Clause restrict Congress' power to legislate in the quasi-copyright field 'to promote the Progress of Science and the useful Arts' . . . under a separate enumerated power."¹¹⁶ It also held, in the alternative, that "even if Congress may enact copyright-like legislation under" other grants of power, that legislation could not be, like the anti-bootlegging statute, "fundamentally inconsistent' with the fixation and durational limitations imposed by the Copyright Clause."¹¹⁷ *Eldred* was cited simply for the proposition that the Copyright

¹⁰⁸ United States v. Martignon, 346 F. Supp. 2d 413, 421 (S.D.N.Y. 2004).

¹⁰⁹ *Id.* at 422.

¹¹⁰ *Id.* at 423.

¹¹¹ *Id.*

¹¹² *Id.* at 423–24. The court explained in a footnote that "[w]hile it is arguable that . . . Congress intended to alter the concept of 'writings' to include unfixed live performances that are capable of fixation, there is no indication in the legislative history to suggest that Congress intended to make such a radical change." *Id.* at 424 n.13.

¹¹³ *Id.* at 424 (citing *Eldred v. Ashcroft*, 537 U.S. 186, 210 (2003)).

¹¹⁴ *Id.* at 424.

¹¹⁵ *Id.* at 424–25.

¹¹⁶ *Id.* at 428.

¹¹⁷ *Id.* See generally Giuliano, *supra* note 81, at 375–78 (criticizing the *Martignon* decision).

Clause is both a grant of power and a limitation¹¹⁸ instead of as justification for deference to Congress' law making power. The district court in *Martignon* did not defer to Congress.

KISS Catalog Ltd. v. Passport International Productions followed *Moghadam* instead of *Martignon*.¹¹⁹ *KISS Catalog* is complicated by the fact that the district court vacated an earlier ruling by a different judge holding that the civil provisions in the anti-bootlegging statute were unconstitutional under the Copyright Clause.¹²⁰ *KISS Catalog* owns rights related to the iconic rock band KISS that has been performing and recording music since the 1970s. It alleged that Passport was distributing a bootleg DVD titled "KISS: The Lost Concert." This DVD was a copy of a recording of a live concert KISS gave in 1976. The complaint included an anti-bootlegging claim as well as a standard copyright infringement count and related trademark and state law claims.¹²¹ Even though the act's civil provisions were included in Title 17 and utilized remedies for copyright infringement, the court concluded it was unlikely that Congress derived authority to enact this law from

¹¹⁸ *Martignon*, 346 F. Supp. 2d at 422–23. The Second Circuit eventually vacated and remanded *Martignon*, holding that Congress could enact the anti-bootlegging statute under its Commerce Clause authority. 492 F.2d 140, 152–53 (2nd Cir. 2007).

¹¹⁹ *KISS Catalog, Ltd. v. Passport Int'l Prods., Inc.*, 405 F. Supp. 2d 1169, 1173 (C.D. Cal. 2005).

¹²⁰ *Id.* at 1170; see also *Anti-Bootlegging Statute is Constitutional, Properly Enacted Under Commerce Clause*, 71 PAT., TRADEMARK & COPYRIGHT J. (BNA) No. 1753, at 263, 263–64 (Jan. 20, 2006) (discussing the ruling by Judge Dale Fischer, dated December 21, 2005, that vacated *KISS Catalog, Ltd. v. Passport Int'l Prods.*, 350 F. Supp. 2d 823 (C.D. Cal. 2004)); Lionel Sobel, *Federal Anti-Bootlegging Statute is Constitutional*, ENT. L. REPTR., May, 2006, at 6, 6–7 [hereinafter Sobel, *Federal Anti-Bootlegging Statute is Constitutional*]. The first ruling by the late Judge William Rea, from December, 2004, held that the anti-bootlegging statute violated the "limited times" and "writings" requirements in the Copyright Clause and that it could not be upheld under the Commerce Clause. *Id.* at 6. He granted a motion to intervene filed by the United States and then, after his death, the case was transferred to Judge Dale Fischer who took up the government's motion to reconsider Judge's Rea's earlier decision on the statute's constitutionality. *Id.*; see also *KISS Catalog, Ltd., v. Passport Int'l Prods., Inc.*, 405 F. Supp. 2d 1169, 1170 (C.D. Cal. 2005); *KISS Catalog v. Passport Int'l Prods.*, 350 F. Supp. 2d, 823, 836 (C.D. Cal. 2004); Howe, *supra* note 87, at 843–44. In discussing this anti-bootlegging claim the late Judge Rea held that the statute applied to the defendant's unauthorized distribution of a DVD even though the original bootleg recording reproduced on the DVD was made in 1976, well before the passage of the statute in 1994. He noted that the statute was not limited to prohibiting the unauthorized distribution of bootlegged recordings made after 1994. It is important to note that the plaintiff's copyright infringement claim was not dismissed by Judge Rea. *KISS Catalog v. Passport Int'l Prods.*, 350 F. Supp. 2d 823, 827, 844 (C.D. Cal. 2004); Nimmer, *supra* note 25, at 1399 (writing in 1995 that the statute's language was broad enough to encompass retroactive protection).

¹²¹ *KISS Catalog, Ltd. v. Passport Int'l Prods., Inc.*, 350 F. Supp. 2d 823, 824 (C.D. Cal. 2004).

the Copyright Clause because of the “writings” requirement.¹²² It found that legislative intent was not controlling, however, so it looked elsewhere and, like the Eleventh Circuit in *Moghadam*, it found support for the law within Congress’ power under the Commerce Clause.¹²³

Addressing the issue of whether Congress can enact legislation under one constitutional power that is inconsistent with limitations imposed by another power, the court disagreed with *Martignon* and said “each of the powers of Congress is alternative to all of the other powers, and what cannot be done under one of them may very well be doable under another.”¹²⁴

We hold that the Copyright Clause does not envision that Congress is positively forbidden from extending copyright-like protection under other constitutional clauses, such as the Commerce Clause, to works of authorship that may not meet the fixation requirement inherent in the term ‘Writings.’ The grant itself is stated in positive terms, and does not imply any negative pregnant that suggests that the term ‘Writings’ operates as a ceiling on Congress’ ability to legislate pursuant to other grants. Extending quasi-copyright protection to unfixed live musical performances is in no way inconsistent with the Copyright Clause, even if that Clause itself does not directly authorize such protection.¹²⁵

The court also pointed out that it was important to give sufficient deference to the fundamental premise that legislation is presumed constitutional.¹²⁶ Since the statute did not fall within the purview of the Copyright Clause, it was not necessary to consider whether the statute complied with the clause’s limits¹²⁷ and it concluded that “[o]ne does not have to stretch the presumption of constitutionality to conclude that legislation that prevents dissemination in perpetuity of an *unauthorized* videotape . . . of a *live performance* does not conflict with a clause that protects ‘for limited [t]imes,’ the

¹²² *KISS Catalog, Ltd. v. Passport Int’l Prods.*, 405 F. Supp. 2d 1169, 1172–73 (C.D. Cal. 2005).

¹²³ *Id.* at 1173. The court stated it was unnecessary to consider whether the statute could be authorized under the Necessary and Proper Clause. *Id.* at n.9.

¹²⁴ *Id.* at 1173.

¹²⁵ *Id.* at 1175.

¹²⁶ *Id.* (citing *United States v. Morrison*, 529 U.S. 598, 607 (2000)).

¹²⁷ *KISS Catalog, Ltd. v. Passport Int’l Prods., Inc.*, 405 F. Supp. 2d 1169, 1172 n.7 (C.D. Cal. 2005). The argument that the anti-bootlegging statute incorporated the durational limits of the copyright statute, 17 U.S.C. § 302, was not addressed. *Id.*

voluntarily disseminated 'Writings' of authors."¹²⁸

Courts are divided on the constitutionality of the anti-bootlegging statute, but there is agreement that bootlegging is a serious problem¹²⁹ and that the anti-bootlegging legislation was poorly drafted.¹³⁰ Congress can try again. It will be simple to impose a term limitation so that the statute, whether enacted under the Commerce Clause or the Copyright Clause, will not contravene the "limited times" restriction.¹³¹ The more difficult issue is whether the "writings" requirement is an insurmountable obstacle to the legislation. The courts do not see eye-to-eye on whether this statute can be based on Congress' authority under the Commerce Clause. There is a plausible argument for sustaining it under the Copyright Clause, however, especially given the Supreme Court's deference to congressional authority under that clause as well as the presumed constitutionality of legislation.¹³² In view of U.S. treaty obligations and the losses sustained as a result of bootlegging, there should be no difficulty finding a rational basis for the statute.¹³³

It has been clear since the passage of the first copyright statute in 1790 that "writings" encompasses much more than literary works. The term has not been construed in a "narrow literal sense" but "with the reach necessary to reflect the broad scope of constitutional principles."¹³⁴ "Writings," however, has always been construed to require something "fixed in a tangible medium of expression."¹³⁵ A live performance of a song or a play or an improvised comedy routine is intangible and does not endure. "[N]o respectable interpretation of the word 'Writings' embraces an untaped performance of someone singing at Carnegie Hall."¹³⁶

¹²⁸ *Id.* at 1176.

¹²⁹ Deas, *supra* note 81, at 578–82; Giuliano, *supra* note 81, at 373 (noting that bootlegging accounted for "\$300 million in lost and displaced revenue").

¹³⁰ Nimmer, *supra* note 25, at 1400 (stating that the law was an example of "very sloppy drafting").

¹³¹ It could be argued that the statute, as drafted, incorporates the durational limits in section 302 of the Copyright Act. *But see* Howe, *supra* note 87, at 851; Shue, *supra* note 87, at 153–54 (discussing options for Congress).

¹³² *United States v. Morrison*, 529 U.S. 598, 607–09 (2000). *But see Federal Anti-Bootlegging Statute is Constitutional*, *supra* note 120 at 6 ("[I]t is clear that Congress did not have the power to enact [this legislation] under the Copyright Clause of the Constitution.").

¹³³ *See* sources cited *supra* notes 80 and 81.

¹³⁴ *Goldstein v. California*, 412 U.S. 546, 561 (1973).

¹³⁵ 17 U.S.C. § 102(a) (2005); JOYCE ET AL., *supra* note 5, at 67.

¹³⁶ Nimmer, *supra* note 25, at 1409. A person who is injured by the unauthorized recording of his or live performance might have a remedy under common law copyright but precedents are sparse. *See, e.g., Falwell v. Penthouse Int'l, Ltd.*, 521 F. Supp. 1204, 1207–08 (W.D. Va. 1981); *Estate of Hemingway v. Random House, Inc.*, 244 N.E.2d 250 (N.Y. 1968);

The bootlegged recording of a live performance is, however, a fixed work. The fixation is not made under the authority of the performer, but there is a fixation. It can be argued that the “writings” requirement would not prevent Congress from enacting a statute under its Copyright Clause authority that provides performers with rights against the distribution of unauthorized recordings (fixed works) of their live performances. This possibility was raised in the first ruling in *KISS Catalog v. Passport International Products*,¹³⁷ but was abandoned in subsequent proceedings.¹³⁸ The court distinguished *Martignon* by noting that the *KISS Catalog* plaintiff was seeking to stop the distribution of an existing unauthorized recording and that this recording might satisfy the writings requirement.¹³⁹ After all, the Supreme Court stated in *Goldstein* case that “writings” in the Constitution encompassed “any physical rendering of the fruits of creative intellectual or aesthetic labor.”¹⁴⁰ In addition, the Eleventh Circuit noted in *Moghadam* that “although a live musical performance may not have been fixed, or reduced to tangible form, as of the time the bootleg copy was made, it certainly was subject to having been thus

LEAFFER, *supra* note 74, at 56–57; see also Ashley T. Barnett, Note, “Profiting at My Expense”: An Analysis of the Commercialization of Professors’ Lecture Notes, 9 J. INTELL. PROP. L. 137, 153–55 (2001). CAL. CIV. CODE § 980(a)(1) (2007) extends protection to original works of authorship that are not fixed.

¹³⁷ *KISS Catalog, Ltd. v. Passport Int’l Prods.*, 350 F. Supp. 2d 823 (C.D. Cal. 2004).

¹³⁸ *KISS Catalog, Ltd. v. Passport Int’l Prods.*, 405 F. Supp. 2d 1169 (C.D. Cal. 2005); see also *United States v. Martignon*, 346 F. Supp. 2d 413, 424–29 (S.D.N.Y. 2004). The court initially held that the unauthorized distribution provision in the anti-bootlegging statute, 17 U.S.C. § 1101(a)(3), was unconstitutional because it violated the Copyright Clause’s “limited times” restriction so it dismissed the plaintiff’s anti-bootlegging claim. *KISS Catalog*, 350 F. Supp. 2d at 837. In discussing this claim the court held that the statute applied to the defendant’s unauthorized distribution of the DVD even though the original bootleg recording was made in 1976, well before the passage of the statute in 1994. *Id.* at 828–29. The court noted that the statute was not limited to prohibiting the unauthorized distribution of bootlegged recordings made after 1994. *Id.* This, however, was the only argument related to the anti-bootlegging claim that went the plaintiff’s way. The plaintiff’s copyright infringement claim was not dismissed. *Id.* at 827.

¹³⁹ *KISS Catalog*, 350 F. Supp. 2d at 832. Still, the court declined to reach a conclusion on whether section 1101(a)(3) passed constitutional muster because the statute had other unconstitutional defects. *Id.* As for the statute’s violation of “limited times,” the court declined to read the anti-bootlegging statute as incorporating the copyright term limits in 17 U.S.C. § 302 in order to save it. *Id.* at 832–33. The court said that it had no business “legislating” an amendment to the statute. *Id.* at 833. Accordingly, the statute created perpetual copyright-like protection in violation of the Copyright Clause, and this court also concluded, like the *Martignon* court, that Congress could not use its powers under the Commerce Clause to enact this perpetual legislation and thereby effectively repeal a provision of the Constitution. *Id.* at 836–37. The court said that there was no reason to find two constitutional defects where only one was necessary. *Id.* at 832 n.5.

¹⁴⁰ *Goldstein v. California*, 412 U.S. 546, 561 (1973).

fixed.”¹⁴¹ The court also said, in explaining why extending copyright-like protection to live performances under the Commerce Clause was not fundamentally inconsistent with the “writings” requirement, that the Copyright Act of 1976 extended copyright protection to live radio and television broadcasts if a recording (a fixation) was made under the authority of the author simultaneously with the broadcast.¹⁴² A person who makes an unauthorized recording of that live broadcast is an infringer even though he copies the live broadcast and not the authorized recording of the broadcast.¹⁴³ If “writings” encompasses live broadcasts which are simultaneously recorded under the authority of the person responsible for the broadcast,¹⁴⁴ then the protection of live performances against bootlegging appears to be an acceptable incremental change under the Copyright Clause.¹⁴⁵ The rational basis to support this legislation comes from the recognized needs to protect the creative efforts of performers, to stop the distribution of bootleg recordings, and to harmonize United States law with international standards while implementing aspects of the TRIPS Agreement.¹⁴⁶ Given the presumption that legislation is constitutional, plus the Supreme Court’s great deference to Congress’ authority under the Copyright Clause to set intellectual property policy and the rational justifications for the legislation, the anti-bootlegging statute might pass muster under the Copyright Clause.¹⁴⁷

Notwithstanding these arguments, the anti-bootlegging legislation should not be upheld as a legitimate exercise of congressional authority under the Copyright Clause. It is well established that a live television broadcast and a live performance of a play or musical composition is not a writing capable of copyright

¹⁴¹ *United States v. Moghadam*, 175 F.3d 1269, 1280 (11th Cir. 1999).

¹⁴² *Id.* at 1280–81 (citing and discussing the definition of fixation at 17 U.S.C. § 101).

¹⁴³ *Id.* at 1280.

¹⁴⁴ “A work consisting of sounds, images, or both, that are being transmitted, is ‘fixed’ for purposes of this title if a fixation of the work is being made simultaneously with its transmission.” 17 U.S.C. § 101 (2005) (defining a “fixed” work); see also 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* 1–114–16; *Moghadam*, 175 F.3d. at 1281; Danitz, *supra* note 11, at 1190–92.

¹⁴⁵ *Moghadam*, 175 F.3d. at 1281; see also Danitz, *supra* note 11, at 1192.

¹⁴⁶ See *supra* notes 77–83 and accompanying text.

¹⁴⁷ See, e.g., *Eldred v. Ashcroft*, 537 U.S. 186, 212–13 (2003); *United States v. Morrison*, 529 U.S. 598, 607 (2000). But see *Federal Anti-Bootlegging Statute is Constitutional*, *supra* note 116, at 6 (“It is clear that Congress [does] not have the power to enact [this] statute under the Copyright Clause . . .”).

protection.¹⁴⁸ Authors and broadcasters usually enjoy ample copyright protection for the works they are broadcasting or performing because they are working from scripts or musical compositions that are fixed writings. Copyright attaches to those tangible writings—not the actual performance or the actual broadcast of a live event. They hold the right to control performances of those works.¹⁴⁹ The copyright owner of the fixed work being performed also has a copyright infringement action against the person who records the live performance of that play or musical composition.¹⁵⁰ The anti-bootlegging statute, however, seeks to protect the actual live performance and it extends this right to the performer, not just to the composer or playwright whose work is being performed. The Copyright Clause empowers Congress to grant authors exclusive rights in their writings,¹⁵¹ yet the writing that triggers the anti-bootlegging statute’s remedies is not the intellectual creation of the performer the statute seeks to protect. Rather, it is the intellectual creation of the person who makes the unauthorized recording.¹⁵² Moreover, *Eldred* emphasized the history of the “unbroken congressional practice of granting to authors of works with existing copyrights the benefit of term extensions”¹⁵³ In contrast, Congress did not afford protection against bootlegging live performances until 1994. Unlike legislation extending the copyright term, history is not on the side of the performers seeking protection for their live performances under the anti-bootlegging statute.

In spite of the Supreme Court’s great deference to Congress’ judgment in setting copyright policy, the “writings” requirement

¹⁴⁸ NIMMER & NIMMER, *supra* note 144, at 1–112.

¹⁴⁹ *Id.* at 1–113.

¹⁵⁰ 1 PAUL GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE 83–84 (1989).

¹⁵¹ The creator of a work is the author and a copyright comes into existence when an author fixes his or her work in tangible form. LEAFFER, *supra* note 74, at 48.

¹⁵² U.S. CONST. art. I., § 8, cl. 8; NIMMER & NIMMER, *supra* note 144, at 1–110–11. The holder of the rights against the distribution of the unauthorized recording is the artist/performer who did the live performance that was recorded without his permission. The “writing” is the product of the infringer. The bootlegged recording is not a writing of the creator (the performer) the anti-bootlegging statute seeks to protect. *Id.* at 1–116 (“The requirement of tangible form appears to preclude federal copyright protection *per se* for the artistic performances of actors and musicians, although . . . visual and sound recordings of such performances are constitutionally capable of achieving such protection.”).

¹⁵³ *Eldred v. Ashcroft*, 537 U.S. 186, 188 (2003); *cf.* Samuelson, *Constitutional Law*, *supra* note 8, at 555; Spiro, *supra* note 21, at 1009–11 (under Professor Spiro’s theory of incremental constitutional change, the fact that Congress took no action to afford protection until 1994 works against the argument that the “writings” requirement is flexible enough to encompass the anti-bootlegging statute).

should remain an insurmountable barrier to the enactment of anti-bootlegging legislation pursuant to the Copyright Clause. Whether Congress could enact this legislation pursuant to its authority under the Commerce Clause or some other grant of power will turn on whether the Supreme Court will follow *Moghadam* and *KISS Catalog* instead of the district court's reasoning in *Martignon*, to the effect that the "limited times" and "writings" requirements restrict Congress' power to enact quasi-copyright laws that are fundamentally inconsistent with the Copyright Clause.¹⁵⁴ As noted earlier, whether or not the Copyright Clause restricts Congress' power under other grants of authority in the Constitution is much debated¹⁵⁵ and opining on that question is beyond the scope of this article.

B. Deference, the Elimination of Formalities, and Automatic Renewal

Prior to the passage of the Copyright Act of 1976, the United States required authors to comply with a number of "formalities" including publication with notice, registration, and deposit. These formalities were conditions to securing copyright protection. In addition, a work could enter the public domain at the end of its initial twenty-eight year term if the copyright owner failed to comply with another formality, renewal. These formalities set the nation's copyright law apart from much of the rest of the world, but many were eliminated in the 1976 Act.¹⁵⁶ It abolished the registration, deposit, and renewal requirements as prerequisites for obtaining or maintaining copyright protection for works created on or after January 1, 1978. Notice requirements also were relaxed to some degree, but prior to March 1, 1989, failure to affix copyright notice to a publicly distributed work could still inject it into the public domain. The Berne Convention Implementation Act was

¹⁵⁴ *United States v. Martignon*, 346 F. Supp. 2d 413, 428 (S.D.N.Y. 2004). *But see* *KISS Catalog, Ltd. v. Passport Int'l Prods., Inc.*, 405 F. Supp. 2d 1169, 1176 ("[T]he Statute complements, rather than violates, the Copyright Clause by addressing similar subject matter, not previously protected—or protectible—under the Copyright Clause."). The Second Circuit vacated *Martignon* on June 13, 2007. *United States v. Martignon*, 492 F.3d 140, 152–53 (2d Cir. 2007). If the anti-bootlegging statute is constitutional, then Congress could, perhaps, protect against the unauthorized fixation of live performances of literary and dramatic works as well as musical works. LEAFFER, *supra* note 74, at 54; *see also* The Patry Copyright Blog, *Martignon Reversed*, <http://williampatry.blogspot.com/2007/06/martignon-reversed.html> (last visited June 14, 2007).

¹⁵⁵ *See supra*, note 8.

¹⁵⁶ *See generally* JOYCE ET AL., *supra* note 5, at 22–27.

passed in 1988, and it eliminated the notice requirement and removed registration as a prerequisite for filing an infringement action based on the works of foreign authors.¹⁵⁷ Congress passed the Copyright Renewal Act in 1992 and this statute had the effect of automatically renewing copyright for all works published between January 1, 1964 and December 31, 1977. Many works published during that fourteen year period would have entered the public domain at the end of their initial twenty-eight year terms because their copyright owners might have failed to take the steps required to renew. This statute automatically extended the life of those works by an extra forty-seven years (the original renewal term of twenty-eight years plus the nineteen years added to the renewal term by the 1976 Act). All of the works published in this period were then given another twenty years of protection when CTEA was enacted in 1998.¹⁵⁸

The Copyright Renewal Act of 1992, the Berne Convention Implementation Act, CTEA, and the 1976 Act were challenged post *Eldred*, in *Kahle v. Ashcroft*. The plaintiffs were archivists who made public domain works available on the Internet. They wanted to copy and post works published between 1964 and 1978 that would have fallen into the public domain but for the renewal act, CTEA, the elimination of the registration and deposit requirements, and the relaxation of notice requirements.¹⁵⁹ Their basic argument was that these statutes had effectively denied the public access to, and the right to freely exploit, cultural and scientific works that are no longer commercially available that otherwise would have entered the public domain. Accordingly, they asserted that the several statutes were unconstitutional because they did not promote the progress of science and they violated the “limited times” restriction.¹⁶⁰ The statutory changes created what the plaintiffs

¹⁵⁷ See generally LEAFFER, *supra* note 74, at 145, 271 n.1.

¹⁵⁸ See generally Kenneth D. Crews, *Copyright Duration and the Progressive Degeneration of a Constitutional Doctrine*, 55 SYRACUSE L. REV. 189 (2005) [hereinafter *Copyright Duration*].

¹⁵⁹ *Kahle v. Ashcroft*, No. C-04-1127 MMC, 2004 WL 2663157 (N.D. Cal. Nov. 19, 2004), *aff'd*, *Kahle v. Gonzales*, 487 F.3d 697 (9th Cir. 2007). The plaintiffs filed a four count complaint. *Id.* at *1-*2; see also *Sonny Bono Copyright Term Extension Act, Copyright Renewal Act, and Berne Convention Implementation Act Are Not Unconstitutional*, ENT. L. REP., July 2005, at 12, 12-13.

¹⁶⁰ *Kahle*, 2004 WL 2663157 at *1. “According to plaintiffs, the consequence of requiring these affirmative steps to secure and retain copyright protection was that the overwhelming majority of published works either passed immediately into the public domain (because they were never registered or deposited or notice was not given), or passed into the public domain after the initial copyright term due to failure to renew the copyright for a second term.” *Id.* at

defined as an unconditional copyright regime that burdened the public's access to works published between 1964 and 1978¹⁶¹ because most are orphan works—works not commercially available for which there is no viable or reasonable way for persons like the plaintiffs to identify copyright owners.¹⁶² This unconditional copyright regime hindered the Internet's creative potential.¹⁶³ The plaintiffs also sought reconsideration of the Supreme Court's decision in *Eldred* and contended that the renewal act and CTEA also violated the First Amendment.¹⁶⁴

The plaintiffs' claims alleging violations of "limited times" were dismissed in large part because of *Eldred*. The court held that the automatic renewal statute and CTEA did not create a copyright term that was effectively perpetual and that Congress had not violated the Copyright Clause or the First Amendment by extending the term. Moreover, the court said it had no power to overturn *Eldred*.¹⁶⁵ The plaintiffs' argument that the statutory elimination of the registration, deposit, and notice requirements violated the Copyright Clause by not promoting the progress of science also was rejected. Here again, *Eldred's* deference to Congress to decide how best to pursue the objectives of the Copyright Clause was decisive.¹⁶⁶ Congress had a rational basis for eliminating renewal for works created after 1978, going with a single term of life of the author plus fifty years,¹⁶⁷ diminishing the importance of registration and deposit,¹⁶⁸ making changes in the notice requirement,¹⁶⁹ and passing the Berne Convention Implementation Act and the Copyright Renewal Act with its provision for automatic renewal.¹⁷⁰ It was not for the courts to second guess Congress about the best way to achieve the objectives of the Copyright Clause.¹⁷¹

*3.

¹⁶¹ The plaintiffs contended that works published in this period constituted "the first class of work in American history that has had its term extended without any requirement of renewal." *Id.* at *4.

¹⁶² *Id.* at *4.

¹⁶³ *Id.* at *5.

¹⁶⁴ *Id.* at *1. They sought declaratory relief and an injunction against enforcement of the No Electronic Theft Act. *Id.* at *2. See generally Matthew Dean Stratton, *Will Lessig Succeed in Challenging the CTEA Post-Eldred?*, 53 J. COPYRIGHT SOC'Y U.S.A. 481, 501–06 (2006).

¹⁶⁵ *Kahle v. Ashcroft*, No. C-04-1127 MMC, 2004 WL 2663157, at *8 (N.D. Cal. Nov. 19, 2004).

¹⁶⁶ *Id.* at *9.

¹⁶⁷ *Id.* at *11.

¹⁶⁸ *Id.* at *12.

¹⁶⁹ *Id.* at *13.

¹⁷⁰ *Id.* at *16.

¹⁷¹ *Id.* at *18 (N.D. Cal. Nov. 19, 2004). Relying on *Eldred*, the court also dismissed the

The result in *Kahle v. Ashcroft* is not surprising in view of the Supreme Court's strong statements in *Eldred* about deference to Congress and the ease of finding rational bases for the 1976 Act, the Berne Convention Implementation Act, the Copyright Renewal Act of 1992, and CTEA. Moreover, the plaintiffs challenged CTEA even though the Supreme Court had upheld the statute just a year earlier in *Eldred*, and they questioned the constitutionality of three other statutes enacted in 1976, 1988, and 1992 respectively, each of which had been applauded at the time of passage for improving United States copyright law.¹⁷²

Although the Supreme Court still speaks about advancing public welfare through copyright and states that the interests of the public are of primary concern while reward to the author is of secondary importance, it seems as if rewarding the author/copyright owner has become paramount.¹⁷³ Relying on *Eldred*, the *Kahle* opinion emphasized "that because 'the profit motive is the engine that ensures the progress of science,' rewarding authors for their labor and promoting Progress are complementary, and that 'copyright law serves public ends by providing individuals with an incentive to pursue private ones.'"¹⁷⁴

The *Kahle* court noted that all of Congress' justifications for the several additions and changes to the Copyright Act were intended to increase the financial reward to authors for their creative works and to bring United States copyright law into compliance with the Berne Convention.¹⁷⁵ Special emphasis was placed on rewarding personal efforts of authors.¹⁷⁶ There is real substance to the argument that the balance between the rights of authors/copyright owners and the rights of the public has shifted.¹⁷⁷

plaintiffs' claim that the Renewal Act and CTEA violated the First Amendment by imposing an unconstitutional burden on speech. *Id.* at *16. In affirming, the Ninth Circuit explained that *Eldred* disposed of the plaintiffs' arguments. 487 F.3d at 700–01. *See also* Stratton, *supra* note 164, at 506.

¹⁷² *See* Olliar, *supra* note 5, at 1832–33 (discussing *Kahle* and the court's discussion of the "progress" preamble and *Eldred*); *cf.* *Eldred v. Ashcroft*, 537 U.S. 186, 200 (2003) (emphasizing the unbroken congressional practice of granting term extensions).

¹⁷³ Okediji, *supra* note 20, at 1653–56.

¹⁷⁴ *Kahle*, 2004 WL 2663157, at *15.

¹⁷⁵ *Id.*

¹⁷⁶ *Id.* This language arguably resurrects the "sweat of the brow" rationale for copyright protection that was rejected by the Supreme Court. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 359–60 (1991).

¹⁷⁷ *See* Dallan, *supra* note 19, at 348–52 (questioning the diminished public interest rationale for copyright reflected in *Eldred*); Heald, *American Corporate Copyright*, *supra* note 61, at 489–90; Okediji, *supra* note 20, at 1649, 1653–55; Ledford, *supra* note 65, at 676–77.

C. Restored Copyrights, Deference and the Public Domain

Prior to 1989, when Congress dropped the last remaining “formalities,” works of authorship originating in other countries still needed to comply with notice, registration, and deposit requirements in order to enjoy full protection in the United States. In addition, the several acts eliminating formalities did not apply retroactively so both domestic and foreign works whose United States copyrights had lapsed because of failure to comply with formalities remained in the public domain.¹⁷⁸ Many foreign works with lapsed copyrights in the United States remained protected in their countries of origin where notice, registration, and deposit had never been conditions for copyright protection. In addition, some works remained protected in their home countries but not here because the United States did not have copyright relations with those countries of origin.¹⁷⁹ Article 18 of the Berne Convention encourages signatory countries to extend retroactive protection to works originating in other Berne countries, but representatives of the United States negotiating copyright issues with foreign countries prior to 1992 always rejected calls for copyright recapture or the restoration of protection for foreign works that had fallen into the public domain in the United States.¹⁸⁰

The rigidity of the United States position on restoration loosened during negotiations over NAFTA in 1992. As a result, NAFTA’s implementing legislation, which went into effect on January 1, 1994, added section 104A to the Copyright Act, providing for the restoration of copyrights for motion pictures first fixed or published in a NAFTA country which had entered the public domain in the United States between January 1, 1978 and March 1, 1989 because of failure to comply with the notice provisions in United States copyright law. This new section soon was substantially revised in section 514 of the Uruguay Round Agreement Act (URAA) of 1994. This Act implemented a 1994 WTO Agreement, including the TRIPS Agreement on intellectual property rights, and it also contained the anti-bootlegging statute discussed earlier in this article.¹⁸¹

The URAA’s provisions on restoration are complex and

¹⁷⁸ Crews, *Copyright Duration*, *supra* note 158, at 223–24.

¹⁷⁹ Nimmer, *supra* note 25, at 1401 (giving an example based on the absence of copyright relations with Egypt prior to 1989).

¹⁸⁰ JOYCE ET AL., *supra* note 5, at 363.

¹⁸¹ *Id.* at 363–64; *see also supra* Part II.A.

convoluted.¹⁸² In a nutshell, the URAA was enacted to bring the United States into compliance with its obligations as a member of the WTO.¹⁸³ It restores copyright protection in the United States to foreign copyright holders whose works remain protected in their country of origin but had entered the public domain in the United States due to reasons like failure to comply with our formalities,¹⁸⁴ the absence of prior subject matter protection in the United States, or a failure of the United States to recognize copyrights from the country of origin.¹⁸⁵

This legislation brought about a dramatic change in United States

¹⁸² JOYCE ET AL., *supra* note 5, at 364 (“The URAA provisions . . . make tough reading.”); Crews, *Copyright Duration*, *supra* note 158, at 225 n.188 (stating that the restoration “statute is actually vastly more complicated than this summary could ever address”); Nimmer, *supra* note 25, at 1401 (noting that section 104(a) might be the longest section in the Copyright Act); Adam P. Segal, *Zombie Copyrights: Copyright Restoration Under the New § 104A of the Copyright Act*, 13 SANTA CLARA COMPUTER & HIGH TECH. L.J. 71, 74–77 (1997). *See generally* William Gable, *Restoration of Copyrights: Dueling Trolls and Other Oddities Under Section 104A of the Copyright Act*, 29 COLUM. J.L. & ARTS 181 (2005) (providing a very thorough and detailed analysis of the statute, highlighting areas of concern, discussing the emerging case law, and offering an outline for making use of section 104A). The act’s complexity might be due, in part, to uncertainties about what kinds of conduct did or did not place a work in public domain here or in a foreign country. *See Societe Civile Succession Richard Guino v. Beseder, Inc.*, 414 F. Supp. 2d 944, 946 (D. Ariz. 2006) (describing litigation over sculpture published in France between 1913 and 1917, in which a major issue was whether the works were still protected by copyright); *Dam Things From Denmark a/k/a Troll Co. ApS v. Russ Berrie & Co.*, 290 F.3d 548, 552 (3d Cir. 2002) (finding that section 104A grants Dam Things a restored copyright for at least one of its troll dolls that had been in the public domain since the early 1960s, but the lower court failed to consider whether the defendant’s troll dolls were derivative works based on the plaintiff’s troll doll); *Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162, 1165 (9th Cir. 1996) (describing one issue, which was whether the publication of *Bambi, A Life in the Woods* in Germany in 1923 without copyright notice placed *Bambi* in the public domain).

¹⁸³ Lionel Sobel, *D.C. and Colorado Federal Courts Express Different Views on Constitutionality of Statute That Restores Copyrights of Foreign Works That had Fallen into Public Domain in United States*, ENT. L. RPTR, June 2004, at 10, 11–12; *Restoration of Foreign Copyrights Under Uruguay Statute Not Unconstitutional*, BNA PAT. TRADEMARK COPYRIGHT J., June 25, 2004, at 197, 197–98.

¹⁸⁴ *See, e.g.*, *Alameda Films S.A. de C.V. v. Authors Rights Restoration Corp.*, 331 F.3d 472, 475 (5th Cir. 2003) (describing how Mexican production companies held to own restored copyrights in more than 80 Mexican movies made between the late 1930s and early 1950s that had fallen into the public domain in the U.S. due to failure to comply with formalities like renewal and registration. These production companies were successful in their infringement suit against U.S. distributors of the films, recovering over one million dollars in damages); CHOW & LEE, *supra* note 31, at 112 n.8. Compliance with section 104A is not simple—there are formalities and traps for the unwary. *See, e.g.*, *Fed. Treasury Enter. v. Spirits Int’l*, 425 F. Supp. 2d 458, 473 (S.D.N.Y. 2006) (describing an infringement claim against reliance parties that was dismissed because the plaintiff failed to provide notice of intent to enforce the restored copyright as required by the statute).

¹⁸⁵ Pub. L. No. 103-465, § 514, 108 Stat. 4809, 4976 (1994), codified at 17 U.S.C. § 104A (2000). *See generally* CHOW & LEE, *supra* note 31, at 111–12; JOYCE ET AL., *supra* note 5, at 363–66; LEAFFER, *supra* note 74, at 265–70; Lee, *supra* note 15, at 176–80.

copyright law by mandating greater protection for foreign works than domestic works, and by reviving copyright protection for works that were already in the public domain under United States law.¹⁸⁶ The URAA's restoration of copyrights has severe critics as well as supporters, and serious questions about the constitutionality of restoring copyright protection for works in the public domain were raised well before the United States signed NAFTA and the Uruguay Round Agreements.¹⁸⁷ After all, restoring copyright protection for a large body of works already in the public domain was claimed to be unprecedented,¹⁸⁸ plus the Supreme Court has stated emphatically that the Constitution forbids the grant of exclusive rights over works in the public domain.¹⁸⁹

The first constitutional challenge to the restoration statute to be heard and decided was *Luck's Music Library v. Ashcroft*.¹⁹⁰ Luck's Music restores old films and sells public domain music. The impact of the restoration statute on its business was substantial. It had a large catalog of orchestra sheet music that included 200 to 300 different works by 20th Century Russian composers including Prokofiev, Shostakovich, and Stravinsky.¹⁹¹ These works had been published in the former Soviet Union and were ineligible for copyright protection in the United States due to the Soviet Union's

¹⁸⁶ Crews, *Copyright Duration*, *supra* note 158, at 224; *see also* Crews, *Harmonization and the Goals of Copyright*, *supra* note 86, at 124–25 (speculating that the different treatment of works of foreign origin will result in pressure to extend restoration to domestic works); Peter A. Jaszi, *Goodbye to All That—A Reluctant (and Perhaps Premature) Adieu to a Constitutionally-Grounded Discourse of Public Interest in Copyright Law*, 29 VAND. J. TRANSNAT'L L. 595, 606 (1996); Lee, *supra* note 15, at 110–16; Nimmer, *supra* note 25, at 1403–04.

¹⁸⁷ JOYCE ET AL., *supra* note 5, at 365; Nimmer, *supra* note 25, at 1410–11.

¹⁸⁸ Crews, *Copyright Duration*, *supra* note 158, at 225 (noting that “[t]he movement of large bodies of expired copyrights back under legal protection is unique in American history.”); *see* United Christian Scientists v. Christian Sci. Bd. of Dirs, 829 F.2d 1152, 1165–66, 1169 (D.C. Cir. 1987) (describing how a private law that granted restored and extended copyright on the works of Mary Baker Eddy was held unconstitutional under the Establishment Clause with the court noting that this kind of copyright conferred by Congress was exceptional, and that grants of copyright by private bill were very rare). *But see* Luck's Music Library, Inc. v. Gonzales, 407 F.3d 1262, 1265–66 (D.C. Cir. 2005) (explaining how copyright protection often had been restored by Congress since the enactment of the first copyright statute in 1790); Golan v. Gonzales, No. Civ. 01-B-1854 (BNB), 2005 WL 914754 (D. Colo. Apr. 20, 2005) (discussing extensively Congress' actions since 1790 to remove copyrightable works from the public domain); Okediji, *supra* note 20, at 1643 nn.50 & 52.

¹⁸⁹ Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 34 (2003); Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 146 (1989); Graham v. John Deere Co. of Kan. City, 383 U.S. 1, 6 (1966); Samuelson, *Constitutional Law*, *supra* note 8, at 563.

¹⁹⁰ Luck's Music Library, Inc. v. Ashcroft, 321 F. Supp. 2d 107, 109–10 (D. D.C. 2004), *aff'd sub nom.* Luck's Music Library, Inc. v. Gonzales, 407 F.3d 1262 (D.C. Cir. 2005).

¹⁹¹ *Id.* at 110.

refusal to provide reciprocal rights. After the copyrights to these public domain works were restored, Luck's received several notices of intent to enforce the restored copyrights and a demand that it cease and desist from selling works by those Soviet-era Russian composers.¹⁹² Luck's Music and a second plaintiff, Moviecraft, sought declaratory and injunctive relief, charging that the restoration statute was unconstitutional because the Copyright Clause requires that the public enjoy an unfettered right to copy works once they are in the public domain and that restoration violates this mandate by removing works from the public domain. They also argued that the statute did not promote the progress of science because it granted retroactive copyright protection to works that were not original. Accordingly, the statute contravened the Copyright Clause.¹⁹³

The trial court disagreed with the plaintiffs' arguments and granted the government's motion to dismiss. It held that section 514 did not violate the Copyright Clause and that it did not need to consider whether Congress could have turned to other provisions of the Constitution to support the legislation. The court cited *Graham*¹⁹⁴ for the principle that the Constitution grants Congress the power to set policy to carry out the purposes of the Copyright Clause so it was appropriate to defer to the legislative branch and not second guess congressional policy judgments.¹⁹⁵

The court said that Congress had repeatedly granted retroactive copyrights to remove works from the public domain since the passage of the first copyright act in 1790,¹⁹⁶ that Congress has

¹⁹² *Id.* at 110. Roughly ten percent of Luck's total inventory consisted of works ineligible for copyright due to the refusal of the country of origin to provide reciprocal protection. *Id.* The other plaintiff, Moviecraft, preserves old films. *Id.* Its library includes "thousands of foreign films in the public domain [in the U.S.] due to lack of copyright notices." *Id.* at 111. Its plan to release for sale on home video a 1963 foreign movie in the public domain titled *The Sicilian* was dropped after it received notice of intent to enforce the restored copyright. *Id.*

¹⁹³ *Id.* at 108–10, 112.

¹⁹⁴ *Id.* at 112 (citing *Graham*, 383 U.S. at 6).

¹⁹⁵ *Id.* (citing *Eldred v. Ashcroft*, 537 U.S. 186, 212 (2003)). The courts are not to strike down legislation "so long as the means adopted by Congress for achieving a constitutional end are 'appropriate' and 'plainly adapted' to achieving that end." *Id.* (quoting *Schnapper v. Foley*, 667 F.2d 102, 112 (D.C. Cir. 1981)).

¹⁹⁶ *Luck's Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107, 113–14 (D. D.C. 2004), *aff'd sub nom.* *Luck's Music Library, Inc. v. Gonzales*, 407 F.3d 1262 (D.C. Cir. 2005). The unbroken practice of granting retroactive copyrights and removing works from the public domain seriously impedes the argument that section 514 violates an implicit public domain within the Copyright Clause. In addition, the court agreed with the government that the enactment of the first copyright statute in 1790 had the effect of creating retroactive copyright protection for works published in three of the original thirteen states. *Id.* at 114.

authorized the President to restore lapsed foreign copyrights during wartime,¹⁹⁷ that the plaintiffs' reliance on *Graham* was misplaced because that holding applied only to patent law,¹⁹⁸ and that Congress had a rational basis for believing that the restoration statute furthered the goals of the Copyright Clause.¹⁹⁹ The court relied on *Eldred* in rejecting the plaintiffs' argument that restored works were not original and could not be protected because they already were in the public domain. In sum, the Copyright Clause did not bar Congress from removing these works from the public domain.²⁰⁰

The Court of Appeals for the D.C. Circuit affirmed in *Luck's Music Library v. Gonzales*, agreeing that the restoration provision did not overstep Congress' power under the Copyright Clause.²⁰¹ The appellate court relied heavily on *Eldred* in concluding that the clause does not create "any categorical ban on Congress's removing works from the public domain."²⁰² The plaintiffs argued that a statute removing works from the public domain did not pass constitutional muster because it failed to create an incentive for the creation of new works. The D.C. Circuit countered this by saying that "[t]his of course was the core argument advanced against the Copyright Term Extension Act in *Eldred*"²⁰³ All variations of that argument lost in *Eldred*, and they did not fare any better in regard to restoration.²⁰⁴ The majority in *Eldred* understood that term extension would help the United States in negotiating with the EU to help American authors, and the Court of Appeals pointed out that in a similar way restoration would benefit owners of U.S.

¹⁹⁷ *Id.* at 114–16.

¹⁹⁸ *Id.* at 116–17.

¹⁹⁹ *Id.* at 117. Following *Eldred*, the court determined that Section 514 bears a rational relation to the progress of science given Congress' rationale of securing protection copyrights in foreign countries for U.S. citizens and to reduce the impact of piracy. *Id.*

²⁰⁰ *Id.* at 119. The court also relied on *Eldred* in rejecting the argument that restoration violated the First Amendment because it restricted the free expression of works in the public domain. *Id.* at 118; see also *Restoration of Foreign Copyrights Under Uruguay Statute Not Unconstitutional*, *supra* note 183, at 197–98.

²⁰¹ *Luck's Music Library, Inc. v. Gonzales*, 407 F.3d 1262, 1263 (D.C. Cir. 2005).

²⁰² *Id.*

²⁰³ *Id.*

²⁰⁴ As with term extension, the court explained that "the knowledge that Congress may pass laws like the URAA in the future does affect the returns from investing time and effort in producing works [T]he extra incentive . . . is meager. But [under] *Eldred* . . . it . . . need not be great." *Id.* at 1264; see also Oliar, *supra* note 5, at 1833–34 (criticizing *Luck's Music* for failing to consider the "progress" preamble as an independent enforceable limitation on Congress' power).

intellectual property.²⁰⁵ The court also rejected the plaintiffs' call for a bright-line rule against laws that remove works from the public domain, noting that *Eldred* rejected a bright-line rule against term extension.²⁰⁶ It said that the plaintiffs had failed to offer any material distinction between their case and *Eldred*, and like the lower court, it disagreed with the plaintiffs' contentions regarding the historical record of Congress enacting legislation having the effect of removing works from the public domain.²⁰⁷ The appellate court also agreed with the lower court that dictum from *Graham* did not help plaintiffs, given *Eldred's* interpretation of that decision as well as a Supreme Court ruling from 1843 that upheld patent protection for an invention that had lapsed into the public domain.²⁰⁸

Similarly, in *Golan v. Gonzales* the United States District Court for the District of Colorado granted a summary judgment for the government and held that Congress had not exceeded its authority under the Copyright Clause in enacting section 514 of the URAA.²⁰⁹ As in *Luck's Music*, the *Golan* court deferred to Congress, relied heavily on *Eldred*, noted that statutes are presumed to be constitutional, distinguished patent cases, thoroughly analyzed the several laws enacted by Congress that had restored copyright protection for works in the public domain starting with the first copyright statute in 1790, and found a rational basis underlying section 514.²¹⁰

²⁰⁵ *Luck's Music Library*, 407 F.3d at 1264.

²⁰⁶ *Id.* at 1265.

²⁰⁷ *Id.* at 1265–66.

²⁰⁸ *Id.* at 1266 (citing and quoting from *Eldred v. Ashcroft*, 537 U.S. 186, 216–17 (2003), and the Supreme Court's analysis of *McClurg v. Kingsland*, 42 U.S. (1 How.) 202, 203 (1843)). See generally *Congress Had Authority to Restore Copyright Protection to Foreign Works in U.S.*, *Federal Courts Rule in Two Separate but Similar Cases*, ENT. L. RPTR., Oct. 2005, at 10, 10–11.

²⁰⁹ *Golan v. Gonzalez*, No. Civ. 01-B-1854 (BNB), 2005 WL 914754, at *1 (D. Colo. Apr. 20, 2005). The *Golan* court initially denied the government's motion to dismiss and noted the seriousness of the challenge to restoration under the Copyright Clause given the *Graham v. John Deere Co. of Kansas City* decision and the fact that prior legislative acts had specifically precluded extending copyright to works in the public domain. *Golan v. Ashcroft*, 310 F. Supp. 2d 1215, 1219–20 (D. Col. 2004), *rev'd sub nom. Golan v. Gonzalez*, 2005 WL 914754, at *1. The court did, however, dismiss the *Golan* plaintiffs' attack on CTEA, holding that the claim was foreclosed by *Eldred*. *Id.* at 1218; see also Stratton, *supra* note 164, at 914.

²¹⁰ The court also ruled that plaintiffs' first amendment rights had not been infringed, and that section 514's retroactive effect, if any, did not offend the Fifth Amendment. *Golan*, 2005 WL 914754, at *17. Just before this article went to press the Tenth Circuit affirmed as to the power of Congress under the Copyright Clause but remanded for the trial court to subject the URAA's restoration provisions to First Amendment review. *Golan v. Gonzalez*, No. 05-1259, 2007 WL 2547974 (10th Cir. Sept. 4, 2007). See also Oliar, *supra* note 5, at 1833–34 (criticism

The *Golan* court made several troubling statements about Congress' authority and the public domain. In response to the plaintiffs' contention that there is an absolute bar to restoring copyright to works in the public domain implicit in the Copyright Clause's commitment to the progress of science and useful arts, it stated "that the public domain is indeed public does not mandate that the threshold across which works pass into it cannot be traversed in both directions. That is a very different question. Indeed, neither the Supreme Court nor any Circuit Court has adopted the rule that the plaintiffs suggest."²¹¹

The court also discussed *Graham* and the differences between the patent and copyright monopolies. It stated that "[r]emoval of existent knowledge from the public domain is a persistent danger in the expansion of patent monopolies That danger, however, is not lurking within the retroactive expansion of copyrights; copyrights restrict the use of expressions but not of ideas themselves."²¹² The court concluded its discussion of the nation's patent and copyright legislation since 1790 with the following statement:

On the whole, Congress has historically demonstrated little compunction about removing copyrightable materials from the public domain. That practice, though no doubt in some cases working a hardship upon parties who have exploited public domain materials, does no violence to the principle that the IP Clause is designed to protect. The courts have agreed that the progress of science and the useful arts is impeded slightly, if at all, because ideas remain public property, even while expressions of those ideas are restored to their authors. In light of this unbroken string of authority, I find the dicta on which plaintiffs rely inapplicable to this case and conclude that Congress acted within its authority.²¹³

The courts deciding *Luck's Music* and *Golan* did not turn to the Commerce Clause or the Treaty Power to find support for the copyright restoration statute. Predictions that the restoration statute would face a more difficult time in the courts than term extension turned out to be wrong.²¹⁴ Following the Supreme Court's

of the *Golan v. Gonzalez* court for ignoring the "to promote progress" preamble).

²¹¹ *Golan*, 2005 WL 914754, at *3.

²¹² *Id.* at *5 (citations omitted).

²¹³ *Id.* at *14.

²¹⁴ See Heald & Sherry, *supra* note 8, at 1180; Okediji, *supra* note 20, at 1644-45;

lead in *Eldred*, these courts simply deferred to Congress' authority under the Copyright Clause and two centuries of experience tinkering with the copyright term.²¹⁵ After all, if Congress can extend the life of existing copyrights as it has repeatedly since 1790, including the several nineteen year extensions that were granted between 1962 and 1976 while the Copyright Act of 1976 was being drafted and revised,²¹⁶ and add twenty more years to the term of all existing copyrights by enacting CTEA in 1998, then why should Congress not be able to authorize the recapture of lapsed copyrights on works in the public domain due to formal defects like the lack of notice or the United States' refusal to recognize copyrights in the country of origin?²¹⁷ The *Luck's Music* and *Golan* courts both explained that Congress had been restoring copyright protection since 1790,²¹⁸ plus it was not difficult to find a rational basis for the legislation.²¹⁹

III. THE LIMITLESS COPYRIGHT CLAUSE

The decisions discussed in the previous section confirm Justice Stevens' dissenting opinion from *Eldred* that “[f]airly read, the Court has stated that Congress’ actions under the Copyright/Patent Clause are, for all intents and purposes, judicially unreviewable.”²²⁰ The Court may have “quitclaimed to Congress its principal

Samuelson, *Constitutional Law*, *supra* note 8, at 563.

²¹⁵ Cf. Samuelson, *Constitutional Law*, *supra* note 8, at 563–64; *Congress Had Authority to Restore Copyright Protection to Foreign Works in public domain in U.S., Federal Courts Rule in Two Separate but Similar Cases*, ENT. L. RPTR., Oct. 2005, at 10, 10–11 (discussing *Golan* and *Luck's Music*).

²¹⁶ JOYCE ET AL., *supra* note 5, at 337 n.1; NIMMER & NIMMER, *supra* note 144, at 9–4.

²¹⁷ Cf. Nimmer, *supra* note 25, at 1410–11 n.158 (arguing that Congress “may extend subsisting copyrights but may not, under the Copyright Clause alone, revive copyrights that were previously protected and entered the public domain for any reason”).

²¹⁸ *Luck's Music Library, Inc. v. Gonzales*, 407 F.3d 1262, 1265 (D.C. Cir. 2005); *Golan*, 2005 WL 914754, at *5–*6; cf. Dallon, *supra* note 19, at 354–57 (criticizing over-reliance on historical congressional practices to support constitutional interpretation); Spiro, *supra* note 21, at 1009–10 (advancing the argument that since Congress had passed restoration statutes several times without challenge, then the “limited times” requirement in the Copyright Clause should not be read to preclude the latest restoration statute).

²¹⁹ See *Golan*, 2005 WL 914754, at *15–*16. CHOW & LEE, *supra* note 31, at 110 (“If the [United States] can secure greater [intellectual property] protection around the world through an international agreement, [it should be able] to sacrifice part of the public domain in the United States, in order to strengthen worldwide [intellectual property] protection” for American authors and copyright owners.). “Many . . . have underestimated the path-dependency created by [prior] term extensions” and restorations. Okediji, *supra* note 20, at 1643.

²²⁰ *Eldred v. Ashcroft*, 537 U.S. 186, 242 (2003) (Stevens, J., dissenting).

responsibility in this area of the law.”²²¹ In upholding several statutes, these courts relied upon the Supreme Court’s great deference to Congress in setting copyright policy as well as the Court’s statements about the differences between the patent and copyright monopolies. These decisions follow the Court’s move away from its historic copyright jurisprudence that emphasized the public purposes embodied in the Copyright Clause over rewarding authors for their labors.²²² As a result, the limits on congressional power in the once-robust exclusive rights clause may be more theoretical than real.²²³

The clause’s explicit language regarding “authors” and “exclusive rights” in their “writings” should be interpreted to prevent Congress from enacting anti-bootlegging legislation under that particular grant of authority,²²⁴ but the meaning of “limited times” appears unsettled. Grants of perpetual rights are forbidden,²²⁵ but can Congress enact legislation that erases the line between the public and proprietary domains to allow the recapture of exclusive rights in works with expired or lapsed copyrights? Does “limited times” allow the public domain threshold to be traversed both ways,²²⁶ or does copyright protection have to be confined to a single, uninterrupted term?²²⁷ Is entry into the public domain permanent?²²⁸

Perhaps *Luck’s Music* or *Golan* will be overruled with the Supreme Court distinguishing the Uruguay Round restoration statute from prior restoration legislation and the 1790 copyright statute.²²⁹ Even if the *Luck’s Music* and *Golan* decisions are upheld,

²²¹ *Id.*

²²² See Heald, *American Corporate Copyright*, *supra* note 61, at 489–90; Okediji, *supra* note 20, at 1649, 1653–55; cf. Dallan, *supra* note 19, at 349–52 (questioning *Eldred’s* shift to a private interest based theory of copyright).

²²³ See Schaumann, *supra* note 20, at 1618. See generally Oliar, *supra* note 5 (asserting that the “to promote progress” language in the Copyright Clause was intended by the Framers to be a limitation on the power of Congress).

²²⁴ See *supra* notes 137–55 and accompanying text.

²²⁵ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003); *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 5–6 (1966).

²²⁶ *Golan v. Gonzales*, No. Civ. 01-B-1854 (BNB), 2005 WL 914754, at *3 (D. Colo. Apr. 20, 2005).

²²⁷ LEAFFER, *supra* note 74, at 265.

²²⁸ CHOW & LEE, *supra* note 31, at 112–13 n.10 (noting that it can be contended that the government has authority to “remove material from the public domain because the ‘public domain’ is simply what the government does not subject to intellectual property rights”); Lee, *supra* note 15, at 101 (the government argues that Congress can authorize the removal of works from the public domain); Zimmerman, *supra* note 74, at 299.

²²⁹ These arguments were not successful in either case. See *Luck’s Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107, 109–10 (D. D.C. 2004), *aff’d sub nom.* *Luck’s Music Library*,

perhaps they will have only a limited impact because section 514 of the URAA is a relatively narrow statute applying only to works of foreign origin still protected by copyright in their countries of origin that entered the public domain in the United States for technical or administrative reasons and otherwise would still have been protected by copyright.²³⁰ On the other hand, an expansive restoration statute applying to domestic works that entered the public domain simply because of the expiration of copyright protection might not stand up.²³¹

There are several reasons why a general restoration statute should not be upheld. Recapturing a work from the public domain is not the same as extending the life of an existing copyright, and the Supreme Court has made many statements about the importance of the public domain and that “the Constitution forbids grants of exclusive rights in that which is already in the public domain.”²³² The *Sears*, *Compco*, and *Bonito Boats* decisions made clear that the states cannot offer, revive, or restore copyright-like or patent-like protection for writings and inventions that are in the public domain. The Lanham Act must not be interpreted to afford protection to works that have entered the public domain because of the Supreme Court’s decisions in *Wal-Mart*, *TrafFix*, and *Dastar*. In *Dastar*, the Court explicitly acknowledged a “federal right to copy and to use expired copyrights,”²³³ and notwithstanding the *McClurg* decision from 1843, the Supreme Court’s decisions in *Singer Manufacturing v. June Manufacturing*, *Kellogg Co. v. National Biscuit Co.*, and *Graham* hold that Congress cannot revive or restore patent protection for an invention that is in the public domain.²³⁴ According to Justice Breyer, the Copyright Clause assumes that the initial grant of the copyright monopoly encourages

Inc. v. Gonzales, 407 F.3d 1262 (D.C. Cir. 2005); *Golan*, 2005 WL 914754.

²³⁰ Heald & Sherry, *supra* note 8, at 1180. Notwithstanding the limited nature of this statute, Professors Heald and Sherry argued that the restoration act is unconstitutional under the Copyright Clause. *Id.* at 1181. Their arguments have been undermined by *Luck’s Music* and *Golan*.

²³¹ *Id.* at 1180 n.427 (citing an article by David Nimmer that quotes testimony before Congress asserting that it would violate “limited times” to revive a work that was in the public domain because its term of protection had expired); Lee, *supra* note 15, at 176–79. *But see* Gable, *supra* note 182, at 188 (noting that Congress could be pressured to expand restoration of United States works, rather than treating them differently from works of foreign origin).

²³² Samuelson, *Constitutional Law*, *supra* note 8, at 563; *see also* Lee, *supra* note 15, at 113–16.

²³³ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003); Okediji, *supra* note 20, at 1645.

²³⁴ *See* Samuelson, *Constitutional Law*, *supra* note 8, at 563 n.75.

creations and that this monopoly then terminates in order to promote the dissemination of those already created works.²³⁵ It is the disappearance of the monopoly, not its perpetuation, that promotes the dissemination of works already in existence. Finally, although there is some history of Congress restoring copyright protection for works in the public domain, that history arguably is not as weighty as the “unbroken congressional practice of granting to authors of works with existing copyrights the benefit of term extensions” that played such a critical role in *Eldred*.²³⁶ In fact, the 1909 Act stated that “no copyright shall subsist in the original text of any work which is in the public domain.”²³⁷ This arguably strengthens challenges to copyright restoration legislation.²³⁸ In essence, the Copyright Clause should be read to prevent removing or burdening free access to materials already in the public domain.²³⁹

Nevertheless, given the *Eldred* decision, the Supreme Court’s deference to the power and judgment of Congress under the Copyright Clause, the perceived shift in its copyright jurisprudence, and the majority opinion’s statement that the Supreme Court’s past pronouncements about patents do not apply to copyright, the clause’s limitations are becoming less significant and this, in turn, puts the public domain at risk.²⁴⁰ When *Eldred*’s statements about deference and the differences between patents and copyrights are taken literally, the remarkable decisions in *Luck’s Music* and *Golan*, upholding the removal of knowledge from the public domain through copyright restoration, seem to rest on solid ground.²⁴¹ The Supreme Court might bless the restoration statute just like it blessed CTEA; by deferring to Congress’ judgment to set intellectual

²³⁵ *Eldred v. Ashcroft*, 537 U.S. 186, 260 (2003) (Breyer, J., dissenting).

²³⁶ *Id.* at 200 (majority opinion). The passage of legislation in 1790 and during World Wars I and II that had the effect of restoring copyright protection is not equivalent to the repeated actions by Congress since 1790 to extend the copyright term. The few restoration efforts have not incrementally altered the meaning of “limited times.” *Cf.* Spiro, *supra* note 21, at 1009–10 (offering a theory that, though analogous, would not apply in this context).

²³⁷ Copyright Act of 1909, ch. 320, § 7. The text of the 1909 Act can be found in LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT 67 (E. Fulton Brylawski & Abe Goldman, eds., 1976).

²³⁸ See Samuelson, *Constitutional Law*, *supra* note 8, at 563.

²³⁹ Benkler, *supra* note 38, at 177; Lee, *supra* note 15, at 116, 176–80.

²⁴⁰ Shipley, *supra* note 9, at 100–01. This seems to fly in the face of *Feist*. See Heald, *The Vices of Originality*, *supra* note 13, at 172–73 (discussing the impact of *Feist*); see also Schaumann, *supra* note 20, at 1618 (arguing that the limitations are theoretical).

²⁴¹ See Gable, *supra* note 182, at 188 (noting that the *Eldred* decision “suggests [that] the Court may not be overly-inclined to second-guess Congress’s expansion of copyright protection under section 104A”).

property policy, emphasizing the congressional practice of restoring copyrights,²⁴² distinguishing prior decisions, and paying lip service to the “limited times” restriction in the Copyright Clause. After all, Congress effectively exercises general legislative powers and, as a practical matter, constitutional invalidation of economic laws like intellectual property statutes is very unlikely.²⁴³

IV. CONCLUSION

The post-*Eldred* decisions discussed in this article show that the limitations in the Copyright Clause are becoming insignificant and that the public domain is in danger. In particular, *Luck's Music* and *Golan* are startling extensions of *Eldred* to uphold the power of Congress under the Copyright Clause to remove works from the public domain and grant private ownership in those restored works. If Congress can enact this legislation under its Copyright Clause powers, then it would seem to be unnecessary to turn to the Commerce Clause and other grants of power in the Constitution, such as the Treaty Power, to evade other limitations in the Copyright Clause,²⁴⁴ such as the “writings” requirement. The Supreme Court’s great deference to congressional authority, its broad and troublesome statements about the differences between the patent and copyright bargains, and the Court’s shift away from its historic copyright jurisprudence provide credible arguments for expanding exclusive rights at the expense of the public’s right to make free use of what had once been within the public domain and unprotected. Reward to the author no longer seems to be a secondary consideration because “[t]he profit motive is the engine that ensures the progress of science.”²⁴⁵

²⁴² Cf. *Eldred v. Ashcroft*, 537 U.S. 186, 212 (2003).

²⁴³ Bohannon, *supra* note 18, at 568, 633; Lawson, *supra* note 18, at 1233, 1236 (arguing, in the context of an article about the status of our nation’s administrative agencies, that Congress effectively exercises general legislative powers in contravention of the principle of limited powers, and that the Supreme Court has effectively acquiesced in Congress’ assumption of general legislative powers).

²⁴⁴ See Samuelson, *Constitutional Law*, *supra* note 8, at 564 (noting that these issues about Congress’ authority under the Copyright Clause and other clauses in the Constitution will have to be litigated); Shipley, *supra* note 9, at 100–01.

²⁴⁵ *Eldred*, 537 U.S. at 212 n.18; *Kahle v. Ashcroft*, No. C-04-1127 MMC, 2004 WL 2663157, at *10 (N.D. Cal. Nov. 19, 2004); see also Ledford, *supra* note 65, at 676–77; Olliar, *supra* note 5, at 1810 (arguing that the Framers intended the “to promote progress” preamble in the Copyright Clause to serve as a limit on the power of Congress).