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We're (Not) Gonna Take It! – Golan and the Shrinking Public Domain

Daniel Kohn

1. Introduction

The Patent and Copyright Clause of the United States Constitution proscribes that Intellectual Property rights are granted “to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”¹ The Framers’ rationale² behind the Clause is that Congress gives authors incentives to create new works, by granting them exclusive rights in Copyright, in order to further promote progress and the betterment of society and the general public through creation of new works of art and widespread access to a large base of creative works.³ This rationale, also known as the Utilitarian Theory of Copyright, is premised upon the fact that Congress’ grant of exclusive copyrights to authors is limited to a fixed number of years.⁴ Once the exclusive “limited time” copyright protection expires, such works of art fall into the public domain and are free to be used and enjoyed by the general public without restriction.⁵ Furthermore, once a work falls into the public domain, it has traditionally been held that it remains there for good.⁶

¹ United States Constitution, Art. I, §8, Cl. 8

² Craig Joyce and L. Ray Patterson, Copyright in 1791: An Essay Concerning The Founders’ View Of The Copyright Power Granted To Congress In Article I, Section 8 Clause 8 Of The U.S. Constitution, 52 Emory L.J. 909, 947 (2003) (quoting George Washington's January 8, 1790 address to Congress, "Knowledge is, in every country, the surest basis of public happiness").

³ J. Blake Pinard, Note, Defending the Public Domain-The First Amendment, the Copyright Power, and the Potential of Golan v. Gonzales, 61 Okl. L. Rev. 395, 398-399 (2008).

⁴ William Patry, Patry on Copyright §1:1 (2007) (recognizing copyright in the United States as a "positive law for utilitarian purposes" and "not a property right, much less a natural right").

⁵ Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 34 (U.S. 2003).

⁶ David E. Shipley, Congressional Authority Over Intellectual Property Policy After Eldred v. Ashcroft: Deference, Empty Limitations, and Risks to the Public Domain, 70 Alb. L. Rev. 1255, 1293 (2007).

However, this assumption about the permanence of the public domain changed when Congress enacted §514 of the Uruguay Round Agreements Act (“URAA”)⁷ in 1994, and passed the Copyright Term Extension Act of 1998 (“CTEA”), also known as the “Sony Bono Act” or “Mickey Mouse Protection Act”.⁸ With the passing of these two laws, Congress used its legislative power to directly and indirectly encroach on the public domain, by extending copyright duration to works that were about to expire, as well as reinstate copyright protection to works that were not protected at all.

Both acts were challenged as being unconstitutional, based on a violation the IP Clause of the Constitution. Recently, in January 2012, the United States Supreme Court held that URAA §514 was constitutional and that the restoration of copyright to works currently in the public domain was within Congress’ power.⁹ In the discussion below I will discuss both the Supreme Court’s holding in this case, as well as what the post-Golan landscape looks like for those most affected by its holding.

2. How We Got Here: Background

a. Sonny Bono and Mickey Mouse

Although important for our discussion to follow below, the CTEA is not the focus of this paper. As such, I will briefly discuss its content and its effect on the public domain.

The CTEA extended US copyright protection an additional twenty years. Pursuant to the Copyright Act of 1976 (“’76 Act”) copyright duration was generally fixed at “life plus 50”, so under the CTEA, Copyright duration was extended to “life plus 70”. In short,

⁷ 17 U.S.C. § 104A

⁸ 17 U.S.C. §§ 108, 203(a)(2), 301(c), 302, 303, 304(c)(2)

⁹ Golan v. Holder, 132 S. Ct. 873, (U.S. 2012).

the CTEA extended copyright protection, for works currently protected, for an additional twenty years. For example, if a work's copyright was set to expire on January 1, 2014, under the terms of the CTEA, it would extend through January 1, 2034. While it may seem innocuous to add a few extra years onto a copyright's already existing duration, by adding an additional twenty years of protection to these works, the CTEA prevented such works from entering the public domain, arguably "robbing" the general public of the benefit of twenty years of free use of such works.

The constitutionality of the CTEA was challenged in Eldred v. Ashcroft.¹⁰ There, the plaintiffs asserted that the CTEA violated the "Limited Times" provisions of the Copyright Clause, and the First Amendment's guarantee of free speech.¹¹ The US District Court for the District of Columbia ruled in favor of the defendants on all grounds and the US Court of Appeals for the District of Columbia District affirmed the ruling *en banc*. The United States Supreme Court granted *certiorari* and heard the case in February 2002. In a 7-2 decision, the Supreme Court affirmed both lower court rulings upholding the constitutionality of the CTEA. The Court pointed to prior Copyright Acts as evidence of Congressional precedent for extending copyrights.¹² Moreover, the Court ruled that the CTEA did not violate the "Limited Times" provision, because so long as the copyrights did not extend in perpetuity, any duration set by Congress is "limited" and passes constitutional muster.¹³ In rejecting the First Amendment challenge to the CTEA, the

¹⁰ Eldred v. Ashcroft, 537 U.S. 186 (U.S. 2003)

¹¹ Id. at 196.

¹² Id. at 204.

¹³ Id. at 210.

majority held that "when, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary."¹⁴

b. The Berne Convention

We will now turn our attention to the focus of the Golan case, §514 URAA. However, in order to fully understand section 514, we must begin our analysis in 1886 with the signing of the Berne Convention for the Protection of Literary and Artistic Works, more commonly known as the Berne Convention ("Berne"). Berne is an international trademark agreement where each member nation agrees to provide a minimum level of copyright protection and treat owners from other member countries as they would treat owners from their own borders.¹⁵ Berne has three basic requirements for membership: (1) member-states must grant works originating in other member-states the same copyright protections granted to works created by its own nationals¹⁶; (2) copyright protection must automatically attach to a work, it cannot be contingent on formalities;¹⁷ and (3) Berne members must grant a minimum copyright term of life of the author plus fifty years.¹⁸

The problem starts because the United States did not become a member of Berne until 1989.¹⁹ The US resisted joining Berne primarily because the United States worldview of copyrights differed from the rest of the world on a principal matter.²⁰ Most

¹⁴ Id. at 221.

¹⁵ Berne Convention for the Protection of Artistic and Literary Works, Art. 5(1). World Intellectual Property Organization, <http://www.wipo.int/treaties/en/ip/berne/>

¹⁶ Id. at Art. 5(3).

¹⁷ Id. at Art. 5(2).

¹⁸ Id. at Art. 7(1).

¹⁹ Berne Convention Implementation Act of 1988, 100 P.L. 568.

²⁰ David L. Lange, Risa J. Weaver & Shiveh Roxana Reed, Article, Golan v. Holder: Copyright In The Image Of The First Amendment, 11 J. Marshall Rev. Intell. Prop. L. 83, 86 (2011).

other countries see copyright as a natural right of the author, evidenced by most other nations having some type of Moral Rights provisions included in their copyright laws.²¹ In contrast, the US sees copyright solely through a utilitarian prism, as a means to incentivize creativity, encourage distribution of new works and progress science.²² Based on the “rest of the world” approach, Berne prohibits the imposition of formalities as a prerequisite for copyright protection.²³ Under the 1909 Copyright Act, authors were required to publish their works with proper copyright notice in order to obtain a federal statutory copyright.²⁴ Additionally, authors were required to register works in order to bring an action for infringement.²⁵ Although nowadays, works can still be protected without formal registration, registration is still a prerequisite for bringing an infringement action in federal court.²⁶ Given these strict rigid formal prerequisites for protection, many works, which would otherwise be eligible to receive copyright protection, fell into the public domain simply because they were published without following such rules.²⁷ It should come as no surprise that many of the works that failed in following the 1909 Act were owned by foreign authors who were simply unfamiliar with such formalities.²⁸ Additionally, published works by foreign authors did not receive federal copyright protection at all because of their country of origin, as federal law only granted copyright protection to published works of foreign origin only when required by treaty or

²¹ Id.

²² Id.

²³ Berne Convention for the Protection of Artistic and Literary Works, World Intellectual Property, <http://www.wipo.int/treaties/en/ip/berne/>

²⁴ Copyright Act of 1909, 17 U.S.C. §10, repealed 1978.

²⁵ Copyright Act of 1909, 17 U.S.C. §13, repealed 1978.

²⁶ 17 U.S.C. §412.

²⁷ Mary LaFrance, Copyright Restoration: The Supreme Court's Upcoming Decision in Golan v. Holder, 2011 Emerging Issues 5890.

²⁸ Id.

presidential proclamation.²⁹

Additionally, while Berne always offered its members copyright protection for life of the author, plus fifty years, US protection was only for a term of twenty-eight years, with an option to renew for another twenty-eight, provided that the author followed the strict renewal formalities.³⁰ As a result of its strict rules, many works that were eligible for copyright protection often fell into the public domain prematurely, either because they were published without a legally sufficient copyright notice, or because their copyrights were not timely renewed.³¹ Many of these works were owned by foreign authors or publishers who were not familiar with the formal strictures of the 1909 Act.³²

With the passing of the United States' current copyright statute, the 1976 Act³³, the basic term of copyright protection was streamlined with Berne's 'life+50' regime.³⁴ However, even with the passing of the 1976 Act, the US was not fully aligned with Berne, as it still required certain formalities when it came to renewal of works published pursuant to the 1909 Act.³⁵ Furthermore, as a result of its failure to streamline its copyright law with Berne, many published foreign works continued not to receive copyright protection in the US.³⁶ The formalities for notice and renewals were still enforced and therefore, noncompliance continued to cause forfeiture of rights to

²⁹ Id.

³⁰ Copyright Act of 1909, 17 U.S.C. §24, repealed 1978.

³¹ Mary LaFrance, Supreme Court's Upheld Constitutionality of Copyright Restoration: Golan v. Holder, 2012 Emerging Issues 6197.

³² Id.

³³ Copyright Act of 1976, 17. U.S.C. §§101, *et. seq.*

³⁴ Copyright Act of 1976, 17. U.S.C. §302.

³⁵ Golan v. Holder, 132 S. Ct. 873, 874 (U.S. 2012).

³⁶ See *supra* note 27.

published foreign works well after the '76 Act was enacted.³⁷

As the 21st Century came closer and technology allowed for the global economic community to shrink, it became of a greater interest to ensure protection of US copyrights abroad. However, in order to effectively achieve this goal, the US would need to finally join Berne, which it did in 1989³⁸. By joining Berne, the United States was now required to grant full copyright protection to works of authorship from fellow Berne countries, without any prerequisite formalities. However, even though the notice and registration formalities are no longer prerequisites for registration, there still are incentives to complying with them. For example, having proper copyright notice eliminates an “innocent infringer” defense when seeking and assessing damages.³⁹

Article 18 of the Berne Convention requires that new member nations provide retroactive protection to other Berne parties' works "which, at the moment of [the Convention's] coming into force, have not yet fallen into the public domain in the country of origin through the expiry of the term of protection."⁴⁰ In short, Art. 18 requires countries to protect the works of other member states, unless the work's copyright term has expired in either the country where protection is claimed, or the country of origin. What this meant for the US was that it should have reinstated copyrights to many of these unprotected foreign works, whose US rights were forfeited due to their failure to follow certain formalities.

Nevertheless, the United States failed to comply with Art. 18, and there was

³⁷ Id.

³⁸ Berne Convention Implementation Act of 1988, 100 P.L. 568.

³⁹ 17 U.S.C. §405(b).

⁴⁰ Berne Convention, Art. 18, <http://www.wipo.int/treaties/en/ip/berne/>

nothing anyone could do to force them to act otherwise, because even though Berne discusses dispute resolution before the International Court of Justice, it does not specify sanctions for noncompliance. Moreover, it permits parties, to declare themselves "not . . . bound" by the Convention's dispute resolution provision.⁴¹

c. The TRIPS Agreement

However, things changed in 1994, when most of the Berne Convention was incorporated into the Trade Related Aspects of Intellectual Property Rights ("TRIPS Agreement"), as part of the WTO Agreement, in the Uruguay Round of the General Agreement on Tariffs and Trade ("GATT"). The United States joined both TRIPS and GATT. Most importantly for our discussion, TRIPS required all its signatories to implement Berne's first 21 articles.⁴² Moreover, TRIPS and the WTO gave Berne enforcement power. Noncompliance with a WTO ruling could subject member countries to tariffs or other retaliation. The possibility of WTO enforcement action and tariffs spurred Congress into action and quickly incorporated Berne Art. 18 into US law with the passing §514 of the URAA.⁴³ Section 514 restored US copyright protection to foreign works that were protectable in their country of origin but were in the public domain in the United States for any of the following reasons:

- (i) Noncompliance with formalities imposed at any time by United States copyright law, including failure of renewal, lack of proper notice, or failure to comply with any manufacturing requirements;
- (ii) Lack of subject matter protection in the case of sound recordings fixed before February 15, 1972; or
- (iii) Lack of national eligibility; [for example, if the country of origin did

⁴¹ Id. Art. 33

⁴² World Trade Organization, TRIPS, Art. 9.1 (requiring adherence to all but the "moral rights" provisions of Article), http://www.wto.org/english/tratop_e/trips_e/t_agm0_e.htm

⁴³ 17 U.S.C. §104A

not initially share copyright reciprocity with the United States].⁴⁴

Under Section 514, the term of copyright for the foreign works would last for “the remainder of the term of copyright that the work would have otherwise been granted” had the work never fallen into the public domain in the first place.⁴⁵ However, owners of these works would not receive any form of compensation for lost time when the works were unprotected. Section 514 simply grants them the protection they are due. It does not make up for any lost time.

Considering that these works have been in the public domain for years and people have been using them free of charge, Congress needed to draft provisions that would enable the public to phase out their use of foreign works that were once free and legal to enjoy, but now copyright protected. As such, section 514 did not impose liability on any use prior to restoration. Moreover, anyone was free to copy and use these works for an additional year after section 514’s effective date.⁴⁶ Anyone who prepared and created derivative works based on a restored work was allowed to exploit the work indefinitely, provided they paid the copyright holder “reasonable compensation”. Should the parties be unable to determine such an amount, a judge will determine the amount.⁴⁷

Based on the above, we have now established the groundwork for understanding where US Copyright law has come from in its treatment of foreign works under the 1909 Act and the 1976 Act. Moreover, we see how it came to be under Berne and URAA §514 that Congress made changes to the Copyright Act, took these works out of the public

⁴⁴ 17 U.S.C. 104A(h)(6)(C)

⁴⁵ 17 U.S.C. 104A(a)(1)(B)

⁴⁶ 17 U.S.C. 104A(h)

⁴⁷ 17 U.S.C. 104A(d)(3)

domain and restored copyright protection to these works. Now that we understand the current legislative landscape, we can turn our analysis to the facts and circumstances of Golan.

3. The Long and Winding Road That Leads To Golan

This case's path to the Supreme Court began back in September 2001⁴⁸. The plaintiffs filed a lawsuit challenging the constitutionality URAA §514 and the CTEA.⁴⁹ The named Plaintiff in this case, Lawrence Golan, is the Director of Orchestral Studies, Conductor, and Professor of Conducting at the University of Denver's Lamont School of Music.⁵⁰ Aside from teaching, he also conducts the school's Symphony Orchestra, which performs 6 free concerts and 1 opera each year in Denver.⁵¹ The other Plaintiffs were various musicians, orchestra conductors, educators, performers, film archivists, and motion picture distributors.⁵² Golan and the other plaintiffs all depended on the public domain as the key source of materials to teach, perform and disseminate to their students and general public.⁵³

As a result of Section 514's restoring copyright to many foreign works, there were many old works that were part of Golan's standard curriculum that he was no longer able to use, because they are no longer freely available in the public domain.⁵⁴ The removal of free access to materials in the public domain - and the corresponding assurance that those materials will remain in the public domain - severely hampered the

⁴⁸ Golan v. Ashcroft, 2001 U.S. Dist. Ct. Pleadings LEXIS 373 (D. Colo. Sept. 19, 2001).

⁴⁹ Id. at 2-5.

⁵⁰ Id. at 5-6.

⁵¹ Id. at 29-30.

⁵² Id. at 6-8.

⁵³ Id. at 8-10.

⁵⁴ Id. at 29-31.

plaintiffs' ability to pursue their creative interests and promote learning in this country.⁵⁵

Because of URAA §514, Golan had fewer materials in the public domain to teach. He was even forced to forgo teaching several famous foreign works, such as works of Shostakovich and Prokofiev, because §514 revived copyrights in these works, which used to be public domain.⁵⁶

The Golan plaintiffs argued that in passing the URAA §514, Congress exceeded its authority under the Copyright Clause, by violating the Clause's "limited times" provision⁵⁷, as well as violating the First Amendment, by imposing the burden of complying with the newly restored copyright protections of URAA §514 to works that were once free to use in the public domain.⁵⁸

a. Lower Court Rulings – Round I

Based on the US Supreme Court's holding that the CTEA was constitutional in Eldred v. Ashcroft,⁵⁹ the district court dismissed Golan's challenge to the CTEA.⁶⁰ The district court then addressed Golan's arguments regarding the Copyright Clause and the First Amendment. The district court granted the government's motion for summary judgment concerning the argument that section §514 violates the "limited times" provision of the Copyright Clause. The court noted that that Congress "has historically demonstrated little compunction about removing copyrightable materials from the public domain."⁶¹ Moreover, the court struck down Golan's First Amendment argument, as it

⁵⁵ Id. at 31-33.

⁵⁶ Id. at 33-34.

⁵⁷ Id. at 55-58.

⁵⁸ Id. at 58-59.

⁵⁹ See Eldred discussion above, *Supra*, pages 2-3.

⁶⁰ Golan v. Gonzales, 2005 U.S. Dist. LEXIS 6800 (D. Colo. Apr. 19, 2005).

⁶¹ Id. at 42.

failed to deviate from "the settled rule that private censorship via copyright enforcement does not implicate First Amendment concerns."⁶²

Golan appealed the district court's grant of summary judgment to the Tenth Circuit Court of Appeals⁶³. On appeal, the Tenth Circuit agreed that by restoring copyright protection to foreign works in the public domain §514 did exceed Congress' power pursuant to the Copyright Clause.⁶⁴ However, the court remanded the case back to the District Court because on the question whether removal of works from the public domain violates the First Amendment.⁶⁵ The Circuit Court held that "since §514 has altered the traditional contours of copyright protection in a manner that implicates plaintiffs' right to free expression, it must be subject to First Amendment review."⁶⁶

b. Lower Court Rulings – Round II

On remand, the district court in Golan v. Holder, 611 F. Supp. 2d 1165 (D. Colo. 2009) determined that the proper level of First Amendment scrutiny in this instance is for content-neutral regulations of speech, which allows speech restrictions that "advances important governmental interests unrelated to the suppression of free speech and does not burden substantially more speech than necessary to further those interests."⁶⁷ In the court's opinion a restriction of free speech must be "narrowly tailored to serve a significant government interest" unrelated to the suppression of free speech. Such a requirement is met if the restriction "promotes a substantial government interest that

⁶² Id. at 48.

⁶³ Golan v. Gonzales, 501 F.3d 1179 (10th Cir. 2007)

⁶⁴ Id. at 1186.

⁶⁵ Id. at 1196.

⁶⁶ Id. at 1197.

⁶⁷ Golan v. Holder, 611 F.Supp.2d 1165, 1170 (D. Colo. 2009) (quoting Turner Broad. Sys., Inc. v. F.C.C., 520 U.S. 180, 189 (1997)).

would be achieved less effectively absent the restriction."⁶⁸ The government offered three interests allegedly served by Section 514:

- (1) Section 514 brings the United States into substantial compliance with its international treaty obligations under the Berne Convention;
- (2) Section 514 helps protect the copyright interests of United States authors abroad;
- and (3) Section 514 corrects for historic inequities wrought on foreign authors who lost their United States copyrights through no fault of their own.⁶⁹

The court held, first, Congress could have complied with the Berne Convention without interfering with a substantial amount of protected speech⁷⁰. Second, the government's failure to provide any evidence showing it has a significant interest that is protected by limiting speech per section 514, and that section 514 does not burden substantially more speech than necessary to further such an interest, "shows no question of material fact remains to be determined on this issue."⁷¹ Third, the court expressed that "the Government proffers no evidence showing how granting foreign authors copyrights in the United States--yet denying similar protections to United States authors--could constitute an important Government interest."⁷² As such, given the fact that URAA §514 failed to meet this standard, the court ruled that URAA §514 violated the First Amendment and was therefore unconstitutional.⁷³

The district court's holding was appealed to the Tenth Circuit, Golan v. Holder, 609 F.3d 1076 (10th Cir. Colo. 2010), which reversed the lower court ruling, and held that §514 was constitutional. The court of appeals agreed with the lower court that §514

⁶⁸ Id. at 1170-71.

⁶⁹ Id. at 1172.

⁷⁰ Id. at 1174.

⁷¹ Id. at 1176-1177.

⁷² Id.

⁷³ Id.

was content-neutral, but the 10th Circuit held that Section 514 did not violate Golan's freedom of speech because it advanced a substantial government interest in complying with TRIPS.⁷⁴ By acting in compliance with TRIPS, and reaching into the public domain and restoring copyrights to foreign works that were not protected in the United States, Congress would ensure that other TRIPS signatories would reciprocate such protection and protect US copyrights around the world.⁷⁵ The court noted that Congress could have chosen alternatives for protecting these interests, but in the end they were not substantially more protective of speech interests than those in §514.

c. Supreme Court

As a result of the Tenth Circuit's holding, Golan appealed, and successfully petitioned the United States Supreme Court for a writ of certiorari. The two issues presented before the Supreme Court in Golan v. Holder, 132 S. Ct. 873, (U.S. 2012) were:

- (1) Does the Copyright Clause prohibit Congress from taking works out of the public domain?
- (2) Does §514 of the URAA violate the First Amendment?

In a 6-2 vote, the majority, led by Justice Ginsburg and joined by Chief Justice Roberts, and Justices Scalia, Kennedy, Thomas and Sotomayor (Justice Kagan recused herself), strongly affirmed the 10th Circuit's holding that URAA §514 is constitutional and that the restoration of copyright to works currently in the public domain is within Congress' power.⁷⁶

The Supreme Court first dealt with the question of if §514 violated the "limited

⁷⁴ Golan v. Holder, 609 F.3d 1076, 1090 (10th Cir. Colo. 2010)

⁷⁵ Id. at 1085.

⁷⁶ Golan v. Holder, 132 S. Ct. 873, (U.S. 2012)

times" restriction of Copyright Clause. The Clause provides that "Congress shall have Power . . . to promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings."⁷⁷ Plaintiffs argued that based on this explicit grant of Copyright protection to specific works for "limited times", that there was an implied barrier to granting copyright protection to works that have already entered the public domain. Plaintiffs further argued that there is a potential that in enacting §514 Congress could essentially grant works perpetual copyright protection, by repeatedly restoring copyright protection to works that fell into the public domain. The Plaintiffs argued that §514 restoration violates the Copyright Clause because it takes a finite and set time period and transforms it into one that can potentially last forever.⁷⁸

The majority disagreed with this argument, reasoning that it did not read any such restriction on Congress' right to extend copyright duration in the text of the Constitution. Nor did the majority see evidence of such a restriction based on Congress' prior legislative history or prior Supreme Court precedent.⁷⁹

In addressing the issue of "Limited Times" the Court primarily relied on its analysis and holding in Eldred v. Ashcroft where it had upheld the CTEA⁸⁰. The majority reasoned that if the CTEA did not exceed Congress's constitutional authority, then applying the same copyright protection to foreign works should be equally constitutional.⁸¹ The majority acknowledged that there is a critical distinction between the works at issue in Eldred and the works here. The works in Eldred were still under

⁷⁷ United States Constitution, Art. I, §8, Cl. 8

⁷⁸ Golan v. Holder, at 884

⁷⁹ Id.

⁸⁰ See discussion on page 2, supra.

⁸¹ Id. at 885.

copyright protection and the CTEA would extend the current protection an additional twenty years. While here in Golan, URAA §514 granted copyright protection to works whose copyright expired and thus fell into the public domain.⁸² However, despite this critical and fundamental difference in the state of the works, the majority found this difference to be non-dispositive.⁸³ In fact, the majority pointed to the original Copyright Act of 1790, as a strong proof as to the constitutionality of §514, in that both the 1790 Act and §514 granted copyright protection to some pre-existing works that were not yet covered by copyright.⁸⁴ Moreover, there were other instances when Congress granted protection to works already in the public domain.⁸⁵

In addition to arguing the §514 violates the “Limited Times” provision, Golan also argued that §514 fails to “Promote the Progress of Science and useful Arts”. Plaintiffs argued, since §514 only restored copyright protection to already created works of art, then such a grant disincentivizes additional creativity, and therefore violated the Copyright Clause’s “Promotion” provision. Once again the majority pointed to its decision in Eldred and noted that, “the creation of at least one new work, however, is not the sole way Congress may promote knowledge and learning...Rather, we explained, the Clause ‘empowers Congress to determine the intellectual property regimes that, overall, in that body's judgment, will serve the ends of the Clause’...And those permissible ends, we held, extended beyond the creation of new works.”⁸⁶ For example, compliance with international copyright agreements, such as Berne, promotes progress and incentivizes

⁸² Id.

⁸³ Id.

⁸⁴ Id. at 886.

⁸⁵ Id. at 885-887.

⁸⁶ Id. at 888 (citing Eldred, 537 U.S. at 205-06, 211-12, 222).

new creation, thus meeting the goals of the Progress Clause, by expanding the market for United States works abroad and invigorate protection against international piracy of US works.

In regard to the second issue, whether §514 violated the First Amendment, the majority once again leaned on the Eldred holding for guidance. The majority pointed out that Eldred rejected the idea that copyright laws are totally immune from First Amendment scrutiny. Moreover, even though the CTEA had the effect of restricting speech and expression, it passed First Amendment scrutiny because, by its nature, the Copyright Act provided for certain free speech and expression provisions, namely the ‘idea-expression dichotomy’⁸⁷ and the fair use defense⁸⁸ that will prevent the law from violating the First Amendment freedom of speech and expression.

The Eldred Court explained, “When...Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.”⁸⁹ However, it neglected to outline a process for evaluating what constituted a ‘traditional contour’, leaving it to the lower courts to develop a working doctrine. The majority in Golan adopted a very narrow interpretation as to what constituted the ‘traditional contours of copyright’. Per the Court, fair use and the idea/expression dichotomy are the “traditional contours of copyright” referred to in Eldred.⁹⁰ Therefore, because §514 does not attack these specific built-in protections, it does not change the traditional contours of copyright.⁹¹ Furthermore, Congress adopted additional “safety” measures to ease the

⁸⁷ 17 U.S.C. §102(b)

⁸⁸ 17 U.S.C. §107

⁸⁹ Eldred at 221

⁹⁰ Golan v. Holder, at 890.

⁹¹ Id.

transition from a national scheme to an international copyright regime and eased the impact of restoration on "reliance parties" who exploited foreign works denied protection before §514 took effect.

The Golan majority also shot down the Plaintiff's final argument that §514 violated the First Amendment because, here, unlike in Eldred, the public had a "vested right" in the works at issue, because they have already entered the public domain, and it would violate such vested rights to pull them out and restore copyright protection to them. However the majority was quick to reject this argument noting that, "petitioners here attempt to achieve under the banner of the First Amendment what they could not win under the Copyright Clause: On their view of the Copyright Clause, the public domain is inviolable."⁹² The majority restated its earlier stated position, "nothing in the historical record, congressional practice, or our own jurisprudence warrants exceptional First Amendment solicitude for copyrighted works that were once in the public domain."⁹³ Moreover, the majority stressed that, however attractive this bright-line rule might be, it is not a rule rooted in the constitutional text or history. Nor can it fairly be gleaned from our case law.⁹⁴

As such, the majority found that §514 of the URAA did not violate the Copyright Clause, nor did it violate the First Amendment and therefore, affirmed the holding of the 10th Circuit.

d. Breyer's Dissent

⁹² Id. at 891.

⁹³ Id.

⁹⁴ Id. at 892, note 32.

Just as he did in Eldred, Justice Breyer dissented from the majority opinion, joined by Justice Alito. Justice Breyer argued that §514 fundamentally conflicted with the utilitarian view of copyright law, the long-established approach to intellectual property law in the United States.⁹⁵ He pointed out that, historically the monopoly privileges that Congress granted to authors was in exchange for them providing benefits to society. Justice Breyer quotes the authors of the original 1909 Act:

The Constitution . . . provides that Congress shall have the power to grant [copyrights] . . . not primarily for the benefit of the author . . . but because the policy is believed to be for the benefit of the great body of people, in that it will stimulate writing and invention, to give some bonus to authors and inventors." H. R. Rep. No. 2222, 60th Cong., 2d Sess., 7 (1909).⁹⁶

He argued that §514 exceeds all plausible limits of the Copyright Clause. In his view the Clause withdraws works from the public domain, brings about higher prices and costs, and in turn restricts dissemination, all *without providing any additional incentive* for the production of new material.⁹⁷

Additionally, Justice Breyer noted that while it is not unprecedented, it is extremely and highly unusual for Congress to permit the withdrawal of creative works from public domain and restore copyrights.⁹⁸ The dissent notes that the examples relied upon by the majority were private bills, statutes retroactively granting protection in wartime, all of which were designed to provide special exceptions for comparable equitable reasons.⁹⁹ Accordingly, Breyer argued that it would seem farfetched to find an important analogy in those special circumstances to §514, which covers works that the

⁹⁵ Supra, footnote 20.

⁹⁶ Golan v. Holder, at 902-903.

⁹⁷ Id.

⁹⁸ Id. at 908.

⁹⁹ Id.

author did not expect to protect in America.¹⁰⁰ In fact, a look at Congressional practice shows the opposite. “It consists of a virtually unbroken string of legislation preventing the withdrawal of works from the public domain. See, e.g., Berne Convention Implementation Act of 1988, ...Copyright Act of 1976...Copyright Act of 1909...Act to Amend the Several Acts Respecting Copy Rights ...”¹⁰¹

Additionally, the dissent argued, that not only does §514 not satisfy the Copyright Clause because it did not encourage the creation of new works, but moreover it will encourage piracy and theft of such restored works by parties who don’t want to pay a fee to use a work with a "restored copyright" when it previously used for free. Furthermore, that would lead to widespread piracy, because “piracy often begets piracy...even when payment is possible”.¹⁰²

Justice Breyer attacked the majority’s holding on the First Amendment issue as well. He notes that by allowing §514 to restore copyright to foreign works and removing them from the public domain, Congress is removing people’s freedom of speech.¹⁰³ This would run counter to the Court’s prior rulings where it has shown a history of trying to protect the public domain and recognized the sanctity and importance of material in the public domain. “See Graham, 383 U.S., at 6; Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 484; Cox Broadcasting Corp. v. Cohn, 420 U.S. 469, 496; see also Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23.”¹⁰⁴

¹⁰⁰ Id. at 909

¹⁰¹ Id.

¹⁰² Id. at 906-907.

¹⁰³ Id. at 907-908.

¹⁰⁴ Id. at 907.

Breyer further attacked the majority's arguments and argued that they are misguided. The majority argued that section 514 "Promotes Progress" by ensuring US copyrights are enforced worldwide. However Justice Breyer argued that such a concern is all about the author's private rights and maximizing profits. He contended that this concern of protecting US copyright interest throughout the world has nothing to do with incentivizing the creation of new works and protecting creation and progress.¹⁰⁵

Last, Breyer argued that this entire situation is Congress' own doing and fault.¹⁰⁶ The Berne Convention did not force the US into action. In fact between 1989 and 1994, they never punished the US for failure to grant copyright to foreign works. It was only a result of WTO/TRIPS pressure that the US acts in full compliance with Berne.¹⁰⁷ But nobody required Congress to enact §514 as it did. Congress could have complied with TRIPS in a different way that did not encroach on the public domain in such an egregious fashion.¹⁰⁸ For example, Breyer suggests that Congress should have adopted some form of compulsory license fee for royalties to use the foreign works. Breyer concluded by saying, at the end of the day, by withdrawing material from the public domain, and combining its other features, it is clear that the Copyright Clause, as understood in light of the First Amendment, does not authorize Congress to enact §514.

4. Where do we go now?

As a result of the Supreme Court's holding in this case it seems unlikely that future challenges to the constitutionality of amendments and expansions to the 1976 Act will be successful. The first thing to note, that the landslide 6-2 win for the majority may

¹⁰⁵ Id. at 909-910.

¹⁰⁶ Id. at 911.

¹⁰⁷ Id.

¹⁰⁸ Id. at 911-912.

come off as surprising, but it really should not have surprised anyone. Golan is the second case that the Supreme Court heard on this type of issue, the other being Eldred, and in both cases it held the federal legislation at issue to be constitutional. These two holdings clearly indicate that the Court has adopted a firm and deferential view of copyright expansion and legislation.

I agree with the district court and Breyer's dissent that URAA §514 should not pass constitutional muster, primarily because of the bedrock principle of US IP law that once a work falls into the public domain, it belongs to the people and should remain there.¹⁰⁹ As such, it should follow that, unless society receives an additional, substantial and new benefit in return, once a work enters the public domain, it should be foreclosed from having the exclusive rights umbrella of copyright protection restored to it. Such is the purpose behind granting copyright owners and patent holders the exclusive rights they enjoy. The Constitution grants authors and inventors exclusive rights to exploit their works and inventions for a set and defined amount of time, in exchange for granting the general public the benefit of disclosure and free use and enjoyment of such a work after the exclusive rights expire. The aim is that current inventors and authors will build on the shoulders of those that came before them and create new works, further enhancing the public welfare and progress of science.¹¹⁰

Furthermore, the Majority's holding seems even further puzzling given the fact that while it examines Congressional precedent regarding copyright restoration, it ignores its own precedent regarding the sanctity of the public domain. In Sears, Roebuck & Co. v. Stiffel Co., the Supreme Court reversed the ruling of the court of appeals, holding that

¹⁰⁹ Supra, footnote 6.

¹¹⁰ Golan v. Holder, at 911-912.

a state could not use its unfair competition laws to prevent the copying of articles in the public domain because that would "permit the State to block off from the public something which federal law has said belongs to the public."¹¹¹ Furthermore, in Graham v. John Deere Co. of Kansas City, the Court stated, "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."¹¹² Moreover, in Bonito Boats, Inc. v. Thunder Craft Boats, Inc., a unanimous Court held that Congress had determined that extending protection to knowledge already freely available to the public "would not only serve no socially useful purpose, but would in fact injure the public by removing existing knowledge from public use."¹¹³ Although Sears, Graham and Bonito Boats were patent cases, it should be presumed that the Court's opinion as to the sanctity of the public domain is equal for both types of constitutionally proscribed intellectual property. In fact, in Dastar Corp. v. Twentieth Century Fox Film Corp., the Court explicitly articulated that the same "bedrock principle" of sanctity of the public domain applies to both copyright and patent. "Once the patent or copyright monopoly has expired, the public may use the invention or work at will and without attribution."¹¹⁴

However, this is not to say that the majority's opinion in Golan was without merit and was nonsensical. The majority was concerned with the need to streamline TRIPS/Berne enforcement and ensure foreign works are protected on US soil, in order to ensure reciprocal protection of US works internationally. While the district court and

¹¹¹ Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 231-232 (U.S. 1964)

¹¹² Graham v. John Deere Co. of Kan. City, 383 U.S. 1, 6 (U.S. 1966)

¹¹³ Bonito Boats v. Thunder Craft Boats, 489 U.S. 141, 148 (U.S. 1989)

¹¹⁴ Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 33-34 (U.S. 2003)

dissent were concerned with the need to pass legislation that does not violate the Copyright Clause. The best way to balance these legitimate and conflicting concerns of is to, for starters, guarantee all future foreign works will receive proper full-term copyright protection. Doing so will ensure that these foreign works receive the full term of copyright protection granted under the Copyright Act, ensure that the US works are protected abroad and that the Clause is not violated.

However, a big problem still remains in regard to works currently in the public domain. We can balance the concerns expressed above, by allowing these works to remain widely available for use, but with the proviso that users must pay a compulsory license fee for use. Such an arrangement would ensure that owners would receive payment for use of their work. While at the same time, the general public would receive the benefit of the work without having to give up too much, in terms of actual cost to use, and more importantly, not having to worry about being sued for infringement of a work that was presumed to be public domain. Furthermore, imposing such a license fee would curb issues of widespread piracy, because most people are likely to pay for something they think it reasonably priced.

In order to impose such a system Congress could look at the Copyright Act for guidance, as it already provides provisions for compulsory licenses for certain works, such as non-dramatic musical compositions, public broadcasting, retransmission by cable TV systems, subscription and non-subscription digital audio transmissions.¹¹⁵ It is certainly arguable that Congress has the authority to legislate a similar compulsory license arrangement in this instance. Instituting such an arrangement would prevent these

¹¹⁵ 17 U.S.C. §§115, 118, 11(c), 114

works from having copyrights fully restored. But at the same time, it would allow authors to receive payment for use of their works, while at the same time not hold users liable for infringement.

Congress can follow the blueprint set up by the recording industry's performance rights organizations ("PROs"), ASCAP¹¹⁶, BMI¹¹⁷ and SESAC¹¹⁸. These three organizations protect their members' musical copyrights by monitoring public performances of their music and compensating the artist accordingly, based on an arranged royalty fee.¹¹⁹ The way PROs work is that the PRO collects fees from users of the music created by artist, who then directly pay the artist a portion of the fee in the form of a royalty. This arrangement enables the user to use and enjoy the artist's work without having to directly pay the copyright holder after each use, while at the same time the artist does not need to chase after each individual user for a fee. By using the "middle-man" PRO, the user is able to easily pay an affordable fee for the right to use the work, and the artist is able to collect royalties for use of his work and not have to worry about widespread infringement.

A similar type of arrangement can easily be set up in regard to these foreign works, which were formerly in the public domain, but now, post-URAA §514, are subject to copyright restoration. Doing so would ensure that, owners of such copyrights receive compensation for use of their works, while at the same time this systems would not violate the "limited times" provisions of the Copyright Clause and for a reasonable fee, it

¹¹⁶ American Society of Composers, Authors and Publishers, ASCAP Music Licensing, <http://www.ascap.com/licensing/>

¹¹⁷ Broadcast Music, Inc., BMI Music Licensing, <http://www.bmi.com/licensing/>

¹¹⁸ Society of European Stage Authors & Composers, SESAC Licensing, <http://www.sesac.com/Licensing/Licensing.aspx>

¹¹⁹ ASCAP, <http://www.ascap.com/licensing/licensingfaq.aspx>

would allow society to continue the use and enjoyment of said works without the fear of being sued for copyright infringement.

Congress should set up a system, to be coordinated and run by the Copyright Office and Library of Congress, whereby when a person wants to use one of the foreign works at issue, he must pay a predetermined fee for that use. All the fees collected would be pooled together and primarily used to pay out royalties to the owner of the work. An issue addressed by the Supreme Court in the Golan decision was the difficulty and cost of determining the identity of the owners of the works at issue.¹²⁰ Under this system, the onus of proving ownership would fall on the individual coming forward claiming ownership of the protected work. Any person claiming ownership of a restored work may come to the Copyright Office and make a *prima facie* evidentiary showing that they are the owners of the work at issue. If they meet the threshold to prove ownership, the Copyright Office and Library of Congress would pay them royalties, just like member artists receive royalties from ASCAP, BMI or SESAC.

Furthermore, if after an owner makes a valid proof of ownership he feels the royalty rate is too low, he can challenge the pre-determined rate before an administrative panel, which can determine the proper amount. Similarly, if two parties contest ownership of the same work, the administrative panel can hold evidentiary hearings to determine ownership. However, there very well may be many instances of works which will remain “unclaimed” and nobody will care to come forward claiming ownership, or nobody will be unable to prove ownership of such works. In such a case, all monies paid to the Copyright Office for use of such “unclaimed” works would be paid out to

¹²⁰ Golan v. Holder, at 905.

institutions whose stated mission is to help promote the progress of science and useful arts, such as museums, theaters, research institutions, etc.

e. **And In The End...**

As a result of the Eldred and Golan holdings, it is pretty clear as to how the Supreme Court views the expansion of copyright terms and duration. Furthermore, it is pretty clear from the way these two cases were decided that the Court is happy with the precedent it has established, and so it seems unlikely that it will change its stance on this issue in the future. Prior to issuing its ruling in January 2012, it seemed as though the Golan Court would affirm the district court's holding §514 unconstitutional. The Supreme Court could have used this as an opportunity to instruct Congress to enact legislation that was more middle of the road, which would address both the concerns of copyright owners, who are entitled to receive full valued compensation for use of their work, and the concerns of users, who had been using these works for free in the public domain but would now be liable for infringement.

However, after Golan, it unfortunately appears as if the opportunity to enact such legislation has passed, and it seems unlikely that Congress would undertake establishing such a system in the future. It appears that in the post-Golan world, we are left with a statutory scheme, which enables Congress to reach into the public domain and take works away from the general public and place them back under the umbrella of copyright protection.