No. 01-618

IN THE

Supreme Court of the United States

ERIC ELDRED, *et al.*,

Petitioners,

v.

JOHN D. ASHCROFT, In his official capacity as Attorney General,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit

REPLY BRIEF FOR THE PETITIONERS

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INTRODUCTION

> "[T]here is no apparent substantive distinction between permanent protection and permanently available authority to extend originally limited protection. The Congress that can extend the protection of an existing work from 100 years to 120 years …. This, in my view, exceeds the proper understanding of enumerated powers reflected in the *Lopez* principle of *requiring some definable stopping point*."

Eldred v. Reno, 239 F.3d 372, 382 (D.C. Cir. 2001) (Sentelle, J., dissenting) (emphasis added).

The government's reply is important as much for what it does not say as for what it says. First, the government does not deny that there is a split in the circuits about two fundamental questions affecting the scope of Congress's Copyright Clause power. It argues that those conflicts do not "implicate" issues in this case (Opp. 12), but not that they don't exist.

Second, the government does not argue that these fundamental issues are unimportant, or do not merit this Court's attention. To the contrary, by singling out the third question presented and arguing that question does not merit Supreme Court review (Opp. 23), the government, by implication, acknowledges the special concern this Court has demonstrated for copyright cases, even without a direct conflict.[1] The claims of the Amici filed in this Court demonstrate the importance of the issues raised in this case to the preservation and extension of the public domain, and the

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[1] *See* Brief of Petitioners for Writ of Certiorari, *New York Times v. Tasini*, No. 00-201, 10 (asserting review in copyright cases is granted "even absent a direct circuit conflict," citing *Campbell v. Acuff-Rose Music*, 510 U.S. 569 (1994); *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.,* 499 U.S. 340 (1991); *Harper & Row v. Nation Enters.*, 471 U.S. 539 (1985); *Mills Music v. Snyder*, 469 U.S. 153 (1984); *Sony Corp. v. Universal City Studios*, 464 U.S. 417 (1984)), *cert. granted* 531 U.S. 978 (2000).

need for this Court to resolve these issues quickly. *See, e.g.*, Brief of Amicus Curiae Internet Archive; Brief of Amici Curiae American Association of Law Libraries, *et al.*

Third, and most tellingly, the government offers no reply to Judge Sentelle's charge that its reading of the term "limited times" provides no "definable stopping point" to Congress's Copyright Clause power. *Eldred,* 239 F.3d at 382 (Sentelle, J., dissenting). Under the government's reading of the Clause, ratified by the decision below, there is no constitutional limitation on Congress's power to extend the term of copyright, so long as each extension is itself "limited."

Rather than answering Judge Sentelle's charge, the government instead characterizes as "hyperbolic" petitioners' (and presumably Judge Sentelle's) fear that Congress has already adopted the practice of perpetually extending the term of existing copyrights. That concern, the government asserts, is "clearly … not the situation here." (Opp. 17 n.3, citations omitted.) But petitioners are not attacking some vague fear about Congress's future practice. It is a fact, not hyperbole, that Congress has extended the term of subsisting copyrights *eleven times* in the past 40 years (Pet. 2), and that these extensions have grown from relatively short extensions of one or two years, to 19 years in 1976, and then 20 years in 1998. (*Id.*)

To resist petitioners' claims, the government argues (1) that the split in circuit authority is not relevant to the resolution of this case, (2) that petitioners' Copyright Clause claim was resolved against petitioners on an alternative ground, thereby rendering "this Court's resolution of the alleged circuit conflicts wholly advisory" (Opp. 18), and (3) that the Court of Appeals's decision is correct on the merits. All three arguments are wrong.

I. THERE IS A REAL AND GROWING SPLIT OF AUTHORITY MERITING THIS COURT'S REVIEW.

The government argues that there is no split in authority affecting the resolution of this case. This argument trivializes this Court's supervisory authority. Robert L. Stern & Eugene Gressman, SUPREME COURT PRACTICE 168 (7th ed. 1993) (recognizing cert. jurisdiction for conflict "in principle"). The government is correct that there is no split on whether the Sonny Bono Copyright Term Extension Act ("CTEA"), Pub. L. No. 105-298, 112 Stat. 2827 (1998), is constitutional. That fact is unsurprising, as this is the first case to challenge a statute by Congress extending copyright terms.

But in resolving petitioners' claims in the court below, the D.C. Circuit relied upon two lines of authority that are themselves the subject of conflicts in principle. The government argues that the split affecting the meaning of the Copyright Clause is not sufficiently pronounced. (Opp. 17.) Petitioners disagree. But the government does not deny the split affecting the interaction between the Copyright Clause and the First Amendment (Opp. 22-23), and this split has become even more firmly entrenched in the two months since petitioners' initial filing.

These two separate conflicts fundamentally affect Congress's power under the Copyright Clause, and if either were resolved differently, then the outcome in this case would likely be different. Thus, it is completely appropriate for this Court to grant review, not only to resolve the important question of Congress's power to extend the term of copyright, but also to resolve two conflicts that will continue to engender confusion in lower courts.

A. There Is A 3-1 Split Over The Relevant Scope Of First Amendment Review Of A Copyright Statute.

Petitioners have maintained that there is a split in authority on whether copyright statutes should be tested under ordinary First Amendment review. The D.C. Circuit held that they should not — finding that "copyrights are categorically immune from challenges under the First Amendment." (Pet. App. 6a.) In considering a First Amendment challenge to what the government rightly calls "a copyright statute" (Opp. 22), the Eleventh Circuit expressly held that they should — applying intermediate First Amendment review to uphold the challenged statute. *CBS Broad., Inc. v. EchoStar Communications Corp.*, 265 F.3d 1193, 1211 (11th Cir. 2001).

This decision in the 11th Circuit has now been followed by the 4th Circuit, in a case addressing the same statute. *Satellite Broad. and Communications Ass'n v. FCC*, 2001 WL 1557809 (4th Cir. 2001). And less than one month ago, the Second Circuit followed the pattern of the 11th and 4th Circuits, applying intermediate scrutiny to "a copyright statute" that regulated technologies designed to circumvent copyright protection technologies. *Universal City Studios, Inc. v. Corley*, 2001 WL 1505495, *12-14 (2d Cir. 2001).

These decisions plainly evidence two different rules about the relationship between "copyright statute[s]" (Opp. 22) and ordinary First Amendment review. In the D.C. Circuit, "copyright *statutes* remain largely immune from First Amendment challenges." (Opp. 22, emphasis added.) In the 11th, 4th, and 2d Circuits, "copyright statutes" are not "immune from First Amendment challenges." (*Id.*) These results conflict.

The government treats this conflict as irrelevant to the merits of this case, because, as it writes, the 11th Circuit "specifically endorsed the law of the D.C. Circuit in the copyright/First Amendment context, stating that '[t]here is no first amendment right to * * * make commercial use of the

copyrighted works of others.'" (Opp. 22-23.) But petitioners have never asserted a First Amendment right to use the copyrighted works of others. Our only claim has been that courts within the D.C. Circuit should apply the same First Amendment review of "copyright statutes" as the courts in the 11th, 4th, and 2d Circuits have to determine if certain creative work can properly be copyrighted.

Had petitioners been allowed the benefit of the First Amendment rule from the 11th, 4th and 2d Circuits, then, we submit, the government would have been unable to meet its burden of demonstrating that the speech restrictive aspects of the CTEA were justified under intermediate review. Thus the split in authority that we allege directly affects the outcome of this case. Petitioners are not asking this Court to reapply a properly selected legal standard. Petitioners complain that the court below did not apply the proper legal standard *because the rule governing the selection of such a standard is in dispute*. By resolving this dispute now, this Court could set the standard that should govern challenges to copyright terms, and set the framework for the inevitable conflicts that will arise as copyright law intersects First Amendment interests.

B. There Is A 5-2 Split Over The Relevance Of The "Grant of Power" In The Copyright Clause To The Scope of Congress's Power.

Following its earlier decision in *Schnapper v. Foley*, 667 F.2d 102 (D.C. Cir. 1981), the Court of Appeals held that the "grant of power" in the Copyright Clause (giving Congress the power "to promote the progress of Science and useful Arts") does not "constitute[] a limit on congressional power." *Eldred*, 239 F.3d at 378 (citations omitted). The court thus rendered this text a constitutional dictum. Only one other circuit has similarly dismissed the framers' text. *Hutchinson Tel. Co. v. Fronteer Directory Co.*, 770 F.2d 128, 130 (8th Cir. 1985). Other circuits have tried to give meaning to the text. Following this Court's reasoning in *Graham v. John Deere*

Co., 383 U.S. 1 (1966), these circuits have read the "grant of power" to constrain Congress in the exercise of its Copyright Clause power. (Pet. 14-17.) As the Fifth Circuit wrote in *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979), upholding the copyrightability of obscene works against a constitutional attack, while the "words of the copyright clause" do not require that *individual* copyrights be shown to "promote science or useful arts," they plainly do "require that *Congress* shall promote those ends." *Id.* at 859 (emphasis added). "Congress' power," the court concluded, "under this Clause *is limited to action that promotes the useful arts*." *Id.* at 860 (emphasis added).[2]

The government dismisses these cases by arguing that they were statutory cases interpreting the scope of the Copyright Act. (Opp. 16.) That claim is untrue about *Mitchell Brothers*, and is otherwise irrelevant. Petitioners have argued that the "grant of power" means something to the scope of Congress's copyright power in the majority of circuits. In the D.C. and Eighth Circuits, it does not. This difference is revealed in the courts' interpretation of the Copyright Act. But the difference, however revealed, is plainly relevant to, and possibly disposative of, petitioners' claims. The division in authority thus merits this Court's review.

II. THE COURT OF APPEALS DID NOT RESOLVE PETITIONERS' COPYRIGHT CLAUSE CHALLENGE UPON AN ALTERNATIVE GROUND.

The government argues that the D.C. Circuit resolved petitioners' Copyright Clause claim on the alternative ground that the CTEA is supported by Congress's power under the

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[2] The government asks "how a decision following *Schnapper*, which follows *Mitchell Brothers*, can have created a conflict with *Mitchell Brothers*." (Opp. 16.) The answer is simple: the D.C. Circuit misread the Fifth Circuit authority, and has thereby established authority that is in conflict with five other circuits.

Necessary and Proper Clause. (Opp. 18.) This is plainly wrong, as the government's own summary of the case demonstrates. (Opp. 10-11.) While the Court of Appeals did rely upon the Necessary and Proper Clause to reject *Amicus Eagle Forum's* interpretation of the "grant of power," it did not rely upon the Necessary and Proper Clause to reject *petitioners'* interpretation of the "grant of power."

While petitioners expressly adopted Amicus's argument at oral argument in the Court of Appeals (Tr. of Oral Arg. 17-18; Pet. App. 29a.), and continue to embrace it in this Court, Eagle Forum's argument is importantly different from the argument advanced by petitioners. Under its view, a statute granting copyrights to "Authors" for their "Writings" for "limited Times" may still be found not to "promote … progress." (It could, in other words, be found not to promote progress either because it is too strong, or too weak, despite its terms being "limited.") The "promote … progress" requirement, under this view, is an additional constraint on the Copyright Clause power, requiring a court to articulate a judicially manageable standard to enforce its limit.

Petitioners have advanced a different argument: that the meaning of "limited Times" should be read in light of the "grant of power" such that only those "Times" that could be said to "promote the Progress of Science" can be considered "limited Times" for purposes of the Copyright Clause. Under this view, the "grant of power" does not constitute an additional constraint beyond the textual constraints in the Copyright Clause, but instead helps inform the interpretation of those other textual constraints.

The D.C. Circuit did not address whether the Necessary and Proper Clause would justify the CTEA under petitioners' reading of the "grant of power." Nor could the Necessary and Proper Clause justify the CTEA under petitioners' reading of the clause. As this Court has recognized in *Printz v. United States*, it is not "proper" to read the scope of Congress's power

to extend in a way that is inconsistent with the Constitution's text *properly interpreted*. 521 U.S. 898, 924 (1997) (citing Lawson & Granger, *The "Proper" Scope of Federal Power: A Jurisdictional Interpretation of the Sweeping Clause*, 43 Duke L.J. 267, 297-326, 330-333 (1993)). If, as petitioners assert, "limited Times" should be read to exclude retrospective extensions because retrospective extensions could not "promote" anything, then the Necessary and Proper Clause cannot be relied upon to invert that interpretation of "limited Times."

III. THE GOVERNMENT'S REMAINING ARGUMENTS ON THE MERITS MUST FAIL

1. The government suggests that the implied constraints on Congress's copyright power derive from the possessive "their" in the Copyright Clause when attached to "Authors" and "Writings." (Opp. 14.) While this argument might well explain the "originality" requirement of *Feist Publ'ns v. Rural Tel. Ser. Co.*, 499 U.S. 340, 345 (1991), it cannot explain the holdings of *Graham*, 383 U.S. at 6, and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989), that Congress cannot remove works from the public domain. Works in the public domain plainly have "Authors." There is no reason, then, on the government's account, why Congress could not extend copyrights to such "Authors" for "their" "Writings." The constraint of *Graham* forbidding such an extension must therefore arise elsewhere.

2. The government argues that the framers' initial copyright statute demonstrates that they intended Congress to have the power to perpetually extend the term of existing copyrights. (Opp. 15.) The government is correct that the first statute extended copyrights to works "already printed." Act of May 31, 1790, ch. 15, §1, 3, 1 Stat. 124-25. But it does not follow that the First Congress thereby intended to extend the *term* of any copyright. In 1790, there was still an important uncertainly about whether copyrights were

protected by common law, or whether they were solely a creation of positive law. *Wheaton v. Peters*, 33 U.S. (8 Peters) 591 (1834) (rejecting common law copyright but acknowledging differing views). If copyrights were protected by common law, then the effect of the 1790 statute would be to terminate that common law right and restrict the resulting term to the term of the federal statute. The same would be true for state copyrights. Federal terms could well have been less than the remaining state terms, and there is nothing to indicate that Congress intended to extend those state terms.

The better view of the 1790 statute is that it resolved a transitional problem created by the enactment of a federal power protecting copyrights, in light of the spotty protection granted by states. *See* Lyman Ray Patterson, COPYRIGHT IN HISTORICAL PERSPECTIVE 181 (1968). Congress's additional requirement that authors of works "already printed" must register their works to obtain the benefit of the federal copyright buttresses petitioners' claim that the framers were not granting Congress the power to extend copyright regardless of whether it "promoted … progress." *See* Act of 1790, *supra*, §3.

3. Finally, the government cites this Court's decision in *McClurg v. Kingsland*, 42 U.S. (1 How.) 202, 206 (1843), as authority for the proposition that Congress has the power to extend existing terms. As the government states, "this Court had made it 'plain' that Congress has the power 'to amplify the terms of an existing patent.'" (Opp. 9, citing *McClurg*.) But *McClurg* did not address a *term extension*. It upheld a statute that "authorized the issuing [of] a new patent, when an original one was invalid by accident, inadvertence, or mistake, and without any fraudulent intent…." 42 U.S. at 207. The equitable power to correct mistakes in the administration of the patent office cannot ground a general power to extend the terms of all existing copyright terms.

IV. IMMEDIATE RESOLUTION OF THESE ISSUES IS REQUIRED TO AVOID ENORMOUS HARM.

As the briefs from Amici Internet Archive and American Association of Law Libraries *et al.* demonstrate, the cost of delaying resolution of the questions raised in this case is enormous. Despite the unsubstantiated assertions of the government, Amici offer direct evidence of the loss of film and other creative work that will flow from the perpetual extension of copyright. As Amicus American Association of Law Libraries *et al.* argues, the overwhelming majority of restored films, for example, were only restored after they entered the public domain. (Amicus AALL 19-20.) The practice of copyright holders has not been to protect and preserve this work generally. Instead, copyright regulation has put a great deal of this work effectively out of public reach.

In other copyright act contexts, this Court has recognized the importance of a speedy resolution of Copyright Clause questions. In *New York Times v. Tasini, supra*, for example, this Court granted review in light of the dangers to speech that delay would produce, despite the absence of any direct conflict in that case. Petitioners suggest that the same concern should guide the Court here. Congress has abandoned the framers' plan of requiring that work pass into the public domain after a "short interval." Joseph Story, COMMENTARIES ON THE CONSTITUTION OF THE UNITED STATES § 502, at 402 (R. Rotunda & J. Nowak eds., 1987). Given the possibilities of digital production as described by Amicus Internet Archive, this change in the framers' practice now threatens to obliterate a great deal of our common culture. In light of the ongoing conflict among the circuits, there is no good reason for the Court to wait to resolve the questions presented by this case.

CONCLUSION

The petition for writ of certiorari should be granted.

Respectfully submitted,

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