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In The
Supreme Court of the United States

BREWSTER KAHLE; INTERNET ARCHIVE;
RICHARD PRELINGER; and
PRELINGER ASSOCIATES, INC.,

Petitioners,

v.

ALBERTO R. GONZALES, Attorney General,
in his official capacity as Attorney
General of the United States,

Respondent.

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

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Do the “traditional contours of copyright protection” referred to in *Eldred, et al. v. Ashcroft*, 537 U.S. 186 (2003), extend beyond the two “traditional First Amendment safeguards” also identified in *Eldred*?
2. If so, is the change from an “opt-in” to an “opt-out” system of copyright a change in a “traditional contour of copyright protection” requiring “further First Amendment scrutiny” under *Eldred*?

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

In this case, Petitioners are Brewster Kahle, Internet Archive, Richard Prelinger, and Prelinger Associates, Inc. Petitioners certify that they do not have a parent corporation, nor does any publicly-held corporation own 10% or more of their stock. The sole Respondent in this matter is Alberto R. Gonzales, in his official capacity as Attorney General of the United States.

TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED	i
PARTIES TO THE PROCEEDINGS AND CORPORATE DISCLOSURE STATEMENT	ii
TABLE OF AUTHORITIES	iv
PETITION FOR A WRIT OF CERTIORARI	1
OPINIONS BELOW.....	1
JURISDICTION.....	1
CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED.....	2
STATEMENT OF THE CASE	2
REASONS FOR GRANTING THE WRIT.....	7
I. This Court Should Grant Certiorari To Resolve a Conflict Among Federal Courts About the Scope of Any Immunity for Copyright Acts Within the “Traditional Contours of Copyright Protection”	11
II. The Proper Application of the <i>Eldred</i> Rule Is Important for Guiding Congress In Its Adjust- ing of Copyright To Digital Technologies	14
III. The Ninth Circuit’s Application of <i>Eldred</i> Is Erroneous	16
IV. Petitioners Are Entitled To First Amendment Review of That Part of Congress’s Current Practice That Deviates from “The Traditional Contours of Copyright Protection”	19
CONCLUSION.....	20

TABLE OF AUTHORITIES

	Page
FEDERAL CASES	
<i>Eldred, et al. v. Ashcroft</i> , 537 U.S. 186 (2003).....	<i>passim</i>
<i>Eldred, et al. v. Reno</i> , 239 F.3d 372 (D.C. Cir. 2001)	4
<i>Golan v. Ashcroft</i> , 310 F. Supp. 2d 1215 (D. Colo. 2004)...	4, 14
<i>Luck's Music Library, Inc. v. Ashcroft</i> , 321 F. Supp. 2d 107 (D.D.C. 2004).....	3, 4, 12, 13
<i>Michael H. v. Gerald D.</i> , 491 U.S. 110 (1989).....	2
<i>Rutan, et al. v. Republican Party of Illinois, et al.</i> , 497 U.S. 62 (1990).....	2, 3, 12
<i>Sony v. Universal Studios</i> , 464 U.S. 417 (1984).....	14
<i>United States v. Virginia</i> , 518 U.S. 515 (1996).....	2
CONSTITUTION	
U.S. CONST., art. I, § 8	2
U.S. CONST., amend. I.....	<i>passim</i>
FEDERAL STATUTES	
28 U.S.C. § 1254(1)	1
28 U.S.C. § 1331.....	5
28 U.S.C. § 1361.....	5
28 U.S.C. § 2201.....	5
Act of Feb. 3, 1831.....	18, 19
Berne Convention Implementation Act of 1988	6
Copyright Act of 1976	6

TABLE OF AUTHORITIES – Continued

	Page
Copyright Renewal Act of 1992	6
Sonny Bono Copyright Term Extension Act of 1998	6, 19
 MISCELLANEOUS	
Daniel A. Farber, <i>Conflicting Visions and Contested Baselines: Intellectual Property and Free Speech in the Digital Age</i> , 89 MINN. L. REV. 1318 (2005).....	4, 5
Intellectual Property Enhanced Criminal Enforcement Act of 2007, H.R. 3155, 110th Cong. (1st Sess. 2007).....	16
WILLIAM M. LANDES & RICHARD A. POSNER, THE ECONOMIC STRUCTURE OF INTELLECTUAL PROP- ERTY LAW (Harvard Univ. Press 2003).....	8
R. Anthony Reese, <i>Innocent Infringement in U.S. Copyright Law: A History</i> , 30 COLUM. J.L. & ARTS 133 (2005).....	8
Christopher Sprigman, <i>Reform(aliz)ing Copyright</i> , 57 STAN. L. REV. 485 (2004)	8
Matt Williams, <i>Balancing Free Speech Interests: The Traditional Contours of Copyright Protection and The Visual Artists' Rights Act</i> , 13 UCLA ENT. L. REV. 105 (2005)	5
U.S. COPYRIGHT OFFICE, REPORT ON ORPHAN WORKS: A REPORT OF THE REGISTER OF COPY- RIGHTS (Jan. 2006).....	16

PETITION FOR A WRIT OF CERTIORARI

Petitioners Brewster Kahle, Internet Archive, Richard Prelinger, and Prelinger Associates, Inc., respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit in this case.

**OPINIONS BELOW**

The amended opinion of the United States Court of Appeals for the Ninth Circuit and order denying rehearing and rehearing *en banc* (App. 1a) is reported at 487 F.3d 697. The original opinion of the United States Court of Appeals for the Ninth Circuit (App. 9a) is reported at 474 F.3d 665. The order of the district court (App. 17a) is reported at 2004 WL 2663157.

**JURISDICTION**

The judgment of the United States Court of Appeals was issued on January 22, 2007, and the petition for rehearing and for rehearing *en banc* was denied on May 14, 2007. This Court has jurisdiction over this petition under 28 U.S.C. § 1254(1).



CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The Progress Clause confers upon Congress the power:

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

U.S. CONST., art. I, § 8, cl. 8.

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

The pertinent provisions of the copyright laws cited in this petition are reprinted in the appendix. (App. 52a-107a).

STATEMENT OF THE CASE

In *Eldred, et al. v. Ashcroft*, 537 U.S. 186 (2003), and for the first time in the history of the First Amendment, this Court adopted a standard for First Amendment review of copyright laws that explicitly linked heightened review to copyright law’s tradition. Following an approach similar to that suggested by Justice Scalia in the context of the Due Process Clause, *see, e.g., Michael H. v. Gerald D.*, 491 U.S. 110, 122 (1989), Equal Protection Clause, *see, e.g., United States v. Virginia*, 518 U.S. 515, 568 (1996) (Scalia, dissenting) and Free Speech Clause, *see, e.g., Rutan, et al. v. Republican Party of Illinois, et al.*, 497 U.S. 62, 95-96 (1990) (Scalia, dissenting), *Eldred* conditioned First Amendment review of a copyright statute upon

Congress's changing the "traditional contours of copyright protection."¹ *Eldred*, 537 U.S. at 221. When Congress enacts a copyright law that conforms to the "traditional contours of copyright protection, further First Amendment review is unnecessary." *Id.* But when a copyright law changes these "traditional contours of copyright protection," then "further First Amendment review" is required, as every court to consider the question has concluded. (App. 1a (Ninth Circuit opinion below) and 17a (District Court order below)). See also *Luck's Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107, 119 (D.D.C. 2004).

¹ As Justice Scalia described this approach in *Rutan*:

The provisions of the Bill of Rights were designed to restrain transient majorities from impairing long-recognized personal liberties. They did not create by implication novel individual rights overturning accepted political norms. Thus, when a practice not expressly prohibited by the text of the Bill of Rights bears the endorsement of a long tradition of open, widespread, and unchallenged use that dates back to the beginning of the Republic, we have no proper basis for striking it down. Such a venerable and accepted tradition is not to be laid on the examining table and scrutinized for its conformity to some abstract principle of First Amendment adjudication devised by this Court. To the contrary, such traditions are themselves the stuff out of which the Court's principles are to be formed. They are, in these uncertain areas, the very points of reference by which the legitimacy or illegitimacy of other practices are to be figured out. When it appears that the latest "rule," or "three-part test," or "balancing test" devised by the Court has placed us on a collision course with such a landmark practice, it is the former that must be recalculated by us, and not the latter that must be abandoned by our citizens. I know of no other way to formulate a constitutional jurisprudence that reflects, as it should, the principles adhered to, over time, by the American people, rather than those favored by the personal (and necessarily shifting) philosophical dispositions of a majority of this Court.

Rutan, 497 U.S. at 95-96 (footnote omitted).

The First Amendment question before the Court in *Eldred* was whether Congress was prohibited from extending the term of copyright for existing works. Applying the “traditional contours” test, the Court held that the term extension in issue in *Eldred* was immunized from First Amendment scrutiny based on Congress’s previous extensions of copyright terms. The Court was not presented with, and did not decide, the question of whether the change from an “opt-in” to an “opt-out” copyright regime was similarly immunized from First Amendment scrutiny.

Eldred was a critically important clarification by this Court of how copyright and the First Amendment interact. It explicitly rejected a statement by the D.C. Circuit that copyrights were “‘categorically immune from challenges under the First Amendment.’” *Eldred*, 537 U.S. at 221 (quoting *Eldred, et al. v. Reno*, 239 F.3d 372, 375 (D.C. Cir. 2001)). And as Professor Daniel Farber has described, the passage effecting this clarification “bears every sign of careful drafting.” Daniel A. Farber, *Conflicting Visions and Contested Baselines: Intellectual Property and Free Speech in the Digital Age*, 89 MINN. L. REV. 1318, 1349 (2005).

That care notwithstanding, however, there is growing conflict and confusion within the federal courts about the meaning of the phrase, “traditional contours of copyright protection.” *See infra*. That conflict and confusion will have increasing significance. The instant case is just the latest in a series of cases that have challenged innovations in Congress’s copyright policy. *See Luck’s Music Library*, 321 F. Supp. 2d at 119; *Golan v. Ashcroft*, 310 F. Supp. 2d 1215 (D. Colo. 2004) (appeal pending; argued June 8, 2006). Relying upon the standard articulated in *Eldred*, a number of commentators have suggested other aspects of current copyright law that are also constitutionally suspect. *See, e.g.*,

Matt Williams, *Balancing Free Speech Interests: The Traditional Contours of Copyright Protection and The Visual Artists' Rights Act*, 13 UCLA ENT. L. REV. 105 (2005) (arguing the Visual Artists' Rights Act changes "traditional contours of copyright protection"); Farber, *supra*, at 1349 (reviewing Digital Millennium Copyright Act). As Congress adapts copyright law to the digital age, it is critically important that it understand clearly the limits the First Amendment imposes upon its work. In light of the growing conflict and confusion in the federal courts, those lines however are not now clear. This Court should grant review to resolve this conflict in authority, and resolve the uncertainty about the standard it set in *Eldred*.

1. Petitioners provide free Internet archives of both cultural and scientific material. Petitioner Brewster Kahle founded the Internet Archive in 1996. Since then, the Archive has collected public domain, and freely licensed material that it has made available freely on its website. Petitioner Richard Prelinger founded the Prelinger Archives in 1983. These archives collect, among other things, "ephemeral" films, including advertising, educational, industrial, and amateur films. Prelinger Archives has made free digital versions of these films available through the Internet Archive. In addition, in cooperation with Getty Images, the Archive provides stock footage to the media and entertainment industries.

2. In March 2004, Petitioners filed an amended complaint seeking declaratory and injunctive relief in the United States District Court for Northern District of California. Jurisdiction was grounded in 28 U.S.C. §§ 1331, 1361 and 2201. The core of Petitioners' complaint asked the Court to find that in changing from an "opt-in"

(in which copyright is granted only to those to take affirmative steps to secure it) to an “opt-out” (in which copyright is automatic) system of copyright, Congress had changed the “traditional contours of copyright protection,” meriting, under the standard first set out in *Eldred*, “further First Amendment review.” In particular, Petitioners alleged that four statutes effected this change: (1) the Copyright Act of 1976, Publ. L. No. 94-553, 90 Stat. 2541, which abolished the registration, deposit and renewal requirements and extended copyright protection automatically to all eligible works; (2) the Berne Convention Implementation Act of 1988, Publ. L. No. 100-568, 102 Stat. 2853-2861, which eliminated the notice requirement; (3) the Copyright Renewal Act of 1992, Publ. L. No. 102-307, 106 Stat. 264, which automatically renewed all copyrights issued from 1964 through 1977; and (4) the Sonny Bono Copyright Term Extension Act of 1998, Publ. L. No. 105-298, 112 Stat. 2827-2828, which extended by 20 years the term of all existing copyrights. Petitioners challenged the effect of these changes on works fixed after December 31, 1963 and before January 1, 1978. (App. 5a).

3. The government moved to dismiss Petitioners’ complaint as failing to state a claim upon which relief might be granted. (App. 17a). In a memorandum opinion issued in November 2004, the District Court dismissed the complaint. The Court agreed with Petitioners that changes in the “traditional contours of copyright protection” merited “further First Amendment review.” (App. 48a-49a). But the lower court held that “mere formalities” could

never constitute “traditional contours of copyright protection.” (App. 50a).²

4. The Court of Appeals for the Ninth Circuit affirmed the judgment of the District Court. (App. 3a). Once again, the Court agreed with Petitioners that changes in the “traditional contours of copyright protection” “may trigger First Amendment review.” (App. 5a). But because *Eldred* had affirmed a statute that in part had the same effect as the changes challenged in the instant case – by “plac[ing] existing and future copyrights in parity” – the Court held that the changes Petitioners challenged were immune from scrutiny under the *Eldred* standard. (App. 5a-7a).

5. Petitioners filed for rehearing and rehearing *en banc*. (App. 2a). The panel voted to deny rehearing, and no judge voted to take the matter *en banc*. (App. 2a). The Court of Appeals, however, did issue an amended opinion that further clarified its holding. (App. 1a-8a).

◆

REASONS FOR GRANTING THE WRIT

This case involves a fundamental change in the tradition of American copyright law, and the standards for reviewing that change under the First Amendment. The change relates to how a copyright is secured and maintained under federal law; the First Amendment standard is the one first articulated in *Eldred*.

² The Court also rejected Petitioners’ claim that the effect of the change from opt-in to opt-out copyright was to render the copyright terms at issue no longer “limited.” Petitioners do not raise that question upon review. (App. 7a-8a).

For 186 years, federal copyright was an “opt-in” system: An author received the full benefit of copyright only if he took certain affirmative steps to claim that protection – including registering the work, depositing the work, marking the work, and renewing the copyright after an initial term. See R. Anthony Reese, *Innocent Infringement in U.S. Copyright Law: A History*, 30 COLUM. J.L. & ARTS 133, 135-46, 148-54 (2005); Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485, 491-93 (2004).

The effect of this traditional design was to radically narrow the regulation of copyright to those works whose authors might presumptively benefit from an exclusive right, leaving unregulated work that had no continuing commercial value tied to an exclusive right. According to one estimate, a majority of all published work during this “opt-in” period of copyright never received copyright at all, and the vast majority never renewed its copyright after an initial term. See Sprigman, *supra*, at 502-14, 519. See also WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 236 (Harvard Univ. Press 2003). As Judge Benjamin Kaplan described the system in 1958, “a very great amount of material published domestically and capable of copyright is not in fact published with notice and passes at once into the public domain without ever touching the Copyright Office.” Reese, *supra*, at 138.

Beginning in 1976, however, Congress has changed this tradition, shifting from an “opt-in” to an “opt-out” system of copyright regulation: Under this “opt-out” regime, an author receives the full protection of copyright automatically, whether or not he registers the work,

deposits the work, marks the work, and without any need to renew the copyright after an initial term.

The effect of this new design is to radically increase the scope and reach of copyright regulation, whether or not there is any commercial benefit from that regulation, and whether or not the author can even be identified. Copyright under the traditional system automatically narrowed its protection to works that could reasonably benefit from it; copyright under the current system is radically different, indiscriminately attaching its regulation without regard to whether it promotes commercial ends or stifles them. Whereas the traditional approach resulted in a rich public domain populated by new and old works alike, the current system of automatic protection destroys that tradition by putting all eligible works under protection for nearly a century or more.

Petitioners challenged this change in the tradition of copyright, relying upon the standard first specified by this Court in *Eldred* – arguing that a change from an opt-in to opt-out system was a change in a “traditional contour of copyright protection.” *Eldred*, 537 U.S. at 221. The government argued in response that *Eldred* limited First Amendment challenges of a copyright statute to the two “First Amendment safeguards” identified by the Court, *id.* at 220 – either a change in the “‘idea/expression’ dichotomy,” or in fair use. See Brief for the Appellee, *Kahle v. Gonzales*, No. 04-17434, 2005 WL 926823, at *31-32 (Mar. 10, 2005).

But while neither the district court nor the Ninth Circuit accepted the government’s broad reading of First Amendment immunity, both rejected Petitioners’ claim. Instead, applying a horseshoes theory of constitutional

review, the Ninth Circuit concluded that because the different changes challenged in *Eldred* would have a “similar” effect to the changes challenged here (App. 3a) the rule first articulated in *Eldred* need not be applied to the claims raised by Petitioners here. Petitioners, the Ninth Circuit wrote, were “mak[ing] essentially the same argument [as in *Eldred*], in different form.” (App. 6a-7a). *Eldred* thus “answer[ed]” Petitioners’ claims. (App. 5a).

The Ninth Circuit misreads both *Eldred* and this case. Petitioners’ challenge here is fundamentally different from the challenge raised in *Eldred*. In *Eldred*, Petitioners attacked the tradition of extending the terms of subsisting copyrights whenever copyright terms were extended prospectively. In this case, Petitioners are attacking something very different – an unprecedented change whereby copyrights are extended and maintained for every work eligible for copyright protection automatically, without regard for the need for protection, or whether the author of the work seeks or wants protection. No doubt both cases involve copyright and the First Amendment. But in this case, the First Amendment is invoked to test a change in the tradition of copyright legislation, applying the tradition-based test articulated in *Eldred*.

This misapplication of the *Eldred* rule, and the growing inconsistency among federal courts about its meaning, argues strongly for review by this Court to resolve apparent uncertainty about the scope of the tradition-based immunity granted in *Eldred*.

I. This Court Should Grant Certiorari To Resolve a Conflict Among Federal Courts About the Scope of Any Immunity for Copyright Acts Within the “Traditional Contours of Copyright Protection”

Eldred plainly grants Congress an immunity from First Amendment review for copyright acts within the “traditional contours of copyright protection.” But that immunity is limited, as is obvious from the context in which it was announced in *Eldred*.

Eldred was this Court’s first review of a free speech challenge to a copyright statute. The Court was presented with two very different standards under which to evaluate a First Amendment claim: Petitioners in *Eldred* had asked the Court to apply ordinary First Amendment review to what they argued was copyright’s “regulation of speech.” *Eldred*, 537 U.S. at 218-21. The government had asked the Court to affirm the decision by the Court of Appeals for the District of Columbia below, holding that copyright laws were “categorically immune from challenges under the First Amendment.” *Id.* at 221.

This Court declined both Petitioners’ and the government’s invitations. Instead, this Court crafted a First Amendment standard that sanctioned traditional practices, but left open challenges to changes in those practices. Heightened review is triggered by changes in “the traditional contours of copyright protection.” *Id.* Where there is no change to these “traditional contours of copyright protection, further First Amendment review is unnecessary.” *Id.*

The appeal of this tradition-based rule is obvious. As Justice Scalia has argued in other contexts, *see, e.g.*,

Rutan, 497 U.S. at 95-96 (Scalia, J., dissenting), where a practice is historically unchallenged and instead supported by long-standing practice, there is little reason for this Court to entertain now a newly discovered challenge. It is unlikely, to say the least, that modern litigants have discovered a constitutional flaw previously unnoticed – as this Court viewed the practice at issue in *Eldred* – for almost two centuries. Such practices, at least in the context of copyright legislation, this Court now deems constitutional. But when a practice is not supported by tradition, obviously no presumption of constitutionality should immunize it from ordinary First Amendment review – at least where the change significantly restricts free speech. Tradition, on this theory, settles constitutional questions within the scope of that tradition. But it cannot settle questions about practices without the tradition.

However sensible the tradition-based rule of *Eldred* may be, its scope is apparently obscure within the federal courts. Following the argument of the government, at least one court has concluded that the “traditional contours of copyright protection” refers exclusively to the two “First Amendment safeguards” identified by the *Eldred* opinion – the “idea/expression” dichotomy and fair use. Other courts have rejected this broad rule for First Amendment immunity.

In *Luck’s Music Library*, 321 F. Supp. 2d at 119, for example, the court was presented with a First Amendment challenge (among others) to a law that removed works from the public domain. The government argued the only grounds for a First Amendment challenge under *Eldred* were changes in either the “idea/expression dichotomy” or fair use. The court agreed. As the district court wrote:

When Congress “has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.”

In the instant case, Congress has not altered the traditional contours of copyright protection by enacting Section 514. *See generally* 17 U.S.C. § 104A. Section 514 does not alter First Amendment accommodations such as the idea/expression dichotomy or the fair-use doctrine. . . . Given that Section 514 does not encroach on the traditional copyright protections and includes additional protections, further scrutiny under the First Amendment is unnecessary.

Luck’s Music Library, 321 F. Supp. 2d at 118-19 (quoting *Eldred*, 537 U.S. at 219-21) (footnote omitted).

In the instant case, however, both the district court and Court of Appeals apparently rejected the government’s interpretation of *Eldred*. As the district court wrote, and contrary to the government’s claim, “[t]he Supreme Court has not identified the entire universe of protections that it considers to be within such ‘traditional contours.’” (App. 49a). Likewise, the Ninth Circuit also did not rely upon the narrow reading of “traditional contours of copyright protection” advanced by the government to reject Petitioners’ claim. (App. 6a-7a). The ground actually relied upon by the Ninth Circuit (discussed below) was neither briefed nor argued before that court.

Thus, at least three courts from two circuits are conflicted about the meaning of the tradition-based immunity granted in *Eldred*. Meanwhile, the Tenth Circuit is also presently considering a claim related to *Luck’s Music Library* in which the government has again maintained that the only changes to copyright law that merit First

Amendment review are changes in the “idea/expression dichotomy” and fair use. *See Golan*, 310 F. Supp. 2d at 1215 (appeal pending; argued June 8, 2006).³

Perceived uncertainty regarding the scope of this Court’s rule has thus slowed resolution of cases raising important questions about changes in the scope of copyright law affected by Congress. This uncertainty is an important ground for granting review.

II. The Proper Application of the *Eldred* Rule Is Important for Guiding Congress In Its Adjusting of Copyright To Digital Technologies

The rule announced in *Eldred* is not an insignificant detail in copyright law. As changing technologies alter the way copyright law regulates, Congress will repeatedly be called upon to rebalance the interests that copyright law affects. *See Sony v. Universal Studios*, 464 U.S. 417, 429 (1984). In the process of these adjustments, Congress is of course free to change copyright law. It is even free to change the “traditional contours of copyright protection.” But the critical question presented by this case is what constitutional standard limits Congress in this process of updating or changing the contours of copyright protection. Is Congress free of the First Amendment so long as it doesn’t change the “idea/expression dichotomy” or fair use? Or are there other “traditional contours of copyright protection” that also constrain its innovations?

³ For this reason, Petitioners would suggest this Court at least hold consideration of this Petition until the Tenth Circuit rules.

For example, copyright law has traditionally been viewpoint neutral. Imagine the European Union decided to deny copyright protection to “hate speech,” and Congress, in an effort to “harmonize” international copyright law, did the same. Would that law be subject to First Amendment review?

On Petitioners’ reading of *Eldred*, the answer is obviously yes. This change in a “traditional contour of copyright protection” – viewpoint neutrality – would subject the law changing that contour to ordinary First Amendment review.

On the view that has been advanced by the government, however, the only changes in the “traditional contours of copyright protection” that would merit First Amendment review would be changes in the two “First Amendment safeguards” identified by this Court in *Eldred*: namely, changes in fair use, or the “idea/expression dichotomy.” *Eldred*, 537 U.S. at 219-20. As the government argued below, it is these safeguards alone that define the traditional contours of copyright protection for purposes of the First Amendment. *See* Brief for the Appellee, *Kahle v. Gonzales*, No. 04-17434, 2005 WL 926823, at *31-32 (Mar. 10, 2005). Thus under this view, a change in the traditional viewpoint neutrality of copyright law would not be subject to First Amendment review.

To avoid this absurd result, the government modified its position below to suggest the *Eldred* rule applies only to content neutral copyright regulation. *See id.* at *36-37. But that gloss on *Eldred* has no basis in the Court’s opinion, and the apparent need to gloss the *Eldred* rule only reinforces Petitioners’ argument that there is important uncertainty about its holding. The government also

modified its position to suggest that the traditional First Amendment safeguards “largely, if not exclusively” determined when First Amendment review was required. *See id.* at *31-32. The government has not described, however, the line defining “largely.” These qualifications demonstrate the uncertainty the government has helped generate around the meaning and scope of the *Eldred* decision.

Given this uncertainty, it is extremely important that this Court clarify the role of the First Amendment in framing the scope of copyright legislation. If Congress believes, as the government has maintained, that the only place it need consider the First Amendment is when changing “fair use” or the idea/expression distinction, then fundamental constitutional values will be ignored as Congress updates copyright law to better fit the digital age. As Congress, for example, considers “Orphan Works” reform, *see* U.S. COPYRIGHT OFFICE, REPORT ON ORPHAN WORKS: A REPORT OF THE REGISTER OF COPYRIGHTS (Jan. 2006), or changes to the Digital Millennium Copyright Act, *see* Intellectual Property Enhanced Criminal Enforcement Act of 2007, H.R. 3155, 110th Cong. (1st Sess. 2007), the scope of First Amendment values will be critical. Thus again, clarifying the perceived ambiguity in *Eldred* would significantly aid Congress as it legislates.

III. The Ninth Circuit’s Application of *Eldred* Is Erroneous

This uncertainty about the scope of the tradition-based immunity in *Eldred* notwithstanding, Petitioners nonetheless urge the Court to grant review for the purpose of instructing the Ninth Circuit to correct an obvious

mistake in its application of *Eldred*, and to evaluate Petitioners' challenge under the *Eldred* standard.

Because *Eldred* established a tradition-based rule for determining whether a copyright statute is subject to First Amendment review, the obvious first question any court presented with a First Amendment challenge to a copyright act must address is whether the act deviates from the "traditional contours of copyright protection." The Ninth Circuit in this case refused even this first step. It did not consider whether the change from an opt-in to an opt-out regime was change in a "traditional contours of copyright protection." Instead, the Court dismissed Petitioners' claim because it believed this Court's decision in *Eldred* "in effect" answered Petitioners' claim. (App. 5a). As the Court wrote:

The [Eldred] Court observed that when Congress passed the CTEA, it 'placed existing and future copyrights in parity. . . .' Thus, extending existing copyrights to achieve parity with future copyrights does not require further First Amendment scrutiny.

(App 5a-6a).

The *Eldred* Court, however, did *not* hold that Congress got immunity from First Amendment review whenever (and however) it "placed existing and future copyrights in parity." (App. 6a). Instead, the Court granted Congress immunity when Congress legislates consistent with the "traditional contours of copyright protection." As applied to the claims in *Eldred*, this Court believed Congress was legislating consistent with tradition, because this Court believed that every time Congress had extended the terms of copyrights prospectively, it granted the

benefit of that extension to all existing copyrights.⁴ It was *consistency with tradition* that justified the immunity, not the *consistency of existing and future copyrights*. Or put differently, this Court did not say *because* the copyrights are placed in parity, “further review is unnecessary.” It said *because* Congress hadn’t changed “the traditional contours of copyright, further First Amendment review is unnecessary.” What mattered to this Court was copyright law’s tradition; what triggers First Amendment review on this standard is a change in that tradition.

It was thus plain error for the Court, after rejecting the government’s broad reading of immunity, not then to consider whether the change to an opt-out system was a change in a traditional contour of copyright. Petitioners would ask this Court to remand the case with instructions that the Court at least consider this obvious and necessary first step.

Such a review, Petitioners believe, would plainly demonstrate that Congress has changed copyright law’s tradition. But Petitioners were denied the opportunity to present any evidence on this issue. Instead, the case was dismissed at the pleading stage, before any evidentiary showing could be made, or any proof introduced. (App. 17a). Accordingly, this Court should at the very least vacate the Ninth Circuit’s decision and remand the case for a consideration of the *Eldred* test upon a proper record.

⁴ This in fact is not correct. When Congress extended the term of copyrights in 1831, it granted the benefit of that extension to works in their initial term. Works in the renewal term did not get the benefit of the extension. See Act of Feb. 3, 1831, ch. 16, §§ 1, 16, 4 Stat. 436, 439.

IV. Petitioners Are Entitled To First Amendment Review of That Part of Congress’s Current Practice That Deviates from “The Traditional Contours of Copyright Protection”

Eldred justified both its Progress Clause and First Amendment conclusions on the grounds of Congress’s actual practice. This Court concluded that Congress had always granted the benefit of an extended term to existing copyright holders. In upholding the Sonny Bono Copyright Term Extension Act (“CTEA”), it believed it was simply affirming a practice that reached back to the Framers.

But in fact, Congress has not historically granted the benefit of an extended term to all existing copyright holders. The Act of 1831, for example, did not grant the benefit of an extended term to copyrights in their renewal term. Act of Feb. 3, 1831, ch. 16, §§ 1, 16, 4 Stat. 436, 439. More importantly, the benefits of every extension before the CTEA were not automatically granted to anyone. Under the traditional regime, in order to secure the benefit of the extended term, copyright holders had to take affirmative steps to claim the benefit of original or additional federal protection. Indeed, until the CTEA, Congress had never granted an automatic extension of term for copyrights that had not, or would not, pass through a filter of formalities. Before the CTEA, every extension was limited to those copyright holders who took affirmative steps to claim the benefits of copyright protection.

This history reflects the true nature of the “traditional contours of copyright protection” in America. Until very recently, the opt-in system assured that copyright law would narrow its reach automatically, by requiring affirmative steps to secure or maintain a copyright. That tradition thus narrowed – automatically – the burden of

copyright. Congress has now changed this traditional nature of copyright law, with profound free speech consequences as the tools for creative and spreading speech – digital technologies – spread. Petitioners thus ask this Court to grant review to permit First Amendment review of that part of Congress’s current practice that deviates fundamentally from the “traditional contours of copyright protection.”

◆

CONCLUSION

For the reasons articulated, this Court should grant certiorari in this case, and reverse the decision of the Ninth Circuit, finding the change from an opt-in to an opt-out copyright regime is a change in a “traditional contour of copyright protection,” meriting ordinary First Amendment review. Alternatively, this Court should grant review, and vacate the judgment of the Ninth Circuit, remanding for a determination of whether the change from an opt-in to an opt-out copyright regime is a change in a “traditional contour of copyright protection,” meriting ordinary First Amendment review.

Respectfully submitted,

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