The Trouble with Traditions: The Split over *Eldred*'s Traditional Contours Guidelines, How They Might Be Applied, and Why They Ultimately Fail

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I. INTRODUCTION

With the enactment of the Sonny Bono Copyright Term Extension Act (CTEA) in 1998, a new era of constitutional challenges to copyright law began.[1] These challenges, spearheaded by Professor Lawrence Lessig, began with *Eldred v. Ashcroft* and have progressed through *Luck's Music Library, Inc. v. Gonzales*, *Kahle v. Gonzales*, and ultimately *Golan v. Gonzales*.[2] These suits have, inter alia, challenged the

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1. Marybeth Peters, *Constitutional Challenges to Copyright Law*, 30 COLUM. J.L. & ARTS 509, 509-10 (2007).

2. *See* Eldred v. Ashcroft, 537 U.S. 186 (2003); Golan v. Gonzales, 501 F.3d 1179 (10th Cir. 2007); Kahle v. Gonzales, 487 F.3d 697 (9th Cir. 2006); Luck's Music Library, Inc. v.

constitutionality of the CTEA and the Uruguay Round Agreements Act (URAA). Mostly, the challenges have failed, in line with the idea "that the Copyright Clause gives Congress the power to enact bad copyright legislation."[3] However, one case, *Golan v. Gonzales*, proved at least partially successful, creating a circuit split in the interpretation of *Eldred*'s "traditional contours" language.[4] This Comment will discuss present and future applications of *Eldred*'s guidelines for First Amendment review as well as why these guidelines ultimately fail.

II. BACKGROUND

In *Eldred v. Ashcroft*, Professor Lawrence Lessig argued that the CTEA violated both the "limited Times" language of the Copyright Clause as well as the First Amendment.[5] The Court held constitutional a retroactive twenty-year copyright term increase, reasoning that a duration increase is constitutional as long as it is not infinite.[6] Furthermore, the Court restated that laws enacted under the Copyright Clause normally will only be subject to rational basis review.[7]

The First Amendment challenge to the CTEA failed as well.[8] While extending the duration of copyright "may indeed restrict certain speech", the Court held that this restriction does not violate the First Amendment.[9] The Court noted that the Copyright Clause and the First Amendment were enacted close in time, a factor that weighs heavily in favor of the idea that copyright laws are generally compatible with the First Amendment.[10] Furthermore, the Court restated the idea from *Harper & Row, Publishers, Inc. v. Nation Enterprises*, that copyright itself is the "engine of free expression."[11] Moreover, the Court reasoned that the idea/expression dichotomy and fair use doctrine are generally adequate to address First Amendment concerns.[12] However, the Court noted that

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

3. Peters, *supra* note 1, at 518.

4. *See Golan*, 501 F.3d at 1179.

5. *Eldred*, 537 U.S. at 186.

6. *See id.* at 199. The essence of the failed argument was that "limited" equals "inalterable."

7. *Id.* at 212-13.

8. *Id.* at 221.

9. *See id.*

10. *Id.* at 219.

11. *Id.* (citing Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 558 (1985) (Brennan, J., concurring)). Copyright provides an incentive to publish, encouraging an open marketplace of ideas.

12. *Id.* at 221.

copyright laws are not "categorically immune from challenges under the First Amendment."[13] In giving guidance on the intersection of copyright and the First Amendment, the Court stated that First Amendment scrutiny is unnecessary when "Congress has not altered the traditional contours of copyright protection."[14] There have been potentially inconsistent applications of this language, and that is the focus of the next section of this Comment.

III. THE CIRCUIT SPLIT

In three cases since *Eldred*, plaintiffs have brought up the First Amendment "traditional contours" argument: *Luck's Music Library*, *Kahle*, and *Golan*. In all three cases, the plaintiffs argued that laws had changed the traditional contours of copyright and should be subject to heightened review, while the government argued that the "traditional contours" should be strictly limited to the idea/expression dichotomy and fair use doctrine.[15] First, the United States District Court for the District of Columbia heard *Luck's Music*, in which plaintiffs argued that the URAA's copyright restoration provisions violated the First Amendment.[16] In *Luck's Music*, the district court held the URAA not to violate the First Amendment because it "does not alter First Amendment accommodations such as the idea/expression dichotomy or the fair use doctrine."[17] Furthermore, the district court found that there exists a history of granting copyright to works in the public domain.[18] On appeal, the United States Court of Appeals for the District of Columbia Circuit upheld the decision of the district court, reasoning that there is no distinction between the copyright term extension upheld in *Eldred* and "extending protection to material that has fallen into the public domain."[19]

Next, the United States Court of Appeals for the Ninth Circuit heard *Kahle*, in which plaintiffs put forth the argument that the Copyright Renewal Act of 1992 (CRA) altered the "traditional contours of

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13. *Id.*

14. *Id.*

15. *See* Lessig Blog, http://lessig.org/blog/2008/01/on_the_continuing_question_of.html (Jan. 7, 2008 17:15 PST).

16. Luck's Music Library, Inc. v. Gonzales, 407 F.3d 1262 (D.C. Cir. 2005), *aff'g* Luck's Music Library, Inc. v. Ashcroft, 321 F. Supp. 2d 107 (D.D.C. 2004).

17. Luck's Music Library, Inc. v. Ashcroft, 312 F. Supp. 2d 107, 119 (D.D.C. 2004). The First Amendment challenge was not raised in the appeal, nor was the issue directly discussed in the appellate opinion.

18. *Id.* at 113-16.

19. *Luck's Music Library, Inc.*, 407 F.3d at 1265.

copyright" by removing the renewal requirement on works created between 1964 and 1977.[20] The removal of the renewal requirement changed the copyright system from an "opt-in" to an "opt-out" system.[21] Here, the Ninth Circuit rejected the argument that this change should invoke further First Amendment review.[22] In line with *Eldred*, they noted that "extending existing copyrights to achieve parity with future copyrights does not require further First Amendment scrutiny."[23] Moreover, they held that removal of the renewal requirement, rather than a change in a traditional contour, was effectively the same as a term extension and was therefore constitutional as a *direct application* of *Eldred*.[24] Although the government prevailed in *Kahle*, the Ninth Circuit's opinion does not necessarily endorse the argument that the "traditional contours" are limited to the idea/expression dichotomy and fair use doctrine.

Finally, the United States Court of Appeals for the Tenth Circuit heard *Golan v. Gonzales*, in which plaintiffs challenged the URAA.[25] In *Golan*, the plaintiffs put forth the First Amendment argument, similar to that in *Kahle* and virtually identical to that in *Luck's Music*, that a law should be subject to First Amendment review because it altered the traditional contours of copyright protection.[26] Agreeing with both the *historical* and *functional* arguments of the plaintiffs, the Tenth Circuit held that the URAA should be subject to heightened First Amendment review.[27] They reasoned that there exists no historical tradition of giving copyright to works in the public domain and that functionally, the "copyright sequence" involves works being created, then being protected for a limited term, and eventually falling into the public domain.[28]

While the courts in *Luck's Music*, *Kahle*, and *Golan* all considered the "traditional contours" argument established by *Eldred*, each court reached a different outcome. It has been suggested that this has created a

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20. Kahle v. Gonzales, 487 F.3d 697, 699 (9th Cir. 2006). Luminary Lectures, Brewston Kahle, About the Speaker (Apr. 21, 2004), http://www.loc.gov/rr/program/lectures/kahle.html.

21. *See, e.g.*, Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485, 487-91 (2004).

22. *Kahle*, 487 F.3d at 700 (2004).

23. *Id.*

24. *Id.*

25. Golan v. Gonzales, 501 F.3d 1179, 1182 (10th Cir. 2007). Plaintiffs also challenged the CTEA and URAA as improper exercises of the Copyright Clause. *See generally* J. Matthew Miller, III, Note, Golan v. Gonzales*: How Copyright Restoration Alters the Ordinary Copyright Sequence and Invites First Amendment Review*, 10 TUL. J. TECH. & INTELL. PROP. 353 (2007).

26. *Golan*, 501 F.3d at 1182-85.

27. *See id.* at 1189-93.

28. *See id.* at 1189-91.

circuit split regarding how and when to apply First Amendment review to copyright laws.[29] This inconsistent outcome deserves further analysis.

Fundamentally, the plaintiffs have lost where the courts have either limited the traditional contours argument or have viewed the "contour change" in question as being functionally equivalent to the term extension in *Eldred*. The government has consistently argued to limit the traditional contours to fair use and the idea/expression dichotomy.[30] However, language supporting the government's position has only appeared in the opinion of the district court in *Luck's Music*.[31] Not relying on this argument, both the District of Columbia Circuit and the Ninth Circuit found in favor of the government, reasoning that the challenged laws were equivalent to a term extension and therefore fit directly into *Eldred*.[32]

Therefore, it is possible to reconcile *Kahle* and *Golan* in that removing the renewal requirement for certain works that have not yet passed into the public domain can be viewed as a term extension not requiring further scrutiny. In other words, *Kahle* fits into tradition and is consistent with *Eldred* in that whatever the traditional contours are and however they are to be applied, they are not altered to the extent of needing First Amendment review when Congress extends the duration of copyright.[33] Therefore, if removal of renewal requirements can be seen as effectively extending the duration of copyright, then *Eldred* cannot be applied successfully to challenge the CRA. More abstractly, if *Eldred* stands for the proposition that the setback of a future interest[34] in another's speech does not implicate the First Amendment, then *Kahle* and *Golan* are compatible.

The more significant disagreement is between *Luck's Music* and *Golan*, as both cases challenged the copyright restoration provisions of the URAA. On one hand, in *Luck's Music*, the District of Columbia held

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29. *See* Lessig Blog, *supra* note 15.

30. *See* Luck's Music Library, Inc. v. Ashcroft, 321 F. Supp. 2d 107, 118 (D.D.C. 2004); Brief for the Appellee at 29, Kahle v. Gonzales, 487 F.3d 697 (9th Cir. 2006) (No. 04-17434). The government later limited this argument as only applying to content neutral laws. *See* Appellants' Amended Opening Brief at 40, *Kahle*, 487 F.3d 697 (No. 04-17434).

31. *Cf.* 321 F. Supp. 2d at 118-19.

32. *See Kahle*, 487 F.3d at 699-700 (stating that the First Amendment arguments against the change from an opt-in system to an opt-out system were essentially the same as those made in *Eldred*); Luck's Music Library, Inc., 407 F.3d 1262, 1281, *aff'g*, Luck's Music Library, Inc. v. Ashcroft, 321 F. Supp. 2d 107 (D.D.C. 2004) (stating that plaintiffs did not distinguish increasing the term from protecting material in the public domain).

33. *See* Eldred v. Ashcroft, 537 U.S. 186 (2003).

34. In a sense, the public has a future interest in all works in the public domain. Constitutionally, everything will eventually go there. It is just a matter of time, and pushing that time back is one thing that we are certain the Supreme Court thought was acceptable.

that copyright restoration is not substantively different than term extension.[35] On the other hand, the Tenth Circuit, in *Golan*, held the exact opposite.[36] The difference between the two opinions lies in whether a court sees granting copyright to works in the public domain as a traditional practice dating back to the origins of copyright in the United States, or as a fundamental violation of the copyright sequence only practiced in a few isolated cases.[37] The disagreement could also be reduced to the amount of weight each court gave to the few historical examples of copyright restoration.[38] Alternatively, the courts may disagree generally about application of the traditional contours analysis. Whatever their disagreement, the goal of the legal system should be a consistent application of the law.[39] In order to consistently apply the law, there must be an understanding of the law. Therefore, a look back at *Eldred* may prove useful.

IV. WHAT DID THE *ELDRED* COURT MEAN?

Eldred, at the very least, stands for the proposition that copyright laws can be subject to First Amendment review. But, when is this

35. *See Luck's Music Library, Inc.*, 407 F.3d at 1265.

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

37. Three examples are considered: The original statutory grant of copyright from the Copyright Act of 1790, which may or may not have granted copyright to existing public domain works, copyright restoration resulting from the 1919 Amendment to the Copyright Act of 1909, and copyright restoration resulting from the Emergency Copyright Act of 1941. Emergency Copyright Act of 1941, ch. 421, 55 Stat. 732 (1941); Act of Dec. 18, 1919, ch. 11, 41 Stat. 368 (1919); Copyright Act of 1790, 1 Stat. 124 (1790). The courts have disagreed whether these are isolated incidents or form a historical tradition. *See generally* Wheaton v. Peters, 33 U.S. (8 Pet.) 591 (1834) (discussing whether the 1790 Act established new rights or merely codified preexisting rights); Second Corrected Brief for Appellants, at 30-37, *Luck's Music Library, Inc.*, 407 F.3d 1262 (No. 04-5240). Both the 1919 and the 1941 laws extended the time to comply with formalities. One difference between these examples and the URAA is that the latter reaches back in time further, allowing more time for parties to expect their First Amendment rights to speak that which is in the public domain.

38. Arguably, these examples did not remove works from the public domain. *See* Second Corrected Brief for Appellants, at 30-37, *Luck's Music Library, Inc.*, 407 F.3d at 1262 (No. 04-17434) (arguing that the 1790 Act recognized common law copyright, that the 1919 Amendment gave authors additional time to secure copyright in their *unpublished* works, and that the 1941 Act lacks the language and the legislative history to be said to remove works from the public domain); Donaldson v. Becket, 98 Eng. Rep. 257, 258-62 (1774) (holding that a common law copyright existed in published works); THE FEDERALIST No. 43, at 338 (James Madison) (Clinton Rossiter ed., 1961) (noting that the Founders recognized common law copyright); Heim v. Universal Pictures Co., 154 F.2d 480, 486-87 (2d Cir. 1946) (holding that publication abroad does not put a work into the public domain).

39. *See, e.g.*, Perkin-Elmer Corp. v. Westinghouse Elec. Corp., 822 F.2d 1528 (Fed. Cir. 1987) (Newman, J., dissenting). "Failure of this court to reach consistent decisions based on a consistent application of precedent will be as destructive of the purposes of a patent system as was the forum-shopping and inconsistent judgments of the past." *Id.* at 1543-44.

appropriate? The text of the opinion gives two statements regarding this question. First, the Court stated that because "[t]he Copyright Clause and First Amendment were adopted close in time . . . copyright's built-in free speech safeguards are generally adequate."[40] Second, they held that "when . . . Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary."[41] The Court looks to tradition because of the historical coexistence of copyright and the First Amendment.[42] Under this thesis, the Court has merely exempted from review copyright traditions which have been vetted by history and has not required, as a prerequisite for invoking review, a change in either the idea/expression dichotomy or fair use. Furthermore, the Court only said that these two safeguards are "generally adequate," not that they are *always* adequate. This implies that fair use and the idea/expression dichotomy are in *some* cases inadequate and that First Amendment review may be necessary when neither of these two concepts have been altered. Next, the Court's traditional contours language may be confused with its inverse.[43] Just because First Amendment review is not necessary when a traditional contour has not been changed does not imply that when a traditional contour *has* been changed that review *is* necessary. Therefore, the logical application of these rules is that plaintiffs seeking First Amendment review of copyright laws must prove, at the very least, that a traditional contour *has* been altered *and* that the idea/expression dichotomy and fair use doctrine do not adequately address First Amendment concerns.[44]

This leaves the question, "What exactly is a *traditional contour*?"[45] If First Amendment review is unnecessary when there has been no change of a traditional contour, but the idea/expression dichotomy and fair use doctrine are not always adequate protection, then traditional contours logically cannot be limited to these two concepts. Consider the possibility that a law could keep these two protections intact yet have serious First Amendment problems. One such example might be a

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40. Eldred v. Ashcroft, 537 U.S. 186, 219-21 (2003).

41. *Id.* at 221.

42. The word "tradition" is used two contexts: "traditional First Amendment safeguards" and "traditional contours of copyright protection." *See id.*; Appellants' Amended Opening Brief at 37, Kahle v. Gonzales, 487 F.3d 697 (9th Cir. 2006) (No. 04-17434).

43. The truth of "If P then Q" does not imply the truth of its inverse: "If not P then not Q." *See generally* HARRY GENSLER, INTRODUCTION TO LOGIC 35 (2002); OLIVER WENDELL HOLMES, THE COMMON LAW (1881). *But see* 2 WILLIAM PATRY, PATRY ON COPYRIGHT § 4:22 (2006) (arguing that the law does not follow formal logic).

44. *See Eldred*, 537 U.S. at 221.

45. As noted by Justice Breyer in his dissent in *Eldred*, "the sentence points to the question, rather than the answer." *Id.* at 264 (Breyer, J., dissenting).

viewpoint-based copyright regulation: the denial of copyright protection to hate speech. It would certainly be twisted logic to think that the Court in *Eldred* intended First Amendment review to be unnecessary in such a case.[46]

The Court gave examples of where traditional contours have and have not been altered. Footnote twenty-four cites *Harper & Row, Publishers, Inc. v. Nation Enterprises* as an example of where further scrutiny is unnecessary.[47] Then, in the same footnote, the reader is instructed to compare this example with *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, which involved trademark, not copyright.[48] Because this footnote represents possibly the best indication of their intent regarding traditional contours, further discussion of *San Francisco Arts* is warranted.

In this case, the Court upheld a statute that altered traditional trademark rights by giving additional trademark protection to the United States Olympic Commission on use of the word "Olympic." However, the Court subjected the statute in question to First Amendment review.[49] In other words, the Court required normally unnecessary First Amendment scrutiny where a statute gave a party additional rights in certain speech. Good analogies of *San Francisco Arts* to copyright law are both a copyright grant for a work not consisting of statutory subject matter and additional rights granted to specific works.[50] If *San Francisco Arts* serves as a guide, then one "traditional contour" could be the equal application of law copyrightable works. In other words, whatever the copyright laws, they are to be the same for all works of the same type. Examples of violations of this principle would include the grant of a copyright or a duration extension to a limited number of works, most likely without the aid of a set of rules for such grants. Another

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46. "Viewpoint discrimination is thus an egregious form of content discrimination. The government must abstain from regulating speech when the specific motivating ideology or the opinion or perspective of the speaker is the rationale for the restriction." Rosenberger v. Rector & Visitors of Univ. of Va., 515 U.S. 819, 829 (1995) (citing Perry Ed. Ass'n v. Perry Local Educators' Ass'n, 460 U.S. 37, 46 (1983)).

47. *See Eldred*, 537 U.S. at 221 n.24.

48. *See id.*

49. *See* S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm., 483 U.S. 522 (1987) (preventing the defendants from using the trademark "Olympic" to identify their "gay Olympic games"). The Court stated that "[e]ven though this protection may exceed the traditional rights of a trademark owner in certain circumstances, the application of the Act to this commercial speech is not broader than necessary to protect the legitimate congressional interest and therefore does not violate the First Amendment." *Id.* at 540.

50. Examples include copyright granted by statute to a single work not meeting the fixation requirement, a sweat of the brow copyright grant to a single work, or a grant of a public performance right to a specific sound recording.

interpretation is that "traditional contours of copyright" modifies "protection." In other words, the Court may have been talking about the traditional protections, or exclusive rights, granted by copyright.[51]

Although looking at *San Francisco Arts* may be helpful, the Court did not provide the clarity needed to escape debate. Therefore, it is unclear exactly where the traditional contours lie, except that the Court most likely envisioned the contours as being more than *only* the idea/expression dichotomy and fair use doctrine.

In summary, it is difficult to distill a true test from *Eldred* for when to apply First Amendment review of copyright laws. However, to invoke the First Amendment, a law must at least change something traditional and must not be saved by either the idea/expression dichotomy or fair use doctrine.[52] Beyond that, little instruction is given, and all that is certain is that copyright duration extension alone is not a change of a traditional contour.

V. APPLYING *ELDRED* TO POTENTIAL CONTOUR CHANGES

Traditional contours defy exact definition because "tradition" changes depending on the time frame examined. The potentially relevant time frames include (1) copyright from its English common law beginnings, (2) copyright in the entirety of U.S. history, and (3) copyright only in more recent history. However, regardless of the time frame used, one thing is clear—copyright law has evolved. For this reason, in certain cases, change *itself* can be seen as a tradition.[53] Overall, there are many traditional aspects of copyright law, but only some of them prove interesting for discussion. Therefore, the rest of this section looks at only a few traditions of copyright, examining them in light of *Eldred*, *Golan*, *Kahle*, and *Luck's Music*.

A. Sweat of the Brow as a Traditional Contour?

One of the traditions of U.S. copyright law is that one's labor does not justify the grant of a copyright. Rather, the United States justifies

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51. *See, e.g.*, *S.F. Arts & Athletics*, 483 U.S. 522.

52. *Eldred*, *Kahle*, and *Golan* all discussed provisions of the law in question which might provide further First Amendment safeguards. When a court evaluates a law to determine whether First Amendment scrutiny is necessary, requiring a First Amendment analysis of provisions in that law seems to put the cart before the horse. Therefore, it seems prudent that such provisions should not be considered when deciding whether a law should be given First Amendment scrutiny, although they may ultimately save that law. It is for this reason that these "extra safeguards" are largely ignored in this Part.

53. For example, the Court in *Eldred* considered Congress to have acted consistently with tradition when enacting a duration increase. *See Eldred*, 537 U.S. 186.

copyright on utilitarian grounds—"To promote the Progress of Science."[54] This tradition is the subject of debate, especially around the issue of the protection of compilations.[55] Compilations have been protected in one fashion or another since the Copyright Act of 1790.[56] However, both the level of protection and the justification for that protection have changed over time.[57] For a time, compilations were protected either because they required investment to produce (sweat of the brow) or on the basis of their originality.[58] However, the Supreme Court repudiated the "sweat of the brow" doctrine in *Feist Publications, Inc. v. Rural Telephone Service Co.*[59] There, the court relied on tradition to reject the idea that hard work deserves protection.[60]

Another tradition of copyright laws is that they have traditionally bent against international pressures. For example, in several instances, the United States has enacted copyright laws in order to achieve protection for domestic works abroad. Congress has increased the copyright term to prevent penalization of U.S. authors in Europe by application of the rule of the shorter term.[61] Additionally, Congress

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54. U.S. CONST. art. I, § 8, cl. 8; *see* Sprigman, *supra* note 21, at 523 n.138 (discussing Thomas Jefferson's justifications for copyright).

55. *See generally* David O. Carson, Statement Before the Subcommittee on Courts, the Internet, and Intellectual Property Committee on the Judiciary and the Subcommittee on Commerce, Trade and Consumer Protection Committee on Energy and Commerce (Sept. 23, 2003), http://www.copyright.gov/docs/regstat092303.html.

56. Copyright Act of 1790, 1 Stat. 124 (1790).

57. *See* Carson, *supra* note 55.

58. *See id.* Courts had consistently ruled telephone directories to be copyrightable. *See* Hutchinson Tel. Co. v. Fronteer Directory Co., 770 F.2d 128 (8th Cir. 1985); S. Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers, 756 F.2d 801 (11th Cir. 1985); Leon v. Pac. Tel. & Tel. Co., 91 F.2d 484 (9th Cir. 1937); Cent. Tel. Co. of Va. v. Johnson Publ'g Co., 526 F. Supp. 838 (D. Colo. 1981); Sw. Bell Tel. Co. v. Nationwide Indep. Directory Serv., Inc., 371 F. Supp. 900 (W.D. Ark. 1974); S. Bell Tel. & Tel. Co. v. Donnelly, 35 F. Supp. 425 (S.D. Fla. 1940); Cincinnati & Suburban Bell Tel. Co. v. Brown, 44 F.2d 631 (S.D. Ohio 1930); Hartford Printing Co. v. Hartford Directory & Publ'g Co., 146 F. 332 (D. Conn. 1906).

59. *See* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991) (holding a telephone directory not to be original). The Court held that originality is a constitutional requirement and that facts cannot be original. *See id.* at 346. However, in an unreported decision, the Tenth Circuit held the directory in *Feist* to have a valid copyright. *See* Rural Tel. Serv. Co. v. Feist Publ'ns, 916 F.2d 718 (10th Cir. 1990), *overruled by* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991).

60. *See Feist*, 499 U.S. at 363.

61. The "rule of the shorter term" allows member states of the European Union to shorten the domestic copyright term of foreign works to the duration the foreign country provides member states' works. *See* Council Directive No. 93/98, art. 1, 1993 O.J. (L 290) 9. By extending the duration of copyright in the United States by twenty years, the CTEA secured for U.S. authors an increase of the copyright term in Europe.

enacted and modified 17 U.S.C. § 104A (copyright restoration) as part of global trade agreements.[62]

This tradition of bending to international pressure could come into conflict with *Feist*'s constitutionally derived originality requirement. Many computer databases, although they are the result of a great deal of investment, are not original and do not receive copyright protection. In contrast, the European Union protects unoriginal computer databases that require a "substantial investment" to create.[63] The European Union also provides reciprocity to nations with similar protection.[64] In order to obtain this reciprocity, protection for databases has been proposed to Congress in the form of the Database and Collections of Information Misappropriation Act (DCIMA).[65]

The proponents of the DCIMA recognize that copyright's originality requirement comes from the United States Constitution As a result, they have attempted to tie protection to the Commerce Clause.[66] Therefore, the traditional contours guidelines do not necessarily apply. However, were originality to be considered only a traditional contour rather than a constitutional requirement, a change in this tradition would invoke First Amendment review under *Eldred*. First, it would be a change in tradition that implicates the right to speak. Second, it would be

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62. "In a nutshell, the URAA was enacted to bring the United States into compliance with its obligations as a member of the WTO." 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, 1285 (2007). 17 U.S.C. § 104A was enacted as part of the North American Free Trade Agreement and was modified as a result of the U.S. participation in the Uruguay Round Agreements. *See* Uruguay Round Agreements Act, Pub. L. No. 103-465, § 514, 108 Stat. 4809, 4976-81 (1994) (codified at 17 U.S.C. § 104A (2000)) (restoring copyright in all works and adding retroactive restoration); North American Free Trade Agreement Implementation Act, Pub. L. No. 103-182, 107 Stat. 2057 (1993) (restoring copyright in motion pictures); H.R. REP. NO. 103-826(I), at 10 (1994), *reprinted in* 1994 U.S.C.C.A.N. 3773 (noting that the Uruguay agreements are the result of negotiations between 125 nations over eight years); William Gable, *Restoration of Copyrights: Dueling Trolls and Other Oddities Under Section 104A of the Copyright Act*, 29 COLUM. J.L. & ARTS 181 (2005) (discussing in detail § 104A).

63. The European Union is not limited to a utilitarian justification for copyright. E.C. Directive on Databases, art. 7(1), 1996 O.J. (L 77) at 25; J.H. Reichman & Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 VAND. L. REV. 51 (1997); *see also* Ruth Okediji, *Towards an International Fair Use Doctrine*, 39 COLUM. J. TRANSNAT'L L. 75, 172 (2000) (pointing out that the European philosophy of protection is "squarely at odds" with the utilitarian justification in the United States and proposing that Fair Use be expanded to international disputes).

64. E.C. Directive on Databases, art. 7(1), 1996 O.J. (L 77) at 26-27.

65. Database and Collections of Information Misappropriation Act 2003, H.R. 3261, 108th Cong. (2003). An incentive differential may encourage pro-business domestic legislation to provide similar protections.

66. *See generally* Yavar Bathaee, *A Constitutional Idea-Expression Doctrine: Qualifying Congress' Commerce Power When Protecting Intellectual Property Rights*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 441 (2008).

the idea/expression dichotomy itself being altered, and an alteration of a traditional safeguard, at the very least, would get review. Third, the First Amendment "bears less heavily when speakers assert the right to make other people's speeches."[67] Speech in the form of facts gathered by another probably qualifies as the speech of "others" and should receive full protection of the First Amendment. Therefore, absent the originality concerns, the DCIMA would likely require First Amendment scrutiny, necessitating a review of whether law is either content based or content neutral in order to determine the appropriate level of scrutiny.

Because a law protecting databases probably would be content neutral, it must also be "narrowly tailored to serve a significant governmental interest."[68] A court deciding this issue would necessarily balance the right of the public to communicate facts (the First Amendment) with the right of a few to be the exclusive outlet for communicating those facts. In comparing these interests, a court must also consider any restrictions placed on the law that may act as additional First Amendment safeguards. The DCIMA limits its protection to misappropriation, only protecting the taking of highly time-sensitive information collected at some expense that is used in direct competition with the collector and reduces the incentive to produce the product from which information is taken.[69] These requirements limit only a small amount of speech and would most likely be held constitutional.

B. Expansion of Copyright as a Traditional Contour?

Throughout U.S. history, copyright has expanded. More specifically, the subject matter of copyright has expanded greatly from originally protecting only maps, charts, and books to its much broader modern scope.[70] The rights afforded to copyright holders have expanded as well.[71] For example, the right to produce derivative works did not exist

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67. Eldred v. Ashcroft, 537 U.S. 186, 191 (2003).

68. *See* Clark v. Cmty. for Creative Non-Violence, 468 U.S. 288, 293 (1984); United States v. O'Brien, 391 U.S. 367, 377 (1968).

69. *See* H.R. 3261; Carson, *supra* note 55; *see also* Int'l News Serv. v. Associated Press, 248 U.S. 215 (1918) (discussing misappropriation of intellectual property).

70. *See* Leslie J. Hagin, *A Comparative Analysis of Copyright Laws Applied to Fashion Works: Renewing the Proposal for Folding Fashion Works into the United States Copyright Regime*, 26 TEX. INT'L L.J. 341, 388 n.25 (1991) (citing H.R. REP. NO. 1476, 94th Cong., 2d Sess. 6, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664 ("The history of copyright law has been one of gradual expansion in the types of works accorded protection.")).

71. H.R. REP. NO. 94-1476, at 51-52 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664-65; Jessica Litman, *Copyright in the Twenty-First Century: The Exclusive Right To Read*, 13 CARDOZO ARTS & ENT. L.J. 29, 34 (1994) (noting that copyright is now applicable to broader range of things).

in the 1790 Act, began in 1870, and became what it is today with the Copyright Act of 1976.[72] Additionally, copyright duration has expanded from the original maximum term of twenty-eight years to the much longer term of life plus seventy years now afforded.[73] There has been so much expansion of copyright that expansion itself may be considered a traditional contour.[74]

Because Congress has traditionally increased what qualifies for copyright, the rights afforded to copyright holders, and the duration of those rights, most laws that continue this tradition would not invoke First Amendment review. For example, duration extensions have already been shown not to require further review.[75] Copyright already covers a fairly broad subject matter, protecting "original works of authorship fixed in any tangible medium of expression, now known or later developed."[76] However, should Congress alter § 102 without dispensing of the originality requirement or the protection of ideas, such a change would most likely not require further review. For example, removing the fixation requirement could potentially prove difficult, but this would not implicate First Amendment concerns. In a certain sense, this would not be a change in tradition, and the idea/expression dichotomy and fair use doctrine would protect as adequately as they do for fixed works.[77]

The one wildcard is expansion of the "bundle of rights" granted to copyright holders. Congress could grant copyright holders any of a limitless number of potential rights, and some of these rights might implicate the First Amendment. However, until now, the rights granted have all been *ejusdem generis*. For example, the value of a dramatic work comes partially from its public performance, and much of the value of a literary work comes from its reproduction and sale. The creation of a new right in this utilitarian tradition would most likely not be an issue. However, there exists the possibility that strange new rights might be conceived and enacted. For example, enactment of additional moral rights beyond the Visual Artists Rights Act[78] may interfere with fair use.[79]

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72. *See* JULIE E. COHEN ET AL., COPYRIGHT IN A GLOBAL INFORMATION ECONOMY 385 (2d ed. 2006).

73. *See* Eldred v. Ashcroft, 537 U.S. 186, 194-95 (2003); COHEN ET AL., *supra* note 72, at 153-58.

74. The court in *Eldred* did not seem to think increasing duration altered a traditional contour. *See Eldred*, 537 U.S. at 194.

75. *See id.*

76. 17 U.S.C. § 102 (2000).

77. This would not be a change in the tradition of increased copyright, but fixation itself could be considered traditional. This illustrates the difficulty of using tradition as a test.

78. *See* 17 U.S.C. § 106A.

Should this be the case, First Amendment scrutiny may be necessary under the guidelines of *Eldred*.

For the most part, copyright can expand freely, but can it contract? Any decrease in subject matter, duration, or rights granted to copyright holders would necessarily increase the availability of speech. However, copyright has been considered "the engine of free expression."[80] Decreasing copyright protections arguably could decrease the incentive to produce works and thus decrease the availability of new ideas.[81] On the other hand, a decrease in copyright would not decrease the right to speak. Rather, it would only change the incentive to produce copyrightable works. In other words, the argument that copyright is "the engine of free expression" only argues that copyright's restriction of speech can coexist in harmony with the First Amendment.[82] Reducing copyright necessarily frees more speech, and should not require any First Amendment scrutiny.

C. Viewpoint and Identity Based Copyright Laws as Traditional Contours?

Traditionally, the rules of copyright apply equally to works of the same type. For example, all books created by U.S. authors before 1978 that were first published in the United States with proper notice after 1963 but before 1978 in the United States are protected until ninety-five years from the publication date.[83] No matter the content, the United

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79. *See generally* Roberta Rosenthal Kwall, *The Attribution Right in the United States: Caught in the Crossfire Between Copyright and Section 43(A)*, 77 WASH. L. REV. 985, 985 (2002) (noting that the United States "does not adequately protect moral rights").

80. Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 558 (1985) (Brennan, J., concurring).

81. If increasing copyright is justified by increasing the availability of ideas, then a decrease could be opposed by the idea of lesser availability of ideas.

82. *Id.*

83. *See* 17 U.S.C. § 303(b) (detailing the duration of the copyright term for works published prior to 1978); Copyright Act of 1909, Pub. L. No. 349, 35 Stat. 1075 (1909) (replaced by the Copyright Act of 1976). The 1976 Act added an additional nineteen years to the twenty-eight-year renewal term of works published prior to 1978, which had a twenty-eight-year initial term. *See* COHEN ET AL., *supra* note 72, at 154. Therefore, the 1976 Act originally protected such works for seventy-five years. *See id.* However, in 1992, Congress removed renewal formalities for works published prior to 1978, but they could only reach back twenty eight years to 1964, as earlier works that failed to renew had already entered into the public domain. *See id.* at 154-55. In 1998, the CTEA added an additional twenty-year term to such works, yielding a total term of ninety-five years, but only extends the term for works not already in the public domain. *See id.* at 154. This presumes publication, as the rules for unpublished works introduce additional complexities. *See generally* Elizabeth Townsend Gard, *January 1, 2003: The Birth of the Unpublished Public Domain and Its International Implications*, 24 CARDOZO ARTS & ENT. L.J. 687 (2006) (discussing the difference between published and unpublished works under the 1909

States gives equal protection. Additionally, copyright has traditionally, with some exception, treated foreign authors no worse than domestic authors.[84] Therefore, copyright gives the same rights no matter the content of the work or the identity of the author.

The First Amendment prohibits the regulation of speech in a manner that favors some viewpoints over others.[85] Although copyright and the First Amendment generally coexist, a law that prevented copyright from subsisting in hate speech, for example, would clearly violate First Amendment principles. However, such a law might be considered a valid exercise of the Copyright Clause. In fact, in the government's strict interpretation of *Eldred*, this type of law would not receive First Amendment review at all.[86] However, such a law *would* part with the tradition of copyright in the United States, and neither the idea/expression dichotomy nor the fair use doctrine deals with this concept at all. Therefore, not only would this be a change in copyright law that has not been "validated by history," but it would also plainly violate First Amendment principles. Additionally, it is unlikely that a law that so blatantly violates First Amendment principles could contain safeguards that save it from review.

The Court in *Eldred* limited First Amendment review to changes in tradition because tradition is both consistent with the Framers' view and has been validated by history.[87] Laws that change the traditional contours of copyright cannot be validated this way.[88] Therefore, this kind of change in copyright should receive First Amendment review in a manner consistent with *Eldred*. It naturally follows that this type of law would receive strict scrutiny.[89]

Analysis of identity-based copyright laws also shows that such laws would implicate the First Amendment. Preventing copyright from subsisting in works created by certain people or classes of people would

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Act and the 1976 Act and noting the recent addition of unpublished works created before 1978 to the public domain).

84. *See* COHEN ET AL., *supra* note 72, at 35.

85. *See* Members of City Council of L.A. v. Taxpayers for Vincent, 466 U.S. 789 (1984); Lamb's Chapel v. Ctr. Moriches Union Free Sch. Dist., 508 U.S. 384 (1993).

86. *See* Appellants' Amended Opening Brief at 39-40, Kahle v. Gonzales, 487 F.3d 697 (9th Cir. 2006) (No. 04-17434).

87. "The Copyright Clause and First Amendment were adopted close in time. This proximity indicates that, in the Framer's view, copyright's limited monopolies are compatible with free speech principles." Eldred v. Ashcroft, 537 U.S. 186, 219 (2003).

88. *See* Appellants' Amended Opening Brief at 40, *Kahle*, 487 F.3d 697 (No. 04-17434).

89. Viewpoint based regulations are an especially egregious form of content based regulation. *See* Rosenberger v. Rector & Visitors of Univ. of Va., 515 U.S. 819, 829 (1995) (citing Perry Ed. Ass'n v. Perry Local Educators' Ass'n, 535 U.S. 819 (1995)).

be a step back in time to copyright's English origins in censorship.[90] Although not as drastic as allowing only authorized publishers to print books, not providing protection to works created by certain people would prevent those authors from earning a return on their investments. By eliminating copyright on these works, these works could be copied freely. This would selectively discourage publishers from taking the economic risk of investing in the publishing and printing of works by these authors, and this could have the effect of silencing a specific viewpoint. For example, if disfavored political figures wishing to publish controversial books were blocked from accessing the copyright system, they would be unable to prevent opportunistic publishers from publishing unlicensed copies of their books. The same argument may apply to any number of minority groups including, but not limited to illegal immigrants, political extremists, religious outliers, or even those convicted of certain crimes.

Just as with a viewpoint-based copyright law, an identity-based copyright law would break with the traditional contours of copyright law. There exists no history of granting copyright to specific authors for specific works.[91] Additionally, copyright has traditionally treated all U.S. citizens the same, and for foreign authors, the United States has a history of national treatment.[92] The United States began the latter with the Copyright Act of 1891, which provided protection to works created by

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90. *See generally* LYMAN RAY PATTERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE 20-29 (1968).

91. *See* Tyler T. Ochoa, *Patent and Copyright Term Extension and the Constitution: A Historical Perspective*, 49 J. COPYRIGHT SOC'Y U.S.A. 19, 46-51 (2001) (noting that congress enacted only nine copyright laws for individual works).

92. National treatment is the idea that foreign works are treated no worse than domestic works. *See* COHEN ET AL., *supra* note 72, at 35. There must be a treaty with another country for works published in that country to have protection in the United States. *See* 17 U.S.C.A. § 104A(h)(6)(d) (2002). Unpublished works are protected no matter the country of creation. *Id.* § 104(a). An author must also be a citizen of or domiciled in an eligible country for U.S. copyright law to protect a work. *Id.* § 104A(h)(6)(d). Afghanistan has joined neither the Universal Copyright Convention or nor the Berne Convention, and protection for works considered published by U.S. soldiers in Afghanistan could be difficult to determine. Publication of such a work probably places it in the public domain. Later publication in an eligible country could either restore copyright in a public domain work or be the first publication of an unpublished work. *See* Twin Books Corp. v. Walt Disney Co., 83 F.3d 1162 (9th Cir. 1996) (holding that publication abroad without notice did not place a book in the public domain and that copyright protection began when work was first published in accordance with formalities in an eligible country); Heim v. Universal Pictures Co., 154 F.2d 480, 486-87 (2d Cir. 1946) (holding that publication abroad does not put a work into the public domain); 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHTS §§ 4.01[C][1], at 4-7 to 4-10.1, 9A.02[B], 9A-13 to 9A-14 (criticizing *Twin Books*); Gable, *supra* note 62, at 197-98 (noting that foreign publication can, but does not automatically, cause works to enter the public domain); The Patry Copyright Blog, http://williampatry.blogspot.com/2006/03/brain-teaser.html (Mar. 12, 2006 16:13 PST) (noting the difficulties with international copyright law and discussing *Twin Books* and *Heim*).

foreign authors provided similar treatment were afforded to US works in the foreign country in question.[93] Although not initially complete, the United States, over time, came increasingly closer to true national treatment.[94]

A copyright law that selectively targeted groups of people could break with tradition either by providing dissimilar treatment for all U.S. citizens or by violating the principle of national treatment if applied to foreign authors. Not only would this type of law break with tradition, but the idea/expression dichotomy and fair use doctrine would be as inapplicable as with viewpoint-based copyright laws. For the same reasons as with viewpoint-based copyright laws, identity-based copyright laws would receive First Amendment strict scrutiny under *Eldred*.

VI. CRITICISM OF *ELDRED*'S FIRST AMENDMENT GUIDELINES

A. Introduction

Eldred's First Amendment guidelines work in theory but not in practice. Generally, copyright and the First Amendment can coexist, but copyright is not "categorically immune" to the First Amendment.[95] Moreover, copyright laws generally receive rational basis review, while laws implicating the First Amendment receive medium to strict scrutiny.[96] Because of the significant difference in deference, guidelines on when to apply heightened scrutiny to copyright laws are desirable, and the Court in *Eldred* attempted to provide them.[97] However, their guidelines appear to be flawed and have been applied with difficulty. First, tradition is difficult to define with the precision required for courts to consistently apply the law. Second, the idea/expression dichotomy and fair use

93. *See* Meredith Shaw, *"Nationally Eligible" Works: Ineligible for Copyright and the Public Domain*, 44 COLUM. J. TRANSNAT'L L. 1033, 1038 (2005). However, this was only the beginning of national treatment, as this Act contained the Manufacturing Clause, which required domestic manufacture for works to be protected. The Manufacturing Clause gradually narrowed and expired on July 1, 1986. COHEN ET AL., *supra* note 72, at 34.

94. The United States joined the UCC in 1954 and the Berne Convention in 1989, gradually expanding the worldwide scope of national treatment. COHEN ET AL., *supra* note 72, at 35. For a modern example of national treatment, works published in the former Soviet Union prior to its ratification of the Universal Copyright Convention (UCC) were unprotected, while works published after have protection equal to domestic works. However, the matter is complicated by the fact that both the Soviet Union and the United States did not originally enact retroactive copyright restoration. *See* Simon Helm, *Intellectual Property in Transition Economies: Assessing the Latvian Experience*, 14 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 119, 137 (2003). Some of these unprotected works later became protected due to the URAA and partially formed the basis for *Golan*.

95. Eldred v. Ashcroft, 537 U.S. 186, 221 (2003) (citation omitted).

96. *See id.* at 213.

97. *Id.* at 221.

doctrine do not safeguard free speech as much as is necessary to maintain a strong First Amendment.

B. Tradition May Serve as a Poor Guideline

Eldred has been criticized for relying too much on tradition.[98] For example, Justice Breyer stated in his dissent in *Eldred* that the traditional contours language "points to the question, rather than the answer.[99] Moreover, defining the traditional contours can be difficult.[100] Making the problem even more formidable, tradition evolves over time, and what was once both traditional *and* well within First Amendment principles might one day evolve into something far askew of current First Amendment principles, yet be considered traditional by a hypothetical court of the future. Applying this idea to current times, who is to say that the Framers would have been comfortable with today's much extended duration and derivative work rights? In a fashion similar to how copyright law has already progressed, future courts may use the guise of slowly evolving tradition to expand copyright beyond anything imaginable today.

Furthermore, tradition has not historically restricted application of the First Amendment.[101] Blasphemy,[102] profanity,[103] commercial advertising,[104] libel and slander[105] all were traditionally unprotected, yet the First Amendment has evolved to protect these forms of speech.[106] Also, the First Amendment now covers many non-traditional forms of expression[107] such as defamation of public officials and public figures,[108] nude dancing,[109] and the burning of both crosses[110] and flags.[111] It seems

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98. *See* Paul Bender, *Copyright and the First Amendment After* Eldred v. Ashcroft, 30 COLUM. J.L. & ARTS 349 (2007).

99. *See Eldred*, 537 U.S. at 264 (Breyer, J., dissenting).

100. "Given *Eldred*'s broad approach to tradition, a clear definition of the traditional contours of copyright is likely to be hard to find." Stephen M. McJohn, Eldred*'s Aftermath: Tradition, the Copyright Clause, and the Constitutionalization of Fair Use*, 10 MICH. TELECOMM. & TECH. L. REV. 95, 119 (2003).

101. *See* Bender, *supra* note 98, at 351.

102. *See* Cantwell v. Connecticut, 310 U.S. 296, 309-10 (1940).

103. *See* Cohen v. California, 403 U.S. 15, 17 (1971).

104. *See* Va. Bd. of Pharmacy v. Va. Citizens Consumer Council, 425 U.S. 748, 762 (1976).

105. *See* N.Y. Times v. Sullivan, 376 U.S. 254, 268 (1964).

106. *See* Bender, *supra* note 98, at 351.

107. *See id.*

108. *See Sullivan*, 376 U.S. at 265.

109. *See* Barnes v. Glen Theater, Inc., 501 U.S. 560 (1991).

110. *See* Virginia v. Black, 538 U.S. 343 (2003).

111. *See* Texas v. Johnson, 491 U.S. 397 (1989).

inappropriate to exclude copyright from First Amendment review just because certain copyright laws follow tradition. If copyright and the First Amendment are considered compatible because they were enacted close in time and thus are to be thought of as compatible by the founders, then the guidelines for evolving *one* should match the *other*. In other words, the First Amendment has been allowed to evolve, but copyright is still bound by history. At some point, the system breaks.[112] Therefore, tradition results in a bad guideline.

C. The Safeguards Fail

Eldred's reliance on the "traditional safeguards" does not actually safeguard the First Amendment. First, fair use was neither intended nor designed to safeguard free speech.[113] Second, fair use as codified in the Copyright Act of 1976 considers the commercial purpose of the use.[114] However, it is improper to make such a consideration under normal First Amendment principles.[115] Third, the Supreme Court has only discussed the First Amendment in *one* of its four cases involving fair use.[116] If the First Amendment is not discussed in relation to application of the fair use doctrine, then it cannot logically serve as a safeguard. Finally, in application of the fair use doctrine, "lower courts rarely balance free speech interests with copyright interests."[117] For these reasons, the fair

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112. *See* Lawrence Lessig, How the Law Is Strangling Creativity, http://www.ted.com/index.php/talks/larry_lessig_says_the_law_is_strangling_creativity.html (last visited July 31, 2008).

113. *See* Lee Ann W. Lockridge, *The Myth of Copyright's Fair Use Doctrine as a Protector of Free Speech*, 24 SANTA CLARA COMPUTER & HIGH TECH L.J. 31, 34 (2007).

114. *See* 17 U.S.C. § 107 (2000); Lockridge, *supra* note 113, at 33-34.

115. *See* Lockridge, *supra* note 113, at 33-34. Although commercial speech may be regulated, such regulation must be justified by and directly advance a substantial government interest and not be more extensive than necessary to serve the interest. *See* Greater New Orleans Broad. Ass'n v. United States, 527 U.S. 173, 183 (1999). Fair use analysis involves neither the government's interest nor [or] the tailoring of the law to serve that interest. 17 U.S.C. § 107. Moreover, the 1976 Act adopted the common law fair use doctrine originally conceived by Justice Story as an equitable rule. *See* Janice E. Oakes, Comment, *Copyright and the First Amendment: Where Lies the Public Interest?*, 59 TUL. L. REV. 135, 141-42 (1984), *noted in* Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 559 (1985). Also, the legislative history of the 1976 act does not reveal a significant governmental interest in codifying fair use. *See id. But see* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994) (allowing parody as an exception to the rule that commercial purpose prevents a finding of fair use).

116. *See Harper & Row*, 471 U.S. at 539; Lockridge, *supra* note 113, at 89. *But cf.* Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005*, 156 U. PA. L. REV. 549, 573 (2008) (noting that forty-three percent of Supreme Court opinions that *discuss* fair use also discuss First Amendment concerns).

117. *See* Lockridge, *supra* note 113, at 90. *But cf.* Beebe, *supra* note 116, at 573 (finding the First Amendment to figure prominently in fair use opinions upon discovering that twenty

use doctrine seems an inadequate protection of free speech and should not be relied upon to justify copyright laws in view of First Amendment concerns.[118]

The other "safeguard," the idea/expression dichotomy, protects speech in theory, but vagueness in the line between idea and expression greatly reduces its usefulness as a First Amendment safeguard. The idea/expression dichotomy safeguards the First Amendment by limiting copyright and allowing for the free exchange of ideas while still protecting original expression. However, the boundary between free ideas and protectable expression is difficult to draw, as noted by Learned Hand, who stated that "[n]obody has ever been able to fix that boundary, and nobody ever can."[119] In other words, although it protects some speech, it is impossible to determine what speech is protected and what speech is not.

When laws restricting speech are unclear, First Amendment jurisprudence recognizes that, in certain situations, laws cannot be expressed with greater clarity and that even a sound law may leave some individuals unsure about whether they may speak without legal repercussions.[120] In cases where such a "chilling effect" exists, the First Amendment "requires clear legal standards which leave breathing room for the exercise of constitutionally valuable speech."[121] This principle limits many speech laws,[122] including obscenity, libel,[123] picketing,[124] intentional infliction of emotional distress,[125] and advocacy of lawless conduct. Application of the idea/expression dichotomy has not provided the "breathing room" required by the First Amendment.[126] Difficulty in separation of idea from expression has caused arbitrary and unprincipled

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percent of district court opinions and thirty-four percent of circuit court opinions that discuss fair use also discuss First Amendment concerns, though not necessarily in the fair use analysis).

118. *Cf.* McJohn, *supra* note 100 (arguing that *Eldred* raises fair use from a constitutionally questionable doctrine that only arose due to market failure up to being a constitutional requirement akin to originality). In other words, this article finds strength in *Eldred* over weakness in fair use.

119. Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930); *see also* Clarisa Long et al., *Copyright and Freedom of Expression*, 30 COLUM. J.L. & ARTS 319, 324 (2007) (statement of Joseph Liu) (noting pessimistically that if Learned Hand could not solve this problem, then there is no hope for anyone else).

120. *See* Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's "Total Concept and Feel,"* 38 EMORY L.J. 393, 396 (1989).

121. *See id.* at 395.

122. *See id.* at 421 n.156.

123. *See* Gertz v. Robert Welch, Inc., 418 U.S. 323 (1974); St. Amant v. Thompson, 390 U.S. 727 (1968); Curtis Publ'g Co. v. Butts, 388 U.S. 130 (1967).

124. *See* Boos v. Barry, 485 U.S. 321, 321 (1988).

125. *See* Hustler Magazine v. Falwell, 485 U.S. 46, 55 (1988).

126. *See* Yen, *supra* note 120, at 396.

decision making that has left individuals unsure as to whether publication of a work would cause infringement.[127] For this reason, the idea/expression dichotomy, a principle relied upon to safeguard the First Amendment, actually chills some speech and therefore should not be used in its current form to determine whether a copyright law should receive First Amendment scrutiny.[128]

VII. CONCLUSION

In conclusion, *Eldred* provided poor guidelines because it relied on tradition and faulty safeguards. Any First Amendment guideline that uses tradition goes against a tradition of not using tradition to limit First Amendment scrutiny, and for good reason.[129] Moreover, not only are the guidelines bad in theory, they are bad in practice, too. The circuit split discussed above results from the Ninth Circuit having a different opinion than the Tenth Circuit about whether copyright restoration fits or does not fit with tradition. Good guidelines should point to the answer, not the question.[130] Further eroding the usefulness of *Eldred*'s First Amendment guidelines, the idea/expression dichotomy and fair use doctrine do not serve as strong First Amendment safeguards. Fair use does not adequately safeguard the First Amendment because it was not intended to and because it does not fit with First Amendment principles.[131] Additionally, the idea/expression dichotomy does not adequately protect the first amendment because it fails the First Amendment void for vagueness test.[132]

If *Eldred* is to be followed, it should be followed closer to the standard set by *Golan*. Among other reasons, this is because the Tenth Circuit tried to come up with clear rationale for showing that what was done was outside of tradition. Going forward, it is clear that First Amendment review under *Eldred* cannot be limited to only the cases where either the idea/expression dichotomy or the fair use doctrine have been altered. There are cases such as viewpoint-based copyright regulation that are both outside of tradition *and* not saved by these two "safeguards." Moreover, even if these safeguards are preserved, they do not really serve as safeguards. If *Eldred* is to stand, then "[u]nless courts

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127. *See id.*

128. Of course, some speech is promoted while other speech is chilled.

129. *See* Bender, *supra* note 98, at 351 (noting that tradition has not limited the First Amendment).

130. *See* Eldred v. Ashcroft, 537 U.S. 186, 264 (2003) (Breyer, J., dissenting).

131. *See* Lockridge, *supra* note 113, at 89-90.

132. *See* Yen, *supra* note 120, at 433-36.

adequately protect speech interests through these internal doctrines, the significant benefits that copyright law bestows upon our society will be placed in jeopardy."[133] In other words, either the idea/expression dichotomy and fair use doctrine need to be strengthened to function as reliable free speech safeguards or new guidelines for First Amendment review of copyright law need to be developed.[134]

Ultimately, the guidelines should be about preserving the free exchange of ideas while still providing adequate incentives to authors. Normally, the copying protected by copyright's reproduction right is not First Amendment activity.[135] However, there is value even in pure copying.[136] For example, making and distributing complete translations of *Mein Kampf* in order to combat a selectively edited translation can be considered valued First Amendment activity.[137]

If new guidelines are developed, then what should they be? Any new guidelines *should* recognize copyright's long history of harmonious coexistence with the First Amendment. The Framers viewed the two to be compatible, and history has proven this to be largely true. Even though First Amendment jurisprudence has evolved while copyright law has not, the two have not drifted apart to the point where copyright law is unsalvageable.[138] New guidelines should be more concrete than merely

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133. Robert Kasunic, *Preserving the Traditional Contours of Copyright*, 30 COLUM. J.L. & ARTS 397, 427 (2007); *see also* Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on the Public Domain*, 74 N.Y.U. L. REV. 354, 357-59 (1999) (arguing that weak application of fair use restricts the public domain and harms the "marketplace of ideas" free speech attempts to promote).

134. Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1135 (1990) (discussing from a circuit judge's perspective the confusion caused by the lack of fair use standards, discouraging the adoption of a bright line rule, and suggesting that courts might issue more consistent and predictable decisions "by disciplined focus on the utilitarian, public-enriching objectives of copyright-and by resisting the impulse to import extraneous policies").

135. *Id.* at 1151-55.

136. *See* Rebecca Tushnet, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535, 562 (2004).

137. *See* Lockridge, *supra* note 113, at 97. In fact, this situation actually happened when Senator Allan Cranston, after having served as a military translator in Europe, returned to the United States and published a *full* translation of Hitler's work. *See* Anthony O. Miller, *Court Halted Dime Edition of 'Mein Kampf'; Cranston Tells How Hitler Sued Him and Won*, L.A. TIMES, Feb. 14, 1988, at 4; *see also* Houghton Mifflin Co. v. Noram Publ'g Co., 28 F. Supp. 676 (S.D.N.Y. 1939) (showing that Hitler won). Houghton Mifflin published its own full translation in 1939, renewing the copyright in 1966. *See also* Hustler Magazine, Inc. v. Moral Majority, Inc., 796 F.2d 1148 (9th Cir 1986). Here, a full copy of an ad used to parody Jerry Falwell was used by his religious organization in a newsletter to both rebut the personal attack and solicit donations, a supposedly commercial purpose. The court allowed a full copy to be made as fair use, stating that he "did not use more than was reasonably necessary." *Id.* at 1153.

138. This is because tradition has not historically limited the First Amendment. *See* Bender, *supra* note 98, at 351.

excluding copyright's traditions from review. Although fair use and the idea/expression dichotomy have not proven to be strong First Amendment safeguards, they could be strengthened to more strongly protect First Amendment interests. For example, a fifth fair use factor that considers First Amendment interests could be added.

Should these doctrines be altered, reliance on these two safeguards could be justified, but they alone should not be the sole safeguards of the First Amendment. Therefore, new guidelines should generally weigh First Amendment interests against this country's utilitarian copyright justifications, and this balancing should include a discussion of whether the existing safeguards provide adequate protection.

Another possible solution looks at whether the copying in question is First Amendment activity, and when it is, the conflict "should be resolved, not by the traditional contours of copyright, by through application of ordinary free expression principles."[139] Using this solution, the analysis should start at determining whether the infringement is First Amendment activity or plagiarism.[140] Then, if the infringement in question is considered First Amendment activity, the inquiry should be on whether the infringement was necessary.[141] Such an inquiry could potentially include the idea/expression dichotomy and fair use doctrine to determine necessity.[142] Then, if a court finds necessity, the First Amendment should protect the infringer.[143] Guidelines for the intersection of copyright and the First Amendment that take this form instead of relying on tradition would fit well with the First Amendment's history of adaptation and could prove to satisfactorily balance free speech and copyright.

The First Amendment guidelines from Eldred have proven unworkable, and new guidelines are needed. Furthermore, the solutions proposed here are merely suggested starting points for developing new laws that can provide a more robust and uniformly applied standard for protecting First Amendment interests in the area of copyright law.

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139. *Id.* at 354.

140. *See* Long et al., *supra* note 119, at 332-33 (statement of Paul Bender).

141. *See id.*

142. This leaves open the possibility that either could become stronger First Amendment safeguards.

143. *See id.*