COPYRIGHT LAW — CONSTITUTIONAL CONSTRAINTS — TENTH CIRCUIT SUBJECTS COPYRIGHT STATUTE TO FIRST AMENDMENT SCRUTINY. — *Golan v. Gonzales*, 501 F.3d 1179 (10th Cir. 2007).

Despite the tendency of copyright laws to burden speech,[1] courts have long denied that any conflict exists between the Copyright Clause[2] and the First Amendment.[3] The Supreme Court has explained that because these provisions were "adopted close in time," the Framers considered "copyright's limited monopolies . . . compatible with free speech principles."[4] Given copyright law's internal speech accommodations — the idea/expression dichotomy[5] and the fair use defense[6] — courts have held that copyright's structure adequately protects free speech without the need to rely on the First Amendment.[7] In *Eldred v. Ashcroft*,[8] the Supreme Court pointed to these two justifications when it upheld the Sonny Bono Copyright Term Extension Act[9] (CTEA) against a First Amendment challenge.[10] However, the Court rejected the idea that copyright is "categorically immune from challenges under the First Amendment."[11] Instead, First Amendment scrutiny is necessary when legislation "alter[s] the traditional contours of copyright protection"[12] — a standard that the Court left undefined.

Recently, in *Golan v. Gonzales*,[13] the Tenth Circuit held that a statute granting copyright protection to certain works that had been in the public domain altered copyright's traditional contours and thus must

---

[1] *See* NEIL WEINSTOCK NETANEL, COPYRIGHT'S PARADOX 169 (2008) ("Because of copyright, speakers are often unable effectively to convey their message, and audiences are deprived of valuable expression.").

[2] U.S. CONST. art. I, § 8, cl. 8.

[3] *See* Michael D. Birnhack, *Copyright Law and Free Speech After* Eldred v. Ashcroft, 76 S. CAL. L. REV. 1275, 1281–82 (2003) (analyzing courts' "systematic rejection" of the conflict between copyright and free speech).

[4] Eldred v. Ashcroft, 537 U.S. 186, 219 (2003).

[5] Authors cannot copyright facts or ideas; instead, copyright protects only "those aspects of the work — termed 'expression' — that display the stamp of the author's originality." Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 547 (1985); *see also* 17 U.S.C. § 102(b) (2000) (codifying the idea/expression dichotomy).

[6] The fair use defense, codified at 17 U.S.C. § 107, provides that certain uses of copyrighted material for purposes such as criticism or research are permissible without the copyright holder's consent.

[7] *See, e.g.*, *Harper & Row*, 471 U.S. at 559–60.

[8] 537 U.S. 186.

[9] Pub. L. No. 105-298, tit. I, 112 Stat. 2827 (1998) (codified as amended at 17 U.S.C. §§ 108, 203, 301–304) (2000 & Supp. V 2005).

[10] *See Eldred*, 537 U.S. at 219–21.

[11] *Id.* at 221 (quoting Eldred v. Reno, 239 F.3d 372, 375 (D.C. Cir. 2001)) (internal quotation marks omitted).

[12] *Id.*

[13] 501 F.3d 1179 (10th Cir. 2007).

be subjected to First Amendment scrutiny.[14] *Golan*'s historical approach to discerning copyright's traditional contours is one possible reading of *Eldred* — and it is preferable to the government's argument that only direct alterations of copyright's internal safeguards require First Amendment scrutiny. However, a third interpretation of *Eldred* would better serve speech values: requiring First Amendment analysis whenever new legislation impairs speech interests in a manner that copyright's internal protections cannot prevent or cure.

Professional conductor and music educator Lawrence Golan frequently performed and taught works in the public domain by foreign composers such as Dmitri Shostakovich.[15] Golan's use of these works became prohibitively expensive when Congress enacted the Uruguay Round Agreements Act[16] (URAA), section 514 of which brings the United States into compliance with the Berne Convention[17] by granting copyright protection to certain foreign works that had previously fallen into the public domain.[18] Golan and others who relied on these foreign works for their livelihoods brought suit, challenging the URAA under the Copyright Clause and the First Amendment.[19]

The district court upheld the constitutionality of the URAA.[20] Although the court recognized that the Copyright Clause envisions eventual access to works and therefore "implicitly guards the public domain in order to encourage intellectual progress and the free exchange of ideas,"[21] it concluded that Congress had authority under the Copyright Clause to enact the URAA.[22] Without citing *Eldred*'s traditional contours language, the court dispensed with Golan's First Amendment argument. It noted that the plaintiffs remained "free to contract with

---

[14] *See id.* at 1187–88.

[15] *Id.* at 1182.

[16] Pub. L. No. 103-465, 108 Stat. 4809 (1994) (codified as amended in scattered sections of 7, 15, 17, 19, 21, 26, 28, 29, 31, 35, 42, and 47 U.S.C.).

[17] Berne Convention for the Protection of Literary and Artistic Works, *adopted* Sept. 9, 1886, S. TREATY DOC. NO. 99-27, 1161 U.N.T.S. 3. The Convention "requires member countries to afford the same copyright protection to foreign authors as they provide their own authors." *Golan*, 501 F.3d at 1182. The URAA approved the Trade-Related Aspects of Intellectual Property Rights (TRIPS) regime, which incorporates the substantive provisions of the Berne Convention and subjects violators to the possibility of trade sanctions. *See* URAA §§ 101–103, 108 Stat. at 4814–19 (codified as amended in scattered sections of 15, 17, 19, and 35 U.S.C.).

[18] *See* URAA § 514, 108 Stat. at 4976–81 (codified as amended at 17 U.S.C. §§ 104A, 109 (2000)); *Golan*, 501 F.3d at 1182.

[19] *See Golan*, 501 F.3d at 1182. The plaintiffs also argued that the CTEA's twenty-year extension of copyright protection violated the "limited Times" provision of the Copyright Clause. *Id.* The district court dismissed this challenge as foreclosed by *Eldred*, Golan v. Ashcroft, 310 F. Supp. 2d 1215, 1218 (D. Colo. 2004), and the Tenth Circuit affirmed that dismissal, *Golan*, 501 F.3d at 1185.

[20] Golan v. Gonzales, No. 1:01-cv-01854, 2005 WL 914754, at *1 (D. Colo. Apr. 20, 2005).

[21] *Id.* at *3.

[22] *See id.* at *14.

copyright holders" to gain permission for use and that it was unnecessary to "expand upon the settled rule that private censorship via copyright enforcement does not implicate First Amendment concerns."[23]

The Tenth Circuit affirmed in part and remanded.[24] The unanimous panel[25] held that, under *Eldred*, section 514 must undergo First Amendment review because it altered the traditional contours of copyright law. The court's analysis focused on history. It began by observing that the copyright sequence has consistently followed a pattern wherein a work advanced from creation to copyright to the public domain, where it remained forever.[26] No clear tradition existed of removing works from the public domain.[27] Historical practice revealed only limited instances when Congress had granted protection to certain public domain works via private bills, and "the fact that individuals were forced to resort to the uncommon tactic of petitioning Congress demonstrates that this practice was *outside* the normal practice."[28] Thus, the court determined that section 514 altered copyright's traditional contours by upsetting the "bedrock principle . . . that works in the public domain remain there."[29]

Furthermore, the court concluded that it could not avoid First Amendment analysis by relying exclusively on copyright's internal safeguards.[30] The idea/expression dichotomy was "simply not designed" to deal with whether expression — rather than ideas — could be removed from the public domain.[31] Fair use could not substitute for unfettered access to public domain works because, even with the availability of the defense, "[section] 514 leaves . . . the public with less access to works than they had before the [URAA]."[32] Thus, the Tenth

---

[23] *Id.* at *16–17.

[24] The court affirmed the district court's conclusion that the URAA did not exceed Congress's Copyright Clause power. *See Golan*, 501 F.3d at 1186–87. For a recent discussion of Congress's authority under the Copyright Clause, see Recent Case, 121 HARV. L. REV. 1455 (2008).

[25] Judge Henry wrote for the court and was joined by Judges Briscoe and Lucero.

[26] *Golan*, 501 F.3d at 1189.

[27] *Id.* at 1191. Although the district court had concluded that Congress intended to remove some works from the public domain in passing the first federal copyright act in 1790, *see Golan*, 2005 WL 914754, at *11, the Tenth Circuit stated that historical evidence was scant and that Congress's intent was "probably not just unclear but also unknowable," *Golan*, 501 F.3d at 1191.

[28] *Golan*, 501 F.3d at 1191. Although the court acknowledged that wartime copyright acts also may have removed a "very small number of works from the public domain," it explained that the acts were "passed in response to exigent circumstances" and were "insufficient to establish a traditional contour of copyright law." *Id.* at 1191–92.

[29] *Id.* at 1187.

[30] *Id.* at 1194. The Tenth Circuit's apparent premise was that, under *Eldred*, even when the traditional contours test triggers First Amendment scrutiny, a court should first try to avoid First Amendment analysis by examining whether the idea/expression dichotomy or the fair use defense can eliminate the burden on speech.

[31] *Id.*

[32] *Id.* at 1195.

Circuit remanded *Golan* so that the district court could determine whether section 514 could withstand First Amendment scrutiny.[33]

Golan's interpretation of copyright's traditional contours by reference to history is potentially more speech-protective than the government's interpretation, which focused exclusively on direct alterations of the idea/expression dichotomy and the fair use defense. Still, *Golan*'s focus on history does not account for the extent to which doctrinal and technological changes undermine the presumed compatibility between copyright and the First Amendment. Moreover, courts may define the relevant historical tradition too broadly and forgo First Amendment review altogether. Although *Golan* avoided this hazard, a more speech-protective reading of *Eldred* would subject new copyright laws to First Amendment analysis whenever copyright's internal safeguards cannot adequately protect speech interests under those laws.

In giving content to the traditional contours language, the Tenth Circuit appropriately rejected the government's argument that only direct alterations of the idea/expression dichotomy or fair use defense require First Amendment scrutiny.[34] The government's reading of *Eldred* ignores how the Supreme Court qualified its approval of copyright's internal safeguards by describing them as "*generally* adequate to address" First Amendment concerns, suggesting that cases exist in which the safeguards remain intact but are insufficient to protect free speech values.[35] *Golan*'s historical focus also makes better sense of the *Eldred* Court's insistence that copyright laws are compatible with speech interests because the First Amendment and the Copyright Clause were adopted in close proximity. New laws that do not deviate from historical copyright protections fall within this compatibility, but alterations of copyright's historical contours — which will, by defini-

---

[33] *Id.* at 1197.

[34] *See* Appellees' Petition for Rehearing and Rehearing En Banc at 11, *Golan*, 501 F.3d 1179 (No. 05-1259), *available at* http://cyberlaw.stanford.edu/node/5633 (arguing that the Supreme Court's invocation of traditional contours "did not create a new standard, but merely repeated prior law" that these two built-in speech protections "ensure the consistency of private copyright enforcement with the First Amendment"); *see also* Brief for the Appellee at 37, Kahle v. Gonzales, 487 F.3d 697 (9th Cir. 2007) (No. 04-17434), 2005 WL 926823. One district court appears to have adopted the government's interpretation of *Eldred*. *See* Luck's Music Library, Inc. v. Ashcroft, 321 F. Supp. 2d 107, 118–19 (D.D.C. 2004) (holding that section 514 of the URAA does not alter copyright's traditional contours because the idea/expression dichotomy and the fair use defense remain untouched), *aff'd on other grounds sub nom.* Luck's Music Library, Inc. v. Gonzales, 407 F.3d 1262 (D.C. Cir. 2005).

[35] Eldred v. Ashcroft, 537 U.S. 186, 221 (2003) (emphasis added). Many laws could severely affect speech interests and change copyright's traditional contours without altering copyright's internal safeguards. If Congress enacted content- or viewpoint-based copyright laws — for example, refusing to copyright hate speech or reducing copyright protection for speech that criticizes the government — surely *Eldred* would not immunize those laws from First Amendment review. *See* Appellants' Response to Appellees' Petition for Rehearing and Rehearing En Banc at 7–9, *Golan*, 501 F.3d 1179 (No. 05-1259), *available at* http://cyberlaw.stanford.edu/node/5633.

tion, lack a longstanding pedigree and concomitant presumption of constitutionality[36] — require First Amendment review even if copyright's internal safeguards remain untouched.

However, *Golan*'s history-based test — while consistent with *Eldred*'s ambiguous language — is still a poor vehicle for fully protecting free speech for two reasons. First, a history-based approach overlooks changes in copyright doctrine that undermine the assumption that copyright and the First Amendment are automatically compatible. Modern copyright legislation has been "a one-way ratchet," granting increased protection to copyright holders, and for longer periods of time.[37] As Professor Rebecca Tushnet has recognized, "copyright is a more significant restraint on what people can say now than ever before, and the initial free speech defense of copyright — that it . . . provid[ed] economic incentives to create — has been destabilized by social and technological change."[38] Troublingly, the standard account of the political economy of intellectual property is that the one-way ratchet is principally the result of industry lobbying rather than a considered balance of speech and copyright holder interests.[39]

One illustration of the one-way ratchet is the Digital Millennium Copyright Act[40] (DMCA), which prohibits circumvention of technological protection measures such as encryption.[41] Copyright owners have relied on technological measures to prevent piracy.[42] But scholars generally agree that these protections are not necessary to encourage the creation of new works[43] and that they risk restricting access to

---

[36] *See* Appellants' Opening Brief at 26, *Golan*, 501 F.3d 1179 (No. 05-1259), 2005 WL 2673976.

[37] Rebecca Tushnet, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535, 543 (2004).

[38] *Id.*

[39] *See* JESSICA LITMAN, DIGITAL COPYRIGHT 31, 122–50 (2001); NETANEL, *supra* note 1, at 182–85. For this reason, courts rather than Congress may be the better institution to strike the balance between proprietary rights and free speech.

[40] Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended in scattered sections of 5, 17, 28, and 35 U.S.C.).

[41] *See* 17 U.S.C. § 1201(a)(1)(A) (2000).

[42] *See* Mark Gimbel, Note, *Some Thoughts on the Implications of Trusted Systems for Intellectual Property Law*, 50 STAN. L. REV. 1671 (1998). The advent of the Internet and digital technology have changed the intellectual property landscape by lowering production costs and making distribution more efficient. *See* Appellants' Amended Opening Brief at *10, Kahle v. Gonzales, 487 F.3d 697 (9th Cir. 2007) (No. 04-17434), 2005 WL 627346 (noting that the Internet has expanded access to expressive material and that digital technology has "profoundly changed the nature and economics of creativity and the preservation and distribution of creativity"). These changes both create opportunities for a robust and diverse domain of ideas and facilitate piracy on unprecedented levels.

[43] *See, e.g.*, LITMAN, *supra* note 39, at 101–10; Yochai Benkler, *Free As the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354, 422–26 (1999).

and uses of public domain material.[44] Even though the DMCA specifically preserves the right to make fair use of copyrighted material,[45] at least one court has held that this provision does not permit circumvention of encryption technology to gain access to material in the first place.[46] In the face of copyright laws like the DMCA that address — and pose — new problems, a test that interprets tradition only by reference to history wrongly looks backward instead of forward.

The second flaw with *Golan*'s historical approach is that it allows courts to deploy the traditional contours language by adopting a broad interpretation of historical tradition — and thereby forgo First Amendment scrutiny altogether. For example, the current copyright term of lifetime protection plus seventy years after the author's death differs dramatically from the original protected term of fourteen years with an option to renew for fourteen years under the 1790 Copyright Act, but the change has occurred gradually over time.[47] If courts interpret the traditional contours of copyright by reference to incremental changes instead of dramatic end-result differences,[48] then the test may do very little work. Is the relevant historical tradition simply "increasing the term of protection," or is it "increasing the term of protection by roughly a factor of ten"? Copyright doctrine has been marked by progressively expansive recognition of intellectual property rights — from the length of protection, to the subject matter protected, to the scope of rights.[49] Any legislation that increases copyright protection in any manner arguably fits within this broad conception of tradition and therefore could evade First Amendment review.[50] *Golan* avoided this

---

[44] *See* Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1, 26 (2001) ("Unless tempered by the First Amendment, this Copyright Act–supported paracopyright regime will effectively accord content providers perpetual protection and proprietary control over all access and use of expressive content."). For a discussion of how the public domain implicates First Amendment interests, see Benkler, *supra* note 43.

[45] *See* 17 U.S.C. § 1201(c)(1).

[46] *See* Universal City Studios, Inc. v. Corley, 273 F.3d 429, 443–44 (2d Cir. 2001); *see also* NETANEL, *supra* note 1, at 185–90 (arguing that the DMCA alters copyright's traditional contours, and stating that "Congress was well aware that the DMCA's sweeping prohibitions might raise First Amendment concerns," but that "the DMCA only pays lip service to these concerns"); Benkler, *supra* note 43, at 415–27 (detailing the provisions of the DMCA and explaining how they raise significant First Amendment concerns).

[47] *See* Eldred v. Ashcroft, 537 U.S. 186, 194–95 (2003) (tracing the history of copyright term extensions).

[48] The *Eldred* Court appeared to do so when it described the pattern of copyright extensions, *id.*, and later explained, "in this case, Congress has not altered the traditional contours of copyright protection," *id.* at 221.

[49] *See* Birnhack, *supra* note 3, at 1289–90 (detailing copyright protection's expansion).

[50] Whether tradition should be interpreted broadly or narrowly is one of several definitional questions unanswered by a historical approach. Others include: What is the relevant time period for determining copyright traditions? Do historical contours include the procedural steps necessary to obtain and preserve a copyright in addition to the substantive scope of copyright law? Are isolated exceptions to copyright laws proof that exceptions are part of the tradition, or does their

pitfall, but the Ninth Circuit recently embraced this dangerous interpretation when it relied on a similar historical approach.[51]

A reading of *Eldred*'s traditional contours language that avoids these problems would require First Amendment review whenever new legislation affects speech interests in a manner that copyright's internal safeguards cannot cure, even if Congress has not directly altered the idea/expression dichotomy or the fair use defense. Under this approach, copyright's traditional contours encompass a balance in which the internal safeguards adequately protect speech values without necessitating resort to First Amendment scrutiny. Congress alters these contours when it enacts new laws that threaten speech interests in a manner the safeguards cannot prevent — thereby upsetting the traditional balance. Essentially, this reading requires that new copyright laws allow the internal safeguards to do their job protecting speech interests.[52]

Although this reading may not have been the *Eldred* Court's intent — an intent difficult to discern since the Court left "traditional contours" undefined[53] — this interpretation is consistent with *Eldred*'s

status as exceptions mean they cannot be included in the tradition? Courts struggling to answer these questions using a historical approach may well be guided by intuitions regarding the value of First Amendment review, rather than by faithful attention to the trigger of historical tradition.

[51] The Ninth Circuit considered whether a copyright statute that eliminated a renewal requirement — and thereby turned copyright into an "opt-out" instead of an "opt-in" system — altered copyright's traditional contours. Kahle v. Gonzales, 487 F.3d 697, 698 (9th Cir. 2007), *cert. denied*, 128 S. Ct. 958 (2008). It held that removing renewal effectively increased the length of copyright protection and thereby accorded with a tradition of extending existing copyrights. *See id.* at 700. Under this interpretation, any alteration of copyright law that incidentally lengthens the term of protection will not qualify for First Amendment review.

[52] One potential criticism of this reading of traditional contours is that many scholars believe that copyright's internal safeguards as currently applied *never* adequately protect speech. *See, e.g.*, NETANEL, *supra* note 1, at 180–81. Both the idea/expression dichotomy and the fair use defense have been criticized as indeterminate and unpredictable. *See, e.g.*, Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1106 (1990); Alfred C. Yen, Eldred*, the First Amendment, and Aggressive Copyright Claims*, 40 HOUS. L. REV. 673, 680 (2003). Because users lack certainty regarding whether material qualifies as an idea rather than as expression, or whether a proposed use will be considered fair, they may be chilled from using that material in the first place. *See* Neil Weinstock Netanel, *Copyright and the First Amendment: What* Eldred *Misses — and Portends*, *in* COPYRIGHT AND FREE SPEECH 127, 143–44 (Jonathan Griffiths & Uma Suthersanen eds., 2005). As a partial solution, Professor Netanel suggests reading *Eldred* to require courts to "interpret and define [the safeguards'] scope in a manner that comports with First Amendment concerns." NETANEL, *supra* note 1, at 190. He suggests "First Amendment–animated" modifications to fair use doctrine, such as altering the burden of proof once a defendant offers a colorable claim of fair use. *Id.* at 191–93.

[53] The *Eldred* Court surveyed historical practice when it considered Congress's powers under the Copyright Clause, *see Eldred*, 537 U.S. at 200–04, suggesting that it also might have intended history to inform the determination of copyright's traditional contours. However, the Court pointed *both* to copyright's historical compatibility with the First Amendment *and* to copyright's internal safeguards in upholding the CTEA. *See id.* at 218–21. *Golan*'s reading of traditional contours — conflating history and tradition — places emphasis on the former, whereas a reading

holding. Under this proposed test, the CTEA would not be subject to First Amendment review — just as *Eldred* held[54] — because the fair use defense allows the same access to expression under a longer copyright term as was previously available before the term was extended. But the URAA, at issue in *Golan*, would warrant First Amendment scrutiny because it lifts material out of the public domain — affecting the free speech rights of those who previously had unfettered access to the material — and neither of copyright's internal safeguards eliminate that new burden on speech.[55] Similarly, the DMCA would merit First Amendment scrutiny because it allows copyright owners to fence off even unprotected expression, and the idea/expression and fair use safety valves cannot prevent the encroachment on speech values caused by the DMCA's unqualified prohibition of circumvention.

Defining copyright's traditional contours by reference to the adequacy of its internal safeguards would likely subject more copyright laws to First Amendment review. As Professor Neil Netanel persuasively explains, increased First Amendment scrutiny in the copyright context is desirable.[56] "[C]opyright owner prerogatives have steadily become more bloated," imposing "an increasingly onerous burden on speech."[57] At the same time, the Court has subjected other private rights, including rights that already have built-in speech accommodations, to First Amendment review.[58] Under these circumstances, Professor Netanel argues, copyright's near immunity from the First Amendment stands as a "striking anomaly,"[59] no longer appropriately balancing copyright and speech interests.

Golan's interpretation of traditional contours partly compensates for this imbalance by allowing for First Amendment review of certain copyright laws — but its historical approach has flaws. Future courts defining and applying *Eldred*'s traditional contours language would be well advised to consider an even more speech-protective reading.

---

that requires the internal safeguards to adequately cure speech burdens focuses on the latter. Either approach is arguably consistent with *Eldred*.

[54] *See Eldred*, 537 U.S. at 221.

[55] *Golan* itself analyzed why copyright's internal safeguards could not protect speech rights under the URAA. *See Golan*, 501 F.3d at 1194–96. *Golan*, however, considered whether the idea/expression dichotomy and the fair use defense were adequate protections only *after* it determined that the URAA altered copyright's historical contours. In contrast, the test proposed here suggests that the fact that the internal safeguards are inadequate is itself the requisite change to copyright's traditional contours that necessitates First Amendment review.

[56] *See* Netanel, *supra* note 44, at 5 (arguing that "the First Amendment should come into play in challenges to the constitutionality of recent statutory expansions of copyright holder rights and as a defense in final adjudications of copyright infringement actions").

[57] *Id.* at 4; *see also id.* at 12–30.

[58] *See id.* at 40 (discussing trademark law and the right of publicity as examples).

[59] Netanel, *supra* note 52, at 132.