

In the
UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT
No. 04-17434

BREWSTER KAHLE, *et al.*,
Plaintiffs-Appellants,

v.

JOHN ASHCROFT,
Defendant-Appellee

On Appeal From a Judgment of the United States District Court for the
Northern District of California

**Brief *Amici Curiae* of the Brennan Center for Justice at New York University
School of Law, the American Civil Liberties Union of Northern California,
Public Knowledge, the Center for the Public Domain, and
The First Amendment Project, in Support of Reversal**

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INTEREST OF *AMICI CURIAE*

All parties have consented to the filing of this brief.

The Brennan Center for Justice at N.Y.U. School of Law unites thinkers and advocates in pursuit of a vision of inclusive and effective democracy. The Center's Free Expression Policy Project (FEPP) provides research and advocacy on arts, culture, and media democracy. In this case, FEPP seeks to advance the public's interest in the widest possible access to historical and creative works that is consistent with a healthy copyright system.

The American Civil Liberties Union of Northern California is a regional affiliate of the American Civil Liberties Union, a nationwide, nonprofit, nonpartisan organization with approximately 400,000 members dedicated to the defense and promotion of the guarantees of individual liberty secured by the state and federal Constitutions. Since its founding in 1920, a primary focus of the ACLU has been to protect and preserve the system of free expression that is at the core of our constitutional democracy.

Public Knowledge (PK) is a nonprofit advocacy and educational organization that seeks to address the public's stake in the convergence of communications policy and intellectual property law. PK is based in Washington, D.C.

The Center for the Public Domain is a philanthropic foundation based in Durham, North Carolina, dedicated to the preservation of a large and robust public

domain. Through grant making, original research, conferences, and collaborative programs, the Center seeks to call attention to the importance of the public domain and spur effective, practical solutions and responses to the challenges of information enclosure.

The First Amendment Project is a nonprofit organization dedicated to protecting and promoting freedom of information, expression, and petition. FAP provides advice, educational materials, and legal representation to its core constituency of activists, journalists, and artists in service of these fundamental liberties.

SUMMARY OF ARGUMENT

The district court erred by drawing a wooden distinction between “procedural formalities” and the substantive “contours of copyright protection.” The court failed to appreciate that procedural changes can have sweeping impact and, as in this case, impose significant burdens on First Amendment rights.

Notice, registration, and renewal requirements were traditionally a fundamental element of copyright law. Like the fair use doctrine and the idea/expression dichotomy, these “opt-in” requirements served free expression values by allowing works whose owners are not concerned with copyright protection at the outset, or who would not renew that protection after a limited term, to enter the public domain. The Amended Complaint alleges that eliminating these requirements, and

thus unnecessarily shrinking the public domain, had far-reaching effects – greatly diminishing the ability of librarians, publishers, and archivists to disseminate historical information and creative work, and the ability of the reading public to access that work.

It is against this background that the plaintiffs challenge the Copyright Renewal Act of 1992. They allege that more than 85% of the many thousands of works published between 1964 and 1978 and thus covered by this law would have entered the public domain at the end of their initial copyright term if not for the Act's elimination of the renewal requirement. Count One of the Amended Complaint thus alleges a radical diminution in works potentially available to the public – a burden on free expression that is sufficient to trigger First Amendment scrutiny.

First Amendment analysis should proceed under both the doctrine of substantial overbreadth and the intermediate scrutiny test for content-neutral laws with an incidental impact on expression. Under both theories, the plaintiffs should have an opportunity to introduce evidence to support their allegations that the unconditional system burdens large amounts of valuable and constitutionally protected expression. Under overbreadth analysis, strict scrutiny applies, and the government would have to demonstrate that the 1992 Renewal Act not only serves a compelling interest but does so in a manner that burdens no more speech than necessary. Under intermediate scrutiny, the government would have to establish

that the Act is narrowly tailored to serve the admittedly strong interest in protecting the rights of copyright owners.

ARGUMENT

I. THE STATUTORY SHIFT TO AN UNCONDITIONAL COPYRIGHT SYSTEM, INCLUDING THE ELIMINATION OF RENEWAL REQUIREMENTS, ALTERED THE “TRADITIONAL CONTOURS OF COPYRIGHT PROTECTION” AND THUS TRIGGERS FIRST AMENDMENT SCRUTINY

A. The Removal of Opt-in Requirements Was Not Merely a Series of Procedural Formalities, But Fundamentally Changed the Copyright System

The district court disposed of the plaintiffs’ First Amendment claim¹ in a few brief, formalistic sentences that wholly ignored the scope and real-world impact of the procedural changes that transformed American copyright law from a conditional to an unconditional system. Contrary to the district court’s rigid view of the distinction between procedure and substance, courts and commentators have long recognized that these are fluid concepts. As Justice Frankfurter wrote in *Guaranty Trust Co. v. York*,

Matters of “substance” and matters of “procedure” are much talked about in the books as though they defined a great divide cutting across the whole domain of law. But, of course, “substance” and “procedure” are the same

¹ This brief only addresses the plaintiffs’ First Amendment claim in Count One of their Amended Complaint, and takes no position on the district court’s dismissal of the other claims.

key-words to very different problems. Neither “substance” nor “procedure” represents the same invariants. Each implies different variables depending upon the particular problem for which is it used.

326 U.S. 99, 108 (1945). In other words, so-called changes in procedure can, in the real world, significantly alter substantive rights.

Although the holding of *Guaranty Trust* has been modified over the years,² its fundamental insight into the shifting legal boxes labeled “procedure” and “substance,” and its recognition of the serious substantive effects that procedural rules sometimes have, remain well-accepted. Thus, in the context of copyright law, Professor Ruth Okediji explains that the formalities “performed central roles in the actual grant of the right itself” because they “facilitated access to the protected works.” *Givers, Takers and Other Kinds of Users: A Fair Use Doctrine for Cyberspace*, 53 Fla. L. Rev. 107, 155 (2001). The formalities “were more than purely administrative” because they made clear “that the copyright grant was not conceived as an absolute, unregulable right.” *Id.* at 155-56. Instead, they

were consistent with the dominant utilitarian philosophy of intellectual property. Registration, in particular, informs the public what literary works exist in the marketplace, facilitating, among other things, research.

Id. at 155 n.271. See also Jessica Litman, *Sharing and Stealing*, 27 Hastings

Comm. & Ent. L.J. 1, 14-15 (2004) (the formalities had a core substantive purpose

² See *Hanna v. Plumer*, 380 U.S. 460 (1965); *Byrd v. Blue Ridge Rural Electric Corp.*, 356 U.S. 525 (1956) (both modifying *Guaranty Trust* with respect to the proper test for applying the doctrine of *Erie Railroad Co. v. Tompkins*, 304 U.S. 64 (1948), to “rules of decision” in the federal courts).

in fueling the public domain; “while the copyright system offered authors protection for a limited time as an incentive to encourage them to distribute their works to the public, it also attempted to ensure that most works entered the public domain promptly, so that the public could make unfettered use of them”).

The plaintiffs allege that precisely this core purpose – the preservation and enhancement of the public domain – has been substantively affected by the statutory shift to an unconditional system because it has dramatically reduced the public’s ability to reproduce, distribute, access, and make new uses of historical and creative materials of all kinds – an interest at the heart of the First Amendment. For purposes of a motion to dismiss, of course, all of their allegations must be taken as true, and dismissal is only appropriate if “it appears beyond doubt that the plaintiff can prove *no set of facts* in support of his claim which would entitle him to relief.” *Conley v. Gibson*, 355 U.S. 41, 45-46 (1957) (emphasis added); *Edwards v. Marin Park, Inc.*, 356 F.3d 1058, 1061 (9th Cir. 2004); *Neighbors of Cuddy Mountain v. Alexander*, 303 F.3d 1059, 1068 (9th Cir. 2002).³

The *Kahle v. Ashcroft* Web site, <http://notabug.com/kahle>, contains many examples of harms to free expression that the plaintiffs might prove. They range

³ In addition, motions to dismiss for failure to state a claim are viewed with disfavor and rarely granted. *Gilligan v. Jamco Dev. Corp.*, 108 F.3d 246, 249 (9th Cir. 1997).

from the near-total disappearance of much-loved but no longer commercially viable music, fiction, and popular art, to the inability to reproduce family photographs. Following are two examples of submissions to the site⁴:

○ Patricia Coombs' "Dorrie" series of 20 children's books about a little witch and her adventures are all, except one, out of print. "The date of the first publish I can find for the first book in the series is ~1965. ... The cost of finding out who owns the copyrights on each different original print, re-print, audio print, etc. from all the different publishers over a 19 year period is burdensome to say the least. ... Since 19 out of 20 of the books appear to be out of print and likely to remain so for the foreseeable future I am interested in making the stories available for free via the web in PDF/HTML/Flash format. ... It seems such a waste that current and future generations won't be able to enjoy the Dorrie series like I did ..."
<http://notabug.com/kahle/36>.⁵

○ "I'm a Psychiatry resident in at a large hospital. One of our attending Psychiatrists had a great handbook on Emergency Psychiatry. The book was a few years out of print. Even so, the professor claimed it was unique compared to the newer books in the way the material was presented. Normally we would all buy copies. Because it was out of print, the only way really for us to get access to it was to borrow it or copy some of the key sections. Perhaps being able to copy the information out of the book which was not commercially available could have prevented harm to a patient." <http://notabug.com/kahle/41>.

Obviously, these examples are not now evidence in support of the plaintiffs' case; they have not yet had the opportunity to submit such evidence. But the

⁴ Notabug Web pages were visited Jan. 14, 2005.

⁵ One reader responded: "There is a very small town in Illinois that has the whole series in their library. I personally would like to see the books reprinted, so that another generation can go to the Bizzare, become Dorrie's friend, and have a cat like Gink." Another wrote: "Sadly, it's almost impossible to find good, collectable copies without paying anywhere from \$30-\$100 per book [for rare used copies]."

examples illustrate the range of evidence that the plaintiffs might introduce to demonstrate the burdens that the unconditional system, and in particular the elimination of a renewal requirement, imposes on those who would keep alive our cultural heritage by publishing and distributing, often without profit, valuable out-of-print materials. In many of these cases, the copyright owner would not likely object, if the owner could be found.

If the plaintiffs are correct that for most of American history, the renewal rate was 8-15%, Amended Complaint, ¶42, this means that overall, more than 85% of works under the traditional system entered the public domain after a relatively short copyright term, and became available to archivists, publishers, distributors, readers, and creators. The elimination of the renewal requirement would thus have caused massive restrictions on access to cultural products, with particularly dramatic implications for today's communications environment, where knowledge, research, distribution, and creation are increasingly taking place online. Whereas a physical book, article, poster, or film, even if not commercially available, can still be viewed (and sometimes copied) in a library or museum, accessing it online requires digital copying. *Id.*, ¶75. In addition to the plaintiffs' examples (the reduced potential of the Internet Archive's Million Book Project and the inability of Prelinger Archives to reproduce "orphan" films or permit the "transformative reuse" of these works, *id.*, ¶¶77-79), the recent announcement by Google of a project

to create a searchable database comprised of the library collections of Harvard, Stanford, the University of Michigan, the University of Oxford, and the New York Public Library, will have dramatically reduced potential because of the 1992 Renewal Act. Press release, “Google Checks Out Library Books” (Dec. 14, 2004), http://www.google.com/intl/en/press/pressrel/print_library.html. While these works can be freely viewed in libraries, generally only public domain works can be copied and disseminated digitally without permission.

B. Both the First Amendment Right to Publish and the First Amendment Right To Receive Information and Ideas Are Implicated by the Shift to an Unconditional Copyright Regime

In *Eldred v. Ashcroft*, the Supreme Court recognized that no matter what power Congress is exercising when it legislates, the First Amendment is never irrelevant. Ordinarily, the Court explained, free-expression interests are accommodated in copyright law through such safeguards as the fair-use defense, but where Congress alters “the traditional contours of copyright protection,” First Amendment scrutiny is needed. 537 U.S. 186, 221 (2003).

The Court referred to fair use and the idea/expression dichotomy as two examples of free-expression safeguards built into the traditional contours of copyright protection, but contrary to the government’s argument, this list of two is not exclusive. The historical expectation that a substantial body of works would enter the public domain upon expiration of the original copyright term, and the

formal requirements that facilitated such entry when copyright owners no longer desired protection, were also critical aspects of the “traditional contours” of copyright law. Indeed, the extent to which the opt-in system made available for public use more than 85% of works whose copyrights were not renewed is a dramatic illustration of just how important a free-expression safeguard the conditional regime was.

The Second Circuit has applied First Amendment scrutiny to significant changes in the traditional contours of copyright other than the elimination of fair use or the idea/expression dichotomy. In a decision predating *Eldred* but consistent with it, the court used intermediate First Amendment scrutiny to analyze a challenge to the Digital Millennium Copyright Act (the “DMCA”). *Universal City Studios v. Corley*, 273 F.3d 429, 454 (2d Cir. 2001). The DMCA altered the traditional contours of copyright protection by criminalizing the creation and distribution of tools that circumvent digital rights management technologies. The result was a significant expansion of copyright liability, with First Amendment implications for technology researchers, humanities scholars, and creators of new works. Federal courts in California have followed the same analysis in addressing First Amendment challenges to the DMCA. *321 Studios v. MGM Studios, Inc.*, 307 F. Supp.2d 1085, 1100 (N.D. Cal. 2004); *United States v. Elcom Ltd.*, 203 F.

Supp.2d 1125 (N.D. Cal. 2002).⁶ This Circuit should do no less in adjudicating plaintiffs' challenge to the 1992 Copyright Renewal Act, whose effects were particularly dramatic against the backdrop of other statutory changes that radically altered the copyright system.

The government is likely to respond that no matter what real-world burdens on expression were created by the change to an unconditional system and in particular the elimination of the renewal requirement, there is no First Amendment interest at stake in this case because “[t]he First Amendment securely protects the freedom to make – or decline to make – one’s own speech; it bears less heavily when speakers assert the right to make other people’s speeches.” *Eldred*, 537 U.S. at 221. The government would be wrong, however, because unlike the 20-year term extension at issue in *Eldred*, the change to an unconditional system, including the 1992 Renewal Act, imposed copyright protection on large numbers of works whose uses their owners no longer desired to control. In essence, the many thousands of works produced between 1964 and 1978 and automatically kept out of the public domain

⁶ See also *Paramount Pictures Corp. v. 321 Studios*, 2004 U.S. Dist. LEXIS 3306 *4-5, 69 U.S.P.Q.2d 2023 (S.D.N.Y. 2004); *Golan v. Ashcroft*, 310 F. Supp.2d 1215, 1220 (D. Colo. 2004) (statute renewing copyrights of works already in the public domain was a change in the traditional contours of copyright law and thus subject to First Amendment scrutiny).

despite their owners' wishes are no longer "other people's speeches" – they are, as the plaintiffs put it, "orphans," whose owners in many cases cannot even be found.⁷

In this context, both the First Amendment right to publish and distribute – and perhaps even more importantly, the First Amendment right to *receive* information and ideas – are implicated. The Supreme Court has recognized a separate First Amendment right to read and receive at least since *Lamont v. Postmaster General*, 381 U.S. 301 (1965), and *Red Lion Broadcasting Co. v. FCC*, 395 U.S. 367, 386-90 (1969).⁸ It reaffirmed the importance of the right in *Kleindienst v. Mandel*, 408 U.S. 753, 762-63 (1972), *Virginia Board of Pharmacy v. Virginia Consumer*

⁷ The government may also argue that eliminating the renewal requirement was simply another means of extending the term of copyright – a decision that the Supreme Court in *Eldred* seemed to consider almost exclusively a congressional prerogative. But as explained above, there are critical differences between a mere lengthening of the duration of copyright and a decision to starve the public domain through automatic extension of copyright protection to owners who no longer desire it.

It is true, of course, that not all owners who declined to renew no longer desired copyright protection. As Congress found, some failed to renew because of inadvertence or ignorance (see section IIB, *infra*). Nevertheless, it cannot be assumed that the majority of those who failed to renew had an affirmative desire to continue copyright protection.

⁸ The plaintiffs have standing to assert this right on their own behalf, as both users and proprietors of online archives, and also on behalf of their readers. See *Secretary of Maryland v. Joseph H. Munson Co.*, 467 U.S. 947, 955-59 (1984); *Craig v. Boren*, 429 U.S. 190, 195 (1976) ("vendors and those in like positions have been uniformly permitted to resist efforts at restricting their operations by acting as advocates of the rights of third parties who seek access to their market or function").

Council, 425 U.S. 748, 756-57 (1976), *First National Bank of Boston v. Bellotti*, 435 U.S. 765, 783 (1978), and *Board of Education, Village of Island Trees v. Pico*, 457 U.S. 853, 866-67 (1982). As Justice Brennan explained in *Pico*:

Our precedents have focused “not only on the role of the First Amendment in fostering individual self-expression but also on its role in affording the public access to discussion, debate, and the dissemination of information and ideas.” ... And we have recognized that “the State may not, consistently with the spirit of the First Amendment, contract the spectrum of available knowledge.” ... In keeping with this principle, we have held that in a variety of contexts “the Constitution protects the right to receive information and ideas.”

Id. (plurality opinion) (quoting *First National Bank*, 435 U.S. at 783; *Griswold v. Connecticut*, 381 U.S. 479, 482 (1965); and *Stanley v. Georgia*, 394 U.S. 557, 564 (1969)).

The Amended Complaint alleges a broad restriction on the public’s right to access literary, artistic, historical, and other important works whose owners no longer wish to limit or control them. Such a broad, and allegedly unnecessary, restriction has sufficiently serious effects on expression to trigger First Amendment scrutiny.

II. THE DISTRICT COURT MUST CONDUCT FACT-FINDING TO ASSESS WHETHER ELIMINATION OF THE RENEWAL REQUIREMENT FOR WORKS PUBLISHED BETWEEN 1964 AND 1978 BURDENED EXPRESSION, AND TO DETERMINE WHETHER THE CHANGE WAS BROADER THAN NECESSARY TO SERVE THE GOVERNMENT’S INTERESTS

A. The Statutory Scheme Should Be Scrutinized Under the Doctrine of Substantial Overbreadth

The Amended Complaint alleges in essence that the 1992 Renewal Act is a substantially overbroad means of accomplishing Congress’s legitimate interests because it burdens large quantities of expression that would otherwise have entered the public domain and thereby been available for First Amendment-protected uses. The Supreme Court has explained that substantial overbreadth is not only a doctrine of third-party standing; it also describes “a challenge to a statute that in all its applications directly restricts protected First Amendment activity and does not employ means narrowly tailored to serve a compelling governmental interest.” *Secretary of State v. Munson*, 467 U.S. 947, 967 (1976) (citing *Schaumburg v Citizens for a Better Environment*, 444 U.S. 620, 637-39 (1980); *First National Bank*, 435 U.S. at 786; and *Zwickler v. Koota*, 389 U.S. 241, 250 (1967)).

Thus, in *Schaumburg*, a law regulating charitable fundraising was substantially overbroad because it “purported to prohibit canvassing by a substantial category of charities” to which it “could not be applied consistently with the First and Fourteenth Amendments.” 444 U.S. at 634. In *Houston v. Hill*, 482 U.S. 451, 458

(1987), and *Gooding v. Wilson*, 405 U.S. 518, 417 (1972), criminal statutes were struck down because they punished “a substantial amount of constitutionally protected conduct,” and thus, “swe[pt] too broadly.”⁹ In *Reno v. American Civil Liberties Union*, 521 U.S. 844, 874-79 (1997), a law that essentially prohibited all “indecent” speech online was invalidated under the strict scrutiny test despite its compelling purpose because of its facial overbreadth and the availability of less restrictive alternatives.

Viewed through the lens of substantial overbreadth, the plaintiffs have stated a claim that the 1992 Renewal Act, in the context of the overall shift to an unconditional copyright regime, restricted substantially more First Amendment activity than necessary to satisfy the government’s and society’s legitimate interest in a healthy copyright system. In addition to the broad range of works that the law renders essentially unavailable despite the probability that many of their owners do not wish to restrict their use, the harsh civil and criminal penalties for copyright infringement produce a chilling effect on archivists and other distributors. Such a chilling effect is a classic indicator of a substantially overbroad law. See *Munson*, 467 U.S. at 967; *Schaumburg*, 444 U.S. at 634; *Bates v. State Bar of Arizona*, 433

⁹ The copyright law of course also contains criminal provisions. 17 U.S.C. §506.

U.S. 350, 380 (1977).¹⁰ As in *City of Ladue v. Gilleo*, 512 U.S. 43, 55 (1994), the statutory scheme is overinclusive because it simply “prohibit[s] too much speech.”¹¹

The Amended Complaint alleges sufficient facts to support a First Amendment overbreadth claim. The plaintiffs should have an opportunity to prove their allegations in the district court. See *Virginia v. Hicks*, 539 U.S. 113, 121 (2003) (“The overbreadth claimant bears the burden of demonstrating, ‘from the text of [the law] and from actual fact,’ that substantial overbreadth exists” (quoting *New York State Club Assn., Inc. v. City of New York*, 487 U.S. 1, 14, (1988))).

B. At the Least, the Statutory Scheme Is Subject to Intermediate First Amendment Scrutiny

Even if the court does not agree that substantial overbreadth analysis is appropriate here, the 1992 Renewal Act at the least should be tested under the

¹⁰ By definition, an overbreadth challenge is “facial,” but the essence of an overbreadth claim is that the statute in question *applies* to a substantial amount of constitutionally protected speech, beyond its legitimate applications. Thus, the Amended Complaint’s characterization of the First Amendment claim as an attack on statutory changes “as they are applied to and affect a large volume of creative work,” ¶91, is consistent with a facial overbreadth challenge.

¹¹ See also Geoffrey Stone, *Content-Neutral Restrictions*, 54 U. Chi. L. Rev. 46, 57-58 (1987) (“To ensure ‘the widest possible dissemination of information,’ *Associated Press v. United States*, 326 U.S. 1, 20 ... (1945), and the ‘unfettered interchange of ideas,’ *Roth v. United States*, 354 U.S. 476, 484 ... (1957), the first amendment prohibits not only content-based restrictions that censor particular points of view, but also content-neutral restrictions that unduly constrict the opportunities for free expression.”)

intermediate scrutiny standard of *United States v. O'Brien*, 391 U.S. 367, 376-77 (1968). See also *Turner Broad. System v. FCC*, 512 U.S. 622, 662 (1994); *Ward v. Rock Against Racism*, 491 U.S. 781, 798-99 (1989). Under *O'Brien* and its successor cases, a content-neutral regulation will be upheld if “it furthers an important or substantial governmental interest; if the governmental interest is unrelated to the suppression of free expression; and if the incidental restriction on alleged First Amendment freedoms is no greater than is essential to the furtherance of that interest.” *Turner*, 512 U.S. at 662 (quoting *O'Brien*, 391 U.S. at 377). Accord, *Universal City Studios v. Corley*, 273 F.3d at 454; *321 Studios*, 307 F. Supp.2d at 1100.

The *O'Brien* narrow-tailoring requirement is not equivalent to the strict scrutiny/least speech-restrictive means test. *Ward*, 491 U.S. at 798-99. The government does not have to come up with the least burdensome means possible to serve its purpose. But this does not mean that a content-neutral legislative scheme “may burden *substantially* more speech than is necessary to further the government’s legitimate interests. Government may not regulate expression in such a manner that *a substantial portion of the burden on speech does not serve to advance its goals.*” *Id.* at 799 (emphases added).

Amici do not contest that Congress’ purpose in switching to an unconditional copyright system served significant government interests and was unrelated to the

suppression of speech. As the legislative history of the 1992 Copyright Renewal Act makes clear, Congress (and the former Register of Copyright) were rightly concerned that copyright owners not lose protection through “inadvertence or neglect.” S. Rep. No. 102-194 (1992) at 7. Evidently, some owners and their heirs failed to renew because they “lack[ed] the sophisticated resources [and] detailed recordkeeping procedures to keep track of renewal dates or the services of lawyers, agents, and large publishing houses to assist them in complying with the intricacies of the renewal provision,” or because “there was simply no knowledge that such a requirement existed, or there was the all-to-common procrastination involved in undertaking to deal with government red tape.” *Id.* at 4-5.¹²

The only question for the district court under intermediate scrutiny, therefore, would be narrow tailoring. There are two aspects to this inquiry: an evaluation of the speech interests burdened by the statutory scheme, and an assessment of other, less burdensome means of serving the government’s purpose.

¹² Similar concerns motivated Congress to eliminate notice and registration requirements; see H. Rep. 94-1476 (1976) at 143. Congress also wanted to comply with the Berne Convention once the U.S. acceded to it; see Berne Convention Implementation Act, Pub.L. 100-568, 102 Stat. 2853 (1988); Jane C. Ginsburg & John M. Kernochan, *One Hundred and Two Years Later: The U.S. Joins the Berne Convention*, 13 Colum.-VLA J.L. & Arts 1 (1988). This no doubt enhances the government’s substantial interest in easing copyright formalities, but it does not eliminate the need for First Amendment narrow tailoring.

Here, for many of the works whose copyrights have no commercial value, and which continue solely by virtue of the elimination of the renewal requirement, no interest whatever may be served: their owners may not wish to assert continued protection, and may even prefer that their works be made widely available. If the plaintiffs are right that more than 85% of copyrights would not be renewed,¹³ this alone suggests that “a substantial portion of the burden on speech” imposed by automatic renewal “does not serve to advance [Congress’] goals” of assuring that copyright owners do not lose protection through “inadvertence or neglect.” The “harsh consequences of inadvertent forfeiture” through failure to renew, about which Congress and the former Register of Copyright were rightly concerned in 1992, *id.* at 7,¹⁴ could very likely be avoided through measures much less sweeping

¹³ This number may be overstated because, as noted below, and as the legislative history of the 1992 Act indicates, some copyright owners and their heirs failed to renew because of lack of knowledge or resources. Finding the true percentage, or approximate percentage, of copyrights automatically extended by the 1992 Act whose owners did not want that protection is a task for the district court.

¹⁴ See also the House report accompanying the 1976 overhaul of copyright law, H.R. Rep. No. 94-1476 (1976) at 134 (“renewal requirement, “[i]n a number of cases ... is the cause of inadvertent and unjust loss of copyright. Under a life-plus-50 system the renewal device would be inappropriate and unnecessary”). Congress in this report, however, acknowledged that “most material which is considered to be of continuing or potential commercial value is renewed,” and that, of the remainder, “there are a large number of unrenewed works that have scholarly value to historians, archivists, and specialists in a variety of fields.” *Id.* at 136. But it failed to consider any solution to the problem that would be less restrictive of the First Amendment interests of these historians and archivists than its total elimination of the renewal requirement.

than a statutory scheme that extended automatic, unilateral, and lengthy protection to every work copyrighted in the years between 1964 and 1978.

For example, Congress could instruct the Copyright Office to allow easy correction of unknowing or inadvertent failures to renew, once an owner became aware of the problem and indicated a desire for extended protection. Another better-tailored alternative would require renewal at some point during the life-plus-50-year term created in 1976 – perhaps after the death of the author and during the administration of the estate.

At the very least, a system with an easily rebuttable presumption that works not renewed had entered the public domain would be less restrictive of First Amendment rights, without significantly burdening copyright owners. Under such a system, anyone who wished to assert copyright but failed to renew would be permitted to remedy the oversight upon becoming aware of it. The court in *Luck's Music Library v. Ashcroft*, 321 F.Supp.2d 107 (D.D.C. 2004), upheld a law that returned a category of public domain works to copyright-protected status in part because the statute created just such a system. It allowed parties to “exploit a restored work indefinitely if no notice is provided,” immunized parties “for acts prior to notification,” and allowed them “to continue exploiting the copyrighted works for a year after notice.” *Id.* at 119. Such accommodations, said the court, “supplement[ed] First Amendment protections by protecting parties who already

have exploited the restored copyrighted work while in the public domain.” *Id.* Similar accommodations of competing interests, where the copyright owner actually wants protection, would certainly be less restrictive than a system that unilaterally keeps all works copyrighted from 1964-1978 out of the public domain for 95 years or more,¹⁵ whether or not their owners can be found; and it would serve the interest in copyright protection equally well.

This is just one option that Congress might choose, once informed by a court that its wholesale shift to an unconditional regime burdens “substantially more speech than is necessary to further the government’s legitimate interests.” *Ward*, 491 U.S. at 799.

CONCLUSION

For the foregoing reasons, the judgment of the district court should be reversed.

Respectfully submitted,

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¹⁵ Under the latest term extension, copyright now continues for the life of the author plus 70 years, or 95 years for anonymous works, pseudonymous works, and works made for hire (*i.e.*, most corporate copyrights). Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998), amending 17 U.S.C. §302(a)-(c).

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