

# MICKEY MOUSE & SONNY BONO GO TO COURT: THE COPYRIGHT TERM EXTENSION ACT AND ITS EFFECT ON CURRENT AND FUTURE RIGHTS

VICTORIA A. GRZELAK\*

## INTRODUCTION

Congress has repeatedly extended the term of copyright protection in the past century.<sup>1</sup> Most recently, Congress extended the protection term for both existing and future copyrights by twenty years.<sup>2</sup> Now imagine that you are an artist, writer, or archivist who uses information in the public domain in order to create new works. Under the current "life-plus-seventy"<sup>3</sup> rule for copyrights, an artist who created a work in the 1930s and died at the age of seventy in the year 1970 will own the copyright of that work at least until the year 2040.<sup>4</sup> That amounts to 110 years<sup>5</sup> of protection under the Copyright Term Extension Act ("CTEA")!

So what is the significance of all this? Not only will the artist's children benefit financially from the copyright, but the artist's grandchildren will profit as well.<sup>6</sup> Moreover, it means that the artist, writer or archivist who wants to use the work must track down the copyright holder to get their permission.<sup>7</sup> In most cases, the copyright holder is not the creator himself and permission is needed regardless of whether the work is popular or profitable.<sup>8</sup> In other cases, the copyright holder will

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\* J.D./LL.M Candidate I.P., June 2003, The John Marshall Law School. B.S. Mgmt. Info. Systems, Northern IL University, 2000. The author would like to thank Ben Cotton, Adrienne Kitchen and Adam Gustafson for their editorial assistance as well as Prof. Doris Estelle Long for her insight.

<sup>1</sup> See, e.g., Sue Ann Mota, *Eldred v. Reno - Is the Copyright Term Extension Constitutional?*, 12 ALB. L.J. SCI. & TECH. 167, 169 (2001). In 1831, copyright terms were extended from fourteen years to twenty-eight years. *Id.* In 1909, this twenty-eight year term was changed from the date of filing to the date of publication. *Id.* Between 1962 and 1974, Congress passed a series of laws that incrementally extended existing copyrights. *Id.* By 1976, the Berne Convention recommended a basic copyright term of life of the author plus fifty years, which was adopted by the U.S. in 1989. *Id.*

<sup>2</sup> Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified as amended 17 U.S.C. §§ 108, 203, 301-304) [hereinafter CTEA].

<sup>3</sup> 17 U.S.C. § 302(a) (Supp. 1999). "In General.- Copyright in a work created on or after January 1, 1978, subsists from its creation and, except as provided by the following subsections, endures for a term consisting of the life of the author and 70 years from the author's death." *Id.*

<sup>4</sup> See generally Jane C. Ginsburg et al., *The Constitutionality of Copyright Term Extension: How Long is Too Long?*, 18 CARDOZO ARTS & ENT. L.J. 651, 674-675 (2000) (discussing the effects of the CTEA).

<sup>5</sup> The calculation for obtaining 110 years is as follows: 1970 + 70 (years) = 2040; 1970 - 1930 = 40 (years); 70 years + 40 years = 110 years of protections.

<sup>6</sup> Ginsburg, *supra* note 4, at 674-676.

<sup>7</sup> *Id.*

<sup>8</sup> *Id.*

not be identifiable and the prohibition on using the work impacts the creation of new works.<sup>9</sup>

Consequently, copyright laws, which restrict the ability of people to disseminate speech, have caused tension between creators and the public.<sup>10</sup> In this day and age, with the Internet being widely used, many internet publishers as well as others who use information in the public domain have joined forces to argue that the CTEA violates the United States Constitution.<sup>11</sup> The Supreme Court has also recently decided to intervene by granting the plaintiffs' writ of certiorari in *Eldred v. Ashcroft* to determine whether Congress has sided too heavily with writers and other inventors or if Congress has merely given writers and inventors the protection entitled to them under the Constitution.<sup>12</sup>

In as soon as two years, Walt Disney Corp. could lose copyrights it holds over Mickey Mouse and other highly profitable characters.<sup>13</sup> But there is no need to feel sorry for Disney quite yet. Disney, as well as other companies who are advocates of the twenty-year extension that the CTEA provides, has also profited from using information in the public domain to make new creations such as the "Hunchback of Notre Dame" and the "Little Mermaid."<sup>14</sup> Now, for the first time in history, based on the new term extension, no copyrighted work in the United States will enter the public domain before the year 2018<sup>15</sup> making it more difficult for new creations to develop.<sup>16</sup> Without access to works that would otherwise be public information,

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<sup>9</sup> See generally Erwin Chemerinsky, *Balancing Copyright Protections and Freedom of Speech: Why the Copyright Term Extension Act is Unconstitutional?*, 36 LOY. L.A. L. REV. (forthcoming Fall 2002), available at <http://lr.lls.edu/eldred/chemerinsky.pdf>. (last visited March 30, 2002).

<sup>10</sup> *Id.*

<sup>11</sup> *Eldred v. Ashcroft*, 255 F.3d 849, 850 (D.C. Cir. 2001), petition for cert. filed, 2001 U.S. Briefs 618 (U.S. Oct. 11, 2001) (No.01-618). The Plaintiffs in this case include Eric Eldred, Eldritch Press, Higginson Book Company, Jill A. Crandell, Tri-horn International, Luck's Music Library, Inc., Edwin F. Kalmus & Co., Inc., American Film Heritage, Moviecraft, Inc. and Dover Publications, Inc. *Id.* These corporations, associations, and individuals who rely upon works in the public domain petitioned for a rehearing en banc. *Id.* They renew their contentions that the Copyright Term Extension Act violates both the First Amendment and the Copyright Clause of the Constitution of the United States. *Id.*

<sup>12</sup> *Eldred*, 255 F.3d at 850, cert. granted, 2002 WL 232898 (U.S. Feb. 19, 2002) (No. 01-618). See also Gina Holland & Anne Gearan, *Justices Intervene in Internet Copyright Dispute*, CHICAGO DAILY LAW BULLETIN, February 19, 2002, at 2.

<sup>13</sup> See generally David Teather, *Copyright Case Threatens Disney*, THE GUARDIAN (London), February 20, 2002, available at LEXIS Library, News Group File, Most Recent Two Years (discussing how characters including Donald Duck, Pluto & Goofy would also lapse in a few years if the law were overturned).

<sup>14</sup> See Amy Harmon, *Case Could Shift Balance in Debate on Public Domain*, CHICAGO DAILY LAW BULLETIN, February 21, 2002, at 1. The "Hunchback of Notre Dame" was created and owned by Victor Hugo prior to falling into the public domain along with Hans Christian Andersen's "Little Mermaid." *Id.* Disney has made movies, toys and clothing drawing off of both of these characters and has profited as a result of such use. *Id.*

<sup>15</sup> Works created after 1922 will not fall into the public domain for an addition twenty years. Since the Copyright Term Extension Act was implemented in 1998, protection will last 20 years from that date until the year 2018.

<sup>16</sup> Dennis S. Karjala, *Opposing Copyright Extension*, available at [www.law.asu.edu/hopepage/karjala/opposingCopyrightExtension/what.htm#EffectofTermExtension](http://www.law.asu.edu/hopepage/karjala/opposingCopyrightExtension/what.htm#EffectofTermExtension) (last visited Mar. 21, 2002). See also L. Ray Patterson, *Eldred v. Reno: An Example of the Law of Unintended Consequences*, 8 J. INTELL. PROP. L. 223, 223-224 (2001) (discussing how the CTEA has prohibited information from entering the public domain).

artists incur burdensome costs and become discouraged from creating additional works.<sup>17</sup>

Considering that the United States Constitution secures for authors and inventors the exclusive rights to their works only for "limited Times," challengers question whether the CTEA is constitutional or whether Congress is abusing its power. Additionally, challengers argue that the CTEA interrupts the progress of science and the useful arts since it prevents others from using any information without permission for extended periods of time.<sup>18</sup> For example, protection lasting beyond the life of the author, or inventor, benefits people who have not contributed creatively to the work. In essence, such protection merely upholds the moral rights of the creator and it is questionable whether this is what the drafters of the CTEA had in mind.<sup>19</sup>

This Comment examines the constitutional problems associated with the CTEA by examining the history of copyright law and looking at the CTEA challenges in both *Eldred v. Reno*<sup>20</sup> and *Eldred v. Ashcroft*. Part I of this Comment will introduce the constitutional guarantees afforded to copyright holders as well as examine the history of copyrights, the current CTEA and discuss certain intellectual property principles. In Part II, this Comment will discuss the United States Court of Appeals decision in *Eldred v. Reno*, addressing the constitutionality of the CTEA in addition to discussing the current U.S. Supreme Court controversy in *Eldred v. Ashcroft*. This Comment will then examine the effect on current and future rights both within the United States and globally. Finally in Part III, this Comment will propose several possible solutions to the constitutional problems with the CTEA such as abandonment provisions, limited assignments, strengthening the fair use exception and placing mandatory ceilings on international copyright protection. This will allow for a better understanding regarding how the Supreme Court decision in *Eldred v. Ashcroft* may have serious effects on all current and future copyrights.

## I. BACKGROUND

### *A. The Constitutional Guarantees Provided for in Article I, Section 8, Clause 8*

Article I, Section 8, Clause 8 (hereinafter the "Copyright Clause") of the Constitution has been held to be both a grant of power and a limitation on

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<sup>17</sup> Chemerinsky, *supra* note 9, at 22. "It imposes a new economic cost on those wanted to engage in speech activities; now they must pay royalties if the speech is to occur at all (and even then might not be allowed)." *Id.*

<sup>18</sup> *Id.*

<sup>19</sup> *Id.* at 20. The CTEA seemed to be a result of the desire to allocate financial benefits and advancing moral rights did not seem to play any role in this. *Id.*

<sup>20</sup> 239 F.3d 372 (D.C. Cir. 2001).

copyrights.<sup>21</sup> It gives Congress the power "to promote the Progress of Science and useful Arts by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>22</sup> The Copyright Clause also indirectly requires Congress to balance the interests of authors and publishers against the interest of the public at large.<sup>23</sup> The language of the Copyright Clause is the heart of the controversy for challengers of the CTEA.<sup>24</sup>

Challengers of the CTEA believe that Congress has simply found a clever way to evade the constitutional command providing protection for "limited Times" by continuously extending the copyright term.<sup>25</sup> Moreover, challengers feel that Congress is defeating the intent of the Framers as well as indirectly creating an unlimited copyright term.<sup>26</sup>

In addition, since both the Copyright Act of 1976<sup>27</sup> and the CTEA<sup>28</sup> are regulations of speech and press, the question becomes whether they should be subject to heightened First Amendment<sup>29</sup> scrutiny.<sup>30</sup> Prior rulings have been interpreted to bar all First Amendment challenges to a copyright statute.<sup>31</sup> Challengers however,

<sup>21</sup> *Graham v. John Deere Co.*, 383 U.S. 1, 5 (1966). *See also* *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) (noting that art. I, § 8, cl. 8 is "a grant of power and certain limitations upon the exercise of that power").

<sup>22</sup> U.S. CONST. art. I, § 8 cl. 8.

<sup>23</sup> *See* Joseph A. Lavigne, *For Limited Times? Making Rich Kids Richer Via the Copyright Term Extension Act of 1996*, 73 U. DET. MERCY L. REV. 311, 316 (1996) (referring to the monopolistic protection of authors and publishers and the public's unrestricted access to works).

<sup>24</sup> Petitioners' Brief at 4-5, *Eldred v. Ashcroft* 255 F.3d 849 (D.C. Cir 2001) (No. 01-618) (stating that the "limited Times" condition should be read in light of the Copyright Clause's grant of power -- "To promote the Progress of Science." So understood, retrospective extensions would not be "limited" in a constitutional sense).

<sup>25</sup> *Id.* at 3. *See also* *Damien Cave, Mickey Mouse v. The People*, Salon.com Technology, at [www.salon.com/tech/feature/2002/02/21/web\\_copyright/print.html](http://www.salon.com/tech/feature/2002/02/21/web_copyright/print.html) (last visited Mar. 29, 2002). People who created a work in 1950 thought they would receive fifty years protection and that was fine with them. *Id.* Tying up additional material retroactively, decade after decade, in copyright is robbing the public. *Id.*

<sup>26</sup> *See* JOSEPH STORY, COMMENTARIES ON THE CONSTITUTION OF THE UNITED STATES, § 502, at 402 (Rotunda & J. Nowak eds. 1987) (discussing how the Framers intended that the copyright terms be, as Justice Story described them, "short," and that after that "short interval," creative works would fall into the public domain "without restraint").

<sup>27</sup> Copyright Act of 1976, 17 U.S.C. §§ 101-810 (1994 & Supp. 2000).

<sup>28</sup> CTEA, *supra* note 2.

<sup>29</sup> U.S. CONST. amend. I. "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances."

<sup>30</sup> Ginsburg, *supra* note 4, at 668. *See also* *Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622, 640-41 (1994) (referring to how the Supreme Court has stated that "laws that single out the press, or certain elements thereof are always subject to at least some degree of heightened First Amendment scrutiny").

<sup>31</sup> *Harper & Row, Publ'rs, Inc. v. Nation Enters.*, 471 U.S. 539, 558-559 (1985). In *Harper*, the defendant had used illegal or unfair means to obtain a copy of the plaintiff's unpublished manuscript. *Id.* at 555-556. The defendant argued that because the matter was of such public importance, First Amendment interests should trump Harper & Row's copyright interests. *Id.* The Court rejected the argument because they found that a copyright functions as an "engine of free expression" by creating an incentive to produce speech that would otherwise not be produced. *Id.* Thus, as long as copyright law regulates expression rather than ideas, *Harper* holds that there is no First Amendment right to trespass on an otherwise legitimate copyright. *Id.* at 558-559. *See also*

point to *Harper & Row v. Nation Enterprises*<sup>32</sup> arguing that its holding has simply been transformed from a narrow holding to a general rule.<sup>33</sup>

### *B. Copyright History in the United States*

Copyrights have always been an integral part of the law in the United States.<sup>34</sup> The Copyright Act of 1790 provided for an original term of fourteen years followed by an optional renewal of fourteen years.<sup>35</sup> Over time, Congress has expanded both the length of the copyright term and the types of works protected.<sup>36</sup> In 1831, the initial term of protection was extended from fourteen to twenty-eight years with the renewal term remaining at fourteen years under a two-tiered renewal system.<sup>37</sup> The next change came with the Act of 1909, in which Congress maintained the two-tiered renewal system but extended the renewal term to twenty-eight years.<sup>38</sup> The 1909 Act,

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*Worldwide Church of God v. Phila. Church of God, Inc.*, 227 F.3d 1110, 1115-16 (9th Cir. 2000) (citing *Harper* and rejecting the First Amendment defense to a copyright infringement case); *Religious Tech. Ctr. v. Henson*, 1999 U.S. App. LEXIS 11828, at 3 (9th Cir. 1999) (in a "copyright infringement action" the court relied upon *Harper* to hold "the Copyright Act already embraces First Amendment concerns"); *Cable/Home Comm. Co. v. Network Prod., Inc.*, 902 F.2d 829, 850 (11th Cir. 1990) (citing *Harper* and rejecting "First Amendment affirmative defense regarding ... copyright ... violations, court held the "First Amendment is not a license to trammel on legally recognized rights in intellectual property").

<sup>32</sup> *Harper*, 471 U.S. at 558-559.

<sup>33</sup> Petitioners' Brief, *supra* note 24, at 21. The petitioners in *Eldred* argued that *Harper* held that there can be no First Amendment right to trespass. *Id.* Therefore, courts expanding this holding to include no First Amendment rights to challenge the legal rule under which property rights are set cannot be upheld. *Id.* Furthermore, petitioners asserted that state action establishing property rights is fully subject to First Amendment scrutiny, even if private action exercising these state established rights is subject to a narrower First Amendment rule. *Id.* at 22. Therefore, the D.C. Circuit's conclusion to the contrary that "copyrights are categorically immune from challenges under the First Amendment is simply mistaken." *Id.* The petitioners distinguish this reasoning from their current case by arguing that the courts addressing the issue have failed to explain how such reasoning would apply to a First Amendment challenge to future copyrights. *Id.*

<sup>34</sup> See generally Christina N. Gifford, *The Sonny Bono Copyright Term Extension Act*, 30 U. MEM. L. REV. 363, 366-367 (2000) (discussing the history of copyright and how twelve of the thirteen original states adopted some form of copyright law under the Articles of Confederation).

<sup>35</sup> Copyright Act of 1790, ch. 15, § 1.

<sup>36</sup> Brain A. Carlson, *Balancing the Digital Scales of Copyright Law*, 50 SMU L. REV. 825, 830 (1997). Initially the scope of copyright law covered only maps, charts and books. *Id.* Over the years however the term "writings" has broadened to include "any physical rendering of the fruits of creative or aesthetic labor," and not just script or printed material. *Id.* Such a broad definition covers technologies that do not yet exist. *Id.*

<sup>37</sup> See Gifford, *supra* note 34, at 368 (discussing the changes made by the Act of Feb. 3, 1831, ch. 16, §§ 1-2, 4 Stat. 436 (1831)). Two significant changes made by the Act of 1831 were: 1) elimination of the ability to make contingent assignments of the entire term including renewal rights concurrently with assignments of the initial term, and 2) security for families of an author who died during the initial term by granting the renewal right to the surviving spouse of children. *Id.*

<sup>38</sup> Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075 (1909).

however, contained ambiguities, requiring judicial interpretation and eventually leading to a call for further change.<sup>39</sup>

The Copyright Act of 1976 represented a shift in the way the United States perceived copyrights. With the advent of photocopiers, computers and videocassette recorders, the then existing copyright laws required revision.<sup>40</sup> The most drastic change of the 1976 Act replaced the fixed twenty-eight year term followed by the twenty-eight year renewal, with a single term for the life of the author plus fifty years.<sup>41</sup> The desire to switch to a single term was sought to eliminate problems associated with failing to renew copyright protection in a timely manner. This new term did not apply to preexisting works.<sup>42</sup> However, the renewal term for works already in existence was extended to forty-seven years.<sup>43</sup>

In addition, another driving force behind the adoption of a single term was the desire of the United States to join the Berne Convention<sup>44</sup> for increased international copyright protection.<sup>45</sup> At that time, most European countries were already parties to international copyright protection and the absence of the United States from such agreements was significant.<sup>46</sup> The purpose of the Convention was to provide the same protection that is available to an author in his own country to authors in all member countries through a policy of reciprocity.<sup>47</sup> Since the United States had an interest in international trade and world leadership, it became a signatory to the Berne Convention in 1988 to show their commitment to protecting intellectual property rights.<sup>48</sup>

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<sup>39</sup> See Jenny L. Dixon, *The Copyright Term Extension Act: Is Life Plus Seventy Too Much?*, 18 HASTINGS COMM. & ENT. L.J. 945, 958 (1996) (discussing how "several attempts had been made to revise the 1909 Act between 1924 and 1974, but these general revision bills failed").

<sup>40</sup> See Jessica D. Litman, *Copyright, Compromise and Legislative History*, 72 CORNELL L. REV. 857, 857-858 (1987) (indicating that by the 1970's, the 1909 Act was clearly outdated and legislative action was necessary).

<sup>41</sup> 17 U.S.C. § 302(a) (1994). "Copyright in a work created on or after January 1, 1978, subsists from its creation and, except as provided by the following subsections, endures for a term consisting of the life of the author and fifty years after the author's death." *Id.*

<sup>42</sup> 17 U.S.C. § 302(a) (Supp. 1999).

<sup>43</sup> 17 U.S.C. § 304(a)(2)(B), (b).

<sup>44</sup> Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, *revised*, Paris, July 24, 1971, 25 U.S.T. 1341 (1988) [hereinafter Berne Convention]. All signatories of the Berne Convention were required to provide a minimum term of protection of life of the author plus fifty years. *Id.*

<sup>45</sup> See generally FRANK ROMANO, GLOBAL TRADEMARK AND COPYRIGHT 1998: PROTECTING INTELLECTUAL PROPERTY RIGHTS IN INTERNATIONAL CONVENTIONS AND TREATIES, 545-557 (Practising Law Institute, 1998) (analyzing international treaties that protect copyrights and discussing the protection they give). See also Mota, *supra* note 1, at 169-170 (stating that the Trade Related Aspects of Intellectual Property Rights (TRIPS) agreement implemented in the United States in 1994 also mandated a minimum copyright term of the author's life plus fifty years).

<sup>46</sup> Dixon, *supra* note 39, at 958-959. The United States efforts encouraging other nations to modernize copyright law were seriously undermined by its own absence from the Berne Convention. *Id.* In addition, American authors had few guarantees of the protection abroad and the United States felt the pressure of providing a comprehensive solution. *Id.*

<sup>47</sup> Berne Convention, *supra* note 44, at art. 3; see also Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (codified at 17 U.S.C. §§ 101-104, 116, 301, 401-402, 404-408, 801 (1988)).

<sup>48</sup> E.C. Directive Harmonizing the Term of Protection of Copyright and Certain Related Rights, Council Directive 93/98/EEC of 29 Oct. 1993, *reprinted* in Paul Goldstein, *International Copyright: Principles, Law, and Practice* (2001).

*C. The CTEA (The Sonny Bono Act) of 1998*

On October 27, 1998, then President Bill Clinton, after extensive lobbying by Disney, approved the CTEA.<sup>49</sup> The CTEA amends various provisions of the Copyright Act of 1976.<sup>50</sup> Its provisions have also been made applicable both prospectively and retrospectively in order to bring United States rules in line with those of the European Union.<sup>51</sup> The most important aspect the CTEA provides is an *additional* twenty years on top of the fifty years following the life of the author for works created after 1977.<sup>52</sup> This allows the author to protect the work for his or her lifetime plus seventy-years.<sup>53</sup> The provision also extends to joint works where the term is life of the last surviving author plus seventy years.<sup>54</sup>

The twenty-year extension served to "ensure adequate copyright protection for American works in foreign nations."<sup>55</sup> In addition, Congress believed that the additional twenty-year extension would benefit works in the public domain by encouraging the creation of new works and providing incentives for the preservation of existing works.<sup>56</sup> However, challengers of the proposed extension disagree. With the Internet opening the door to draw upon and develop creative works without restraint, they argue the "extension of copyright laws [is] closing off this medium to a broad swath of common culture."<sup>57</sup> Some critics of the CTEA also say that the repercussions of such an extension are that books, movies and sound recordings are being lost before they can be archived, and are therefore gone forever.<sup>58</sup>

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<sup>49</sup> Cave, *supra* note 25, at [www.salon.com/tech/feature/2002/02/21/web\\_copyright/print.html](http://www.salon.com/tech/feature/2002/02/21/web_copyright/print.html). See also Associated Press, *Disney Lobbying for Copyright Extension No Mickey Mouse Effort*, CHI. TRIB., available at [www.law.asu.edu/HomePages/Karjala/OpposingCopyrightExtensi.../ChiTrib10-17-98.htm](http://www.law.asu.edu/HomePages/Karjala/OpposingCopyrightExtensi.../ChiTrib10-17-98.htm) (last visited Mar. 29, 2002).

<sup>50</sup> CTEA § 101 et seq., 112 Stat. 2827 (1998) (amending 17 U.S.C. §§ 302, 304).

<sup>51</sup> *Id.*

<sup>52</sup> CTEA § 102(b) and (d), 112 Stat. 2827 (1998). (amending 17 U.S.C. 302, 304). The Act applied to all original works that, at the time of the Act's effective date, had not fallen into the public domain. *Id.*

<sup>53</sup> 17 U.S.C. § 302(a) (Supp. 1999).

<sup>54</sup> See Pub L. No. 105-298 § 102(b)(1), 112 Stat.; 17 U.S.C. § 302(a). For a work created in 1978 or later, to which an individual author holds the copyright, the Act extends the term to the life of the author plus 70 years. *Id.* See also Pub. L. No. 105-298 § 102(b)(3), 112 Stat. 2827; 17 U.S.C. § 302(c). For a work created in 1978 or later that is anonymous, or pseudonymous, or is made for hire, the term is extended from 75 to 95 years from the year of publication or from 100-120 years from the year of creation, whichever occurs first. *Id.*; Pub. L. No. 105-298 § 102(d), 112 Stat. 2827; 17 U.S.C. § 304. For a work created before 1978, for which the initial term of the copyright was 28 years, the renewal term is extended from 47-67 years, thereby creating a combined term of 95 years. *Id.*

<sup>55</sup> S. Rep. No. 104-315, at 3 (1996).

<sup>56</sup> *Id.*

<sup>57</sup> See Holland & Gearan, *supra* note 12, at 2 (referring to a statement made by Eldred's attorney Lawrence Lessig).

<sup>58</sup> See *Id.* This, they believe, is based in part on the notion that publishers only keep materials that are economically profitable and once the popularity and profitability ceases, the materials go into storage or become unavailable for a number of years. *Id.* See also Cave, *supra* note 25, at [www.salon.com/tech/feature/2002/02/21/web\\_copyright/print.html](http://www.salon.com/tech/feature/2002/02/21/web_copyright/print.html); Chris Springman, *The Mouse that Ate the Public Domain*, FindLaw's Legal Commentary, at [http://writ.news.findlaw.com/commentary/20020305\\_springman.htm](http://writ.news.findlaw.com/commentary/20020305_springman.htm) (last visited Mar. 13, 2002).

#### *D. Intellectual Property Principles*

There are a number of intellectual property principles that define the rights afforded to both creators and the public. The public domain for one is a term used to indicate that there is not a copyright claim on a creation or that the copyright has expired allowing one to use the materials freely.<sup>59</sup> The main argument that stems from the public domain is whether or not its existence creates rights; and if so, whether there is a constitutional or statutory basis for such a right.<sup>60</sup> Artists in general, depend on a rich public domain because the creation of new works inevitably rests on the borrowing of existing ideas.<sup>61</sup>

History has demonstrated this with the fictional creation of Santa Claus and the famous Christmas season movie "It's a Wonderful Life."<sup>62</sup> Santa Claus was created by a 19<sup>th</sup> century American cartoonist, Thomas Nast, and had his copyright been protected by the CTEA proposal, families across the world may have never been able to enjoy Santa Claus.<sup>63</sup> Instead, people would have had to seek permission from Thomas Nash and pay royalties for its use even though the Santa Claus concept was already recognized by several cultures.<sup>64</sup> Similarly, Frank Capra's 1946 film "It's a Wonderful Life" received a second life after it fell into the public domain.<sup>65</sup> After several broadcasting stations aired the movie, the once-forgotten film became a classic.<sup>66</sup>

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<sup>59</sup> Robert A. Baron, *Making the Public Domain Public*, Copyright Town Meeting, at <http://www.pipeline.com/~rabaron/VRA-TM-SF-PublicDomain.htm> (last visited Mar. 13, 2002). The significance of works that have fallen into the public domain is that one cannot prevent another from using the work. *Id.*

<sup>60</sup> *Id.* The advocates who have argued that rights to the public domain exist use the Ninth Amendment which states "The enumeration in the Constitution, of certain rights, shall not be construed to deny or disparage others retained by the people" to support their position." *Id.*

<sup>61</sup> Karjala, *supra* note 16, at [www.law.asu.edu/hopepage/karjala/opposingCopyrightExtension/what.html#EffectofTermExtension](http://www.law.asu.edu/hopepage/karjala/opposingCopyrightExtension/what.html#EffectofTermExtension). See also Springman, *supra* note 58, at [http://writ.news.findlaw.com/commentary/20020305\\_springman.htm](http://writ.news.findlaw.com/commentary/20020305_springman.htm) (noting that there is an abundance of "evidence regarding the vital importance to the progress of our culture of a robust stock of public domain works").

<sup>62</sup> See Henry Weinstein et al., *Studios May Have the Most to Loose*, LOS ANGELES TIMES, available at [www.latimes.com/business/la-000013191feb21.story](http://www.latimes.com/business/la-000013191feb21.story) (last visited Mar. 13, 2002) (discussing how the Supreme Court ruling in *Eldred v. Ashcroft* could affect early depictions of Mickey Mouse, film classics such as "Gone With the Wind" and the "Wizard of Oz" as well as novels such as "The Great Gatsby" and "The Sun Also Rises").

<sup>63</sup> Karajala, *supra* note 16, at [www.law.asu.edu/hopepage/karjala/opposingCopyrightExtension/what.html#EffectofTermExtensio](http://www.law.asu.edu/hopepage/karjala/opposingCopyrightExtension/what.html#EffectofTermExtensio).

<sup>64</sup> *Id.*

<sup>65</sup> Weinstein, *supra* note 62, at [www.latimes.com/business/la-000013191feb21.story](http://www.latimes.com/business/la-000013191feb21.story). The copyright to "It's a Wonderful Life" was allowed to lapse because of an oversight and it gathered dust in a movie studio until the early 1970's when its copyright expired. *Id.*

<sup>66</sup> *Id.* See also Reel Classics, *It's a Wonderful Life Academy Awards*, at <http://www.reelclassics.com/Movies/Wonlife/wonlife-awards.htm> (last visited June 30, 2002). "It's a Wonderful Life" has been nominated for numerous academy awards in the categories of best picture, best actor, best director, best film editing and best sound recording. *Id.*; Roger Cadenhead, *Why TV Lost Interest in a Holiday Classic*, Knight-Ridder News Service, at <http://www.reelclassics.com/Movies/Wonlife/wonlife-articles.htm> (last visited June 30, 2002). The practically continuous broadcast of the Frank Capra classic ended in 1993, when Republic Pictures asserted its right to receive royalty payments for each showing of "It's A Wonderful Life." *Id.*



Another popular intellectual property principle is the fair use doctrine.<sup>67</sup> Traditionally, fair use was defined as "a privilege in others than the owner of the copyright to use the copyrighted material in a reasonable manner without consent."<sup>68</sup> The fair use concept, implemented primarily to decrease First Amendment concerns, requires courts to undertake a case by case analysis.<sup>69</sup> As codified in the Copyright Act of 1976, the fair use doctrine employs a general guide for decision including four statutory factors plus any other factors the court deems appropriate.<sup>70</sup> Given the doctrine's open ended, case specific application, there has been criticism for its inconsistent application.<sup>71</sup>

The public domain and the fair use doctrine exist so that all works serve and benefit the public and society as a whole.<sup>72</sup> Since both of these principles are unclear and ambiguous the balancing of the public's rights with those of artists and inventors is difficult. Accordingly, the United States Supreme Court's pending decision in *Eldred v. Ashcroft* will have an immediate and long-term impact on all current and future copyrights.

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Republic has cautioned broadcasters, cable channels and video dealers not to sell, rent or show the movie without paying royalties. *Id.*

<sup>67</sup> 17 U.S.C. § 107 (Supp. 1999).

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.

*Id.*

<sup>68</sup> H. BALL, LAW OF COPYRIGHT AND LITERARY PROPERTY 260 (1944).

[T]he author's consent to a reasonable use of his copyrighted works ha[d] always been implied by the courts as a necessary incident of the constitutional policy of promoting the progress of science and the useful arts, since a prohibition of such use would inhibit subsequent writers from attempting to improve upon works and thus ... frustrate the very ends sought to be attained.

*Id.*

<sup>69</sup> See *Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F. 3d 65, 74 (2nd Cir. 1999) (discussing how the Second Circuit has "repeatedly rejected First Amendment challenges to injunctions from copyright infringement on the ground that First Amendment concerns are protected by and coextensive with the fair use doctrine").

<sup>70</sup> 17 U.S.C. § 107 (Supp. 1999).

<sup>71</sup> See 1 MELVIN B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05(A)(2001) (analyzing fair use factors and concluding that their "infinite elasticity" results in their "inability to resolve difficult questions").

<sup>72</sup> Baron, *supra* note 59, at <http://www.pipeline.com/~rabaron/VRA-TM-SF-PublicDomain.htm>. Quoting Eric Eldred, Baron notes that

copyright doesn't mean the right to deny others right to copy, but rather registers "ownership" or a bundle of rights to specific creative expression, including copying, making derivative works, publishing or not publishing, and so on. But if this "ownership" concept is okay, then why not go on and assert that the "public" has certain rights (fair use, etc., etc.) that are implicit in the creation and publication of any creative expression, copyrighted or not.

*Id.*

## II. ANALYSIS

### *A. The Court of Appeals for the District of Columbia's rejection to the Constitutional Challenges of the CTEA - Eldred v. Reno*

Eric Eldred,<sup>73</sup> a publisher of old books, never intended to become the heart of a copyright war.<sup>74</sup> In his view, the CTEA harmed the public by retroactively extending the copyright term for works that were about to expire.<sup>75</sup> As a result, huge corporations that were able to spend extensive money lobbying Congress would benefit and the small publishers would suffer.<sup>76</sup> In order to protect the small publishers, Eldred and other plaintiffs' like Laura Bjorklund,<sup>77</sup> in a sense, took Mickey Mouse and Sonny Bono<sup>78</sup> to court.<sup>79</sup>

#### *1. The First Amendment Freedom of Speech Challenge*

The most prevalent argument challenging the CTEA centered on the First Amendment because of the prospective and retrospective application of the CTEA.<sup>80</sup> The plaintiffs believed that the CTEA failed to sustain the intermediate level of scrutiny test<sup>81</sup> afforded by the First Amendment because the government did not

<sup>73</sup> Cave, *supra* note 25, at [www.salon.com/tech/feature/2002/02/21/web\\_copyright/print.html](http://www.salon.com/tech/feature/2002/02/21/web_copyright/print.html). Eric Eldred is an Internet Publisher whose website has hosted versions of old Nathaniel Hawthorne novels and Robert Frost Poems since 1995. *Id.*

<sup>74</sup> *Id.*

<sup>75</sup> *Id.*

<sup>76</sup> *Id.* See also Weinstein, *supra* note 62, at [www.latimes.com/business/la-000013191feb21.story](http://www.latimes.com/business/la-000013191feb21.story). Large corporations such as Disney have characters with enormous earning potential because of licensing and merchandize. *Id.* Winnie the Pooh for instance, generated \$2 billion a year in the late 1990's. *Id.*

<sup>77</sup> Cave, *supra* note 25, at [www.salon.com/tech/feature/2002/02/21/web\\_copyright/print.html](http://www.salon.com/tech/feature/2002/02/21/web_copyright/print.html). Laura Bjorklund owns a small publishing company in Massachusetts and focuses on genealogy texts and out-of-print histories. *Id.*

<sup>78</sup> See Lawrence Lessig, *Copyright's First Amendment*, 48 UCLA L. REV. 1057, 1064 (2001). Congressman Mary Bono lobbied Congress on behalf of her late husband Sonny Bono for extension of copyright protection. *Id.* According to her, Sonny Bono wanted the term of copyright protection to last forever. *Id.* Realizing that such a change would in fact violate the U.S. Constitution, Ms. Bono extensively pushed for strengthening copyright laws. *Id.* Her efforts were successful when Congress increased term protection by 20 years and named the Act after her late husband Sonny Bono. *Id.*

<sup>79</sup> See Phyllis Schlafly, *Why Disney has Clout with the Republican Congress*, Eagle Forum, at [www.eagleforum.org/column/1998/nov98/98-11-25.html](http://www.eagleforum.org/column/1998/nov98/98-11-25.html) (last visited Mar. 4, 2002). The Disney Political Action Committee (PAC) lined up Republican and Democratic co-sponsors on the two Judiciary Committees and rewarded them with direct campaign contributions totaling \$95,805 to the Democratic Members of Congress and \$53,807 to Republican Members. *Id.*

<sup>80</sup> *Eldred*, 239 F.3d at 374-376. The plaintiffs' cited *Simon & Schuster, Inc v. Members of NY State Crime Victims Bd.*, 502 U.S. 105, 115-23 (1991) which held statutes unconstitutional under the First Amendment. *Id.*

<sup>81</sup> *Turner Broad Sys.*, 512 U.S. at 640. In First Amendment cases involving different speech issues, Courts have invoked the content-based/content-neutral distinction as a basis for its decisions. *Id.* Presumably, content-based restrictions are invalid on their face requiring strict

have an "important" interest to justify withholding speech.<sup>82</sup> The government, on the other hand, questioned the standing of the plaintiffs to even raise a First Amendment issue.<sup>83</sup> The plaintiffs had to then successfully demonstrate that an injury in fact would be traceable to the CTEA for both current copyrights and works not yet created.<sup>84</sup> The struggle was far from over. Eldred and his pals still had to overcome the *Harper* decision, which stood as a bar to their First Amendment theory.<sup>85</sup>

In *Harper*, the Court held that a magazine's advance publication of excerpts from former President Gerald Ford's memoirs infringed upon the former President's copyrights.<sup>86</sup> The Court also explained how a copyright itself respects and adequately safeguards the freedom of speech protected by the First Amendment.<sup>87</sup> In essence, copyright laws are not restrictions on freedom of speech, as copyright protects only forms of expression and not the ideas expressed.<sup>88</sup> In following the *Harper* approach, courts have held that copyrights are categorically immune from challenges under the First Amendment.<sup>89</sup>

Despite the plaintiffs' argument that *Harper* is restricted to cases where a litigant demands a right under the First Amendment to use copyrighted materials, the Court disposed of the claim.<sup>90</sup> The Court found the plaintiffs theory entitling a First Amendment challenge to the constitutionality of the statute granting the

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scrutiny. *Id.* Content-neutral regulations on the other hand, are valid if they meet intermediate scrutiny. *Id.*

<sup>82</sup> See *Eldred*, 239 F.3d at 374-376 (citing *San Fran. Arts and Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 535-41 (1987) which applied heightened scrutiny to a statute granting the United States Olympic Committee trademark like protection for the word "Olympic").

<sup>83</sup> *Id.* at 375.

<sup>84</sup> *Id.* at 375-376. The plaintiffs' referred to *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560-61 (1992) for the proposition that they would suffer an injury in fact that was traceable to the CTEA. *Id.*

<sup>85</sup> *Id.* The Court in conjunction with *Harper* cited *United Video, Inc. v. FCC*, 890 F.2d 1173 (1989) for the proposition that copyrights are categorically immune from challenges under the First Amendment. *Id.*

<sup>86</sup> *Harper*, 471 U.S. at 539. Gerald Ford contracted with Harper & Row and The Reader's Digest to publish his yet unwritten memoirs. *Id.* As the memoirs were nearing completion, Harper & Row negotiated a prepublication licensing agreement with Time magazine. *Id.* Time agreed to pay \$25,000, \$12,500 in advance and an additional \$12,500 at publication with exclusivity being an important consideration. *Id.* Weeks before the Time article's scheduled release, an unidentified person secretly brought a copy of the Ford manuscript to Victor Navasky, editor of Nation magazine. *Id.* Navasky reprinted the material prior to Time's schedule release and as a result, Time canceled its piece and refused to pay Harper & Row the remaining \$12,500. *Id.*

<sup>87</sup> *Id.* at 557.

<sup>88</sup> *Feist Publ'ns, Inc. v. Rural Telephone Serv. Co., Inc.*, 499 U.S. 340, 348-349 (1991).

<sup>89</sup> *United Video*, 890 F.2d at 1191 (1989).

In the present case, the petitioners desire to make commercial use of the copyrighted works of others. There is no first amendment right to do so. Although there is some tension between the Constitution's copyright clause and the First Amendment, the familiar idea/expression dichotomy of copyright law, under which ideas are free but their particular expression can be copyrighted, has always been held to give adequate protection to free expression.

*Id.*

<sup>90</sup> *Eldred*, 239 F.3d at 375-376. The plaintiffs' attacked the constitutionality of the CTEA as a statute and attempted to distinguish their claim from the holding in *Harper* which dealt with a First Amendment challenge to the use of particular copyrights. *Id.* The Court was not persuaded. *Id.*

copyright to lack any cognizable First Amendment right to exploit the copyrighted works of others.<sup>91</sup>

## 2. Preexisting Works Lack Originality

A second claim challenging the constitutionality of the CTEA rested on the premise that the originality requirement of the Copyright Act with respect to its application to preexisting works had not been met.<sup>92</sup> The reasoning behind this is that the CTEA cannot be applicable to existing copyrights because their prior existence provides no incentive to create and the speech that benefits from the extension has already occurred.<sup>93</sup> Plaintiffs relied on *Feist Publications, Inc. v Rural Telephone Service Co.*,<sup>94</sup> in which the Supreme Court found originality to be a constitutional requirement for a copyright.<sup>95</sup> Additionally, the plaintiffs pointed to *Graham v. John Deere Co.*,<sup>96</sup> for its proposition that "Congress may not authorize the issuance of patents<sup>97</sup> whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available."<sup>98</sup> Applying the *Graham* standard to the subject of copyrights would preclude Congress from authorizing a copyright to a work already in the public domain.<sup>99</sup>

The District of Columbia, however, shot down this argument by concluding that the requirement of originality is, by its nature, only a threshold question relevant to copyrightability and not a continuing concern relevant to Congress' authority to extend the term of the copyright.<sup>100</sup> According to the Court, in order for the plaintiffs to have prevailed, they needed something more than the requirement of originality upon which to make their argument survive.<sup>101</sup>

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<sup>91</sup> *Id.*

<sup>92</sup> *Id.* at 376-377.

<sup>93</sup> *Id.* See also *Feist*, 499 U.S. at 345 (emphasizing that a work of authorship must be "original" in order to qualify for copyright protection).

<sup>94</sup> *Feist*, 499 U.S. at 346.

<sup>95</sup> *Id.* In *Feist*, the Supreme Court found telephone white page listings did not satisfy the originality requirement because they lacked minimal creativity. *Id.* at 362-363. The white pages listed the names of telephone service subscribers alphabetically, including the subscriber's town and phone number. *Id.* The Court deemed this selection and arrangement involved no creativity and thus was not original for copyright protection. *Id.*

<sup>96</sup> *Graham*, 383 U.S. at 6.

<sup>97</sup> See generally U.S. CONST. art. I, § 8 cl. 8. Since both patents and copyrights are governed by the same constitutional clause, the *Graham* decision should apply equally to copyrights.

<sup>98</sup> *Graham*, 383 U.S. at 6. It would be beyond Congress' constitutional power to grant a patent to a work in the public domain. *Id.*

<sup>99</sup> *Id.* See also Trade-Mark Cases, 100 U.S. 82, 94, 25 L.Ed. 550 (1879) (discussing the notion that the issuance of a trademark could not be justified under the Copyright Clause because the subject matter of trademark is "the adoption of something already in existence").

<sup>100</sup> *Eldred*, 239 F.3d at 377.

<sup>101</sup> *Id.*

### 3. The "Limited Times" Restriction Imposed by Article 1 Section 8, Clause 8 of the Constitution

A third argument challenging the CTEA's constitutionality was based on the idea that the CTEA violates the "limited Times" requirement of the Copyright Clause which was created "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>102</sup> It was the plaintiffs' view that since Congress could not make copyright protection permanent, it could not retroactively continue to protect copyrights.<sup>103</sup> The CTEA therefore, in effect, indirectly made copyright protection permanent in violation of the of the "limited Times" restriction.<sup>104</sup>

The Court disregarded the argument and found that it ran squarely against the holding in *Schnapper v. Foley*,<sup>105</sup> which rejected the argument that "the introductory language of the Copyright Clause constitutes a limit on congressional power."<sup>106</sup> The Court also refused to acknowledge that the predecessors had interpreted the terms "authors" and "writings" in light of the Preamble, and they refused to do the same by interpreting "limited Times."<sup>107</sup> In dismissing the third and final claim, the Court in effect stated that a court sitting *en banc*<sup>108</sup> in the future could revisit the issue.<sup>109</sup>

### 4. Criticisms of *Eldred v. Reno*

The most notable criticism of *Eldred v. Reno* was that its decision was contrary to the Supreme Court's tradition of rendering copyright decisions that serve the public interest.<sup>110</sup> In addition, the Court's finding that the Copyright Clause is irrelevant to both Congress' power to enact copyright statutes and their duty to

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<sup>102</sup> *Id.* at 377-378.

<sup>103</sup> *Id.* at 378.

<sup>104</sup> *Id.*

<sup>105</sup> *Schnapper v. Foley*, 667 F.2d 102, 115-117 (D.C. Cir. 1981).

<sup>106</sup> *Eldred*, 239 F.3d at 378.

<sup>107</sup> *Id.*

<sup>108</sup> See BARRON'S LAW DICTIONARY 167 (4th Ed. 1996) (defining the term *en banc* as "by the full court"). Many appellate courts sit in parts or divisions of three or more judges from among a larger number of the full court. These parts will generally decide a particular case but sometimes either on the courts motion or at the request of one of the litigants the court will consider the matter by the full court rather than by only a part thereof.

<sup>109</sup> *Eldred*, 239 F.3d at 380.

<sup>110</sup> *Patterson*, *supra* note 16, at 224. See also *Wheaton v. Peters*, 33 U.S. 591 (1834) (holding that copyright is a limited statutory monopoly, not the perpetual common law monopoly that the publishers sought); *Baker v. Seldon*, 101 U.S. 339 (1879) (holding that copyright does not protect ideas, as the Plaintiff claimed in seeking to protect his method of bookkeeping); *Bobbs-Merrill v. Straus*, 210 U.S. 339 (1908) (holding that a publisher's sale of a copy of a work exhausted the right to control the future sale of that copy); *Sony Corp. of Am. V. Universal City Studios, Inc.*, 464 U.S. 417 (1984) (holding that an individual can copy a copyrighted motion picture off the air for personal use without infringing the copyright); *Feist*, 499 U.S. at 340 (holding that white pages of telephone directories are not copyrightable because they are not original and originality is a constitutional condition for copyright).

interpret those statutes has been deemed a bad decision-making process.<sup>111</sup> Moreover, lobbying efforts, particularly by Disney, who has made extensive contributions to both the House and Senate,<sup>112</sup> has made the decision in *Eldred v. Reno* highly controversial.<sup>113</sup>

The dissent in *Eldred v. Reno* also criticizes the government's failure to offer any theory as to how retroactive extension can promote the useful arts.<sup>114</sup> Rejecting the majority's *Schnapper* argument, Judge Sentelle, dissenting, stated that the decision could be construed not as a holding, but simply dicta and not binding on future panels.<sup>115</sup> In concluding, Judge Sentelle found two of the majority arguments to be unpersuasive.<sup>116</sup> First, the majority's reliance on the enactment by Congress in 1790 that regularized the state of copyright law for works protected by state acts preexisting the Constitution was, in his opinion, *sui generis*.<sup>117</sup> Second, the majority's reliance on the fact that the CTEA matches that of the European Union is immaterial since neither the European Union nor its constituent countries are bound by the Constitution of the United States.<sup>118</sup> Evidently, one or more of these criticisms must have had some weight for there is now another controversy.

### *B. The Current Controversy - Eldred v. Ashcroft*

In the current constitutional challenge to the CTEA, the plaintiffs, who are again corporations, associations and individuals who rely upon works in the public domain for their careers, petitioned for rehearing.<sup>119</sup> The plaintiffs did not challenge the *Schnapper v. Foley* decision; instead they maintained that the substantive grant of power in the Copyright Clause - authorizing Congress to grant copyrights for "limited Times" - does not authorize Congress to extend the terms of copyrights as it did with the CTEA.<sup>120</sup> In contrast to the plaintiffs approach, an argument by *amicus*<sup>121</sup> maintained that the CTEA violated the preamble of the Copyright Clause because extending the term of an existing copyright does not promote the progress of science and the useful arts.<sup>122</sup>

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<sup>111</sup> Patterson, *supra* note 16, at 225. Logically, courts should be bound by the Copyright Clause in interpreting copyright statutes just as Congress should be bound by it in enacting them. *Id.*

<sup>112</sup> Schlafly, *supra* note 79, at [www.eagleforum.org/column/1998/nov98/98-11-25.html](http://www.eagleforum.org/column/1998/nov98/98-11-25.html). Of the twelve sponsors of the Senate bill, nine received contributions from Disney. *Id.* Of the 13 sponsors of the House bill, ten received contributions from Disney. *Id.*

<sup>113</sup> Associated Press, *supra* note 49, at [www.law.asu.edu/HomePages/Karjala/OpposingCopyrightExtensi.../ChiTrib10-17-98.htm](http://www.law.asu.edu/HomePages/Karjala/OpposingCopyrightExtensi.../ChiTrib10-17-98.htm). Facing the loss of copyrights for a number of characters, the Walt Disney Co., executives lead a successful lobbying campaign to secure an extra 20 years protection. *Id.*

<sup>114</sup> *Eldred*, 239 F.3d at 378-380 (Sentelle, J., dissenting).

<sup>115</sup> *Id.*

<sup>116</sup> *Id.* at 379.

<sup>117</sup> *Id.*

<sup>118</sup> *Id.*

<sup>119</sup> *Eldred*, 255 F.3d at 850.

<sup>120</sup> *Id.*

<sup>121</sup> See BARRON'S LAW DICTIONARY, *supra* note 108, at 24 (defining the term *amicus* as "friend of the court"). As applied, an *amicus* is one who gives information to the court on some matter of law, which is in doubt.

<sup>122</sup> *Eldred*, 255 F.3d at 851-852.

*1. Reasons Eldred Should Prevail- Petition for Writ of Certiorari and the Decisions Effect on Current and Future Rights*

On petition for writ of certiorari, Eldred once again challenges the CTEA's constitutionality.<sup>123</sup> This time around Eldred's arguments should survive for a number of reasons. For one, since retroactive extension does not offer an incentive for creating speech because the speech has already occurred, the government fails the intermediate scrutiny test in violation of the First Amendment.<sup>124</sup> The government's argument that copyright is property and regulation of property is only subject to the rational basis test disregards the fact that such property is in fact speech.<sup>125</sup>

Moreover, the government's argument that the CTEA is constitutional since it provides the resources for producers to engage in more speech activity fails.<sup>126</sup> Based on the speculative nature of such an argument, a court is unlikely to find that this outweighs the speech that is lost by removing works from the public domain.<sup>127</sup>

Whatever the outcome of the controversy, both the interests of the public and the interests of authors are at stake.<sup>128</sup> If the public domain continues to be hindered by copyright term extension, the future of ideas and creations will be seriously impaired.<sup>129</sup> The control of a vast amount of material will continue to be placed in a "fixed and concentrated" group of corporate hands to the dismay of smaller companies and the public at large.<sup>130</sup> Also, because copyright law also precludes "derivative use"<sup>131</sup> of copyrighted material, people will not be able to develop new material based on copyrighted work without prior authorization.<sup>132</sup> This will radically

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<sup>123</sup> Eldred v. Ashcroft, 255 F.3d 849 (D.C. Cir 2001), *petition for cert. filed*, (No. 99-5430). The plaintiffs presented three questions on review: 1) whether the D.C. Circuit erred in holding that Congress has the power under the Copyright Clause to extend retrospectively the term of existing copyrights; 2) whether the law that extends the term of existing and future copyrights is categorically immune from challenge under the First Amendment; and 3) whether a circuit court may consider arguments raised by *amicus curia* briefs, different from arguments raised by either party, on a claim properly raised by a party. *Id.*

<sup>124</sup> See Chemerinsky, *supra* note 9, at 19 (stating that "[r]etroactive extension is a windfall, benefiting one group - the copyright holders, who may or likely may not be the producers, at the expense of another group - those who want wider dissemination of speech").

<sup>125</sup> *Id.* at 21.

<sup>126</sup> *Id.*

<sup>127</sup> *Id.* at 23.

<sup>128</sup> Weinstein, *supra* note 62, at [www.latimes.com/business/la-000013191feb21.story](http://www.latimes.com/business/la-000013191feb21.story). Everyone in the entertainment business will be impacted as well as individual copyright owners. *Id.*

<sup>129</sup> See Karlin Lillington, *Why Copyright Laws Hurt Culture*, WIRED NEWS, at [www.wired.com/news/print/0,1294,48625,00.html](http://www.wired.com/news/print/0,1294,48625,00.html) (last visited Mar. 28, 2002) (explaining the impact on culture as a result of numerous copyright term extensions that prohibit material from falling into the public domain).

<sup>130</sup> *Id.* An example is the music industry. Five record companies now control 85% of music distribution. *Id.*

<sup>131</sup> 17 U.S.C. § 101 (Supp. 1999).

A 'derivative work' is a work based upon one or more preexisting works, such as translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work'.

*Id.*

change how human culture will evolve since people will not risk imprisonment or large fines for having used some part of a copyrighted work.<sup>133</sup>

Moreover, technological innovation is at risk, as developers *cannot even enhance* existing material to produce new creations.<sup>134</sup> As a result, copyrighted material is being lost because corporations refuse to keep material that is not profitable; with the CTEA extending terms, the material "falls into a black hole where no one could have access to it."<sup>135</sup> In some circumstances, it is also difficult or impossible to establish who owns the rights to a work due to lengthy copyright terms.<sup>136</sup>

Additionally, since international intellectual property protection is important for purposes of international trade and other business dealings across the world, the Supreme Court's decision could drastically affect the global marketplace.<sup>137</sup> For instance, if retroactive copyright protection is found to be unconstitutional, American creators may enjoy only the minimal established standards provided in the Berne Convention, whereas citizens of other countries may have extended protection.<sup>138</sup> This could lead to serious implications on the economy since countries and individual creators may be hesitant to conduct business in the United States. The United States may also lose its position as a global market leader because other countries may continue to increase copyright protection and the United States will lag behind.

#### IV. PROPOSAL

Pressure from corporate moneymakers such as Disney, has turned the fight against copyright extension into a war.<sup>139</sup> In addition, the European trend away from the minimum life-plus-fifty standard under the Berne Convention to life-plus-seventy has put additional pressures on the United States to extend protection in order to

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<sup>132</sup> See Lillington, *supra* note 129, at [www.wired.com/news/print/0,1294,48625,00.html](http://www.wired.com/news/print/0,1294,48625,00.html) (quoting Lawrence Lessig, "the property owner has control over how that subsequent culture is built;" and stating that a more open business model in which artists have greater control over their productions would create "diverse, competitive industries" rather than centralized, monopolistic companies).

<sup>133</sup> *See generally* Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2827 (1998). The DMCA actually criminalizes copyright infringement by providing a term of imprisonment of five years or a fine up to \$500,000. *Id.* Prior to the DMCA implementation, copyright infringement was almost exclusively a civil issue and the most normal remedy was to cease publication and repay royalties due. *Id.*

<sup>134</sup> Lillington, *supra* note 129 at [www.wired.com/news/print/0,1294,48625,00.html](http://www.wired.com/news/print/0,1294,48625,00.html).

<sup>135</sup> *Id.*

<sup>136</sup> *Id.*

<sup>137</sup> *See generally* Keith E. Maskus, *Intellectual Property Rights and Economic Development*, 32 CASE W. RES. J. INT'L L. 471, 478-493 (Summer 2000) (discussing both the positive and negative impacts of intellectual property rights on economic development).

<sup>138</sup> *Id.* at 479.

<sup>139</sup> Weinstein, *supra* note 62, at [www.latimes.com/business/la-000013191feb21.story](http://www.latimes.com/business/la-000013191feb21.story). This will be the biggest copyright decision since the landmark 1879 decision that divided intellectual property into functional works, which are patented, and artistic works, which are copyrighted. *Id.* *See also* Associated Press, *supra* note 49, at [www.law.asu.edu/HomePages/Karjala/OpposingCopyrightExtensi.../ChiTrib10-17-98.htm](http://www.law.asu.edu/HomePages/Karjala/OpposingCopyrightExtensi.../ChiTrib10-17-98.htm).



maintain their world leadership position.<sup>140</sup> With this in mind, this comment proposes solutions that may find the proper balance between creators who need protection and the public who need access.

*A. Allowing for an abandonment provision to eliminate the "blackhole"*

With the increased length of copyright terms, there is tremendous concern about works falling into a black hole where no one can have access to them.<sup>141</sup> Corporations have tremendous power in demanding the copyright to works they fund, and once they have all the rights to a work, they have the power to provide the public with the access they need.<sup>142</sup> The problem with this is that corporations only use the works as long as they are profitable and once the corporations cease from using the work, the public is denied access for the remainder of the copyright term, which can be very lengthy.<sup>143</sup> Moreover, copyrights that are not held by corporations are controlled by the heirs of the original copyright holder and are difficult if not impossible to locate.

Implementation of abandonment provisions to ensure the works do not fall into the black hole will give access of these works to the public for the creation of new works.<sup>144</sup> Like Trademark law, if the holder of a copyright has not used a work in a number of years and has no interest in the remainder of the copyright protection, the copyright should be deemed abandoned and the work should fall into the public domain.<sup>145</sup>

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<sup>140</sup> See Irene Segal Ayers, *The Future of Global Copyright Protection: Has Copyright Law Gone Too Far?*, 62 U. PITT. L. REV. 49 (2000) (discussing how the U.S and other nations are in a "race to the top" competition for the holder of the strongest intellectual property protection).

<sup>141</sup> Lillington, *supra* note 129, at [www.wired.com/news/print/0,1294,48625,00.html](http://www.wired.com/news/print/0,1294,48625,00.html).

<sup>142</sup> *Id.* Corporations have "enormous power and will do whatever they can to protect the survival of the dinosaurs over the coming of the mammals." *Id.*

<sup>143</sup> *Id.*

<sup>144</sup> *Id.* "The period of copyright primacy is going to end up as a huge hole in the cultural record". *Id.* The major problem is that copyrighted material simply vanishes when corporations are not interested in keeping all that they copyright commercially available. *Id.*

<sup>145</sup> *Cf.* 15 U.S.C.A. § 1127 (Supp. 2001).

A mark shall be deemed to be "abandoned" when either of the following occurs:

1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

2) When any course of conduct of the owner, including acts of omission as well as commission, cause the mark to become the generic name of the goods or services or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.

*Id.*

*B. Limiting assignments by authors to reduce excessive copyright terms*

If abandonment provisions would be difficult to implement based on tracking possession or ownership of who has what materials, it may be easier to implement limitations on assignments.<sup>146</sup> As mentioned earlier, large corporations can be very persuasive when it comes to assigning copyrights for financial incentives.<sup>147</sup> By limiting the assignments of copyrights, corporations will not be in a position to bargain or negotiate as they do now because they will not have the same bargaining power.<sup>148</sup> Corporations will therefore be unable to exploit technologies or other creations where limitations on such assignments are imposed.

Limitations would also decrease the amount of lost materials as a result of corporations going out of business or going bankrupt.<sup>149</sup> Older films, books and music that have been assigned many times will no longer be at risk if assignments are limited since the copyright holder will be easily identified.<sup>150</sup> A limitation on assignment that balances the interests of the author of getting the work produced and that of the corporations who look only at profitability may be the key in eliminating many public concerns.<sup>151</sup>

*C. Strengthening the Fair-Use Exception*

Fair use<sup>152</sup> and the public domain are closely related concepts designed to benefit society as a whole.<sup>153</sup> The CTEA has currently attempted to minimize some societal costs associated with longer copyright terms by allowing for non-commercial uses of copyrighted works.<sup>154</sup> Qualified libraries, archives and certain non-profit educational

<sup>146</sup> See William Patry, *The Failure of the American Copyright System: Protecting the Idle Rich*, 72 NOTRE DAME L. REV. 907, 927-929 (May 1997) (discussing the effect of assignment rights and how European authors cannot assign away right to the exploitation of technologies not in existence at the time of any contracts).

<sup>147</sup> Schlafly, *supra* note 79, at [www.eagleforum.org/column/1998/nov98/98-11-25.html](http://www.eagleforum.org/column/1998/nov98/98-11-25.html).

<sup>148</sup> Patry, *supra* note 146 at 927-929. Assignments between distributors and authors contain clauses granting the distributor the right to any future term extensions. *Id.* Authors, who receive lump sum payments for assigning their rights, will not receive a penny from the extended twenty years of copyright. *Id.* Every penny will go to corporation who, "did not bargain for it, did not expect it, and did nothing to deserve it". *Id.*

<sup>149</sup> Lillington, *supra* note 129, at [www.wired.com/news/print/0,1294,48625,00.html](http://www.wired.com/news/print/0,1294,48625,00.html). "If a corporation goes bankrupt, we're going to lose access to our culture." *Id.*

<sup>150</sup> *Id.*

<sup>151</sup> *Id.*

<sup>152</sup> See *infra* Part I.D and notes 67-72.

<sup>153</sup> Baron, *supra* note 59, at <http://www.pipeline.com/~rabaron/VRA-TM-SF-PublicDomain.htm>. Fair use offers a way to override the rights of the holders in intellectual property when it is in the public interest. *Id.* Similarly, the passage of works into the public domain secures, on behalf of the public, intellectual properties that were once private. *Id.*

<sup>154</sup> See Senator Orrin G. Hatch, *Toward a Principled Approach to Copyright Legislation at the Turn of the Millennium*, 59 U. PITT. L. REV. 719, (Summer 1998) (discussing how although copyright term extension does encourage creativity and does not unduly hamper the widespread dissemination of works, there are certain works for which the costs of restricting dissemination do outweigh the benefits of term extension).

institutions will be able to reproduce, distribute, display or perform a copy of a protected work for purposes of preservation, scholarship or research.<sup>155</sup>

This fair use exception,<sup>156</sup> however, requires courts to undertake a case-by-case analysis, employing as a general guide for decision four statutory factors.<sup>157</sup> This broad approach has made the fair use exception highly criticized for its inconsistent application since each factor has been interpreted differently.<sup>158</sup> Strengthening the fair use exception to employ consistency may ease the effects of long copyright terms.<sup>159</sup> This can be accomplished by amending § 107 of the Copyright Act<sup>160</sup> to include a wider range of uses that will be exempt from copyright infringement. The four-factor analysis<sup>161</sup> can also be amended in order to define the proper purpose in order to eliminate confusion and inconsistency. The balance between the copyright holders and the public will then be met since the objective of each will be addressed.<sup>162</sup>

#### *D. Mandatory Ceilings on International Copyright Protection*

The European-influenced international copyright treaties erect no barriers to lengthening the term of copyright protection.<sup>163</sup> Because the CTEA was largely viewed as necessary to keep up with international trade competition with the

<sup>155</sup> *Id.*

<sup>156</sup> See 17 U.S.C. § 107 (2001) (excluding certain uses from infringing on a copyright such as criticism, comment, news, reporting, teaching, scholarship, or research).

<sup>157</sup> See Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1, 21 (Oct. 2001) (stating that the United States' courts developed the fair use doctrine in the 19<sup>th</sup> century as an equitable privilege).

<sup>158</sup> *Id.* See also William W. Fisher, III, *Reconstructing the Fair Use Doctrine*, 101 HARV. L. REV. 1661, 1668-69, 1692-95 (1988) (describing equitable nature of fair use doctrine, but concluding that doctrine as it stands is incoherent).

<sup>159</sup> Baron, *supra* note 59 at <http://www.pipeline.com/~rabaron/VRA-TM-SF-PublicDomain.htm>. Fair use and the public domain exist to counterbalance the weight given to the right of exclusive temporary ownership. *Id.*

<sup>160</sup> 17 U.S.C. §§ 101-107 (Supp. 1999).

<sup>161</sup> 17 U.S.C. § 107 (Supp. 1999).

In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or the value of the copyrighted work.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

*Id.*

<sup>162</sup> *Id.*

<sup>163</sup> Ayers, *supra* note 140, at 74. The natural law roots of European copyright law suggest no philosophical barriers to a copyright of eternal duration. *Id.*

Europeans, mandatory ceilings on protection are essential to avoid conflict with the United States Constitution.<sup>164</sup>

Since the inception of the Berne Convention, the European Union has decided to lengthen the term of copyright protection further than the minimum term of life-plus-fifty.<sup>165</sup> The United States responded with the CTEA under the rationale that it was important to keep protection consistent with the Europeans.<sup>166</sup> The United States failure to take a stronger stand in international treaty negotiations for mandatory ceilings on copyright protection encouraged a competition among nations in offering the strongest intellectual property protection.<sup>167</sup> Now the United States will do anything in order to keep up with the competition.<sup>168</sup>

What will the United States do when the Europeans continue to increase copyright protection? The "limited Times" restriction and the promotion of the progress of science and the useful arts seem to be caught flat in the middle of globalization.<sup>169</sup> Is eternity minus one day what the Framers of the United States Constitution had in mind?<sup>170</sup> The stage is now set and the United States must focus on implementing ceilings through the use of Preambles like that of the WIPO Copyright Treaty.<sup>171</sup> Otherwise, the United States will continue to follow the

<sup>164</sup> *Id.* See also Mota, *supra* note 1, at 168-169 (stating that "Congress' purpose was to ensure adequate copyright protection for American works in foreign nations and the continued economic benefits of a healthy surplus balance of trade in the exploitation of copyrighted works").

<sup>165</sup> Ayers, *supra* note 140, at 73.

<sup>166</sup> *Id.* at 74. U.S. copyright owners were at a potential disadvantage in foreign countries following the "rule of the shorter term". *Id.* Under that rule, U.S. copyright holders receive the benefits of national treatment in the foreign country except in regard to the duration of copyright protection. *Id.* Works whose copyright has expired in the home country do not receive protection in the foreign country, even where the foreign country would provide longer protection under its own copyright laws. *Id.* See also Mota, *supra* note 1, at 170 (noting that because Congress wanted to give present and future U.S. copyright holders the benefit of twenty more years of protection in countries with extended copyright protection, the CTEA was passed).

<sup>167</sup> Ayers, *supra* note 140, at 75-76. See also Patry, *supra* note 146, at 930-931. If harmonization is so important, it is baffling that the U.S. negotiators did not seek (or seek in acquiesce in) a basic international standard of life plus seventy in the Uruguay Round of the General Agreement on Tariffs and Trade (GATT). *Id.* No such argument was made or even contemplated because the harmonization argument is entirely post hoc. *Id.*

<sup>168</sup> Patry, *supra* note 146, at 930-931.

<sup>169</sup> Ayers, *supra* note 140, at 74-75. Not only may it exceed the "limited Times" requirement, it may also fail to "promote the progress of science and the useful arts" because it is granting term extensions to already existing works. *Id.* The grant does not act as an incentive for the production of these works – they were produced with the incentives under earlier law. *Id.* Nor does the public receive any benefit, and new "quid pro quo," for lengthening copyright protection for works already created. *Id.*

<sup>170</sup> *Id.*

<sup>171</sup> *Id.* at 74. The Preamble of the WIPO Copyright Treaty balances the rights of authors and the public interest. *Id.* at 76. See also World Intellectual Property Organization Copyright Treaty, Dec. 20, 1996 at <http://www.wipo.org/eng/diplconf/distrib/94dc.htm> (last visited Mar 30, 2002). The Preamble reads as follows:

The Contracting Parties,

Desiring to develop and maintain the protection of the rights of authors in their literary and artistic works in a manner as effective and uniform as possible,

Recognizing the need to introduce new international rules and clarify the interpretation of certain existing rules in order to provide adequate solutions to

Europeans in order to be the world leader in intellectual property policy.<sup>172</sup> The problem with this is that Europeans are not bound by the same "limited Times" provision present in the United States Constitution.<sup>173</sup>

## V. CONCLUSION

The Copyright Term Extension Act is an overprotection of authors' and inventors' rights.<sup>174</sup> Such protection leads to a reduction of public access to information, depriving future authors of raw materials and encouraging private censorship.<sup>175</sup> Although there is need for copyright protection to encourage authors to produce new works, there is also a need to protect ordinary citizens' rights of access to this information.<sup>176</sup>

By providing abandonment provisions and limitations on assignment rights, the detrimental impact of lengthy copyright terms on United States culture and economic development may be decreased.<sup>177</sup> In addition, strengthening the fair use exception to provide consistent access for the creation of new works would also be beneficial.<sup>178</sup> The United States has a world leadership position that could hinder other countries from exploiting copyright protection.<sup>179</sup> The Supreme Court's decision in *Eldred v. Ashcroft* will be the deciding factor.

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the questions raised by new economic, social, cultural and technological developments,

Recognizing the profound impact of the development and convergence of information and communication technologies on the creation and use of literary and artistic works,

Emphasizing the outstanding significance of copyright protection as an incentive for literary and artistic creation,

Recognizing the need to maintain a balance between the rights of authors and the larger public interest, particularly education, research and access to information, as reflected in the Berne Convention,

Have agreed as follows:

*Id.*

<sup>172</sup> See Alexander A Caviedes, *International Copyright Law: Should the European Union Dictate Its Development?*, 16 B.U. INT'L L.J. 165, 166 (Spring 1998) (comparing and contrasting the development of international copyright protections with the evolution of copyright protections under EC law).

<sup>173</sup> U.S. CONST. art. I, § 8 cl. 8.

<sup>174</sup> Springman, *supra* note 58, at

[http://writ.news.findlaw.com/commentary/20020305\\_springman.htm](http://writ.news.findlaw.com/commentary/20020305_springman.htm). Subsisting and future copyright extension substantially burdens free speech by foreclosing use of expression that would otherwise be available in the public domain, while advancing no important government interest. *Id.*

<sup>175</sup> *Id.*

<sup>176</sup> See, e.g., Cave, *supra* note 25, at

[www.salon.com/tech/feature/2002/02/21/web\\_copyright/print.html](http://www.salon.com/tech/feature/2002/02/21/web_copyright/print.html)

<sup>177</sup> Lillington, *supra* note 129, at [www.wired.com/news/print/0,1294,48625,00.html](http://www.wired.com/news/print/0,1294,48625,00.html).

<sup>178</sup> *Id.*

<sup>179</sup> *Id.*



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MARK H. HOPKINS, PH.D.

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