

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLORADO

Civil Action No. 01-B-1854

LAWRENCE GOLAN, et. al.

Plaintiffs,

v.

JOHN ASHCROFT, in his official
capacity as Attorney General of the
United States

Defendant.

DEFENDANT’S REPLY IN FURTHER SUPPORT OF HIS MOTION TO DISMISS

Preliminary Statement

This controversy rests on a disagreement over what is best for the public. Plaintiffs believe that the growth of the public domain is the sole way to promote artistic progress, and that the Sonny Bono Copyright Term Extension Act (CTEA) and §514 of the Uruguay Round Agreements Act (URAA) do the public a disservice. Congress disagreed, and legislated on its judgment. Plaintiffs now wish to move the policy debate to a new forum—attempting to get a second bite at the apple. But courts do not review legislative debates to ensure that Congress arrived at the best result. The resolution of such debates is Congress’s task alone.

In his initial memorandum, the Attorney General demonstrated that, even assuming the truth of all the facts in their complaint, Plaintiffs are not entitled to relief. Plaintiffs seem to

believe that the Supreme Court and the Tenth Circuit have already ruled in their favor on every issue currently before this Court. In truth, the Tenth Circuit has not ruled on *any* of the issues relevant to the merits of this lawsuit and the Supreme Court's precedent supports many of Defendant's positions, at the expense of Plaintiffs'. In addition, Plaintiffs' memorandum mischaracterizes the positions taken by the Attorney General, setting up "strawman" positions to then knock down. This memorandum responds to certain arguments raised by Plaintiffs in their opposition memorandum. As a matter of law, Plaintiffs cannot prevail.

Standard of Review on a Motion to Dismiss

A motion to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6), functions to test the legal adequacy of a complaint; it is a vehicle by which courts may evaluate pure legal questions. In other words, a motion to dismiss argues that the "harm" of which the plaintiff complains is not recognized as a violation of legal rights. For the purposes of a 12(b)(6) motion—to ensure that they focus only on matters of law—courts accept as true all reasonable allegations of fact in the complaint. See *Conley v. Gibson*, 355 U.S. 41, 45-46 (1957); *Sutton v. Utah State School for the Deaf and Blind*, 173 F.3d 1226, 1236 (10th Cir. 1999). If, as a matter of law, the plaintiff is not entitled to relief, the motion is granted. The plaintiffs here assert that all they need to show is a "colorable legal claim" to defeat this motion. Pl. Mem. 4. That is incorrect. Plaintiffs must state a *valid* legal argument that the facts they allege (if proved) would entitle them to relief—a colorable legal argument will not suffice.

The Attorney General, in his prior memorandum, and in this one, does not challenge any of Plaintiffs' factual allegations. Facts aside, however, as a matter of law, the "harm" of which

Plaintiffs complain is not one remediable in the courts.

Argument

I. The CTEA is Constitutional.

A. Congress Has a Longstanding Tradition of Applying Term Extensions to Subsisting Copyrights.

In his original memorandum, the Attorney General argued that rejecting the CTEA would also reject a consistent, longstanding tradition—dating back to the first congress—of applying copyright-term extensions to existing works. Def. Mem. 3-6. In response, Plaintiffs first dispute that the 1790 Act applied to subsisting copyrights. Pl. Mem. 20-24. They make an obvious point. As Defendant noted multiple times in his prior memorandum, the 1790 Act was the United States’ first copyright act and, therefore, could not have extended the terms of previously existing copyrights. Def. Mem. 3, 4, 23. However, the 1790 Act did apply to works that were already in existence at the time of that statute’s enactment—just as the CTEA does. 1 Stat. 124, §1. And Plaintiffs’ complaint is not that the CTEA applies to subsisting copyrights, but that it applies to works already in existence (which happen to have subsisting protection). So the 1790 Act—while not extending subsisting copyright terms—did establish the tradition which the CTEA followed.¹

¹ Plaintiffs suggest that they are entitled to introduce the testimony of a legal historian regarding the meaning and legislative history of the 1790 Act. Pl. Mem. 4, 63. Questions of legislative history are legal, not factual, disputes, and are ripe for consideration on a motion to dismiss. See *Union Pacific Land Resources Corp. v. Moench Investment Co.*, 696 F.2d 88, 93 n.5 (10th Cir. 1982) (holding that “[q]uestions of statutory construction or legislative history traditionally present legal questions properly resolved by summary judgment”). If Plaintiffs

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Plaintiffs next attempt to distinguish the 1790 Act, calling it a necessary measure in order to preclude individual states from issuing perpetual copyrights, and asserting that the Act limited copyrights rather than extended them. Pl. Mem. 21-23. This argument is unavailing for a number of reasons. First, there was no need to preempt any state perpetual copyright terms, because no states had perpetual copyright terms for published works (which is all the 1790 Act covered). All 12 of the states that enacted copyright protection for published works prior to 1790 expressly limited their terms to between 14 and 28 years—not even close to perpetual protection.² Nor was the principal objective of the 1790 Act to limit perpetual copyright terms existing at common law. Plaintiffs provide no support for their contention to the contrary, not even from academic commentary. In fact, Edward Walterscheid, the very “expert” whose testimony Plaintiffs propose to introduce, rejects this claim, writing that “[n]o state was disposed to view copyright as creating a perpetual property right.” Edward C. Walterscheid, *Defining the Patent and Copyright Term: Term Limits and the Intellectual Property Clause*, 7 J. Intell. Prop. L. 315, 349 (2000). Second, if Congress’s primary aim was to preempt state law, it could have done so by passing a statute which said “Every state copyright shall terminate X years after it was issued.” But the 1790 Act did not take such a limited step. It created a new federal

¹(...continued)
disagree with Defendant’s history, then they were welcome to have an historian assist them in preparing their memorandum. Cf. *Charter National Bank & Trust v. Chapter One Financial, Inc.*, No. 01 C 0905, 2001 WL 1035721, *6-*7 (N.D. Ill. Sept. 4, 2001).

² The original copyright legislation for all 12 states is reprinted in Melville B. Nimmer & David Nimmer, 8 *Nimmer on Copyright* App. 7[C]. Some of those state statutes never went into effect. See *infra*, pp. 15-16.

right—suggesting that there is more to the statute than Plaintiffs’ explanation admits. And finally, the 1790 Act lengthened, rather than limited, the term of protection for already existing works. The Act granted a 28-year term (including the renewal period) to authors *beginning* on the date they registered with their work with the clerk of the nearest district court. See 1 Stat. 124-25. And because the 28 years granted by the Act was as long as the most generous state’s term, which would have already been running when the 1790 Act was passed, the 1790 Act protected all works already in existence for longer than they would have been protected by state law. Plaintiffs’ attempt to distinguish the 1790 Act from the CTEA, therefore, cannot succeed.

Since the 1790 Act, every extension of the copyright term—in 1831, 1870, 1909, and 1976—applied both to subsisting and new works, and the CTEA falls squarely within that tradition. Plaintiffs proclaim that the tradition is meaningless because “the fact that a law or congressional practice has gone unchallenged does not render it constitutional.” Pl. Mem. 24 (citations omitted). Plaintiffs are correct that tradition cannot cure an otherwise unconstitutional statute. However, when deciding *whether* a statute is unconstitutional, tradition certainly looms large. *Freytag v. Commissioner of Internal Revenue*, 501 U.S. 868, 890 (1991) (noting that the losing side’s position would “undermine longstanding practice”); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884). Congress’s longstanding tradition of applying copyright-term extensions to already existing works (and its tradition of looking to the copyright term in Europe and adjusting the United States’ term in response, which Plaintiffs ignore completely) establishes the CTEA’s constitutionality.

B. The CTEA Satisfies All of the Copyright Clause’s Requirements.

1. The Life of the Author Plus 70 Years Is a Limited Time.

The basic copyright term established by the CTEA, equal to the author’s life plus 70 years, meets the Copyright Clause’s requirement that terms extend only for “limited Times”. U.S. Const. art. I, §8, cl. 8. “Limited” means restricted in duration, which the CTEA’s term is. Def. Mem. 6-7. Still, Plaintiffs insist on a novel definition of “limited,” focusing on the number of times that Congress has extended the copyright term—which is irrelevant to whether its length is “limited”—and on the hypothetical question whether Congress could “prolong the term of copyrights ad infinitum”. Pl. Mem. 30-31. Yet the only question before this Court is whether the *actual* term created by the CTEA is a limited one. Plaintiffs refuse to address that issue.

The historical context of the Copyright Clause’s adoption supports the Attorney General’s definition of “limited.” See Def. Mem. 7-8. The framers employed the phrase “limited Times” in order to end the debate over finite versus perpetual copyrights. Thus, “limited” is exactly what it seems—the opposite of unlimited. Plaintiffs contend that the Attorney General’s history is somehow flawed, but then include an extended discussion in their own memorandum noting that “the debate undoubtedly influenced the drafters of the Copyright Clause”. Pl. Mem. 21-22. Given this agreement, there can be no doubt about the proper definition of “limited” or that the CTEA satisfies its requirement.

2. Plaintiffs’ Definition of “Secure” Is Incorrect and Forsakes a Contextual Reading of the Copyright Clause.

Plaintiffs next craft an argument based on the Copyright Clause’s supposed mandate that

the term of copyright protection be “secure,” which they define as “to make certain.” The term of subsisting copyrights is not certain, Plaintiffs argue, if it can be lengthened at Congress’s discretion. Pl. Mem. 31-33. This argument is flawed, and not only because Plaintiffs cite not a single case to ever read any limitation into the word “secure.” The Supreme Court has already provided a contextual definition of “secure” for the copyright field, defining it as “to protect, insure, save, [or] ascertain”. *Wheaton v. Peters*, 33 U.S. 591, 660 (1834).³ The CTEA does “protect,” “insure,” “save,” and “ascertain” copyright protection for authors. Reading into the Constitution a latent requirement that the term of copyright never change is completely without support in the precedent interpreting the Copyright Clause, the Supreme Court’s definition of “secure”, and the longstanding practice of applying term extensions to subsisting copyrights.

3. The Determination of What Best Promotes Artistic Progress Is Committed Solely to Congress’s Discretion.

Even if this Court finds that the Copyright Clause’s prefatory phrase does limit Congress’s power to enact copyright legislation (which it should not, see Def. Mem. 9), the decision what best promotes “the Progress of Science and useful Arts” is committed to Congress alone. As demonstrated in the Attorney General’s first memorandum (Def. Mem. 9-11), copyright protection skirts a fine line between the rights of authors and the growth of the public domain. The delicacy of the relationship necessitates that Congress govern the balance. *Stewart v. Abend*, 495 U.S. 207, 230 (1990).⁴

³ Plaintiffs do cite this definition, but then proceed to ignore it completely.

⁴ Plaintiffs suggest a number of times in their memorandum that the Attorney General’s
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Plaintiffs respond that “the settled law of the Tenth Circuit *and* the Supreme Court” requires courts to review copyright legislation to ensure that it promotes “the Progress of Science and useful Arts”. Pl. Mem. 15-17 (emphasis in original); also 29-30. Plaintiffs make much ado over very little. Not a single case from the Supreme Court or Tenth Circuit has ever reviewed copyright legislation to determine whether it promotes artistic progress or even suggested that courts should do so.⁵ The cases Plaintiffs cite fall into two categories.

The first class of cases simply note—after arriving at their holding—that their result is consistent with the background objective of the Copyright Clause, which the prefatory phrase restates. *Blish, Mize & Silliman Hardware Co. v. Time Saver Tools*, 236 F.2d 913 (10th Cir. 1956); *Gates Rubber Co. v. Bando Chemical Industries, Ltd.*, 9 F.3d 823 (10th Cir. 1993); *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366 (10th Cir. 1997). Noting that a particular result matches the underlying purpose of a rule is quite common to judicial opinions. See, e.g., *United States v. Hernandez-Muniz*, 170 F.3d 1007, 1010 (10th Cir. 1999). It does not mean that the objective itself becomes the rule.

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position effectively would allow Congress to enact copyright laws willy-nilly, completely unfettered by the Constitution. Pl. Mem. 3, 4 18, 19. This is a strawman. The Copyright Clause contains several firm limitations on Congress’s power to enact legislation—e.g., “limited Times” and originality. Congress may not contravene these limits when legislating under the Copyright Clause.

⁵ Of the cases Plaintiffs cite, only *Mitchell Brothers Film Group v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979), holds that the Copyright Clause’s prefatory phrase limits Congress’s power in any way—and it supports the Attorney General’s position that if courts apply the prefatory phrase to copyright statutes, *McCulloch* provides the proper standard. See *infra*, p. 10.

The second category of cases suggest that, to select among competing views of their meaning, other parts of the Copyright Clause may be construed in light of the prefatory phrase's background purpose. *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991); *Graham v. John Deere Co.*, 383 U.S. 1 (1966); *Higgins v. Keufel*, 140 U.S. 428 (1891). These decisions too present nothing unusual. Courts routinely use background principles to aid their interpretation of both statutory and constitutional rules—that does not amount to making the objectives themselves into rules.⁶

4. The CTEA Is Plainly Adapted to “promote the Progress of Science and useful Arts”.

If the Court does look to ensure that the CTEA promotes artistic progress, the Act passes the test (which is not an onerous one). Def. Mem. 13-16. Plaintiffs make three responses. First, they say that Defendant's justifications for the CTEA are irrelevant on a motion to dismiss, and should instead await trial. Pl. Mem. 27-28. Next, Plaintiffs posit that the Court's review should be under *United States v. Lopez* rather than *McCulloch v. Maryland*'s “plainly adapted to a legitimate legislative goal” test. Pl. Mem. 17-20. And finally, Plaintiffs argue that the CTEA's

⁶ Perhaps recognizing this deficiency, Plaintiffs contend in the alternative that, if the prefatory phrase itself does not allow courts to ensure the promotion of progress, the Court should construe the “limited Times” requirement in light of the prefatory phrase. Pl. Mem. 29-30. Plaintiffs offer no explanation as to how this would be done, other than to argue that in determining whether a particular term is a “limited Time[]”, courts should ask whether the term “promotes progress.” *Id.* at 28 & n.11 (“[T]he only constitutionally permissible ‘limited Times’ are those that ‘promote progress.’”). That merely restates their position that courts should review every copyright enactment to see whether it does, in the court's view, promote progress. It runs headlong into the Supreme Court's decisions committing that determination to Congress (cited in Def. Mem 9-10).

extension of the term of *subsisting* copyrights cannot promote artistic progress. Pl. Mem. 24-26.

Plaintiffs' first argument, that analysis of whether the CTEA promotes artistic progress must await trial, misunderstands the standard that the Act would be held to under the Necessary and Proper Clause. Courts evaluate whether a statute falls under one of Congress's enumerated powers by asking whether that statute is necessary and proper to the enumerated power. Under the Supreme Court's well-settled construction of the Necessary and Proper Clause, Congress may enact laws utilizing "all appropriate means which are conducive or adapted to the end to be accomplished, and which *in the judgment of Congress* will most advantageously effect it." *The Legal Tender Cases*, 110 U.S. 421, 440 (1884) (emphasis added). Thus, "where the law is not prohibited, and is really calculated to effect any of the objects intrusted to the government, to undertake here to inquire into the decree of its necessity, would be to pass the line which circumscribes the judicial department, and to tread on legislative ground. This court disclaims all pretensions to that power." *McCulloch v. Maryland*, 17 U.S. 315, 422 (1819). So long as the CTEA is "appropriate" and "plainly adapted" to promoting artistic progress, therefore, the statute must be upheld. *Id.* at 421. See also *United States v. Hallmark*, 911 F.2d 399, 401 (10th Cir. 1990); *Mitchell Brothers Film Group v. Cinema Adult Theater*, 604 F.2d 852, 860 (5th Cir. 1979) (applying the "lenient standard" of *McCulloch* to a copyright case). It is not relevant to the analysis whether Plaintiffs can show that the CTEA does not *in fact* promote progress.

The Attorney General demonstrated at length in his original memorandum that the CTEA is plainly adapted to promote artistic progress. Def. Mem. 13-16. Congress reasoned that the CTEA would foster greater international cooperation in protecting copyrights worldwide; that it

would produce greater income for American copyright holders, much of which would be reinvested in new works; and that it would assure prospective authors that their investments in new works would be safeguarded. The CTEA is plainly adapted to achieve these legitimate legislative goals.

Plaintiffs next assert that *McCulloch* is not the proper standard by which to evaluate whether the CTEA promotes artistic progress, but rather, would apply the Supreme Court's recent Commerce Clause decision in *United States v. Lopez*, 514 U.S. 549 (1995). Pl. Mem. 17-20. Remarkably, Plaintiffs rely for authority only on the dissent in *Eldred v. Reno*, 239 F.3d. 372 (D.C. Cir. 2001), rehearing en banc denied 255 F.3d 849 (2001).

Lopez dealt with the proper scope of the Commerce Clause. It does not mention the Copyright Clause, nor does it purport to articulate any general principles to guide courts reviewing other exercises of Congress's enumerated powers. Nowhere does it purport to change the longstanding principles articulated in *McCulloch* and *The Legal Tender Cases*. In the almost seven years since *Lopez* was decided, the Tenth Circuit has never so much as cited it outside the Commerce Clause context.⁷

Finally, Plaintiffs argue that, regardless of the standard of review, it is impossible that the extension of the term of *subsisting* copyrights promotes artistic progress. Their theory is that once a work is created, Congress need not provide any more incentive to the author to create it.

⁷ Additionally, the Tenth Circuit has continued to apply *McCulloch* and *The Legal Tender Cases* after *Lopez*. See *United States v. Boos*, 1999 WL 12741 (10th Cir. 1999) (unpublished). Defendant realizes that *Boos*, an unpublished decision, does not bind this Court. It is cited only to serve as an example.

But Plaintiffs overlook the effect that Congress’s treatment of existing works can have on authors that are considering creating new works. These effects, well-developed in the legislative history, deal specifically with the benefits of extending the term of *subsisting* copyrights. They are fully articulated in the Attorney General’s original memorandum. Def. Mem. 13-16.

5. The CTEA Does Not Violate the Copyright Clause’s Originality Requirement.

As argued in Defendant’s original memorandum (Def. Mem. 16-17), Plaintiffs misunderstand the originality requirement. *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), mandates that to “qualify” for copyright protection, works must be original. Works whose terms are extended by the CTEA do not need to qualify for copyright protection—they are already protected. Plaintiffs even admit, during their discussion of the URAA, that “[a] work must bear ‘some minimal degree of creativity’ *when granted* copyright protection.” Pl. Mem. 47 (emphasis added). Despite this tacit admission, Plaintiffs insist that if the Attorney General’s position were correct, the works of Aristotle and Plato would be original, and thus copyrightable. That is half correct. The works of Aristotle and Plato were original when written and are original now. Originality does not fade over time. However, those works could not be copyrighted now because Aristotle and Plato died more than 70 years ago. Their term of protection, therefore, would be long over. The same is true of William Shakespeare, and many other authors of important works. Plaintiffs’ characterization, while perhaps amusing exaggeration, is unconvincing.

C. The CTEA Does Not Abridge the Freedom of Speech.

Plaintiffs posit that the CTEA, because it impinges on the freedom of speech, is subject to intermediate scrutiny under *United States v. O'Brien*, 391 U.S. 367 (1968). Pl. Mem. 34-37. Plaintiffs cite two forced speech cases⁸ and one case dealing with copyright enforcement provisions⁹ in support of their position. But they misunderstand *Harper & Row, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985), which explained that the *exclusive license* granted by copyright—not all copyright legislation—does not infringe upon the first amendment.¹⁰ Def. Mem. 17-19. Copyright's exclusive license, which incorporates the idea/expression dichotomy and fair use provisions, ensures that copyright protection and the first amendment coexist peacefully. None of the decisions that Plaintiffs cite involves the review of any part of copyright's exclusive license; nor were the idea/expression dichotomy or the fair use provisions implicated in any way.¹¹ Plaintiffs' challenge here is that the exclusive license granted to authors by the CTEA violates the first amendment. That is explicitly foreclosed by *Harper & Row*.

⁸ *Satellite Broadcasting & Communications Corp. v. FCC*, No. 01-1151, 2001 WL 1557809 (4th Cir. Dec. 7, 2001); *CBS Broadcasting, Inc. v. Echostar Communications Corp.*, 265 F.3d 1193 (11th Cir. 2001).

⁹ *Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2nd Cir. 2001).

¹⁰ Plaintiffs are exercised because Defendant did not note in his prior memorandum that copyright legislation (even if on the expression side of the dichotomy) would implicate the first amendment if it engaged in viewpoint discrimination. Pl. Mem. 35. Viewpoint discrimination is not at issue in this case, and thus, there was no reason to address this.

¹¹ The Tenth Circuit opinion cited by Plaintiffs is also beside the point. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996). That decision has nothing to do with copyright law at all, let alone the idea/expression dichotomy or fair use provisions.

D. The CTEA Does Not Violate Substantive Due Process.

Plaintiffs argue that substantive due process claims may not be challenged with a motion to dismiss. Pl. Mem. 40. In support, they cite three cases where other plaintiffs have alleged enough for a due process claim to go forward. These cases are irrelevant. The Attorney General does not doubt that some complaints of due process violations should go forward. Motions to dismiss, however, weed out potentially meritorious claims from ones that, under no set of facts, entitle the plaintiffs to relief. As Defendant’s prior memorandum establishes, these Plaintiffs’ due process claim cannot proceed. Def. Mem. 19-21. All Defendant must show is that Congress’s decision to enact the CTEA was not wholly irrational. The Attorney General “has no obligation to produce *evidence* to sustain the rationality” of the Act; “a legislative choice is not subject to courtroom factfinding and may be based on rational speculation unsupported by evidence or empirical data.” *Heller v. Doe*, 509 U.S. 312, 320 (1993). Defendant’s original memorandum meets that low burden: Accepting all Plaintiffs’ well-pled allegations as true, the CTEA is not more onerous than the allegedly burdensome legislation upheld in numerous Supreme Court decisions. See, e.g., *United States v. Sperry Corp.*, 493 U.S. 52 (1989); *Pension Benefit Guaranty Corp. v. R.A. Gray & Co.*, 467 U.S. 717 (1984); *Usery v. Turner Elkhorn Mining Co.*, 428 U.S. 1 (1976). Plaintiffs opted not to respond (or even cite) any of these cases.

II. The URAA Is Constitutional.

The URAA is a valid exercise of at least two enumerated powers—the Copyright Clause and Congress’s power under the Necessary and Proper Clause to implement valid treaties. Either of these powers can justify the URAA (and obviate the need for the Court to consider the other).

Further, the URAA does not violate either the first or fifth amendments.

A. The URAA Is a Valid Enactment under the Copyright Clause.

1. The URAA's Removal of Works from the Public Domain Is Constitutional.

The Attorney General demonstrated in his initial memorandum that, with respect to the URAA, removing works from the public domain is constitutional for two reasons: First, the 1790 Act, enacted by the first congress, removed works from the public domain, which should be accorded conclusive deference as to what is constitutional. Def. Mem. 23-24. Second, the Supreme Court would allow the restoration of copyright protection where the authors of the restored works were deprived of the choice between donating their work to the public domain or protecting it. Def. Mem. 24-26.

Plaintiffs initially dispute that the works protected by the 1790 Act were in the public domain. Pl. Mem. 50-51. They contend that the works covered by the Act were protected by the states (Pl. Mem. 50), and that there was no public domain before 1790 (Pl. Mem. 50-51). They are wrong on both counts. As Plaintiffs themselves note, not all works protected by the 1790 Act were protected previously by the states. Delaware never passed copyright protection. See Pl. Mem. 23 n.9 (noting that only 12 of the 13 states passed copyright legislation). Furthermore, Maryland and Pennsylvania passed statutes that never went into effect because they were expressly contingent on “similar laws” being enacted “in all and every of the United States.”

1783 Md. Laws Ch 34 (enacted April 21, 1783).¹² Those statutes never went into effect because Delaware never passed any copyright protection. So prior to 1790, at least with regard to those three states, published works were not protected and were, therefore, in the public domain.

When Congress passed the 1790 Act, these works were removed from the public domain in those states and restored to protection. It is irrelevant that some works were protected by other states. *All* works covered by the URAA are protected in their home countries. The 1790 Act establishes conclusively, then, that works may—at least at times—be removed from the public domain and restored to copyright protection.¹³

Plaintiffs make two final contentions regarding the 1790 Act. First, they argue that the Attorney General may not allege on a motion to dismiss that the Act removed works from the public domain. Pl. Mem. 49. Yet this is not in dispute. The text of the 1790 Act expressly states that it applies to works “already printed” within the United States. 1 Stat. 124. The Act’s passage, therefore, necessarily removed works from the public domain in states that had not previously protected published works (Delaware, Maryland, and Pennsylvania). Second, Plaintiffs argue that the Attorney General contradicts himself because, with reference to the CTEA, he claimed that the 1790 Act extended subsisting copyright terms (as opposed to removing

¹² Both the Maryland and Pennsylvania statutes are reprinted in Melville B. Nimmer & David Nimmer, 8 *Nimmer on Copyright* App 7[C].

¹³ The 1790 Act actually went further than the URAA in its restoration. It granted a new, full term to the works it covered—even if they had existed for years previously and not been protected. 1 Stat. 124 (granting a 14 year term (plus a 14 year renewal) to works starting the day they record the title in the clerk’s office). The URAA grants only the remainder of the term the work would have been eligible for had it been protected all along.

works from the public domain). Pl. Mem. 50. As noted above (*supra*, p. 3), the Attorney General’s position has consistently and correctly been that the 1790 Act created *new* copyright protection for *works already in existence*. That is plain from the text of the statute itself. Plaintiffs do not disagree—they simply claim that it is not a matter for a motion to dismiss.

Plaintiffs next argue that the dicta in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), creates a firm rule that nothing can be removed from the public domain. Pl. Mem. 51-53. But *Graham* did not purport to announce this rule. Rather, *Pennock v. Dialogue*, 27 U.S. 1 (1829), announced the rule, which *Graham*—because it only mentioned the rule in dicta—did not fully re-articulate. Def. Mem. 24-26. The proper meaning of *Pennock*’s rule was reaffirmed by *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989)—a case decided after *Graham*. Authors who have made the “voluntary act or acquiescence” to donate their works to the public domain are held to that choice, which constitutes “an abandonment of [their] right.” *Bonito Boats*, 489 U.S. at 149. The *Pennock* rule does not foreclose, therefore, the restoration of works from the public domain when their authors were denied the choice to protect or donate.¹⁴

¹⁴ Plaintiffs also contend that foreign authors whose works the URAA restores were not deprived of their choice. If they really wanted U.S. copyright protection, Plaintiffs insist, the authors could have moved here or just complied with U.S. copyright law. Pl. Mem. 52. Plaintiffs cannot seriously contend that because authors could have moved to the United States and did not, they had the option to protect their works and gave it up. That is not the choice to which *Pennock* and *Bonito Boats* refer. And Plaintiffs’ suggestion that other authors (whose countries the United States did have reciprocal relations with) could have complied with the U.S. formalities is counter-factual. Congress passed the URAA precisely because many of these authors were unaware of the U.S. formalities and, therefore, could not comply. As a practical matter, they were deprived of their choice. *Joint House and Senate Committee Hearings on the URAA*, 103rd Cong. 191 (1994) (statement of Shira Perlmutter).

2. The URAA Is Plainly Adapted to “promote the Progress of Science and useful Arts”.

For the reasons identified in Defendant’s original memorandum and the above discussion of the CTEA, the Court should not reach the question whether the URAA promotes artistic progress. Def. Mem. 26-27; *supra*, pp. 7-8. If the Court does evaluate whether the Act promotes artistic progress, any such analysis would be done using the lenient *McCulloch* standard. *Supra*, pp. 9-12. The Attorney General’s initial memorandum demonstrates in detail that the URAA is “plainly adapted” to promote artistic progress. Def. Mem. 27-29. Plaintiffs do not challenge this showing. They respond only that they will prove at trial that the URAA does not, *in fact*, promote progress. That misses the point; whether the URAA actually promotes progress is irrelevant to whether it satisfies *McCulloch*.

B. The URAA Is a Proper Exercise of Congress’s Power to Implement Treaties.

Under the Necessary and Proper Clause, Congress may implement any valid treaty. The URAA is a valid treaty. Def. Mem. 30-31. Plaintiffs argue, in accord with the Attorney General’s position, that treaties cannot contravene constitutional prohibitions. Pl. Mem. 54-57. Plaintiffs argue further, however, that the Copyright Clause is such a prohibition because it is both a grant of power and a limit. That position is incorrect. All enumerated powers are both grants and limits—that is why the federal government is called a government of limited, enumerated powers. The Commerce Clause, for example, grants Congress the power to regulate commerce. It also limits that power to *interstate* commerce. Every enumerated power could be broken down like that: “[W]e have also recognized that the same language that serves as the basis for the

affirmative grant of congressional power also serves to limit that power.” *Kimel v. Florida Board of Regents*, 528 U.S. 62, 81 (2000) (discussing §5 of the fourteenth amendment).

The treaty-power decisions, which both sides cite, hold that treaties cannot negate constitutional *prohibitions*, such as those contained in the Bill of Rights—not that treaties cannot exceed the limits on Congress’s enumerated powers. Indeed, *Missouri v. Holland*, 252 U.S. 416 (1920), makes the point expressly that the enumerated powers do not limit the treaty power. If every enumerated power were also a prohibition, *Missouri v. Holland* would be meaningless. So while the URAA cannot implement the Berne Convention if it violates the first or fifth amendments, the Copyright Clause does not factor into the treaty-power analysis.

C. The URAA Complies Substantive Due Process.

With regard to substantive due process, Plaintiffs misunderstand the purpose of a motion to dismiss. Pl. Mem. 59-62. Taking the facts as Plaintiffs have alleged, the URAA is not unduly retroactive, nor does it unsettle expectations in any unconstitutional manner. Congress built into the Act a number of protections specifically to protect American citizens. Def. Mem. 32-34. Plaintiffs completely ignored these crucial safeguards, such as the protections for reliance parties and derivative works. These are not facts, but the legal attributes of the statute. Nor do Plaintiffs make any attempt to distinguish the Supreme Court cases upholding much more onerous statutes, statutes which affix liability based on past acts—something the URAA does not do. Def. Mem. 32-33. As a matter of law, therefore, the URAA does not violate due process.

Conclusion

The Attorney General’s motion to dismiss, designed to test the legal sufficiency of

Plaintiffs' complaint, demonstrates conclusively that both the CTEA and the URAA are constitutional. The motion should, therefore, be granted.

Respectfully submitted,

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