

**LIFE AFTER *ELDRED*: THE SUPREME COURT
AND THE FUTURE OF COPYRIGHT**

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In this essay I will reflect on the three cases decided by the Supreme Court in the new millennium. Of course, there is nothing sacrosanct about the year 2001, except that there was an overblown scare about the breakdown of our computerized world. That said, the three copyright cases decided in or after 2001 do provide a picture, albeit somewhat blurred, of where the Court stands on copyright issues. Three cases, obviously, do not constitute an enormous amount of empirical data, so I can only posit tentative conclusions about where the Court is going and what these decisions might mean for the future of copyright law.

On the whole, as I reflect on this rather limited Supreme Court jurisprudence, I fail to conclusively find a unifying theme. I would prefer to speak of certain tendencies, which may or may not come to full fruition in the future. What I see in reviewing *Eldred v. Ashcroft*,¹ *New York Times Co. v. Tasini*,² and *Dastar v. Twentieth Century Fox Film Corp.*³ is a Court that rejects a clear-cut normative vision in favor of what one might characterize as a jurisprudence of

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1. 537 U.S. 186 (2003).
 2. 533 U.S. 483 (2001).
 3. 123 S. Ct. 2041 (2003).

deference, a conservative orientation rather than an exercise of some form of judicial activism. Relative unanimity rules the day among members of the Court as exemplified by *Eldred* and *Tasini* in their 7-2 opinions, finding Stevens and Breyer the dissenters in each.⁴ It is a court that has reconfirmed the traditional contours of copyright, one that recognizes the delicate balance between the exclusive rights of the copyright owner and exceptions and limitations on that property right. In this regard, certain public domain advocates, who were sorely disappointed after the Court upheld the Copyright Term Extension Act (CTEA) in *Eldred v. Ashcroft*, may be pleasantly surprised if and when the Court is asked to accommodate digital issues within the traditional confines of copyright. I will return to this issue throughout this essay.

In reviewing these cases, I reveal my own particular bias in constitutional interpretation, which avoids a structured formalist or originalist interpretation. Instead, I favor a more generalized pragmatic, instrumentalist approach to the law and believe that the ultimate goal of any constitutional jurisprudence is the enhancement of social welfare, an important aspect of which is consumer welfare, as defined from an economic standpoint. Of course, this jurisprudence should always be constrained by the language of statutes and the intent of Congress, particularly when that intent unambiguously flows from the statutory provision. However, statutes and constitutional provisions must be interpreted flexibly in order to make them speak intelligently to circumstances sometimes not envisaged by their drafters. In other words, the law is not grounded in permanent principles and realized in logical manipulation of these principles.

As for my own view on the three cases at issue, I find the decisions to be sensible from a jurisprudential standpoint, although I might find fault with the rationale of *Dastar*, rather than its holding. I might disagree with the policy behind the CTEA, but not the *Eldred* decision. Likewise, I am not happy with the immediate societal effect of the Court's *Tasini* decision, but I think the Court properly interpreted the statute. I will begin with the most talked about Supreme Court case affecting copyright law, which is, of course, *Eldred*, decided on January 15, 2003.

4. See *Eldred*, 537 U.S. at 223, 242; *Tasini*, 533 U.S. at 506.

I. *ELDRED V. ASHCROFT*: DEFERENCE AND HUMILITY

*Eldred v. Ashcroft*⁵ is a significant case because it represents the first direct challenge to the constitutionality of any portion of federal copyright legislation to reach the Court since the first statute became law in 1790. The fact that the Court decided to hear the case on certiorari, after it was lost on both the district level and on appeal, was a high point for public domain advocates.

The law was an impediment to Eric Eldred, who had hoped to post a number of 1923 works on the Internet upon expiration of their copyrights in 1999.⁶ The passage of the CTEA extended by twenty years the copyright term for existing copyrights, pushing the copyright expiration on these works to 2019.⁷ Eldred's primary argument was that the CTEA did not "promote science and useful arts" as required by Article I, Section 8, Clause 8 of the United States Constitution.⁸ Rather the law was simply a windfall to owners of existing copyrights, and neither encouraged the creation of new works nor provided any other benefit to the public.⁹ Moreover, the statute was said to violate Article I because an extension of existing copyright terms would exceed congressional power to grant copyright for "limited times."¹⁰ Eldred also asserted a violation of the First Amendment claiming that the CTEA was a content-neutral regulation of speech that could be upheld only if it satisfied a heightened level of judicial scrutiny.¹¹ Both the district court and the Court of Appeals for the District of Columbia Circuit summarily rejected these arguments.¹²

To the surprise of many, the Supreme Court granted certiorari in February 2002.¹³ The case soon became front-page news around the world and generated an unusually large number of amici briefs. By a 7-2 vote, the Supreme Court upheld the CTEA that prolonged the duration of existing and future copyrights for another twenty years.¹⁴ As a result of the decision, the term of copyright for individual authors was extended to the life of the author plus

5. 537 U.S. 186 (2003).

6. Joint Appendix at 13aa, *Eldred v. Ashcroft*, 2002 WL 32102971 (2002).

7. *Eldred*, 537 U.S. at 195.

8. Pet. for Writ of Cert. at 10, *Eldred v. Ashcroft*, 2001 WL 34092017 (2001).

9. *Id.*

10. *Id.*

11. *Id.* at 17.

12. *Id.* at 3-4.

13. *Eldred v. Ashcroft*, 534 U.S. 1126 (2002).

14. *Eldred v. Ashcroft*, 537 U.S. 186, 222 (2003).

seventy years for works created on or after January 1, 1978.¹⁵ For works first published before that date, the term is ninety-five years from the date of first publication.¹⁶ Although the Supreme Court decided against *Eldred* on both the Article I and First Amendment issues, the Court's rationale is worthy of attention for its possible effect on future cases. I will begin by discussing the Article I issue and then proceed to the First Amendment issue, which I believe may prove to be the more significant issue in the future development of copyright law.

A. *The Article I Issue: Did the Extension Promote Progress?*

One intriguing question was whether the Court would assume the activist role that it took in federalist cases¹⁷ or take the more deferential position that it has applied to commercial legislation. Of course petitioners hoped that the Court would adopt its anti-federalist role; in that case, the CTEA would be in serious difficulty. At oral argument, when I heard Chief Justice Rehnquist speak with enthusiasm about the expansive nature of Congress's Commerce Clause power, however, petitioner's position was obviously in jeopardy.

In deciding that Congress could apply a copyright extension to existing copyrights, the Court acknowledged the influence of "an unbroken congressional practice of granting to authors of works with existing copyrights the benefit of term extensions"¹⁸ holding that "[s]uch consistent congressional practice is entitled to 'very great weight . . .'"¹⁹ This attitude is grounded on a basic principle of constitutional interpretation. When Congress passes a law there is an implicit congressional judgment that the statute is within Congress's constitutional power.²⁰ Thus, the constitutional beliefs

15. 17 U.S.C. § 302(a) (2000).

16. *Id.* § 302(e). For works created before January 1, 1978 but not published or copyrighted, the term of copyright "subsists from January 1, 1978, and endures for the term provided by section 302." *Id.* at § 303(a).

17. *See Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627, 640-41 (1999); *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44 (1996).

18. *Eldred*, 537 U.S. at 188.

19. *Id.* at 213.

20. *See, e.g., United States v. Munoz-Flores*, 495 U.S. 385, 391 (1990) ("Because Congress is bound by the Constitution, its enactment of any law is predicated at least implicitly on a judgment that the law is constitutional.").

of Congress are a basic source for judicially constructed constitutional law.

Indeed, even upon the most cursory reading, one is struck with the language of an opinion permeated with the rhetoric of deference. Having determined that the CTEA does not violate the “limited Times” prescription of the “Copyright Clause,” the Court goes on to state that “we defer substantially to Congress” on this constitutional question.²¹ “[W]e are not at liberty to second-guess congressional determinations and policy judgments of this order, however debatable or arguably unwise they may be.”²² I surmised that the petitioners may have been in trouble when Justice O’Conner posed to the petitioners’ counsel, Lawrence Lessig, that perhaps the term extension was bad policy, but was it unconstitutional?²³ Indeed, the majority stated that the CTEA “reflects judgments of a kind Congress typically makes, judgments the Court cannot dismiss as outside the Legislature’s domain.”²⁴ Thus, deference to Congress is appropriate in this instance because the kinds of judgments necessary to apply the relevant constitutional rule either are better made by Congress or are beyond the institutional competence of the Court.²⁵ In the end, the Court’s position markedly contrasts its cases based on Congress’s power to abrogate states’ sovereign immunity. Instead, the majority viewed the CTEA as another form of commercial legislation.

I do not find the Court’s decision to defer to Congress’s authority to make policy and opt for the status quo particularly unanticipated, unusual, or striking. I say this even though I disfavored lengthening the copyright term. Like so many others, I was convinced that it could hardly enhance consumer welfare and promote science and the useful arts by impoverishing the public domain of thousands of works. My hunch is that the public’s ability to freely access these works outweighs whatever incentive the copyright monopoly might give to the copyright owner to distribute the work. The Court, however, found it sufficient that Congress “rationally credited projections that longer terms would encourage copyright holders to invest in the restoration and public

21. *Eldred*, 537 U.S. at 204.

22. *Id.* at 208.

23. *Id.* at 222.

24. *Id.* at 188.

25. *Id.*

distribution of their works.”²⁶

It is hard for me to fault the Court for deferring to Congress. Evaluating the costs and benefits of term extension—that is, how to promote science and the useful arts—is an appropriate determination for Congress within its role as policy maker. However, I am skeptical that the twenty-year extension will create or save a significant number of jobs for our copyright industries. I would like to see a study performed to determine the effect the CTEA has on jobs; but even if one comes about, it might raise more questions than it answers. It would be a worthwhile project, but I suspect we will never know the full effects of the term extension because such empirical determinations are inherently indeterminate.

In short, Congress has wide latitude in determining what kind of “progress” it is trying to promote when it passes copyright legislation. The petitioners did not think that the CTEA was the best way to promote progress, and I agree. As stated above, however, one can just as easily argue that conferring more rights will promote the distribution of works. In other words, term extension may provide a useful subsidy for the efficient management of property rights. Ultimately, no universally recognized definition of progress exists. The meaning of “progress” is inherently contingent. To adopt some fixed meaning of “progress” would signal, at least in the copyright domain, a return to a Lochnerian regime of economic substantive due process that defined important aspects of constitutional law in the first third of the twentieth century.²⁷

Looking farther out, what will happen in anticipation of 2019, when the twenty-year extension will expire on the oldest currently protected works? Will Congress provide another extension, a CTEA II, substantiating the worst fears of those who believe the 1998 amendments are the first in a series leading to an ultimate term of eternity minus one day? Or as one might express it: “perpetual copyright term ‘on the installment plan’”?²⁸ This was a position taken by petitioners in *Eldred*.²⁹ Their argument can be characterized as follows: Once Congress has granted a term of

26. *Id.*

27. See Thomas B. Nachbar, *Judicial Review and the Quest to Keep Copyright Pure*, 2 J. ON TELECOMM. & HIGH TECH. L. 33, 67-68 (2003).

28. Pet. for Writ of Cert. at 9, *Eldred v. Ashcroft*, 2001 WL 34092017 (2001).

29. *Id.*

copyright, Congress is prohibited from extending the term of copyright. To do so would constitute a violation of the “limited Times” provision of Article I. Of course, a twenty-year extension is limited to twenty years. As William Patry explains, this logical reality forced petitioners to argue the term extension was not unconstitutional in itself but rather unconstitutional as one of an infinite series of future extensions.³⁰ Such arguments about the future behavior of Congress carry little weight convincing a court to strike down legislation.³¹

I do not share the fears of many of my copyright colleagues who believe that we have just seen the beginning of many promiscuous term extensions.³² I think the opposite. My prediction is that this will be the last extension, unless, of course the European Union decides to extend their copyrights. If the European Union would extend its copyright protection to, let’s say, life plus ninety years, and the United States Congress followed suit, I can see no rational basis for the Court to strike down such legislation. Thus, the legislative problem may have to be solved by legislative determination.

Actually, there is an elegant legislative solution to the copyright term dilemma that I think would maximize consumer welfare without, perhaps, unduly offending the needs of those who advocate the extended term. As Justice Breyer noted in his dissent, the Congressional Research Service study prepared for this case indicates that only “2% of copyrights between 55 and 75 years old retain commercial value.”³³ Moreover, it is usually impracticable to identify, much less find, authors of old works. And, of course, in instances where one can do so, the transaction costs may be prohibitive for creators of new intellectual property to acquire licenses.³⁴ To liberate those works that no longer have value to the copyright owner, Congress should impose a copyright maintenance fee every year up to the twentieth year of the extended term.³⁵ One

30. William Patry, *The United States and International Copyright Law: From Berne to Eldred*, 40 HOUS. L. REV. 749, 758 (2003).

31. See *id.*; William Patry, *Court Takes Hands Off Approach on Copyrights*, NEW YORK L.J., May 12, 2003.

32. See, e.g., Lawrence B. Solum, *Congress’s Power to Promote the Progress of Science: Eldred v. Ashcroft*, 36 LOY. L.A. L. REV. 1, 81-82 (Fall 2002) (discussing unlimited extension of copyright duration under the CTEA).

33. *Eldred*, 537 U.S. at 248.

34. *Id.* at 250.

35. See Public Domain Enhancement Act, H.R. 2601, 108th Cong. § 3(c) (2003); <http://www.eldred.cc> (a web site for the Public Domain Enhancement Act

could even take a page from patent law and progressively increase the maintenance fee every year until twenty years ends.³⁶

I believe this is the best congressional solution to the public domain and one that is more feasible from a practical and political standpoint than the solution that Landes and Posner propose: infinitely renewable copyrights as measured from the beginning of the copyright term.³⁷ The Landes and Posner plan would necessarily entail the renegotiation of the TRIPS agreement and a withdrawal from the Berne Convention, an unimaginably intolerable price to pay in the creation of an economically efficient system for managing copyright duration. A copyright maintenance system as outlined above—one applied to the extended twenty-year period only—while not a panacea to public domain publishers, would avoid some of the deadweight loss that the term extension has imposed on the market for copyrighted works. It would do so without creating havoc with our international copyright relations.

What effect will the Court's deferential attitude have on the critical copyright issues of our day? *Eldred* does not bode well for those who would challenge the Digital Millennium Copyright Act (DMCA)³⁸ on constitutional grounds. If the striking deference that the Court confers on Congress is here to stay, the focus should be directed to the legislative stage where concessions may be garnered to ameliorate the more offensive aspects of the particular bill at issue. In other words, once the legislation is passed, do not look to the courts to bail you out. Indeed, the courts have in only one instance declared that a copyright bill was unconstitutional.³⁹

B. *Eldred and the First Amendment*

In my opinion, the First Amendment issue in *Eldred* ultimately

movement which seeks to move unused copyrighted work into the public domain) (last visited July 8, 2004). The PDEA would require a copyright holder to pay a \$1 renewal fee fifty years after his work is first published, and every ten years after until the end of the copyright term.

36. See 35 U.S.C. § 41(b) (2000) (defining progressive rate structure for patent maintenance fees).

37. See William M. Landes & Richard R. Posner, *Indefinitely Renewable Copyright*, 70 U. CHI. L. REV. 471, 518 (2003).

38. 17 U.S.C. § 1201 et seq. (2000).

39. *United Christian Scientists v. Christian Sci. Bd. of Dirs.* 829 F.2d 1152, 1171 (D.C. Cir. 1987) (invalidating Private Law 92-60, 85 Stat. 857 (1971) on establishment of religion grounds.)

may have more impact on the future of copyright law than the Court's status quo, inherently deferential reading of Article I. That said, though the petitioner lost as well on this issue, what Justice Ginsberg said about the interplay of copyright and the First Amendment indicates real constraints on the scope of copyright law.

On the First Amendment issue, the majority agreed with the government's position that the "speech-protective purposes and safeguards" embodied in copyright law were sufficient to preclude any heightened scrutiny of copyright legislation.⁴⁰ In that regard, the Court referred to the idea/expression in § 102(b),⁴¹ and § 107's fair use doctrine⁴² as part of the definitional balance that retains a free marketplace of ideas while protecting the author's original expression. In conclusion, the majority declared: "The CTEA . . . does not oblige anyone to reproduce another's speech against the carrier's will The First Amendment securely protects the freedom to make—or decline to make—one's own speech; it bears less heavily when speakers assert the right to make other people's speeches."⁴³ Thus, copyright's built-in free speech safeguards are generally adequate to address them. Significantly, the Court added that the D.C. Circuit spoke too broadly when it declared copyrights "categorically immune from challenges under the First Amendment."⁴⁴ "But when, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary."⁴⁵

These remarks about the relationship between copyright law and the First Amendment are apt to have an influence beyond the narrow issue of term extension. They may be the most important feature of the Court's opinion on future developments in copyright law. When does legislation alter those "traditional contours?" In this regard, one might refer to the decision in *Universal Studios, Inc. v. Corley*.⁴⁶ In *Corley*, the editors of a web site published the hyperlinks to other web sites making available a program, the so-called DeCSS code, that could be used to crack the motion picture

40. *Eldred*, 537 U.S. at 218-19.

41. 17 U.S.C. § 102(b) (2000).

42. *Id.* § 107.

43. *Eldred*, 537 U.S. at 221.

44. *Id.* (citation omitted).

45. *Id.* (citations omitted)

46. 273 F.3d. 429 (2d Cir. 2001).

industry's DVD anti-copying security software.⁴⁷ In holding that such conduct violated § 1201(c) of the DMCA,⁴⁸ the Court of Appeals deferred to Congress's authority to enact prohibitions against making available the means to circumvent technological measures designed to protect copyrighted works against unauthorized access and use.⁴⁹ It read § 1201(c) of the DMCA narrowly, holding that the provision preserves fair use in the context of traditional copyright infringement litigation but not for independent causes of action brought under the DMCA.⁵⁰ The Court found that the legislation imposed no undue burdens on the First Amendment interests of individuals who communicate about computer code.⁵¹ Neither the statute nor, as far as I know, the legislative history addresses the linking issue; nonetheless, the court interpreted the law to afford full relief against the harms at which the statute was intended.⁵² The *Corley* court, however, declined consideration on the record of whether enforcement of the anti-circumvention provisions might improperly encumber the "fair use" rights of third parties.⁵³

For proponents of a wider public domain, *Eldred* was a loss at least for the question of term extension. They will no doubt find some support in their position from Justice Ginsberg's statements regarding the role of fair use in the overall scheme of copyright. I look for public domain proponents to accelerate their efforts on this issue.

II. *NEW YORK TIMES CO. V. TASINI*: THE MEANING OF MEDIA NEUTRALITY

New York Times Co. v. Tasini,⁵⁴ decided some two years before *Eldred*, spoke to a relatively narrow and technical issue under § 201(c) of the Copyright Act.⁵⁵ This section of the Act allows publishers of "collective works," such as newspapers and magazines, the right to republish the material supplied by freelance

47. *Id.* at 445-46.

48. 17 U.S.C. § 1201(c) (2000).

49. *Universal Studios, Inc.*, 273 F.3d at 458.

50. *Id.* at 458-59.

51. *Id.* at 455.

52. *Id.* at 458.

53. *Id.* at 458-59.

54. 533 U.S. 483 (2001).

55. 17 U.S.C. § 201(c) (2000).

contributors in “revisions” of those collective works.⁵⁶ Even though *Tasini* did not receive the universal ballyhoo of *Eldred*, it is an important decision because the Court gave its first indication of how it will apply traditional copyright principles to disputes involving digital information technologies. The Court rejected the argument that unforeseen technological developments call for specifically crafted approaches to interpretations of the Copyright Act.⁵⁷

This litigation was initiated by *Tasini* and other freelance writers who contributed articles to the *New York Times* and other publishers.⁵⁸ Under agreements with the periodicals’ publishers, two computer database companies placed copies of the freelancers’ articles—along with all other articles from the periodicals in which the freelancers’ work appeared—in three databases.⁵⁹ In this format, the user could retrieve each article individually, clear of the context in which the article appeared in print publication.⁶⁰ In other words, the user entered a search query based on key words, which would then be retrieved by the search engine.

The question presented was whether a publisher’s reproduction and distribution of its entire periodical, not only in print but also electronically, is a privileged revision of a collective work under § 201(c) of the Copyright Act.⁶¹ The Act provides in part:

In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.⁶²

Justice Ginsberg, writing for the same 7-2 *Eldred* majority (Breyer and Stevens dissenting), rejected the publisher’s argument that databases are analogous to microfilm and microfiche.⁶³ Unlike

56. *Id.*

57. *Tasini*, 533 U.S. at 505-06.

58. *Id.* at 483.

59. *Id.*

60. *Id.*

61. *Id.* at 487.

62. 17 U.S.C. § 201(c) (2000).

63. *Tasini*, 533 U.S. at 485-86.

microforms, the databases at issue did not perceptibly reproduce articles as part of the collective work to which the author contributed or as part of any revision thereof.⁶⁴ Nor was the Court persuaded by publishers' reliance on the concept of media-neutrality in contending that transferring a work between media does not alter the character of the work.⁶⁵ Unlike the conversion of newsprint to microfilm, the transfer of articles to the databases is not a mere conversion of intact periodicals or revisions from one medium to another.⁶⁶ Rather, the databases offer users individual articles, not intact periodicals.⁶⁷ The Court repeatedly returned to the way the files are perceived and accessed by end users "[i]n determining whether the Articles have been reproduced and distributed 'as part of' a 'revision' of the collective works in issue, we focus on the Articles as presented to, and perceptible by, the user of the Databases."⁶⁸

As to remedy, the Court remanded the case without explicit guidance.⁶⁹ The court discounted the publisher's predictions of the devastating consequences that would result from an injunction.⁷⁰ Justice Ginsberg concluded "[i]n any event, speculation about future harms is no basis for this Court to shrink authorial rights Congress established in § 201(c). Agreeing with the Court of Appeals that the Publishers are liable for infringement, we leave remedial issues open for initial airing and decision in the District Court."⁷¹

As in *Eldred*, Justices Stevens and Breyer sharply disagreed with the majority's statutory analysis, concluding that the databases were in fact revisions under § 201(c).⁷² Justice Stevens reasoned that if a single edition of the *New York Times* were stored as ASCII files on a floppy disk, preserving the "all-important editorial selection," the dissent would hold such a collection of files to be a "revision" of that collective work, if not "that collective work" itself.⁷³ "[A]s long as each article explicitly refers to the original collective work and as

64. *Id.*

65. *Id.* at 486.

66. *Id.*

67. *Id.*

68. *Id.* at 499.

69. *Id.* at 506.

70. *Id.* at 504-05.

71. *Id.* at 505-06.

72. *Id.* at 506. (Stevens & Breyer, JJ., dissenting).

73. *Id.* at 514-16.

long as substantially the rest of the collective work is, at the same time, readily accessible to the reader of the individual file,” there should be no difference between a print version and an electronic version of a single daily paper.⁷⁴ The dissent retraced the evolution of § 201(c) from the relevant sections of the 1909 Act, asserting that the majority decision gave insufficient weight to the public benefit provided by the databases, and thus “unnecessarily subverts this fundamental goal of copyright law in favor of a narrow focus on ‘authorial rights.’”⁷⁵

The majority’s holding in *Tasini* is troublesome even though, from a purely doctrinal standpoint, I agree with the Court’s interpretation of § 201(c). To hold otherwise would distort the wording of the statute to achieve a result that would keep the status quo and not distort the current distribution of articles already available to consumers. However correct *Tasini* may be from a doctrinal standpoint, it has proved to be an unmitigated disaster from a societal standpoint.⁷⁶

At first blush, the Supreme Court’s decision appears to be a nice victory for freelance journalists. On closer inspection, it hardly accommodates anyone. One might conclude that the freelancers won the battle but lost the war. What happened is this: In the 1990s, with the *Tasini* case looming, publishers (like the New York Times Co.) became fully aware of the possible liability risk and began insisting on “all rights” agreements designed to allow publishers to reuse freelancers’ contributions.⁷⁷ The contracts are standard now, but it is not clear whether freelancers were able to extract larger profits in negotiating these agreements. After all, media outlets for freelance articles have continued to consolidate so that publishers are now virtual oligopolies. The market is now a buyer’s market: “You want to write an article for us, sign over the rights.” Thus, the freelancers earned a modest one-time windfall at best.

If the freelancers earned an ambiguous victory, and the publishers suffered an ambiguous loss, what about the public interest in access to information? Here is where the story gets

74. *Id.* at 514.

75. *Id.* at 520.

76. See *Experts Weigh Tasini Ruling’s Impact on Freelancers and Electronic Publishing*, 62 BNA’S PATENT, TRADEMARK & COPYRIGHT J. 557 (2001) (reporting on a briefing that discussed *Tasini* and its consequences).

77. *Id.*

depressing. The public appears to have lost unambiguously. In the aftermath of *Tasini*, many newspapers and other print media, uncertain as to which archived articles were written by freelancers, have resorted to overly inclusive purges to avoid liability. Consequently, a researcher who wants access to a certain article may not be able to go online to obtain it and, in turn, is forced to find a library that keeps paper (or microfiche) copies of the publication.

So what has *Tasini* accomplished outside of a reasoned interpretation of § 201(c) and rather unfortunate practical results?⁷⁸ One thing stands out. *Tasini* is a pro-author decision that reconfirms the basic policy that individual creation, encouraged by the incentives of copyright law, benefits the public interest. After all, it was concern about the unfair situation of periodical contributors that motivated Congress to structure § 201(c) as it did.⁷⁹ Some might take pleasure in the fact that the beneficiaries of this pro-author attitude were real live creators rather than the “content providing” corporate entities.

In addition to reaffirming the pro-author basis of § 201, *Tasini*, more importantly, articulates a certain attitude in the application of copyright law to digital issues. In my view, the case stands for one version of “media neutrality,” the idea that courts should interpret copyright law in a technologically neutral fashion. In applying § 201(c), the Court focused on consumers’ perceptions to determine what constituted a qualifying “revision” of a periodical, rather than on the technology’s characteristics itself. In so doing, it rejected the notion that digital issues are somehow different than others, a position adopted in part by the dissenters. What this means is that the digital condition is not so overwhelmingly singular to justify the abrogation of traditional copyright principles.

What does this view of “media neutrality” hold for the future of copyright law? Although *Tasini* is an author’s rights case, its implicit approach to media neutrality might result in applying the doctrine of fair use in a technologically neutral manner, even though the user may have accessed a work residing in digital format

78. For an analysis of the legislative history concerning § 201 see William Patry, *New York Times v. Tasini: Call for Common (Not Horse) Sense*, 61 BNA’S PATENT TRADEMARK & COPYRIGHT J., No. 602 (2001).

79. Often in United States copyright law the notion of authorship is pressed into service to benefit corporate entities rather than individual creators. See Peter Jaszi, *Towards a Theory of Copyright: The Metamorphosis of “Authorship,”* 1991 DUKE L. J. 455 (1991).

and despite the argument that such use might cause greater risks to the copyright owner. To this extent, *Tasini's* version of media neutrality, read in conjunction with *Eldred's* reaffirmation of fair use in its First Amendment discussion, may bode well for advocates of a more vibrant public domain.

From an immediate standpoint, *Tasini* has already had an impact on the development of the law under § 201(c). In *Faulkner v. National Geographic Society*,⁸⁰ the district court for the Southern District of New York held that the use of freelancers' photographs in CD-ROM versions of *National Geographic* magazine was a privileged revision of the print publication, not an infringement of the freelancers' copyright in their contributions.⁸¹ The *Faulkner* case runs counter to *Greenberg v. National Geographic Society*,⁸² a pre-*Tasini* decision, that found no revision privilege in favor of the magazine under the same facts. The *Faulkner* court emphasized the fact that the individual contributions appeared in the same contexts as they did in the original collective work.⁸³

III. *DASTAR V. TWENTIETH CENTURY FOX FILM CORP.*: RIGHT OF PATERNITY

One could challenge my characterization of *Dastar Corp. v. Twentieth Century Fox Film Corp.*⁸⁴ as a copyright case and in some ways I would agree. After all, *Dastar* concerns the application of unfair competition in an unusual context. I include it in my discussion because it does reflect the interplay between the Commerce and Copyright clauses of the Constitution, the protection of moral rights, and more generally, the Court's current attitude about the role of public domain.

In 1948, General Dwight D. Eisenhower completed his book, *Crusade in Europe*, an account of the Allied crusade of Europe.⁸⁵ The publisher, Doubleday, registered the copyright and granted exclusive TV rights to Fox.⁸⁶ Fox commissioned Time to produce a

80. 294 F. Supp. 2d 523 (S.D.N.Y. 2003).

81. *Id.* at 544-46.

82. 244 F.3d 1267 (11th Cir. 2001)

83. *Faulkner*, 294 F. Supp. 2d at 543.

84. 123 S. Ct. 2041 (2003).

85. *Id.* at 2044.

86. *Id.*

TV series, based on the book, which was first broadcast in 1949.⁸⁷ Time assigned its copyright in the series to Fox.⁸⁸ Doubleday renewed its copyright in the book.⁸⁹ Fox did not renew its copyright in the TV series, which expired in 1977.⁹⁰ In 1988, Fox reacquired television rights in the book, including the exclusive right to distribute the videos.⁹¹ It then sublicensed to SFM Entertainment and New Line Video the right to produce and distribute a video set.⁹² In 1995, Dastar copied the original TV series, removed the credits, repackaged the set, and released its own video product under the credit “DASTAR CORP presents.”⁹³ Fox, SFM, and New Line filed suit alleging copyright infringement and violation of § 43(a) of the Lanham Act and state unfair competition law for “reverse passing off.”⁹⁴ The district court granted summary judgment to Fox on both the copyright and “reverse passing off claim.”⁹⁵ It found that Dastar had committed a “bodily appropriation” by substantially copying the series and selling it without attribution to Fox.⁹⁶ The Court of Appeals reversed and remanded on the copyright infringement claim, but affirmed the claim for “reverse passing off.”⁹⁷ The court found that Dastar made a “false designation of origin” in violation of trademark law and the “bodily appropriation test” precluded any need to show consumer confusion.⁹⁸

Some court watchers were intrigued, even surprised, that the Supreme Court took the case at all. Were the justices looking for a way to counterbalance the *Eldred* opinion that the Copyright Term Extension Act was constitutional? I do not think we should read too much into this. As fascinating as *Dastar* is, the case is not based on the application of the constitutional clause, as *Eldred* was. It could have been otherwise. For example, the Court could have

87. *Id.*

88. *Id.*

89. *Id.*

90. *Id.*

91. *Id.*

92. *Id.*

93. *Id.*

94. *Id.* at 2044-45.

95. *Id.* at 2045.

96. *Id.*

97. *Id.*

98. *Twentieth Century Fox Film Corp. v. Entm't Distrib.*, 34 Fed. Appx. 312, 314 (9th Cir. 2002), *rev'd sub nom*, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 S. Ct. 2041 (2003).

found that the Commerce Clause cannot be used to circumvent the Copyright Clause. In the end it took a more modest approach to the question.

The Court chose instead to base its decision by construing the scope of § 43 of the Lanham Act.⁹⁹ It did so, however, in an unexpected way. When the court granted certiorari, I thought that the Court would follow in the footsteps of *Moseley v. Victoria's Secret Catalogue, Inc.*¹⁰⁰ and require proof of actual confusion before sustaining action for reverse confusion. In fact, the opinion is much more expansive and has ramifications beyond trademark law. Justice Scalia, writing for a unanimous Court, reversed the Court of Appeals, which held that the Lanham Act does not prevent the unaccredited copying of an uncopyrighted work.¹⁰¹ The Court concluded that the phrase “origin of goods” in the Lanham Act “refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods To hold otherwise would be akin to finding that § 43(a) created a species of perpetual patent and copyright, which Congress may not do.”¹⁰²

The Court based its rationale on the difference between the standard definitions of “goods” and “origins” and determined that those terms did not cover the underlying intellectual property or its creators.¹⁰³ By contrast, the action could be sustained if Dastar had bought some of New Line's Crusade videotapes and merely repackaged them as its own.¹⁰⁴ Instead Dastar took a creative work in the public domain, copied it, made modifications, and produced its own series of videotapes.¹⁰⁵ Thus, Dastar was the origin of the physical products it sold as its own, and as such, the respondents could not prevail on its Lanham Act claims.¹⁰⁶

The question is: What constitutes “origin”? Does it refer to the manufacturer or the producer of physical goods, or does it refer to the creator of the underlying work? The Court concluded that

99. 15 U.S.C. § 1125 (2000).

100. 537 U.S. 418 (2003).

101. *Dastar Corp.*, 123 S. Ct. at 2041. Justice Breyer took no part in either consideration or decision of the case.

102. *Id.* at 2050 (citing *Eldred*, 537 U.S. 186, 208 (2003)).

103. *Id.* at 2049-50.

104. *Id.* at 2050.

105. *Id.*

106. *Id.*

“origin” refers to the former.¹⁰⁷ Consumers who buy brand-name products do not automatically assume that the brand-name company is the entity that came up with or designed the product. In general, consumers do not care what entity designed the product they are purchasing. In other words, consumers may care who manufactured the product, but do not care who created it. To conclude otherwise, the Court asserted, would cause a conflict with copyright law, which grants the public the right to copy without attribution once a copyright has expired.¹⁰⁸

I personally take issue with Justice Scalia’s conclusion as to what purchasers care about when it comes to the origin of goods. As for myself, I am particularly interested in knowing the author’s name and I suspect many others hold a similar view. I do not agree that a § 43(a) right of paternity in the appropriate circumstance after the expiration of copyright would create an inherent conflict with copyright law. Such a rule would not prevent copying of the copyrighted work with impunity. Thus, I fail to see how the requirement to acknowledge authorship would be that onerous and would improperly extend copyright.

Justice Scalia also asserted that the § 43(a) cause of action would conflict with copyright law in another way. He reasoned that Congress has already created a specific paternity right in the Visual Artists Rights Act (VARA) codified in § 106A of the Copyright Act.¹⁰⁹ VARA provides the author of a qualifying artistic work the right “to claim authorship of that work.”¹¹⁰ Justice Scalia pointed out the VARA paternity right is much more focused than a more generalized right under the Lanham Act.¹¹¹ Thus, to recognize “a cause of action for misrepresentation of authorship of noncopyrighted works (visual or otherwise) would render these limitations superfluous.”¹¹²

This is a striking statement for two reasons. One is factual. I fail to see how a more generalized right of paternity under federal unfair competition law would render VARA superfluous. Certainly, Congress gave no indication that VARA was intended to supersede the protection of paternity interests upheld in the application of

107. *Id.* at 2049-50.

108. *Id.* at 2050.

109. *Id.* at 2048.

110. 17 U.S.C. § 106A(a)(1)(A) (2000).

111. *Dastar*, 123 S. Ct. at 2048.

112. *Id.*

§ 43(a). Second, and more importantly, the statement seems to give short shrift to United States obligations under the Berne Convention requiring that authors be provided the rights of paternity and integrity.¹¹³ Did the Court forget that the requirement of moral rights protections was a major obstacle for United States participation in the Berne Convention? For the United States, the moral rights issue was, to put it mildly, an inconvenient aspect of Berne. At the time of the passage of the Berne Convention Implementation Act, it was generally recognized that the passage of a full-fledged moral rights provision in the copyright law would have been a political impossibility. Thus, the United States, to save face, took a minimalist position on moral rights. In other words, it skirted the issue, maintaining that the entirety of United States law including unfair competition, defamation, privacy, and contract, in addition to copyright law, provided effective protection of moral rights.¹¹⁴ *Dastar* goes far in undermining whatever illusion is left of the minimalist argument.

In addition to ignoring the Berne requirements, *Dastar* also avoided an important and controversial issue concerning legislative authority in the field of intellectual property law. Can the Congress evade constraints placed on it by the Copyright Clause by basing a statutory enactment in another grant of power, such as the Commerce Clause? This issue has particular importance in debates over the proposed *sui generis* database protection legislation.¹¹⁵ Database owners assert that they need such legislation to protect their investment in the development of their informational product, particularly in the digital environment. The pervasive question is whether such *sui generis* legislation is constitutional in light of *Feist Publications, Inc. v. Rural Telephone Service Co.*,¹¹⁶ which precluded copyright protection for facts per se, irrespective of the amount of effort made generating or assembling them. Under *Feist*, a database is protectable only to the extent that it manifests originality as to its selection and arrangement.¹¹⁷

113. Berne Convention for the Protection of Literary and Artistic Works as revised at Paris on July 24, 1971 (Paris Act), art. 6*bis*, available at <http://www.wipo.int/clea/docs/en/wo/wo001en.htm> (last visited July 8, 2004).

114. The Berne Implementation Act of 1988 § 2(3), Pub. L. No. 100-568, 102 Stat. 2853 (1988).

115. See, e.g., The Databases and Collections of Information Misappropriations Act, H.R. 3261 (introduced Oct. 8, 2003).

116. 499 U.S. 340 (1991).

117. *Id.* at 363-64.

Some might view the Court's holding that the Lanham Trademark Act could not override the durational limitation expressed in the Copyright Clause as answering in the negative the question whether legislation, designed to avoid the constitutionally mandated requirement of originality declared in its landmark *Feist* case, can constitutionally be enacted under the Commerce Clause. My guess is that the Court did not have this in mind when it issued its opinion. But *Dastar* will no doubt provide some ammunition to public domain advocates who would find the data proposals lacking in validity from a constitutional standpoint.

IV. CONCLUSION

In my opinion, the Court's record on its millennium copyright decisions is mixed. As for *Eldred*, while the term extension may be bad from a policy standpoint, I relate to Justice Ginsberg's careful and thoughtful opinion despite what some might view as its excessive deference to the Congress on the issue. And perhaps more important for the future of copyright is the Court's reaffirmation that the fair use doctrine enables copyright to pass muster under the First Amendment.

Similarly for *Tasini*, the Court got it right from a doctrinal standpoint, even though the ultimate result of the holding led to some unfortunate results in the information marketplace. On the other hand, public domain advocates may take heart in the Court's refusal to adopt a position of "digital exceptionalism." Thus, when the time comes to apply the doctrine of fair use in the appropriate case, anti-DMCA forces may be pleasantly surprised and take sustenance from the view expressed that just because you call something "digital," that does not rule out the traditional limitations and balances embedded in copyright law. Finally, I agree with the holding in *Dastar* but find its rationale less appealing.

What does all this mean for public domain advocates? Only time will tell. But I will say this, particularly to those who optimistically believed that the Court was poised to overturn the term extension: The future may be grey, but it is certainly not black. Indeed, in their own quirky way, *Eldred*, *Tasini*, and *Dastar* may prove to be the key in reaffirming the traditional checks and balances of copyright law.