04-5649-CR

United States Court of Appeals

FOR THE SECOND CIRCUIT

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UNITED STATES OF AMERICA,

Appellant,

— v.—

JEAN MARTIGNON,

Defendant-Appellee.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

BRIEF OF *AMICI CURIAE* THIRTY-ONE INTELLECTUAL PROPERTY AND CONSTITUTIONAL LAW PROFESSORS IN SUPPORT OF DEFENDANT-APPELLEE AND AFFIRMANCE
[*Amici* Are Listed On Next Page]

Deirdre K. Mulligan
Director, Samuelson Law, Technology & Public Policy Clinic
Acting Clinical Professor of Law
University of California
School of Law (Boalt Hall)
346 Boalt Hall
Berkeley, CA 94720-7200
(510)642-0499

NY Bar No. 2864353

Jack I. Lerner
Clinic Fellow, Samuelson Law, Technology & Public Policy Clinic
University of California
School of Law (Boalt Hall)
392 Boalt Hall
Berkeley, CA 94720-7200
(510) 642-7515

CA Bar No. 220661

Attorneys for Intellectual Property and Constitutional Law Professors

LIST OF *AMICI CURIAE* LAW PROFESSORS

Amici file this brief in their individual capacities, and not as representatives of the institutions with which they are affiliated.

Stephen R. Barnett
Elizabeth J. Boalt Professor of Law Emeritus
University of California, Berkeley
School Of Law (Boalt Hall)

Margreth Barrett
Professor of Law
University of California Hastings College of Law

Barton Beebe
Assistant Professor of Law
Benjamin N. Cardozo School of Law
Yeshiva University

James Boyle
William Neal Reynolds Professor of Law
Duke University School of Law

Dan L. Burk
Oppenheimer, Wolff & Donnelly Professor
University of Minnesota Law School

Irene Calboli
Assistant Professor of Law
Marquette University Law School

Susan Crawford
Assistant Professor of Law
Cardozo School of Law

Kenneth D. Crews
Samuel R. Rosen II Professor of Law
Indiana University
School of Law-Indianapolis

Shubha Ghosh
Professor of Law
University at Buffalo Law School, SUNY

Llewellyn Joseph Gibbons
Associate Professor
College of Law, University of Toledo

Eric Goldman
Assistant Professor
Marquette University Law School

David Greene
Executive Director and Staff Counsel, the First Amendment Project
Instructor of Communications Law
San Francisco State University

Paul J. Heald
Allen Post Professor of Law
University of Georgia School of Law

Institute of Intellectual Property and Social Justice
Howard University School of Law

Steven D. Jamar
Professor
Associate Director, Institute of Intellectual Property and Social Justice
Howard University School of Law

Peter Andrew Jaszi
Professor of Law
American University Washington College of Law

Peter D. Junger
Professor of Law Emeritus
Case Western Reserve University

Raymond Ku
Professor of Law
Associate Director, Institute of Law, Technology & the Arts
Case Western Reserve University School of Law

Michael Landau
Professor of Law
Director, Intellectual Property, Technology, and Media Law Program
Georgia State University

David L. Lange
Professor of Law
Duke University School Of Law

Lydia Pallas Loren
Professor of Law
Lewis & Clark Law School

Eben Moglen
Professor of Law
Columbia Law School

Lateef Mtima
Associate Professor
Director, Institute of Intellectual Property and Social Justice
Howard University School of Law

Deirdre K. Mulligan
Director, Samuelson Law, Technology & Public Policy Clinic
Acting Clinical Professor of Law
University Of California, Berkeley
School Of Law (Boalt Hall)

Tyler T. Ochoa
Interim Academic Director
High Technology Law Institute
Santa Clara University School of Law

Malla Pollack
Visiting Associate Professor
University of Idaho, College of Law

David G. Post
I. Herman Stern Professor of Law
Temple University Law School

Pamela Samuelson
Chancellor's Professor of Law
University of California, Berkeley
School of Law (Boalt Hall)

Niels Schaumann
Professor of Law
William Mitchell College of Law

David E. Shipley
Thomas R.R. Cobb Professor
University of Georgia School of Law

Rebecca Tushnet
Assistant Professor of Law
New York University School of Law
Visiting Associate Professor
Georgetown University Law Center

Eugene Volokh
Professor of Law
UCLA School of Law

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Interest of *Amici Curiae*[1]

Individual *amici* are legal academics who teach and write about intellectual property and constitutional law. None has received any compensation for participating in this brief. *Amici's* sole interest in this case is in the evolution of sound and balanced legal rules for copyright law that conform to the mandates of the Constitution. *Amici* firmly believe that permitting copyright or copyright-like protections that ignore constitutional restrictions undermines the purpose of intellectual property law: "[t]o promote the Progress of Science and useful Arts." U.S. Const. art. I, § 8, cl. 8. *Amici* file this brief with the consent of both parties.

[1] Brian W. Carver, John Rory Eastburg, and Aaron Perzanowski, students of the Samuelson Law, Technology & Public Policy Clinic at the Boalt Hall School of Law, University of California, Berkeley, contributed in the preparation of this brief under the supervision of Deirdre Mulligan and Jack I. Lerner.

Summary of the Argument

This case presents a question of central significance for both copyright law and our system of enumerated powers—whether Congress may avoid constitutionally-mandated limitations under the Copyright Clause (Article I, Section 8, Clause 8) of the United States Constitution by acting under another power. According to the district court, the dispute in this case is whether Congress may regulate original creative works in a manner explicitly forbidden by the Copyright Clause. The Government argues that because 18 U.S.C. § 2319A regulates ephemeral rather than fixed works, the Copyright Clause and its limitations are irrelevant. Appellee Jean Martignon argues that because the statute regulates original creative works, it must heed the constraints of the Copyright Clause regardless of the constitutional basis upon which it ostensibly rests.

While we agree with Martignon that any regulation of original expressive works must adhere to the constraints of the Copyright Clause, this case can and should be decided on far simpler grounds. The government has charged that Martignon "distributed, sold, … trafficked … and reproduced" copies of unauthorized live recordings. The provisions of § 2319A that cover such conduct, §§ 2319A(a)(1) and (a)(3), concern physical copies of works—Writings that are well within the scope of the

Copyright Clause. Because these provisions do not contain any durational limit, they directly violate the Copyright Clause's Limited Times requirement. There is thus no need to reach more difficult questions such as whether other parts of the statute are or are not within the Copyright Clause, or whether they can be enacted under alternative grants of constitutional authority. The provisions at issue here are clearly within the scope of the Copyright Clause, but contain no durational limit; for this reason, if for no other, this Court should affirm the decision below dismissing the indictment against Martignon.

Despite our belief that this case can be decided on these narrow grounds, *amici* offer the Court our expertise and assistance in navigating the admittedly complicated and novel constitutional question with which it has been presented. As professors of intellectual property and constitutional law, *amici* aim to assist the Court in determining the proper relationship between the grants and limitations of the Copyright Clause and legislation regulating original expressive works ostensibly under other constitutional grants of authority.

Section 2319A disregards the limits established by the Copyright Clause in two ways. First, it establishes perpetual exclusive rights in written works—copies and phonorecords that embody live performances—in

violation of the Limited Times requirement. Second, it grants an exclusive right to fix ephemeral, non-written live performances.

The government argues that irrespective of any deficiencies under the Copyright Clause, § 2319A is authorized by other constitutional grants such as the Commerce Clause. As the court below correctly understood, however, the specific limitations of the Copyright Clause constrain congressional authority whenever Congress acts to grant exclusive rights to works of original expression. These limitations apply both internally, to enactments authorized by the Copyright Clause, and externally, to enactments authorized by any other constitutional provision.

The government also contends that these deficiencies are irrelevant because the Copyright Clause simply does not apply to § 2319A. This argument is incorrect: all works regulated by § 2319A lie within the exclusive domain of the Copyright Clause and are subject to its limitations. The Copyright Clause empowers Congress "To Promote the Progress of Science and useful Arts" by granting to "Authors" an "exclusive right" to their "Writings." The term "Writings" acts simultaneously as a grant, authorizing Congress to regulate written creative works, and a limitation, prohibiting Congress from regulating unwritten creative works. Live performances, as creative works, fall within the exclusive domain of the

Copyright Clause, but because they lack tangible form and therefore are not Writings, they may not be protected.

Moreover, regardless of the limitations in the Copyright Clause, the absence of copyright's traditional First Amendment "safety valves," such as a durational limitation and fair use exceptions, render § 2319A unconstitutional. Because the statute does not contain these important provisions, and due to its sweeping breadth and vagueness, § 2319A constitutes an impermissible restriction on protected speech in violation of the First Amendment.

On each of these bases, this Court should affirm the decision below dismissing the indictment against Martignon.

I. The Statutory Provisions Under Which Respondent Is Charged Grant Exclusive Rights In Original Writings Free Of Durational Limits, In Direct Violation Of The Copyright Clause.

The written nature of the works at issue in this case and the fact that the applicable statutory provisions do not contain a durational limit provide the simplest grounds for affirmance. Jean Martignon was charged with the reproduction, distribution and sale of unauthorized copies of live performances. Joint Appendix at A-1. Physical renderings such as these qualify as Writings under the Constitution. Section 2319A(a)(1) prohibits, *inter alia*, unauthorized reproduction of a recording of a live performance,

while § 2319A(a)(3) prohibits the unauthorized distribution and sale of such a recording. These provisions, because they grant exclusive rights in Writings, are properly categorized not as "copyright-like" but as copyright laws, and thus cannot escape the limitations required by the Copyright Clause. Since the rights conferred by §§ (a)(1) and (a)(3) are perpetual, they cannot be sustained without disregarding the plain language of the Constitution.

As the Supreme Court explained in *Burrow-Giles Lithographic v. Sarony*, "Writings" in the Copyright Clause includes "all forms of writing, printing, engraving, etching, &c., by which the ideas in the mind of the author are given visible expression."[2] 111 U.S. 53, 59 (1884). The Court expanded this broad understanding of "Writings" in *Goldstein v. California*, holding that "the word 'writings' … may be interpreted to include any physical rendering of the fruits of creative intellectual or aesthetic labor. . . . Recordings of artistic performances may be within the reach of Clause 8." 412 U.S. 546, 561-62 (1973) (internal citations omitted).

[2] One should not infer from the phrase "visible expression" that the Court intended to exclude sound recordings from the ambit of "Writings." *Burrow-Giles* involved photography, an unquestionably "visible" medium. It is doubtful that the Court considered sound recordings at all, as the Edison phonograph had been patented only six years earlier.

The copies regulated by § 2319A, as the physical embodiments of creative effort, meet the well-established standard for Writings. In fact, the statute itself recognizes the written nature of the works it regulates. Sections (a)(1) and (a)(3) penalize one who "reproduces" or "distributes … , sells … , or traffics in any copy or phonorecord ***fixed*** as described in paragraph (1), regardless of whether the ***fixations*** occurred in the United States." § 2319A(a) (emphasis added).[3]

Not only do provisions (a)(1) and (a)(3) regulate Writings, they do so by granting exclusive rights. The Copyright Act confers to copyright holders "exclusive rights to do and to authorize" the reproduction, distribution, and public performance of their works. 17 U.S.C. § 106. Under the copyright grant, only the copyright holder is permitted to engage in these activities or to authorize others to do so. By creating criminal liability for one who reproduces, distributes, or sells copies or phonorecords "without the consent

[3] While the fixation requirement of the Copyright Act—the current statutory instantiation of the demand for Writings found in the Copyright Clause—appears to require physical embodiment "by or under the authority of the author," the Constitution imposes no such limitation. 17 U.S.C. § 101. The Copyright Clause demands only a "physical object that can be made to reproduce." *Capital Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 664 (2d. Cir. 1955) (Hand, J. dissenting in part, concurring in part). Nevertheless, the government argues that two identical digital recordings should receive disparate treatment—not only under the Copyright Act but under the Constitution as well –if one of the recordings was unauthorized. This argument—that an unauthorized recording is not only denied copyright protection, but is so unlike its authorized counterpart that it is governed under a separate grant of power free from Copyright Clause limitations—has no basis in law or reason.

of the performer," § 2319A provides precisely the protection granted by the Copyright Act. But the statute diverges from the Copyright Act in one critically important respect: it grants these exclusive rights in Writings in perpetuity, in direct conflict with the Copyright Clause and the intent of its drafters.

It is well-established that this Limited Times requirement is a cornerstone of our copyright system. Every proposal put forward at the Constitutional Convention limited the period of copyright protection. Karl Fenning, *The Origin of the Copyright Clause of the Constitution*, 17 Geo. L.J. 109 (1928) 109-13.[4] According to one scholar "[r]eading the [Copyright Clause] power, then, in light of the [S]tatute of Anne and the then recent decisions of the English courts, it is clear that this power of Congress was enumerated in the Constitution for the purpose of expressing its limitations." William W. Crosskey, 1 *Politics and the Constitution in the History of the United States* 477-86, 486 (1953).

The Supreme Court has repeatedly recognized that the Copyright Clause requires Congress to limit the term of exclusive rights. *See, e.g., Goldstein*, 412 U.S. at 560 ("Art. I, § 8, cl. 8 . . . provides that copyrights

[4] Indeed, Thomas Jefferson was so skeptical of the value of even a limited monopoly that he suggested it might be better to have none at all. *See* The Papers of Thomas Jefferson 442-43 (Julian P. Boyd ed., 1956.

may only be granted 'for limited Times.'"). In *Eldred v. Ashcroft*, the Supreme Court reaffirmed the importance of "Limited Times," referring to it as a "restriction," "limitation," and "constraint" on congressional power. *Eldred v. Ashcroft*, 537 U.S. 187, 196, 198, 208 (2003).[5]

Exclusive rights of limited duration promote progress by guaranteeing that copyrights will eventually expire and that the public will ultimately receive the right to unfettered use of copyrighted works. "The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors." *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932). As the Court in *Harper & Row* explained, copyright "is intended to … allow the public access to the products of [authors'] genius after the limited period of exclusive control has expired." *Harper & Row Publishers, Inc. v. Nation Enterprises,* 471 U.S. 539, 546 (1985). These constraints play a central role in achieving the underlying purpose of the Copyright Clause, and given the corrosive effect on the public's access to knowledge that would result from perpetual grants of exclusive rights authorized under another authority, it is clear that "Limited Times" imposes a constraint on congressional authority.

[5] In *United States v. Moghadam*, the Eleventh Circuit noted on three different occasions that had the issue of "Limited Times" been properly before it, it likely would have held that this limitation constrained congressional action under the Commerce Clause. 175 F.3d 1269*,* 1274 n.9, 1281 n.15, 1282 n.17 (11th Cir. 1999).

The Constitution "clearly precludes Congress from granting unlimited protection for copyrighted works." *Eldred*, 537 U.S. at 210 n.16 (internal citations omitted); *accord Dastar v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (Congress may not "create a species of perpetual . . . copyright."). Sections 2319A(a)(1) and (a)(3) are therefore not a valid exercise of congressional power, and the decision below must be affirmed.[6]

II. Congress May Not Grant Exclusive Rights To Works Of Original Creative Expression—Whether Fixed Or Ephemeral— In A Manner Inconsistent With The Constraints Imposed By The Copyright Clause.

The Government argues that because § 2319A governs unfixed works, it falls outside the scope of the Copyright Clause, and in any event can be authorized by the Commerce Clause. However, the longstanding constitutional principle that Congress may not do indirectly what it is forbidden to do directly, applied by the district court, prohibits Congress from protecting unfixed original creative works that are not Writings. The "powers of the legislature are defined and limited; and that those limits may not be mistaken, or forgotten, the constitution is written... [A]n act of the

[6] Affirming the decision below would not preclude Congress from fulfilling its obligations under the TRIPs agreement with respect to these works. TRIPs requires that performers and producers of phonograms receive protection for 50 years after performance or fixation. Art. 14 § 5. Congress could satisfy these obligations by including the suggested term limit or by granting the performer a copyright in any unauthorized recordings, just as it does now for authorized recordings. 17 U.S.C. § 102.

legislature, repugnant to the constitution, is void." *Marbury v. Madison*, 5 U.S. 137, 176-77 (1803). This principle would apply even if Congress had tried to use its Commerce Clause powers to regulate original, expressive works in an effort to evade the express limitations imposed on it by the Copyright Clause.[7]

A. The Copyright Clause Limits Congressional Authority To Regulate Original Creative Expression.

The Framers of our Constitution crafted a legislative branch of limited and enumerated powers, and the Copyright Clause was no exception. James Madison described the limitations in the Copyright Clause as "a [deliberate] fetter on the National legislature." 13 *Papers of James Madison* 128 (C. Hobson & R. Rutland, eds. 1981). To allow Congress to avoid the limitations imposed by the Copyright Clause, which both establishes and constrains congressional power to grant monopolies on original, expressive works, would frustrate the founder's efforts and violate a core constitutional principle.

In granting Congress the power to create copyrights, the Framers recognized that ideas were powerful yet ephemeral assets, demanding rights

[7] As *amici* discuss infra at Section II.B.2, Congress clearly intended § 2319A to be part of the copyright regime; the government's Commerce Clause argument is merely a litigation afterthought.

narrowly tailored under the Constitution to promote the arts and sciences. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 5-6 (1966) (describing the Copyright Clause as "both a grant of power and a limitation," and stating that Congress "may not overreach the restraints imposed by the stated constitutional purpose."). Thus the Constitution requires that copyright extend only to original works, *Feist Publ'ns v. Rural Tel. Ser. Co.*, 499 U.S. 340 (1991), promote the progress of the arts and sciences, *United States v. Paramount Pictures*, 334 U.S. 131, 158 (1948), persist only for limited times, *Eldred*, 537 U.S. at 210 n.16 (2003), and extend only to "Writings," *Burrow-Giles*, 111 U.S. at 58 (1884). Further, courts have long held that the copyright grant must permit certain "fair uses" of protected works, *Harper & Row,* 471 U.S. at 549, and protect expressions rather than ideas, *Baker v. Selden*, 101 U.S. 99 (1880).

The Supreme Court has consistently struck down legislation ostensibly taken under one constitutional authority due to constraints found in another constitutional grant. In *Railway Executives' Ass'n, Inc. v. Gibbons*, 455 U.S. 457 (1982), the Supreme Court struck down a non-uniform bankruptcy law that Congress had enacted to protect the employees of a single railroad company, stating that

> the Bankruptcy Clause itself contains an

> affirmative limitation or restriction upon Congress' power [that] is not required by the Commerce Clause. Thus, if we were to hold that Congress had the power to enact nonuniform bankruptcy laws pursuant to the Commerce Clause, we would eradicate from the Constitution a limitation on the power of Congress to enact bankruptcy laws.

455 U.S. at 468-69; *see also* Paul J. Heald and Suzanna Sherry, *Implied Limits On The Legislative Power: The Intellectual Property Clause As An Absolute Constraint On Congress*, 2000 U. Ill. L. Rev. 1119, 1125-1128 (2000). The same is true here, where another Article I, § 8 power is at issue. If, as the government argues, Congress could enact legislation under the Commerce Clause in direct conflict with a limitation in the Copyright Clause, it would "eradicate from the Constitution a limitation on the power of Congress to enact" copyright laws.[8]

Not surprisingly, every court to consider § 2319A has followed the reasoning in *Gibbons* concluding that the Copyright Clause's express limitations have external effect. The Eleventh Circuit accepted the proposition that limits within the Copyright Clause can operate externally to constrain congressional action when it considered § 2319A in *Moghadam*, 175 F.3d at 1280. Similarly, the district court in this case and the court in

[8] The Supreme Court has also found implied limits on congressional power that prohibit inconsistent actions under the Tenth Amendment, *New York v. United States*, 505 U.S. 144, 188 (1992), the Eleventh Amendment, *Seminole Tribe v. Florida*, 517 U.S. 44 (1996), and Article III, *Plaut v. Spendthrift Farm, Inc.*, 514 U.S. 211 (1995).

KISS Catalog v. Passport Intern. Prods., Inc., 350 F. Supp. 2d 823 (C.D. Cal. 2004), concluded that the Copyright Clause prevents Congress from providing copyright-like protection under the Commerce Clause that is inconsistent with constitutional limits.[9]

The cases upon which the Government relies to support its assertion that the Commerce Clause justifies § 2319A are either easily distinguished or inapposite. In *The Trademark Cases*, the Supreme Court held that because trademarks lacked originality—the *sine qua non* of copyright—the regulation of such marks fell entirely outside of the scope of the Copyright Clause. *Trademark Cases*, 100 U.S. 82, 94 (1879). Here, however, the live performances regulated by § 2319A unquestionably contain the requisite originality.

The other cases cited by the Government stand only for the uncontroversial proposition that what cannot be done under one constitutional provision may very well be accomplished under another, so

[9] Similarly, in 1998 the President's Office of Legal Counsel opined that legislation granting copyright-like protections to unoriginal data "falls outside the permissible scope of the power conferred by that clause" and "gives rise to concerns that, as an exercise of the Commerce Power, it would impermissibly infringe on an implicit limitation contained in the [Copyright Clause]." William Michael Treanor, Office of Legal Counsel, Memorandum, Constitutional Concerns Raised by the Collections of Information Antipiracy Act H.R. 2652, July 28, 1998. Like the proposed database legislation, § 2319A's grant of exclusive rights in unwritten performances invades the "constitutionally prescribed public domain … on which Congress may not infringe." *Id*.

long as no limitation on congressional authority is violated. In *Heart of Atlanta Motel, Inc. v. United States*, 379 U.S. 241 (1964), the Supreme Court held that the Civil Rights Act of 1964 could not be justified under the Fourteenth Amendment, but unlike the Copyright Clause, the Fourteenth Amendment contains no limitations precluding such legislation under another independent authority. In *Author's League of America, Inc. v. Oman*, 790 F.2d 220, 224 (2d Cir. 1986), this Court remarked that the manufacturing provision of the Copyright Act, 17 U.S.C. § 601(a)(1985), limiting the importation of physical goods, was authorized by the Commerce Clause. Importantly, that provision, unlike the ones at issue here, in no way affected the scope of copyright protection over original, expressive works.

Where legislation is not fundamentally inconsistent with an express constitutional limitation on congressional authority, the Commerce Clause may authorize it. But where, as here, legislation would violate a prohibition contained in the Copyright Clause, that limitation must be respected even if the legislation could otherwise have been enacted under the Commerce Clause.[10]

[10] The Government also contends § 2319A can be justified under the Treaty Power. However, "no agreement with a foreign nation can confer power on the Congress, or on any other branch of Government, which is free from the restraints of the Constitution." *Reid v. Covert*, 354 U.S. 1, 16 (1957). Moreover, the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS"), which spawned § 2319A, was a

B. The Writings Requirement Of The Copyright Clause Forbids Congress From Extending Copyright Protection To Ephemeral Works Such As Live Performances.

Just as the Copyright Clause prohibits Congress from granting perpetual exclusive rights in Writings (as *amici* argue in Section I supra), the Copyright Clause also forbids the legislature from conferring exclusive rights, under any authority, to intangible works of original expression. Indeed, "[t]he most significant constitutional limitation in the Copyright Clause is contained in the word 'writings.'" 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright*, § 1.08.

The relationship between the ephemeral live performances governed by § 2319A and the Writing requirement of the Copyright Clause is the subject of disagreement. Federal courts have consistently held that Writings include only those expressions embodied in physical form,[11] but some

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Congressional-Executive agreement rather than a treaty. Such agreements do not find their constitutional support in the Treaty Power and are subject to relaxed approval standards. Indeed, scholars disagree as to their very constitutionality. *Compare* Laurence H. Tribe, *Taking Text and Structure Seriously: Reflections on Free-Form Method in Constitutional Interpretation*, 108 Harv. L. Rev. 1221 (1995) (questioning constitutionality of Congressional-Executive agreements) *with* John C. Yoo, *Laws as Treaties?: The Constitutionality of Congressional-Executive Agreements*, 99 Mich. L. Rev. 757, 820 (2001) (providing constitutional justification for Congressional-Executive agreements distinct from Treaty Power).

[11] *See* Nimmer on Copyright, § 1.08 ("If the word 'writings' is to be given any meaning whatsoever, it must, at the very least, denote 'some material form, capable of identification and having a more or less permanent endurance.'") (internal citation omitted).

commentators, including one leading treatise author, contend that the constitutional understanding of Writings accommodates these performances. *See* Goldstein, Copyright § 15.6.1 (2nd ed. Supp. 2001) ("[P]erformances subject to [federal anti-bootlegging] protection are 'writings' in the constitutional sense . . . ."). Under this interpretation of Writings, live performances fall squarely within the Copyright Clause, and as *amici* argue in Section I supra, § 2319A would therefore be impermissible.

Conversely, the Government argues that live performances fail to qualify as Writings. These performances, it maintains, fall outside the scope of the Copyright Clause and therefore Congress may disregard its inherent limits. Such a reading stymies both the purpose of the Copyright Clause and the intent of its Framers by allowing the government to establish pre-copyright exclusive rights that frustrate the limitations on monopoly grants required by the Constitution.

Amici suggest a third alternative, one consistent with the intent of the Framers and in harmony with settled precedent. Although live performances do not constitute Writings because they lack even a transient tangible embodiment, these original expressive works still fall within the exclusive domain of the Copyright Clause. Because both the works protected and the rights granted by § 2319A serve the core function of the Copyright Clause,

the statute regulates inside the clause's protective ambit and must comply with its constitutional limits.[12]

The Copyright Clause establishes the sole authority under which Congress may grant exclusive rights to creators in their original expressive works. The live performances at issue here are clearly original expressive works. Under the Copyright Clause, however, Congress is permitted to grant rights only in Writings, leaving the regulation of unwritten expression prohibited by the Copyright Clause and simultaneously beyond the reach of other enumerated powers. The Writings requirement establishes the confines of protected works "in the same way as the edges on personal property or physical boundaries around realty do . . . simultaneously [working] to identify the staked claim over which others must respect the owner's entitlements and to identify the intellectual material open to use by all." Wendy J. Gordon, *An Inquiry into the Merits of Copyright: The Challenges of Consistency, Consent, and Encouragement Theory*, 41 Stan. L. Rev. 1343, 1380-81 (1989). The Writings requirement fosters the distribution of knowledge to the public and is essential to the overarching purpose of the Copyright Clause.

[12] The Copyright Clause directly constrains Congress. The extent to which states may regulate unfixed works is not currently before this court.

1. Live Performances are Original Works Of Expression Within The Province Of The Copyright Clause, But Because These Performances Are Not Writings Congress May Not Extend Them Protection.

Ephemeral live performances, like recordings of them, amply demonstrate the central characteristic of works protectible under the authority of the Copyright Clause—originality.[13] Because live performances are original and expressive, their regulation implicates the inherent limitations of the Copyright Clause. Because those works fail to qualify as Writings, however, the Copyright Clause demands that they be denied protection.

Originality has been described as the "*sine qua non*" of copyright protection, *Feist*, 499 U.S. at 345*,* and the "premise of copyright law," *Miller v. Universal City Studios, Inc.,* 650 F. 2d 1365, 1368 (5th Cir. 1981). As a constitutional matter, originality is "the core question of copyrightability." *Eldred*, 537 U.S. at 211. Given the purpose of copyright,

[13] Originality also acts as both a grant and a limit, empowering Congress to protect original works and, consistent with its intrinsic First Amendment safeguards, prohibiting Congress from granting monopolies in other sorts of information. Yochai Benkler, *Constitutional Bounds of Database Protection; The Role of Judicial Review in the Creation and Definition of Private Rights in Information,* 15 Berkeley Tech. L.J. 535 (2000). The First Amendment sets additional limits on Congress's ability to grant exclusive rights in non-original works. These two constitutional constraints limit Congress from constricting the growth of the public domain and burdening speech, for example, by creating exclusive rights in factual information about the world around us. *Id.*

the central role of originality is fitting. "Copyright supplies the economic incentive to create and disseminate ideas." *Harper & Row*, 471 U.S. at 558. By granting rights in original works, copyright best serves its constitutional function as the "engine of free expression." *Id.*

The live performances regulated by § 2319A exhibit both originality and expression. Live performances, as independent creations, exhibit the originality requisite for copyright protection. *Feist,* 499 U.S. at 345*; Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951). Likewise, each performance is itself a distinct expression. Indeed, live performance is so central to copyright that when fixed in a tangible medium, live performances enjoy copyright protection, 17 U.S.C. § 102, and the Copyright Act grants copyright holders in fixed works, such as musical compositions, the exclusive right to perform them publicly. 17 U.S.C. § 106(4).

However, the ephemeral live performances in which § 2319A(a)(1) grants exclusive rights fail to satisfy the demand for Writings found in the Copyright Clause, and thus may not be protected despite their originality. While courts acknowledge the necessity of interpreting "Writings" in recognition of developing technologies, *Burrow-Giles*, 111 U.S. at 58, they have never included ephemeral works embodied in no physical form among

the class of Writings. *See Goldstein*, 412 U.S. at 561-2 (holding "[t]he word 'writings' … may be interpreted to include any physical rendering of the fruits of creative intellectual … labor."). Tellingly, in 1954 Congress deemed it "impossible to subscribe to the [Berne] Convention" because it required "protection of 'oral' works, such as speeches [that] would have conflicted with Article I, Section 8 of the Constitution which refers only to 'writings' as material to be protected." Senate Committee on Foreign Relations, Ex. Rept. No 5, 83rd Cong, June 11, 1954. [14] Congress understood that the Commerce Clause could not justify adherence to international agreements at odds with the Copyright Clause.

To allow for protections in unwritten works would prove antithetical to the very purpose of the limited exclusive rights permitted by the Copyright Clause. If Congress could grant exclusive rights in unwritten original expression, a significant disincentive to fix and disseminate such works might result—at the cost of widespread and enduring availability of creative works. Malla Pollack, *What Is Congress Supposed to Promote? Defining "Progress" in Article I, Section 8, Clause 8 of the U.S. Constitution, or Introducing the Progress Clause*, 80 Nebraska L. Rev. 754, 773 (2001). By

[14] Before the United States joined the Berne Convention in 1988, the Convention was revised to allow member countries to deny protection to works not fixed in a tangible medium, avoiding the constitutional conflict that prevented U.S. participation in 1954. Berne Convention, 1971 Paris Text, Art. 2(2).

ensuring that exclusive rights are granted only to works recorded in some enduring material form, the Writings requirement ensures that the public benefits through preservation and access to the work just as the author benefits from the right to reap profits from it.

Because live performances are works of original expression and quintessentially copyrightable subject matter, they fall within the exclusive domain of the Copyright Clause even though it simultaneously denies them protection.

2. The Right Of Fixation Provided By § 2319A Confers Exclusive Rights Indistinguishable From Those Provided By Copyright Law

Not only do the live performances regulated by § 2319A(a)(1) properly lie within the singular domain of the Copyright Clause, the exclusive right in fixation created by that statutory provision likewise invades the field of regulation established by the Copyright Clause and must adhere to its limitations.

In both purpose and effect, the exclusive right to fix or authorize fixation of performances serves as the functional equivalent of the Copyright Act's exclusive rights. Congress clearly intended § 2319A to "strengthen certain aspects of copyright law." 140 Cong. Rec. H 11441, 11548 (daily ed.

Nov. 29, 1994) (statement of Rep. Berman regarding the Uruguay Round Agreements Act, which gave rise to § 2319A). The Act contained "a number of changes in copyright" that Congress "expected to strengthen the rights of U.S. copyright holders." 140 Cong. Rec. H 11441, 11547 (daily ed. Nov. 29, 1994) (statement of Rep. Hughes). Indeed, § 2319A did expand copyright protection. Congress's intent is further evinced by its decision to place § 2319A's civil counterpart in Title 17, *see* 17 U.S.C. § 1101, and as discussed supra at page 19, performance rights are addressed in several other parts of the Copyright Act.

The exclusive right to fix was intended to supplement the economic incentives provided by copyright for artists and copyright holders to create new works. To the extent that unauthorized recordings compete with their authorized counterparts,[15] the right to prevent the reproduction of unauthorized fixations arguably protects the market for both studio and live recordings. By granting an exclusive right to fix, however, § 2319A goes much further than copyright's bar against reproduction—it precludes the very creation of a tangible record of an ephemeral live performance. This

[15] The level of harm to the market for authorized recordings attributable to the sale of unauthorized live recordings is unclear. Lee H. Rousso, *The Criminalization of Bootlegging: Unnecessary and Unwise*, 1 Buff. Intell. Prop. L.J. 169 (2002); Allan Kozinn, *Bootlegging as a Public Service: No, This Isn't a Joke*, N.Y. Times, Oct. 8, 1997, at E3.

sort of upstream preemptive control grants performers a right in unwritten works free from constitutional constraints. While efforts to encourage the creation of original expressive works are laudable, they must operate, as a constitutional matter, through the power enumerated in the Copyright Clause.

By granting an exclusive right in paradigmatic works of original expression that serves as a substitute for the rights granted by the Copyright Act, § 2319A(a)(1) functions as copyright legislation and must conform to Copyright Clause limitations regardless of the grant of authority the Government now argues serves to justify the statute.

III. Section 2319A Is Unconstitutionally Overbroad and Therefore Invalid On Its Face

Regulations of intellectual property, whether or not grounded in the Copyright Clause, are subject to First Amendment scrutiny.[16] *Eldred*, 537 U.S. at 221; *accord Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2d Cir. 2001) (applying First Amendment scrutiny to the Digital Millenium Copyright Act). Traditional copyright legislation has been insulated from

[16] While the First Amendment issue is not discussed in the parties' appellate briefs, the issue was raised in district court. Even if it had not been, "[t]he matter of what questions may be taken up and resolved for the first time on appeal is one left primarily to the discretion of the courts of appeals, to be exercised on the facts of individual cases." *Singleton v. Wulff*, 428 U.S. 106, 121 (1976).

First Amendment scrutiny only because it includes "its own speech-protective purposes and safeguards," including the "fair use" doctrine. *Eldred*, 537 U.S. at 219-20.[17]

Though governed by the Copyright Clause,[18] § 2319A lacks these safeguards and is therefore subject to full First Amendment review and a facial challenge.[19] Section 2319A is unconstitutionally overbroad and it fails to meet the heightened First Amendment scrutiny it must bear.

A. Because § 2319A Constrains Expression Yet Lacks The Speech-Protective Limitations of Copyright Law, It Merits Heightened First Amendment Scrutiny.

"Music, as a form of expression and communication, is protected under the First Amendment." *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989). See also *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston*, 515 U.S. 557, 568 (1995). The government seeks to draw a

[17] Even the Florida "anti-bootlegging" statute, cited by the court below and in *Moghadam*, 175 F.3d at 1272 n.5, includes a fair use exemption. Fla. Stat. § 540.11(2)(a)(3) (West 2005).

[18] If § 2319A were not governed by the Copyright Clause, the case for heightened scrutiny would be stronger yet. Other intellectual property rights have been subject to more exacting First Amendment scrutiny, even when the regimes have their own internal safeguards. Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1, 7 (2001).

[19] The Defendant challenged Section 2319A facially. (Rep. to Opp'n to Def.'s Mot. to Dismiss, 18.) Defendants whose speech *can* be constitutionally regulated may facially challenge a statute on vagueness and overbreadth. *See, e.g., Broadrick v. Oklahoma*, 413 U.S. 601 (1973); *Schad v. Borough of Mt. Ephraim*, 452 U.S. 61 (1981).

distinction between First Amendment interests in disseminating the speech of others and disseminating one's own speech. However, courts have repeatedly found First Amendment interests in activity dealing with the speech of others. *See, e.g. Satellite Broad. v. FCC*, 275 F.3d 337, 353 (2001) (deciding which channels a cable or satellite system will carry); *Lamont v. Postmaster General*, 381 U.S. 301 (1965) (receiving Communist literature).

When a speaker copies the speech of another, that speech has independent value to both the speaker and those who would otherwise not hear it. It is this independent value that gives rise to First Amendment interests in both speakers and listeners of the copied speech. *See* Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred, 44 Liquormart, Saderup, and Bartnicki*, 40 Hous. L. Rev. 697 (2003) (noting that such non-original speech as flag burning and wearing black armbands has been protected).

Assuming arguendo that this regulation warrants only intermediate scrutiny,[20] it must further an important or substantial governmental interest unrelated to the suppression of free expression in order to be constitutional. *Turner Broadcasting System, Inc. v. Federal Communications Comm'n*, 512

[20] Some commentators consider copyright law to be a content-based restriction that requires strict scrutiny. Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 186 (1998).

U.S. 662, 643 (1994). Moreover, incidental restriction on speech must be no greater than essential to the furtherance of that interest. *Id.*

Section 2319A fails this test in two ways. First, it is unclear whether there is a "substantial governmental interest" in regulating ephemeral creative works. The Government's primary asserted interest is "ensuring that artists retain economic control over their own live musical performances,"[21] Opp'n to Def.'s Mot. to Dismiss, 21, but it is unclear whether unauthorized recordings harm the market for authorized recordings,[22] and even if they do, the Copyright Act still provides protections for performances fixed in a tangible medium.[23] On the other hand, the government clearly has both an interest and an obligation under the Copyright Clause to promote progress in the sciences and useful arts which is at the very least in tension with the granting of exclusive rights in unfixed works. *See* supra at Section II.B.

Second, §2319A unquestionably goes beyond what is necessary to further the government's stated interests. If the Copyright Clause, with its

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[21] The Government also cites the need to fulfill treaty obligations, *id.*, but compliance with international agreements can only be a *legitimate* government interest if the agreements do not violate constitutional guarantees. Moreover, as discussed supra at Section II.A. note 10, the agreement on which §2319A is based is *not* a treaty. Finally, the Government argues that § 2319A protects the artist's freedom to not speak. *Id.* This makes little sense, since only some unauthorized fixation is covered by § 2319A and the performances themselves are often public.

[22] *See* supra at note 15.

[23] *See* supra at page 19.

durational limitation and fair use exception, sufficiently protects authors' interests so as to spur ongoing production of creative works, then a similarly-limited §2319A should also suffice. *See Eldred*, 537 U.S. at 218.

B. The Statute Is Substantially Overbroad Because It Does Not Explicitly Exempt Fair Use And It Provides Perpetual Protection

Even if this Court finds that § 2319A narrowly advances important governmental interests unrelated to the suppression of free speech, the statute includes within its sweep of prohibitions "real" and "substantial" exercises of protected speech. *See Broadrick v. Oklahoma*, 413 U.S. 601 (1973). As a result, "the statute's very existence may cause others not before the court to refrain from constitutionally protected speech." *Id.* at 612.

First, this statute criminalizes behavior that the government has no authority to prohibit. For example, under § 2319A it would be nearly impossible for a television station to cover a protest march or other assembly because it would require "authorization" from every "performer" who could be heard singing during the event. If the station did not obtain such permission, its "willing commercial distribution" could subject all involved to the possibility of five years in federal prison. Likewise, any otherwise public event could be effectively hidden from press coverage through the use

of no more than a string quartet, and any politician could veto embarrassing news coverage that included a musical performance involving that politician.[24]

Finally, the statute is substantially overbroad because it contains no durational limit. The limited term of traditional copyright is seen by prominent scholars as an essential part of the internal protections which help to insulate copyright from full First Amendment scrutiny. *See* Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983, 1011 (1970); Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?,* 17 UCLA L. REV. 1180, 1193-200 (1970).

C. The Statute Is Unconstitutionally Vague Because It Fails to Define Core Terms and Is In Conflict with Significant First Amendment Rulings.

Section 2319A is unconstitutionally vague on its face in addition to being overly broad. In general, a regulation will be declared unconstitutionally vague when a person of "common intelligence" may read

[24] Musical performances involving politicians have had a significant effect on American politics. In 1945, Harry Truman landed in hot water after playing a piano on which Lauren Bacall struck a suggestive pose. David McCullough, *Truman*, 336-37 (1992). And Marilyn Monroe's famous rendition of "Happy Birthday" before John F. Kennedy in 1962 has become an iconic moment in American popular culture. Stephen McFarland, *All Beads and Skin: Marilyn Serenades JFK and JFK Listens Politely 1962*, N.Y. Daily News, Mar. 11, 2004, at 37.

it as proscribing speech protected by the First Amendment. *Cramp v. Bd. of Public Instruction*, 368 U.S. 278, 287 (1961).

As the Government said, "[t]he defense contends that Section 2319A lacks...the fair use defense. However, it is far from clear that this is so." (Opp'n to Def.'s Mot. to Dismiss, 20.) *Amici* submit that this is precisely the problem—it is unclear whether or not there is a fair use exception to the statute. *See City of Chicago v. Morales*, 527 U.S. 41 (1999) (striking down ordinance because the term 'loitering' was too vague).[25]

The Government notes that early copyright statutes had a common law fair use exemption, and posits that a similar doctrine may develop here. (Opp'n to Def.'s Mot. to Dismiss, 20.) This may be the case, and *amici* would welcome such judicial narrowing. In its absence, however, people of "common intelligence" simply cannot know whether there is an exception to § 2319A similar to that in other areas of intellectual property law. This ambiguity chills protected speech.

D. Because § 2319A Is Overbroad And Vague, It Should Be Struck Down Or Narrowly Construed

Federal statutes that are found to be overbroad or vague on their face may be totally invalidated, in which case they cannot be applied even against

[25] The statute's vagueness is exacerbated by the fact that core terms such as "authorization" are undefined.

those engaged in proscribable conduct. *Broadrick*, 413 U.S. at 613; *Schad v. Borough of Mt. Ephraim*, 452 U.S. 61 (1981) (striking down an overbroad prohibition on all live entertainment, even though the case concerned proscribable nude dancing).

Amici acknowledge that the overbreadth doctrine is "strong medicine," *Broadrick*, 413 U.S. at 611, and note that the Court has sometimes avoided total invalidation of an overbroad statute by adopting a narrowing interpretation. *See Osborne v. Ohio*, 495 U.S. 103, 119 (1990) (refusing to strike down a state law that has was narrowed by the state supreme court); *Hamling v. United States*, 418 U.S. 87, 112 (1974) (narrowing federal statute to prohibit only the mailing of obscene materials).

Here, this Court could limit § 2319A by finding a fair use exception similar to 17 U.S.C. § 107 and imposing the type of external First Amendment balance that was seen in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 574 (1997). However, such narrowing may be more difficult with regard to the duration of the rights, *see KISS Catalog*, 350 F. Supp. 2d at 833 (calling the introduction of terms limits "much closer to legislating an amendment to the United States Code than [the court was] willing to venture"), and more fundamentally, "it is generally for Congress,

not the courts, to decide how best to pursue the Copyright Clause's objectives," *Eldred*, 537 U.S. at 212.

Conclusion

For the reasons set forth above, *amici* respectfully submit that the decision of the district court should be affirmed.

Respectfully Submitted,

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Deirdre K. Mulligan
Director, Samuelson Law,
Technology & Public Policy Clinic
Acting Clinical Professor of Law
University of California
School of Law (Boalt Hall)
346 Boalt Hall
Berkeley, CA 94720-7200
(510)642-0499
Attorney for Amici Curiae *Thirty-One Intellectual Property and Constitutional Law Professors*

May 12, 2005

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Jack I. Lerner
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I, Debra Krauss, declare: I am a citizen of the United States and am employed in the County of Alameda, State of California. I am over the age of 18 years and am not a party to the within action. My business address is University of California at Berkeley School of Law (Boalt Hall), 344 Boalt Hall, Berkeley, CA 94720-7200. I am personally familiar with the business practice of the Samuelson Law, Technology & Public Policy Clinic. On May 12, 2005, I served the following document(s):

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