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Extending Copyright and the Constitution: "Have I Stayed Too Long"

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EXTENDING COPYRIGHT AND THE CONSTITUTION:

"HAVE I STAYED TOO LONG?"¹

Michael H. Davis*

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* Professor of Law, Cleveland State University College of Law; co-author (with Miller), *INTELLECTUAL PROPERTY* (3rd ed. West 2000). This article could not have been completed without the professionalism of Kevin Byrne.

1. Sonny & Cher, *Have I Stayed Too Long*, on *THE BEAT GOES ON: THE BEST OF SONNY & CHER* (ATCO 1975). I have incorporated into the various headings a number of Sonny Bono or Sonny & Cher songs because of the irony that copyright term extension was accomplished in the name of Congressman Sonny Bono, in a somewhat kitsch homage to the career he shared with his first wife, Cher, as the songwriting half of Sonny and Cher. Although he claimed a kind of credit for his talents in *SONNY & CHER, Mama Was a Rock and Roll Singer But Papa Wrote All Her Songs*, on *GREATEST HITS* (UNI/MCA 1974), the remarkable truth, in light of what is now his permanent presence in copyright history, is that his major talent was to borrow the talents of others. A well-known industry story recounts how after he and Cher heard the Byrds performing covers of Dylan songs in L.A., they rushed Cher's cover of Dylan's *ALL I REALLY WANT TO DO* into the record stores, "before the Byrds' own was in stores, beating the folk-rock group at its own game of popularizing Dylan songs." Ward Lamb, *SONNY AND CHER, THE 60'S RECORDINGS*, Sundazed CD Liner Notes (1999). He possessed an almost uncanny ability to identify the new wave of the moment and ride it to the next swell, from his first days as the folk-rock imitator of Bob Dylan through his borrowings from the Beatles (Sonny & Cher's psychedelic 1967 *INNER VIEWS* album, in its first track, *I Just Sit There*, lifted the style and even a complete phrase from the Beatles *A DAY IN THE LIFE*) until his later days in the early 70s spent out-Wayne-Newtoning Wayne Newton as a Las Vegas entertainer. The paradox, of course, is that modern copyright law makes "borrowing" far more difficult and the Bono Law has extended that difficulty by an additional, and surely unnecessary, twenty years.

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I. INTRODUCTION: "HELLO"²

On October 27, 1998, President Clinton signed into law the Sonny Bono Copyright Term Extension Act of 1998, Pub. L. No. 105-298, 112 Stat. 2827 (hereinafter the "Bono Law"). The Bono Law extended the term of copyright protection by an additional twenty years, both prospectively and retrospectively. The former is probably constitutionally proper;³ the latter is almost certainly forbidden by the Constitution's copyright clause.⁴ But most criticism⁵ has not forcefully distinguished between retrospective

2. SONNY & CHER, *Hello, on THE BEAT GOES ON: THE BEST OF SONNY & CHER* (ATCO 1975).

3. The focus of this article is retrospective term extension. Therefore, the constitutionality of prospective extensions is not deeply analyzed, although it becomes relevant in deciding whether there can be any judicial control of copyright terms. *See infra* Part V. However, the question of how long is too long seems redolent of the kind of problems classically reserved for legislatures. Although the Supreme Court has not directly addressed this question, it has implied that it is the kind that legislatures, not courts, should answer. "These arguments are better addressed by Congress than the courts . . . This evolution of the duration of copyright protection tellingly illustrates the difficulties Congress faces in attempting to 'secur[e] for limited Times to Authors . . . the exclusive Right to their respective Writings.' . . . [I]t is not our role to alter the delicate balance Congress has labored to achieve." *Stewart v. Abend*, 495 U.S. 207, 229-30 (1990) (quoting U.S. CONST. art. I, § 8, cl. 8). On the other hand, perhaps I am too insouciant. The Framers would no doubt be shocked at the present copyright terms. Justice Story thought the Patent and Copyright Clause was beneficial because it would "promote the progress of science and the useful arts, and admit the people at large, after a *short interval*, to the full possession and enjoyment of all writings and inventions without restraint." JOSEPH STORY, COMMENTARIES ON THE CONSTITUTION OF THE UNITED STATES § 502, at 402 (R. Rotunda & J. Nowak eds., 1987) (emphasis added). Lifetime plus seventy years is surely not a "short interval" by anyone's judgment.

4. "Congress shall have Power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8.

5. The body of criticism is quite large but a representative sample as well as perhaps the bulk of the arguments, can be found in the legislative history of the Bono Law. *See Pre-1978*

as opposed to prospective extension and so far has failed to convince either Congress or the courts of any constitutional infirmity.⁶ This is because most critics agree—or at least do not seriously contest the notion—either that prospective extension is probably constitutional,⁷ though there is not absolute unanimity on this point,⁸ or that it is subject to a standard that is virtually nonjusticiable.⁹ Failing to distinguish (or, surprisingly often,

Distribution of Recordings Containing Musical Compositions, Copyright Term Extension, and Copyright Per Program Licenses: Hearings before the Subcomm. on Courts and Intellectual Property of The House Judiciary Comm., 105th Cong. (1997); *Pre-1978 Distribution of Recordings Containing Musical Compositions; Copyright Term Extension; and Copyright Per Program Licenses: Hearing Before the Subcomm. on Courts and Intell. Prop. of the Comm. on the Judiciary*, 105th Cong. (1997); *Copyright Term, Film Labeling, and Film Preservation Legislation: Hearing on H.R. 989, H.R. 1248 and H.R. 1734. Before the Subcomm. on Courts and Intell. Prop. of the Comm. on the Judiciary*, 104th Cong. (1995); *The Copyright Term Extension Act of 1995: Hearing on S. 483 before the Subcomm. on the Judiciary*, 104th Cong. (1995); *Copyright Term, Film Labeling, and Film Preservation Legislation: Hearings on H.R. 989, H.R. 1248 and H.R. 1734. Before the Subcomm. on Courts and Intell. Prop. of the Comm. on the Judiciary*, 104th Cong. (1995); *The Copyright Term Extension Act of 1995: HEARING ON S. 483 BEFORE THE COMM. ON THE JUDICIARY*, 104th Cong. [hereinafter *1995 Hearing*], U.S.G.P.O. (1997); see also ROBERT L. BARD & LEWIS KURLANTZICK, *COPYRIGHT DURATION: DURATION, TERM EXTENSION, THE EUROPEAN UNION, AND THE MAKING OF COPYRIGHT POLICY* (Austin & Winfield, Bethesda, MD (1998)); Jon M. Garon, *Media and Monopoly in the Information Age: Slowing the Convergence at the Marketplace of Ideas*, 17 CARDOZO ARTS & ENT. L.J. 491 (1999); Christina N. Gifford, *The Sonny Bono Copyright Term Extension Act*, 30 U. MEM. L. REV. 363 (2000); Peter A. Jaszi, *Goodbye to All That—A Reluctant (and Perhaps Premature) Adieu to a Constitutionally-Grounded Discourse of Public Interest in Copyright Law*, 29 VAND. J. TRANSNAT'L L. 595 (1996); D. Karjala et al., *Comment of US Copyright Law Professors on the Copyright Office Term of Protection Study*, reprinted in 14 EUR. INTELL. PROP. REV. 531 (1994); Robert Patrick Merges & Glenn Harlan Reynolds, *The Proper Scope of the Copyright and Patent Power*, 37 HARV. J. ON LEGIS. 45 (2000); William F. Patry, *Copyright and the Legislative Process: A Personal Perspective*, 14 CARDOZO ARTS & ENT. L.J. 139 (1996) [hereinafter *A Personal Perspective*]; William F. Patry, *The Failure of the American Copyright System: Protecting the Idle Rich*, 72 NOTRE DAME L. REV. 907 (1997) [hereinafter *Protecting the Idle Rich*]; Stewart E. Sterk, *Rhetoric and Reality in Copyright Law*, 94 MICH. L. REV. 1197 (1996); Tung Yin, *Reviving Fallen Copyrights: A Constitutional Analysis of Section 514 of the Uruguay Round Agreements Act of 1994*, 17 LOY. L.A. ENT. L.J. 383 (1997).

6. See, e.g., *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999) (finding the extension provisions of the Bono Law Constitutional and granting judgment on the pleadings).

7. See *1995 Hearing*, *supra* note 5, at 23 (statement of Marybeth Peters).

8. See Merges & Reynolds, *supra* note 5, at 60. Merges and Reynolds make the interesting, though somewhat unconvincing, argument that any retrospective extension of copyright term is, by its nature, a violation of the "limited times" provision since it can be done multiple times with no end in sight—and therefore without limit. *Id.* "Can anyone doubt that now that Disney has the twenty-year extension on Mickey Mouse that it wanted, it will be back in 2023 asking for another" they ask. *Id.* Faith that Congress will not provide such an extension, however, is the very source of the deference that the Supreme Court requires with respect to these and other legislative judgments.

9. "Nonjusticiable" is not meant to refer to the doctrine of constitutional law incorporating issues like political questions which are considered nonreviewably delegated to a coordinate branch. Rather, it refers to issues which, by their nature, are not susceptible to judicial resolution because the terms of measurement are peculiarly not legal. The requirement that patents and

confusing) the radically different limitations which apply to the two kinds of extension, they effectively cede the entire issue to proponents of extension. This has allowed proponents to argue that extension in general (mistakenly combining both forms of extension into one argument) is constitutionally unassailable. Proponents also deploy a second argument, surprisingly bereft of any identifiable textual basis, contending that any copyright legislation which yields a "public benefit" is constitutional, thereby immunizing any conceivable legislation that might otherwise be constitutionally vulnerable. In a seemingly counterproductive tactic, some opponents of term extension have also embraced this theory, claiming that retrospective extension produces no public benefit or good, at the same time however implicitly supporting what is surely an ineffective argument. Most importantly and a pivotal point of this article, opponents of extension have failed to understand that although retrospective extension seems less important, its constitutional invalidity contains the strategic means to block prospective extension as well.

Besides the strategic mistake of confusing retrospective and prospective extensions, there are two decisively pivotal legal issues, and one overarching jurisprudential one, that have escaped careful analysis. The first is that two different constitutional phrases effectively govern retrospective and prospective extensions:¹⁰ the "limited times" phrase of the constitutional patent and copyright phrase effectively governs only prospective, not retrospective, extension while the "promotion-of-progress" phrase is the one that effectively governs retrospective extension.¹¹ The second is that the notion of "public good" or "public benefit" is not a source or grant of legislative power but is, instead, a limit on that power. The failure to observe these nuances is at least one, and perhaps the major, reason why opposition to copyright term extension has so far failed.

copyrights expire after a "limited time" seems to be that kind of term. See *Stewart v. Abend*, 495 U.S. 207 (1990); *supra* note 3 and accompanying text. What is more or less limited and what is not appropriately limited, short of perpetuity, seems to call for a judgment which is not one of law but one of policy. See *infra*, note 39 and accompanying text.

10. I do not mean to imply that either of these two phrases is limited, as a matter of theory or law, to only one facet of copyright term extension. Obviously, neither prospective nor retrospective extensions can violate the "limited times" phrase and, likewise, neither can violate the promotion-of-progress phrase. But as a matter of practical reality, the point of constitutional infirmity of retrospective extension is located only where it meets the promotion-of-progress phrase while that of prospective extension is found only at the "limited times" phrase.

11. Professor Patry implies that the "limited times" phrase is limitative, but that the promotion-of-progress phrase might be merely declarative, though he offers no textual basis for this distinction, seeming to rely simply on the difficulty of applying it, lamenting that "no guidance is given to legislators on how to encourage learning." Patry, *Protecting the Idle Rich*, *supra* note 5, at 911. Since the "limited times" phrase is equally devoid of such guidance, however, that cannot possibly serve as a distinction.

The third and jurisprudential issue addresses more directly the problem of policing constitutional limits in those areas, like prospective copyright term extension, that seem to escape direct judicial control. It is true that the "limited times" phrase does not seem susceptible to close judicial control, but this is because the Constitution trusts Congress to legislate rationally and fairly within such constraints. The process, however, seems to have failed with the Bono Law, because massive extensions of future copyrights were enacted—with no real support for such encroachments upon the public domain and the public interest—just to gain retrospective protection of existing copyright terms. John Hart Ely has discussed an analogous problem in the larger area of judicial review generally.¹² But his solution has surprising applicability here. Ely endorses relatively limited judicial review, but advocates vigorous intervention when the very process of legislation is impaired or sullied. Perhaps it is just coincidence, or perhaps just due to some hidden genius in the constitutional scheme itself, but it turns out that just as the overall system can be kept generally honest, in Ely's eyes, by scrupulously policing failures of the democratic process, copyright legislation can be kept similarly honest. If the Court were only to invalidate retrospective extensions, it appears fairly certain that Congress could be trusted to enact copyright legislation that might either lengthen or shorten copyright terms according to the Legislature's assessment of the public interest. To put it another way, if lobbyists and interested parties understand that future copyrights are fair game but that existing copyrights cannot be extended, those parties would have far less interest—if any at all—in extending copyrights into the almost unforeseeable future. In fact, it is probable that those parties might then have an equal or greater interest in shortening the terms of future copyrights to preserve their rights of access. And this, of course, is exactly the balance that all interested parties, authors and publishers alike, as well as the public, have in a rational copyright system.¹³ Or, to put it a still different, perhaps more impartial way, if there are further extensions there will be good reason to do so, upon which most will agree.

This Article hopes to show that when the constitutional limits are properly understood, it becomes clear that retrospective copyright term extension violates the promotion-of-progress phrase, that the "public benefits" policy, being a limit rather than a grant of power, cannot justify it, and, finally, that once retrospective extension fails, prospective extension loses not only legal justification, but legislative and political

12. JOHN ELY, *DEMOCRACY AND DISTRUST* (1980).

13. As Professor Goldstein observes, "[T]he intellectual property solution to the problem of inappropriability—property right as incentives—inevitably conflicts with the social benefits of indivisibility—unrestricted public access . . . Intellectual property law . . . seeks to strike a balance between the competing demands . . ." PAUL GOLDSTEIN, *COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES* 8 (Revised 4th ed. 1999).

support as well. This Article intends to show that retrospective extension is unconstitutional and that if it is so held, there will almost certainly be no further prospective extensions. This article does not discuss why copyright term extension—both retrospective and prospective—is not good copyright policy, although the case against extension is surely overwhelming.¹⁴

Briefly, the arguments against both prospective and retrospective extension are as follows. First, an extension of twenty years—meaning ninety-five years instead of seventy-five for works for hire, and lifetime plus seventy instead of lifetime plus fifty for non-works for hire—violates the Constitutional clause that copyright must be granted only for “limited times”¹⁵ and that such extremely long terms (compared with terms of only twenty-eight years less than thirty years earlier) are effectively unlimited and therefore unconstitutional.¹⁶ Second, to extend existing copyrights retrospectively by an additional twenty years violates the functional limits of the constitutional clause because such a retrospective extension cannot possibly serve the purposes of the Copyright Clause. Some critics raised a peculiarly strange argument that copyright is only for authors, and therefore statutory changes that redound to the benefit of those to whom authors have assigned their royalties violates some kind of “author limitation.”¹⁷ An underlying theme to all of these arguments is that, aside from the Copyright Clause, there is no constitutional basis to grant copyright protection.¹⁸

14. Perhaps the best, most comprehensive, though somewhat tendentious, source for the policy arguments against extension is ROBERT L. BARD & LEWIS KURLANTZICK, *COPYRIGHT DURATION: DURATION, TERM EXTENSION, THE EUROPEAN UNION, AND THE MAKING OF COPYRIGHT POLICY* (1998). See also 1995 Hearing, *supra* note 5, at 147 (statement of Dennis Karjala).

15. See U.S. CONST. art. I, § 8, cl. 8.

16. See *Merges & Reynolds*, *supra* note 5, at 58 n.52; see also *Eldred v. Reno*, 74 F. Supp. 2d 1, 2 (D.D.C. 1999).

17. This argument is baffling, but was presented by Professor Patry on behalf of individuals, whom he claimed were being “left in the lurch” because of the large corporate entities to whom authors had assigned their interests. Patry, *supra* note 5, at 933.

This violates the Constitution, which vests power in Congress to grant copyright solely to authors and solely in order to promote the progress of science. Granting rights to distributors and the estates of deceased authors cannot fulfill the constitutional imperative and is, therefore, outside of Congress's authority. It is time for the courts to set things right.

Id. This “author’s” argument was that which seems to have lost the case for plaintiffs in *Eldred v. Reno*. Fashioned, as it was, out of a grasping self-interest (on behalf of individual authors) in parallel to that of the corporate interests who won the day in the extension battle in Congress and in the D.C. District Court, one is tempted to wish a plague on both houses were it not for the fact that as a result, individual and corporate interests aside, the public has now lost.

From a strategic and jurisprudential point of view, these arguments have been stood on their head. Until recently, the literature—of which there is an abundance—was wholly concerned with convincing Congress that a copyright extension was inadvisable. The arguments were, therefore, framed in legislative terms. Critics far more frequently explained why it was bad policy to extend copyright than why it was unconstitutional. In what is a kind of American tradition, arguments of constitutionality were reserved for a later judicial challenge. Unfortunately, the only time, so far, that general¹⁹ copyright extension has been judicially challenged²⁰ the sharp distinction between the very different principles which govern retrospective and prospective extension was not explored, and neither was the fact that the “public benefit” argument lacks constitutional basis. And some commentary, convinced of the constitutional infirmity of copyright extension, was nevertheless strangely pessimistic over the possibility that if legislation were passed it might be swiftly challenged.²¹

18. That copyright can be authorized or at least limited by other constitutional powers is an argument which is not without some, however limited, precedential support. *Authors League of Am., Inc. v. Oman*, 790 F.2d 220, 224 (2d Cir. 1986) (“In our view, denial of copyright protection to certain foreign-manufactured works is clearly justified as an exercise of the legislature’s power to regulate commerce with foreign nations.”). On the other hand, and more directly on point, in *Railway Labor Executives Ass’n v. Gibbons*, 455 U.S. 457, 471 (1982), the Supreme Court held that the constitutional limit on nonuniform bankruptcy laws prevented Congress from using the Commerce Clause to enact that which the Bankruptcy Clause implicitly forbids. In fact, all commentators seem to agree that, absent some difference in claimed rights or subject matter, true copyright cannot be granted by means other than the copyright clause.

Just as commerce power or the treaty power could not be used to create copyrights of perpetual duration without running afoul of a specific limitation rooted in that clause, legislation that does not fulfill the mandate to promote science and the useful arts also may be outside congressional competence, whatever source of authority is being invoked.

Jaszi, *supra* note 5, at 608-09.

19. From time to time Congress has specially extended copyright or patent terms of specific works; probably the most notorious of these was the attempt to extend the copyright term of SCIENCE AND HEALTH, the central text of Christian Science. In *United Christian Scientists v. Christian Sci. Bd. of Dirs.*, 829 F.2d 1152, 1161 (D.C. Cir. 1987), that extension was found unconstitutional, not as a matter of copyright law but as a violation of the First Amendment. It therefore did not address the question of general copyright term extensions.

20. *Eldred*, 74 F. Supp. 2d at 1. This case is presently on appeal to the Court of Appeals for the District of Columbia.

21. See Garon, *supra* note 5, at 600. It was suggested that his “modest alternative” involving actual repeal of the Bono Law—surely a strangely unimaginable fortuity—was preferable to “the less efficient alternative of having the extension declared unconstitutional by the Supreme Court after *Eldred v. Reno* winds its way through the courts.” *Id.*

II. CONGRESS: "THE GREATEST SHOW ON EARTH"²²

This legislation has a substantial history composed, naturally, of testimony offered by interested parties. Unsurprisingly, various authors and composers offered testimony, much of it anecdotal, that copyright term extension was proper and even essential. From their perspective, they were, for the most part, correct. They stood to gain twenty years of additional copyright protection they theretofore never expected and without the incentive of which, of course, they—or their ancestors—had still created the works from which they now anticipated a windfall. In addition to authors, many publishers—in the broad, generic, sense—testified. They, too, of course, anticipated the same twenty-year windfall profit. (In fact, as will be shown later, the prospective copyright term extension was only a stalking, or even a Trojan horse, for the retrospective extension the bill brought to these owners of pre-existing works.) There were certainly opponents of as well as proponents for extension. But there was a pattern to the testimony. The opponents marshaled arguments against both prospective and retrospective extension—though, in what appears to have been a strategic error, most of the opposition was leveled against prospective extension. Of those who supported extension, however, all of the witnesses had interests in existing copyrights that were on the verge of expiration. In other words, there were no proponents of solely prospective extension.

At the 1995 hearings²³ on the predecessor bill to the Bono Law, there were five non-governmental²⁴ witnesses. One, Professor Peter Jaszi, testified against extension. The remaining four testified in favor of extension and all had or represented interests in copyrights that were about to expire. Patrick Alger testified on behalf of "over 4,600 songwriters," all of whom had interests in existing copyrights. Jack Valenti, president and CEO of the Motion Picture Association of America, testified on behalf of the owners of almost every motion picture in America whose copyrights were soon to expire. Alan Menken, representing AmSong, an organization whose members are the "vast cross-section" of American composers and whose existing copyrights would otherwise expire testified in favor of extension. Mr. Menken submitted a statement by Mary Rodgers, the daughter of musical composer Richard Rogers, whose copyrights would also expire twenty years sooner without extension. Ms. Rogers presented a four-page list containing several hundred compositions by AmSong members, the copyrights for all of which would have expired within ten

22. SONNY & CHER, *THE GREATEST SHOW ON EARTH*, on *GREATEST HITS* (UNI/MCA 1974).

23. 1995 *Hearing*, *supra* note 5.

24. There were also four governmental witnesses: Register Peters, Patent Commissioner Bruce Lehman, and two United States Senators. *See id.*

years. What was at stake, testified Ms. Rogers, was over fifty million dollars of annual revenue.

An appendix of about seventy pages of additional submissions was added to the hearing record.²⁵ This included statements from a coalition of approximately twenty writers' and composers' groups, all of whom owned existing copyrights, from the ABA (which addressed only harmonization and thus did not discuss the policies or legalities of extension), and from publishers who owned rights to existing copyrighted works, all of whom, of course, supported extension. Several academics and groups of academics variously opposed both prospective and retrospective extension. Again, all the proponents had interests in existing copyrights and were no doubt motivated to support the legislation for that reason. There were no proponents whose only interest was in prospective extension, and no testimony which supported the notion that twenty additional years was necessary to promote the creation of new works.²⁶

Though the gist of the Congressional testimony was that protection of life-plus-fifty and seventy-five year terms should be extended to life-plus-seventy and ninety-five year terms, it seems beyond argument that, in fact, the only real interest those witnesses had was the immediate twenty year extensions they would enjoy from their products staying out of the public domain.

One witness after another, from Arnold Schoenberg's grandchildren, to those of Jerome Kern and of Richard Rogers, to Don Henley of the Eagles, testified not that they might be motivated to create more works of authorship if the term were extended from the then-lifetime plus fifty to lifetime plus seventy years.²⁷ Instead of testifying to the need to extend copyright prospectively, they presented massive inventories of existing copyrights that would imminently expire.²⁸ "Amsong has prepared a list

25. *See id.* at 120-98.

26. To be fair, there was one such claim. Mr. Alger, amid his discussion of the interests of the thousands of his organization's members, and an undoubtedly even greater number of individual compositions at stake, who supported extension of their existing copyrights, opined that twenty more years "in our opinion will serve as an even greater creative incentive." Even then, however, his support singularly rested upon existing rights and was so qualified: "In sum, so long as present rights of authors and creators are not eroded, NSAI wholeheartedly supports . . . passage . . ." *Id.* at 70 (testimony of Patrick Alger).

27. *See id.* at 55-56.

The real impetus for term extension comes from a very small group: children and grandchildren of famous composers whose works are beginning to fall into the public domain, thereby threatening trust funds . . . The estates of these famous composers frequently are music publishers as well, completing the royalty loop and eliminating any concerns about termination of transfers.

Patry, *Protecting the Idle Rich*, *supra* note 5, at 932-33.

28. *See supra* notes 23-25 and accompanying texts.

of just some of the popular songs which will fall into the public domain in the next ten years if S. 483 is not enacted.”²⁹

The sole interest of all those who testified in favor of extension at the various Congressional hearings was in preserving existing terms which were about to lapse.³⁰ In other words, it was only retrospective extension that interested Congressional witnesses and lobbyists.³¹ The reason for extension was obvious, perhaps even more so, to the lay press like the New York Times which, without any noticeable concern for the legal nuances or perhaps because it was not burdened by such concerns, presented the situation squarely, stating that the old life plus fifty or seventy-five year copyright term “seemed to satisfy artists and corporate copyright holders until the expiration date of many valuable copyrights drew near.”³² The problem, of course, is that this conundrum and unsatisfactory resolution will predictably recur at every new copyright term extension interval.

The most notoriously publicized interest group was Disney for whom the imminent expiration of several phenomenally profitable works justified the investment of huge sums.³³ But the lobbying effort was expertly crafted to present a long list of individual authors—or more accurately their heirs and descendants—who urged the extension to avoid the elimination of their income. While the array of witnesses did much to present the appearance that it was not only corporate but also individual authors

29. 1995 Hearing, *supra* note 5, at 46 (testimony of Alan Menken). Amsong Incorporated is “a not for profit association representing a vast cross section of America’s song writing community.” *Id.* at 43.

30. As Professor Patry observed while the term extension proposal was still in Congress, “But the bill really isn’t motivated by the ‘life plus seventy’ term, or even getting European royalties.” Patry, *A Personal Perspective*, *supra* note 5, at 149. “Instead, the bill is actually concerned with ‘old act works’—specifically, musical compositions published in the 1920s and 30s.” *Id.*

31. See Garon, *supra* note 5, at 599. Various sources indicate a veritable Buddhist temple of contributions made to both Republican and Democratic entities, including \$50,000 gifted by Disney to the Republican party the day before the Bono Law bill went to the President for his signature, and \$342,000 by the “entertainment industry” to both parties. See Jonathan D. Salant, *Last-minute Bills Lead to Big Campaign Contributions*, ASSOC. PRESS STATE & LOCAL WIRE, Oct. 31, 1998, AM cycle.

32. Sabra Chartrand, *Congress Has Extended Its Protection for Goofy, Gershwin and Some Moguls of the Internet*, N.Y. TIMES., Oct. 19, 1998, at C2. That the lay press understood is illustrated by headlines such as *Disney Gets Extension for Character Copyrights*, BUFFALO NEWS (AP), Oct. 17, 1998, at 12A.

33. See Garon, *supra* note 5, at 600. Garon, in a veritable *tour de force* surveying the various economic interests promoting term extension, showed not only that Disney was a driving force because of its imminently expiring copyrights, but that Disney had actually conditioned its investment in the A.A. Milne Winnie The Pooh character on obtaining term extension. See *id.* Though Garon did not say so, this was very much like, in fact identical to, how a homebuyer conditions purchase upon obtaining a private mortgage. The difference between a private mortgage and a copyright monopoly, and between that of a private bank and Congress, however, are (hopefully) too obvious to require discussion.

whose interests were at stake, what it did not present was any imminent interest in prospective extension. All of those arguing for extension were interested, for all practical purposes, solely in retrospective extension! Indeed, it was somewhat of a *non sequitur* to argue that those interested comprised both corporate and individual entities, because the real issue was not who was interested, but for what reason. Was it, that is, constitutionally cognizable or not. And by demonstrating, if only by inadvertence, that the interest was solely in retrospective extension, the witness list itself tended to answer whether or not extension truly satisfied the constitutional demand that copyright constitute a reward rather than a windfall.³⁴

That is not to say that Congress only heard from proponents of extension. But what is telling is that Congress heard, for the most part, from only two groups: those who supported extension because it would serve their immediate interests by forestalling otherwise imminent termination of copyright and those who opposed it for a variety of reasons—including the argument that extending copyright, both retrospectively and prospectively, could not act as a meaningful incentive to promote further works. But there was no identifiable group that supported extension because they would create more works, whether through prospective or retrospective extension. The only argument close to that was that works would be published—not created—in either greater numbers or greater quality,³⁵ if extension were granted. There does not

34. See *Goldstein v. California*, 412 U.S. 546, 555 (1973).

35. As only one example of such testimony promising imminent decline in the quality of our cultural heritage, consider what can only be called the “Little Orphan Annie” testimony of Jack Valenti, president and CEO of the Motion Picture Association of America who testified:

Whatever work is not owned is a work that no one protects and preserve(sic). The quality of the print is soon degraded. There is no one who will invest the funds for enhancement because there is no longer an incentive to rehabilitate and preserve something that anyone can offer for sale. A public domain work is an orphan. No one is responsible for its life. But everyone exploits its use, until that time certain when it becomes soiled and haggard, barren of its previous virtues. How does the consumer benefit from the steady decline of a film’s quality?

1995 *Hearing*, *supra* note 5, at 42 (prepared statement of Jack Valenti). Even a cursory consideration of this “Little Orphan Annie” theory of intellectual property compels the conclusion that it supports perpetual copyright and that, if it is valid, the Copyright Clause’s insistence on limited times is a guarantee of mediocrity—at best. It should be noted that Register Peters proffered the same argument in less dramatic terms:

Once a work falls into the public domain there is no guarantee that the work will be more widely available or cheaper. In fact, there is ample evidence that shows that once a work falls into the public domain it is neither cheaper nor more widely available One reason quality copies of public domain works are not as widely available may be because publishers will not publish a work that is in the public

seem to be any constitutional power premised, however, on publication, as opposed to creation, of works nor upon the quality of works.³⁶

The testimony of the Register of Copyright seems to have been key. Though the Register addressed many issues, the Register's position with regard to the constitutional legitimacy of copyright term extension, prospective and retrospective, was presented as follows:

Few would argue that a perpetual copyright term under federal law would be constitutional. Despite a history of over two hundred years of copyright jurisprudence, judicial authority on the meaning of the "limited times" provision is scant. In 1976 Congress believed that life plus 50 years did not violate the Constitution. Consequently, the Copyright Office believes that H.R. 989 which proposes adding an additional twenty years is within reasonable bounds. Perhaps the best judicial authority on the "limited times" provision . . . is subject to a number of different interpretations Another constitutional objection which may be raised is the failure of the public to secure a "benefit" for the extended copyright in works already in existence. This argument essentially seeks to reduce issues of constitutionality to an inquiry over identification of specific public benefits for each individual copyrighted work. The copyright clause has never been interpreted in such a fashion. It appears reasonable to conclude that a longer revenue stream for copyrighted material is to the public good because funds become available for the creation of new works. Some may disagree with the length of the copyright term chosen by Congress, but the Constitution gives Congress the right to decide this issue. When the 1976 Copyright Act was enacted, Congress specifically embraced longer terms for works already in existence. This decision was never challenged as unconstitutional. For these reasons, the Copyright Office believes consideration of term extension is well within the Constitutional powers of Congress.³⁷

domain

Id. at 26-27.

36. The Supreme Court has habitually avoided judgments of quality in assessing copyright disputes. "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [works of authorship] . . . and the taste of any public is not to be treated with contempt." *Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 239, 251 (1903). Clearly, this Congressional testimony was not oriented so much towards the quality of content as towards the quality of presentation (at least it so appears) but, in any event, the Court considers questions of relative quality to be outside the ambit of the copyright clause.

37. 1995 *Hearing*, *supra* note 5, at 17 (statement of Marybeth Peters, Register of Copyright and Associate Librarian for Copyright Services).

Towards the end of the portion of the Register's comments presented above, she confuses retrospective and prospective extension when, addressing retrospective extension, she says that "some may disagree with the length of [time],"³⁸ which of course is not at all the disagreement regarding retrospective extension. The issue is whether it is constitutional to grant any time, not any particular length of time, to an existing copyright term because to do so does not seem to satisfy the constitutional command of an incentive or "guaranteed reward."³⁹ Then, compounding the constitutional confusion, she proceeds to point out that past copyright revisions (specifically the 1976 Act) that extended terms retrospectively went without "challenge." But these are separate issues: first, the disagreement over the length of time appears, indeed, not to be cognizable though it has nothing to do with the arguments against retrospective extension. How long is long enough is exactly the kind of question that the Supreme Court has reserved for Congress at least since the *Carolene Products* case.⁴⁰ Second, whether a legislative act goes unchallenged for a short or a long time surely has little, if anything, to do with its constitutionality. The Supreme Court has not been shy about invalidating long-standing customs or practices that turn out to be unconstitutional.⁴¹ There is no known rule that immunizes repeated constitutional violations from judicial scrutiny. If there were, it would lead to the paradoxical result of immunizing repeated, and therefore more harmful, unlawful conduct, while policing only those occasional, and surely less harmful, violations. Whether this retrospective extension—as well as earlier ones—is constitutional depends upon the nature of the constitutional limits on retrospective protection, not on how many times those limits were violated. Finally, it should not escape attention that the Register raised the "public benefit" as a supposed basis for extending copyright terms. But there is no mention of "public benefit" in the constitutional clause, nor is it recognized as a source of copyright power in Supreme Court decisions. The public benefit argument is, in short, a red herring.

38. *Id.* at 8.

39. See *Mazer v. Stein*, 347 U.S. 201, 209 (1954).

40. *United States v. Carolene Prod. Co.*, 304 U.S. 144, 153 (1938). Whether fifty, seventy, or ninety-five years is an appropriate copyright term, or even 150, 170, or 195 years, seems clearly within the *Carolene Products* rule that such legislative judgments need only be rational and that the factual basis for those judgments, barring allegations of racial discrimination or other intrusions on fundamental rights, are virtually presumed to exist. If Congress, for instance, has such unbounded discretion to choose the number of years appropriate for a mandatory retirement age for airline pilots, *Vance v. Bradley*, 440 U.S. 93 (1979), it must surely be able to do so with respect to copyright terms.

41. See, e.g., *Brown v. Board of Educ.*, 347 U.S. 483 (1954) (holding almost a century of public school racial segregation unconstitutional); *Furman v. Georgia*, 408 U.S. 238 (1972) (holding almost two centuries of capital punishment procedures unconstitutional).

Thus, two misunderstandings coincided when Congress considered the Bono Law. First, virtually all those supporting extension were interested in retrospective, not prospective extension. From the representatives of individual songwriters, to their heirs, to large corporate entities like the Motion Picture Association and ASCAP, all were interested in preventing the termination of copyrights that were supplying them with dependable streams of income. This is not surprising, of course, because as economists have pointed out, the present value of prospective extension fifty to seventy-five years from the present is so insignificant that it could not even justify the airfare to attend a Congressional hearing.⁴² What motivated the witnesses and, as a result, Congress, was the retrospective extension of existing copyright terms.

Second, Congress was presented—notably by the Register of Copyrights—with legal theories which confused the relevant controlling legal doctrines,⁴³ misunderstood the applicable constitutional sources of the copyright power,⁴⁴ and misinformed Congress about its role.⁴⁵

III. THE INCENTIVE RATIONALE AND RETROSPECTIVITY: “BRING IT ON HOME TO ME”⁴⁶

With respect to retrospective extension, the Register's arguments are problematical and historically and logically flawed. One thing is clear: the Constitution authorizes copyright as an incentive. Over a century ago, in the *Slaughter-House Cases*,⁴⁷ the Court considered a law enacted by the State of Louisiana for a group of individuals who were thus entitled to monopolize the slaughterhouse industry in the New Orleans area. The

42. The value is uniformly gauged by economists as something less than one-tenth of one per cent of the whole. See *infra* note 177 and accompanying text.

43. See *infra* Part IV (distinguishing between the “limited times” and “promotion-of-progress” phrases which the Register confused).

44. See *infra* Part IV (discussing why “public benefits” and “public goods” are limits upon, not sources of, the copyright power).

45. Congress was misinformed in several respects. First, it was urged to enact a copyright term extension statute both prospectively and retrospectively when it was only the latter which was truly important to the interested parties who testified. See 1995 Hearing, *supra* note 8 (statement of Marybeth Peters). Second, Congress was basically told that it had the power to extend copyright terms as long as there was some benefit. See *id.* Finally, the prospective benefit of which Congress was at best only vaguely informed was too insignificant to matter (because the discounted value was at best trifling) while there was little accounting and a lot of obfuscation of the retrospective benefits (that is, how much the witnesses stood to gain by passage of the Bono Law). See *id.*

46. SONNY & CHER, *Bring It on Home to Me, on THE WONDEROUS WORLD OF SONNY & CHER* (Sundazed Records 1966).

47. *Butchers' Union Slaughter-House Live-Stock Landing Co. v. Crescent City Live-Stock Landing & Slaughter-House Co.*, 111 U.S. 746 (1884).

Court upheld that monopoly as a legitimate exercise of local police powers which need little or no justification other than a legislative inclination to indulge them, but contrasted it with the incentive strategy of the Copyright clause, observing: "Society gives to the . . . author the exclusive benefit for a time of that which, but for him, would not, or might not, have existed; and thus not only repays him, but encourages others to apply their powers for the public utility."⁴⁸

More recent Court pronouncements have repeated this philosophy. "[T]he monopoly granted by copyright actively serve[s] its intended purpose of inducing the creation of new material."⁴⁹ The Constitutional clause is about "authors," and about affording them incentives to produce copyrightable works.⁵⁰ It is not about funding authors, or publishers, generally, in the hope or expectation that they might produce something.⁵¹ It is about rewarding them for the completion of the task, and holding out that incentive for future works.

The clause thus describes both the objective which Congress may seek and the means to achieve it. The objective is to promote the progress of science and the arts. As employed, the terms "to promote" are synonymous with the words "to stimulate," "to encourage," or "to induce." To accomplish its purpose, Congress may grant to authors the exclusive right to the *fruits* of their respective works In other words, to encourage people to devote themselves to intellectual and artistic creation, Congress may *guarantee* to authors and inventors a *reward* in the form of control over the sale or commercial use of copies of their works.⁵²

The incentive theory is a theme that recurs. "A copyright, like a patent, is 'at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals and the incentive to further efforts for the same important objects.'"⁵³

48. *Id.* at 763.

49. *Harper & Row v. Nation Enterprises*, 471 U.S. 539, 546 (1985).

50. *See United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948) ("It is said that reward to the author or artist serves to induce release to the public of the products of his creative genius.").

51. *See Merges & Reynolds, supra* note 5, at 59 ("[T]he value of intellectual property is that it encourages authors . . . to take risks 'on the front end' with the expectation of reaping profits later. A *post hoc* reward . . . is unlikely to provide such encouragement . . .").

52. *Goldstein v. California*, 412 U.S. 546, 555 (1973) (footnote omitted) (emphasis added).

53. *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127-128 (1932) (citing *Kendall v. Winsor*, 62 U.S. (21 How.) 322, 327-28 (1858); *Grant v. Raymond*, 31 U.S. (6 Peters) 218, 241-42 (1832)). Besides reiterating the incentive theory, *Fox Film* is interesting for what it had to say about the nature of copyright once it has been granted. *See Fox Film*, 286 U.S. at 130. Deciding that royalties were not immune from state taxation, because they were not in any way a continuing Federal instrumentality, the Court said:

With respect to retrospective extension, thus, the greater “revenue stream” (which in this case is simply hype for windfall profits) about which the Register testified is, by definition, not such a constitutional “guaranteed reward,” an incentive to authors for future works,⁵⁴ because whether they produce more works or not, this unexpected greater term is paid to them for past works only.⁵⁵ And since those works have already been produced, there can be no incentive. It is certainly not a “guaranteed reward” for an author’s “fruits” with respect to works already produced (and paid for with the already-bargained-for existing copyright term). It is, instead, an afterthought, not a guarantee; it is not, therefore, the constitutionally authorized incentive. In other words, copyright has already done its job with respect to past works and, by definition, the existing copyright term was sufficient to provide the necessary incentive. The

The advantage to the public is gained merely from the carrying out of the general policy in making such grants and not from any direct interest which the Government has in the use of the property which is the subject of the grants. *After the copyright has been granted* the Government has no interest in any action under it save the general one that its laws shall be obeyed.

Id. (emphasis added). This would certainly imply, on grounds complementary to those urged here that the incentive theory forbids retrospective term extension, and that there is no legitimate Congressional role in a copyright, including extending its term, “after the copyright has been granted.”

54. See 1995 Hearing, *supra* note 5, at 8 (statement of Marybeth Peters). Obviously, these authors will know, if copyright terms are extended properly and constitutionally, that there is a greater incentive for future works. If Congress decides this will work (that is, that an additional twenty years will motivate the production of sufficient future works to outweigh the additional twenty years burden upon access) then Congress is the appropriate organ to make that decision.

55. Some commentators seem ready to recognize a Congressional power to legislate copyright on the basis of some indirect benefit to authors by subsidizing publishers, but they only do so ruefully through a dissatisfied acceptance of a perversion of constitutional rules:

Here, however, the changing vision of the core purposes of copyright comes into play. In the emerging new understanding of what constitutes the progress of science and the useful arts, enhancing overall financial well-being of companies that invest in the production and distribution of copyrightable works contributes generally, if not specifically, to the promotion of creativity and authorship, especially in the form of works for hire.

Peter A. Jaszi, *Impact of the TRIPS Agreement on Specific Disciplines: Copyrightable Literary and Artistic Works Goodbye to All That—A Reluctant (and Perhaps Premature) Adieu to a Constitutionally-Grounded Discourse of Public Interest in Copyright Law*, 29 VAND. J. TRANSNAT'L L. 595, 608-09 (1996). This admission is, however, absolutely unnecessary. If the basis of this argument is in fact the significance of works for hire, Professor Jaszi has failed to understand that in those cases the corporate entities are themselves the authors. Corporate entities, on behalf of their workers for hire and as individuals, are entitled to the copyright incentive prospectively. But neither are entitled to it retrospectively, for it motivates nothing, whether works for hire or not.

Court has emphasized, and reiterated, the incentive theory which relies, according to the Court, on motivating individual authors.

In holding, in a landmark case addressing the copyrightability of mass-produced objects of mixed utility and expression, that the expressive features of such objects are fully copyrightable, the court founded its decision upon and concluded its opinion with the following succinct summary of the incentive rationale:

The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in "Science and useful Arts." Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.⁵⁶

The Constitution clearly contemplates "authors" who will produce works in exchange for the copyright monopoly. But the "revenue stream" that the Register applauded was not for authors as a reward for their works, but for authors (and, probably most importantly, publishers) who might or might not produce works. The copyright clause, however, does not grant monopolies to authors who might produce works, but only to those who actually do produce a work, in exchange for which the copyright is granted. What the Bono Law provided is not an incentive, but a gift or a windfall. It is clear, from the other Congressional comments, that the Register was advancing the arguments made by the publishing industry generally, that with the greater revenues received from past successful books, movies, and songs, they would be able to commission more new works.⁵⁷ Whether that was true or sincere or not, it is not constitutionally cognizable. Copyright is not granted to publishers or to any industry that they might commission new works. It could not be the "guaranteed reward" for the successful completion of a work to which the Supreme Court has referred.⁵⁸ Copyright is granted to the author upon the successful completion of a work. Thus, the Register's argument seems logically misplaced.

56. *Mazer v. Stein*, 347 U.S. 201, 219 (1954).

57. Aside from Register Peters' testimony, a coalition of owners of existing copyrights, or those representing those owners, ranging from the Writers Guild of America and the Volunteer Lawyers for the Arts, to ASCAP and the American Music Center, asserted the "future authorship" argument: "Extended copyright term will provide additional economic incentive to such copyright owners, and will finance future authorship, production and distribution." *1995 Hearing, supra* note 5, at 136.

58. *Mazer*, 347 U.S. at 219; *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948).

There was one additional reason that the Bono Law was enacted: international so-called "harmonization." Though it is not important to the present question concerning the constitutionality of retrospective term extension, it becomes important when considering whether the Supreme Court should invalidate the law.⁵⁹ At the time the Bono Law was being considered, some members of the Berne Convention—notably the European Union—had increased their terms for many, though not all, works to seventy years. Because of the "rule of the shorter term," however, U.S. authors could not get the benefit of the seventy year period as long as the U.S. itself had a shorter, fifty-year, term. It is clear, however, that retrospective extension was not necessary to achieve this harmonization since the EU policy addressed future, not existing, copyright terms.

IV. THE CONSTITUTIONAL TEXT: A "GOOD COMBINATION"⁶⁰

There has been very little close constitutional analysis of the problem of copyright term extension and, as a result, the central, perhaps decisive fact, that the area is effectively governed by two textually distinct sources has remained unfortunately obscure. It is elementary but essential to regard, no matter how briefly, the two distinctively different terms of the patent and copyright clause: "Congress shall have Power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."⁶¹ Most discussion of copyright term extension has involved the "limited times" phrase. But copyright term extension does not involve only the one very obvious constitutional phrase, "limited terms," although prospective term extension is governed and surely limited by that phrase. Any copyright term extension also involves the promotion-of-progress phrase, and retrospective term extension is governed and surely effectively limited only by that phrase. The failure to identify these two distinctively different phrases—the limited-times phrase and the promotion-of-progress phrase—condemns the issue to one of hopelessly indecipherable constitutional confusion.

The failure to identify the two distinctive sources is reminiscent of the continuing confusion over the "parsing" of the Patent and Copyright Clause itself.⁶² Authors⁶³ and courts⁶⁴ have failed to distinguish between

59. See *infra*, Part XI (discussing severability). Since legislative intent is central to severability, the fact that the Congressional goal of harmonization could be achieved with or without retrospective extension becomes important. On the other hand, the legislative history of the Bono Law includes precious little comment on the goal of harmonization.

60. SONNY & CHER, *Good Combination*, on THE BEAT GOES ON: THE BEST OF SONNY & CHER (ATCO 1975).

61. U.S. CONST. art. I, § 8, cl. 8.

62. See, e.g., *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 56 (1884); Alfred Bell

the relevant parts of the Clause, which in identifiably distinct but unfortunately mixed portions address separately patents and copyrights. Thus, although it is easy to distinguish "authors" from "inventors" and to conclude that the first applies to copyright while the latter applies to patents, it is less easy to distinguish between "useful Arts" and "science" which apply, perhaps counterintuitively, to patents and copyright, respectively. This is not a necessarily minor issue. To confuse the two can be truly damaging. In a famous constitutional embarrassment, Justice Douglas once authored a dissent to a denial of certiorari in which he insisted that copyright and patent, supported by the same clause, required the same elements and thus the patent requirement of novelty should apply equally to copyright.⁶⁵ The court rejected that view of course, but had it been accepted it would have transformed and perhaps even destroyed copyright law.⁶⁶

These confusions, however, should not really influence the present issue. The promotion-of-progress term applies equally to both patents and copyrights,⁶⁷ as does the "limited times" term. Obviously, the particular

& Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 100 (2d Cir. 1951) (correctly parsing the Patent and Copyright Clause).

63. See, e.g., Jaszi, *supra* note 5, at 597 (discussing the exact same issue addressed here, and stating "that legislation which grants protection for works already in being would not seem calculated to advance the progress of Science and the useful Arts"). The error is repeated later in the article. See *id.* at 609. Professor Patry, however, rightly refers solely to "the progress of science." Patry, *Protecting the Idle Rich*, *supra* note 5, at 908.

64. *Baker v. Selden*, 101 U.S. 99, 103 (1880); *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 526 (1994) (citing with approval *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349-350 (1991)); see also *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) ("The Patent Clause itself reflects a balance between the need to encourage innovation and the avoidance of monopolies which stifle competition without any concomitant advance in the 'Progress of Science and useful Arts.'"); cf. *Graham v. John Deere Co.*, 383 U.S. 1, 5 (1966) (a patent case in which the Court effortlessly and flawlessly parsed the clause thusly: "'To promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries.'" (citation omitted)).

65. See *Lee v. Runge*, 404 U.S. 887, 889-91 (1971).

66. See *id.* at 887. It is famous in the sense that it is frequently included in intellectual property casebooks as an example of this confusion. Note that if novelty in fact did limit copyright, far fewer works would be entitled to copyright and, perhaps more importantly (at least to law professors who love to teach it) the doctrine of independent creation would vanish. Cf. *Bright Tunes Music Corp. v. Harrisongs Music, Ltd.*, 420 F. Supp. 177, 180-81 (S.D.N.Y. 1976) (holding the inadvertent use of a previously released melody constitutes copyright infringement).

67. There being no textual nor policy reason to support a differential treatment, it seems inarguable that the promotion-of-progress phrase applies to both copyright and patent equally. *Merges* and *Reynolds* agree, though they assert it somewhat more cautiously: "There seems to be no reason for interpreting the provision differently given the parallel structure of the clause." *Merges & Reynolds*, *supra* note 5, at 58 n. 52; see also *Tung Yin*, *supra* note 5, at 392. Yin admits the promotion-of-progress phrase has parallel applicability to both patents and copyright but then concludes that, because patent protection is much more broad—though radically shorter in time—than copyright, that the *John Deere* doctrine "should not be applicable to the revival of

application of those two common terms might be different with respect to one field than the other.⁶⁸ But the imperative of both—that a constitutional limit applies—is constant. If retrospective extension does not promote progress, as seems clear from its concomitant failure to satisfy the incentive requirement, it loses all constitutional legitimacy.

V. THE CONSTITUTIONAL LIMITS ON COPYRIGHT PROTECTION: “UNITED WE STAND”⁶⁹

Obviously, an argument that copyright legislation may be unconstitutional relies upon the notion that the copyright power is constrained by enforceable limits. This is a point, however, that seems beyond argument. For, as the Supreme Court has said, “We have often recognized the monopoly . . . [is] limited in nature”⁷⁰

Over 150 years of judicial decisions confirm that the text of the copyright clause supplies limits upon legislative action. But to rely on those cases alone would ignore a similarly large body of commentary, all of which asserts a constitutional basis for a wide variety of limits stemming from the copyright clause, many of those limits of far more obscure and arguable character than the limit on retrospective copyright protection. These cases and commentary underline the fact that the typically spare Constitutional language is not simply a vague grant of power but is also a source of practicably enforceable limits beyond which Congress cannot proceed. For instance, the terms “author” and “writing” have been defined in an expansive, but limited, way. In *Burrows-Giles Lithographic Co. v. Sarony*, the Supreme Court held the limits of what is a writing and an author, in the constitutional sense, to be a question “not free from difficulty” but that the answer surely included lithographs and their creators.⁷¹ Nevertheless, the court heard the case because of the implicit Constitutional limits posed by the clause, and upheld protection because defining writings and authors to include lithographs “comes

copyrights,” instead of concluding that it should, perhaps, be differently applicable. *Id.* at 393-94.

68. So, for instance, the term of copyright is much longer than it is for patent. This does not obviously reflect a decision that the terms of each shall not be limited but that an appropriate limit is different in the area of useful technology than it is for expressive works. This does not bode well, it would appear, for those who claim that a particular limit—like seventy years—is simply not a “limited time” in a constitutional sense. But both areas are devoted to increasing the public domain, since the promotion of progress is concerned with that, and both are premised on the same incentive theory that protection is a reward, and not an unexpected windfall.

69. *SONNY & CHER, United We Stand, on GREATEST HITS* (UNI/MCA 1974); *SONNY & CHER, ALL I EVER NEED IS YOU* (MCA 1994).

70. *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 526 (1994).

71. 111 U.S. 53, 56 (1884). The Court, in a later case, characterized the question as “whether Congress had the constitutional right to protect photographs and negatives by copyright” *American Tobacco Co. v. Werckmeister*, 207 U.S. 284, 293 (1907).

within the purpose of the Constitution in securing its exclusive use or sale to its author.”⁷² The Court thus decided the constitutional limits based on the purposes of copyright, not upon a mechanical reading of the words. This rule of purposive construction of the limits of the copyright clause is something that the Supreme Court has always embraced.

Not long after *Burrows-Giles*, the Supreme Court again considered the scope of the copyright clause in *United States v. Steffens*⁷³ and found that despite the constitutional clause’s expansive breadth, the terms and purposes of copyright were not wide enough to include trademarks. It was not just that a trademark was not a “writing,” which, of course, in *Burrows-Giles* was broad enough to include such things as photographs, but that trademarks were not “original . . . founded in the creative powers of the mind . . . [nor] are the fruits of intellectual labor”⁷⁴ Despite the lean constitutional language—writings, authors, and progress—the court found cognizable limits extending to abstract notions of creativity and intellectual labor.⁷⁵

In a series of even earlier nineteenth-century cases⁷⁶ concerning the copyrightability of judicial decisions, the Court had repeatedly found limits beyond which Congress could not proceed despite the undoubtedly expansive nature of the definition it applied to the word “authors.” In an Ohio case, the Court asserted that “[i]n no proper sense can the judge who, in his judicial capacity, prepares the opinion or decision . . . be regarded as their author . . . in the sense of [the copyright statute.]”⁷⁷ This was a question of policy of course, but it was based, at least in part, on limitations deriving from the express language of the Copyright clause—those of authorship. In the same term, however, the Court held in an Illinois case that a court reporter, unlike a judge, could indeed be an author, in the constitutional sense, with respect to judicial opinions organized and edited by the reporter.⁷⁸ It was clearly not the nature of the publication—judicial reports—but the nature of the author and the goals of copyright law—to produce that which would not or might not be created absent the copyright incentive—which furnished the limits upon Congressional latitude.

72. *Burrows-Giles*, 111 U.S. at 59.

73. 100 U.S. 82 (1879).

74. *Id.* at 94.

75. *See id.* The Court is still engaged in the search for intellectual labor, finding, for instance that telephone directories simply lack the minimal creativity necessary for copyright protection—a limit that derives not from the statute, but from the Constitutional clause. *See generally* Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991).

76. The first was *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834).

77. *Banks v. Manchester*, 128 U.S. 244, 253 (1888).

78. *See Callaghan v. Myers*, 128 U.S. 617 (1888).

Shortly before the turn of the century, the Court again considered the copyrightability of devices more appropriately treated as trademarks.⁷⁹ The Court held that commercial labels were not copyrightable, first because they had nothing to do with “the creative powers of the mind.”⁸⁰ Nowhere (except buried within the meaning of “authors”), of course, is there any reference to such mental faculties in the copyright clause. But, second, the court relied on the promotion-of-progress phrase and found the labels not copyrightable because it could have “no possible influence upon science or the useful arts.”⁸¹ This, said the court, was not “within the purpose of the clause”⁸² The promotion-of-progress phrase imposed an enforceable limit upon copyright legislation.

Shortly after the turn of the century, the Court again considered the copyrightability of prints, this time commercial chromolithographs.⁸³ Whether such representations were copyrightable was not a matter of statutory construction but was, decided the Court, a constitutional matter determined by the copyright clause.⁸⁴ And it was not simply a matter of textual definition, but of constitutional purpose. Whether the pictures were copyrightable, wrote Justice Holmes, depended upon whether such pictures could be found in copyrightable subject matter (writings) “the progress of which Congress is empowered by the Constitution to promote.”⁸⁵ The limits of copyright, therefore, are found in the specific words—those of the promotion-of-progress phrase—of the copyright clause and the concomitant incentive function they demand.

In a landmark case determining the limits of copyright pre-emption, the Court considered whether a news agency could gain a “free ride” by wiring news from the East Coast, where it had been published by a competitor, to its own West Coast offices.⁸⁶ The Court held that such news reports could not enjoy copyright protection because news was not copyrightable.⁸⁷ The reason such news is not copyrightable is, among other things, because it is not the product of the constitutionally-required writer or “author”:

But the news element—the information respecting current events contained in the literary production—is not the creation of the writer, but is a report of matters that ordinarily are publici juris; it is the history of the day. It is not to be

79. *See Higgins v. Keuffel*, 140 U.S. 428, 431 (1891).

80. *Id.* at 431.

81. *Id.*

82. *Id.*

83. *See Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 239, 249 (1903).

84. *See id.* at 252.

85. *Id.* at 249.

86. *See International News Serv. v. Associated Press*, 248 U.S. 215, 234 (1918).

87. *See id.* at 244.

supposed that the framers . . . intended to confer upon one who might happen to be the first to report a historic event the exclusive right for any period to spread the knowledge of it.⁸⁸

The Court proceeded to grant relief on the basis of common law misappropriation, but it is essential to understand that the Court was required to do so, if it was inclined to grant relief, because of the enforceable limits imposed by the Copyright Clause itself.

Not only has the Court found limits upon Congressional copyright protection derived from the constitution, but it has articulated a broad rule that imposes a general restriction upon legislative activity. This rule is based upon the public interest, and it has allied both in parallel directions generally limiting copyright protection to that which can serve the incentive theory. Congressional activity is limited both by what can be justified on the basis of motivating authors and, as well, by what the public interest demands.⁸⁹ In an important case, the holding of which was eventually codified into the 1976 Copyright Statute,⁹⁰ the court held that the doctrine of fair use was a claim upon the copyright owner's title, and derived from the "public interest" which, in a broadly general way, creates a "limited scope" of both the constitutional grant and the resulting statutory language:

The limited scope of the copyright holder's statutory monopoly, like the limited copyright duration required by the Constitution, reflects a balance of competing claims upon the public interest: Creative work is to be encouraged and rewarded, but private motivation must ultimately serve the cause of promoting broad public availability of literature, music, and the other arts. The immediate effect of our copyright law is to secure a fair return for an "author's" creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good. "The sole interest of the United States and the primary object in conferring the monopoly," this Court has said, "lie in the general benefits derived by the public from the labors of authors."⁹¹

88. *Id.* at 234.

89. But note that these are both limits, not sources of power. As stated earlier, the Congressional testimony in support of the Bono Law, and the Register's comments particularly, simply misunderstood and, to put it charitably, misstated the Court's view that the public interest or the public good is the basis for limiting, not expanding, copyright legislation. The public welfare, or interest, or good, is not a source of the copyright power; the power comes only from the words and function of the constitutional clause.

90. 17 U.S.C. § 107 (1976).

91. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (quoting *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932)) (citations omitted). Once again, note that the "public

Even fair use, a statutory codification of judicially-created defenses, has been viewed by the Court as part of the constitutional scheme. Holding that the right to prevent copying of unpublished works extends to preventing others from pre-emptively publishing even politically charged text, the Court noted that the statute provides only a "scheme" by which the "seed and substance" guaranteed by the Constitution is "harvest[ed]."

[C]opyright is intended to increase and not to impede the harvest of knowledge The rights conferred by copyright are designed to assure contributors to the store of knowledge a fair return for their labors "This limited grant is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired."⁹²

The relationship between the constitutional grant and Congressional latitude may seem arguable, but the Supreme Court, rightly or wrongly, has said it is a simple matter deriving from the copyright clause itself. The Court, in articulating what it seems to believe is a fairly simple calculus, stated it plainly: copyright allows Congress to grant to individual authors a monopoly in exchange for works they create. This is a "reward," said the Court—and, as is true of rewards generally, it is a reward for work completed, not, as the Register's comments misperceived it, as a subsidy for future works. This monopoly has as its sole goal the public good, and the public good is a limit upon Congressional latitude. The court said it was a simple textual matter:

The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved. It is intended to *motivate* the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.

interest" is a limit upon the author's interests or rights, creating rights in the public to freely and fairly use what would otherwise be within a wider perimeter of copyright. Were it not for the Register's comments, and some other misleading legislative history already mentioned, it would not be necessary here to again emphasize that the Court's use of the terms "public benefit" and "public good" is that of a limit, not a source, of copyright power.

92. *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 545-46 (1985) (citations omitted).

As the text of the Constitution makes plain, it is Congress that has been assigned the task of defining the scope of the limited monopoly that should be granted to authors or to inventors in order to give the public appropriate access to their work product. Because this task involves a difficult balance between the interests of authors and inventors in the control and exploitation of their writings and discoveries on the one hand, and society's competing interest in the free flow of ideas, information, and commerce on the other hand, our patent and copyright statutes have been amended repeatedly.⁹³

Consistent with the Court's traditional and institutional tendency to prefer statutory construction over findings of unconstitutionality and to privilege a construction which is constitutional over one that is not,⁹⁴ most copyright decisions have avoided construing the Act in a way that would collide with the Copyright Clause. But sometimes the expansive wording of the Act has made this difficult.⁹⁵ For many years, federal courts had given copyright protection to telephone directories.⁹⁶ But, in 1991, rejecting the "sweat of the brow" theory of copyright, the Court declared that, although "[c]ompilations [are] expressly mentioned in the Copyright Act of 1909, and again in the Copyright Act of 1976,"⁹⁷ such copyright cannot include, as a matter of constitutional limitations, telephone white page directories, because such "white pages, limited to basic subscriber information and arranged alphabetically, fall short of the mark."⁹⁸ That mark, the Court explained, was the requirement of originality, a constitutional limitation only partly appearing in the statute itself. "[O]riginality is a constitutionally mandated prerequisite for copyright protection,"⁹⁹ said the Court. The fact that courts and commentators, and arguably even the 1909 statute, at least by its ambiguity, recognized copyright in such directories, could not change the unvarying constitutional nature of the limitation

93. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (citations omitted) (emphasis added).

94. *See ex rel Attorney Gen. v. Delaware & Hudson Co.*, 213 U.S. 366, 408 (1909). "Where a statute is susceptible of two constructions, by one of which grave and doubtful constitutional questions arise and by the other of which such questions are avoided, our duty is to adopt the latter." *Id.*

95. *See Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). The Court could not avoid observing that the terms of the copyright act were so broad as to impermissibly include works composed of nothing but uncopyrightable fact. "Yet copyright law seems to contemplate that compilations that consist exclusively of facts are potentially within its scope." *Id.*

96. *See Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937); *Jeweler's Circular Publ'g Co. v. Keystone Publ'g Co.*, 281 F. 83 (2d Cir. 1922).

97. *Feist*, 499 U.S. at 345.

98. *Id.* at 363.

99. *Id.* at 351.

imposed by originality. "The Court's decisions announcing this rule predate the Copyright Act of 1909, but ambiguous language in the 1909 Act caused some lower courts temporarily to lose sight of this requirement. The 1909 Act embodied the originality requirement, but not as clearly as it might have."¹⁰⁰ The result, of course, is that neither Congress nor the courts can constitutionally recognize copyright protection beyond the limits imposed by the copyright clause itself. And, of course, with respect to originality, it is instructive to recognize that the clause contains no explicit reference to any such requirement. And, contrary to the Register's notion that constitutionality is gained through mere passage of time, it is equally instructive to recognize that almost a century of acceptance did not alter the constitutional limit upon directories as unoriginal works even though their copyright, and even registration by the Register, had not been "contested," in the words of Register Peters. Further, note that the notion of the public good or public benefit never arose. Surely, there might be a benefit derived from protecting directories¹⁰¹ and this would merit discussion if it were constitutionally relevant. But *Feist* is clear evidence that the public good or benefit can never support copyright legislation, in the face of limits imposed by the constitutional copyright clause itself.

More recent cases have, unsurprisingly, reiterated this rather simple calculus, emphasizing that the copyright grant is a reward for the task completed, not an advance payment for future work. The danger of such an open-ended offer was recognized in patent law when Justice Fortas, in *Brenner v. Manson*,¹⁰² made the famous remark that a patent is not a "hunting license."¹⁰³ One must guard vigorously against confusing patent and copyright law¹⁰⁴ because they are distinctively different in both function and application in a host of ways, but the basic justification for the constitutional clause is the same for both, and *Manson* was based on the overarching principles of the constitutional clause generally. It is instructive to consider *Manson*, in which a patentee claimed rights over a process that produced chemicals that were homologues—minor chemical variations—of demonstrably useful and pharmacologically active substances. There was some chance that these homologues would be useful, but no one could know. Because of a lack, therefore, of demonstrable utility, the Court held the patent invalid because it did not satisfy the constitutional utility requirement. Because patent law does not grant a "hunting license," and because "it is not a reward for a search, but

100. *Id.*

101. In fact, it has seemed so potentially beneficial as to spawn an international effort to recapture that protection in one form or the other. See *infra* notes 136 and 137.

102. 383 U.S. 519 (1966).

103. *Id.* at 536; see also *infra* Part IX (discussing the relevance of the patent clause).

104. See *supra* notes 62-66 and accompanying text.

compensation for its successful completion,”¹⁰⁵ such an open-ended application of the patent power violates its constitutional limits. This position conflicts fatally with the Register’s argument that publishers can be given an open-ended warrant, so to speak, to search for publishable material.

One of the troublesome features of retrospective extension is that it is justified, however feebly, by a kind of blanket incentive given to all holders of copyright. This is such a unique and novel justification that there are few, if any cases, to either support or reject it. But such language does exist. For instance, Justice O’Connor affirmed in *Harper & Row* that the copyright monopoly is based on a notion of individual, and assumedly not group, merit, stating: “The monopoly created by copyright thus rewards the *individual* author in order to benefit the public.”¹⁰⁶

In sum, the cases seem clear that the Copyright Clause exercises a limit upon the scope of Congressional action. Congress cannot grant protection to those works which do not qualify as writings. Neither can Congress grant protection to that which constitutes a mere idea. Nor can Congress grant protection to that which has not the minimum creativity to constitute the required originality. Neither can it grant an open-ended monopoly and, finally, it can grant only an incentive as a reward for works upon their “successful completion.” It must be clearly observed that none of these limits stem from an express command of the constitutional clause. Instead, the Supreme Court has chosen to find limits—firm and enforceable limits upon Congressional discretion—that are implied from the text as well as the very nature of the clause itself. The Court has repeatedly emphasized that the copyright monopoly is granted as an incentive, and an individual reward. There is no reason to doubt that if the Court considers it important to police extension of the clause beyond its constitutional limits with respect to writings, ideas, originality, creativity, and open-endedness, it will do so as well with respect to the very incentive basis upon which the clause rests.

105. *Manson*, 383 U.S. at 536.

106. *Harper & Row Pub.v. Nation Enters.*, 471 U.S. 539, 546 (1985) (citing the dissenting opinion of Justice Blackmun in *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 477 (1984)) (emphasis added).

VI. THE PROMOTION-OF-PROGRESS PHRASE AND THE PUBLIC DOMAIN:
"SET ME FREE"¹⁰⁷

It seems clear that Congress and most of the Congressional testimony confounded retrospective with prospective extensions¹⁰⁸ of the copyright term. But to properly understand whether retrospective extension is unconstitutional, it must be appropriately analyzed separately. Instead of considering the whole of the Bono Law, it is essential to ask the following question: would it be permissible under the Copyright Clause to extend an existing copyright term—separate and apart from prospective extensions? Another way of asking the question might be, what constitutional purpose is served by, and could justify, simply extending a copyright term for a finished work for which the author was already enjoying the existing monopoly? Or, more pointedly, does retrospective extension satisfy the promotion-of-progress phrase? If, as the preceding cases demonstrate, the Court will insist that Congressional legislation does not exceed the justificatory limits of the Constitutional clause, such an extension seems constitutionally adrift.

The promotion-of-progress phrase and the oft-articulated policy protecting the public domain from illegitimate intrusions are two sides of the same coin. The progress of which the constitutional clause speaks is the growth of the public domain—for it is these contributions to the public domain, as a result of creations due to the incentive of copyright, that constitute progress in copyright law.¹⁰⁹

In many cases, of course, the Court understands that the Clause looks to that which is without as well as within copyright. Most cases can probably be characterized as restating what is within copyright. But many others ensure that what is outside copyright remains in the public domain or, as importantly, that there be regular conversion from copyright to the

107. *SONNY & CHER, Set Me Free, on THE WONDEROUS WORLD OF SONNY & CHER* (Sundazed Records 1966)

108. See *supra* note 43 and accompanying text. Also note how Register Peters blurred the one into the other in her prepared testimony. See *supra* note 5, at 6. Confusion reigned, it appears. Robert Stoll, appearing on behalf of Patent and Trademark Office Commissioner Bruce Lehman to consider copyright music licensing (the Music Licensing Act of 1997), answered in response to a question by Representative Delahunt, whether he had "reviewed this proposal, in terms of its constitutionality?" answered, "Yes, Sir, Article I, Section 8, the 'to promote the useful arts,'" the term, of course, which limits patents, not copyrights. *Music Listening in Restaurants and Retail and Other Establishments: Hearing before the Subcomm. on Courts and Intell. Prop. Comm. of the House Judiciary*, 106th Cong. 23 (1997) (testimony of Robert Stoll).

109. That the point of the entire intellectual property exercise is to promote progress by increasing the public domain has been reiterated in a host of Supreme Court Cases of which the following are just a short sample: *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991); *Fogerty v. Fantasy, Inc.*, 510 U.S. 517 (1994); *Harper & Row Publishers*, 471 U.S. at 546; *Sony Corp.*, 464 U.S. at 417 (1984); *Mazer v. Stein*, 347 U.S. 201 (1954).

public domain through the device of the limited term. For instance, a dispute quietly brewed for years over whether the “prevailing party” who might recover attorneys’ fees in an infringement action could be a successful defendant as well as a successful plaintiff. In deciding that such party-neutrality was the rule, the Court rejected the argument that encouraging plaintiffs to police their copyrights was a deciding factor. It was just as important, said the Court, that defendants be encouraged to police the public domain by awarding them attorneys’ fees when they successfully did so. “Because copyright law ultimately serves the purpose of enriching the general public through access to creative works, it is peculiarly important that the boundaries of copyright law be demarcated as clearly as possible.”¹¹⁰ Limiting the copyright monopoly was at least as important as protecting it, the Court decided: “We have often recognized the monopoly privileges that Congress has authorized, while “intended to motivate the creative activity of authors and inventors by the provision of a special reward,” are limited in nature and must ultimately serve the public good.”¹¹¹ This was also, of course, the basis for *Feist Publications*, in which the court, requiring more originality than the mere alphabetization found in telephone directories, explained that the Constitutional clause demanded it, saying,

The primary objective of copyright is not to reward the labor of authors, but “to promote the Progress of Science and useful Arts.” To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.¹¹²

The constitutional point of all this, it seems, is that the Copyright Clause erects a fence which the Court polices from both sides, not just one. From the earliest days of the republic, increasing the public domain was recognized as the justificatory purpose of the copyright and patent clause. “[I]t will promote the progress of science and the useful arts, and admit the people at large, after a short interval, to the full possession and enjoyment of all writings and inventions without restraint.”¹¹³

It is true, however, that, as is inevitably the case with constitutional cases, especially Supreme Court opinions, the reasons are not always inescapably singular and identifiable. In a patent case, *Bonito Boats v. Thunder Craft Boats, Inc.*,¹¹⁴ the Supreme Court held that, under the doctrine of preemption, the state of Florida could not protect the design of

110. *Fogerty*, 510 U.S. at 527.

111. *Id.* at 526 (citation omitted).

112. *Feist*, 499 U.S. at 349-50 (citation omitted).

113. Story, *supra* note 3, § 502, at 402.

114. 489 U.S. 141, 146 (1989).

boat hulls from imitation by others when those designs did not qualify, for one reason or another, for federal patent protection. The reasons for this preemption in *Bonito Boats* cannot be said to be exclusively constitutional.¹¹⁵ It is difficult to know if the Court was intentionally vague, for the language sometimes points to the constitutional clause and sometimes to the statute. But just as it is impossible to exclude the statute as a basis for the decision, it is impossible to deny that *Bonito Boats* found that useful designs cannot be protected outside the patent law because the constitutional clause, not just the statute, requires that the public domain be free of all monopolies over useful arts unless they satisfy the patent scheme—something which includes both constitution and statute.

That there are constitutional limits on the power of Congress to legislate in the field of copyright is thus beyond question; that the Court has the power and the will to sanction legislation that goes beyond those limits seems similarly certain. In *Harper & Row Publishers v. Nation Enterprises*,¹¹⁶ the Court denied that a magazine's pre-emptive publication of portions of former President Ford's unpublished memoirs constituted a fair use. However, in so holding, the Court maintained the importance of preserving the public domain and that the ideas, if not the exact words, of the Ford memoirs would remain accessible. The Court specifically pointed to the limits of the public domain, and the constitutional clause as its source, as a "limit" on the copyright power:

The "promotion of science and the useful arts" requires this limit on the scope of an author's control. Were an author able to prevent subsequent authors from using concepts, ideas, or facts contained in his or her work, the creative process would wither and scholars would be forced into unproductive replication of the research of their predecessors.¹¹⁷

Similarly, in *Feist*, holding that telephone directories and other fact-based works are not copyrightable, the Supreme Court relied on the function served by the public domain as copyright's *raison d'être*. "The same is true of all facts—scientific, historical, biographical, and news of the day. 'They may not be copyrighted and are part of the public domain available to every person.'"¹¹⁸ Indeed, the Court then went on to reiterate

115. The exact basis of *Bonito Boats* is, according to one author, "baffling" to analysts. Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause and the First Amendment*, 17 CARDOZO ARTS & ENT. L.J. 47, 63-65 (1999).

116. 471 U.S. 539, 546 (1985).

117. *Id.* at 582 (citation omitted).

118. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991) (quoting *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1369 (5th Cir. 1981)).

the central limiting role of the public domain,¹¹⁹ as well as its justifying function, concluding: "This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art."¹²⁰

The decisive point is that for two centuries the Supreme Court has recognized time and time again that the Constitutional clause limits both textually and functionally what Congress can do, and that the promotion-of-progress phrase is intended to augment the public domain. The Court seems to believe that safeguarding the public domain is not only key, but that it is a value higher than all other copyright and patent interests.¹²¹ In the case of the Bono Law, the decisive text is that legislation, to be constitutional, must "promote" the future production of copyrightable works of authorship. Retrospective term extension can have no rational connection with an augmentation of the public domain.

VII. CONGRESS CANNOT USE OTHER POWERS TO DO THAT WHICH THE COPYRIGHT CLAUSE FORBIDS: "LIVING IN A HOUSE DIVIDED"¹²²

Simple common sense tells us, of course, that if the Commerce Clause can accomplish that which the Copyright Clause prohibits, then those prohibitions will have been rendered nugatory, something to which basic rules of statutory construction are sensibly opposed. All of the Supreme Court cases, as well, that have found limits upon the copyright power in the Copyright Clause itself would similarly be rendered nugatory and useless. Another way to put this is to understand that, although we have no case explicitly holding that the Commerce Clause cannot overcome the limits of the Copyright Clause, all of the cases that have labored to find those limits¹²³ implicitly hold those limits not so illusory as to disappear by the simple repetition of a legislative mantra raising the Commerce Clause.

But it is not just common sense that tells us this. Equally persuasive is *Railway Labor Executives Ass'n v. Gibbons*,¹²⁴ in which the Court held

119. *Id.*

120. *Id.* at 350.

121. As *Lear v. Adkins*, 395 U.S. 653, 670 (1969) demonstrates, the Supreme Court values the public domain above all other intellectual property values, so much so that it is willing to sacrifice the interests of contract law before it.

122. SONNY & CHER, *Living in a House Divided*, on ALL I EVER NEED: THE KAPP/MCA ANTHOLOGY (UNI/MCA 1996).

123. See *supra* notes 70-88 (discussing the Supreme Court cases on the limits of the Copyright Clause). For a broad-ranging explication of the position that the Commerce Clause cannot abnegate the limits of the Constitutional Copyright Clause, see Paul J. Heald & Suzanna Sherry, *Implied Constitutional Limits on Congressional Power: Construing the Commerce Power in Light of the Intellectual Property Clause*, U. ILL. L. REV. (Forthcoming).

124. 455 U.S. 457, 471 (1982). Cf. *Dowling v. United States*, 473 U.S. 207 (1985) (reasoning

that Congress could not enact bankruptcy laws pursuant to the Commerce Clause when those laws conflicted with the clear directives of the constitutional bankruptcy power. The Constitutional Bankruptcy Clause¹²⁵ authorizes Congress to enact “uniform” bankruptcy laws. In *Railway Labor*, Congress had enacted special legislation, the Rock Island Railroad Transition and Employee Assistance Act (RITA), essentially a “private bill,”¹²⁶ designed to protect the benefits of the employees of one bankrupt railroad from creditors of the bankrupt. Applying to no other businesses and no other economic sectors, RITA violated the uniformity requirement of the Bankruptcy Clause. The Court found RITA to be an unconstitutional exercise of that Clause and rejected the notion that it could avoid its limit by resort to the Commerce Clause, saying:

Unlike the Commerce Clause, the Bankruptcy Clause itself contains an affirmative limitation or restriction upon Congress' power: bankruptcy laws must be uniform throughout the United States. Such uniformity in the applicability of legislation 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.¹²⁷

Furthermore, it is one thing to suggest that Congress can, pursuant to other enumerated powers, create new rights or remedies either which it might also do under the copyright clause, or which are not anticipated by the copyright clause, and another to suggest that Congress can do through other powers—for instance the commerce power or the necessary and

that implying different criminal punishments for copyright violations under the National Stolen Property Act, pursuant to the Commerce Clause, would undermine the carefully structured remedies for copyright infringement).

125. U.S. CONST. art. I, § 8, cl. 4.

126. *Railway Labor*, 455 U.S. at 471. “RITA is nothing more than a private bill such as those Congress frequently enacts under its authority to spend money.” *Id.*

127. *Id.* at 468-69 (citations omitted). It is instructive to substitute the word “copyright” for “bankruptcy” and to alter the limitations so as to be appropriate for copyright, and see that the Court’s words become:

Unlike the Commerce Clause, the Copyright Clause itself contains an affirmative limitation or restriction upon Congress' power: it must promote future works. Such a specific goal is not required by the Commerce Clause. Thus, if we were to hold that Congress had the power to enact retrospectively extended copyright laws pursuant to the Commerce Clause, we would eradicate from the Constitution a limitation on the power of Congress to enact copyright laws.

Id.

proper clause—that which is forbidden by the copyright clause.¹²⁸ Thus, in *Authors League of America, Inc. v. Association of America Publishers*, the Second Circuit's holding that Congressional denial of copyright protection to certain foreign works was an appropriate exercise of the Commerce Power is not at all inconsistent with the rule that the Commerce Power cannot be used to overcome specific limits in the Constitution, such as those of the Copyright Clause.¹²⁹ In *Authors League*, there was no limit being violated. The Copyright Clause is silent, and completely discretionary, as to whether specific works must be protected. Because the Copyright Clause does not compel Congress to grant copyright protection, its failure to do so with regard to some works does not violate any part of the Copyright Clause.

The bottom line, however, seems to be indisputable. Legislation that violates the constitutional limitations of the copyright clause cannot be justified by the Commerce Clause. To allow that would render the Copyright Clause nugatory.

VIII. THE "PUBLIC GOOD" OR "PUBLIC BENEFIT" IS A LIMIT UPON, NOT A SOURCE OF, COPYRIGHT POWER: "IT'S THE LITTLE THINGS"¹³⁰

It is not surprising that supporters of term extension, in what appears to be a last-gasp effort at justification, have claimed that extension is constitutional as long as there is a public benefit. Clearly, though, if such a basis existed, it would entirely gut the constitutional phrase of any limiting power. Anything that Congress might do would be definably in the public interest, enacted as it is by the public's representatives, and the "rational purpose" test would undoubtedly uphold such legislation.¹³¹ But even a cursory view of the case law shows that the Supreme Court has always used the concept of the public good as a limit, not as a source of congressional power.

Thus, the Register's use of the terms "public good" and "public benefits" as a basis for copyright protection is troubling when, as a constitutional matter, it is strictly a basis for general limits upon such

128. See Pollack, *supra* note 115, at 86 *et seq.* (arguing that general powers, such as the Commerce Clause, are insufficient to overcome express limitations upon Article I powers such as the copyright clause, and drawing a parallel to the bankruptcy power and the Supreme Court's decision in *Railway Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457, 471 (1982)).

129. 790 F.2d 220, 224 (2d Cir. 1986).

130. SONNY & CHER, *It's the Little Things*, IT'S THE LITTLE THINGS (ATCO 1966).

131. Certainly, the most characteristic feature of the rational purpose test is that it allows virtually unrestrained Congressional discretion: "[I]f all the legislative cross-purposes are sensitively taken into account the classification in issue is bound to relate at least 'rationally' (in fact quite closely) to them. Legislatures do not act for no reason (though they sometimes do act for unconstitutional reasons)." ELY, *supra* note 12, at 251 n.69 (1980).

protection. There is no such term nor even such an implied argument in the Copyright clause. Yet the argument was advanced to Congress that the copyright term could be extended because of such goods and benefits. Aside from the public benefit or good provided by the production of literary and other copyrightable works by authors, however, there is no available legal or historical basis for a constitutionally cognizable benefit independent of such authors' labors.¹³² While it is true that, during the nineteenth century, the copyright statute was undoubtedly harnessed to encourage the development of a domestic publishing industry, this was accomplished through specific features of the copyright statute that had nothing to do with, and perhaps departed from, the focus of the constitutional clause on "authors," who, alone, are mentioned as recipients of copyright's benefits. As shown below, the use of the term "public good" or "public interest" as a basis for protection instead of as a constitutional limit upon protection completely upends copyright law and flies in the face of constitutional adjudication.

Thus, it may be beneficial that publishers receive a greater stream of income (or it may be beneficial if they do not—it would not matter, since as long as Congress were to enact a law based on either of these bases, such a reason would be constitutionally immune from judicial scrutiny under the "rational basis" test¹³³ if the public benefit is the measure of copyright legislation). But since the test of copyright legitimacy is whether a measure promotes progress by creating new works, copyright extension based solely on a nebulous "public benefit" does not pass constitutional muster. To hold otherwise, of course, would require the Supreme Court to abnegate all constitutional oversight over a substantial and growing body of copyright legislation. One of the most extreme examples of this threat of abnegation of the copyright clause—virtually into legal nothingness—is, ironically, the statement on behalf of sixty law professors submitted in opposition to the Bono Law which not only noted but relied in large part upon the surely unenforceable notion that the "public benefit" provides at least one measure and source of the copyright power.¹³⁴

132. Professor Hamilton, for instance, writes of "making copyright law subservient to the public good," but in this sense the "public good" operates as a limit, rather than extension, on copyright term. That is, she considers why, if authors are the focus of copyright, they nevertheless lose their monopolies after a term of years. This is because their interest in receiving royalties, perhaps perpetually, is "subservient to the public good." This "public good" or "public benefit" notion is the basis for a justificatory theory, not for an independent source of power. Far from suggesting that the public good might support copyright protection, Professor Hamilton suggests that it is a reason for terminating it. Marci A. Hamilton, "The Historical and Philosophical Underpinnings of the Copyright Clause," Occasional Papers in Intellectual Property, No. 5, Benjamin Cardozo School of Law, Yeshiva University. *But see* Gifford, *supra* note 5 (echoing the troubling strategy adopted by the Statement of 60 law professors).

133. *See* Ely, *supra* note 12, at 181.

134. *See* 1995 Hearing, *supra* note 5, at 78 (statement Dennis S. Karjala).

An example of how constitutionally destructive it would be to pervert the public-benefits rationale from a limit into a source of power is the justification for term extension based on "harmonization." Extension was urged in order to harmonize United States copyright law with European laws. Harmonization is certainly rational, and if the public-benefit rationale were a constitutional source of power, then Congress' intent to harmonize by retrospectively extending the copyright term would be constitutionally valid. But so, of course, would virtually anything Congress might do short of the bizarrely irrational—hardly a likelihood, since "[l]egislatures do not act for no reason."¹³⁵ This is, of course, why the rational basis test is not really a test but, rather, a jurisprudential apologia—it justifies any conceivable Congressional action. Allowing public benefits or goods to serve as a basis of copyright legislation would run the same risk.

For instance, shortly after *Feist Publications* held that purely fact compilations devoid of further expressive organization were unconstitutional, the computer industry lobbied for adoption of a new law that would protect databases. Congress did not enact the law, however. In response the industry lobbied, instead, the World Intellectual Property Organization¹³⁶ which did adopt (and subsequently tabled) a draft database treaty requiring member states to protect databases. The European Union also adopted a directive, some argue as a result of *Feist*, and the industry then returned to Congress armed with the treaty provisions and the EU directive, urging Congress to pass the database law in order to comply, or harmonize, our copyright regime with what the industry claimed was now a world standard.¹³⁷ If the public-benefit rationale were actually a constitutional source of Congressional power, such a database law, harmonized with an international treaty—no matter how suspicious its genesis as a backdoor route to evading constitutional limits—would become constitutional, despite the Supreme Court's decision in *Feist Publications* that it violated the copyright clause.

Amazingly, however, it was not only supporters who cited the "public interest" as a basis for copyright terms. As already mentioned, the group of sixty law professors, all critics of term extension, with an argument that quite possibly laid the seed for the ultimate District Court defeat of the

135. ELY, *supra* note 12, at 251 n.69.

136. Jack E. Brown, *Proposed International Protection of Electronic Databases*, 27 CUMB. L. REV. 17, 23 (1996-1997). "At the same time, representatives of the United States presented to the World Intellectual Property Organization (WIPO) a proposal that included substantive draft provisions of a treaty calling for a harmonious approach to a sui generis protection of databases, supplementing whatever protection might be available by copyright or otherwise." *Id.*

137. See Pollack, *supra* note 115, at 86 *et seq.*; see also Fred H. Cate, *Introduction: Sovereignty and the Globalization of Intellectual Property*, 6 IND. J. GLOBAL LEG. STUD. 11, 14 (1998). The story is told succinctly in Pamela Samuelson, *The Digital Agenda of the World Intellectual Property Organization*, 37 VA. J. INT'L L. 369, 373-74 (1997).

challenge in *Eldred v. Reno*, also used the notion of the public benefit or good to argue that term extension had no constitutional support.¹³⁸ As was also true of the Copyright Register's statement in support of extension, these critics, perhaps unwittingly, confused retrospective and prospective extension, arguing somewhat cryptically—in the space of two consecutive sentences—that retrospective extension somehow violates the “limited times” requirement; an argument similar to that of the Register. But even more dramatically, they suggested that retrospective extension might be proper if a “public benefit” could be shown, implying that the “public benefit” is a source, as opposed to a limit, on copyright legislation.

Some believe that special constitutional problems arise from an extension of the period of protection for works already under copyright, because it recaptures from the public domain works that should be freely available under the “bargain” made at the time the work was created and offers no countervailing public benefit. They argue that the constitutional term “limited times” must be interpreted in terms of the constitutional goal to promote the progress of science and the useful arts.¹³⁹

Even as a footnote, that argument is surely misguided. Tellingly, neither the proponents nor the critics identified a constitutional source for the public benefit argument. Instead, they cited cases which uniformly used the argument to explain but not to support or augment the copyright power.¹⁴⁰

IX. PATENT LAW: “THE BEAT GOES ON”¹⁴¹

It is important to distinguish between patent and copyright. Even the Court has occasionally confused the two, and individual justices have erred even more dramatically.¹⁴² But patent and copyright do stem from

138. See 1995 Hearing, *supra* note 5, at 148.

139. See *id.* at 148 n.23.

140. See *id.* (citing *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (“The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved.”); *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932) (“[t]he sole interest of the United States and the primary object in conferring the [copyright] monopoly lie in the general benefits derived by the public from the labors of authors”). Neither opinion uses the exact term “public interest,” but instead they explain that the limits of the copyright power are designed to secure a certain benefit.

141. SONNY & CHER, *The Beat Goes On*, on IN CASE YOU'RE IN LOVE (ATCO 1967).

142. See *supra*, note 62 and accompanying text. Justice Douglas' ham-handed confusion of patent and copyright in *Lee v. Runge* reappeared slightly altered in Justice O'Connor's mistaken

the same clause, and are qualified by the same functional language. Both are meant to "promote" their respective fields—copyright for the sciences and patent for the useful arts. Both are for limited times—copyright for far longer, historically, than patent, and for good reasons of purpose.¹⁴³ Thus, the cases which address these common functions are fairly, if not in fact completely, interchangeable. The Court has observed their parallel policies and functions. "To forbid copying would interfere with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."¹⁴⁴ And the Court has been assertive in identifying the limiting import of the patent clause, just as it has for the copyright clause.

As we have noted in the past, the Clause contains both a grant of power and certain limitations upon the exercise of that power. Congress may not create patent monopolies of unlimited duration, nor may it "authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available."¹⁴⁵

The most obvious patent cases from which to gain an understanding of the common purposes which underlie both copyright and patent would seem to be *Lear, Inc. v. Adkins*,¹⁴⁶ and *Graham v. John Deere*.¹⁴⁷ Perhaps the next most obvious case to teach those lessons would be *Brenner v. Manson*,¹⁴⁸ although *Manson* relies, to a large extent, upon statutory, rather than constitutional, grounds.

employment of the patent requirement of obviousness in *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 341 (1991) ("Rural's selection of listings—subscribers' names, towns, and telephone numbers—could not be more obvious . . .").

143. The difference between patent and copyright, though they are governed by some common terms in the Patent and Copyright Clause, yields different results when those terms are applied. Thus, the limited times of the term governing copyrights which are neither useful nor necessarily profitable, are nearly five times as long as those for patent. Part of the reason is that patents, being useful, may well turn a more immediate profit. Another is that the interference with progress is far less with a nonuseful item, such as an expressive work, than for a useful one, as a technological innovation whose fruits may be necessary as building blocks to further progress. Remember, too, that the progress of the "useful Arts" is measured by finitely useful gains whereas the progress of Science is a much more indefinite base of learning. This difference, while important, means that the promotion-of-progress phrase will be applied differently for copyright than for patents. It does not, however, mean that it will not be applied at all, any more than the "limited times" phrase would be inapplicable, as opposed to differently applicable, to copyright or patent law.

144. *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964) (emphasis added).

145. *Bonito Boats v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) (citation omitted).

146. 395 U.S. 653 (1969).

147. 383 U.S. 1, 6 (1966).

148. 383 U.S. 519 (1966).

In *Lear*, the Court considered whether a patent licensee could contest the validity of the subject patent of his license which implicitly forbade such contest.¹⁴⁹ Traditionally, the doctrine of licensee estoppel barred such claims. Licensee estoppel held that considerations of contract law trumped those of patent law which would otherwise encourage patent contests even though patent contests satisfy the interest of invalidating improvidently granted patents. Licensee estoppel, if upheld by the Supreme Court, would forbid such patent contests because "a licensee should not be permitted to enjoy the benefit afforded by the agreement while simultaneously urging that the patent which forms the basis of the agreement is void."¹⁵⁰ The *Lear* court, however, balancing the profoundly important—socially, historically, economically, and jurisprudentially—principles of contract law against the interest of patent law in freeing technology that should be in the public domain from illegitimate patent claims, decided that patent policy governs, saying "enforcing this contractual provision would undermine the strong federal policy favoring the full and free use of ideas in the public domain."¹⁵¹ Perhaps as important as the substantive holding, was *Lear*'s procedural decision to apply its rejection of licensee estoppel retrospectively. Such retrospective application could only, one might fairly speculate, be justified by important reasons of high, say constitutional, import. And, indeed the Court seemed to so see it: "Moreover, the public's interest in the elimination of specious patents would be significantly prejudiced if the active effect of today's decision were limited in any way."¹⁵² Thus unsurprisingly, in patents as in copyright, a defining and propelling value is that protection of the public domain—which, of course, is nothing but an alternate articulation of the promotion-of-progress phrase—from the patent monopoly, even when to do so requires subordinating one of the most profoundly essential bodies of doctrine known to the legal system, that of contract law itself.

In *Graham v. John Deere*, the Supreme Court considered whether the standard of patentability had been altered by the adoption of the 1952 Patent Act. The patent requirement of invention had long been measured by a judicial doctrine of inventiveness, dating back to 1850.¹⁵³ The 1952 Patent Act had, instead, imposed a statutory standard called "nonobviousness."¹⁵⁴ The question in *John Deere* was whether the 1952 Act had changed the law or had simply codified the existing judicial

149. *Lear*, 395 U.S. at 656 (quoting *Adkins v. Lear, Inc.*, 435 P.2d 321, 325-26 (Cal. 1967)).

150. *Id.* at 656.

151. *Id.* at 674.

152. *Id.* at 674 n.19.

153. See *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1850).

154. 35 U.S.C.A. § 103 (West 2000).

doctrine.¹⁵⁵ Deciding that the standard of patentability had not been altered because it was of constitutional origin, the Court said:

At the outset it must be remembered that the federal patent power stems from a specific constitutional provision The clause is both a grant of power and a limitation. This qualified authority . . . *is limited to the promotion of advances* The Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose. Nor may it enlarge the patent monopoly without regard to the innovation, advancement or social benefit gained thereby. [T]hings which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must "promote the Progress of . . . useful Arts." This is the standard expressed in the Constitution and it may not be ignored.¹⁵⁶

It is important to understand that the Supreme Court, in this seminal case of twentieth-century patent law, enumerated the elements essential for an understanding of the constitutional clause. First, it serves as an enforceable limit upon Congressional action.¹⁵⁷ Second, a major and perhaps defining source of that limit is the promotion-of-progress phrase, which all Congressional action must satisfy to be valid. Third, in order to be justified by the constitutional clause, it is a requisite that the subject matter of a patent (or, necessarily a copyright) add to the sum of useful knowledge (or, in the case of copyright, of "science," or, in modern terms, expressive knowledge).

Having surveyed the reach and historical roots of the constitutional power, the Court proceeded to its underlying policy, relying heavily on the views of Jefferson—as both Founding Father and author of the first Patent Statute of 1793.¹⁵⁸ The Court observed,

155. *Graham v. John Deere Co.*, 383 U.S. 1, 3 (1966).

156. *Id.* at 5-6 (citation omitted) (emphasis added).

157. *See id.* at 6. With no other reason but to emphasize the constraining nature of the clause upon Congressional latitude, the Court reiterated this, saying:

Within the limits of the constitutional grant, the Congress may, of course, implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim Within the scope established by the Constitution, Congress may set out conditions and tests for patentability. It is the duty of the . . . courts in the administration of the patent system to give effect to the constitutional standard by appropriate application, in each case, of the statutory scheme of the Congress.

Id. (citations omitted).

158. *Id.* at 9.

The patent monopoly was not designed to secure to the inventor his natural right in his discoveries. Rather, it was a reward, an inducement, to bring forth new knowledge Only inventions and discoveries which furthered human knowledge, and were new and useful, justified the special inducement of a limited private monopoly.¹⁵⁹

The Court added that the meaning of "invention," or of "nonobviousness" as codified in the 1952 Act, was an issue of historical proportions dating back to Jefferson's time. "The inherent problem was to develop some means of weeding out those inventions which would not be disclosed or devised but for the inducement of a patent."¹⁶⁰ This, of course, is the same issue as in copyright, going to the very core of the incentive theory: if the promotion-of-progress phrase is to be given effect, then copyright can only apply to those works which "would not be disclosed or devised but for the inducement of a [copyright]."¹⁶¹ The relation between the incentive requirement of the constitutional clause and the promotion-of-progress phrase is therefore unsurprisingly intimate.

The Supreme Court has evidenced an acute concern with the promotion-of-progress phrase and the concomitant need to protect the public domain from inappropriate incursions by patent. Most recently, in *Pfaff v. Wells Electrics, Inc.*,¹⁶² the Court applied the doctrine of "statutory bar,"¹⁶³ which renders a patent invalid if the inventor offers his invention for sale more than one year prior to applying for a patent. Although statutory bar had long been understood to be based on a policy aimed at discouraging inventors from attempting to extend illegitimately the patent term (by attempting to sell or license the invention before even applying for a patent and thus far before the patent term even begins to run),¹⁶⁴ the

159. *Id.*

160. *Id.* at 11.

161. *Id.* Once again, the particular application of this doctrine to copyright differs from that of patent, where the relation is generally treated as one of but-for cause. Because patents are useful and, in effect, necessary, the Court is far more mindful of the need to exclude all innovations except those that would not be considered "obvious" to the practitioner of ordinary skill in the particular art and would not be developed were it not for the patentee—in other words, granting patents only to true inventions. *See id.* at 1. In copyright, the relation seems not to be a but-for causal one but, rather, the kind of substantial factor analysis employed in tort law, asking whether the copyright incentive could have been a factor in the author's creation. *See Banks v. Manchester*, 128 U.S. 244, 253 (1888); *Callaghan v. Myers*, 128 U.S. 617 (1888); *see also International News Serv. v. Associated Press*, 248 U.S. 215 (1918). Viewed in that way, prospective term extension passes constitutional muster, since it is impossible to deny the possibility that the author created because of the copyright reward. Retrospective extension, on the other hand, fails because it is impossible for an extension enacted after the work was produced to have been a factor in its creation.

162. 525 U.S. 55, 63 (1999).

163. *See* 17 U.S.C.A. § 102(b) (West 2000).

164. *See Elizabeth v. Pavement Co.*, 97 U.S. 126 (1878). "It is sometimes said that an inventor

Court emphasized as well a constitutional basis upon which to rest its decision: that once the inventor discloses the invention to the public by offering it for sale, its resulting entry into the public domain should not be reversed by the patent law.¹⁶⁵

A . . . reluctance to allow an inventor to remove existing knowledge from public use undergirds the on sale bar The patent laws therefore seek both to protect the public's right to retain knowledge already in the public domain and the inventor's right to control whether and when he may patent his invention.¹⁶⁶

So, too, in patent law, does the demand that patents promote progress entail a strict watch over the public domain. In *Bonito Boats*,¹⁶⁷ the Court considered whether a state can grant patent-like protection to boat hulls, absent the requirements of invention that the federal patent act requires. The Court found that the area outside the patent clause was preempted by the Federal monopoly. The Patent and Copyright Clause, said the Court, not only authorized federal protection within its ambit, to the extent Congress chooses to offer such protection, but it also affirmatively defines the public domain in that area outside the clause's protective ambit. In *Bonito Boats*, the issue was whether the states can enter that area, but the holding of the Court would equally apply to an attempt by Congress to invade the area reserved by the Clause for the public domain.¹⁶⁸

In *Bonito Boats* it was clear that states cannot grant patent protection to unpatentable products—primarily because even the Federal Government cannot do that.¹⁶⁹ The preemption in *Bonito Boats* was not express statutory preemption, based on legislation upon which state action intruded. Instead, it was based on something akin to “conflict

acquires an undue advantage over the public by delaying to take out a patent, inasmuch as he thereby preserves the monopoly to himself for a longer period than is allowed by the policy of the law” *Id.*

165. See *Pfaff*, 525 U.S. at 64-65.

166. *Id.*

167. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 141 (1989).

168. In fact, it appears that Congress has attempted to occupy this forbidden area, with the enactment of the Vessel Hull Design Protection Act, 17 U.S.C. § 1301, which was expressly passed to reverse the holding of *Bonito Boats*. To the extent that new statute attempts to grant patent-like protection to unpatentable products, it would seem to be clearly unconstitutional. The Court, of course, has not had the opportunity yet to consider the statute and Congress, perhaps sensing the constitutional infirmity of the provision, only provisionally authorized protection, for a period of four years during which the Patent Office and the Library of Congress are to study the matter. See Act of Oct. 28, 1998, Pub. L. No. 105-304, Title V, § 504, 112 Stat. 2917; Act of Nov. 29, 1999, Pub. L. No. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536.

169. *Bonito Boats*, 489 U.S. at 167-68.

preemption”¹⁷⁰ in which states intrude into areas which are mandated to be free of Federal intrusion and, by extension, state intrusion as well. But if this is so, one must ask what mandates this preemption, the answer to which is quite obviously the promotion-of-progress phrase, the concomitant interest in safeguarding the public domain, as well as perhaps the incentive or inducement function at issue in *John Deere*.

Similarly, in *Brenner v. Manson*¹⁷¹ it was clear that Congress could not grant patents to products which did not demonstrate the requisite utility. Justice Fortas’ “hunting license” observation succinctly captured the role of the public domain—it is public by virtue of its freedom from private claims—to the constitutional clause with respect to copyright as well as to patent. The significance of the public domain to the constitutional clause is key; in a word, it is vital. First of all, the Court has long said, without exception, that the goal of the clause is not to reward inventors or authors, but to promote progress by expanding the public domain.¹⁷² It is the public domain, not individual authors or inventors, which is the true object of the constitutional clause. And, although it seems intuitive to believe that copyright somehow exists to reward “deserving” authors, the Supreme Court seems to have decisively rejected this intuition.¹⁷³ Understanding that, it is easier to understand why the Court has so jealously guarded the public domain from encroachment by legislation that does not further, nor is justified by, the ultimate goals of the constitutional clause. The lessons of both patent and copyright cases are, in this respect, coextensive.

170. See Caleb Nelson, *Preemption*, 86 VA. L. REV. 225, 230 (2000).

171. 383 U.S. 519 (1966).

172. See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991). In a way, the promotion-of-progress phrase might be said to be the most important part of the Copyright clause, the touchstone of copyright’s purpose, much as originality is the touchstone of copyrightability itself. “The primary objective of copyright is not to reward the labor of authors, but ‘to promote the Progress of Science . . .’” *Id.*

173. One author claims that the Supreme Court has somehow vacillated between, or at least has offered, two competing theories. See Stewart E. Sterk, *Rhetoric and Reality in Copyright Law*, 94 MICH. L. REV. 1197, 1197 n.2 (1996). However, this seems clearly wrong. All that Sterk has to offer to buttress his theory is a somewhat cryptic phrase: “Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.” *Id.* (quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954)). Even if this phrase means what Sterk claims, the Court’s later statement in *Feist*, 499 U.S. at 340, unambiguously rejects the suggestion that there is anything but an incentive, and instrumental, basis for the copyright clause.

X. THE LOTTERY ARGUMENT.¹⁷⁴ "GOOD TIMES"¹⁷⁵

At a certain, very low level, there is a logic—though not necessarily a rational one—to the notion that retrospective extension can promote progress. This logic would hold that, though retrospective extension in itself cannot act as an incentive to already created works, the knowledge that retrospective extensions historically occur is an incentive to a potential author considering whether to create a writing.¹⁷⁶ In other words, the incentive provided is a result of a "bet" the author makes that Congress will enact another retrospective extension. This bet is, by any standard, a bizarrely rarified long shot because its present value is discounted by several truly huge factors. First, of course, it is a true bet, based on events which, though they occur, have only occurred a handful of times in 200 years. Second, the present value of a future extension—which, at this point would have to occur more than seventy years after the author's death (or more than ninety-five years in the future in the case of a work-for-hire)—is of the order of a tenth of a percent in its totality of future revenue.¹⁷⁷ Third, the potential author cannot be sure that the extension will occur during the period of his term and thus is betting that Congress will act before his term expires.¹⁷⁸ Fourth and finally, the author must be one, in one commentator's words, who has "extreme confidence in his own success,"¹⁷⁹ because an extension would offer nothing of value—even heavily discounted value—unless the work remained, or even more remotely suddenly became, popular almost a century later.

174. My use of this term has apparently been at least partially anticipated in an unpublished paper by a third author proposing what Merges and Reynolds characterize as the "home run" theory of invention. Merges & Reynolds, *supra* note 5, at 59 n.55.

175. SONNY & CHER, *Good Times*, on SONNY & CHER ORIGINAL FILM SOUNDTRACK (ATCO 1967).

176. "Unless there is reason to believe that retroactivity was the result of special circumstances and any future extensions will not be retrospective, potential producers of intellectual and artistic products should assign some weight to the possibility that future extensions also will be retrospective." BARD & KURLANTZICK, *supra* note 5, at 182.

177. These are the figures upon which all commentators, proponents and opponents of extension, do not seem to disagree. See Garon, *supra* note 5, at 518 n.134; see also Sterk, *supra* note 173, at 1223 n.115 (estimating, based on a more profitable 50 not 75 years delay, something less than one percent).

178. Bard and Kurlantzick observe in this scenario, "Thus, the incentive effect of the possible provision of additional copyright protection for a period so far into the future will be minuscule." *Supra* note 5, at 185 n.253.

179. Sterk, *supra* note 173, at 1223.

XI. CONSTITUTIONALITY, SEVERABILITY AND JUDICIAL REVIEW: "I CAN SEE CLEARLY NOW"¹⁸⁰

If the retrospective extensions of the Bono Law were found unconstitutional, a threshold question would be whether to invalidate the entire Law or just its retrospective portions. But the possibility of gaining unconstitutional retrospective extensions through the guise of prospective extensions has served to pervert the normal democratic processes.¹⁸¹ It would surely be a failure of the democratic process if the result were to be a law that no one wanted. If, in fact, none of the Congressional witnesses truly cared about rewards that will only start to accrue seventy-five years from now, Congress will have massively erred. If all that concerned the witnesses and lobbyists was the immediate extra twenty years that, for instance, the otherwise-soon-to-expire Walt Disney characters would enjoy, the entire legislative process was stood on its head.

It is surely possible that some future Congress will conclude that prospective extensions of the copyright terms are appropriate (though, absent the hidden agenda of retrospective extensions it is quite possible that shortening terms will seem preferable to publishers). But Congress has not yet had the opportunity to consider that separately legitimate question. As it is, the Bono Law was borne out of a process that was perverted from its democratic foundations. Following the normal rules of severability would—and certainly should—almost certainly lead the Court to invalidate the legislation as a whole, allowing copyright extension to return to Congress for a fresh, and more importantly, uncontaminated consideration.

It is almost notoriously understood that, with a limited caseload of 100 or less cases each year, the Court does not simply decide cases, or resolve simple legal differences. The Court is an active partner in a system of separated powers, and, within the context of a case or controversy judicial system, examines policy in that heightened light, choosing and deciding cases only when their impact will not only go beyond the case at hand, but

180. SONNY & CHER, *I Can See Clearly Now*, SONNY & CHER, *ALL I EVER NEED*: THE KAPP/MCA ANTHOLOGY (MCA 1996).

181. While it is not central to the issue of constitutionality generally, it is nonetheless key to any remedy to understand that copyright term extension was clearly a product of industry lobbying. Professor Patry says that in the area of copyright, at least, "it is the private sector who will do the drafting." Patry, *A Personal Perspective*, *supra* note 5, at 145.

also advance the delicately balanced mechanisms of democracy.¹⁸² Aside perhaps from voting rights cases and campaign finance laws, there can be no better example of the sensitive mechanisms demanding Supreme Court review than the Bono Law. Copyright extension, to the extent retrospective extensions are allowed, sits in a netherworld of lobbying excess and constitutional scorn. Whether copyright will enjoy any constitutional oversight at all depends, essentially, upon whether the Court treats the issue as justiciable or not. Either as a result of the genius of our constitutional system, or sheer coincidence, the astonishing fact is that, while the limited-times phrase is quite possibly non-justiciable in all but its most extreme and unimaginable form (perpetuity), the promotion-of-progress phrase is not only easily justiciable but, in its justiciability, indirectly ensures that the limited terms phrase, though not justiciable, is policed by Congress itself.

John Hart Ely presented a theory of judicial review that seems to neatly embrace this issue. Ely's process-oriented theory of relatively limited judicial review starts with a premise that the Court should avoid substantive judgments, as they are generally within the exclusive province of the Legislature. In this case, of course, whether copyright should last ten or twenty years, one lifetime or two, is that kind of substantive judgment. Ely believes that courts should intervene when the process by which Congress acts is somehow defective. Under this "participation-oriented, representation-reinforcing approach to judicial review,"¹⁸³ the Court should refrain from substituting its judgment for that of Congress and "devote [itself] instead to policing the mechanisms by which the system seeks to ensure that our elected representatives will actually represent."¹⁸⁴ This theory, one critic says, allows the court to act when "the market is systematically malfunctioning" because their constitutional task "is to play an indispensable role in preserving the integrity of the political process."¹⁸⁵ Judicial review should only intervene in the legislative process when it is "malfunctioning" but even then, the job of the Court is not to decide the "substantive merits"; rather it is to restore the political process.¹⁸⁶ In a way, the structure of the constitutional Copyright Clause adopts Ely's

182. This is the "representation-reinforcing theory of judicial review" advanced by John Hart Ely, in which he advocates that "constitutional decisions are generally to be limited to policing the mechanisms of decision and distribution." ELY, *supra* note 12, at 181. I rely on Ely here not because I subscribe to his minimalist vision of judicial review but because if, in its very minimality, the Ely approach would find retrospective term extension unconstitutional, then any more intrusive theory would surely do so as well.

183. *Id.* at 87.

184. *Id.* at 485.

185. Alan Dershowitz, *John Hart Ely: Constitutional Scholar (A Skeptic's Perspective on Original Intent as Reinforced by the Writings of John Hart Ely)*, 40 STAN. L. REV. 360, 362-63 (1988).

186. ELY, *supra* note 12, at 187.

philosophy: if Congress is allowed to address only that which the Clause authorizes, it will, in all likelihood, not malfunction. If it is allowed to depart from the limits of the clause, the integrity of the political process, and of the resulting copyright regime, is threatened. All the Supreme Court need do is police that part of the Clause that is amenable to policing and that, if policed properly, will allow Congress to act within the less reviewable sphere without need of further judicial oversight.

To understand this it is necessary to recall the actual circumstances under which copyright term extension, and the Bono Law as a dramatically particular instance of it, was achieved. The Bono Law's twenty-year prospective copyright term extension was promoted solely to gain the retrospective extension. Not one witness, lobbyist, nor Congressperson, had an interest in extending the terms of future copyrights that will expire seventy-five years from their future publication, for instance. Their interest was to save those immensely profitable sources of present income which were about to be lost.

Because the very purpose of the Bono Law was to rescue those copyrights from imminent extinction, a finding that retrospective extension is unconstitutional would raise the perplexing question of what to do about the prospective extension which was enacted only as an unconsidered appendage to its retrospective body. Invalidity of retrospective extension would, in other words, raise issues of separability. It seems that prospective extension by itself cannot stand because of the Supreme Court's test of severability and the very conditions under which the Bono Law was adopted. In *Champlin Refining Co. v. Corporation Commission*, the Court first enunciated the modern severability test.¹⁸⁷ Under that test, the presence of a severability clause raises a presumption of severability so that, "[u]nless it is evident that the legislature would not have enacted those provisions which are within its power, independently of that which is not, the invalid part may be dropped if what is left is fully operative as a law."¹⁸⁸ The modern test for legislation accompanied by a severability clause is not much different and was articulated in *Alaska Airlines, Inc. v. Brock*,¹⁸⁹ "The final test, for legislative vetoes as well as for other provisions, is the traditional one: the unconstitutional provision must be severed unless the statute created in its absence is legislation that Congress would not have enacted."¹⁹⁰ The Bono law, however, has no such clause, and therefore benefits from no such presumption. "In the absence of a

187. 286 U.S. 210, 234 (1932), *overruled by* *Phillips Petroleum Co. v. Oklahoma*, 340 U.S. 190 (1950); *see also* Robert L. Stern, *Separability and Separability Clauses in the Supreme Court*, 51 HARV. L. REV. 76 (1937) (the "seminal work" on severability; John Copeland Nagle, *Severability*, 72 N.C.L. REV. 203, 204 (1993)).

188. *Champlin*, 286 U.S. at 234.

189. 480 U.S. 678, 685 (1987).

190. *Id.*

severability clause, however, Congress' silence is just that—silence—and does not raise a presumption against severability.”¹⁹¹ To say that the absence of a severability clause does not raise a presumption against severability, however, is not the same as saying that its absence is meaningless.¹⁹² Nonseverability clauses exist. Surely had Congress adamantly intended nonseverability, it could have included such a clause. It did not.

Thus, the question of severability is always one of legislative intent and in the absence of a severability clause the discovery of relevant legislative intent is fairly straightforward, for the ultimate goal of the severability analysis is generally the same: “The goal of the severability analysis embodied by *Alaska Airlines* has been to determine whether the legislature would have enacted the statutory provisions that survive after another part of the statute is held unconstitutional.”¹⁹³ Even if the test were altered as suggested by critics, it would seem the Bono Law would not survive a severability challenge.

If a statute contains a severability clause (or a nonseverability clause), such an explicit statement should be construed according to its plain meaning. If the statutory text is silent regarding severability, then the structure of the act, its purpose, and the legislative history should be consulted, although such sources are often inconclusive about severability.¹⁹⁴

In *Alaska Airlines*, the Court concluded, “There is abundant indication of a clear congressional intent of severability both in the language and structure of the Act and in its legislative history.”¹⁹⁵ But if the same analysis conducted in *Alaska Airlines* is applied to the Bono Law, a very different conclusion is reached. To determine severability, the Court must consult “the language and structure of the Act and . . . its legislative history.”¹⁹⁶ But the inquiry, under *Alaska Airlines* is not to examine whether the different parts can possibly exist independently, but rather to decide “whether the legislature would have enacted the statutory provisions.” The legislative history answers this fairly conclusively. Since all of the proponents of the bill primarily sought the retrospective extension that immediately extended their income by twenty years, to ask

191. *Id.* at 686.

192. See Israel E. Friedman, Comment, *Inseverability Clauses in Statutes*, 64 U. CHI. L. REV. 903 (1997) (arguing that while severability clauses rightly create a mere presumption, an inseverability clause should be faithfully respected).

193. Nagle, *supra* note 187, at 206.

194. *Id.*

195. *Alaska Airlines*, 480 U.S. at 687.

196. *Id.*

whether the bill would have been enacted without that provision is virtually to answer it. The answer is quite clearly no. The only witnesses who had any interest in the bill outside retrospective extension were the opponents, not proponents, of copyright extension.

Thus, the question is quite simple: would Congress have enacted prospective extension alone? *Alaska Airlines* asked exactly that kind of question and defined it as the test for severability. The Court showed that severability is to be therefore decided on the basis of the nature of the testimony offered at the Congressional hearings, and the identities and interests of the parties testifying.

The sponsors of the . . . bill . . . were optimistic that deregulation would lead to an increase in the number of jobs and that bill did not contain employee protections. But in response to union testimony . . . and the support for labor-protection provisions expressed by administration witnesses . . . provisions were added . . . With the inclusion of the labor provisions, the bill was viewed as "[striking] the proper balance between the legitimate demands of industry, consumers, labor, and management."¹⁹⁷

The Court went so far as to identify the specific testimony of the union witnesses who were responsible for reaching this "balance," citing that of Teamster President Frank E. Fitzsimmons and William G. Mahoney, counsel to several airline labor unions.¹⁹⁸

Applying the *Alaska Airlines* analysis, consideration of the sponsors' goals as well as those of the witnesses indicates that it was the retrospective, not the prospective, extension which was the heart, soul, and purpose of the Act. Applying *Alaska Airlines* to the Bono Law leads inescapably to the conclusion that its provisions are not severable because Congress simply would not have passed prospective extension without retrospective extension; realistically, of course, they would not even have been asked to consider prospective extension without enacting the only real goal of the bill: saving imminently terminating copyright terms. Without a severability clause, and with prospective and retrospective extension sharing so intimately the same goal, it seems that a finding of unconstitutionality should invalidate the entire statute.

This is consistent with the Ely analysis as well. Protecting the integrity of the legislative process in this case means allowing Congress the opportunity to consider prospective extension from the point of view of all interested parties. It is not that the parties may be different the second time

197. *Id.* at 691.

198. *Id.* at 692.

around; it is, rather that their testimony may be radically different. Will composer Richard Rogers' daughter care about prospective extension when retrospective extension is unavailable? Will Arnold Schoenberg's grandchildren or those of Jerome Kern? One may well ask whether ASCAP or AmSong will have an interest in extending copyright by another twenty years on behalf of its members who may have an equal or even greater interest in access to existing works free from copyright protections from which they can borrow without fear of infringement or royalty obligations. Even Disney might prefer—absent the possibility of immediate extension of imminently expiring copyrights of incredible value—to be able to “borrow” from its competitors expiring characters. The negligible discounted values of copyrights seventy-five years from now will almost certainly be outweighed by the possibility that Disney might compete with Marvel Comics in creating more Bugs Bunny product, as Marvel decides to compete by the creation of its own Mickey Mouse and other formerly Disney characters. The *Alaska Airlines* analysis leads inescapably to the conclusion that, absent retrospective extension, Congress would have heard very different testimony and felt very different pressures regarding prospective extension. And if the conclusion is—as the facts seem to compel—that Congress would have acted very differently and would not have enacted prospective extension under those circumstances, then prospective extension should also fall.

And that is, of course, as it should be. Congress should be free to extend, or shorten, copyright terms according to prevailing economic theories. It can only do that if its procedures are effectively policed to keep them honest, corrected when found defective, its integrity checked from serious malfunctioning. This is all the Supreme Court is supposed to do: it need not substitute its judgment for that of Congress on the merits. All that is required is that the Court keep the process honest by removing the unconstitutional retrospective term extension from Congressional options. Congress can then—and by virtue of the Constitution must—be trusted to do the rest.

