

## Is the Public Domain Permanent?: Congress's Power to Grant Exclusive Rights in Unpublished Public Domain Works

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### INTRODUCTION

The scope of Congress's power under the Constitution to regulate works of authorship has come under greater scrutiny in recent years than probably ever before. The Supreme Court took up the question most recently in *Eldred v. Ashcroft*, only its seventh decision ever interpreting Congress's copyright power.

In this article, I begin by describing the Court's approach in *Eldred* in interpreting that power, and argue that the broad interpretation given there was fundamentally consistent with the Court's approach in its earlier Copyright Clause cases. I then seek to apply the lessons of *Eldred* and its antecedents. The context for this application is recent developments in U.S. copyright law that have for the first time made unpublished works part of the public domain of works whose copyright terms have expired. These developments may lead to calls for Congress to grant some period of exclusive rights to the party who first publishes a previously unpublished public domain work—a so-called “publication right.” I argue that a court seeking to apply the lessons of *Eldred* and the earlier Copyright Clause cases might well construe the clause to empower Congress to grant such a publication right.

### I. THE SCOPE OF CONGRESS'S COPYRIGHT POWER

#### A. THE *ELDRED* OPINION: CONGRESS CAN EXTEND EXISTING COPYRIGHTS

The Court last considered the scope of Congress's power under the Copyright Clause in *Eldred v. Ashcroft* in 2003, which challenged the provisions of the Sonny

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Bono Copyright Term Extension Act that extended by twenty years the term of all copyrighted works that were then in existence, and whose term of protection had not expired as of its effective date. *Eldred* examined whether the power granted Congress to protect authors' exclusive rights in their writings for "limited Times" includes the power to extend the duration of copyright protection for existing copyrighted works. The majority, in answering this question, looked to the text of the Copyright Clause, the history of Congressional practice, and judicial precedent.

As to the text, the Court viewed the meaning of the word "limited," both when the Constitution was written and in current English use, as merely "confined within certain bounds" or "restricted in extent, number, or duration."<sup>1</sup> The plaintiffs had conceded that the copyright terms established by the Copyright Term Extension Act [hereinafter CTEA] for works created after that act took effect—life plus seventy years in most cases, ninety-five years from publication in certain cases—were in that sense "limited Times." The Court concluded that the exact same term "does not automatically cease to be 'limited' when applied to existing copyrights."<sup>2</sup> The Copyright Clause's language, the Court concluded, seemed to allow Congress to extend the term of existing copyrights, so long as the extended term qualified as a "limited Time."<sup>3</sup>

The Court then looked beyond the clause's text to the history of Congressional practice thereunder, suggesting that "a page of history is worth a volume of logic."<sup>4</sup> Because the "limited Times" language of the Copyright Clause also applies to Congress's patent power, the Court considered the history of both copyright and patent legislation. The Court pointed to two historical facts to support the conclusion that the Copyright Clause allows Congress to extend the term of existing copyrights. First, looking to the original 1790 Copyright Act and the term extensions of 1831, 1909, and 1976, the Court found "an unbroken congressional practice of granting to authors of works with existing copyrights the benefit of term extensions so that all under copyright protection will be governed evenhandedly under the same regime."<sup>5</sup> Indeed, the Court pointed several times to the need for parity between new and existing copyrights as evidence that Congress had the power to extend the term for existing copyrights.<sup>6</sup> Second, the Court noted numerous instances early in U.S. history when Congress extended the duration of individual existing patents and copyrights.<sup>7</sup>

Finally, the Court observed that judicial precedents involving term extensions under patent law also supported interpreting the "limited Times" language to allow extending the copyright term for existing works. Most importantly, several early

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1. *Eldred v. Ashcroft*, 537 U.S. 186, 199 (2003).

2. *Id.*

3. The Court also suggested that extending the term of existing copyrights would not be constitutional if Congress were to enact an extension in order "to evade the 'limited Times' prescription." *Id.* at 199-200. *See infra text accompanying note 11.*

4. *Id.* at 200 (quoting *N.Y. Trust Co. v. Eisner*, 256 U.S. 345, 349 (1921)).

5. *Id.*

6. *See, e.g., id.* at 194, 208, 214-15.

7. *Id.* at 201.

court cases upheld patent terms renewed or extended by Congress.<sup>8</sup>

Thus, the Court found that the language of the Copyright Clause, the history of Congressional practice in legislating copyright and patent terms, and judicial precedents finding no constitutional objection to legislative expansions of existing patents all led to the conclusion that “extending the duration of existing copyrights is [not] categorically beyond Congress’ authority under the Copyright Clause.”<sup>9</sup> Subject to further decisional interpretation, “limited Times” means only that the copyright term must have *some* boundary, though the Court was unwilling to suggest any particular outer boundary beyond which Congress could not go in establishing the copyright term.<sup>10</sup>

The Court rejected the suggestion that upholding repeated term extensions allowed Congress in effect to grant perpetual copyright protection and thus evade the “limited Times” constraint, finding that nothing before it justified viewing the CTEA as such an attempt at evasion. While the Court suggested that it might more carefully scrutinize a law passed in an attempt to circumvent the restriction, the Court’s treatment of this argument suggests that future challengers may have difficulty showing that Congress enacted any particular term extension law in an effort to get around the “limited Times” restriction.<sup>11</sup>

Those challenging the CTEA had also argued that the extension of the copyright term for already-created works was outside the scope of Congress’s authority because the Copyright Clause permits Congress to act only, as stated in the clause’s preamble, “[t]o promote the Progress of Science,” and such an extension would not in fact promote progress, because it would not stimulate the creation of new works but rather would simply reward owners of copyright in existing works. The challengers argued that the Court should interpret the “limited Times” restriction in light of the preambular statement of purpose and therefore strike down the CTEA provisions governing works created before its passage. The Court acknowledged that this was one of the challengers’ more forceful arguments. It pointed out that prior decisions had described the clause as “both a grant of power and a

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8. *Id.* at 202 (citing 1813, 1815, and 1839 circuit court decisions, including decisions by Chief Justice John Marshall and Justice Joseph Story). The Court also relied on an 1843 patent decision, *McClurg v. Kingsland*, 42 U.S. (1 How.) 202 (1843), holding that a patent’s validity was to be judged by “the law as it stood at the emanation of the patent, together with such changes as have been made since” and concluded that the retrospective operation of such changes was “not a sound objection to their validity” so long as they did not “take away the rights of property in existing patents.” *Eldred*, 537 U.S. at 203-04, 239.

9. *Id.* at 204.

10. In particular, the Court did not see how the CTEA, with its life-plus-seventy and ninety-five-year terms, “crosses a constitutionally significant threshold with respect to ‘limited Times’” that earlier copyright statutes—providing maximum terms of forty-two years, fifty-six years, seventy-five years, or life plus fifty years—did not cross. *Id.* at 209-10. Similarly, the Court declined to indicate whether other common durational limits in property law, such as 99-year leases and the rule against perpetuities, marked any “outer boundary of ‘limited Times.’” *Id.* at 210 n.17.

11. Given the Court’s discussion of using legislative history to measure a Congressional purpose of evasion, *id.* at 209 n.16, such a showing might require express statements that Congress would like to grant protection in perpetuity but cannot, and so instead is repeatedly extending the term of protection.

limitation”<sup>12</sup> and had recognized that if Congress exercises its copyright power it must “create a ‘system’ that ‘promote[s] the Progress of Science.’”<sup>13</sup> However, the Court decided that the order of the day was deference to Congress: “[I]t is generally for Congress, not the courts, to decide how best to pursue the Copyright Clause’s objectives.” And the deferential Court found that Congress could rationally have believed that enacting the CTEA would promote the progress of science, by promoting international harmonization of copyright term and by responding to demographic and technological changes. In addition, the Court again looked to Congress’s “unbroken practice since the founding generation”<sup>14</sup> of applying term extensions to both past and future works as evidence of the rationality of a Congressional view that a system in which the term of past works was extended would achieve the copyright power’s purpose of promoting the progress of science.

Having decided that Congress has the general Constitutional power to extend the unexpired copyright term of previously created works, the *Eldred* Court then considered whether the CTEA itself was a rational exercise by Congress of its copyright power. The Court rejected the challengers’ suggestion that it should subject copyright enactments to any of the stricter standards of review, and emphasized that in its rational-basis review of the legislation, it would “defer substantially to Congress.”<sup>15</sup>

In keeping with the deferential nature of its rationality review, the Court only briefly identified several rational policy justifications for the term extension. First, the Court noted that the CTEA would allow U.S. authors to receive the same protection as European authors in E.U. nations that had recently extended their term of copyright protection by 20 years. The Court also suggested that the extension might provide authors greater incentive to create and disseminate their works in the United States.<sup>16</sup> Next, the Court said that the CTEA responded to “demographic, economic, and technological changes.” Increases in longevity and child-bearing age, Congress feared, would keep authors from being able “to take pride and comfort in knowing that [the authors’] children—and perhaps their children—might also benefit from [the authors’] posthumous popularity.”<sup>17</sup> And Congress may have believed that the term extension responded to “the substantially increased commercial life of copyrighted works resulting from the rapid growth in communications media.”<sup>18</sup> Finally, the Court observed that Congress “rationally credited” projections that the extended term would give copyright owners incentives to invest in the restoration and dissemination of their works. Having identified these justifications as rational, the Court upheld the CTEA against the

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12. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 5 (1966).

13. 537 U.S. at 212 quoting *Graham*, 383 U.S. at 6 (1966).

14. 537 U.S. at 213-14.

15. *Id.* at 204.

16. *Id.* at 205-06. The opinion did not explain how the extension would provide such additional incentives for creation and dissemination.

17. *Id.* at 207 n.14 (quoting Sen. Dianne Feinstein).

18. *Id.* (quoting Sen. Orrin Hatch).

challenge on Copyright Clause grounds.<sup>19</sup> The Court did sound a note of skepticism about the desirability, rather than the constitutionality, of the CTEA, noting that the law's justifications might be "debatable or arguably unwise" but that the Court could not second-guess Congress's wisdom.<sup>20</sup>

### B. *ELDRED* IN CONTEXT: THE HISTORY OF COPYRIGHT CLAUSE INTERPRETATION

The Court's reading of the "limited Times" prescription as imposing only minimal limits on Congressional power to enact copyright laws is largely consistent with the overall trend of Supreme Court interpretation of the Copyright Clause.<sup>21</sup> In general, the Court has interpreted the clause so as to give Congress very broad power to enact copyright laws.

In 1879, the first Supreme Court case to interpret the Copyright Clause found that the language indeed imposed some limit on Congress's power to legislate under the clause.<sup>22</sup> *The Trade-Mark Cases* involved a law granting federal protection to trademarks. The Court determined that Congress passed the law pursuant to its Copyright Clause authority. But the Court held that trademarks did not necessarily qualify as the "Writings" of "Authors" that Congress could protect under its copyright power, because a trademark could be protected even if the trademark owner did not create the mark but merely adopted as a mark something that already existed and then acquired rights through the use of that mark. Such a mark could not qualify as the writing of an author, the Court explained, because a "writing," in the constitutional sense, included only those creations that were "original" to the author and "the fruits of intellectual labor."<sup>23</sup> Thus, the trademark law was not a legitimate exercise by Congress of its copyright power (though of course Congress later enacted federal trademark laws pursuant to its power to regulate commerce.)

Aside from invalidating Congress's use of the copyright power to enact a trademark law, however, the Court in its first 200 years otherwise interpreted the

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19. Interestingly, though the Court several times mentioned the need for parity between holders of new and existing copyrights, *see supra* note 6, it did not expressly offer a Congressional desire for parity as a justification for the extension of existing copyrights.

20. 537 U.S. at 208.

21. Prior to *Eldred*, only six Supreme Court cases had interpreted the language of the Copyright Clause. *See* Marci A. Hamilton, *Copyright at the Supreme Court: A Jurisprudence of Deference*, 47 J. COPYRIGHT SOC'Y U.S.A. 317, 335-40 and 362-63 (2000) (noting five cases, omitting *The Trade-Mark Cases* as a non-copyright decision). In a seventh case, *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911), the Court construed the Copyright Act's grant of the exclusive right to dramatize a literary work as including the right to make a motion picture, and it very briefly rejected the argument that, so construed, the Act exceeded Congress's power. The argument, however, appears to have been that the Court's construction would extend copyright to the author's idea, rather than his expression, and the Court rejected that characterization and said that its construction of the Act conferred no monopoly over ideas. 222 U.S. at 63.

22. In 1834, in *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, the Court briefly discussed the Copyright Clause, but did not offer any interpretation of it. *See* Hamilton, *supra* note 21, at 336.

23. *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

Copyright Clause quite broadly. In 1884, the Court decided a case challenging Congress's authority to grant copyright protection to photographs. The challenger argued that because a photograph was merely "a reproduction on paper of the exact features of some natural object or of some person," it was not "a writing of which the producer is the author," and since the Copyright Clause only authorized Congress to protect the "Writings" of an "Author," the attempt by Congress to grant copyright in photographs was invalid.<sup>24</sup> The Court rejected the challenge by giving the constitutional terms very broad definitions. An "Author," the Court said, is "he to whom anything owes its origin; originator; maker; one who completes a work of science or literature," and a "Writing," in the constitutional sense, was held to mean "the literary productions of . . . authors" and to include "all forms of writing, printing, engravings, etching, etc., by which the ideas in the mind of the author are given visible expression."<sup>25</sup> So long as such a writing represents "original intellectual conceptions of the author," the Court said, Congress may protect it by copyright, as it had in the case of photographs (though the Court suggested that the "ordinary production of a photograph" might not represent such intellectual conception). In sum, the Court read the words of the Copyright Clause—and Congress's power under it—quite broadly, not narrowly.

In 1973, the Court again considered the meaning of the Copyright Clause's language, and again read the words broadly. *Goldstein v. California* involved a challenge to the constitutionality of a state law against copying sound recordings, on the ground that the state law conflicted with the federal copyright power.<sup>26</sup> At the time California's law was enacted, sound recordings were not subject to federal copyright protection. As part of its analysis, the Court considered whether Congress had the power to protect sound recordings under copyright. The Court held that the "Writings" that Congress *could* protect did include sound recordings: "[A]lthough the word 'writings' might be limited to script or printed material, it may be interpreted to include any physical rendering of the fruits of creative intellectual or aesthetic labor."<sup>27</sup> In keeping with its earlier decisions, the Court chose the latter interpretation, viewing Congress's copyright power as quite broad, rather than reading the words of the Copyright Clause in a narrow, literal way.

In 1991, however, for the first time since *The Trade-Mark Cases*, the Court read in the Copyright Clause limits beyond which Congress could not legislate. *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.* involved the copyrightability of a standard telephone directory as a factual compilation. The Court analyzed the standards that a work must meet to obtain copyright protection and concluded, as in *The Trade-Mark Cases*, that the work must be "original" to the author. The Court went further, however, stating that, to be original, a work must not be copied and must "possess[] at least some minimal degree of

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24. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 56 (1884).

25. *Id.* at 57-58.

26. *Goldstein v. California*, 412 U.S. 546 (1973).

27. *Id.* at 561.

creativity.”<sup>28</sup> This creativity requirement marked “a significant departure from precedent,” according to a leading commentator.<sup>29</sup> While the decision could have been justified on the basis of the language of the 1976 Copyright Act,<sup>30</sup> the Court instead went out of its way to emphasize that the minimal creativity element of originality was a constitutional requirement for copyright protection.<sup>31</sup> The constitutional dimension of the originality requirement sprang from the Copyright Clause’s terms “Authors” and “Writings,” as the Court held that an author’s writings in the context of the Copyright Clause encompassed only independently created *and* at least minimally creative works. Thus, for the first time in over a century, the Supreme Court interpreted the Copyright Clause to restrict Congress’s power: Congress could not protect any work that was not minimally creative (though the Court stressed that this threshold was quite low).

If *Feist* might have been thought to signal a change in the Court’s traditional approach of interpreting the scope of Congress’s copyright power very broadly,<sup>32</sup> the *Eldred* decision could certainly be seen as signaling a return by the Court to its traditional approach. *Eldred*, after all, involved the meaning of the phrase “limited Times”—the only *express* textual limitation in the Copyright Clause on Congress’s power (the Court in *The Trade-Mark Cases* and *Feist* having inferred limits from the words “Authors” and “Writings”). But the *Eldred* majority showed no more inclination to read those express words of limitation restrictively than the Court had shown before *Feist* to read the words “Writings” and “Authors” narrowly in determining Congress’s power under the clause. Indeed, the *Eldred* majority rejected the argument that the CTEA ran afoul of *Feist*’s originality requirement because existing works, to which the CTEA granted additional years of protection, were not “original” at the time when the additional protection was granted. The Court showed no inclination to apply *Feist*, or its apparently more vigorous interpretive method, beyond the issue of originality presented in that case.

The *Eldred* Court’s use of the Copyright Clause’s preamble in interpreting the clause is also consistent with its historic behavior. The Court first discussed the preamble in some detail in *Higgins v. Keuffel*, an 1891 case involving a claim of copyright in a label that apparently constituted only the bare three-word description, “water-proof drawing ink.”<sup>33</sup> The Court expressed doubt that copyright protection for such a label could be granted under the Copyright Clause because such protection would not serve the purpose stated in the clause of “promot[ing] the Progress of Science and useful Arts.” The Court described the

28. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991).

29. 1 PAUL GOLDSTEIN, COPYRIGHT § 2.2.1, at 2:8 (2d ed. 1996 & Supp. 2005) [hereinafter GOLDSTEIN]. See also Hamilton, *supra* note 21, at 339 (describing decision as “dramatic change” based on “rather fleeting references” in precedents).

30. See, e.g., Hamilton, *supra* note 21, at 339.

31. “Justice O’Connor referred to the originality requirement’s constitutional underpinning at no fewer than thirteen places in her opinion for the Court.” GOLDSTEIN, *supra* note 29 at 2:9 n.12.

32. See Hamilton, *supra* note 21, at 339 (“If the case was a harbinger of things to come, the Court in *Feist* instituted a new relationship with Congress vis-à-vis copyright law, one in which it was no longer inclined to be deferential to the point of servility.”).

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

plaintiff's label as having "no possible influence upon science or the useful arts": the use of a descriptive label on the product it described had "no connection with the progress of science and the useful arts" and "nothing to do with such progress."<sup>34</sup> As a result, the Court concluded, "[i]t cannot . . . be held by any reasonable argument that the protection of mere labels is within the purpose of the clause."<sup>35</sup> Despite this language, the Court actually decided the case on the much narrower ground that the label did not qualify for protection under the statute because the plaintiff had not complied with the strict notice formalities required of copyright owners at the time.<sup>36</sup> As a result, the Court did not need to rule definitively as to the impact of the Copyright Clause's preamble on the scope of Congress's power.

Less than a decade later, the Court decisively declined to read the Copyright Clause's preamble to limit Congress's copyright power. *Bleistein v. Donaldson Lithographing Co.* involved copyright in posters advertising a circus.<sup>37</sup> The lower court, relying in part on the *Higgins* opinion, ruled that if a work had no use other than advertising "it would not be promotive of the useful arts, within the meaning of the constitutional provision, to protect the 'author' in the exclusive use thereof."<sup>38</sup> In the Supreme Court, although the dissent adopted the lower court reasoning that "a mere advertisement of a circus" did not promote progress and therefore could not be protected pursuant to the Copyright Clause, only two justices supported that position. The Supreme Court majority, instead of following the path suggested by the language in *Higgins*, treated the preamble argument dismissively:

We shall do no more than mention the suggestion that painting and engraving unless for a mechanical end are not among the useful arts, the progress of which Congress is empowered by the Constitution to promote. The Constitution does not limit the useful to that which satisfies immediate bodily needs.<sup>39</sup>

Thus, the only Supreme Court decision before *Eldred* that actually decided the question interpreted the Copyright Clause's preambular goal of promoting progress as broadly as the Court had interpreted the terms "Writings" and "Authors." *Eldred's* deference to Congress in determining whether the copyright system it enacts will promote progress thus continues the Court's past approach.

The lasting interpretive import of the *Eldred* decision lies not in its position on the substantive question of copyright duration, but rather in its view of the process of copyright lawmaking. The *Eldred* Court's approach to interpreting the Copyright Clause largely continues a 150-year tradition of reading the Constitution

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34. *Id.* at 431.

35. *Id.*

36. *Id.* at 434-35.

37. For a full discussion of the case and its background, see Diane Leenheer Zimmerman, *The Story of Bleistein v. Donaldson Lithographing Company: Originality as a Vehicle for Copyright Inclusivity*, in *INTELLECTUAL PROPERTY STORIES 77* (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2006).

38. *Courier Lithographing Co. v. Donaldson Lithographing Co.*, 104 F. 993, 996 (1900).

39. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903).



to grant Congress very broad power in the copyright field.<sup>40</sup> The *Eldred* Court showed no interest in further limiting Congress's copyright power. Indeed, the Court expressly noted that, in its view, "the Copyright Clause empowers Congress to determine the intellectual property regimes that, overall, *in that body's judgment*, will serve the ends of the Clause."<sup>41</sup> As a result, Congress may for now have a fairly free hand in writing copyright laws, though the Court's 1991 *Feist* decision signals a willingness to impose some constitutional boundaries on Congress's power at the margins.<sup>42</sup>

## II. CAN CONGRESS GRANT EXCLUSIVE RIGHTS IN UNPUBLISHED PUBLIC DOMAIN WORKS?

Courts are already using the *Eldred* decision to help resolve constitutional challenges to recent copyright enactments as beyond the scope of Congress's copyright power. For example, pending and recently decided cases have challenged laws that restored copyright in foreign works that had entered the public domain in the United States through failure to comply with required formalities,<sup>43</sup> that granted protection to unfixed musical performances,<sup>44</sup> and that eliminated a variety of formalities as preconditions to obtaining copyright protection.<sup>45</sup> In this Part, I examine how the Court might interpret the Copyright Clause if faced with a law that Congress has not yet enacted, but might someday pass, namely, a law granting a period of exclusive rights to the first party to publish a previously unpublished work which has entered the public domain through expiration of its copyright term. I first explain the recent emergence in U.S. law of a public domain of unpublished material, and consider the possibility that Congress will be urged to grant a "publication right" in such material. The bulk of this Part then argues that, under the *Eldred* approach, the Court might well find a publication right within the scope of the copyright power.

### A. THE NEW UNPUBLISHED PUBLIC DOMAIN

Until 1978, unpublished works of authorship were generally protected not by federal copyright but by state law.<sup>46</sup> State "common law" copyright, as it was

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40. Similarly, the *Eldred* majority's handling of the interaction of copyright and free speech law continues the Court's recent trend of treating copyright's internal limits as accommodating speech interests sufficiently to make formal First Amendment review unnecessary.

41. *Eldred v. Ashcroft*, 537 U.S. 186, 222 (emphasis added).

42. Particularly, for example, where Congress alters the traditional contours of copyright law.

43. *Luck's Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107 (D.D.C. 2004), *aff'd*, 407 F.3d 1262 (D.C. Cir. 2005); *Golan v. Gonzales*, 74 U.S.P.Q.2d (BNA) 1808 (D. Colo. 2005).

44. *KISS Catalog v. Passport Int'l Prods.*, 350 F. Supp. 2d 823 (C.D. Cal. 2004), *vacated in part on reconsideration*, 405 F. Supp. 2d 1169 (C.D. Cal. 2005); *United States v. Martignon*, 346 F. Supp. 2d 413 (S.D.N.Y. 2004), *appeal pending*.

45. *Kahle v. Gonzales*, 474 F.3d 665 (9th Cir. 2007).

46. See, e.g., 1909 Copyright Act, ch. 320, § 2, 35 Stat. 1075, 1076 ("[N]othing in this Act shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his

called,<sup>47</sup> usually covered a work from the time of its creation and protected the owner against its unauthorized initial publication. This state-law protection lasted until the work was first published, at which point the work either acquired federal copyright protection (if the owner complied with the formalities imposed by federal law) or entered the public domain, because state protection ended and federal protection was not obtained. Because a work could remain unpublished indefinitely, state-law copyright was similarly indefinite and potentially perpetual.<sup>48</sup>

The 1976 Copyright Act ended this division of labor between state law protecting unpublished works and federal law protecting primarily published works. Indeed, Ralph Brown, a preeminent copyright scholar of the day, claimed that the “greatest change” worked by the 1976 Act was that “[a] dual system that has persisted since the beginning of the republic give way to a unified national copyright.”<sup>49</sup> For works created on or after January 1, 1978, federal copyright protection attaches to the work not when it is published or registered, as under all prior U.S. copyright acts, but as soon as it is fixed in a tangible medium of expression. Whether a work is published or not, once created, it enjoys federal copyright protection. This new unitary copyright system changed the term of protection for unpublished works. Whereas previously an unpublished work could be protected indefinitely, after 1978 copyright protected an unpublished work for the same term as any other copyrighted work, which under the 1976 Act as originally adopted was in most cases the life of the author plus fifty years.<sup>50</sup>

The 1976 Act ended state copyright protection not only for works created after January 1, 1978, but also for works created before that date. Section 303 of the 1976 Act made express provision for any work that already existed on January 1, 1978, but had (a) never secured a federal copyright,<sup>51</sup> and (b) not entered the public

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consent, and to obtain damages therefor.”). In fact, federal copyright protection was *available* for certain types of unpublished works—all of which were commonly exploited by public performance or display rather than by publication of copies—but only if the work’s owner affirmatively registered the work for protection with the Copyright Office. 1909 Copyright Act, ch. 320, § 11, 35 Stat. 1075, 1078. Interestingly, the 1909 Act made no express provision for the term of federal copyright acquired by the registration of unpublished works, as the Act’s term provisions ran only from “the date of first publication.” 1909 Copyright Act, ch. 320, § 23, 35 Stat. 1080. Courts eventually decided that the initial term of unpublished works registered for protection ran for twenty-eight years from the date of deposit. *Marx v. United States*, 96 F.2d 204 (9th Cir. 1938); *Shilkret v. Musicraft Records*, 131 F.2d 929 (2d Cir. 1942).

47. The label “common law” copyright is generally used regardless of whether the state law governing the subject remained decisional or was codified into statute.

48. See generally 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 4.02[C], at 4-17 (2006).

49. Ralph S. Brown, Jr., *Unification: A Cheerful Requiem for Common Law Copyright*, 24 UCLA L. REV. 1070 (1977). He also noted that it “has been attended with the least controversy.” *Id.*

50. 1976 Copyright Act, ch. 3, § 302(a), 90 Stat. 2568, 2572. In the case of joint works, the term was measured from the life of the last surviving author. *Id.* at § 302(b). For works made for hire, anonymous works, and pseudonymous works, the term was the shorter of seventy-five years from publication or one hundred years from creation. *Id.* at § 302(c). These terms were all later extended by twenty years. See *infra* text accompanying notes 55-57.

51. The statute simply refers to works “created before January 1, 1978, but not theretofore . . .

domain, a category that principally included existing but unpublished works protected by state common-law copyright. The Act removed those works from state protection and granted them federal copyright as of January 1, 1978.<sup>52</sup> But how long a federal copyright term should these newly protected works receive? Congress gave them the same basic term as all post-1977 works, which was generally the life of the author plus fifty years.

For unpublished works of long-dead authors, though, Congress realized that this created an inequity.<sup>53</sup> Before 1978, such works could continue to enjoy their state-law copyright protection indefinitely. If Congress gave these works federal protection on January 1, 1978, only for a term that lasted until fifty years after the author's death, the copyright in these works would have expired immediately. For example, Rainer Maria Rilke died in 1926, so a Rilke poem that was unpublished (and protected by state common-law copyright) on December 31, 1977 would have achieved federal copyright on January 1, 1978, and would have expired that same day, since 50 years had already passed since Rilke's death.

Congress sought to prevent this outcome, in part because questions had been raised about the constitutionality of cutting off potentially perpetual common law protection. The suggestion had been made that such a cut-off would be less problematic if some period of statutory protection was granted. Congress therefore adopted a transitional mechanism in Section 303 and provided a minimum twenty-five-year term of federal protection for all pre-1978 unpublished works. On January 1, 1978, these works acquired a federal copyright that lasted for the ordinary term of protection *or* for twenty-five years, until December 31, 2002, whichever was longer. And to encourage the publication of unpublished material, Congress held out the possibility of even longer protection: if the work was actually published during its twenty-five-year minimum term, that term would be

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*copyrighted*," 17 U.S.C. § 303(a) (1976) (emphasis added), but logic and the legislative history make clear that "copyrighted" in this context must mean copyrighted under the federal statute as opposed to under state common law. *See, e.g.*, H.R. REP. NO. 94-1476 at 138-139 (1976).

52. The one exception was sound recordings fixed before February 15, 1972. Federal copyright law offered no protection to sound recordings before that date, though state protection was often available, even after records had been distributed to the public. The 1976 Act allowed state law to continue to protect such recordings for up to seventy-five more years (to 2047), and simply never brought pre-1972 recordings into federal copyright: "Notwithstanding the provisions of section 303, no sound recording fixed before February 15, 1972, shall be subject to copyright under this title before, on, or after February 15, 2047." 17 U.S.C. § 301(c) (1976) (as enacted). The CTEA extended that period by twenty years. 17 U.S.C. § 301(c). At least one state court has recently held that pre-1972 sound recordings retain their state copyright protection even after the sale of records to the public. *Capitol Records, Inc. v. Naxos of America, Inc.*, 4 N.Y.3d 540 (N.Y. 2005).

53. H.R. REP. NO. 94-1476 at 139 (1976). In the discussions on an early draft of the bill that became the 1976 Act, Leon Kellman, of the American Guild of Authors and Composers, argued that the estates of many authors and composers often retained unpublished works in reserve waiting for the right opportunity to exploit them, knowing that they could obtain a limited-term, statutory copyright by publishing those works. H. COMM. ON THE JUDICIARY, 88TH CONG., COPYRIGHT LAW REVISION PART 4: FURTHER DISCUSSIONS AND COMMENTS ON PRELIMINARY DRAFT FOR REVISED U.S. COPYRIGHT LAW 45-46 (Comm. Print 1964). He thus argued that "some period of protection should be given so that those who own [unpublished works of dead authors] can at least be warned that, if they do not hasten to exploit them, they must be deprived of all their rights." *Id.* at 46.

extended to fifty years, through December 31, 2027.<sup>54</sup>

In 1998, the CTEA lengthened the terms of copyright under U.S. law, but did not change the fundamental structure adopted in the 1976 Act.<sup>55</sup> As a result, copyright now generally runs for seventy (rather than fifty) years after the death of a work's last surviving author.<sup>56</sup> This new term also applies to works that were unpublished on January 1, 1978 and received federal protection on that day.<sup>57</sup> And for those works, the Sonny Bono Act also partially extended the minimum term of protection under Section 303. The basic minimum term of twenty-five years remained, expiring on December 31, 2002, but if a work was published before that date, it would receive forty-five more years of protection (through 2047), for a total minimum term of seventy (rather than fifty) years.

Congress made no further amendments, so at midnight on December 31, 2002, the minimum term for pre-1978 unpublished works expired.<sup>58</sup> As a result, works entered the public domain in the United States on January 1, 2003, if (1) as of January 1, 1978, they were unpublished and had never been registered for copyright protection, (2) they remained unpublished through December 31, 2002, and (3) the author died on or before December 31, 1932.<sup>59</sup> Because all copyright terms run until the end of the year in which they expire, works that met the first two conditions are in the public domain today if the author died on or before December 31, 1936.

I have elsewhere discussed the reasons for this change, the kinds of materials it will affect, and some of the implications of this new public domain of unpublished material.<sup>60</sup> Here, I take up only one issue raised by placing unpublished works in the public domain: the possibility of Congress granting some period of exclusive control over such works once they are published, and whether Congress has the power under the Copyright Clause to protect works first published after their copyright term expires.

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54. H.R. REP. NO. 94-1476 at 139 (1976).

55. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998).

56. 17 U.S.C. § 302(a), (b) (2000). For works made for hire, the term is the shorter of ninety-five years from publication or 120 years from creation. *Id.* § 302(c).

57. The CTEA was adopted in 1998, before the twenty-five year minimum term for pre-1978 unpublished works had expired. As a result, the federal copyright term for all pre-1978 works that had acquired federal copyright on January 1, 1978 had not expired at the time of the extension, so the new terms apply to all of those works. *See* Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998).

58. That date also marked the expiration of protection in most then-unpublished architectural works. Congress did not extend copyright protection to architectural works until Dec. 1, 1990, and when it did so, it protected any work which, on that date, was "unconstructed and embodied in unpublished plans," but it provided that such protection would expire on Dec. 31, 2002, "unless the work is constructed by that date." Architectural Works Copyright Protection Act, Pub. L. No. 101-650, § 706(2), 104 Stat. 5133, 5134 (1990).

59. This was probably the largest single addition of material to the public domain ever.

60. R. Anthony Reese, *Public But Private: Copyright's New Unpublished Public Domain*, 85 TEX. L. REV. 585 (2007).

### B. THE POSSIBILITY OF A “PUBLICATION RIGHT”

Putting older unpublished works in the public domain means that if those works *are* eventually published, copyright law as currently written will not prevent further use of them by anyone who obtains a published copy. Those who own copies of unpublished works, and those interested in commercially publishing them, may argue that this will cause problems: publishers may be reluctant to invest in publishing unpublished works, because someone else may simply copy the work and compete with the publisher to supply copies to meet any demand. We might therefore expect calls for Congress to offer some protection against such competitive copying.

Any such call for protection would no doubt include an appeal to the recent harmonization of European copyright law to provide exactly such protection. In 1993, the European Union adopted a directive to harmonize the term of copyright protection throughout Europe.<sup>61</sup> Article 4 of the directive requires protection for unpublished public domain works upon their publication:

Any person who, after the expiry of copyright protection, for the first time lawfully publishes or lawfully communicates to the public a previously unpublished work, shall benefit from a protection equivalent to the economic rights of the author. The term of protection of such rights shall be 25 years from the time when the work was first lawfully published or lawfully communicated to the public.<sup>62</sup>

Although there is no real legislative history of this requirement to create a “publication right,” it appears to have been intended to harmonize the member states’ differing approaches to protecting older unpublished works upon publication.<sup>63</sup> Member states were to implement the provision by July 1, 1995, and

61. Council Directive 93/98, art. 1, 1993 O.J. (L 290) 9, 11 (EC). As a general matter, the directive requires copyright protection in unpublished works to last for seventy years after the death of the author, or in some cases seventy years after the work is created. *Id.* at art. 1(1), 1(6). Article 1(1) provides that for literary and artistic works, protection lasts for seventy years after the death of the author, “irrespective of the date when the work is lawfully made available to the public.” Article 1(6) provides that for works whose term is not measured from the date of the author’s death (for example, anonymous or pseudonymous works protected under article 1(3) for seventy years from the date on which the work “is lawfully made available to the public”), protection shall terminate if such works “have not been lawfully made available to the public within seventy years from their creation.” *Id.*

62. *Id.* at art. 4.

63. I COPINGER AND SKONE JAMES ON COPYRIGHT § 17-02 at 876 (Kevin Garner et al eds., 14th ed. 1999). The French Copyright Law of 1957, for example, protected for fifty years from publication a work that was first published after the death of the author; by the 1990s, French law protected such a work for seventy years from publication. *See* 1957 Act, Art. 23; 1992 Code, Art. L. 123-4. The German statute of 1901, which generally provided for a life-plus-fifty year term, appears to have been interpreted to provide a minimum term of protection of ten years from publication for any literary work published more than forty years after the death of the author; the 1965 German Act expressly provided a ten-year-from-publication term of protection for posthumously published works. 1901 Act, § 29; Eugen Ulmer and Hans Hugo von Rauscher auf Weeg, *Germany (Federal Republic)*, in STEPHEN M. STEWART AND HAMISH SANDISON, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS 425, 441 (2d. ed. 1989). When Britain adopted the life-plus-fifty term for published works in the 1911 Copyright Act, it simultaneously provided for a term of protection for posthumously published works of fifty years from publication. Copyright Act, 1911, 1 & 2 Geo. 5, c. 46 §§ 3, 17(1).

many have done so.<sup>64</sup>

Essentially, the directive requires EU members to grant twenty-five years of copyright protection to the first person to lawfully publish an unpublished work that has previously entered the public domain through expiration of its term of copyright protection.<sup>65</sup> The right is acquired by “publishing” the work in the traditional copyright sense of issuing copies to the public, but also by publicly performing or displaying the work (which constitute communicating it to the public), and the right appears not to be available if the work was publicly performed or displayed during its original copyright term, even though it was not technically “published.” At least in the United Kingdom implementation of this provision, the “lawful” publication necessary to obtain the publication right must be made with the consent of the owner of the copy in which the work is fixed.<sup>66</sup>

The existence of this new Europe-wide exclusive right in previously unpublished public domain works might prompt American publishers to press for a similar right in the United States. After all, Europe’s adoption of a basic copyright term of seventy years after the author’s death was cited as a principal motivation for Congress to extend the U.S. copyright term in 1998. Congress argued that it was acting both to harmonize the term of copyright protection with a major U.S. trading partner and to protect the interest of U.S. copyright owners, as Europe would not protect works in the sixth and seventh decades after the author’s death if the work’s country of origin did not do so. Similar arguments could be made concerning the publication right. In particular, the directive is silent as to the application of the publication right to non-European publishers,<sup>67</sup> and at least in the United Kingdom, the directive has been implemented to protect only publishers

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The European approach is not particularly novel; many jurisdictions with a “life-plus” term traditionally protected “posthumous works”—works first published after the running of the ordinary life-plus copyright term. A 1957 Copyright Office study indicated that Britain, France, Mexico, Japan, and Italy all protected posthumously published works for a period of years measured from publication. WILLIAM S. STRAUSS, GENERAL REVISION OF THE COPYRIGHT LAW STUDY NO. 7, PROTECTION OF UNPUBLISHED WORKS 19 (1958) *reprinted in* 1 STUDIES ON COPYRIGHT 209 (Arthur Fisher Memorial ed. 1963). A 1987 summary of protection in seventy-six members of the Berne Union indicated that thirty-one nations provided some protection beyond the ordinary copyright term for works first published after the author’s death. SAM RICKETSON, THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886-1986, 356-363 (1987). Thus, while some states that adhere to the civil law tradition of copyright term have generally allowed unpublished works to expire when the ordinary *post mortem auctoris* term expires, many of them have long protected posthumously published works beyond the ordinary expiration of their copyright.

64. 1 COPINGER AND SKONE JAMES ON COPYRIGHT § 17-02 at 876-877 (Kevin Garner et al eds., 14th ed. 1999) (citing enactments in Austria, Belgium, Denmark, Finland, Germany, Ireland, Italy, the Netherlands, Norway, Spain, and Sweden, but not noting any implementation in France, Greece, Iceland, Liechtenstein, Luxembourg, or Portugal).

65. The limitation of protection to the author’s economic rights means that the publication right need not confer any moral rights protection.

66. Copyright and Related Rights Regulations, 1996, S.I. 1996/2967, pt. II, reg. 16(3) (U.K.).

67. 1 SIR HUGH LADDIE, THE MODERN LAW OF COPYRIGHT AND DESIGNS § 11.42 (3rd ed. 2000) (“[T]he Directive certainly does not require member states to refrain from granting publication right to nationals of other countries, provided their country grants an equivalent right.”).

who are nationals of a nation of the European Economic Area.<sup>68</sup> It seems clear that if the United States wishes to convince European states to extend the publication right in Europe to works published by American nationals, it will have to extend similar protection in the United States to European nationals. Adopting a publication right in the United States could thus be a first step to securing equivalent protection for U.S. publishers in Europe.

These arguments, of course, were available when Congress considered and passed the CTEA, and yet no attempt appears to have been made at that point to adopt a publication right. This was not due to a complete oversight of unpublished works, as Congress did consider the copyright term for previously unpublished works.<sup>69</sup> The initial term extension bill would have extended by ten years the minimum term under Section 303 for older unpublished works, so that their copyrights would not have expired until 2012.<sup>70</sup> Testimony from the Register of Copyrights, scholars, and librarians convinced the Senate Judiciary Committee to drop this extension, because the extreme difficulty of clearing copyright in most older unpublished works meant that “the public will not realize sufficient benefit from extended protection for these older unpublished works to justify precluding public access to those works beyond 2003.”<sup>71</sup>

But while Congress did consider unpublished works (and indeed extended the minimum term of protection for such works if they saw publication before 2003), it is perhaps not surprising that it did not consider granting protection along the lines of Europe’s new publication right. Granting a publication right in unpublished works in which copyright has expired, as discussed in Part II.D, below, has different effects from merely extending the term of copyright in an unpublished work. And, of course, at the time when term extension was considered and adopted, no unpublished works had yet entered the public domain in the United States, and none would do so for several more years.<sup>72</sup> Now that those who own copies of older unpublished works or who seek to publish them must for the first time actually deal with those works’ public domain status, it seems quite possible that they will ask Congress to consider providing a publication right along the lines of the European right.<sup>73</sup>

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68. Copyright and Related Rights Regulations, 1996, S.I. 1996/2967, pt. II, reg. 16(4) (U.K.).

69. And, of course, Congress did apply the twenty-year extension to all existing unpublished works, so that on January 1, 2003, only works whose authors had been dead for seventy years went into the public domain, instead of those whose authors has been dead for just fifty years, as would have been the case had the CTEA not been enacted.

70. S. 483, 104th Cong. § 2(c) (1995) (amending 17 U.S.C. § 303 (1976)).

71. S. REP. NO. 104-315 at 14 (1996).

72. In addition, it was not clear that any European nations were prepared to extend the publication right to non-European nationals on the basis of reciprocity, as they were already doing for the additional twenty years of ordinary copyright protection.

73. As Diane Zimmerman has noted, even academic views that material in the public domain should be subject to exclusive control are not unknown. Diane Leenheer Zimmerman, *Is There A Right to Have Something to Say? One View of the Public Domain*, 73 FORDHAM L. REV. 297, 306-308 (2004) (noting views that the public domain is a subsidy to the public that the government can withdraw, and that works will more likely be “exploited at optimal levels under a comprehensive private control regime than under one that relies on a large public domain”).

### C. DOES THE COPYRIGHT CLAUSE EMPOWER CONGRESS TO GRANT A PUBLICATION RIGHT?

The possible proposal of a publication right in the United States raises the question of whether Congress could constitutionally grant a period of exclusive rights to the first publisher of a work in which copyright has already expired. The Supreme Court's decision in *Eldred*<sup>74</sup> provides the basic two-part framework for determining whether the Copyright Clause gives Congress that power.<sup>75</sup> First, does the Constitution's Copyright Clause empower Congress to enact such a publication right? And if so, would Congress's particular enactment of a publication right be a rational exercise of the copyright power? In this section, I analyze a publication right under this framework, and suggest that although the outcome is far from certain, a Court following *Eldred* and interpreting the Copyright Clause with its traditional breadth might well uphold a publication right as constitutional. I consider three possible constitutional objections to a publication right: that it violates the Clause's "limited Times" language, that Congress has no power to remove works of authorship from the public domain once they have entered it, and that the publication right would not benefit "Authors" as required by the Clause. For each objection, *Eldred* directs attention not only to the Constitutional text, but, where relevant, to historical practice, and to judicial precedent.

#### 1. "Limited Times"

One possible Constitutional objection to a publication right might be that adding any additional period of exclusivity to the ordinary copyright term already enjoyed by an unpublished public domain work violates the Clause's "limited Times" restriction.

##### a. Text

The *Eldred* decision squarely suggests that this objection alone is not likely to be well founded, since the Court there upheld as within Congress's power the addition of time to the copyright term for works already in existence and protected by copyright, at least as long as such extension was not an attempt to provide the perpetual protection that the Constitution forbids. The Clause restricts Congress to

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

75. I am not considering in this article whether, if a publication right is within Congress's Copyright Clause power, the grant of such a right would be subject to First Amendment review under the *Eldred* view that a copyright enactment may require such review if Congress has "altered the traditional contours of copyright protection," *Id.* at 191, or whether a publication right would survive such scrutiny. In addition, I am not considering whether Congress could grant a publication right pursuant to its Commerce Clause power if the Court were to determine that it could not do so under its Copyright Clause power. See, e.g., Paul Heald and Suzanna Sherry, *Implied Limits on Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 ILL. L. REV. 1119; Thomas B. Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272 (2004).



granting rights only for “limited Times,” but *Eldred*’s reading of that phrase as simply requiring protection to be for some period that is restricted in duration would probably encompass protection that lasts for two such periods: one, from the work’s creation until seventy years after the author’s death, and a second for (perhaps) twenty-five years from the work’s publication. The phrase “limited Times” does not clearly require that the bounded period be only a single, uninterrupted stretch of time. And a publication right does not seem to approach perpetual protection, which *Eldred* recognized as beyond the scope of Congress’s power because of the “limited Times” language. Given that the *Eldred* Court found no reason to view the CTEA’s additional twenty years of protection as designed “to evade the ‘limited Times’ prescription” and provide perpetual protection, it seems unlikely to view a single twenty-five-year post-publication period of exclusive rights in a previously unpublished work as designed to do so.

*b. History*

The historical record would likely refute any objection that a publication right for a work that has entered the public domain would result in protecting a work for an “excessive” duration beyond a limited time (assuming that a Court were willing to establish any particular duration as excessive). Going forward, a publication right in a previously unpublished public domain work, together with the protection given before the copyright expired, would often provide a shorter total term of protection for a work than would have been available to that work for most of U.S. history. Consider, for example, a work written in 1800, by an author who died in 1870, and first published in 1970. The work would have been protected by common-law copyright for 170 years and by federal statutory copyright for ninety-five years, for a total of 265 years. Contrast a work written in 2000 by an author who dies in 2070 and is first published in 2170. If the publication triggers a twenty-five-year publication right, then the work would have been protected for a total of 165 years—140 years between its creation and the passage of seventy years after its author’s death, and twenty-five years after its publication.<sup>76</sup> Thus, in terms of the total duration of legal protection for an unpublished work, the grant of a publication right might be seen as entirely consistent with historical practice.

Historical practice also indicates that Congress can protect unpublished works indefinitely and can then further protect such works when they are first published long after their creation. The Copyright Clause was traditionally understood to

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76. Even if one considers the period in which the work is legally in the public domain but unpublished and presumably not publicly accessible (in the example, between 2140 and 2170), the total term of protection for a work first published 170 years after its creation would, under the current system with a publication right added, be 195 years, as compared to 265 years for the same work under pre-1978 law. See also H. COMM. ON THE JUDICIARY, 89TH CONG., COPYRIGHT LAW REVISION, PART 5: 1964 REVISION BILL WITH DISCUSSIONS AND COMMENTS 175 (Comm. Print 1965) (remarks of Irwin Karp, Authors League of America, noting that “there are many works published at the present time which have enjoyed protection for literally twice or three times the duration of life-and-fifty years under our present system, which combines common law and statutory copyright” and giving the example of Frank Carpenter’s *Carp’s Washington*, written during the Civil War and published in 1960).

allow Congress to grant a limited term of federal copyright protection to any previously unpublished work, as part of a system in which an unpublished work could be protected in perpetuity. The indefinite, potentially perpetual protection for unpublished works was typically a matter of state law. But starting with the first copyright act in 1790, Congress itself protected some unpublished as well as published works, and seems to have protected the former without time limitation. The 1790 Act created a cause of action for the unauthorized publication of “any manuscript”<sup>77</sup> without imposing any limitation on how long ago the work had been created or any formalities on the enjoyment of this protection, in sharp contrast to the time-limited protection granted to published works only if detailed formalities were strictly observed.<sup>78</sup> This provision remained in federal law each time the copyright act was revised until 1909,<sup>79</sup> so for nearly 120 years Congress viewed its constitutional copyright power as authorizing it to protect unpublished works for as long as they remained unpublished. And until the 1976 Act took effect and granted federal copyright protection to all existing unpublished works, it was well understood that one could obtain federal copyright, for the full statutory term, in a previously unpublished work—even a work created a very long time ago by a long-dead author—by publishing the work and complying with the statutory formalities.

## 2. Removing Material from the Public Domain

A second possible objection to a publication right is that it would give one person exclusive rights over a work that had already entered the public domain and become free for anyone to use, and that removing material from the public domain in that way is beyond Congress’s power. *Eldred* does not directly address that objection, but a court might read the constitutional text, historical practice, and judicial precedent as confirming Congress’s power.

### *a. Text*

The Copyright Clause contains no express textual restriction against Congress granting rights in works that have entered the public domain. The textual inquiry

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77. This provision apparently did not protect all works that could acquire federal copyright. For example, at least one case interpreted the term “manuscript” to exclude a painting. *Parton v. Prang*, 18 F. Cas. 1273, 1275 (C.C.D. Mass. 1872) (No. 10,784).

78. Act of May 31, 1790, ch. 15, § 6, 1 Stat. 124, 125-126. Authorization for publication could be made either by the author or by the proprietor of the manuscript, but protection extended (until 1891) only if the author or proprietor was a citizen or resident of the United States. (The question of whether a U.S. assignee of a nonresident author could claim the protection of the manuscript was unsettled. See EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 125-126 (1879).) This provision apparently provided an additional remedial avenue against unauthorized publication, rather than preempting state protection. See Brown, *supra* note 49, at 1071.

79. See Act of February 3, 1831, ch. 6, § 9, 4 Stat. 436, 438, § 9 (expressly authorizing injunctive relief, in addition to the suit for damages provided in the 1790 Act); Act of July 8, 1870, ch. 230, § 102, 16 Stat. 198, 212; Copyright Act, ch. 3, § 4967, 2 Rev. Stat. 965, 968 (1875); Act of March 3, 1891, ch. 565, § 9, 26 Stat. 1106, 1109.

into whether Congress has the power to do so would probably focus on two issues and would arguably support the publication right. First, the Copyright Clause has long been interpreted, beyond its express language, to allow Congress to protect only “original” works. It might be argued that at the time a publication right is granted, the work to be protected is no longer “original,” having been created at least decades, and often more than a century, earlier. That argument seems unlikely to prevail and bar a publication right given the *Eldred* Court’s reading of the originality requirement and rejection of a similar argument in the term extension context. *Eldred* stated that originality was simply a threshold requirement for a work to receive any copyright protection at all, and had “no bearing” on the constitutionality of the length of that protection.<sup>80</sup>

Second, the Copyright Clause’s preambular requirement that Congress act “to promote the Progress of Science,” as interpreted by *Eldred*, would perhaps be met by a publication right. *Eldred* suggested that the preamble requires Congress to adopt a copyright *system* that promotes progress, and that it is generally for Congress to evaluate a law’s progress-promoting function. The Court appears to have rejected the argument that the preamble means that Congress can act only to “stimulate the creation of new works,”<sup>81</sup> and to have accepted as constitutional a Congressional view that a system that grants some protection to works already in existence can also promote progress as required by the Copyright Clause.

The publication of long-unpublished works can fairly easily be seen as promoting progress in this view; indeed, all U.S. copyright statutes from 1790 on have offered protection in order to encourage such publication. Publication makes a work much more widely available than would otherwise be the case, and that public availability is at the core of the interest in progress embodied in the Copyright Clause. In fact, for almost all of our legal history, Congress reserved federal copyright protection primarily for published works, and made publication the key operative act in obtaining such protection, making clear the centrality of dissemination of works of authorship to its view of the progress of science and useful arts. Today, Congress could no doubt believe that where a work remains unpublished after its copyright has expired, some period of exclusivity would increase the likelihood that the work would eventually be published, and that such publication would promote progress.

*b. History*

The *Eldred* Court, in examining the history of Congress’s exercise of its copyright power, could point to what it viewed as “an unbroken Congressional practice” of extending existing copyrights when revising copyright duration upward as evidence that the Copyright Clause included the power to extend existing

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80. *Eldred v. Ashcroft*, 537 U.S. 186, 211 (2003); see also *Luck’s Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107, 117-18 (D.D.C. 2004) (holding that originality requirement not violated by law granting copyright to foreign works that had fallen into the public domain).

81. *Eldred*, 537 U.S. at 189.

copyrights.<sup>82</sup> History offers less explicit support for a publication right that would remove material from the public domain than it did for term extension.<sup>83</sup> In *Eldred*, the Court could point to at least three undisputed instances, over a long period of time, in which Congress had taken precisely the action under challenge: it had extended the term of protection for existing, unexpired copyrights at the same time that it extended the term for subsequently created works. By contrast, an express publication right for public domain unpublished works would be without exact precedent in prior legislation. (In large part, of course, that is because the opportunity to enact such legislation has never previously arisen: until 2003, the entry of unpublished works into the public domain had essentially never occurred in the United States.)

But history does reveal Congressional practices that may suggest that Congress's power does extend to granting rights in works which had previously entered the public domain. The first Copyright Act in 1790 granted protection to works that had been previously published, which may have included works unprotected by any copyright law or works in which any prior copyright protection had expired. To some extent, though, any federal protection for such works under the 1790 Act should, perhaps, best be viewed as unique given the transitions between colonial, revolutionary, confederation, and federal systems that occurred in the preceding two decades.

The *Eldred* Court seemed to consider private legislation as relevant to the historical inquiry into Congressional power, and Congress enacted several private laws in the nineteenth century extending copyright protection beyond the ordinary term.<sup>84</sup> Five nineteenth-century private laws fairly clearly provided protection to works that had previously entered the public domain.<sup>85</sup> In three instances, in 1849, 1874, and 1898, Congress enacted private bills that provided copyright for works whose authors had failed to comply with the formalities then required to secure or

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82. *Id.* at 200.

83. When Congress has in the past extended the copyright term, it has always limited the extension to works whose copyrights had not yet expired, and has not sought to remove material from the public domain by applying the extension retrospectively. Thus, at least in the term extension context, the unbroken practice has been not to remove material from the public domain.

84. These laws are described in more detail in Tyler Ochoa, *Patent and Copyright Term Extension and the Constitution: A Historical Perspective*, 49 J. COPYRIGHT SOC'Y U.S.A. 19, 46-49 (2001).

85. Three other laws concerned *Rowlett's Tables of Discount or Interest*, by John Rowlett, which was apparently first registered for copyright protection in 1802; Congress granted two additional fourteen-year terms of protection for the work in 1828 and 1842. Act to Continue a Copyright to John Rowlett, ch. 145, 6 Stat. 389 (1828), Act Supplemental to the Act of May 24, 1828, to Continue a Copyright to John Rowlett, ch. 140, 6 Stat. 897 (1843). An 1830 act clarified the notice requirement imposed on Rowlett in the original 1828 extension, Act to Amend "An Act to Continue a Copyright of John Rowlett," ch. 13, 6 Stat. 403 (1828). It is unclear whether the work's copyright had been renewed in 1816 and therefore whether the copyright had expired when Congress offered additional protection in 1828. The 1828 law does provide, however, that "it shall be lawful for any persons or persons who may heretofore have published copies of [Rowlett's] book, or of parts thereof, to sell such as may have been heretofore published," suggesting that the book could lawfully have been published because it was in the public domain before the private act passed. Act to Continue a Copyright to John Rowlett, ch. 145, 6 Stat. 389 (1828). It is possible that the proviso refers to copies that had been printed and held for sale in anticipation of the expiration of the work's renewal copyright in 1830.

renew copyright protection.<sup>86</sup> In these cases, the works had, under ordinary copyright principles, entered the public domain due to the noncompliance, but Congress's action allowed the authors to recover exclusive ownership of their works. In two other laws, Congress provided copyrights for two works that had initially been published under the order of Congress, apparently without securing copyright protection for them upon initial publication; these acts were apparently designed to provide compensation to the authors' relatives.<sup>87</sup> In each of these instances, Congress protected by copyright a work that had already entered the public domain under ordinary copyright law.<sup>88</sup> While Congress acted only once in the nineteenth century, in 1831, to generally extend the term of copyright in works whose term had not yet expired,<sup>89</sup> Congress acted several times to grant copyright in individual works that had passed into the public domain. While this latter historical practice had a narrower impact than the 1831 extension relevant in *Eldred*, it does evidence a Congressional view that the copyright power allowed restoration, and that a work's public domain status was not irrevocable.<sup>90</sup>

In the twentieth century, Congress acted much more broadly to provide copyright protection to works that had already entered the public domain.<sup>91</sup> In 1919 and 1941, Congress authorized the President to provide copyright protection to foreign works that had entered (or would enter) the public domain in the United States for failure (due to war conditions) to comply with required formalities, provided that the copyright owners did subsequently comply.<sup>92</sup> And in 1993 and 1994, to implement U.S. obligations under NAFTA and the TRIPs Agreement, Congress enacted laws that provided copyright protection to works of foreign

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86. An Act for the Relief of Levi H. Corson, and for other Purposes, ch. 57, 9 Stat. 763 (1849); An Act for the Relief of William Tod Helmuth of New York, ch. 534, 18 Stat. 618 (1874); 30 Stat. 1396 (1898) (renewal copyright).

87. An Act for the Relief of Mistress Henry R. Schoolcraft, ch. 16, 11 Stat. 557 (1859) (providing copyright in Henry R. Schoolcraft's *History, Statistics, Condition, and Prospects of the Indian Tribes of the United States* to Mistress Henry R. Schoolcraft); An Act for the Relief of Mrs. William L. Herndon, ch. 99, 14 Stat. 587 (1866) (providing copyright in William L. Herndon's *Exploration of the Valley of the Amazon* to Mrs. William L. Herndon).

88. To the extent that patent practice is deemed relevant to the question, Justice Stevens's dissent in *Eldred* identified fifty-six instances in the nineteenth century in which Congress, by private bill, granted patent protection to an invention that had entered the public domain. *Eldred v. Ashcroft*, 537 U.S. 185, 235 (2003) (Stevens, J., dissenting).

89. As noted above, it appears that Congress also twice acted by private bill to extend the copyright in one particular work in which the term of protection may not have expired. See Ochoa, *supra* note 84, at 46-49.

90. Justice Stevens's dissent in *Eldred* makes clear that he would likely hold any grant of protection in a work that has entered the public domain as beyond Congress's copyright power. *Eldred*, 537 U.S. at 239-40 (Stevens, J., dissenting).

91. One twentieth-century private law, enacted in 1971, granted copyright protection in editions of Mary Baker Eddy's *Science and Health* that had already entered the public domain, but the law was held unconstitutional as a violation of the Establishment Clause. *United Christian Scientists v. Christian Science Board of Directors, First Church of Christ, Scientist*, 829 F.2d 1152 (D.C. Cir. 1987).

92. An Act to amend sections 8 and 21 of the Copyright Act, Pub. L. No. 102, 41 Stat. 368 (1919); An Act to amend section 8 of the Copyright Act of March 4, 1909, as amended, so as to preserve the rights of authors during the present emergency, and for other purposes, Pub. L. No. 258, 55 Stat. 732 (1941).

origin that had entered the public domain in the United States due to the copyright owner's earlier failure to comply with formalities.<sup>93</sup> The current statute has thus *automatically* restored copyright protection to a great many works that were previously in the public domain in the United States, often for many years. And those public domain works were often being exploited here, as the statute recognizes in providing conditions for notice to, and grace periods for, parties who were using the works in reliance upon their public domain status.<sup>94</sup> To the extent that Congressional practice in the twentieth century bears on the determination of the meaning of the Copyright Clause, that practice may support the view that the clause sometimes empowers Congress to remove works from the public domain for a limited time.

The current statutory restoration provisions offer perhaps the least guidance on the historical inquiry relevant under *Eldred* because they are so recent. But those provisions have provided an avenue for judicial interpretation of the scope of Congress's copyright power over works that have entered the public domain, because their constitutionality has been challenged in two recent cases.<sup>95</sup> In both cases, courts have so far upheld the restorations as legitimate exercises of Congress's power. The district courts in both cases relied in large part on the historical evidence of the 1790 Act and the twentieth-century wartime acts.<sup>96</sup> The D.C. Circuit relied primarily on the *Eldred* decision and the parallels between the arguments rejected in that case and the arguments advanced against the restoration acts.<sup>97</sup> The court concluded that the challengers "are wrong that the [Copyright] Clause creates any categorical ban on Congress's removing works from the public domain."<sup>98</sup> Essentially, the court concluded that the challengers "completely fail to adduce any substantive distinction between the imbalance (if it be that) in tacking

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93. Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809 (1994) (implementing TRIPs and restoring copyrights in all types of works); North American Free Trade Agreement Implementation Act, Pub. L. 103-182, 107 Stat. 2057 (1993) (implementing NAFTA and restoring copyrights in motion pictures only). These provisions are codified at 17 U.S.C. § 104A. For a detailed discussion of the scope and interpretation of Section 104A, see William Gable, *Restoration of Copyrights: Dueling Trolls and Other Oddities Under Section 104A of the Copyright Act*, 29 COLUM. J. L. & THE ARTS 181 (2005).

94. The 1919 and 1941 laws also provided relief to those who had used the works before copyright was restored.

95. *Luck's Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107 (D.D.C. 2004), *aff'd* 407 F.3d 1262 (D.C. Cir. 2005); *Golan v. Gonzales*, 74 U.S.P.Q.2d (BNA) 1808 (D. Colo. Apr. 20, 2005). The district court's decision in *Golan* has apparently been appealed, but no appellate decision has yet been issued.

96. The *Luck's Music* court also rejected arguments that restoration would not promote the progress of science and that it was forbidden by the requirement that copyright extend only to original works. *Luck's Music*, 321 F. Supp. 2d at 117-18.

97. For example, the court noted the argument that copyright restoration would not provide any incentive to create with respect to the works in which protection was granted (since they had already been created before the copyright was restored). But the court read the *Eldred* decision to indicate that despite the lack of incentive, Congress *can* grant protection to works already produced, as it did in granting an additional twenty years of protection in the extension act approved in *Eldred*. 407 F.3d. at 1263-64.

98. *Id.* at 1263.

20 years onto a copyright term about to expire in (say) a year, and extending protection to material that has fallen into the public domain.”<sup>99</sup> Because *Eldred* read the Copyright Clause to grant Congress the power to take the former step, the D.C. Circuit concluded that the Clause similarly empowers Congress to take the latter step. To the extent these decisions hold that the Copyright Clause allows Congress to grant exclusive rights in works that have already entered the public domain, they could support Congress’s power to grant a publication right.

It is important to recognize, though, that the historical precedents for granting exclusive rights in works that have entered the public domain differ in important ways from a publication right, and those differences may in some ways weaken, and in some ways strengthen, the support that Congress’s historical practice lends to an interpretation that the Copyright Clause permits enactment of a publication right.

Virtually all of the previous restorations, whether by private bill, by wartime acts, or by amendments designed to comply with international obligations, have restored copyright to works that were in the public domain in the United States not through expiration of their ordinary maximum possible copyright term, but rather for failure to comply with the formalities necessary to obtain an initial or renewal copyright. Thus, under the restoration acts, the works that copyright law retrieved from the public domain would enjoy at most a total copyright term that was no greater than they would have enjoyed if their owners had properly and timely complied with the required formalities.<sup>100</sup> Under a publication right, however, an unpublished work would have enjoyed its full potential term under then-applicable copyright law, and then gain an additional term of protection.<sup>101</sup> Thus, a court might conclude that the historical record demonstrates only that Congress’s copyright power allows it to grant the ordinary term of copyright to works that have entered the public domain through what Congress deems to be excusable or justified failure to comply with required formalities, but that the power does not allow granting protection to a work that properly acquired and maintained federal copyright protection and entered the public domain through the normal process of expiration of such protection.

On the other hand, another way in which the publication right differs from all previous grants of copyright in public domain works might lead the Court to find a publication right constitutional even if it were to find, contrary to the lower court

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99. *Id.* at 1265.

100. In fact, these works would likely have been protected in total for less than the maximum possible term of protection, since the restoration acts do not appear generally to have allowed copyright owners to “recoup” the time during which their works were in the public domain due to noncompliance with formalities; instead, they allowed the owners to enjoy the *remainder* of their ordinary term of protection.

101. Of course, it may be somewhat difficult to determine the baseline for computing an unpublished work’s “full term” of ordinary protection. Before 1978, the full potential term would have been indefinite and potentially perpetual protection under common law copyright, plus a maximum term of fifty-six years of federal statutory protection. For a work that remained unpublished as of 2003, even a grant of a twenty-five-year publication right would result in a much shorter term of total protection than was previously available.

decisions so far, that the current statutory restoration provisions are outside the scope of Congress's power and are unsupported by the limited prior practice of private and wartime restorations. In all of the earlier instances of restoration, the works affected were in the public domain because they had been *published* (usually without accompanying fulfillment of the required formalities). As a result, removing the work from the public domain meant ending the public's right to use material that it in fact could have used (and in many cases was using), because copies had been offered to the public. Indeed, Congress's routine protection, in past and current restoration provisions, of those who had used works before the copyright was revived, recognizes that restoration could interfere with the activities of people who were both legally entitled to use the work and practically able to do so.<sup>102</sup>

The publication right, however, would apply only to previously *unpublished* works. While these works are in the public domain as a legal matter, free for use without any permission, they are not necessarily in the public domain in the sense of actually being accessible for anyone to use. They generally exist in a single copy so that anyone wishing to use the work would need to obtain that copy, or access to it, and the person who owns the copy would generally be free to deny such access. To the extent that a publication right would keep the public from using a work after its copyright term expires, it would not necessarily restrict any use that would actually take place if the work remained technically in the public domain, since the work would not necessarily be available for anyone to use. The right would not generally interfere with any third-party activity previously undertaken in reliance on a work's public domain status, since by definition no one would have engaged in any public exploitation of the work before its publication.<sup>103</sup>

Historical practice thus offers no precise precedent of Congress withdrawing material from the public domain in the way that a publication right would. But history does show Congressional actions that could support a court's interpretation

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102. See, e.g., An Act to Continue a Copy-right to John Rowlett, ch. 145, 6 Stat. 389 (1828); An Act for the Relief of Levi H. Corson, and for other Purposes, ch. 57, 9 Stat. 763 (1849); 17 U.S.C. § 104A.

103. A publication right could, of course, interfere with the expectation that all of an author's works will be in the public domain seventy years after an author's death. Usually, though, only someone with access to a copy of the work would be able to undertake any preparations to use the work in anticipation of the seventieth anniversary of the author's death, and a publication right that turns on lawful publication, and defines lawful as derived from lawful access to a copy of the work, would not interfere with that party's activity. In any event, the expectation that all of an author's works will expire seventy years after her death is not absolute, even in the absence of a publication right. This expectation, in any event, seems weakest as to an author's works that have not been (and might never be) disclosed to the public. The expectation does not hold today for any author who published any work before 1978. In addition, any work that an author produces for hire will generally expire at a different time from her other works, as will any joint works of which she is a co-author. And where an author bases a work on some underlying work, that underlying work's copyright may often last for more than seventy years after the author's death and restrict what use can be made of the author's derivative work, even though it enters the public domain at that point. See, e.g., *Russell v. Price*, 612 F.3d 1123 (9th Cir. 1979).



of the Copyright Clause that as permitting Congress to grant a publication right.

*c. Judicial Precedent*

The Supreme Court has sometimes expressed concern about the constitutionality of laws that would allow the recapture of material from the public domain (though those expressions have not always involved copyrighted works). Most significantly, in *Graham v. John Deere Co.*, the Supreme Court, in discussing the scope of Congress's patent power, noted that "Congress may not 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."<sup>104</sup> Any challenge to a publication right might argue that *Graham* is equally applicable to the copyright context and thus bars Congress from granting exclusive rights in unpublished public domain works and thereby removing them from the public domain.

More recently, in *Dastar Corp. v. Twentieth Century Fox Film Corp.*, the Court interpreted Section 43(a) of the Lanham Act with a strong concern that rights against unfair competition not interfere with works of authorship in the public domain.<sup>105</sup> The Court said that when a copyright expires, the right to copy the work, with or without attribution, passes to the public. Imposing a right under unfair competition law against misattribution of such a work, the court held, "would create a species of mutant copyright law that limits the public's federal right to copy and to use expired copyrights."<sup>106</sup> And the Court concluded that "[t]o hold otherwise would be akin to finding that § 43(a) created a species of perpetual patent and copyright, which Congress may not do."<sup>107</sup>

The Supreme Court's concerns about intrusion into the public domain, however, have all involved public domain material that is, in fact, publicly accessible.<sup>108</sup> With respect to copyright law, that makes perfect sense, since traditionally only published works have generally been in the public domain. Only with the new unpublished public domain has copyright protection expired in a substantial amount of material that has not been publicly disseminated. Because unpublished works have not been made available to the public, their new "public domain" status differs substantially from the status of publicly available public domain material that the Supreme Court has previously shown an interest in protecting against exclusive control. As a result, even if the Court were to decide that conferring copyright protection on previously published public domain works—as Congress

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104. 383 U.S. 1, 6 (1966).

105. 539 U.S. 23 (2003).

106. *Id.* at 33 (internal quotation marks omitted).

107. *Id.* at 37.

108. The cases quoted and cited by the *Dastar* Court (*Sears*, *TraFFix*, and *Bonito Boats*), on the public's right to copy public domain material, all involved items that had been sold to the public by the party seeking to prevent others from copying. *Id.* at 33. And the material at issue in *Dastar* itself had been sold on videocassette to the public for some time before the defendant copied the work and offered it for sale.

did for foreign works in the 1990s—is unconstitutional, it might nonetheless decide that Congress could create a limited exclusive right in the first publisher of a previously unpublished public domain work.

The effect of granting a publication right in unpublished works would differ significantly from the effect of restoring copyright in published works. Such a right would not “restrict free access to materials already available” or remove works from the public domain traditionally understood as works legally and factually available for use. And, as noted above, it would not generally interfere with any activity undertaken in reliance on a work’s public domain status.

In addition, a publication right would differ from the attribution right rejected in *Dastar*. A publication right, after all, would involve express legislation by Congress, while the *Dastar* Court was motivated in part by a desire not to interpret ambiguous language in the Lanham Act in a way that would significantly interfere with the public domain expressly created by the Copyright Act. To the extent that the *Dastar* decision was based on a view that Congress does not have the power to grant an attribution right along the lines of that contended for by the plaintiffs there, the Court seemed to rest that conclusion on the fact that such a right would interfere with the public’s freedom to copy indefinitely, and thus be akin to “a species of perpetual . . . copyright.”<sup>109</sup> A twenty-five year publication right would obviously restrict use of previously public domain material for a much shorter time than would an indefinite and potentially perpetual trademark-based right to attribution.

In sum, while the text, history, and judicial precedents in no way definitively answer the question of whether the Copyright Clause gives Congress the power to remove a work from the public domain, the Court could arguably find such a power consistent with all three sources.<sup>110</sup>

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109. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 537 U.S. 23, 37 (2003).

110. By contrast, if Justice Breyer adheres to his dissenting views in *Eldred*, he would rather clearly find a publication right beyond Congress’s power. In *Eldred*, Justice Breyer rejected claims that the CTEA could be justified as providing incentives for republishing older works as “inconsistent with the basic purpose of the Copyright Clause.” *Eldred v. Ashcroft*, 537 U.S. 186, 260 (2009) (Breyer, J., dissenting). The Clause, he wrote, “assumes that it is the *disappearance* of the monopoly grant, not its *perpetuation*, that will, on balance, promote the dissemination of works already in existence.” *Id.* This view, he wrote, “den[ies] Congress the Copyright Clause power to base its actions primarily upon [the] empirical possibility” that on occasion additional copyright protection might help resurrect a long-lost work. *Id.* A publication right might be distinguished from the perpetuation of the copyright that Justice Breyer directly addressed, since the right would be directed to encouraging *initial* publication of a work that has never before been disseminated, rather than to encouraging the republication of a work that was once published but that has long since gone out of print. But Justice Breyer’s position seems clearly to suggest that any dissemination advantages that might accrue from exclusive control rather than public domain status could not justify reading Congress’s power as permitting it to remove works from the public domain after their ordinary term has expired.

### 3. Grant of Rights Not to the Author

#### *a. Text*

The third likely objection to a publication right as beyond Congress's power stems from the Copyright Clause language allowing Congress to secure to "Authors . . . the exclusive Rights in their . . . Writings."<sup>111</sup> A publication right would obviously inure not to an unpublished work's author, who will necessarily have long been dead, but to someone who publishes the author's work long after it was created. The Supreme Court has provided very little interpretation of the word "Author" in the Copyright Clause beyond explaining that it means "he to whom anything owes its origin; originator; maker; one who completes a work of science or literature."<sup>112</sup> The recipient of a publication right, though, would clearly not come within even the Court's broad reading of the term "Author."

#### *b. History*

*Eldred's* command to look to history may, however, provide support for the publication right that the use of the word "Author" in the text of the Copyright Clause does not. Congress, after all, has often granted copyright protection to persons other than the actual human creator of a work, the person usually understood in the lay sense as the work's author, the person to whom the work owes its origin.<sup>113</sup> From 1790 through 1977, federal copyright protection in a work of authorship was obtained not by the act of creating a work, but rather by complying with the statutorily prescribed formalities, principally by publishing the work with a proper copyright notice.<sup>114</sup> Copyright acts from 1790 forward expressly contemplated that a person other than the author, having obtained the common law copyright from the author, could comply with the formalities and that that person, whom the statute referred to as the "proprietor," would thereby receive the statutory copyright in her own name.<sup>115</sup> Thus, for nearly 170 years, Congress exercised its Copyright Clause power by granting exclusive rights not directly to the author, but rather to someone—usually someone who published the work—who

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111. U.S. CONST. art. I, § 1, cl. 8.

112. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884). The Court has also indicated that Congress's inability to grant copyright to works that are not "original" stems in part from the Clause's language allowing Congress to protect only the work of "Authors." *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). As noted above, text accompanying *supra* note 80, the *Eldred* Court's approach to originality suggests that as long as the work was original when it was created, Congress can grant or extend rights in it, even though the work has already been created, and in a sense is no longer "original" at the time of the grant.

113. *See Cmty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989) ("As a general rule, the author is the party who actually creates the work . . .").

114. Those formalities varied over time but typically required registration and deposit before and/or after publication, as well as the publication of copies of the work with proper copyright notice.

115. *See, e.g.*, 1 Stat. 124, § 1 (author's "assigns" can acquire copyright); 4 Stat. 436, § 1 (same); 16 Stat. 212, § 86 (same); 1873 Rev. Stat. § 4952 (same).

could trace a claim to those rights back through a chain of title to the author.

The history of renewal copyright from at least 1831 to 2005 provides another example of unquestioned Congressional grants of exclusive rights under the Copyright Clause to persons other than an “Author.”<sup>116</sup> From 1790 on, when a work’s initial copyright term expired, a second term of protection was in most cases available (upon compliance with renewal formalities). Starting in 1831, the statute specified that the renewal term vested in the author, if she was then living. If the author was not alive when the time came to renew, however, the statute provided that the renewal copyright would vest in the author’s surviving spouse and children.<sup>117</sup> This renewal copyright was not simply an extension of the time period of the initial copyright that inured to the benefit of whoever happened to own that copyright when the initial term expired. Instead, it was what courts came to describe as a “new estate”—a new grant by Congress of exclusive rights, separate from the initial copyright and unencumbered by any transfers of that initial copyright.<sup>118</sup> The exclusive rights in a work in its renewal term did not necessarily vest in the actual “Author” of the work, as a strict reading of the Copyright Clause would seem to require. Instead, they often vested by statute in the author’s surviving family members or, under later acts, in the beneficiaries of the author’s will or her estate.

Congress has thus engaged in a consistent practice of granting exclusive rights under the Copyright Clause not just directly to the author, as the text’s express language might be read to dictate, but also in many cases to parties with some connection, direct or indirect, to the author. In the renewal context, the grantee’s relationship with the author was often a familial one of marriage or parenthood. In many cases, though, the party obtaining an initial-term federal copyright up until 1978 was simply someone who could trace her interest in the work back to the author through a chain of title. The author might have expressly transferred the right to take out the federal copyright, though many courts took the position that the transfer of the author’s original copy of her work—the manuscript of a song or story, for example, or the canvas on which a painting had been made—was *presumed* also to transfer to the recipient the right to obtain a copyright in the work.<sup>119</sup>

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116. The renewal provisions of the 1790 Act were ambiguous on this score. They required that a work’s author or authors be alive at the end of the initial term in order for the copyright to be renewable, but provided that if that was the case and if the formalities were followed, the copyright “shall be continued to him or them, his or their executors, administrators or assigns” for the renewal term. 1 Stat. 124 (1790). Whether this allowed the renewal term to be granted to someone other than an author is unclear from the text, and there are no cases on that issue.

117. 4 Stat. 436 (1831). The 1870 revision retained this provision. 16 Stat. 212, § 88. In 1909, the statute was amended to provide that if the author left no surviving spouse or child, when the time came to renew, the renewal term could vest in the author’s executor or, in the absence of a will, her next of kin; the 1976 act continued this provision for works published before 1978. Copyright Act of 1909, § 23; 17 U.S.C. § 304(a).

118. *See, e.g.,* G. Ricordi & Co. v. Paramount Pictures, Inc., 189 F.2d 469, 471 (2d Cir. 1951) (“A copyright renewal creates a new estate, and the few cases which have dealt with the subject assert that the new estate is clear of all rights, interests or licenses granted under the original copyright.”).

119. *See* Pushman v. New York Graphic Soc’y, 287 N.Y. 302 (1942). With respect to works of

If Congress were to grant a publication right to the first person to publish a previously unpublished public domain work, vesting that right in someone other than the author would arguably be only a somewhat more attenuated instance of the principles at work in these earlier instances of copyright grants to non-authors. The party acquiring the publication right would do so by publishing the work, which would require possessing the copy in which the work is embodied (or obtaining permission from the party in possession of that copy). Because the manuscript originated with the author herself, the current possessor is at the end of a chain of title that begins with the author. That chain might be very short: the author herself may have conveyed copies of her unpublished works to an archive, which many years later itself publishes the work (and thereby claims the publication right).<sup>120</sup> Or the chain might be very long, with the copy having changed hands many times before reaching its current possessor.<sup>121</sup> But that, of course, could have been equally true in the case of any person who secured the copyright in any work first published before 1978—the copyright could well have initially vested in someone very far removed from the author through a long series of intermediate assignments and transfers.

While these historical precedents offer support for grants of protection to non-authors who can trace their rights back to authors, the Court might find a publication right distinguishable, and the historical practice thus less relevant. The owner of the copy of an unpublished public domain work, who would be able to claim the publication right by publishing, would generally be a person or institution farther removed from the actual author than were the usual renewal beneficiaries when renewal was available. And while for most of our history, the proprietor of a manuscript protected by common law copyright could obtain a statutory copyright by proper publication, such a proprietor was someone who had succeeded to the original author's common law copyright. By contrast, someone who possesses the original copy of an unpublished work might be able to trace ownership of the copy back to the author, but ownership of the copyright might well have been separately disposed of (prior to its expiration). The most common instance might involve letters. Generally, the author of a letter is deemed to have transferred ownership of

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fine art, New York altered this presumption by statute in 1966. See Elizabeth Townsend Gard, *January 1, 2003: The Birth of the Unpublished Public Domain and Its International Consequences*, 24 CARDOZO ARTS & ENT. L.J. 687, 702 & n.78 (2006). The 1976 Act also adopted a contrary position with respect to federal copyright. 17 U.S.C. § 202 (2000).

120. The author may have expressly transferred not only her copy of the work, but all rights and interests of any sort attaching thereto, or the transfer of the copy may have been silent as to anything beyond the ownership of the chattel, but as noted above, *supra* text accompanying note 119, that could also have occurred in pre-1978 situations in which the federal copyright was obtained by someone other than the author who had complied with the statutory formalities.

121. Indeed, it may not be easy to determine the proper owner of copies of older unpublished works. See, e.g., *Chamberlain v. Feldman*, 89 N.E.2d 863, 864 (N.Y. 1949) (discussing conflicting findings in trial and appellate courts over whether Mark Twain's manuscript of the story, *A Murder, a Mystery and a Marriage*, had ever been transferred by Twain); *Polygram Records, Inc. v. Legacy Entm't Group, LLC*, 205 S.W.3d 439, 441–46 (Tenn. Ct. App. 2006) (discussing ownership of acetate recordings of live performances of Hank Williams and The Drifting Cowboys made, and later discarded, by the radio station that broadcast the performances).

the physical embodiment of the letter to the recipient, but to have retained ownership in the literary (or other) works embodied in the letter.<sup>122</sup> While the recipient might donate the letter to an archive, the author might at death dispose of all of her copyright interests, including those in the letter, to a literary executor. If the archive, by publishing the letter after its copyright expires, could acquire a period of exclusive rights in the letter, the grant of rights by Congress would arguably be to a party that could not trace its interest back through any chain of title to the author's *copyright* interest. Thus, while history offers substantial evidence of Congressional grants under the Copyright Clause to non-authors, the Court might nonetheless conclude that the beneficiaries of a publication right are too far removed from the authors of the covered works to justify the right by reference to historical practice.

In sum, even though a publication right would grant exclusive rights in a work of authorship to someone other than the work's author, it is possible, though by no means certain, that the Court would conclude that such a grant would be within the scope of Congress's power under the Copyright Clause, given the historical practice of vesting copyrights themselves in persons other than actual "Authors."<sup>123</sup>

#### D. WOULD A PUBLICATION RIGHT BE A RATIONAL EXERCISE OF POWER?

If the Court determines that the Copyright Clause includes the power to grant a limited term of exclusivity to the first publisher of a previously unpublished work in which the ordinary term of copyright has expired, then a statute granting a publication right along the lines of the E.U. right, or perhaps more narrowly, would likely be a rational exercise of that power.<sup>124</sup> In some instances, the costs to publish a previously unpublished work could possibly exceed the return to be made if the publisher faces competitive copyists, so that publishers would choose not to make the work available to the public. In such instances, granting a limited exclusive right would encourage publication and thereby further the Copyright Clause goal of promoting progress.

Indeed, the publication right would likely be a more rational means of encouraging the publication of previously unpublished works than was the pre-1978 combination of indefinite common law copyright protection for unpublished works and a post-publication term of statutory copyright. Copyright in old

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122. See, e.g., *Salinger v. Random House*, 811 F.2d 90 (2d Cir. 1987); *Baker v. Libbie*, 210 Mass. 599 (1912).

123. Again, Justice Breyer's *Eldred* dissent indicates that he would likely view a publication right that vested in a *publisher* or *copy owner* (and not an author) as beyond the scope of the copyright power. 537 U.S. 186, 261 (2003) (Breyer, J., dissenting) (reading of Copyright Clause as requiring public domain status, rather than exclusive control, as means of increasing dissemination of older existing works finds "textual support in the word 'Authors,' which is difficult to reconcile with a rationale that rests entirely upon the incentives given to publishers perhaps long after the death of the work's creator").

124. As noted above, *supra* note 110, it seems fairly clear that Justice Breyer's views in *Eldred* would lead him to conclude that a publication right would not be a rational exercise of the copyright power.

unpublished works can greatly hinder their initial publication because of the difficulty of identifying and locating the current copyright owner to obtain permission. For example, one who wishes to publish letters written by an ordinary Civil War soldier who died in 1865 would today likely be extremely hard pressed to determine to whom the soldier's common law copyright rights have descended.<sup>125</sup> Such difficulties convinced Congress not to further extend Section 303's twenty-five-year minimum term as part of the CTEA<sup>126</sup> The publication right, though, would impose no such hindrance to initial publication, at least to the extent that the right could be acquired by lawfully publishing the work and that such lawful publication merely requires that the publisher obtained access to the copy of the work lawfully (not, for example, by theft or fraud) from the owner of that copy. One would not need to identify and locate any copyright owners in order to publish a public domain unpublished work, or to obtain the publication right in the work. Instead, one would generally only need to deal with the lawful owner of the *copy* of the work—the party with whom a publisher would likely need to deal even in the absence of a publication right (in order to get the access necessary to publish the work).

In sum, the Court might well conclude that the Copyright Clause gives Congress the authority to grant copyright-like protection to unpublished works that have already entered the public domain, and that a publication right in previously unpublished public domain works is a rational exercise by Congress of that authority. Such a conclusion would not be a significant departure from the general trend of the Court's Copyright Clause decisions reading Congress's power broadly.

### III. CONCLUSION

The analysis of whether Congress has the power to grant a publication right makes clear that *Eldred's* interpretive approach to the Copyright Clause allows the Court to read the clause very broadly—broadly enough to encompass the power to enact something as novel in U.S. law as a publication right in unpublished public domain works would be. This broad approach to Congressional power is consistent with most of the Court's prior Copyright Clause jurisprudence in cases such as *Burrow-Giles*, *Bleistein*, and *Goldstein v. California* (though perhaps not with the approach in *Feist*, the Court's most recent pre-*Eldred* Copyright Clause decision). It is worth noting, however, that all of the Supreme Court's earlier Copyright Clause cases involved questions about the scope of subject matter that Congress could protect using its copyright power,<sup>127</sup> or the standards that such subject matter

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125. Peter B. Hirtle, *Unpublished Materials, New Technologies, and Copyright: Facilitating Scholarly Use*, 49 J. COPYRIGHT SOC'Y U.S.A. 259, 273–74 (2001).

126. See S. REP. NO. 104-315, at 14-15 (1996) (explaining amendment of bill to eliminate original ten-year extension of Section 303(a)'s minimum term); H.R. REP. NO. 105-452 at 7 (1998) (“These older works by definition have not been subject to commercial exploitation, so that the benefit from extending the term of protection for this category of works do [*sic*] not outweigh the detriments from limiting public access to these often historically significant works.”).

127. *E.g.*, *The Trade-Mark Cases*, 100 U.S. 82 (1879) (trademarks not necessarily original

must meet in order for Congress to be able to protect it.<sup>128</sup> *Eldred* is the first Supreme Court case to apply the Copyright Clause to issues beyond the question of subject matter and standards, and the decision may thus signal that the Court will maintain its traditionally broad reading of Congress's copyright power in other areas, including not only the question of duration considered in *Eldred*, but also the kinds of issues that would be raised by the enactment of a publication right.

Considering a publication right under the approach set forth in *Eldred* also shows that the *Eldred* Court's reliance on history for guidance in interpreting Congress's power may offer only limited assistance in marking out the boundaries of that power in future cases. The *Eldred* Court, in reviewing the CTEA, could easily rely on the historical precedent of a long pattern of Congressional practice, since Congress had, on a number of past occasions, taken precisely the same action as it took in the CTEA: it had extended the terms of all existing and unexpired copyrights simultaneously with the grant of a new, longer term for subsequently created works. The use of the historical record becomes more difficult, however, when Congressional action becomes more innovative, as the analysis of a potential publication right demonstrates. In such situations, past enactments will at most be somewhat similar, and somewhat different, from the challenged law. Thus, history will offer at best more ambiguous support for such new laws than the history of Congressional practice offered for the CTEA.

My discussion in this article has centered on the predictive question of how the Court *might* respond to a challenge to a publication right if Congress were to enact such a right, rather than on the normative question of how the Court *should* respond to such a challenge. There may be reasons, though, to think that, at least on this issue, reading Congressional power broadly enough to encompass a publication right might be desirable, primarily because of the flexibility that such a reading would give Congress in dealing with the question of unpublished works.

After all, the 1976 Act represented a fundamental shift in course from a system that dated back to the first days of the republic. Congress for the first time provided unpublished works with federal protection for a limited time. This created a system of uniform federal protection for works of authorship, whether published or not, and it ended the tradition of indefinite and potentially perpetual protection for unpublished works. There are many reasons to think that the change was a positive one. It eliminated potential disuniformity of state protection for unpublished works. It allows, at some definite point, the use of older unpublished works without the complexity of determining from whom copyright permission must be obtained. And it might provide incentives to copyright owners to publish works sooner, rather than later, in order to enjoy the benefits of copyright

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"Writings" of "Authors"); *Burrow-Giles Lithographic Co. v. Saroni*, 111 U.S. 53 (1884) (photographs can be original "Writings" of "Authors"); *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903) (protection for circus posters not barred as not promoting the progress of science and useful arts); *Goldstein v. California*, 412 U.S. 546 (1973). (sound recordings can be original "Writings" of "Authors").

128. *E.g.*, *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340 (1991) (work must be minimally creative in order to qualify as "Writing" of "Author" subject to copyright protection).



protection in those works. But it certainly seems possible (though unlikely) that we might discover after some experience with this new system that it has adverse effects. In particular, it might turn out that older unpublished works (now in the public domain) would not be published as often as they were in the past, because of the lack of copyright protection for them upon publication.

I think that outcome is unlikely, but if that were to prove to be the case, then we would probably want Congress to be able to act to adjust the system in order to try to get more older works published. Congress might want to maintain many of the benefits of the unified system and limited term for unpublished works, while providing some incentive for publishing unpublished public domain works in circumstances where that incentive would likely get more such works published. But if the Court reads the Copyright Clause as not including the power to grant something like a publication right in an unpublished work that has entered the public domain, then Congress's options could be rather limited. Congress could, presumably, amend the copyright law so that each new original work of authorship would be protected from its creation until, for example, seventy years after the death of the author *or* ninety-five years after its publication, whichever comes later, effectively reinstating indefinite and potentially perpetual protection for unpublished works. But that might be a less desirable solution than a publication right, since it would have the disadvantage of eventually requiring someone who wanted to publish an unpublished work by a long-dead author to determine who owns the copyright in a work created many decades earlier in order to get permission to exploit it. If the Court reads the Copyright Clause as barring Congress from granting rights in unpublished works that have entered the public domain, however, the old system of indefinite and potentially perpetual protection for unpublished works, followed by a full term of copyright protection upon publication, might be the only option available to Congress to address a potential lack of incentives for the initial publication of unpublished public domain works, despite the disadvantages of such protection in comparison to a publication right.

I want to conclude by emphasizing that, as I have discussed in greater detail elsewhere,<sup>129</sup> I remain extremely skeptical that a strong case can be made that a publication right will in fact be needed to spur the publication of unpublished public domain works, or that any possible benefits of a publication right would be likely to outweigh its considerable costs. It might well be desirable for the Court to interpret the Copyright Clause broadly enough, under *Eldred's* interpretive approach, to give Congress the flexibility to enact a publication right in the unlikely event that genuine and strong evidence was to emerge that some period of post-publication exclusivity is required in order for most long unpublished works in the public domain to be made accessible to the public. But Congress should exercise that flexibility only in the event of truly demonstrated need that cannot be met through any less costly method.

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129. R. Anthony Reese, *Public But Private: Copyright's New Unpublished Public Domain*, 85 TEXAS L. REV. 585, 652-63 (2007).