Golan v. Holder: Lessons for Patent Lawyers Too

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Golan addresses the legitimacy of affording copyright protection to previously unprotected works, but much in the opinion bears equally on patent law.

Those who regard the United States as a bastion of strong intellectual property (IP) protection may be surprised to learn that it was once regarded as "the Barbary coast of literature," populated by "the buccaneers of books." Golan v. Holder, 2012 WL 125436 at *5. An 1891 Act did much to end that well-deserved reputation, but, by conditioning copyrights on domestic publication, discrimination against foreign authors continued. *Id*. Moreover, the need to renew registrations and publish with notice was unfair to foreign authors accustomed to regimes lacking such requirements. The need for renewal ended in 1976 and the need for notice upon publication ended in 1988. Meanwhile, many foreign works forfeited protection.

In 1994, we made amends by "restoring" protection under 17 U.S.C. 104A. *Id*. at *6. Yet, as the court points out, many affected works never enjoyed U.S. Copyright protection. *Id*. At *7 n. 13. Motivated by solicitude for current and past users of such works as well as the Fifth Amendment, Congress ameliorated the effects of restoration. See, e.g., *id*. at *16, n. 33. Yet some parties obligated to pay for what they had freely used were not satisfied. Filing suit in 2001, they argued that restoration exceeded the power conferred by the IP clause and offended the First Amendment. *Id*. at *8.

As to the former argument, the Court finds, "no… barrier in the text of the Copyright Clause, historical practice, or our precedents." *Id*. at *9. "Notably, the Copyright Act of 1790 granted protection to many works previously in the public domain." *Id*. Also, several private bills, as well as several pieces of general legislation, dating from the 1800s through the end of World War II, reinstated patent and copyright protection. Most apparently went unchallenged. A few private bills reinstating expired patents were upheld, however. *Id*. at *10-11. Indeed, in one opinion, the Court found the owner of a machine constructed during the lapse of the patent to be liable for damages once it was reinstated. Evans v. Jordan, 9 Cranch 199, 204 (1815). Any serious question about congressional power surely would have been raised, but the opinion is devoted to statutory interpretation.

Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966), is also considered because it says, "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." *Id*. at 6. *Golan*, however, dismisses that statement not only as dicta but also as "not speak[ing] to the constitutional limits on Congress' copyright

and patent authority." *Id*. at *11.

The *Golan* majority also dismisses Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 479–484, (1974), and another case cited at *31 in Justice Breyer's dissent, saying, "Neither decision remotely ascribed constitutional significance to a work's public domain status." *Id*. at *15.

The preamble to the IP Clause sets progress as its goal. But *Golan* holds, "The creation of at least one new work, however, is not the sole way Congress may promote knowledge and learning." *Id*. at *12. It also points out that Eldred v. Ashcroft, 537 U.S. 186, 222 (2003), rejects a nearly identical argument. *Id*.

Having noted, "Perhaps counterintuitively for the contemporary reader, Congress' copyright authority is tied to the progress of science; its patent authority, to the progress of the useful arts," the Court narrows its focus. *Id*. "Even were we writing on a clean slate, [n]othing in the text of the Copyright Clause confines the "Progress of Science" exclusively to "incentives for creation." *Id*. Applying the rational basis test, the Court concludes that enacting § 104A, "Congress had reason to believe, would expand the foreign markets available to U.S. authors and invigorate protection against piracy of U.S. works abroad," *Id*.

Golan then turning to the First Amendment finds, "nothing in the historical record, congressional practice, or our own jurisprudence warrants exceptional First Amendment solicitude for copyrighted works that were once in the public domain" — at least when it is "not faced, for example, with copyright protection that hinges on the author's viewpoint." *Id*. at *15.

Although little of the First Amendment analysis bears on patent law, one portion of the opinion warrants attention. According to petitioners, it says, § 104A "impermissibly revoked their right to exploit foreign works that "belonged to them" once the works were in the public domain." *Id*. The majority, however, is unconvinced: "Rights typically vest at the outset of copyright protection…. Once the term of protection ends, the works do not revest in any rightholder. Instead, the works simply lapse into the public domain. Anyone has free access to the public domain, but no one… acquires ownership rights in the once-protected works." *Id*. at 16 (citations omitted).

The majority then goes on to note, pointedly it seems, that § 104A merely "places foreign works in the position they would have occupied if the current regime had been in effect when those works were created and first published. [It] gives them nothing more than the benefit of their labors during whatever time remains before the normal copyright term expires." *Id*. at 17. Indeed, the *Golan* majority chides the dissent for

protesting removal of material from the public domain without considering how it got there initially. *Id*. n. 35.