

**PATENT AND COPYRIGHT TERM EXTENSION AND THE  
CONSTITUTION: A HISTORICAL PERSPECTIVE\***

by TYLER T. OCHOA\*\*

*The U.S. Constitution provides that patents and copyrights may only be granted “for limited Times.” This article analyzes the constitutionality of the Sonny Bono Copyright Term Extension Act of 1998 (CTEA) in light of the long history of congressional extensions of patents and copyrights. Congress has retroactively extended copyrights each time it has changed the basic term, a practice that has gone unchallenged until now; but only two copyrights have been extended by private legislation, and one of those extensions was invalidated as a violation of the Establishment Clause. By contrast, patents have been extended fewer times by general legislation, but many more times by private legislation. Between 1809 and 1874 (and again in 1962), many of those private patent term extensions were challenged in court as unconstitutional on various grounds, and all were upheld. Except for a single summary affirmance, however, none of these decisions were rendered by the U.S. Supreme Court; and the meaning of the phrase “for limited Times” was never expressly addressed or settled. (Congress has also extended many design patents on the insignia of various patriotic organizations, but the author concludes that these extensions are more properly treated as trademark legislation.)*

*The U.S. Supreme Court recently granted certiorari to review the two opinions of the D.C. Circuit in *Eldred v. Reno* and *Eldred v. Ashcroft*, upholding the constitutionality of the CTEA. The view of the Patent and Copyright Clause expressed in those opinions, that Congress may extend a patent or copyright for any finite term it chooses, does violence to the language and purpose of the*

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Clause, as it has been interpreted by the U.S. Supreme Court in recent decades. The alternative position that retroactive term extension is absolutely forbidden by the Clause has an appealing simplicity, but it is difficult to maintain in light of the long history of patent term extensions which were upheld in the mid-nineteenth century. A closer examination of those extensions, however, suggests an intermediate position: that Congress may extend patent and copyright terms in limited circumstances, in order to vindicate the expectation interest of authors and inventors who, for reasons beyond their control (such as war, judicial corruption, administrative error or delay in FDA approval), did not receive the term of years promised to them at the time the patent or copyright was granted. That position, however, does not support the indiscriminate twenty-year term extension provided by the CTEA.

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I. INTRODUCTION

On February 12, 1924, George Gershwin’s *Rhapsody in Blue* was played for the first time, to instant acclaim, at a concert of jazz music conducted by Paul Whiteman at Aeolian Hall in New York.<sup>1</sup> Following a concert tour by the Whiteman band, the work was recorded<sup>2</sup> and published,<sup>3</sup>

<sup>1</sup> DAVID SCHIFF, *GERSHWIN: RHAPSODY IN BLUE* 55, 61-62 (1997); EDWARD JABLONSKI, *GERSHWIN* 61, 72-75 (1988).

<sup>2</sup> The concert was repeated at Aeolian Hall on Mar. 7, at Carnegie Hall on Apr. 21, and in May in Rochester, Pittsburgh, Cleveland, Indianapolis and St. Louis. The work was recorded in New York in June. JABLONSKI, *supra*

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and it quickly became one of the most popular and successful works of American music ever written.

One may question whether Gershwin needed any financial incentive to compose the *Rhapsody in Blue* other than the substantial fees he received to perform the work.<sup>4</sup> It is clear, however, that Gershwin had an additional financial incentive: copyright. Under the terms of the 1909 Copyright Act which was then in effect, upon publication of the work and registration of the copyright with the U.S. Copyright Office, Gershwin was entitled to receive royalties for all copies, recordings and public performances of *Rhapsody in Blue* for an initial term of twenty-eight years.<sup>5</sup> If the work was successful (as it proved to be),<sup>6</sup> the copyright could be renewed once for an additional twenty-eight years.<sup>7</sup> Thus, at the time he composed the *Rhapsody in Blue*, Gershwin was assured by law that he or his heirs could continue to receive any royalties earned from the commercial exploitation of the work for a maximum duration of fifty-six years. After that, *Rhapsody in Blue* would enter the public domain, where it could be freely copied, recorded and performed by anyone wishing to do so.

Upon publication of the *Rhapsody in Blue*, the financial incentive provided to Gershwin by copyright law had served its constitutionally-mandated purpose. The Copyright and Patent Clause of the Constitution gives Congress the power "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>8</sup> By granting the authors of new works the exclusive right to publish and perform them for up to fifty-six years, the 1909 Act encouraged the creation of new works of

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note 1, at 75. The recording sold a million copies. SCHIFF, *supra* note 1, at 62.

<sup>3</sup> The work is published in several different editions: for two pianos (Gershwin's original), for piano and jazz band (arranged for the Whiteman band by Ferde Grofe), for piano and orchestra (orchestrated by Grofe), and for solo piano. SCHIFF, *supra* note 1, at 4-6.

<sup>4</sup> Gershwin performed the *Rhapsody* eleven times in 1924. JABLONSKI, *supra* note 1, at 77-78.

<sup>5</sup> Former 17 U.S.C. § 1(a) (exclusive right to publish and sell the copyrighted work); § 1(e) (exclusive right to publicly perform for profit and to make mechanical reproductions of musical compositions); § 23 (twenty-eight-year initial term) (1909; repealed eff. Jan. 1, 1978).

<sup>6</sup> It is estimated that "the royalties from sale of sheet music, records, and other subsidiary rights gathered more than a quarter of a million dollars in a decade." DAVID EWEN, *A JOURNEY TO GREATNESS: THE LIFE AND MUSIC OF GEORGE GERSHWIN* 115 (1956). Gershwin was paid \$50,000 alone for the right to use the music in the motion picture *The King of Jazz* (1930). JABLONSKI, *supra* note 1, at 183.

<sup>7</sup> Former 17 U.S.C. § 23 (1909; repealed eff. Jan. 1, 1978).

<sup>8</sup> U.S. CONST. art. I, § 8, cl. 8.

authorship like the *Rhapsody in Blue*. At the same time, the law of copyright assured that the work would enter the public domain by the year 1980, and thereby continue to promote the creation of new works by providing raw material for other authors and composers to draw upon in fashioning new works of their own.<sup>9</sup> Composers wishing to pay homage to Gershwin could quote from the *Rhapsody* or make new arrangements of it without fear of liability for copyright infringement.<sup>10</sup> Placing the work in the public domain would also allow the free market to provide multiple editions of the *Rhapsody in Blue*, which would have the effect of lowering the price of the work to the public,<sup>11</sup> allowing many smaller orchestras who could not otherwise afford to perform the *Rhapsody* to bring this popular work to their communities.

George Gershwin died in 1937, but his estate continued to benefit from the copyrights he had obtained on works published during (and after) his lifetime. The heirs of the Gershwin estate, however, were unhappy with the copyright bargain that their illustrious and productive relative had accepted. In the 1960s, they joined many other publishing and authors' rights organizations in lobbying Congress to rewrite the rules of the copyright game and to give the new rules retroactive effect. Their efforts bore fruit in the Copyright Act of 1976, which granted a nineteen-year extension of the renewal term of all copyrights registered before January 1, 1978.<sup>12</sup> New works created on or after that date would receive a single copyright term, instead of an initial and a renewal term, and would enter

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<sup>9</sup> See Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 966-67 (1990) ("the very act of authorship in any medium is more akin to translation and recombination than it is to creating Aphrodite from the foam of the sea. Composers recombine sounds they have heard before . . . [and] all [authors] engage in the process of adapting, transforming, and recombining what is already 'out there' in some other form. This is not parasitism; it is the essence of authorship.").

<sup>10</sup> For musical examples, listen to JOHANNES BRAHMS, VARIATIONS ON A THEME BY HAYDN (1873); SERGEI RACHMANINOFF, RHAPSODY ON A THEME OF PAGANINI (1934); OTTORINO RESPIGHI, LA BOUTIQUE FANTASTIQUE (1919) (based on music of Rossini); JOAQUIN RODRIGO, FANTASIA PARA UN GENTILHOMBRE (1954) (based on music of Gaspar Sanz); IGOR STRAVINSKY, PULCINELLA (1920) (based on music of Pergolesi); and RALPH VAUGHAN WILLIAMS, FANTASIA ON A THEME OF THOMAS TALLIS (1910).

<sup>11</sup> A study of published works of classical music by Luck's Music Library demonstrates the benefit to the public of placing works in the public domain. For example, during the copyright term the publisher of Gustav Holst's *THE PLANETS* (1916) charged a community orchestra \$815 for two performances; after the work entered the public domain, it could be purchased for \$300 and performed an unlimited number of times without any additional charge. See <http://www.law.asu.edu/HomePages/Karjala/OpposingCopyrightExtension/letters/Luck'sMusic01.html> (last visited Oct. 31, 2001).

<sup>12</sup> Former 17 U.S.C. § 304 (1976; amended 1998).

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the public domain fifty years after the author's death.<sup>13</sup> Although the nineteen-year extension afforded to existing works was difficult to justify in terms of the incentive rationale for copyright, it was generally accepted as part of a comprehensive revision of U.S. copyright law that codified many important principles that had been judicially recognized under the 1909 Act<sup>14</sup> and harmonized the terms of future copyrights with the life-plus-fifty year term required by the Berne Convention.<sup>15</sup> Under the 1976 Act, Gershwin's heirs would continue to receive royalties from the *Rhapsody in Blue* until December 31, 1999.<sup>16</sup> The dawning of Y2K would place this musical landmark of the twentieth century in the public domain.

In the 1990s, however, having become accustomed to the affluent lifestyle afforded them by royalties they themselves did nothing to earn, the heirs of Gershwin and other popular songwriters were back in Congress,<sup>17</sup> together with music publishers and motion picture companies,<sup>18</sup> lobbying for yet another extension of copyright terms. Once again, they were successful: on October 27, 1998, President Clinton signed into law the Sonny Bono Copyright Term Extension Act of 1998,<sup>19</sup> which added an additional twenty years to the terms of all existing and future copyrights. Under this legislation, the copyright on *Rhapsody in Blue* will not expire until December 31, 2019; and it is not difficult to predict that if this latest round of copyright term extension is upheld by the courts, the heirs of the Gershwin estate will be back in Congress in another twenty years, seeking

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<sup>13</sup> Former 17 U.S.C. § 302 (1976; amended 1998).

<sup>14</sup> See, e.g., 17 U.S.C. § 102(a) (2000) (limiting copyright to "original works of authorship"); *Id.* § 107 (2000) (fair use).

<sup>15</sup> See Berne Convention for the Protection of Literary and Artistic Works, July 24, 1971 (Paris Revision), art. 7(1). The U.S. eventually adhered to the Berne Convention, effective Mar. 1, 1989. See Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853.

<sup>16</sup> 17 U.S.C. § 305 (2000) extends all copyright terms to the end of the year in which they would otherwise expire.

<sup>17</sup> See William F. Patry, *The Failure of the American Copyright System: Protecting the Idle Rich*, 72 NOTRE DAME L. REV. 907, 932 (1997) ("The real impetus for term extension comes from a very small group: children and grandchildren of famous composers whose works are beginning to fall into the public domain, thereby threatening trust funds. These estates have considerable political and financial impact with ASCAP, the music performing rights collecting society. It is ASCAP and . . . [BMI] who are pushing term extension.").

<sup>18</sup> See Jonathan P. Decker, *Of Mice and (Congress)Men*, FORTUNE, Nov. 23, 1998, at 44 (discussing lobbying by Disney and the Motion Picture Association of America, including campaign contributions paid to the sponsors of copyright term extension); *Disney Lobbying for Copyright Extension No Mickey Mouse Effort*, CHI. TRIB., Oct. 17, 1998, at 22 (same).

<sup>19</sup> Pub. L. No. 105-298, 112 Stat. 2827 (1998).

yet another extension of copyright terms, at the expense of the public domain.

This latest round of copyright term extension has not gone unchallenged, however. On January 11, 1999, Eric Eldred, an individual who publishes public domain works on the Internet, filed suit against U.S. Attorney General Janet Reno in the U.S. District Court for the District of Columbia, seeking a judicial declaration that the Sonny Bono Copyright Term Extension Act is unconstitutional.<sup>20</sup> Eldred was later joined by nine other plaintiffs seeking to overturn the Act, on the ground that it violates the “limited Times” provision of the Copyright Clause and the First Amendment.<sup>21</sup> Both the District Court and the Court of Appeals have now rejected Eldred’s challenge, and the U.S. Supreme Court has granted certiorari to review those decisions.<sup>22</sup>

It is not the purpose of this article to evaluate the wisdom (or lack thereof) of Congress’ decision to extend copyright terms by twenty years.<sup>23</sup> That issue has already been discussed thoroughly in the legal literature.<sup>24</sup> Nor will this article discuss whether the Constitution places

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<sup>20</sup> Complaint, *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999), available at [http://cyber.law.harvard.edu/eldredvreno/complaint\\_orig.html](http://cyber.law.harvard.edu/eldredvreno/complaint_orig.html) (last visited Oct. 31, 2001).

<sup>21</sup> Second Amended Complaint, *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999), available at [http://cyber.law.harvard.edu/eldredvreno/complaint\\_amd2.html](http://cyber.law.harvard.edu/eldredvreno/complaint_amd2.html) (last visited Oct. 31, 2001).

<sup>22</sup> See *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999), *aff’d*, 239 F.3d 372 (D.C. Cir. 2001), *petition for reh’g and reh’g en banc denied sub nom. Eldred v. Ashcroft*, 255 F.3d 849 (D.C. Cir. 2001), *petition for cert. granted*, 70 U.S.L.W. 3324 (U.S. Feb. 19, 2002) (No. 01-618).

<sup>23</sup> In the interest of full disclosure, the author notes that he was one of sixty professors who signed a statement written by Prof. Dennis J. Karjala of Arizona State University, opposing the enactment of the Copyright Term Extension Act. See Statement of Copyright and Intellectual Property Law Professors in Opposition to H.R. 604, H.R. 2589, and S. 505 (1998), available at <http://www.law.asu.edu/HomePages/Karjala/OpposingCopyrightExtension/legmats/1998Statement.html> (last visited Oct. 31, 2001).

<sup>24</sup> See, e.g., ROBERT L. BARD & LEWIS KURLANTZICK, *COPYRIGHT DURATION: DURATION, TERM EXTENSION, THE EUROPEAN UNION, AND THE MAKING OF COPYRIGHT POLICY* (1998); Hank Brown & David Miller, *Copyright Term Extension: Sapping American Creativity*, 44 J. COPYR. SOC’Y 94 (1996); Lisa M. Brownlee, *Recent Changes in the Duration of Copyright in the United States and European Union: Procedure and Policy*, 6 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 579 (1996); Shauna C. Bryce, *Life Plus Seventy: The Extension of Copyright Terms in the European Union and Proposed Legislation in the United States*, 37 HARV. INT’L L.J. 525 (1996); Jenny L. Dixon, Note, *The Copyright Term Extension Act: Is Life Plus Seventy Too Much?*, 18 HASTINGS COMM/ENT L.J. 945 (1996); Jerome N. Epping, Jr., Comment, *Harmonizing the United States and European Community Copyright Terms: Needed Adjustment or Money for Nothing?*, 65 U. CIN. L. REV.

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any outer limit on the duration of copyright protection for new works. Instead, this article will focus on one of the principal questions raised in *Eldred v. Reno*: whether the Sonny Bono Copyright Term Extension Act is unconstitutional as applied retroactively to existing copyrights.<sup>25</sup>

Should the Supreme Court decide to consider this question, it will not be writing on a clean slate. Although prior to *Eldred v. Reno* the issue of copyright term extension was never addressed in a published decision, there are a number of nineteenth-century decisions upholding various patent term extensions granted to inventors by Congress by means of special legislation.<sup>26</sup> In evaluating the arguments presented in *Eldred v. Reno*, therefore, the first question must be: has the constitutional validity of term extension under the Patent and Copyright Clause already been established? Or is there some way to distinguish *Eldred v. Reno* from the line of cases that apparently settled this question more than a century ago?

Part II of this article will review the history of copyright term extension legislation. This history shows that Congress has retroactively extended existing copyrights each time it has changed the basic term, a practice that has gone unchallenged until now. In contrast, only two copy-

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183 (1996); Marci A. Hamilton, *Copyright Duration Extension and the Dark Heart of Copyright*, 14 CARDOZO ARTS & ENT. L.J. 655 (1996); Joseph A. Lavigne, Comment, *For Limited Times? Making Rich Kids Richer Via the Copyright Term Extension Act of 1996*, 73 U. DETROIT-MERCY L. REV. 311 (1996); Arthur R. Miller, *Copyright Term Extension: Boon for American Creators and the American Economy*, 45 J. COPYR. SOC'Y 319 (1998); Patry, *Protecting the Idle Rich*, *supra* note 17, at 923-33; William F. Patry, *The Copyright Term Extension Act of 1995: Or How Publishers Managed to Steal the Bread from Authors*, 14 CARDOZO ARTS & ENT. L.J. 661 (1996); J.H. Reichman, *The Duration of Copyright and the Limits of Cultural Policy*, 14 CARDOZO ARTS & ENT. L.J. 625 (1996).

<sup>25</sup> With a few notable exceptions, most commentators agree that retroactive copyright term extension violates the Patent and Copyright Clause. See Michael H. Davis, *Extending Copyright and the Constitution: "Have I Stayed Too Long?"*, 52 FLA. L. REV. 989 (2000); Christina M. Gifford, Note, *The Sonny Bono Copyright Term Extension Act*, 30 U. MEM. L. REV. 363 (2000); Richard B. Graves III, *Private Rights, Public Uses and the Future of the Copyright Clause*, 80 NEB. L. REV. 64 (2001); Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. ILL. L. REV. 1119; Lavigne, *supra* note 24, at 352-58; Robert Patrick Merges & Glenn Harlan Reynolds, *The Proper Scope of the Copyright and Patent Power*, 37 HARV. J. ON LEGIS. 45 (2000); Edward C. Walterscheid, *Defining the Patent and Copyright Term: Term Limits and the Intellectual Property Clause*, 7 J. INTELL. PROP. L. 315 (2000); see also Symposium: Jane C. Ginsburg, Wendy J. Gordon, Arthur R. Miller & William F. Patry, *The Constitutionality of Copyright Term Extension: How Long is Too Long?*, 18 CARDOZO ARTS & ENT. L.J. 651 (2000) (panel debate).

<sup>26</sup> See notes 235-321 and accompanying text.

rights have been extended by private legislation, and one of those extensions was invalidated as a violation of the Establishment Clause. Part III will review the history of patent term extension legislation. This history shows that patents have been extended fewer times by general legislation, but many more times by private legislation. Many of these private patent term extensions were challenged in court as unconstitutional, and all were upheld. Part III-B will discuss several private design patent extensions passed by Congress, and will conclude that these extensions are more properly treated as private trademark legislation. Part III-C will examine the Patent and Copyright Clause in light of this history, and will analyze three possible interpretations of the Clause. This section demonstrates that most of the private patent term extensions can be justified as restoring to the inventor the period of years which he or she had expected to receive under the general patent law, but which had been lost due to circumstances beyond the inventor's control. Finally, Part IV will evaluate the arguments made in *Eldred v. Reno* in light of this legislative and judicial history.

## II. COPYRIGHT TERM EXTENSION

### A. General Laws

The first copyright statute, commonly known as the Statute of Anne, was adopted in England in 1710.<sup>27</sup> It provided for an initial term of fourteen years from the date of first publication of a new book;<sup>28</sup> and if the author was living at the expiration of the first term, the copyright could be renewed for another fourteen years.<sup>29</sup> Books that had previously been published were given a single term of twenty-one years.<sup>30</sup> After that time,

<sup>27</sup> An Act for the Encouragement of Learning, by Vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, during the Times therein mentioned, 8 Anne ch. 19 (1710) (Eng.). For a history of the origins of the Statute of Anne, see PAUL GOLDSTEIN, *COPYRIGHT'S HIGHWAY: FROM GUTENBERG TO THE CELESTIAL JUKEBOX* 39-43 (1994); 1 WILLIAM F. PATRY, *COPYRIGHT LAW AND PRACTICE* 3-11 (1994); or BENJAMIN KAPLAN, *AN UNHURRIED VIEW OF COPYRIGHT* 2-7 (1967).

<sup>28</sup> “[T]he author of any book or books already composed, and not printed or published, or that shall hereafter be composed, and his assignee or assigns, shall have the sole liberty of printing and reprinting such book and books for the term of fourteen years, to commence from the day of the first publishing the same, and no longer.” 8 Anne ch. 19 (1710) (Eng.).

<sup>29</sup> “Provided always, that after the expiration of the said term of fourteen years, the sole right of printing or disposing of copies shall return to the authors thereof, if they are then living, for another term of fourteen years.” *Id.*

<sup>30</sup> “[T]he author of any book or books already printed, who hath not transferred to any other the copy or copies of such book or books, share or shares thereof, or the bookseller or booksellers, printer or printers, or other person or persons, who hath or have purchased or acquired the copy or copies



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the work passed into the public domain, and could be freely copied by anyone.<sup>31</sup>

After the American colonies gained their independence from Great Britain, the new Continental Congress passed a resolution encouraging the States “to secure to the authors or publishers of any new books not hitherto printed . . . the copy right of such books for a certain time not less than fourteen years from the first publication; and to secure to the said authors, if they shall survive the term first mentioned, . . . the copy right” of such books for another term of time not less than fourteen years.”<sup>32</sup> Three states had already enacted copyright statutes,<sup>33</sup> and within three years, nine other states followed suit.<sup>34</sup> Seven of the States followed the Statute of Anne and the Continental Congress’ resolution in providing two fourteen-year terms.<sup>35</sup> The five remaining States granted copyrights

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of any book or books, in order to print or reprint the same, shall have the sole right and liberty of printing such book or books for the term of one and twenty years, to commence from said tenth day of April, and no longer.”  
*Id.*

<sup>31</sup> It was not immediately obvious that this was the effect of the expiration of the statutory copyright. Printers and booksellers who had enjoyed exclusive rights under the statute attempted to argue that a perpetual copyright existed at common law, and that the Statute of Anne did not divest this common-law copyright but merely provided additional remedies. In the famous case of *Donaldson v. Beckett*, 4 Burr. 2408, 98 Eng. Rep. 257 (H.L. 1774), however, the House of Lords rejected this argument, holding that although the author of an unpublished manuscript had a common-law right of first publication, no common-law copyright existed after the work was published; and therefore that upon the expiration of the period provided by the Statute of Anne, any publisher could publish a competing copy of a previously copyrighted book. See Howard F. Abrams, *The Historic Foundation of American Copyright Law: Exploding the Myth of Common-Law Copyright*, 29 WAYNE L. REV. 1119, 1156-71, 1188-91 (1983).

<sup>32</sup> Resolution of May 2, 1783, reprinted in COPYRIGHT OFFICE BULLETIN No. 3, COPYRIGHT ENACTMENTS OF THE UNITED STATES, 1783-1906 (2d ed. 1906), at 11 [hereinafter COPYRIGHT ENACTMENTS].

<sup>33</sup> *Id.* at 11-16 (Connecticut, Massachusetts and Maryland).

<sup>34</sup> *Id.* at 16-31. In compiling these state statutes in 1906, the Register of Copyrights noted that “No copyright law seems to have been enacted by the State of Delaware.” *Id.* at 31.

It has been noted that Noah Webster played a significant role in the development of American copyright law by traveling from state to state to encourage the state legislatures to pass copyright legislation. See Irah Donner, *The Copyright Clause of the U.S. Constitution: Why Did the Framers Include It With Unanimous Approval?*, 36 J. AM. LEGAL HIST. 361, 370-71 (1992).

<sup>35</sup> Connecticut, Georgia, Maryland, New Jersey, New York, Pennsylvania, and South Carolina. See Francine Crawford, *Pre-Constitutional Copyright Statutes*, 23 BULL. COPYRIGHT SOC’Y 11, 21-22 (1975). Crawford erroneously asserts that “South Carolina did not legislate any renewal rights for anyone

for single terms of fourteen,<sup>36</sup> twenty,<sup>37</sup> and twenty-one<sup>38</sup> years' duration, with no right of renewal.

At the Constitutional Convention of 1787, both Charles C. Pinckney of South Carolina and James Madison of Virginia submitted proposals to give Congress the power to grant patents and copyrights.<sup>39</sup> The proposals were referred to the Committee of Eleven, which drafted the Patent and Copyright Clause as it exists today, and recommended its adoption.<sup>40</sup> The clause was approved by the delegates with no debate.<sup>41</sup> The only significant mention of the Clause in the subsequent ratification debates came in the *Federalist No. 43*, authored by James Madison:

The utility of this power will scarcely be questioned. The copy right of authors has been solemnly adjudged in Great Britain to be a right at Common Law. The right to useful inventions seems with equal reason to belong to the inventors. The public good coincides in both cases with the claims of individuals. The States cannot separately make effectual provision for either of the cases, and most of them have anticipated the decision of this point by laws passed at the instance of Congress.<sup>42</sup>

From this scarce record, it is difficult to determine the meaning that the Framers attached to the phrase "for limited Times."<sup>43</sup> Several scholars,

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under any circumstances," *id.* at 22; but the legislation as passed clearly authorizes a fourteen-year renewal term. See Act of Mar. 26, 1784 (South Carolina), reprinted in COPYRIGHT ENACTMENTS, *supra* note 32, at 24.

<sup>36</sup> Crawford, *supra* note 35, at 22 (North Carolina).

<sup>37</sup> *Id.* at 23 (New Hampshire).

<sup>38</sup> *Id.* (Massachusetts, Rhode Island, and Virginia).

<sup>39</sup> Karl Fenning, *The Origin of the Patent and Copyright Clause of the Constitution*, 17 GEO. L. J. 109, 109-13 (1925). It is noteworthy that each of these proposals specified that patents and copyrights should be granted only for "a limited time" or "a certain time." *Id.* at 112-13.

<sup>40</sup> WALTERSCHEID, *infra* note 190, at 49.

<sup>41</sup> Fenning, *supra* note 39, at 114. For one historian's explanation for the unusual unanimity of the delegates on this subject, see Donner, *supra* note 34, at 361-78.

<sup>42</sup> JAMES MADISON, THE FEDERALIST NO. 43, at 279 (Modern Library ed. 1941). See also Donner, *supra* note 34, at 376-77 (quoting statements of Thomas McKean of Pennsylvania and James Iredell of North Carolina in support of the Clause).

<sup>43</sup> It is interesting to note that in recording Pinckney's proposal, Madison initially wrote "for a limited time," then crossed out the word "limited" and wrote in the word "certain." One commentator states that "[n]othing is known about the reason for this change." 1 PATRY, *supra* note 27, at 23 n.68. Two others argue that from the use of the word "certain" here and in the 1783 Continental Congress Resolution, "it seems clear that 'limited' also implies 'certain' — a term of copyright determined by a set numerical span of years, as was already the accepted practice in the states." Oscar Cargill & Patrick

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however, have pointed out that the Framers were strongly opposed to the granting of monopolies.<sup>44</sup> Patents and copyrights were exceptions to this opposition, but they were exceptions which needed to be carefully limited in order to prevent Congress from enacting more pernicious monopolies.<sup>45</sup> This accounts for the unusual fact that the Patent and Copyright Clause is the only clause which includes both a grant of power and the specific means by which that power was to be exercised.<sup>46</sup>

That insight, however, does not by itself supply a precise meaning for the phrase “for limited Times.” Perhaps the best evidence of the meaning of the phrase, therefore, is the first legislation passed under its authority.<sup>47</sup> The Patent Act of 1790 granted patents for a maximum term of fourteen years;<sup>48</sup> and the Copyright Act of 1790 granted copyrights for a term of “fourteen years from the time of recording the title thereof”;<sup>49</sup> with a right of renewal “for the further term of fourteen years” if the author survived

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A. Moran, *Copyright Duration v. The Constitution*, 17 WAYNE L. REV. 917, 927 (1971). Cargill and Moran therefore conclude that a copyright term of variable duration, based upon the life of the author, is unconstitutional. *Id.* at 927-28. Even accepting their premise that “limited” and “certain” were considered interchangeable, however, the argument is far from compelling. Compare 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.05[A][1], at 1-66.15 (2001 rev.) (life-plus-fifty term “in itself raises no constitutional problem under the ‘limited times’ limitation.”).

<sup>44</sup> See Heald & Sherry, *supra* note 25, at 1143-46, 1150; Walterscheid, *supra* note 25, at 318-46; Malla Pollack, *Purveyance and Power, or Over-Priced Free Lunch: The Intellectual Property Clause as an Ally of the Takings Clause in the Public’s Control of Government*, 30 SW. L. REV. 1, 106-12 (2000).

<sup>45</sup> See Heald & Sherry, *supra* note 25, at 1160-61; Walterscheid, *supra* note 25, at 318-19. The Framers may have been aware that Parliament had in 1775 granted ten colleges and universities perpetual copyrights to the King James Bible and several other works. 1 PATRY, *supra* note 27, at 175-76.

<sup>46</sup> See Heald & Sherry, *supra* note 25, at 1153; Walterscheid, *supra* note 25, at 316.

<sup>47</sup> See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57 (1884) (“The construction placed upon the constitution by the first act of 1790 . . . , by the men who were contemporary with its formation, many of whom were members of the convention which framed it, is of itself entitled to very great weight”). In the First Congress, ten of twenty-six Senators and nine of sixty-six Representatives were delegates at the Constitutional Convention of 1787. See 1 1787: DRAFTING THE CONSTITUTION 21-25 (Wilbourne E. Benton ed., 1986) (listing delegates); BIOGRAPHICAL DIRECTORY OF THE UNITED STATES CONGRESS, 1774-1989, 51-52 (1989) (listing members of First Congress).

<sup>48</sup> An Act to promote the progress of useful Arts, §1, 1 Stat. 109, 110 (Apr. 10, 1790).

<sup>49</sup> An Act for the encouragement of learning, §1, 1 Stat. 124 (May 31, 1790). The Act required that the copyright be registered “in the clerk’s office of the district court where the author or proprietor shall reside.” *Id.*, §3, 1 Stat. 125.

to the end of the first term.<sup>50</sup> Significantly, the first copyright act granted copyrights to the domestic authors of “any map, chart, book or books *already printed* within these United States” as well as to the domestic authors of “any map, chart, book or books already made and composed, but not printed or published, or that shall hereafter be made and composed.”<sup>51</sup> Thus, it appears that the First Congress was concerned not only with encouraging the creation and publication of new works, but also with rewarding the authors of works that had previously been published. Given that these works could have qualified for similar copyright protection under the English Statute of Anne<sup>52</sup> or under the laws of twelve of the thirteen original states,<sup>53</sup> however, this provision can be justified as a transitional measure, designed to ensure that no author was deprived of the term that he or she had been promised under previous legislation.<sup>54</sup>

In 1831, Congress undertook to revise the copyright laws. The 1831 Act granted a copyright to the authors of “any book or books, map, chart, or musical composition, which may be now made or composed, and not printed and published, or shall hereafter be made and composed . . . for the term of twenty-eight years from the time of recording the title thereof”;<sup>55</sup> with a right of renewal “for the further term of fourteen years.”<sup>56</sup> In addition, Section 16 of the 1831 Act extended the term of all existing copyrights:

for such additional period of time as will, together with the time which shall have elapsed from the first entry of such copyright, make up the term of twenty-eight years, with the same right to

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<sup>50</sup> *Id.*, § 1, 1 Stat. 124.

<sup>51</sup> *Id.*

<sup>52</sup> *But see* Heald & Sherry, *supra* note 25, at 1146 (noting uncertainty as to “whether the Statute of Anne was applicable at all to the colonies.”).

<sup>53</sup> Although “[f]ew authors . . . took advantage of the colonial statutes,” 1 PATRY, *supra* note 27, at 21, it is clear that some copyrights were in fact granted by the states, contrary to the suggestion of one recent scholar. Compare G. Thomas Tanselle, *Copyright Records and the Bibliographer*, 22 STUDIES IN BIBLIOGRAPHY 77, 81-85 (1969) (identifying state copyright records listing approximately forty books) with Walterscheid, *supra* note 25, at 349 n.136 (“I have been unable to find a reference to any copyright issued under these state statutes.”).

<sup>54</sup> *See* Heald & Sherry, *supra* note 25, at 1151 (arguing that “retroactive protection in the *first* copyright act was uniquely justified by several considerations.”) (emphasis in original).

<sup>55</sup> An Act to amend the several acts respecting copy rights, § 1, 4 Stat. 436 (Feb. 3, 1831). The same term was also granted to the authors of new prints and engravings. *Id.*

<sup>56</sup> Copyright Act of 1831, § 2, 4 Stat. 436. The right of renewal was extended for the first time to the author’s heirs, if the author died before the end of the first term. *Id.*

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his widow, child, or children, to renew the copyright, at the expiration thereof, as is above provided in relation to copyrights originally secured under this act. . . . *Provided*, That this act shall not extend to any copyright heretofore secured, the term of which has already expired.<sup>57</sup>

With this first general revision, therefore, Congress established a precedent of extending the terms of all copyrights that had not yet expired, but declining to revive the copyrights in works that had already fallen into the public domain.<sup>58</sup>

The legislative history of the 1831 Act reveals that one of its principal purposes was “to enlarge the period for the enjoyment of copy-right, and thereby to place authors in this country more nearly upon an equality with authors in other countries.”<sup>59</sup> Congress also expressed skepticism concerning the benefits of the public domain.<sup>60</sup> Although the utilitarian rationale for copyright was alluded to,<sup>61</sup> it is clear that many members of Congress believed that copyright was a natural right of the author.<sup>62</sup> This

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<sup>57</sup> *Id.*, § 16, 4 Stat. 439.

<sup>58</sup> In debating the extension of existing copyrights, Rep. Jabez W. Huntington of Connecticut asked “why . . . should the author who had sold his copyright a week ago, be placed in a worse situation than the author who should sell his work the day after the passing of that act?” 7 GALES & SEATON’S REGISTER OF DEBATES IN CONGRESS 424 (1831). This rhetorical question does not explain why the author whose copyright would have expired the day after the passing of the act should be placed in a better situation than the author whose copyright had expired a week earlier. The principle of preserving settled expectations provides an answer to the former question, but not to the latter.

<sup>59</sup> *Id.* at app. cxix. At the time, England had adopted a twenty-eight-year term, with a renewal term for the life of the author; and France had adopted a term of fifty years after the death of the author. *Id.*

<sup>60</sup> *Id.* at cxx (“There is no serious danger of a monopoly. The question is, whether the author or the bookseller shall reap the reward.”); *but see id.* at 423 (Rep. Michael Hoffman, N.Y.) (arguing the bill “went to establish a monopoly of which authors alone would reap the advantage, to the public detriment.”).

<sup>61</sup> *Id.* at cxx (“We ought to present every reasonable inducement to influence men to consecrate their talents to the advancement of science.”); *see also id.* at 423 (Rep. William W. Ellsworth, Conn.) (contending the bill would “enhance the literary character of the country, by holding forth to men of learning and genius additional inducements to devote their time and talents to literature and the fine arts.”).

<sup>62</sup> *Id.* at cxx (“Upon the first principles of proprietorship in property, an author has an exclusive and perpetual right, in preference to any other, to the fruits of his labor.”); *see also id.* at 424 (Rep. Gulian C. Verplanck, N.Y.) (“the work of an author was the result of his own labor. It was a right of property existing before the law of copyrights had been made. That statute . . . [was] merely a legal provision for the protection of a natural right.”).

rationale for copyright was rejected three years later, however, when the U.S. Supreme Court held in *Wheaton v. Peters*<sup>63</sup> that there was no common-law copyright that survived first publication of a work.<sup>64</sup> This decision therefore undercuts one of the principal justifications for the term extension of 1831. Moreover, unlike the enactments of the First Congress,<sup>65</sup> the Act of 1831 is not entitled to any special weight in construing the Constitution.<sup>66</sup>

The next general revision occurred in 1870, but the initial and renewal terms of copyright remained the same, providing a maximum duration for all copyrights of forty-two years.<sup>67</sup>

In 1890, during consideration of a bill that would extend U.S. copyright law to foreign authors, Representative Benjamin Butterworth of Ohio, speaking in favor of the bill, remarked that he “would willingly vote to reduce the term [of copyright] to eighteen years or even seventeen years.”<sup>68</sup> Representative Samuel Ritter Peters of Kansas, an opponent of the legislation, seized upon that suggestion and proposed that the bill be sent back to the Committee on Patents, “with instructions to make the limit of the copyright fourteen years.”<sup>69</sup> He rejected a suggestion by Representative Francis Spinola of New York to “[m]ake the term seventeen

<sup>63</sup> 33 U.S. 591 (1834).

<sup>64</sup> *Id.* at 657-63.

<sup>65</sup> *See* note 47 *supra*.

<sup>66</sup> By 1831, none of the delegates to the Constitutional Convention of 1787 remained in Congress. *See* BENTON, *supra* note 47, at 21-25 (listing delegates); BIOGRAPHICAL DIRECTORY, *supra* note 47, at 108-10 (listing members of 21st Congress). *See also* Heald & Sherry, *supra* note 25, at 1151-52 (“This isolated incident, coming more than forty years after the first copyright act and not repeated for another seventy-seven years, is more indicative of congressional reticence than of congressional assertion of authority.”).

<sup>67</sup> An Act to revise, consolidate, and amend the Statutes relating to Patents and Copyrights, §§ 87-88, 16 Stat. 198, 212-13 (July 8, 1870).

<sup>68</sup> 22 CONG. REC. 58 (Dec. 3, 1890). He reasoned that “when the copyright law was first enacted, it was not an easy matter to inform the public of the nature and content of a publication or to get books across the continent,” but that since that time, improvements in advertising and distribution had effectively eliminated such delays. *Id.*

<sup>69</sup> *Id.* at 59. It is somewhat unclear whether Rep. Peters’ motion referred to the duration of all copyrights, or only the copyrights of foreign authors. He initially stated “I move to recommit the bill to the Committee on Patents with instructions to limit the duration of *this* copyright privilege to five years.” *Id.* (emphasis added). When asked to reduce his motion to writing, he said “At the suggestion of a gentleman near me, I will modify my proposition so as to make the limit fourteen years instead of five years.” *Id.* The written motion that resulted is quoted in the text. Although this exchange could be interpreted to refer only to the term for foreign authors, in the context of Rep. Butterworth’s remark, the reasoning of which applied to

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years, the same as the term of a patent.”<sup>70</sup> The motion was apparently viewed as a strategic ploy only,<sup>71</sup> and it was rejected upon a vote of the full House.<sup>72</sup>

In 1905, the Librarian of Congress convened a conference of authors, publishers and other interested parties for the purpose of discussing a general revision of the copyright laws.<sup>73</sup> At the conference, both the American Copyright League (an association of authors) and the Music Publishers’ Association expressed the view “[t]hat the copyright term should be as long a period as possible”<sup>74</sup> and suggested a single term of life of the author plus fifty years.<sup>75</sup> The principal reasons advanced were that copyright was a natural right<sup>76</sup> (a position rejected by the U.S. Supreme Court<sup>77</sup>), that authors ought not to outlive their copyrights,<sup>78</sup> that the term would provide income to an author’s children and grandchildren,<sup>79</sup> and that it ought not to be shorter than the term in several European countries.<sup>80</sup> The Register of Copyrights prepared a draft embodying the proposal,<sup>81</sup> adding a provision extending the terms of existing copy-

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all copyrighted works, it seems that Rep. Peters was proposing a reduced term of general application.

<sup>70</sup> *Id.*

<sup>71</sup> Rep. William Simonds of Connecticut, the bill’s principal sponsor, complained “That is meant to kill the bill, nothing else.” *Id.*

<sup>72</sup> *Id.* The vote on the motion was 96 in favor, 138 against, and 96 not voting. *Id.*

<sup>73</sup> 1 E. FULTON BRYLAWSKI & ABE A. GOLDMAN, LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT C3 (1976) [hereinafter BRYLAWSKI & GOLDMAN].

<sup>74</sup> *Id.* at C7 (American Copyright League); *see also id.* at C11 (Music Publishers’ Association) (“We shall ask for the longest term of copyright”). Indeed, some of the conferees expressed the opinion that copyright should be perpetual. *See, e.g.,* 2 BRYLAWSKI & GOLDMAN, *supra* note 73, at D28, D218.

<sup>75</sup> 1 BRYLAWSKI & GOLDMAN, *supra* note 73, at C7, C11.

<sup>76</sup> *Id.* at C78 (“What the American Copyright League desires to emphasize is the fact that what we think is a natural right should be made a statutory right.”).

<sup>77</sup> *See* note 63 and accompanying text.

<sup>78</sup> 1 BRYLAWSKI & GOLDMAN, *supra* note 73, at C75.

<sup>79</sup> *Id.* at C75, C78.

<sup>80</sup> *Id.* The American Copyright League initially resolved to ask for life of the author plus thirty years, to protect works for one generation after the author’s death, but instead adopted the term provided for in France. *Id.* At the time, France and nine other European countries had adopted a life-plus-fifty-year term, while Germany had a term of life-plus-thirty years. 2 BRYLAWSKI & GOLDMAN, *supra* note 73, at 49; 3 BRYLAWSKI & GOLDMAN, *supra* note 73, at LIV (listing countries). England had a term of the longer of life plus seven years or forty-two years, but was considering a life-plus-thirty-year term. 4 BRYLAWSKI & GOLDMAN, *supra* note 73, at 12 (statement of Herbert Putnam, Librarian of Congress).

<sup>81</sup> Memorandum Draft of a Bill to Amend and Consolidate the Acts Respecting Copyright §§ 51-52 (Oct. 23, 1905) at 23-24, *reprinted in* 2 BRYLAWSKI & GOLDMAN, *supra* note 73, at D-XXXVI-VIII. The draft provided for a ba-

rights.<sup>82</sup> None of the conferees opposed making the extension retroactive, but they disagreed vehemently over whether the benefit of the extension should run to the author or to the author's assignees (i.e., to the publisher).<sup>83</sup>

During congressional hearings on the proposed revision in May 1906,<sup>84</sup> several witnesses questioned whether a life-plus-fifty term was a "limited time" within the meaning of the Constitution,<sup>85</sup> and one argued that extension of existing copyrights would impair the obligation of contracts.<sup>86</sup> Representing the Melville Clark Piano Company, Charles S. Burton submitted a written statement that was particularly eloquent on the question of duration:

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sic term of life of the author plus fifty years, with a flat fifty-year term from registration for collective works, derivative works, and photographs.

Concerned that Congress might oppose such a lengthy term, the American Copyright League later proposed an alternative term of the longer of forty-two years or life of the author plus twenty-one years, 2 BRYLAWSKI & GOLDMAN, *supra* note 73, at D37-49, but after discussion the conferees agreed to support the original proposal. *Id.* at D218-19.

<sup>82</sup> Memorandum Draft § 53 at 24-25, *reprinted in* 2 BRYLAWSKI & GOLDMAN, *supra* note 73, at D-XXXVIII-XIX.

<sup>83</sup> *Id.* at D24-25, D219-21; *see also* 3 BRYLAWSKI & GOLDMAN, *supra* note 73, at E297-304. The conferees eventually agreed on a proposal under which the copyright would be extended only if both the author or his heirs and the assignee agreed. *Id.* at E301-04.

<sup>84</sup> In the 1906 draft, the life-plus-fifty year term was in Section 18(c), and the extension of existing copyrights was in Section 19. 4 BRYLAWSKI & GOLDMAN, *supra* note 73, at Hvii-ix.

<sup>85</sup> *See* 4 BRYLAWSKI & GOLDMAN, *supra* note 73, at H53 (statement of George W. Ogilve, publisher) ("it seems to me that under the law as it is suggested, a term of fifty years from the date of the death of the youngest of authors is going beyond what the framers of the Constitution decided was a limited time."); *id.* at H136 (statement of H.N. Low, manufacturer of music rolls) ("The word 'limited' in the Constitution shows that the framers of that instrument had in mind to secure for the public certain benefits after the time had expired. To provide such a long copyright term as the authors seek to obtain in this bill would practically defeat the object of the said clause of the Constitution and the intention of its framers."); *id.* at H197 (statement of Charles S. Burton, Melville Clark Piano Company) ("The bill before your committee proposes a remarkable extension of the period of copyright beyond anything heretofore granted. This is believed to be contrary to sound public policy and of doubtful constitutionality.").

<sup>86</sup> *Id.* at H137 (statement of H.N. Low) ("Section 19 should, in my opinion, be canceled. It is retroactive in its character. Definite contracts have been entered into between authors and the public with respect to matters already copyrighted, and it would impair the obligations of those contracts to provide any renewal or extension of such copyrights. It has already been agreed between such authors and the public at what time their copyrighted works should pass into the public domain.").



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The Constitution expressly limits the power of Congress in respect to their copyright protection to granting such protection “for limited periods.” The term “limited” can have only a relative meaning, and the obvious meaning is limited with respect to or in comparison with the period during which the public will have desire or use for the copyrighted work. It is contemplated, evidently, that in compensation for the protection which the statute gives the composer for a limited period the public shall derive the unqualified use and benefit of the work for a remaining period. If there is no remaining period, the consideration for the protection has failed.

It needs no statistics to establish to the common knowledge of the committee that not one book in ten thousand has any commercial value fifty years after its publication. . . . If, therefore, the author is given the monopoly for fifty years, the public has nothing left to compensate it for that monopoly and protection.

Not one work in a million endures so as to have any value after one hundred years. But the bill proposes, as to the great bulk of copyrightable matter, that the period of copyright shall be substantially one hundred years—fifty years after the death of the author.

It is respectfully submitted that this transcends the intention of the constitutional limitation, and that the public would, by such an enactment, be deprived of substantially all the compensation which the Constitution intended should be reserved to it in return for the copyright protection granted the author.<sup>87</sup>

Another witness, Albert H. Walker of New York,<sup>88</sup> contended that Congress had the discretion to fix any term of copyright short of perpetuity,<sup>89</sup> but nonetheless stated:

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<sup>87</sup> *Id.* at H197-98 (statement of Charles S. Burton).

<sup>88</sup> Walker was a distinguished lawyer and the author of an influential treatise on patent law. See ALBERT HENRY WALKER, TEXT-BOOK OF THE PATENT LAWS OF THE UNITED STATES OF AMERICA (1st ed. 1883). Although greatly revised, his treatise is still updated today. See ERNEST BAINBRIDGE LIPSCOMB III, WALKER ON PATENTS (3d ed. 1984).

<sup>89</sup> See 4 BRYLAWSKI & GOLDMAN, *supra* note 73, at H163 (“the constitutional convention was influenced by this consideration: We will not grant a permanent property right in any intellectual production, because in our judgment that would be inconsistent with the progress of civilization as a whole.”); *id.* at H176 (“Mr. Currier: Do you think a hundred years is a limited time within the meaning of the Constitution? Mr. Walker: Oh, yes; certainly. A thousand would be. [Laughter.]”). As a matter of policy, Walker stated that “the longest period that could possibly be vindicated by argument for a

I am totally opposed to any law providing for the extension of any copyright or any patent. The public ought to know, when the copyright comes out and when the patent comes out, exactly when it is going to expire; and it ought not to made contingent upon anything so uncertain as human life.<sup>90</sup>

Perhaps in response to the objections raised in May, at the December 1906 hearings proponents of the life-plus-fifty-years proposal marshaled an impressive array of witnesses to testify in favor of the longer term. Dr. Edward Everett Hale<sup>91</sup> argued that copyright was a natural right of the author that should last as long as possible.<sup>92</sup> Mark Twain agreed, and he devoted the bulk of his statement to the proposition that copyright ought to last in perpetuity.<sup>93</sup> Recognizing, however, that perpetuity was both an unrealistic goal and forbidden by the Constitution, he pronounced himself satisfied with the life-plus-fifty term:

I like the fifty years' extension, because that benefits my two daughters, who are not as competent to earn a living as I am, because I have carefully raised them as young ladies, who don't know anything and can't do anything. So I hope Congress will extend to them that charity which they have failed to get from me.<sup>94</sup>

John Philip Sousa also made a plea on behalf of his children,<sup>95</sup> and the American Copyright League argued that copyright should provide for an author's children and minor grandchildren.<sup>96</sup> Finally, several witnesses ex-

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patent would be twenty years," but for copyright he advocated a fixed term of 100 years for original works, and fifty years for derivative works. *Id.*

<sup>90</sup> *Id.* at H175 (statement of Albert H. Walker).

<sup>91</sup> Hale, author of "The Man Without a Country," was at the time the Chaplain of the Senate. *Id.* at J80.

<sup>92</sup> *Id.* at J114-15 (statement of Rev. Edward Everett Hale). This view, of course, had been rejected by the Supreme Court in *Wheaton v. Peters*, 33 U.S. 591 (1834). *See* note 63 *supra*.

<sup>93</sup> *Id.* at J116 (statement of Samuel L. Clemens) ("I do not know why there should be a limit at all. I am quite unable to guess why there should be a limit to the possession of the product of a man's labor."); *id.* at J118-20.

<sup>94</sup> *Id.* at J117; *see also id.* at J116 ("I think that will satisfy any reasonable author, because it will take care of his children. Let the grandchildren take care of themselves.").

<sup>95</sup> *Id.* at J201 ("I have children who are in their teens, and I think that the limit of the copyright might very justly be extended. That may possibly yet be of some benefit to my children.").

<sup>96</sup> *Id.* at J87 (statement of Richard R. Bowker, Vice-President, American Copyright League) ("The term proposed in the bill provides for the author and his children's children during the probable minority of the grandchildren, a period to which the entail of realty is limited by our laws."). Bowker also noted that thirty-seven counties had adopted terms of life-plus-fifty-years or

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pressed the view that Congress had the discretion under the Constitution to enact a life-plus-fifty-year term.<sup>97</sup>

In January 1907, the Copyright Office prepared a memorandum expressing its views on the question of duration.<sup>98</sup> It indicated that copyright should be long enough to enable an author “to provide for his children until they reach the age where they are likely to be self-supporting, or, if daughters, married”; but that it “ought *not* to tie up automatically *all* copyrights whether or not they require a term so long. Experience shows that a large percentage of them do not.”<sup>99</sup> Believing that Congress was opposed to the life-plus-fifty-year term, it proposed an initial term of either twenty-eight or forty-two years, which could be extended to life-plus-thirty-years at the end of the initial term.<sup>100</sup> The report also included a rebuttal of several arguments against a longer term.<sup>101</sup> The House and Senate Committees incorporated the revised proposal (using a twenty-eight-year initial term) into their 1907 drafts.<sup>102</sup> Other issues, however, prevented the enactment of the copyright revision bills.

Ironically, it was the authors who ultimately turned the tide against the revised proposal. At congressional hearings in 1908, they objected

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longer; and he listed several prominent authors who had outlived their copyrights, including Emerson and Longfellow. *Id.*

<sup>97</sup> *Id.* at 136 (statement of Charles Porterfield) (stating that “the period of copyright . . . is a question for Congress in its wise discretion”; but expressing the opinion that life-plus-fifty years “is much too long.”); *id.* at J155-56 (statement of Arthur Steuart, former President of the American Bar Association) (“If the Courts thought that what Congress did was unreasonable, was practically unlimited, they would, of course, declare it to be unconstitutional. But within certain limits almost any time is within the jurisdiction of the committee.”); *id.* at J407-08 (Memorandum of the Committee on Copyright and Trademark of the Association of the Bar of the City of New York).

<sup>98</sup> The Copyright Term: Memorandum Accompanying Substitute Suggested by Copyright Office for Section 18 of the Bill (Jan. 22, 1907), *reprinted in* 5 BRYLAWSKI & GOLDMAN, *supra* note 73, at M31-38.

<sup>99</sup> *Id.* at M31 (emphasis in original). The report noted that approximately four-fifths of copyrights were not renewed under the 1831 Act. *Id.* at M33.

<sup>100</sup> *Id.* at M32.

<sup>101</sup> *Id.* at M34-37. It remarked that while an invention or discovery “may concern the essential welfare, even the lives, of the community, and should be freely available at the earliest possible moment not unjust to the creator of it,” no book “can be said to be essential to the welfare or protection of the community.” *Id.* at M34. It also dismissed the contention that competition would lower the price of works in the public domain, arguing that it would merely enrich publishers at the expense of authors, with little or no benefit to the public. *Id.* at M34-36.

<sup>102</sup> H.R. REP. NO. 59-7083 (1907), *reprinted in* 6 BRYLAWSKI & GOLDMAN, *supra* note 73, at N13-14 (report), N31-33 (bill); S. REP. NO. 59-6187 (1907), *reprinted in* 6 BRYLAWSKI & GOLDMAN, *supra* note 73, at Q6-8 (report), Q18-19 (bill).

that a life-plus-thirty-years term could result in a *shorter* term of copyright than the existing law if the author lived less than twelve years after completing the work.<sup>103</sup> The Librarian of Congress submitted a report concluding that while 50% of authors would gain additional protection under a life-plus-thirty term, 32% would end up with a shorter term.<sup>104</sup> Finally, Representative Frank Currier of New Hampshire recounted a discussion he had with Mark Twain:

Mr. Clemens told me that he sold the copyright for *Innocents Abroad* for a very small sum, and he got very little out of the *Innocents Abroad* until the twenty-eight year period expired, and then his contract did not cover the renewal period, and in the fourteen years of the renewal period he was able to get out of it all the profits.<sup>105</sup>

These considerations were apparently sufficient to convince Congress to retain a fixed term of years with a renewal term. In the final report accompanying the 1909 Act, the House Committee on Patents said:

Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of the author to take the renewal term, and the law should be framed as is the existing law, so that he could not be deprived of that right.

The present term of twenty-eight years, with the right of renewal for fourteen years, in many cases is insufficient. The terms, taken together, ought to be long enough to give the author the exclusive right to his work for such a period that there would be no probability of its being taken away from him in his old age, when, perhaps, he needs it the most.<sup>106</sup>

<sup>103</sup> 5 BRYLAWSKI & GOLDMAN, *supra* note 73, at K61-66 (statement of Robert Underwood Johnson, American Copyright League) (characterizing the life-plus-thirty-year term as a “backward step”); *id.* at K88 (written analysis by American Copyright League).

<sup>104</sup> *Id.* at K163 (statement of Herbert Putnam, Librarian of Congress).

<sup>105</sup> *Id.* at K20; *see also id.* at K62 (repeating the story).

<sup>106</sup> H.R. REP. NO. 60-2222 (1909), *reprinted in* 6 BRYLAWSKI & GOLDMAN, *supra* note 73, at S14. Taking a different view of “the existing law,” the Supreme Court held in *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643 (1943), that a publisher could enforce an agreement made during the initial term requiring an author to assign both the initial and renewal terms. For a criticism of this decision, see Patry, *supra* note 24, at 670-71.

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Consequently, the Copyright Act of 1909 retained an initial term of twenty-eight years,<sup>107</sup> but it increased the duration of the renewal term to twenty-eight years,<sup>108</sup> for a maximum duration of fifty-six years. Like the 1831 Act, the 1909 Act extended the term of all existing copyrights,<sup>109</sup> but it did not revive any expired copyrights.<sup>110</sup>

In 1955, Congress authorized the Copyright Office to undertake a series of studies with an eye toward another comprehensive revision of the copyright laws.<sup>111</sup> This process culminated in a report to Congress by the Register of Copyrights in July 1961.<sup>112</sup> The Report recommended that the two-term structure be retained, with the renewal term extended to forty-eight years.<sup>113</sup> A vocal opposition insisted, however, that the U.S. should adopt a single term of life of the author plus fifty years, in order to permit eventual U.S. adherence to the Berne Convention.<sup>114</sup> Under the life-plus-fifty proposal, federal copyright protection would attach upon creation of the work, rather than on the date of first publication.<sup>115</sup> As the contro-

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<sup>107</sup> An Act To amend and consolidate the Acts respecting copyright, § 23, 35 Stat. 1075, 1080 (1909) (“the copyright secured by this Act shall endure for twenty-eight years from the date of first publication.”).

<sup>108</sup> *Id.* (author or specified successors “shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years” upon proper registration). The consequences of failing to register a renewal were expressly stated for the first time: “provided further, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication.” *Id.*

<sup>109</sup> *Id.*, § 24, 35 Stat. 1080-81 (“the copyright subsisting in any work at the time when this Act goes into effect may, at the expiration of the term provided for under existing law, be renewed and extended . . . for a further period such that the entire term shall be equal to that secured by this Act, including the renewal period.”).

<sup>110</sup> *Id.*, § 7, 35 Stat. 1077 (“no copyright shall subsist in the original text of any work which is in the public domain, or in any work which was published in this country or any foreign country prior to the going into effect of this Act and has not been already copyrighted in the United States.”).

<sup>111</sup> 1 PATRY, *supra* note 27, at 74.

<sup>112</sup> REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW, 87th Cong. (1961).

<sup>113</sup> 1 PATRY, *supra* note 27, at 76.

<sup>114</sup> *Id.* See Berne Convention for the Protection of Literary and Artistic Works, July 24, 1971 (Paris Revision), art. 7(1). Although the U.S. did adopt a life-plus-fifty term in 1976, its continued insistence on formalities such as notice and registration prevented its joining the Berne Convention until Mar. 1, 1989, when Congress removed these barriers to entry.

<sup>115</sup> Prior to the 1976 Act, most works were protected by state common-law copyright prior to first publication, and were eligible for federal statutory copyright only after publication with notice. See 1 NIMMER ON COPYRIGHT, *supra* note 43, at § 4.01[B]. The 1976 Act eliminated this dual state/federal

versy dragged on throughout 1962, it became clear that the general revision would not be enacted soon. Anticipating that any general revision would retroactively extend the terms of existing copyrights (but not revive expired copyrights), on September 19, 1962, Congress passed a law extending the renewal terms of all subsisting copyrights until December 31, 1965,<sup>116</sup> in order to keep older works under copyright until the general revision could be enacted.<sup>117</sup> The Department of Justice opposed the extension on the grounds that it would impede the public interest “in the early passing of copyrighted material into the public domain”;<sup>118</sup> but Congress brushed this objection aside, asserting that “the benefit arising from the expiration of copyright does not necessarily pass to the public.”<sup>119</sup>

Congress surely expected that three years would be enough time to finish the general revision; but in May 1965, the Senate Judiciary Committee reported “it is doubtful that a new law can be enacted before the expiration of the temporary extension.”<sup>120</sup> It recommended another extension until December 31, 1967, “so that the copyright holders may enjoy the benefit of any increase in term that may be enacted by the Congress.”<sup>121</sup> Congress passed the recommended two-year extension on August 28, 1965.<sup>122</sup> As work on the general revision continued, Congress enacted a

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system, replacing it with a unified federal term, and preempting all state laws providing protection “equivalent” to copyright. *See* 17 U.S.C. § 301(a) (2000). Because the Copyright Clause only allows Congress to protect “Writings,” however, federal copyright protection attaches only when the work is “fixed in a tangible medium of expression.” 17 U.S.C. § 102(a) (2000). Works of authorship that are not fixed can still be protected by state copyright law. *See, e.g.,* Cal. Civ. Code § 980(a)(1) (Deering 1990).

<sup>116</sup> Pub. L. No. 87-668, 76 Stat. 555 (1962).

<sup>117</sup> *See* Report of House Judiciary Committee on H.J. Res. 627, at 3 (1962), *reprinted in* 8 NIMMER ON COPYRIGHT, *supra* note 43, at app. 8-5 (“Although it is not possible to revive expired terms of copyright, it seems to the committee to be desirable to suspend further expiration of copyright for a period long enough to enable the working out of remaining obstacles to the overall revision of the copyright law.”).

<sup>118</sup> *Id.* at 6, *reprinted in* 8 NIMMER ON COPYRIGHT, *supra* note 43, at app. 8-10.

<sup>119</sup> *Id.* at 4, *reprinted in* 8 NIMMER ON COPYRIGHT, *supra* note 43, at app. 8-6.

<sup>120</sup> S. REP. NO. 89-548 (1965), *reprinted in* 1965 U.S.C.C.A.N. 2872, 2873.

<sup>121</sup> *Id.*

<sup>122</sup> Pub. L. No. 89-142, 79 Stat. 581 (1965).

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series of one-year extensions in 1967,<sup>123</sup> 1968,<sup>124</sup> 1969,<sup>125</sup> 1970,<sup>126</sup> and 1971.<sup>127</sup>

In dissenting from the House Report recommending passage of the 1971 extension, Congressman Robert W. Kastenmeier stated bluntly: “I regret I can no longer concur in the action of my colleagues in the matter of these annually recurring, ostensibly ‘interim,’ extensions of expiring

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<sup>123</sup> Act of November 16, 1967, Pub. L. No. 90-141, 81 Stat. 464 (1967). The stated purpose of the extension was identical to that for the 1965 extension: to benefit the holders of existing copyrights. H.R. REP. NO. 90-870, *reprinted in* 1967 U.S.C.C.A.N. 1921, 1922. The report was accompanied by a statement from the Register of Copyrights, estimating that 58,000 renewal copyrights would be affected, and adding: “The poignant irony of copyrights that have already been extended in anticipation of revision being allowed to fall into the public domain only a few months short of their goal is too obvious to require elaboration.” *Id.* at 1924. Thus, the mere fact of previous extensions having been granted was used as a justification for subsequent ones.

<sup>124</sup> Act of July 23, 1968, Pub. L. No. 90-416, 82 Stat. 397 (1968). Once again, the stated purpose was to benefit existing copyright holders. H.R. REP. NO. 90-1613 (1968), *reprinted in* 1968 U.S.C.C.A.N. 2701, 2702. In recommending passage of this extension, the Acting Librarian of Congress stated: “The series of extensions have been intended to keep works already in their second copyright term from falling into the public domain for the time being, so that they would have the advantage of the seventy-five-year term when the new copyright law comes into effect.” *Id.* at 2703.

<sup>125</sup> Act of Dec. 16, 1969, Pub. L. No. 91-147, 83 Stat. 360 (1969). The stated purpose was once again identical to that stated in 1965; and the recommendation of the Librarian of Congress was virtually identical to that of 1968. H.R. REP. NO. 91-651 (1969), *reprinted in* 1969 U.S.C.C.A.N. 1464, 1465, 1466.

<sup>126</sup> Act of Dec. 17, 1970, Pub. L. No. 91-555, 84 Stat. 1441 (1970). The boilerplate statement of purpose was repeated; and Congress estimated that some 86,800 copyrights would be affected by the extension. H.R. REP. NO. 91-1621, *reprinted in* 1970 U.S.C.C.A.N. 4969, 4970.

<sup>127</sup> Act of Nov. 24, 1971, Pub. L. No. 92-170, 85 Stat. 490 (1971). Congress’ explanation of its purpose was somewhat more elaborate than usual:

[T]he series of interim extension measures . . . stand revealed as legislation directed to the end that presently subsisting copyrights should, as far as possible, remain eligible for the advantage of longer term that will be derived by holders of copyrights that have not expired by the effective date. In short, the intent and purpose of the Congress has been to avoid lapses of copyright protection on the eve of the revision . . .

As a result, copyright holders have a real and reasonable expectancy that their copyright interests will survive long enough to benefit from the revision, . . . This expectancy should not be thwarted.

H.R. REP. NO. 92-605 (1971), *reprinted in* 1971 U.S.C.C.A.N. 1780, 1781. The Librarian of Congress estimated that an additional 12,700 works would be affected by the 1971 extension, bringing the total number of works affected to 99,500. *Id.* at 1782.

copyrights.”<sup>128</sup> He went on to question both the purpose and constitutionality of the interim extensions:

I now believe that [the resolution] affords a windfall to the holders of copyrights in their renewal term, where such term would otherwise expire this year. I find it impossible to identify any public interest that would be served by the enactment of this measure. . . .

The legislation makes what amounts to a retrospective reward for authorship at the expense of the public domain, in a situation in which the constitutional prescription “to promote the progress of useful Arts . . .” cannot directly be served.<sup>129</sup>

Despite Kastenmeier’s continued opposition,<sup>130</sup> Congress passed two more interim extensions of two years’ each, in 1972<sup>131</sup> and 1974.<sup>132</sup> This extraordinary series of extensions amply demonstrates that Congress believed that it had the constitutional power to extend the terms of copyrights that had not yet expired; but that the revival of expired copyrights would probably violate the “limited Times” provision of the Constitution.<sup>133</sup>

As finally enacted, the 1976 Act provided for a term of life-plus-fifty years for most works created on or after January 1, 1978.<sup>134</sup> Works made

<sup>128</sup> *Id.* at 1783 (dissenting views of Hon. Robert W. Kastenmeier).

<sup>129</sup> *Id.*

<sup>130</sup> See H.R. REP. NO. 92-1449 (1972) (dissenting views of Hon. Robert W. Kastenmeier, Hon. Don Edwards, Hon. John Conyers, Jr., and Hon. Robert F. Drinan), reprinted in 8 NIMMER ON COPYRIGHT, *supra* note 43, at app. 8-71 (interim extension “affords a windfall to the holders of copyrights in their renewal terms, . . . and it is impossible to identify any public interest that would be served by the enactment of this measure.”); H.R. REP. NO. 93-1581 (1974), reprinted in 1974 U.S.C.C.A.N. 6849, 6859 (views of Hon. Robert W. Kastenmeier, Dissenting in Part) (“It continues to be my belief that in too many instances the measure will operate to provide an unjustifiable windfall at the expense of the public domain.”).

<sup>131</sup> Act of Oct. 25, 1972, Pub. L. No. 95-566, 86 Stat. 1181 (1972).

<sup>132</sup> Act of Dec. 31, 1974, Pub. L. No. 93-573, § 104, 88 Stat. 1873 (1974). The Librarian of Congress estimated that 153,500 copyrighted works would be affected by the legislation. H.R. REP. NO. 93-1581 (1974), reprinted in 1974 U.S.C.C.A.N. 6849, 6858.

<sup>133</sup> See note 8 *supra*.

<sup>134</sup> “Copyright in a work created on or after January 1, 1978, subsists from its creation and, except as provided in the following subsections, endures for a term consisting of the life of the author and fifty years after the author’s death.” Former 17 U.S.C. § 302(a), as enacted in Pub. L. No. 94-553, § 101, 90 Stat. 2541, 2572 (1976). For joint works, the term was the life of the last surviving author plus fifty years. Former 17 U.S.C. § 302(b), as enacted in Pub. L. No. 94-553, § 101, 90 Stat. 2572 (1976).



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for hire were given a single term of seventy-five years from first publication, or 100 years from creation, whichever was shorter.<sup>135</sup> In order to unify federal and state law, works created before January 1, 1978, which were neither in the public domain nor copyrighted (and were therefore still subject to state common-law copyright) were given the basic term afforded to new works, subject to a statutory minimum of either twenty-five or fifty years.<sup>136</sup> Existing works still under copyright as of December 31, 1976 had their renewal terms extended by nineteen years, resulting in a maximum term of seventy-five years.<sup>137</sup> Finally, for administrative convenience, all existing and future copyrights were extended to “the end of the calendar year in which they would otherwise expire.”<sup>138</sup> Like its predecessors, the 1976 Act did not revive the copyrights of any works that had fallen into the public domain.<sup>139</sup>

Beginning on January 1, 1982, and each January 1 thereafter, works which had been copyrighted seventy-five years earlier and properly re-

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<sup>135</sup> Former 17 U.S.C. § 302(c), as enacted in Pub. L. No. 94-553, § 101, 90 Stat. 2572 (1976). The same term applies to anonymous works and pseudonymous works, unless the authors are identified in the records of the Copyright Office before the end of such term. *Id.*

<sup>136</sup> “Copyright in a work created before January 1, 1978, but not theretofore in the public domain or copyrighted, subsists from January 1, 1978, and endures for the term provided by section 302. In no case, however, shall the term of copyright in such a work expire before December 31, 2002; and, if the work is published on or before December 31, 2002, the term of copyright shall not expire before December 31, 2027.” Former 17 U.S.C. § 303, as enacted in Pub. L. No. 94-553, § 101, 90 Stat. 2573 (1976).

<sup>137</sup> For works still in their first term on Jan. 1, 1978, the Act provided a twenty-eight-year initial term, and a forty-seven-year renewal term. Former 17 U.S.C. § 304(a), as enacted in Pub. L. No. 94-553, § 101, 90 Stat. 2573 (1976). Subsection (b) provided:

The duration of any copyright, the renewal term of which is subsisting at any time between December 31, 1976, and December 31, 1977, inclusive, or for which a renewal registration is made between December 31, 1976, and December 31, 1977, inclusive, is extended to endure for a term of seventy-five years from the date copyright was originally secured.

Former 17 U.S.C. § 304(b), as enacted in Pub. L. No. 94-553, § 101, 90 Stat. 2574 (1976). Although the effective date of most of the 1976 Act was January 1, 1978, the Act expressly provided that this section would “take effect upon enactment.” Pub. L. No. 94-553, § 102, 90 Stat. 2599 (1976).

<sup>138</sup> 17 U.S.C. § 305 (2000).

<sup>139</sup> “This Act does not provide copyright protection for any work that goes into the public domain before January 1, 1978.” Pub. L. No. 94-553, § 103, 90 Stat. 2599 (1976). As a result of the interim extensions, however, the only works which were in the public domain by reason of age alone (as opposed to failure to comply with the required formalities or failure to renew) were those which had been copyrighted prior to Sept. 19, 1906. *See* notes 116-133 and accompanying text.

newed entered the public domain upon the expiration of their extended terms. This orderly progression continued until the mid-1990s, when two events converged to upset the status quo. First, members of the European Union extended the basic term of copyright for European authors to life-plus-seventy-years<sup>140</sup>; but under the rule of the shorter term, they refused to extend the terms for U.S. authors until the U.S. adopted a similar extension.<sup>141</sup> Second, as 1995 approached, the seventy-five-year term for older works threatened to begin to engulf works created in the 1920s and 1930s, an important period of artistic creativity in the U.S.<sup>142</sup> “Talking pictures” were introduced in 1927,<sup>143</sup> and film historians consider the 1930s to be the Golden Age of Hollywood. Commercial radio broadcasts began in the 1920s. The development of movies and radio in turn spurred the development of American popular song, and many of the creative giants of the age — Irving Berlin, George and Ira Gershwin, and Cole Porter, to name a few — published their most popular works in the 1920s and 1930s. Thus, movie studios, music publishers and the heirs of these popular songwriters were faced with the prospect of losing lucrative sources of revenue as these copyrighted works entered the public domain.<sup>144</sup> The extension of copyright terms in Europe gave these powerful economic interests the excuse they needed to seek an additional twenty years of copyright protection at the expense of the public domain.

<sup>140</sup> Council Directive 93/98, art. 1, para. 1, 1993 O.J. (L 290) [hereinafter EC Directive]. Works for which no natural author was identified were required to be given a term of seventy years “after the work is lawfully made available to the public.” EC Directive, art. 3 (anonymous and pseudonymous works), art. 4 (collective works and works made for hire).

<sup>141</sup> EC Directive, art. 7, para. 1 (“Where the country of origin of a work . . . is a third country, and the author of the work is not a Community national, the term of protection granted by Member States shall expire on the date of expiry of the protection granted in the country of origin of the work, but may not exceed the term laid down in Article 1.”).

<sup>142</sup> Cf. Lavigne, *supra* note 24, at 339 (“[D]uring the 1920s . . . the United States enjoyed a period of unprecedented growth and creativity. Hollywood emerged as the world headquarters of the motion picture industry, and the big band era, led by the likes of George Gershwin and Irving Berlin, was in full swing.”).

<sup>143</sup> See *THE JAZZ SINGER* (Warner Bros. 1927). The first animated talking picture was Walt Disney’s *Steamboat Willie* (1928), which introduced the original Mickey Mouse to the world.

<sup>144</sup> It is estimated that the Gershwin family trust alone will receive more than \$4 million dollars *per song* in additional royalties during the twenty-year extension. See John J. Fialka, *Songwriters’ Heirs Mourn Copyright Loss*, *WALL ST. J.*, Oct. 30, 1997, at B1 (reporting that a nationwide license for a single Gershwin song cost \$200,000 to \$250,000 annually). *Rhapsody in Blue* alone makes \$300,000 per year in royalties just for its use in United Airlines’ television commercials. SCHIFF, *supra* note 1, at 1.

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Legislation adding twenty years to all existing and future copyright terms was introduced in 1995,<sup>145</sup> but it failed to garner enough support in Congress. Although objections were raised to the constitutionality of term extension,<sup>146</sup> the main sticking point was ASCAP's and BMI's opposition to the Fairness in Music Licensing Act, a companion measure exempting many businesses and restaurants from having to pay licensing fees to play background music.<sup>147</sup> In 1998, however, Congress enacted both measures,<sup>148</sup> and the Sonny Bono Copyright Term Extension Act (named after the late singer-songwriter and Congressman) became law.<sup>149</sup> During the congressional debate on the CTEA, Mary Bono, Sonny's widow and congressional successor, proclaimed that perpetual copyright remained her ultimate goal, saying:

Actually, Sonny wanted the term of copyright protection to last forever. I am informed by staff that such a change would violate the Constitution. . . . As you know, there is also Jack Valenti's proposal for term to last forever less one day. Perhaps the Committee may look at that next Congress.<sup>150</sup>

Under the CTEA, copyrights in works created by individual authors on or after January 1, 1978, were extended to a term of life plus seventy years;<sup>151</sup> works-made-for-hire created on or after January 1, 1978, were extended to

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<sup>145</sup> See Copyright Term Extension Act of 1995, H.R. 989, 104th Cong. (1995); Copyright Term Extension Act of 1996, S. 483, 104th Cong. (1996) (as amended).

<sup>146</sup> See S. REP. NO. 104-315, at 33-35 (1996) (minority views of Mr. Brown); *id.* at 37-38 (minority views of Mr. Kohl).

<sup>147</sup> See Patry, *Protecting the Idle Rich*, *supra* note 17, at 923-24 (describing the political stalemate); Laurence R. Helfer, *World Music on a U.S. Stage: A Berne/TRIPS and Economic Analysis of the Fairness in Music Licensing Act*, 80 B.U. L. REV. 93, 132-39 (2000) (describing legislative efforts to enact the FMLA).

<sup>148</sup> See Lydia Pallas Loren, *Paying the Piper*, 3 J. SMALL & EMERGING BUS. L. 231, 235 (1999) ("Many in the legislature expressed the view that the FMLA balanced out the lengthening of copyright by giving small businesses a slight break from having to pay license fees when they wanted to play the radio.").

Given that the FMLA was considered a political trade-off for copyright term extension, it should be noted that this compromise is threatened by the ruling of the World Trade Organization that the FMLA violates the United States' international obligations under the TRIPs Agreement. See United States — Section 110(5) of the U.S. Copyright Act, WT/DS160/R (WTO 2000). Should Congress choose to repeal or amend the FMLA in response to this ruling, it should also reconsider its support for copyright term extension.

<sup>149</sup> Pub. L. No. 105-298, 112 Stat. 2827 (1998).

<sup>150</sup> 144 CONG. REC. H9952 (daily ed. Oct. 7, 1998).

<sup>151</sup> 17 U.S.C. § 302(a) (2000).

the shorter of ninety-five years from first publication or 120 years from creation;<sup>152</sup> and works registered for copyright before January 1, 1978 were extended to ninety-five years from the date of first publication.<sup>153</sup> Following the precedent established in 1831, the Act extended the terms of all existing and future copyrights, but it did not revive copyrights which had already fallen into the public domain.<sup>154</sup>

The effect of these multiple extensions on the replenishment of the public domain has been dramatic. Under the 1909 Act, all works published before 1922 would have entered the public domain on or before January 1, 1978, the effective date of the 1976 Act. Since that time, due to copyright extensions, only one additional year of copyrighted works (works first published in 1922) has entered the public domain; and under the CTEA, no published works will enter the public domain for the next eighteen years.

#### B. *Private Laws*

Beginning in 1789, several authors petitioned Congress to grant copyrights to individual works by means of private bills.<sup>155</sup> Despite a favorable recommendation from the special Committee to whom the petitions were referred, however, none of these private bills were enacted.<sup>156</sup> With the passage of the Copyright Act of 1790, the need for private legislation largely disappeared. Over the next one hundred years, however, Congress saw fit to enact nine private copyright laws for individual works.<sup>157</sup> Only two of these laws, however, granted an extension of the copyright term provided for in the general copyright law.

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<sup>152</sup> *Id.* § 302(c).

<sup>153</sup> *Id.* § 304(a) (for works in their first term on Jan. 1, 1978, an initial term of twenty-eight years, followed by an automatic renewal term of sixty-seven years); 17 U.S.C. § 304(b) (“Any copyright in its renewal term at the time that the Sonny Bono Copyright Term Extension Act becomes effective shall have a copyright term of 95 years from the date copyright was originally secured.”). The CTEA became effective on Oct. 27, 1998. Pub. L. No. 105-298, § 106, 112 Stat. 2829.

<sup>154</sup> 17 U.S.C. § 304(b) (2000).

<sup>155</sup> See 1 PATRY, *supra* note 27, at 25-27 & nn.76-77, 80.

<sup>156</sup> *Id.* at 26-29 & nn.78-80, 84-85.

<sup>157</sup> See *id.* at 27 n.80 (describing private laws); COPYRIGHT ENACTMENTS, *supra* note 32, at 73-77 (collecting private laws).

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The first three private laws<sup>158</sup> were for the benefit of John Rowlett of Philadelphia, whose book, *Rowlett's Tables of Discount or Interest*,<sup>159</sup> was originally copyrighted on February 4, 1802.<sup>160</sup> The first act, signed into law on May 24, 1828, extended the copyright on Rowlett's book for fourteen years, provided that Rowlett comply with the formalities of notice, registration and deposit.<sup>161</sup> The second act, passed in 1830, clarified that the notice requirement only applied to those copies in Rowlett's possession at the time the first Act was passed.<sup>162</sup> Finally, in 1843, the copyright was extended for another fourteen years.<sup>163</sup> All told, it appears that Rowlett enjoyed fifty-six years of copyright protection.<sup>164</sup>

What impelled Congress to twice extend Rowlett's copyright? In a forward to a later edition, Rowlett explained that he had invested a great deal of time and money in ensuring the accuracy of the first edition, and had lost money publishing it.<sup>165</sup> In subsequent years, however, the work

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<sup>158</sup> An Act to continue a copy-right to John Rowlett, ch. 145, 6 Stat. 389 (May 24, 1828); An Act to amend "An Act to continue a copyright of John Rowlett," ch. 13, 6 Stat. 403 (Feb. 11, 1830); An Act supplemental to the act of the twenty-fourth May, one thousand eight hundred and twenty-eight, to continue a copyright to John Rowlett, ch. 140, 6 Stat. 897 (Mar. 3, 1843).

<sup>159</sup> JOHN ROWLETT, *ROWLETT'S TABLES OF DISCOUNT OR INTEREST* (1st ed. 1802); see 6 Stat. 389 (1828); 6 Stat. 403 (1830). In the 1843 Act, the title was listed as "Rowlett's Tables of Discount *and* Interest." 6 Stat. 897 (1843) (emphasis added). As its name implies, the bulk of Rowlett's book was a compilation of mathematical tables, and it is possible that this portion may not have satisfied the constitutional standard of originality set forth in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), which holds that a compilation of facts or data cannot be copyrighted unless the facts or data are selected or arranged in an original manner. *Id.* at 357-59.

<sup>160</sup> 6 Stat. 897 (1843).

<sup>161</sup> 6 Stat. 389 (1828).

<sup>162</sup> 6 Stat. 403 (1830).

<sup>163</sup> 6 Stat. 897 (1843).

<sup>164</sup> Read literally, the extension provided by the 1828 Act would have expired on May 24, 1842; and the 1843 Act revived as well as extended Rowlett's copyright, effective Feb. 4, 1844, leaving a lapse of some twenty months. The last act, however, used the phrase "prolonged and continued forward," which implies that Congress believed that the copyright was still in force. This would have been true if the first extension had taken effect when Rowlett's original renewal term expired, on Feb. 4, 1830, rather than on the effective date of the first act. It appears, therefore, that both Rowlett and Congress assumed that the first extension added a full fourteen years to Rowlett's copyright.

<sup>165</sup> "[N]otwithstanding this uncommonly costly work . . . has been so extensively and so liberally patronized, it has not yet so much as paid with Interest, the heavy loss of nearly Four Thousand Dollars, besides six years of Time, (from 1799 to 1805,) sustained on the first edition of 7000 copies; . . . to say nothing of compensation or profit, for almost a lifetime of care, toil, and

was deemed so valuable that second-hand copies were being sold at auction for high prices;<sup>166</sup> and many pirated editions appeared during the initial term.<sup>167</sup> Rowlett sought the extensions so that he could recover some of the money he had lost on the first edition.<sup>168</sup> The record thus reveals a problem that continues to trouble copyright theorists to this day: protecting the investment of time and money spent in compiling a database that can easily be copied by free-riders.<sup>169</sup>

In two other instances, Congress “privatized” copyrights that had previously been in the public domain.<sup>170</sup> Each of these acts was for the benefit of a widow of a prominent American.<sup>171</sup> In both instances, the books

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sacrifice.” JOHN ROWLETT, *ROWLETT’S TABLES OF DISCOUNT OR INTEREST* vii (5th ed. 1836).

<sup>166</sup> “[W]hen, after a lapse of 26 years, the Book had become scarce, and in great demand, it appeared that a great number of copies had been sought for in every quarter, and picked up as they could be found, *second hand*, at various prices, from 10 to 25 dollars per copy.” *Id.* at 18.

<sup>167</sup> Even the pirates acknowledged the scarcity and value of Rowlett’s work. The preface to one unauthorized edition states: “This inestimable work was then patronized to an extent unparalleled in this country. It now maintains a reputation above every work of the kind, and has become so scarce that rarely, if at all, can a copy be found for sale; and if met with, an exorbitant price is always demanded for it.” JOHN ROWLETT, *ROWLETT’S TABLES OF DISCOUNT OR INTEREST* 3 (reprint; Portland, Maine, Jan. 1, 1826).

<sup>168</sup> “[I]t was evident the Book had proved itself useful *beyond doubt*, . . . and a Copy was laid before Congress for inspection, soliciting a continuance of Copyright — a special Act for this work was passed accordingly, and from that period *alone*, may be dated a *hope of reimbursement*, and peradventure before I die, *Interest* on the loss, if not something for compensation.” *ROWLETT’S TABLES*, *supra* note 165, at 18.

<sup>169</sup> See, e.g., Amy C. Sullivan, *When the Creative is the Enemy of the True: Database Protection in the U.S. and Abroad*, 29 *AIPLA Q.J.* 317 (2001); Jonathan Band & Makoto Kono, *The Database Protection Debate in the 106th Congress*, 62 *OHIO ST. L.J.* 869 (2001); Paul J. Heald, *The Extraction/Duplication Dichotomy: Constitutional Line-Drawing in the Database Debate*, 62 *OHIO ST. L.J.* 933 (2001); Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment*, 17 *CARDOZO ARTS & ENT. L.J.* 47 (1999); Jane C. Ginsburg, *Copyright, Common Law, and Sui Generis Protection of Databases in the United States and Abroad*, 66 *U. CIN. L. REV.* 151 (1997); J.H. Reichman & Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 *VAND. L. REV.* 51 (1997).

<sup>170</sup> An Act for the relief of Mistress Henry R. Schoolcraft, ch. 16, 11 Stat. 557 (1859); An Act for the relief of Mrs. William L. Herndon, ch. 99, 14 Stat. 587 (1866).

<sup>171</sup> Henry Rowe Schoolcraft was an Indian Agent for the U.S. Government. He spent thirty years living among Indian tribes in the Michigan territory and elsewhere, and negotiated several treaties with them. See *Mole Lake Band of Chippewa Indians v. United States*, 126 Ct. Cl. 596, 607-09, 611-12 & n.32

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were written by government employees in the course of their duties<sup>172</sup> and were “published under order of Congress,”<sup>173</sup> and were therefore not subject to copyright. Moved by the financial plight of the authors’ widows, however, Congress granted to each “the exclusive right to republish the book” for a period of fourteen years.<sup>174</sup>

In one private law, Congress purchased the copyright of a book describing a new method of navigation, and placed the work in the public domain.<sup>175</sup> The other three private laws from this period restored the copyrights of authors who had relied on the economic incentive provided by copyright but had inadvertently failed to comply with one or more of the necessary formalities.<sup>176</sup> There are no reported decisions challenging the validity of any of these nineteenth-century private laws.

Only one private copyright law was enacted in the twentieth century. In 1971, Congress passed a law extending, and in some instances reviving, the copyrights in all editions of Mary Baker Eddy’s *Science and Health*, for a term of seventy-five years from the effective date of the Act or from the date of first publication, whichever was later.<sup>177</sup> The book had originally been published in 1875, and had been revised numerous times before Eddy’s death in 1910.<sup>178</sup> Under this extraordinary legislation, the copy-

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(1953). For a scathing critique of his role in these negotiations, see *United States v. State of Michigan*, 471 F. Supp. 192, 215-16, 226-30 (W.D. Mich. 1979). William Lewis Herndon was an officer in the U.S. Navy who became the first American to explore the Amazon basin. For his background, and an account of his final voyage, see GARY KINDER, *SHIP OF GOLD IN THE DEEP BLUE SEA* 22-25 (1998).

<sup>172</sup> Schoolcraft’s six-volume treatise, *History, Statistics, Conditions and Prospects of the Indian Tribes of the United States*, was commissioned by Congress and originally published in 1851-57. Herndon’s book, *Exploration of the Valley of the Amazon*, was his report, in narrative form, of an expedition he was ordered to undertake by the Navy in 1851. “His report so far surpassed his superiors’ expectations that Congress . . . published ten thousand copies” in 1854. KINDER, *supra* note 171, at 23.

<sup>173</sup> 11 Stat. 557 (1859); 14 Stat. 587 (1866).

<sup>174</sup> 11 Stat. 557 (1859); 14 Stat. 587 (1866).

<sup>175</sup> An Act for the purchase of the copyright of a work by Thomas H. Sumner, wherein he describes his new method of ascertaining a ship’s position at sea, ch. 187, 10 Stat. 810 (Aug. 2, 1854).

<sup>176</sup> An Act for the relief of Levi H. Corson, ch. 57, 9 Stat. 763 (Feb. 19, 1849); An Act for the relief of William Tod Helmuth, of New York, ch. 534, 18 Stat. 618 (June 23, 1874); An Act for the relief of Judson Jones, ch. 29, 30 Stat. 1396 (Feb. 17, 1898).

<sup>177</sup> An Act for the relief of Clayton Bion Craig, Arthur P. Wuth, Mrs. Lenore D. Hanks, David E. Sleeper, and DeWitt John, Priv. L. No. 92-60, 85 Stat. 857 (Dec. 15, 1971).

<sup>178</sup> *United Christian Scientists v. Christian Science Bd. of Directors, First Church of Christ, Scientist*, 829 F.2d 1152, 1154-55 (D.C. Cir. 1987).

rights would have been extended to at least the year 2046, 171 years after first publication and 136 years after the death of the author. Moreover, as the Court of Appeals later noted:

[B]y providing that subsequently published editions are each to be protected for 75 years from the date of first publication, it may empower First Church to maintain the copyright for an indefinite period in variant editions of Science and Health which it does not choose to publish. . . .

Should First Church remain content to publish only the 1906 edition of the text it currently publishes, it would hold copyrights in, and thus publication control over, all other variant editions, whose publication it could suppress indefinitely.<sup>179</sup>

The constitutionality of the law was challenged in court by dissident members of the Christian Science Church, who wished to promote and publish variant editions of the Church's basic text.<sup>180</sup> The law was struck down on the grounds that it violated the Establishment Clause of the First Amendment.<sup>181</sup> Although the Court did not find it necessary to rule on the argument that the law also violated the "limited Times" provision of the Copyright Clause,<sup>182</sup> its opinion is replete with skeptical references to the extraordinary duration of the copyrights granted by the law.<sup>183</sup>

In sum, the history of private copyright legislation reveals only one work for which Congress successfully extended the term of copyright. There is an important reason, however, why that single example should not be considered persuasive precedent for term extension generally. In an era in which bankers and merchants had to calculate interest by hand, Rowlett's production of accurate interest tables required a truly monumental investment of time, labor and money that far exceeded the typical copyrighted work.<sup>184</sup> In Rowlett's day, the investment of time, labor and

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<sup>179</sup> *Id.* at 1157 & n.22.

<sup>180</sup> *Id.* at 1155-56.

<sup>181</sup> *Id.* at 1161-71.

<sup>182</sup> *Id.* at 1171 n.104.

<sup>183</sup> *Id.* at 1169-70 ("Moreover, the copyright granted by means of Private Law 92-60 is exceptional in scope and duration. Even if not construed as a copyright in perpetuity, it purports to confer rights of unprecedented duration. . . . Scant authority, if any, exists for such a dramatic departure from copyright practice.") *See also id.* at 1157 & n.22; 1159 ("an unusual measure of copyright protection by unusual means") & n.28; 1160 ("an extraordinary grant of power").

<sup>184</sup> Rowlett hired a team of assistants to perform each mathematical computation three times, by different methods. The three lists were examined twice each for errors by different teams, and the page proofs were examined four times. ROWLETT'S TABLES, *supra* note 159, at 6-7. Rowlett claimed that he



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money was at least arguably an acceptable basis for copyright protection.<sup>185</sup> Now that the Supreme Court has firmly rejected the “sweat of the brow” doctrine as inconsistent with the Copyright Clause,<sup>186</sup> however, the conceptual underpinnings of Rowlett’s copyright claim have been eroded. Likewise, while such a large investment of time, labor and money might have been entitled to protection under a broad reading of the misappropriation doctrine of *International News Service v. Associated Press*,<sup>187</sup> in recent years the pre-*Erie INS* doctrine has been greatly restricted.<sup>188</sup> Rowlett’s case, therefore, provides little support for the notion that Congress may serially extend all existing copyrights without heed to the “limited Times” provision of the Copyright Clause.

### III. PATENT TERM EXTENSION AND THE CONSTITUTION

#### A. Utility Patents

##### 1. General Laws

In accordance with the established practice in England, all colonial and state patents prior to 1789 were granted by means of private laws for the benefit of specific individuals.<sup>189</sup> It is therefore unsurprising that fourteen petitions for patent rights were presented to Congress during its first

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had “expended in the undertaking a sum of money beyond ordinary bounds in works of this bulk and kind.” *Id.* at 8.

<sup>185</sup> See Paula Baron, *Back to the Future: Learning from the Past in the Database Debate*, 62 OHIO ST. L.J. 879, 912-28 (2001) (describing how copyright cases prior to 1850 effectively provided protection for databases).

<sup>186</sup> See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991); see also Jane C. Ginsburg, *No “Sweat”? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338 (1992).

<sup>187</sup> 248 U.S. 215, 239-40 (1918) (“defendant . . . admits that it is taking material that has been acquired by the complainant as the result of organization and the expenditure of labor, skill and money, and which is salable by the complainant for money, and that defendant in appropriating it and selling it as his own is endeavoring to reap where he has not sown, and . . . is appropriating to itself the harvest of those who have sown.”). See Wendy J. Gordon, *On Owning Information: Intellectual Property and the Restitutionary Impulse*, 78 VA. L. REV. 149 (1992).

<sup>188</sup> See *Nat’l Basketball Ass’n v. Motorola, Inc.*, 105 F.3d 841, 850-53 (2d Cir. 1997) (misappropriation claim limited to time-sensitive information, appropriated by free riders, in such a way that the existence of plaintiff’s product or service is threatened); Gary Myers, *The Restatement’s Rejection of the Misappropriation Tort: A Victory for the Public Domain*, 47 S. C. L. REV. 673 (1996).

<sup>189</sup> See Edward C. Walterscheid, *The Early Evolution of the United States Patent Law: Antecedents (Part 4)*, 78 J. PAT. OFF. SOC’Y 668 (1996). It is worth noting that many statutes were enacted in England in the late eighteenth century extending the duration of particular patents, including James Watt’s patent on the steam engine. See Walterscheid, *supra* note 25, at 327-31.

session under the new Constitution.<sup>190</sup> Congress rejected all of these private bills in favor of general legislation, the Patent Act of 1790; which, as noted above, authorized patents to be granted for a maximum term of fourteen years.<sup>191</sup>

As patents granted under the Act began to expire in the early 1800s, many inventors began to complain that the fourteen-year term was too short a time in which to profit from exploitation of their inventions.<sup>192</sup> Between 1805 and 1814, Congress considered and rejected several proposals to enact a general renewal term for patents of between seven and fourteen years.<sup>193</sup> “Instead, it chose to act only on a case-by-case basis with regard to petitions for extension or renewal of particular patents.”<sup>194</sup> Between 1808 and 1836, eleven private laws were passed granting term extensions for individual patents. These private laws are discussed below.<sup>195</sup>

In 1832, in response to the growing number of private petitions for extension or renewal, Congress passed a statute specifying the conditions under which it would consider such petitions.<sup>196</sup> That statute provided “that application to Congress to prolong or renew the term of a patent shall be made before its expiration,”<sup>197</sup> and further added that:

The petition shall set forth particularly the grounds of the application. . . . [and] it shall be accompanied by a statement of the ascertained value of the discovery, invention, or improvement, and of the receipts and expenditures of the patentee, so as to exhibit the profit or loss arising therefrom.<sup>198</sup>

Although this statute standardized the form of petitions, “it did not give any assurance that the petition would be granted. In other words, extension or renewal still necessitated a special act of Congress.”<sup>199</sup>

Four years later, Congress enacted a general revision of the patent laws.<sup>200</sup> The 1836 Act retained the fourteen-year patent term,<sup>201</sup> and it

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England, of course, did not have a Constitution limiting the duration of patents and copyrights to “limited Times.”

<sup>190</sup> See EDWARD C. WALTERSCHEID, *TO PROMOTE THE PROGRESS OF USEFUL ARTS: AMERICAN PATENT LAW AND ADMINISTRATION, 1798-1836*, 82-87, 107-08 (1998).

<sup>191</sup> An Act to promote the progress of useful Arts, § 1, 1 Stat. 109, 110 (Apr. 10, 1790).

<sup>192</sup> See WALTERSCHEID, *supra* note 190, at 309-13.

<sup>193</sup> *Id.* at 337-40.

<sup>194</sup> *Id.* at 313.

<sup>195</sup> See notes 235-286 and accompanying text.

<sup>196</sup> Act of July 3, 1832, § 2, 4 Stat. 559 (1832).

<sup>197</sup> *Id.*

<sup>198</sup> *Id.*

<sup>199</sup> WALTERSCHEID, *supra* note 190, at 344.

<sup>200</sup> Act of July 4, 1836, ch. 357, 5 Stat. 117 (1836).

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included a procedure by which any patentee could petition a three-person Board for a seven-year extension of his or her term.<sup>202</sup> The statute provided:

And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent . . . for the term of seven years from and after the expiration of the first term. . . . *Provided however*, that no extension of a patent shall be granted after the expiration of the term for which it was originally issued.<sup>203</sup>

The application of this section to patents issued under the 1836 Act presents no constitutional difficulty, as the right to apply for a single seven-year renewal term became part of the expected reward for prospective patentees.<sup>204</sup> But this provision applied retroactively to existing patents, as well as to patents issued under the 1836 Act. Once again, therefore, Congress expressed its view that it could extend the term of patents and copyrights, so long as they had not yet expired at the time of the extension.

The process of hearing petitions for extensions under the 1836 Act proved to be burdensome for the Patent Office. In 1861, therefore, Congress decreed “[t]hat all patents hereinafter granted shall remain in force for a term of seventeen years from the date of issue, and all extension of such patents is hereby prohibited.”<sup>205</sup> By its terms, this enactment was not retroactive. Thus, when a general revision was passed in 1870, the right to petition for an extension under the 1836 Act was limited to those patents granted prior to March 2, 1861.<sup>206</sup> Consequently, “[t]he last extension of

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<sup>201</sup> *Id.*, § 5, 5 Stat. 119.

<sup>202</sup> *Id.*, § 18, 5 Stat. 124-25. It is clear from the statutory language that a patent could only be renewed once, “for the term of seven years from and after the expiration of the first term.” *Id.*

<sup>203</sup> *Id.*

<sup>204</sup> In this respect, the 1836 Act is no different from the Copyright Acts of 1790, 1831, and 1909, all of which provided for an initial term and a single renewal term of fixed duration.

<sup>205</sup> Act of Mar. 2, 1861, ch. 88, § 16, 12 Stat. 246, 249 (1861).

<sup>206</sup> Patent Act of 1870, § 63, 16 Stat. 198, 208 (1870).

the kind was granted in 1875 and expired in 1882.”<sup>207</sup> Aside from this grandfather clause, both the 1870 Act<sup>208</sup> and the 1952 Act<sup>209</sup> provided for a single term of seventeen years.

In the twentieth century, special term extension acts were passed in the wake of the World War I<sup>210</sup> and World War II.<sup>211</sup> These Acts authorized the Commissioner of Patents to extend patents owned<sup>212</sup> by war veterans,<sup>213</sup> “on the theory that their service would have in many cases precluded them an opportunity to exploit their patents during that period.”<sup>214</sup> Although the Acts allowed extensions that exceeded the terms

<sup>207</sup> 2 ERNEST BAINBRIDGE LIPSCOMB III, WALKER ON PATENTS § 8:8, at 498 (3d ed. 1985).

<sup>208</sup> Patent Act of 1870, § 22, 16 Stat. at 201.

<sup>209</sup> Pub. L. No. 82-593, § 4, 66 Stat. 792, 804 (1952) (codified at former 35 U.S.C. § 154).

<sup>210</sup> Act of May 31, 1928, ch. 992, § 1, 45 Stat. 1012 (1928). Only six patents were extended under the 1928 law. *See* Extension of Reissued Patent No. 19,023, Hearings Before the Committee on Patents on H.R. 2994, 78th Cong. (Oct. 13, 1943) at 2. One aggrieved veteran appealed to the Court of Customs and Patent Appeals, but the appeal was dismissed on procedural grounds. *See In re Horton*, 58 F.2d 682 (C.C.P.A. 1932).

<sup>211</sup> Pub. L. No. 81-958, ch. 444, 64 Stat. 316 (1950). It is unknown how many patents were extended under this Act, but one veteran had no fewer than twenty-four patents extended. *See* Application of Walker, 195 F.2d 531, 532 (C.C.P.A. 1952); *see also* Barrett v. United States, 405 F.2d 502, 503 n.1 (Ct. Cl. 1968) (noting patent was extended by six years under 1950 Act).

<sup>212</sup> The 1950 act applied only to patents “still owned” by the veteran-inventor, or to patents assigned to the veteran of which the veteran was “continuously thereafter the sole owner.” In a series of decisions, the Court of Customs and Patent Appeals interpreted the phrase “still owned” to require continuous and sole ownership, and it affirmed the denial of several extensions on that ground. *See* Application of Field, 190 F.2d 268 (C.C.P.A. 1951) (patent owned by corporation of which veteran owned 79% of stock); Application of Miller, 193 F.2d 339 (C.C.P.A. 1951) (patent assigned to corporation for period of twenty-two months and reassigned to veteran); Application of Blood, 197 F.2d 545 (C.C.P.A. 1952) (patent issued to corporation of which veteran owned 52% of stock and later assigned to the veteran); Application of Sutherland, 197 F.2d 556 (C.C.P.A. 1952) (patent held in trust by two veterans for the benefit of themselves and four others). Congress subsequently amended the act to provide that “[n]o person shall be held not to be the sole owner of a patent within the meaning of this Act, by reason of any interest of his spouse in such patent.” Pub. L. No. 82-437, ch. 540, 66 Stat. 321 (1952).

<sup>213</sup> In *Application of Martin*, 195 F.2d 303 (C.C.P.A. 1952), the Court of Customs and Patent Appeals held that service in the Merchant Marine, operating under the control of the U.S. Navy, was not service “in the military or naval forces of the United States” within the meaning of the 1950 Act.

<sup>214</sup> S. REP. NO. 81-1190, reprinted in 1950 U.S.C.C.A.N. 2667, 2667. Consequently, both acts were restricted to veterans who could demonstrate that they had lost income from the patent as a result of their service. *See* Appli-

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of service of the patentees,<sup>215</sup> this was considered necessary because of the delay in enacting them following the wars.<sup>216</sup> These Acts can thus be justified as restoring the term reasonably expected to be enjoyed by the patentees, rather than increasing it.

In 1984, Congress again acted to mitigate the consequences of circumstances beyond the control of the patentee by enacting the Drug Price Competition and Patent Term Restoration Act of 1984,<sup>217</sup> commonly known as the Hatch-Waxman Act. The Act provided for the extension of patents for human drug products, medical devices, and food additives subject to regulatory review by the Food and Drug Administration.<sup>218</sup> The extension is equal to the period during which the product was under regulatory review,<sup>219</sup> subject in most cases to a maximum extension of five years.<sup>220</sup> The extended patent term may not exceed fourteen years follow-

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cation of Walker, 195 F.2d 531 (C.C.P.A. 1952) (affirming denial of extension where income from patent had increased during the war years).

<sup>215</sup> Act of May 31, 1928, § 1(F), 45 Stat. at 1013 (“The period of extension of the patent from the expiration of the original term thereof . . . shall in no case exceed a further term of three times the length of his said service in the military or naval forces”); Pub. L. No. 81-958, § 1, 64 Stat. at 317 (“The period of extension of such patent shall be a further term from the expiration of the original term thereof equaling twice the length of the portion of his said service . . . during which his patent was in force.”).

<sup>216</sup> See CONF. REP. NO. 81-1880, *reprinted in* 1950 U.S.C.C.A.N. 2669, 2669 (“The Senate amendment to the bill would have reduced the period of the proposed extension of patents for veterans of World War II from twice the period of their service between certain dates to a length of time only equaling the period of service between those dates. This would have inadvertently deprived many veterans of their rights because in many cases the period represented by the Senate amendment would have already expired.”).

As a consequence of the delay, these Acts in some cases revived expired patent rights in addition to extending them. Both Acts, however, contained savings clauses that preserved the rights of those who had manufactured infringing devices after the expiration of the original term and before the extension was obtained. Act of May 31, 1928, § 1(H), 45 Stat. at 1013; Pub. L. No. 81-958, § 4(c), 64 Stat. at 318.

<sup>217</sup> Pub. L. No. 98-417, Title II, 98 Stat. 1585, 1598 (1984) (codified as amended in 35 U.S.C. § 156).

<sup>218</sup> See 35 U.S.C. § 156(f) (2000).

<sup>219</sup> *Id.* § 156(c). The regulatory review period is reduced by “any period . . . during which the applicant . . . did not act with due diligence,” *Id.* § 156(c)(1), and by one-half of the period between which testing was begun and an application for approval was submitted to the FDA, *Id.* § 156(c)(2).

<sup>220</sup> *Id.* § 156(g)(6) (2000). If the patent issued after the date of enactment, or the patent issued before the date of enactment but no testing had occurred before that date, the maximum extension is five years. § 156(g)(6)(A-B). If the patent issued and testing was begun but approval was not obtained before the date of enactment, the maximum extension is two years.

ing FDA approval,<sup>221</sup> and a patent may receive only one such extension.<sup>222</sup> Like the veterans' extensions, the Hatch-Waxman Act can be justified as merely restoring the term intended by Congress and reasonably expected to be enjoyed by the patentees, rather than increasing it.

In 1994, in legislation implementing the Uruguay Round of the General Agreement on Tariffs and Trade,<sup>223</sup> Congress changed the basic term for all newly-issued patents<sup>224</sup> from seventeen years from the date of issue to twenty years from the date of filing.<sup>225</sup> Existing patents and pending applications were automatically given the greater of the two periods.<sup>226</sup> For these patents, the statute extends the term of the patent only if the patent issued less than three years from the date of filing. In a case decided shortly after the amendment, the Federal Circuit commented:

The purpose of the URAA was not to extend patent terms, although it has the effect in some cases, but to harmonize the term provision of United States patent law with that of our leading trading partners . . . .<sup>227</sup>

Nonetheless, Congress recognized that extending the terms of existing patents might be unfair to those who had relied on the previous expiration date. It therefore provided that if, prior to the effective date, a person had

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§ 156(g)(6)(C). A statutory loophole exempts some products which do not fall into any of the above categories from any maximum period of extension. *See Hoechst Aktiengesellschaft v. Quigg*, 917 F.2d 522, 528-29 (Fed. Cir. 1990).

<sup>221</sup> 35 U.S.C. § 156(c)(3) (2000).

<sup>222</sup> Extension is permitted only if "the term of the patent has never been extended" under the Act. 35 U.S.C. § 156(a)(2) (2000).

<sup>223</sup> *See generally* Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809 (Dec. 8, 1994) (codified in scattered sections of the United States Code).

<sup>224</sup> Section 534(b)(1) of the URAA provides: "Subject to paragraph (2), the amendments made by this subtitle take effect on the date that is 6 months after the date of enactment of this Act and shall apply to all patent applications filed in the United States on or after the effective date." Pub. L. No. 103-465, § 534(b)(1), 108 Stat. at 4990. The URAA was passed on Dec. 8, 1994; so the effective date of the term extension provisions was June 8, 1995. For a discussion of an ambiguity with regard to the effective date, see 5 DONALD S. CHISUM, CHISUM ON PATENTS § 16.04[6], at 16-221 n.4 (2001 ed.).

<sup>225</sup> "[S]uch grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States." 35 U.S.C. § 154(a)(2) (2000).

<sup>226</sup> "The term of a patent that is in force on or that results from an application filed before [the effective date] . . . shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers." 35 U.S.C. § 154(c)(1) (2000).

<sup>227</sup> *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543, 1547 (Fed. Cir. 1996).

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commenced acts or made a substantial investment toward acts that became infringing because of the extension, the normal remedies for infringement would not apply.<sup>228</sup> Instead, the person would be allowed to continue the infringing acts upon payment of an “equitable remuneration” to the patentee.<sup>229</sup>

This brief history of patent terms reveals three noteworthy features. First, while patent terms have been increased from a maximum of fourteen years from issuance to a maximum of twenty years from filing, copyright terms have been increased from a maximum of twenty-eight years from first publication to a maximum of ninety-five years from first publication for older works, the greater of ninety-five years from first publication or 120 years from creation for works made for hire, and life of the author plus seventy years for the works of individual authors. In 1790, a copyright could last twice as long as a patent; today, a copyright lasts five or six times as long as a patent. If the Constitution can be read to require proportionality between copyright terms and patent terms, the Sonny Bono Copyright Term Extension Act would seem to exceed it.<sup>230</sup>

Second, both of the veterans’ extensions and the Hatch-Waxman Act were intended to be compensatory for some delay beyond the control of the patentee, rather than a true increase in the basic term of a patent.

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<sup>228</sup> 35 U.S.C. § 154(c)(2) (2000).

<sup>229</sup> *Id.* § 154(c)(3).

The Uruguay Round Agreements Act also added a provision increasing the term of a patent to compensate for delays in issuance caused by an interference proceeding, a secrecy order, or appellate review of the denial of a patent. Pub. L. No. 103-465, § 532(a), 108 Stat. at 4984 (codified in former 35 U.S.C. § 154(b)). This subsection was in effect for just five years; in 1999 it was repealed and replaced with a new section adjusting the patent term for these and other delays in prosecution of a patent beyond the control of the patentee. Pub. L. No. 106-113, Div. B, § 1000(a)(9) [S. 1948, Title IV, § 4402(a)], 113 Stat. 1536, 1501A-557-58 (Nov. 29, 1999) (codified at 35 U.S.C. § 154(b)). Neither of these sections presents constitutional difficulties, however, because both were applied prospectively only, i.e., only to applications filed on or after their effective dates. *See* Pub. L. No. 103-465, § 534(b)(1), 108 Stat. at 4990 (“Subject to paragraph (2), the amendments made by section 532 take effect on the date that is 6 months after the date of enactment of this Act [Dec. 8, 1994] and shall apply to all patent applications filed in the United States on or after the effective date.”); Pub. L. No. 106-113, Div. B, § 1009(a)(9) [S. 1948, Title IV, § 4405(a)], 113 Stat. at 1501A-560 (“The amendments made by section 4402 and 4404 shall take effect on the date that is 6 months after the date of the enactment of this Act [Nov. 29, 1999] and . . . shall apply to any application filed on or after the date that is 6 months after the date of the enactment of this Act.”).

<sup>230</sup> *See* Edward C. Walterscheid, *The Remarkable—And Irrational—Disparity Between the Patent Term and Copyright Term*, 83 J. PAT. & TRADEMARK OFF. SOC’Y 233 (2001).

Third, until 1994 relatively few subsisting patents were extended for non-compensatory reasons by general acts of Congress. The 1836 Act only allowed patentees to apply for an extension; it did not automatically grant an extension to all existing patents.<sup>231</sup> The 1861 Act enacting a seventeen-year term did not apply retroactively. The recent exception is the URAA, which applied retroactively to those patents in force which issued within three years of filing. Although the effect of this change was hotly debated, a 1994 study found that approximately 75% of existing patents would have their terms extended by the URAA, by an average of 253 days.<sup>232</sup> However, while the URAA did extend most patents, its principal purpose was to change the measurement of patent terms from the date of issuance to the date of filing.<sup>233</sup> Some members of Congress even believed that the change would result in a significant reduction of patent terms.<sup>234</sup> Unlike the CTEA, it cannot be said that term extension was the primary motivating factor for the URAA legislation. Thus, although Congress has occasionally asserted the power to extend the terms of existing patents, none of those occasions provides a precedent for the across-the-board term extension of the Sonny Bono Copyright Term Extension Act.

## 2. *Private Laws*

The first private law extending a patent was enacted by Congress in 1808.<sup>235</sup> The patentee was Oliver Evans, and the patent described a combination of five machines used in the operation of a flour mill.<sup>236</sup> His patent was destined to become one of the most litigated patents in U.S. history, generating twelve reported decisions between 1807 and 1822.<sup>237</sup>

<sup>231</sup> In 1846, it was reported that only ten patents had been extended under § 18 of the 1836 Act, out of 14,526 patents that had been issued prior to that time. *Wilson v. Rousseau*, 45 U.S. (4 How.) 646, 708 (1846) (Woodbury, J., dissenting).

<sup>232</sup> See Mark A. Lemley, *An Empirical Study of the Twenty-Year Patent Term*, 22 *AIPLA Q.J.* 369, 391-92 (1994).

<sup>233</sup> *Id.* at 376-81 (explaining that the GATT extension was motivated in part by the problem of “submarine” patents, and that the incentive to engage in submarine patenting is defeated by a term measured from date of filing).

<sup>234</sup> *Id.* at 381.

<sup>235</sup> An Act for the relief of Oliver Evans, 6 Stat. 70 (1808). By this time, only two delegates to the Constitutional Convention of 1787 remained in Congress, both in the Senate. Three other members of the Senate had been representatives in the First Congress. See BENTON, *supra* note 47, at 21-25 (listing delegates); BIOGRAPHICAL DIRECTORY, *supra* note 47, at 51-52 (listing members of First Congress), 74-76 (members of 10th Congress).

<sup>236</sup> See P.J. Federico, *The Patent Trials of Oliver Evans*, 27 *J. PAT. OFF. SOC'Y* 586, 590-93 (1945); WALTERSCHEID, *supra* note 190, at 158-59.

<sup>237</sup> See *Evans v. Jordan*, 13 U.S. (9 Cranch) 199 (1815); *Evans v. Eaton*, 16 U.S. (3 Wheat.) 454 (1818); *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356 (1822); *Evans v.*



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In order to fully appreciate the significance of those decisions, it is helpful to examine the chronology of his attempts to obtain an extension.

Evans' original patent was the third patent issued by the federal government; its effective date was January 7, 1791,<sup>238</sup> and under the terms of the 1790 Act, its original expiration date was January 7, 1805. On December 21, 1804, Evans presented a petition to Congress seeking to have the term of his patent extended by seven years.<sup>239</sup> The House Committee of Commerce and Manufactures described the petition as follows:

The petitioner represents, that, owing to the great extent of the United States, and the difficulties usually attending the introduction of improvements in new countries, he has not yet been able to collect any considerable sums from his patent; and having found it necessary to impose on himself a condition not to expend in new inventions and discoveries any more than the net profits derived from old ones, he finds himself compelled to ask for the extension of his patent right for the improvement in merchant flour mills, with a view that he may appropriate the proceeds towards completing his further inventions on steam engines . . .<sup>240</sup>

On January 22, 1805, the Committee recommended that the extension be granted, and further recommended that Congress amend the 1790 Act to allow for term extensions.<sup>241</sup> Both recommendations were rejected.<sup>242</sup>

On December 31, 1805, Evans again petitioned Congress, this time seeking an extension "for such term as you, in your wisdom, may deem best."<sup>243</sup> He reiterated the arguments he had made in his previous peti-

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Hettick, 20 U.S. (7 Wheat.) 453 (1822); *Evans v. Chambers*, 8 F. Cas. 837 (C.C.D. Pa. 1807) (No. 4,555); *Evans v. Weiss*, 8 F. Cas. 888 (C.C.D. Pa. 1809) (No. 4,572); *Evans v. Robinson*, 8 F. Cas. 886 (C.C.D. Md. 1812) (No. 4,571); *Evans v. Jordan*, 8 F. Cas. 872 (C.C.D. Va. 1813) (No. 4,564); *Evans v. Eaton*, 8 F. Cas. 846 (C.C.D. Pa. 1816) (No. 4,559); *Evans v. Kremer*, 8 F. Cas. 874 (C.C.D. Pa. 1816) (No. 4,565); *Evans v. Eaton*, 8 F. Cas. 856 (C.C.D. Pa. 1818) (No. 4,560); *Evans v. Hettick*, 8 F. Cas. 861 (C.C.D.C. 1818) (No. 4,561).

<sup>238</sup> Federico, *supra* note 236, at 589-90; WALTERSCHEID, *supra* note 190, at 158.

<sup>239</sup> Federico, *supra* note 236, at 598; WALTERSCHEID, *supra* note 190, at 347.

<sup>240</sup> American State Papers, No. 186, 1 Misc. 416 (1805).

<sup>241</sup> *Id.*

<sup>242</sup> Federico, *supra* note 236, at 599 & n.39; WALTERSCHEID, *supra* note 190, at 347 & n.60.

<sup>243</sup> American State Papers, No. 196, 1 Misc. 434, 435 (1805). Walterscheid erroneously states that Evans sought an extension for a full fourteen-year term. WALTERSCHEID, *supra* note 190, at 348. He apparently based his belief on language used earlier in the petition, in which Evans asked for "the exclusive right of his own inventions for another term." American State Papers, No. 196, 1 Misc. at 434. As the language quoted in the text indicates, how-

tion, that he had not been “well-rewarded” for his invention, and that he had “already expended more than the net profits arising from his invention” in working on improvements to steam engines; and he stated his intention to spend \$9,000 in refining and introducing his steam engines.<sup>244</sup> Congress did not act on this petition.<sup>245</sup>

The following year, Evans tried a different tactic. On December 19, 1806, he presented an anonymous petition to Congress, arguing that patent rights ought to be granted to inventors and their heirs and assigns forever; or at least for the greater of the life of the inventor or fifty years from the date of the grant.<sup>246</sup> A bill was prepared authorizing three renewal terms of seven years each for existing patents, and two renewal terms for expired patents.<sup>247</sup> The House took no action on the bill, and it died at the end of the session.<sup>248</sup>

In April 1807, an infringement action that Evans had filed three years earlier came up for trial.<sup>249</sup> The defendant, Benjamin Chambers, did not deny infringement, but argued that the patent was invalid because the face of the patent document did not recite the allegations of the petition that Evans had presented when applying for his patent.<sup>250</sup> Evans’ attorney was surprised by the argument, and asked that the case be held over to the October term.<sup>251</sup> Evans immediately wrote to Thomas Jefferson seeking his advice,<sup>252</sup> and Jefferson replied, stating his opinion that a ministerial error was not sufficient to invalidate the patent.<sup>253</sup> Nonetheless, when the

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ever, Evans left the duration of the renewal term he sought to the discretion of Congress.

<sup>244</sup> American State Papers, No. 196, 1 Misc. at 434-35.

<sup>245</sup> Federico, *supra* note 236, at 599.

<sup>246</sup> WALTERSCHEID, *supra* note 190, at 310-11 & nn.19-20.

<sup>247</sup> *Id.* at 338. The extent to which Evans’ petition influenced the content of the bill is unclear, as the Committee that reported it was appointed eight days before Evans’ petition was presented. *Id.*

<sup>248</sup> *Id.*

<sup>249</sup> Federico, *supra* note 236, at 601; WALTERSCHEID, *supra* note 190, at 159.

<sup>250</sup> Federico, *supra* note 236, at 601; WALTERSCHEID, *supra* note 190, at 159.

<sup>251</sup> Federico, *supra* note 236, at 602; WALTERSCHEID, *supra* note 190, at 160.

<sup>252</sup> The letter is quoted in Federico, *supra* note 236, at 601 n.44; and in WALTERSCHEID, *supra* note 190, at 159-60. Walterscheid adds: “The idea of writing to the President of the United States concerning what had transpired in a federal court and fully expecting a reply at the hand of the President would seem highly audacious today, but in the circumstances it was not unreasonable, particularly when it is recalled that Jefferson was the Secretary of State who had issued the patent in question and he was quite familiar with the requirements of the Patent Act of 1790.” *Id.* at 159 n.47.

<sup>253</sup> Jefferson’s reply is quoted Federico, *supra* note 236, at 601; and in WALTERSCHEID, *supra* note 190, at 160-61.

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case came up for decision in October, the court held that the patent was invalid.<sup>254</sup>

According to one scholar, “[i]t was immediately recognized that, if accepted as binding on the federal government, the views expressed by the Circuit Court would render invalid all fifty-seven patents issued under the Patent Act of 1790.”<sup>255</sup> Evans could not appeal to the U.S. Supreme Court, however, because the amount in controversy did not meet the \$2000 amount that was then required.<sup>256</sup> Instead, Evans presented another petition to Congress, seeking a reissue of his patent on the grounds that the decision had prevented him from receiving the economic reward to which he was entitled.<sup>257</sup> The Committee to whom the petition was referred recommended that it be granted, because “the defect in his patent was caused by those appointed to issue it, from a misapprehension of the provisions of the law merely.”<sup>258</sup> Congress approved a private bill granting Evans a new patent of fourteen years, and President Jefferson (who, as Secretary of State, had been responsible for issuing the patent in the first place) signed it into law on January 21, 1808.<sup>259</sup>

Evans’ reissued patent was problematic for at least two reasons. First, as one scholar has noted:

In thus authorizing a new patent for a full term Congress went beyond the necessities of the occasion. The most that Evans lost by the decision of the court was the right to collect from those who had infringed prior to the expiration of the first patent, over three years before the act was passed. While the total of these sums may have been substantial, this total would be far greatly exceeded by the value of fourteen years in the future, with the steadily growing use of the inventions. . . . [T]he decision of the court was a fortunate accident enabling Evans to secure the extension for which he had petitioned two successive Congresses without result.<sup>260</sup>

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<sup>254</sup> *Evans v. Chambers*, 8 F. Cas. 837 (C.C.D. Pa. 1807) (No. 4,555).

<sup>255</sup> WALTERSCHEID, *supra* note 190, at 163. This statement is based on the subsequent report of a congressional committee, which quotes a letter from James Madison, then Secretary of State, which states “a compliance with [the decision] would admit the invalidity of all the patents issued in the same form since the commencement of the Government.” *American State Papers*, No. 231, 1 Misc. 646 (1807).

<sup>256</sup> Federico, *supra* note 236, at 604.

<sup>257</sup> *Id.* at 604-05 & n.49; WALTERSCHEID, *supra* note 190, at 348.

<sup>258</sup> *American State Papers*, No. 231, 1 Misc. 646 (1807).

<sup>259</sup> An Act for the relief of Oliver Evans, 6 Stat. 70 (1808).

<sup>260</sup> Federico, *supra* note 236, at 605.

Second, Congress had not merely extended Evans' patent; it had revived a patent that had already expired three years earlier. To protect the rights of those who had relied on the expiration of the original patent, Congress included a proviso, stating "[t]hat no person who shall have used the said improvements, or erected the same for use, before the issuing of the said patent, shall be liable for damages therefor."<sup>261</sup> The construction of this clause became a major issue in litigation that would eventually reach the U.S. Supreme Court. Parties who had begun practicing the improvements during the intervening three years argued that the clause immunized them from suit during the entire term of the reissued patent; whereas Evans argued that it only immunized them for the use of the improvements during those three years.

The first reported decision involving Evans' revived patent was *Evans v. Weiss*.<sup>262</sup> Weiss had been licensed to use the improvements during the original term of the patent and had expanded his use after the patent expired.<sup>263</sup> Construing the proviso for the first time, Justice Bushrod Washington held that Evans was entitled to recover royalties from Weiss for continued use during the second term.<sup>264</sup> In so doing, he rejected the argument that "such a construction would render this an ex post facto law, and consequently repugnant to the constitution."<sup>265</sup>

In *Evans v. Robinson*,<sup>266</sup> the defendants challenged the constitutionality of the private law on similar grounds. The court responded to these arguments as follows:

[T]hat in the opinion of the court the act referred to is not an ex post facto law, for that relates to criminal cases only; that it does not impair the obligation of contracts, or interfere with any rights previously acquired by the community; . . . that congress have the exclusive right by the constitution to limit the times for which a patent right shall be granted, and are not restrained from renewing a patent or prolonging the time of its continuance; more especially in the present case, where the patent granted in the first instance had been decided by judicial authority to be null and void on account of some defect in the patent.<sup>267</sup>

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<sup>261</sup> 6 Stat. at 71.

<sup>262</sup> 8 F. Cas. 888 (C.C.D. Pa. 1809) (No. 4,572).

<sup>263</sup> *Id.* at 888.

<sup>264</sup> *Id.* at 889.

<sup>265</sup> *Id.*

<sup>266</sup> 8 F. Cas. 886 (C.C.D. Md. 1813) (No. 4,571).

<sup>267</sup> *Id.* at 888.

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The court also concurred with Justice Washington's construction of the proviso.<sup>268</sup>

In *Evans v. Jordan*,<sup>269</sup> the defendants argued that they had constructed their flour mills after the expiration of the first patent and before the date of the second; that it would be unjust to subject them to royalties for using improvements which they had commenced using when they had a right to do so; and that the proviso ought not to be construed to reach an unjust result.<sup>270</sup> In the course of its opinion, the court, in dicta, remarked on Congress' power under the Patent and Copyright Clause:

To that department is confided, without revision, the power of deciding on the justice as well as the wisdom of measures relative to subjects on which they have the constitutional power to act.<sup>271</sup>

That this statement was merely dicta, however, is clear from the court's subsequent observation that "[the] construction of the constitution which admits the renewal of a patent is not controverted."<sup>272</sup> Being divided on the proper construction of the proviso, the court certified the question to the U.S. Supreme Court.<sup>273</sup>

The Supreme Court, in an opinion by Justice Washington, upheld his previous construction of the proviso.<sup>274</sup> It stated:

[T]his Court would transgress the limits of judicial power by an attempt to supply, by construction, this supposed omission of the legislature. The argument, founded upon the hardship of this and similar cases, would be entitled to great weight, if the words of this proviso were obscure and open to construction. But considerations of this nature can never sanction a construction at variance with the manifest meaning of the legislature, expressed in plain and unambiguous language.<sup>275</sup>

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<sup>268</sup> *Id.*

<sup>269</sup> 8 F. Cas. 872 (C.C.D. Va. 1813) (No. 4,564).

<sup>270</sup> *Id.* at 873.

<sup>271</sup> *Id.*

<sup>272</sup> *Id.* at 874.

<sup>273</sup> *Id.*

<sup>274</sup> *Evans v. Jordan*, 13 U.S. (9 Cranch) 199 (1815).

<sup>275</sup> *Id.* at 203.

Although the defendants made allusions to the Constitution in their argument,<sup>276</sup> they did not argue that the extension was beyond Congress' power under the Patent and Copyright Clause.<sup>277</sup>

The constitutionality of the revived patent was expressly raised in a later case, *Evans v. Eaton*.<sup>278</sup> The reporter states:

The plaintiff having closed his evidence, a motion was made to nonsuit the plaintiff. It was contended, that after the expiration of the plaintiff's privilege granted to him by this state, the right to his invention became vested in the people of the state, by an implied contract with the government; and that therefore congress could not, consistently with the constitution of the United States, grant to the plaintiff an exclusive right to the invention.<sup>279</sup>

The Circuit Court, in an opinion by Justice Washington, rejected this argument, saying:

Neither the premises upon which this motion is founded, nor the conclusion can be admitted. It is not true that the grant of an exclusive privilege to an invention for a limited time, implies a binding and irrevocable contract with the people, that at the expiration of the period the invention shall become their property. The state has a perfect right to renew the grant at the end of the period or refuse to do so; and in the latter case, it is a matter of course that the invention may be used by any person who

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<sup>276</sup> The defendants argued: "A law to oblige them now to abandon their property or to pay what Mr. Evans may choose to exact, is in the nature of an ex post facto law; and although it may not be absolutely unconstitutional, yet [it] is so far within the spirit of the constitution, that this Court will not give such a construction to the proviso if it can possibly be avoided. . . . To deprive a person of the use of his property is equivalent to depriving him of the property itself." *Id.* at 200.

<sup>277</sup> Contemporary writers, however, suggested that the decision might violate the Due Process clause. Federico states: "While it can readily be said today, considering over one hundred years of legal development, that the *Evans v. Jordan and Morehead* decision is questionable, even contemporary writers felt constrained to criticize the decision. Phillips in his *Law of Patents for Inventions* . . . suggests that the special act, as interpreted by the courts, was of doubtful constitutionality." Federico, *supra* note 236, at 611-12 (citing WILLARD PHILLIPS, *LAW OF PATENTS FOR INVENTIONS* (1837)). Federico also notes that in an 1813 letter, Thomas Jefferson expressed his view that the proviso had been misinterpreted. *Id.* at 612 & n.73 (quoting the letter).

<sup>278</sup> 8 F. Cas. 846 (C.C.D. Pa. 1816) (No. 4,559), *rev'd on other grounds*, 16 U.S. (3 Wheat.) 454 (1818), *on remand*, 8 F. Cas. 856 (C.C.D. Pa. 1818) (No. 4,560), *aff'd*, 20 U.S. (7 Wheat.) 356 (1822).

<sup>279</sup> 8 F. Cas. at 846.

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chooses to do so. In like manner may congress renew a patent right or decline to do so. But even if the premises were true, still there is nothing in the constitution of the United States which forbids congress to pass laws violating the obligation of contracts, although such a power is denied to the states individually.<sup>280</sup>

Although it appears that the defendants' argument was premised on the Contracts Clause of the Constitution,<sup>281</sup> rather than on the "limited Times" language of the Patent and Copyright Clause, this language strongly indicates that the court would have found such an argument to be without merit. The case was later appealed to the Supreme Court,<sup>282</sup> remanded for retrial,<sup>283</sup> and appealed again,<sup>284</sup> but the contention that the revived patent was unconstitutional was not raised in any of the subsequent proceedings.

Although the renewal of Evans' patent had been contentious and problematic,<sup>285</sup> Congress continued to grant patent extensions through private acts. Prior to July 4, 1836, when the Patent Office was given the authority to grant a seven-year extension, Congress extended the terms of ten more patents.<sup>286</sup> Six of these extensions were enacted after the origi-

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<sup>280</sup> *Id.* at 848-49.

<sup>281</sup> U.S. CONST. art. I, § 10, cl. 1 ("No state shall . . . pass any Bill of Attainder, ex post facto law, or Law impairing the Obligation of Contracts . . .").

<sup>282</sup> *Evans v. Eaton*, 16 U.S. (3 Wheat.) 454 (1818). Reversing a directed verdict by Justice Washington, the Court held that Evans' patent covered all five improvements individually, as well as the combination of the five improvements. *Id.* at 506-12.

<sup>283</sup> *Evans v. Eaton*, 8 F. Cas. 856 (C.C.D. Pa. 1818) (No. 4,560). Justice Washington again directed a verdict in favor of the defendant, this time on the ground that the patent did not sufficiently explain how Evans' hopperboy was an improvement over prior similar machines. *Id.* at 859-60.

<sup>284</sup> *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356 (1822). This time the court affirmed, ruling "that if it be a patent for an improvement, it is void, because the nature and extent of the improvement is not stated in the specification." *Id.* at 432. By this time, the revived patent had expired, and Oliver Evans had been dead for three years. Federico, *supra* note 236, at 681; WALTERSCHEID, *supra* note 190, at 354.

In a companion case, the Supreme Court affirmed a jury verdict for the defendant, who was found to have used a prior similar machine, rather than Evans' improvement. *Evans v. Hettick*, 20 U.S. (7 Wheat.) 453 (1822), *aff'g* 8 F. Cas. 861 (C.C.E.D. Pa. 1818) (No. 4,562).

<sup>285</sup> In addition to the litigation noted above, over a dozen petitions were filed in Congress between 1810 and 1813 seeking to limit the application of Evans' revived patent. See Federico, *supra* note 236, at 609-10, 661-62, 666-73; WALTERSCHEID, *supra* note 190, at 351-54.

<sup>286</sup> Interestingly, one of the extensions was An Act to extend the time of Oliver Evans' patent for his improvement on steam engines, 6 Stat. 147 (1815).

nal patent had expired. Even after 1836, patentees whose applications for extension were rejected by the Patent Office continued to turn to Congress for relief.<sup>287</sup> Some of these extended patents were challenged in court, and the resulting decisions indicate that Congress has plenary authority to extend patent terms under the Constitution. The majority of these reported decisions involved four patents.

Thomas Blanchard's patent was originally issued on September 6, 1819, and was reissued on January 20, 1820.<sup>288</sup> On June 30, 1834, after the original patent had expired,<sup>289</sup> Congress passed a special act extending the patent for fourteen years.<sup>290</sup> That act, however, inadvertently gave the date of the patent as January 12, 1820, rather than January 20.<sup>291</sup> In *Blanchard v. Sprague* (1838), this variance was held to be fatal.<sup>292</sup> Congress immediately corrected its error, passing an amended act on February 6, 1839.<sup>293</sup> Blanchard refiled his infringement action, and Sprague raised

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The others are listed in the argument of the plaintiff's counsel in *Bloomer v. McQuewan*, 55 U.S. (14 How.) 539, 543 (1852). Walterscheid states that only six additional extensions were granted during this period, *supra* note 190, at 354. He appears to have relied upon a congressional study published in 1979 in which this figure was given. See CHRISTINE P. BENAGH, *THE HISTORY OF PRIVATE PATENT LEGISLATION IN THE HOUSE OF REPRESENTATIVES*, 96th Cong. (1979), at 7 & n.69.

<sup>287</sup> At least five additional special extensions were passed by Congress between 1836 and 1847. See *Bloomer v. McQuewan*, 55 U.S. (14 How.) at 543-44 (cases listed in argument of counsel). One of these was an amendment correcting a clerical error in a previous extension. See An Act to amend, and carry into effect, the intention of an act entitled "An Act to renew the patent of Thomas Blanchard," 6 Stat. 748 (1839). Of the remaining four, two were extended after the expiration of the original patent. See An Act for the relief of William Gale, 6 Stat. 895 (1843); An Act for the relief of Samuel K. Jennings, 6 Stat. 899 (1843).

<sup>288</sup> See *Blanchard v. Sprague*, 3 F. Cas. 645, 646 (C.C.D. Mass. 1838) (No. 1,517) (Story, J.).

<sup>289</sup> The exact expiration date of the original patent is open to question. Ordinarily, a reissued patent would expire fourteen years from the date of the original patent, or Sept. 6, 1833. The reissued patent, however, granted rights "for the term of fourteen years from the sixth day of January, A.D. 1819," which would place the expiration date on Jan. 6, 1833. *Id.* In extending the patent, however, Congress appeared to assume that the original patent did not expire until fourteen years from the date of the reissued patent, or Jan. 20, 1834. See note 293, *infra*. In any case, it is clear that Congress did not pass the extension until after the original patent had expired.

<sup>290</sup> See An Act to renew the patent of Thomas Blanchard, 6 Stat. 589 (1834).

<sup>291</sup> *Id.*

<sup>292</sup> 3 F. Cas. 645, 646-48 (C.C.D. Mass. 1838) (No. 1,517).

<sup>293</sup> See An Act to amend, and carry into effect, the intention of an act entitled An Act to renew the patent of Thomas Blanchard," 6 Stat. 748 (1839). This act extended the patent for fourteen years from Jan. 20, 1834, *id.*, indicating



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the issue of the constitutionality of the extension.<sup>294</sup> Writing for the Circuit Court, Justice Story stated:

[I]t is suggested that the grant of the patent by the act of congress of 1839, is not constitutional; for it operates retrospectively to give a patent for an invention, which, though made by the patentee, was in public use and enjoyed by the community at the time of the passage of the act. But this objection is fairly put at rest by the decision of the supreme court in the case of the patent of Oliver Evans. For myself, I have never entertained any doubt of the constitutional authority of congress to make such a grant. The power is general, to grant to inventors; and it rests in the sound discretion of congress to say, when and for what length of time and under what circumstances the patent for an invention shall be granted. There is no restriction, which limits the power of congress to enact, where the invention has not been known or used by the public. All that is required is, that the patentee should be the inventor.<sup>295</sup>

In two subsequent cases involving the same patent, counsel for the defendants conceded that Congress had the constitutional power to extend patents.<sup>296</sup>

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that Congress assumed the original patent expired fourteen years from the date of the reissued patent.

<sup>294</sup> *Blanchard v. Sprague*, 3 F. Cas. 648, 650 (C.C.D. Mass. 1839) (No. 1,518).

<sup>295</sup> *Id.* at 650. The Court also held that damages could only be recovered from the date of the amended act (Feb. 6, 1839), even though the language of the amended act granted the extended patent from Jan. 20, 1834, and contained a proviso exempting only those persons who had constructed the invention between the expiration of the original patent and the date of the first special act (June 30, 1834). *See* 6 Stat. at 748. Justice Story wrote: “The act of congress . . . ought to be construed not to operate retrospectively, or ex post facto, unless that construction is unavoidable; for even if a retrospective act is, or may be constitutional, . . . that interpretation is never adopted without absolute necessity.” 3 F. Cas. at 650.

<sup>296</sup> *See* *Blanchard’s Gun-Stock Turning Factory v. Warner*, 3 F. Cas. 653, 656 (C.C.D. Conn. 1846) (No. 1,521) (“In the exercise of the power conferred by the constitution, congress may, without doubt, extend, or make provision by law for the extension of the exclusive privilege to inventors, beyond the term originally limited, if that is deemed too short to afford them an adequate reward or encouragement.”) (argument of Roger S. Baldwin, for defendant); *Blanchard v. Haynes*, 3 F. Cas. 628, 628 (C.C.D. N.H. 1848) (No. 1,512) (“It was admitted that congress had the constitutional right to confer a new and further term on the patentee. Such cases have frequently occurred.”). In the latter case, however, two of the three cases cited for the proposition involved reissued patents (which expire at the same time as the original patent), rather than extensions. *See* *Stimpson v. West Chester Rail-*

William Woodworth obtained a patent on December 27, 1828.<sup>297</sup> Woodworth died six weeks later; but in 1842, on the application of his administrator, the patent was extended under the 1836 Act for seven years,<sup>298</sup> or until December 27, 1849. On February 26, 1845, Congress passed a special act extending the patent for an additional seven years.<sup>299</sup> In *Bloomer v. Stolley*,<sup>300</sup> the second extension was challenged in court, on the ground that Congress could only extend patents by general legislation, rather than by special legislation.<sup>301</sup> The court rejected this argument, saying:

There would seem to be no doubt that the constitutional power in question might have been fully exercised by congress in making special grants. . . . Congress adopted a system for the sale and granting of public lands, but no one doubts that it may make special grants of land by law. This has been done; and the same principle applies to the granting of an exclusive right to an inventor. The machinery through which this right is ordinarily applied for, and obtained, may be dispensed with, and the title may be conferred by legislative grant; and this may be done in regard to the extension of an exclusive right by congress, the same as originally granting it. No constitutional restriction appears against the exercise of this power by congress. . . . There is no prohibition in the law against a second extension, while provision is made for a first extension, should the inventor bring himself within it.<sup>302</sup>

The court also rejected an argument that the extension could not be applied retroactively to licensees under the first patent, who arguably had relied on the expiration date of the patent in investing in the invention. The court said:

The true answer to the case put is, the expenditure made by the licensee, or any other person, was made with a presumed knowledge of the law the congress had the power to extend the patent; and, with this knowledge, the risk of a renewal of the patent was incurred.<sup>303</sup>

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road Co., 45 U.S. (4 How.) 380, 381 (1846); *Grant v. Raymond*, 31 U.S. (6 Pet.) 240 (1832).

<sup>297</sup> *Bloomer v. Stolley*, 3 F. Cas. 729, 730 (C.C.D. Ohio 1850) (No. 1,559).

<sup>298</sup> *Id.*

<sup>299</sup> An Act to extend a patent heretofore granted to William Woodworth, 6 Stat. 936 (1845).

<sup>300</sup> 3 F. Cas. 729, 730 (C.C.D. Ohio 1850) (No. 1,559).

<sup>301</sup> *Id.* at 730.

<sup>302</sup> *Id.* at 730-31.

<sup>303</sup> *Id.* at 731.

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It should also be noted that Woodworth's extended patent came before the U.S. Supreme Court on three occasions, with nary a suggestion by the Court that the extension might violate the "limited Times" provision of the Constitution.<sup>304</sup>

A truly extraordinary situation was presented in the case of *Jordan v. Dobson*.<sup>305</sup> John Goulding obtained a patent on December 15, 1826, and it expired fourteen years later, on December 15, 1840.<sup>306</sup> As the Supreme Court later explained:

Omission of the original patentee seasonably to apply for an extension of his patent was occasioned through erroneous information given to him by the commissioner, and not from any negligence or fault of his own. Acting upon information from that source, the inventor did not file the application until it was too late to give the notice required by law, and the time for presenting such an application having expired. The commissioner had no power to grant his request. Deprived of any legal remedy under the general laws for the protection of inventors, he applied to Congress.<sup>307</sup>

On May 30, 1862, more than twenty-one years after the original patent had expired, Congress passed a special act authorizing the Commissioner of Patents to entertain Goulding's application for a seven-year extension, with a proviso that the extension would not restrain those who had begun

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<sup>304</sup> See *Wilson v. Rousseau*, 45 U.S. (4 How.) 646 (1846); *Bloomer v. McQuewan*, 55 U.S. (14 How.) 539 (1852); *Bloomer v. Millinger*, 68 U.S. (1 Wall.) 340 (1863).

In *McQuewan*, plaintiff's counsel considered the power of Congress to extend patents to be so well established that he stated: "It is not deemed necessary by the appellants to present any authorities to meet the point argued by the appellees, that an act of Congress, extending a patent for seven years, is unconstitutional and void." 55 U.S. (14 How.) at 544. It appears, however, that the constitutional argument was not based on the "limited Times" provision, but on the Due Process Clause of the Fifth Amendment. In dicta, the court stated:

[I]t can hardly be maintained that Congress could lawfully deprive a citizen of the use of his property after he had purchased the absolute and unlimited right from the inventor. . . . And a special act of Congress, passed afterwards, depriving the appellees of the right to use them, certainly could not be regarded as due process of law.

*Id.* at 553. The court avoided the question, however, by construing the extension not to apply to those who had purchased the invention during the original term. *Id.* at 554.

<sup>305</sup> 13 F. Cas. 1092 (C.C.E.D. Pa. 1870) (No. 7,519).

<sup>306</sup> *Id.* at 1093.

<sup>307</sup> *Agawam Co. v. Jordan*, 74 U.S. (7 Wall.) 583, 608 (1868).

using the invention in the interim.<sup>308</sup> The revived patent issued on August 30, 1862.<sup>309</sup> When Goulding's assignees sued Dobson for infringement, Dobson argued that the extension was unconstitutional. The Circuit Court rejected this argument, saying:

It has been further contended . . . that the act of congress of May 30, 1862, under which the patent was extended, was unauthorized and went beyond the power of congress, because the patent had expired in 1840, and the invention had become the property of the public, and because, therefore, the act was in effect taking property which belonged to the public and giving it to an individual. It assumes that every person had a right of property in Goulding's invention immediately after the expiration of his first patent, even before any attempt to appropriate it. It puts a right to appropriate that which is common, and in which there can be no private property until there has been an actual appropriation, on the footing of property acquired. And it overlooks the express grant of power to congress by the constitution. . . . This is a large power. It is not said when those limited times shall commence, how long they shall continue, or when they shall end. All that is left to the discretion of congress. I see no reason why, under this commission, congress may not secure to an inventor an exclusive right to his invention for a limited period, beginning at any time after the invention is made, and after it became publicly known. Congress may be trusted, and they are trusted, to take care that in protecting the inventor, the public shall not be injured. . . . I am not aware that it has ever been seriously thought that congress has not power, after a patent has expired, to provide for its extension.<sup>310</sup>

Again, a subsequent case involving the same patent came before the U.S. Supreme Court,<sup>311</sup> and no argument or suggestion was made that the revived and extended patent was unconstitutional.

A similar situation was presented in *The Fire Extinguisher Case*.<sup>312</sup> William A. Graham's original patent application was filed in the patent office on November 23, 1837.<sup>313</sup> The Commissioner refused to grant the

<sup>308</sup> An Act for the Relief of John Goulding, 12 Stat. 904 (1862).

<sup>309</sup> *Jordan v. Dobson*, 13 F. Cas. at 1093.

<sup>310</sup> *Id.* at 1095 (citing *Blanchard v. Sprague*) (*supra* notes 288-295 and accompanying text); *Evans v. Eaton* (*supra* notes 278-284 and accompanying text); *Blanchard's Gun-Stock Turning Factory v. Warner* (*supra* note 296); and *Blanchard v. Haynes* (*id.*).

<sup>311</sup> *Agawam Co. v. Jordan*, 74 U.S. (7 Wall.) 583 (1868).

<sup>312</sup> *Graham v. Johnston*, 21 F. 40 (C.C.D. Md. 1884).

<sup>313</sup> *Id.* at 40.

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patent on the grounds that the specifications did not disclose a practicable device.<sup>314</sup> Graham was unable to travel to Washington to demonstrate his device, and he died in 1857 without obtaining a patent.<sup>315</sup> In 1874, a similar patent was invalidated on the ground that Graham was the first inventor.<sup>316</sup> Graham's administrator filed another application in the patent office, "but was refused upon the ground that in consequence of the long delay the invention had gone into public use."<sup>317</sup> On June 11, 1878, Congress passed an act permitting Graham's heirs to revive the application.<sup>318</sup> In a subsequent infringement suit, the defendant argued that the revival of Graham's application violated the Due Process Clause of the Fifth Amendment.<sup>319</sup> The court rejected this argument, saying:

[T]he constitutional power of congress for securing to [inventors] the exclusive right to their inventions has only one restriction, viz., that is shall be for limited times. With regard to the terms upon which the exclusive right shall be granted, the time when the application for the original grant or for any renewal or extension of it shall be made, it has been frequently held that the regulations in these matters are merely self-imposed restrictions on the constitutional power of congress, which it can at its pleasure disregard in any particular case. . . .<sup>320</sup>

The right which the public has acquired to use the thing invented, by reason of the applicant for a patent failing to do something prescribed by congress, and the necessity for which congress might, by previous legislation, have dispensed with, have never been held to be a vested right. The cases of *Evans v. Eaton*; *Evans v. Jordan*; *Bloomer v. Stolley*; [and] *Jordan v. Dobson* hardly leave this question debatable.<sup>321</sup>

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<sup>314</sup> *Id.* at 41.

<sup>315</sup> *Id.*

<sup>316</sup> *Id.* See *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 18 F. Cas. 394, 397-400 (C.C.E.D. Pa. 1874) (No. 10,337).

<sup>317</sup> *Graham*, 21 F. at 41.

<sup>318</sup> An Act for the relief of the heirs of William A. Graham, 20 Stat. 542 (1878).

<sup>319</sup> *Id.* at 42 ("It is contended by the respondents that this patent is void because congress had no constitutional power to act; that is, by the general acts of congress on the subject of patents . . ., the applications of Graham and his administrator were declared abandoned, and all right to prosecute them was denied, it resulted that the public had acquired the right to use the inventions, and that right could not be taken away without the law being repugnant to the declaration of the constitution that no person shall be deprived of his property without due process of law.").

<sup>320</sup> *Id.*

<sup>321</sup> *Id.* at 43 (citations omitted).

Although this decision involved a revived patent application, rather than an extension, the ruling demonstrates that the court did not consider that the general public had any kind of vested right to practice inventions that were in the public domain.

Throughout the second half of the nineteenth century, Congress continued to pass private patent extensions.<sup>322</sup> Some of these extensions were passed to make amends for the negligence of a public official;<sup>323</sup> but others were based simply on congressional disagreement with the determination of the Commissioner;<sup>324</sup> while others were based on the failure of the inventor to receive adequate compensation for his invention during the patent term.<sup>325</sup> In 1879, however, “the House Committee on Patents began to cut off the flow of petitions based upon inadequate compensation.”<sup>326</sup> It did so by requiring an inventor to demonstrate “reasons not only beyond his control but beyond the control of a man of reasonable prudence and foresight.”<sup>327</sup> As a result, “the heyday of private patent petitions ended with the century.”<sup>328</sup>

Only one private patent extension was passed in the first half of the twentieth century. In 1928, Louis V. Aronson, President of Art Metal Works, Inc., received a patent for a pocket cigar lighter.<sup>329</sup> In 1932, the patent was held valid and infringed by two competing lighters manufactured by the Evans Case Company.<sup>330</sup> On remand, however, the defendant was permitted to amend its answer to allege inequitable conduct by

<sup>322</sup> See Benagh, *supra* note 286, at 9-10.

<sup>323</sup> See, e.g., An Act for the relief of David Bruce, 11 Stat. 546 (1858). Benagh explains that “the Patent Office had lost the application.” Benagh, *supra* note 286, at 9.

<sup>324</sup> See, e.g., An Act for the relief of Oliver C. Harris, 9 Stat. 734 (1848). According to Benagh, “[t]he Commissioner’s refusal was based upon a finding that the invention in question was of insufficient novelty and importance. The committee disagreed, pointing out that when, as part of the fire restoration of the Patent Office, descriptive models were chosen to be re-built on the basis of value, interest, and importance to the public, the petitioner’s invention was among those re-built.” Benagh, *supra* note 286, at 9.

<sup>325</sup> See, e.g., An Act for the relief of George G. Bishop, and the Legal Representative of John Arnold, deceased, 10 Stat. 776 (1854). Benagh states that “although few . . . ever became law,” petitions for private extensions based on inadequate compensation “easily out numbered any other patent petitions” between 1848 and 1880. Benagh, *supra* note 286, at 9.

<sup>326</sup> Benagh, *supra* note 286, at 9.

<sup>327</sup> H.R. REP. NO. 45-177 (1879), *quoted in* Benagh, *supra* note 286, at 9.

<sup>328</sup> Benagh, *supra* note 286, at 10.

<sup>329</sup> U.S. Patent No. 1,673,727 (June 12, 1928). The patent was reissued in 1933. U.S. Patent No. RE 19,023 (Dec. 12, 1933).

<sup>330</sup> See *Art Metal Works, Inc. v. Abraham & Straus, Inc.*, 61 F.2d 122 (2d Cir. 1932). Although the suit was brought against a retailer, “[t]he suit was defended by the Evans Case Manufacturing Company, as manufacturer of the

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Art Metal Works.<sup>331</sup> The district court rejected the defense;<sup>332</sup> but on appeal the Second Circuit, in an opinion by Judge Martin T. Manton, held that the plaintiff had affirmatively misrepresented the scope of the prior decision, and denied all relief on that basis.<sup>333</sup> At the same time, a third lighter manufactured by Evans was held to be non-infringing.<sup>334</sup> Five years later, in 1939, Judge Manton resigned his office and was convicted of conspiracy to obstruct justice and to defraud the United States, based in part upon his having solicited money from Evans in return for favorable decisions on the two 1934 appeals.<sup>335</sup> On motion of Art Metal Works, the two decisions were vacated<sup>336</sup> and reargued, with Art Metal Works prevailing in both cases.<sup>337</sup> Despite ultimately having prevailed, Art Metal Works successfully argued to Congress that the seven-year delay between the original finding of infringement in 1932 and the decisions on re-argument of the Second Circuit in 1939 warranted a patent term extension of seven years.<sup>338</sup> According to one commentator, “[t]his was a classic exam-

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alleged infringing devices.” *Art Metal Works, Inc. v. Abraham & Straus, Inc.*, 52 F.2d 951, 953 (E.D.N.Y. 1931).

<sup>331</sup> *Art Metal Works, Inc. v. Abraham & Straus, Inc.*, 61 F.2d 79, 79 (2d Cir. 1932) (granting motion for permission to apply to District Court for leave to amend); *see also* *Art Metal Works, Inc. v. Abraham & Straus, Inc.*, 2 F. Supp. 292 (E.D.N.Y. 1933) (granting motion for leave to amend).

<sup>332</sup> *See* *Art Metal Works, Inc. v. Abraham & Straus, Inc.*, 4 F. Supp. 298 (E.D.N.Y. 1933).

<sup>333</sup> *See* *Art Metal Works, Inc. v. Abraham & Straus, Inc.*, 70 F.2d 641 (2d Cir. 1934). Judge Manton’s opinion was joined by Judge Harrie Brigham Chase; Judge Learned Hand dissented.

<sup>334</sup> *See* *Art Metal Works, Inc. v. Abraham & Straus, Inc.*, 2 F. Supp. 677 (E.D.N.Y. 1933) (denying motion for preliminary injunction); *Art Metal Works, Inc. v. Abraham & Straus, Inc.*, 4 F. Supp. 303 (E.D.N.Y. 1933) (dismissing action), *aff’d*, 70 F.2d 639 (2d Cir. 1934) (opinion by Manton, J., joined by Chase and L. Hand, JJ.).

<sup>335</sup> *See* *United States v. Manton*, 107 F.2d 834, 837, 840-41 (2d Cir. 1939).

<sup>336</sup> *See* *Art Metal Works, Inc. v. Abraham & Straus, Inc.*, 42 U.S.P.Q. 639 (2d Cir. 1939) (per curiam).

<sup>337</sup> *See* *Art Metal Works, Inc. v. Abraham & Straus, Inc.*, 107 F.2d 940 (2d Cir. 1939) (reversing finding of non-infringement of third lighter), *rev’g* 4 F. Supp. 303 (E.D.N.Y. 1933); *Art Metal Works, Inc. v. Abraham & Straus, Inc.*, 107 F.2d 944 (2d Cir. 1939) (adopting opinion at 70 F.2d 645 (2d Cir. 1934) (L. Hand, dissenting)), *aff’g* 4 F. Supp. 298 (E.D.N.Y. 1933).

<sup>338</sup> *See* An Act to extend Reissued Letters Patent Numbered 19,023, 58 Stat. 1095 (Dec. 23, 1944); Extension of Reissued Patent No. 19,023, *Hearings Before the Committee on Patents on H.R. 2994*, 78th Cong. (Oct. 13, 1943). The Act extended the patent seven years from its original expiration date of June 12, 1945. The seven-year extension was held to be valid despite a typographical error by Congress in identifying the date of the reissued patent. *See* *Ronson Patents Corp. v. Sparklets Devices, Inc.*, 102 F. Supp. 123, 124-25 (E.D. Mo. 1951).

ple of the traditional purpose of private legislation, to relieve a private party in circumstances in which the government had incurred a moral or ethical obligation toward the party.”<sup>339</sup>

The development of radar resulted in a similar piece of private legislation. In 1931, Major William R. Blair of the U.S. Army Signal Corps was placed in charge of a project to detect enemy aircraft by noise, infrared waves and radio waves.<sup>340</sup> He conceived “a method and means for determining the position of distant objects by means of reflected radio waves,”<sup>341</sup> and on May 18, 1937, a prototype was demonstrated to military and government officials at Fort Monmouth, New Jersey.<sup>342</sup> With war looming in Europe, Blair “was specifically ordered by his commanding officer to keep the invention secret and not to file a patent application thereon.”<sup>343</sup> When Blair eventually applied for a patent many years later, his application was denied on the ground that the invention had been in public use or on sale for more than one year before the date of the application.<sup>344</sup> In 1950, Congress passed a private law to relieve Blair of the one-year limit,<sup>345</sup> and Blair was issued a basic patent on radar in 1957.<sup>346</sup>

In 1962, in an infringement suit brought by an assignee of Blair,<sup>347</sup> the private law was challenged on four grounds.<sup>348</sup> First, the defendant argued that since the Act preserved the rights of persons manufacturing or using the invention before the passage of the Act, it did not grant an “exclusive right” within the meaning of the Patent Clause of the Constitution.<sup>349</sup> A three-judge district court<sup>350</sup> rejected this argument, relying in

<sup>339</sup> Benagh, *supra* note 286, at 10. See *United States v. Realty Co.*, 163 U.S. 427, 440-41 (1896) (private legislation is “based upon consideration of a moral or merely honorary nature, such as are binding on the conscience or the honor of an individual, although the debt could obtain no recognition in a court of law.”).

<sup>340</sup> [http://www.infoage.org/SCR\\_270.html](http://www.infoage.org/SCR_270.html) (last visited Sept. 10, 2001).

<sup>341</sup> U.S. Patent No. 2,803,819 (Aug. 20, 1957).

<sup>342</sup> Letter from Kenneth C. Royall, Secretary of the Army, to Chan Gurney, Chairman, Senate Armed Services Committee (Apr. 7, 1948), *reprinted in* S. Rep. No. 81-1665, at 11 (1950).

<sup>343</sup> *Radio Position Finding Corp. v. Bendix Corp.*, 205 F. Supp. 850, 852 (D. Md. 1962), *aff’d mem.*, 371 U.S. 577 (1963) (per curiam).

<sup>344</sup> *Id.* at 851; see 35 U.S.C. § 102(b) (2000).

<sup>345</sup> An Act to Correct Possible Inequity in the Case of a Certain Application for Letters Patent of William R. Blair, Priv. L. No. 1008, 81st Cong., 64 Stat. A243 (1950).

<sup>346</sup> U.S. Patent No. 2,803,819 (Aug. 20, 1957).

<sup>347</sup> *Radio Position Finding Corp. v. Bendix Corp.*, 205 F. Supp. 850 (D. Md. 1962), *aff’d mem.* 371 U.S. 577 (1963) (per curiam).

<sup>348</sup> The court characterized the challenge as based on three grounds, *id.* at 852; but as discussed below, the defendant had two different arguments based on substantive due process. See notes 353-363 and accompanying text.

<sup>349</sup> *Radio Position Finding Corp.*, 205 F. Supp. at 852.



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part on the patent term extension cases described above.<sup>351</sup> The court stated:

The direct and indirect expressions of approval of various private laws which have modified the exclusiveness of the grant to the patentee and the long legislative history of the exercise of congressional power to modify the exclusiveness of a patent grant, dating, indeed, from shortly after the adoption of the Constitution, lead us to conclude that Congress did not violate Article I, § 8, cl. 8 of the Constitution in the enactment of Private Law 1008.<sup>352</sup>

Second, the defendant argued “that it and other members of the public acquired a vested right in the invention because of Blair’s failure to seek a patent within the time prescribed by law and the passage of the invention into the public domain,”<sup>353</sup> and that allowing Blair to obtain a patent would deny them that property right in violation of the Due Process Clause of the Fifth Amendment.<sup>354</sup> Relying on *The Fire-Extinguisher Case*,<sup>355</sup> the court rejected this argument.<sup>356</sup> It reasoned:

Private Law 1008 did nothing more than waive the statute of limitations contained in 35 U.S.C.A. § 102(b). In Federal jurisprudence statutes of limitations are not generally considered to create vested rights in those whose obligations are barred from enforcement.<sup>357</sup>

The court’s decision on this point is flawed. The court relied in part on the premise that “not until the Patent Act of 1870 . . . was any time limit

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<sup>350</sup> Between 1937 and 1976, federal law required that a three-judge district court be convened whenever the enforcement, operation or execution of any Act of Congress was challenged as unconstitutional. Former 28 U.S.C. § 2282 (repealed 1976); see CHARLES ALAN WRIGHT, *LAW OF FEDERAL COURTS* § 50, at 316-17.(5th ed. 1994).

<sup>351</sup> *Radio Position Finding Corp.*, 205 F. Supp. at 853-55 (citing *Evans v. Jordan*, 13 U.S. 199 (1815)); *Agawam Co. v. Jordan*, 74 U.S. 583 (1868); and *The Fire-Extinguisher Case*, 21 F. 40 (C.C.D. Md. 1884). These cases are discussed above at notes 269-277 and 305-321, and accompanying text.

<sup>352</sup> *Radio Position Finding Corp.*, 205 F. Supp. at 855.

<sup>353</sup> *Id.* at 855-56.

<sup>354</sup> The court characterized this argument as based on “substantive due process.” *Id.* at 852.

<sup>355</sup> 21 F. 40 (C.C.D. Md. 1884), discussed at notes 312-321 and accompanying text.

<sup>356</sup> *Radio Position Finding Corp.*, 205 F. Supp. at 856 (“defendant is in error when it argues that it and the public had acquired a property right in the Blair invention by reason of Blair’s failure to pursue a timely application for a patent, and that this right is one entitled to the protection of the due process clause.”).

<sup>357</sup> *Id.* at 856.

imposed on an applicant for a patent to make his application,”<sup>358</sup> but this premise was incorrect. While the Patent Act of 1870 allowed a two-year period of public use before making an application,<sup>359</sup> prior to that time *any* public use of the invention before the application would disqualify the applicant from receiving a patent.<sup>360</sup> In addition, the court’s analogy to a statute of limitations is flawed. Statutes of limitation act to preserve the status quo and to protect settled expectations,<sup>361</sup> while granting a patent many years after the public has adopted the invention has the opposite effect of disrupting the status quo and interfering with settled expectations.

Third, the defendant argued that the Private Law violated the Equal Protection component of the Due Process Clause of the Fifth Amendment.<sup>362</sup> The court correctly concluded that Congress had a rational basis to grant Blair individual relief.<sup>363</sup> Finally, the defendant argued that the Private Law violated procedural due process by circumventing the usual interference procedure of the Patent Office in determining priority of invention.<sup>364</sup> The court concluded that the ability to challenge the validity of Blair’s patent in court constituted sufficient process to satisfy the requirements of the Fifth Amendment.<sup>365</sup> On a direct appeal,<sup>366</sup> the U.S. Supreme Court affirmed the decision of the three-judge district court without a written opinion.<sup>367</sup>

In the last half of the twentieth century, several pharmaceutical manufacturers sought patent term extensions to compensate them for the time during which their products underwent regulatory review in the Food and

<sup>358</sup> *Id.* at 856 n.6.

<sup>359</sup> Patent Act of 1870, § 24, 16 Stat. 198, 201 (“not in public use or on sale for more than two years prior to his application”).

<sup>360</sup> Patent Act of 1790, § 1, 1 Stat. 109, 109 (“not before known or used”); Patent Act of 1793, § 1, 1 Stat. 318, 318 (“not known or used before the application”). The Patent Act of 1836 limited disqualifying prior uses to those known to the inventor and not objected to. *See* Patent Act of 1836, § 6, 5 Stat. 117, 119 (“not, at the time of the application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer”).

<sup>361</sup> *See* Tyler T. Ochoa & Andrew J. Wistrich, *The Puzzling Purposes of Statutes of Limitation*, 28 PAC. L.J. 453, 464-66 (1997).

<sup>362</sup> *Radio Position Finding Corp.*, 205 F. Supp. at 856-57; *see* *Bolling v. Sharpe*, 347 U.S. 497, 499 (1954).

<sup>363</sup> *Radio Position Finding Corp.*, 205 F. Supp. at 857 (“We cannot say . . . that Congress had no basis on which to conclude that Colonel Blair was entitled to special relief.”).

<sup>364</sup> *Id.* at 857.

<sup>365</sup> *Id.* at 857-58.

<sup>366</sup> *See* 28 U.S.C. § 1253 (2000) (authorizing direct appeal to the U.S. Supreme Court from the decision of a three-judge district court).

<sup>367</sup> 371 U.S. 577 (1963) (per curiam). The precedential effect to be accorded this summary affirmance is discussed at notes 548-563 and accompanying text.

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Drug Administration.<sup>368</sup> These efforts resulted in several special patent extensions for particular products.<sup>369</sup> The first product to receive such an extension was the artificial sweetener Aspartame, patented by G.D. Searle & Co.<sup>370</sup> During the FDA approval process, questions had arisen concerning the data Searle had submitted with its application. “Although Searle was not at fault, the FDA, to protect the public, formally stayed the approval of aspartame until the validity of the data on aspartame . . . was confirmed.”<sup>371</sup> The stay remained in effect from December 5, 1975, until the FDA approval of aspartame on October 22, 1981,<sup>372</sup> a total of five years, ten months and seventeen days. In 1983, Searle sought and received an extension from Congress equal to the period of the delay.<sup>373</sup>

Over the next two years, four additional products were granted special terms extensions under similar circumstances. FDA approval of the anesthetic drug Forane took more than ten years, leaving it with less than seven years of patent protection.<sup>374</sup> Congress granted an extension of five years and three months,<sup>375</sup> the portion of the delay attributable to investigation of a spurious claim that the drug was carcinogenic.<sup>376</sup> USDA approval of a veterinary drug called Impro was withheld for sixteen years on the basis of a private study later found to contain false and misleading statements, during which time the USDA refused to release the underlying data to the patentee.<sup>377</sup> Congress granted Impro an extension of fifteen years.<sup>378</sup> Two oral hypoglycemic drugs, Glyburide and Glipizide, were found to be safe and effective by the FDA in 1974, but final approval was withheld for ten years over a labeling issue.<sup>379</sup> In 1984, Congress extended

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<sup>368</sup> See generally Richard M. Cooper, *Legislative Patent Extensions*, 48 FOOD & DRUG L.J. 59 (1993).

<sup>369</sup> *Id.* at 64.

<sup>370</sup> *Id.* at 64-65.

<sup>371</sup> *Id.* at 65.

<sup>372</sup> *Id.*

<sup>373</sup> See 35 U.S.C. § 155 (2000). Although this statute is phrased in general terms, the only product which falls within its scope is Aspartame. Under this statute, a total of thirty-two patents covering aspartame were extended. See *Patent Terms Extended Under 35 U.S.C. § 155*, <http://www.uspto.gov/web/offices/pac/dapp/opla/term/155.html> (last visited July 14, 1999).

<sup>374</sup> See Cooper, *supra* note 368, at 66.

<sup>375</sup> See 35 U.S.C. § 155A (2000). Once again, although the statute does not identify Forane by name, it is the only drug that satisfies the description set forth in the statute. See *Patent Terms Extended Under 35 U.S.C. § 155A*, <http://www.uspto.gov/web/offices/pac/dapp/opla/term/155.html> (last visited July 14, 1999).

<sup>376</sup> See Cooper, *supra* note 368, at 66-67.

<sup>377</sup> *Id.* at 67-68.

<sup>378</sup> See Priv. L. No. 98-34, 98 Stat. 3430 (1984).

<sup>379</sup> See Cooper, *supra* note 368, at 68-69.

five patents covering the two drugs until April 21, 1992,<sup>380</sup> a period of between two years, nine months for the most recent patent, and nearly six years for the oldest patent.<sup>381</sup>

In 1984, Congress addressed the problem more systematically by enacting the Hatch-Waxman Act, which allows the patentee to apply for an extension to compensate for delays in regulatory approval.<sup>382</sup> The Act also streamlined the approval process for generic drugs following patent expiration. As a result, patent owners that had expected to enjoy an extended period of market exclusivity following expiration of the patent, while a generic drug went through the FDA approval process, were now faced with competition immediately upon expiration of the patent.<sup>383</sup> One such patent owner was Warner-Lambert which, as a condition of FDA approval on its cardiovascular drug Lopid, had been required to continue funding a five-year heart attack prevention study in Helsinki, Finland.<sup>384</sup> Warner-Lambert agreed to the condition, expecting that it would have a period of five to seven years of market exclusivity after the patent expired in which to recoup its investment in the study.<sup>385</sup> The Hatch-Waxman Act eliminated this expectation. As Senator Hatch remarked, “[i]n effect, the rules were changed in the middle of the game on this product.”<sup>386</sup> In response, Congress granted Warner-Lambert an extension of three years and six months to the Lopid patent.<sup>387</sup>

Notwithstanding the enactment of the Hatch-Waxman Act, Congress continued to be besieged with requests for term extensions on specific pharmaceutical patents.<sup>388</sup> Some of these requests involved so-called “pipeline” drugs, i.e., drugs which were already under review in the FDA

<sup>380</sup> See Priv. L. No. 98-46, 98 Stat. 3434 (1984).

<sup>381</sup> See *Patent Terms Extended Under Private Laws (Not Codified Into Title 35)*, <http://www.uspto.gov/web/offices/pac/dapp/opla/term/law.html> (last visited July 15, 1999).

<sup>382</sup> See notes 217-222 and accompanying text.

<sup>383</sup> See Cooper, *supra* note 368, at 70-71.

<sup>384</sup> *Id.* at 69-70.

<sup>385</sup> *Id.*; see also 133 CONG. REC. E3209-03 (daily ed. Aug. 3, 1987) (remarks of Hon. Butler Derrick, South Carolina).

<sup>386</sup> 133 CONG. REC. S10,353 (daily ed. July 21, 1987) (remarks of Senator Orrin Hatch, Utah).

<sup>387</sup> See Pub. L. No. 100-418, § 9201, 102 Stat. 1569 (1988).

<sup>388</sup> See Cooper, *supra* note 368, at 73-85 (describing four patent extension requests to Congress during the 1991-1992 term). Extensions were sought of behalf of the anti-inflammatory drugs Ansaid (S. 1165, 102d Cong. (1991) and H.R. 2255, 102d Cong. (1992)) and Lodine (H.R. 4896, 102d Cong. (1992)); the anti-radiation drug Ethiofos (S. 526 and H.R. 1314, 102d Cong. (1991)); and the fat substitute Olestra (S. 1506 and H.R. 2805, 102d Cong. (1991)).

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when the Hatch-Waxman Act was passed.<sup>389</sup> Expecting that most such drugs would be approved relatively quickly, Hatch-Waxman limited patent term extensions for pipeline drugs to a maximum of two years.<sup>390</sup> When some pipeline drugs took longer than expected to gain approval, the drug manufacturers sought relief in Congress. In 1992, the Senate Judiciary Committee expressed concern about the process:

The committee views the dramatic increased interest in patent extension requests as troubling. The patent system was not designed to guarantee every inventor a financial reward for his efforts. Furthermore, the Hatch-Waxman Act provides a uniform and fair mechanism for dealing with a diminished patent life from regulatory delay. In the long run, uncertainty in the length of the patent term may have a chilling effect on competitors.<sup>391</sup>

At the same time, the House Subcommittee on Intellectual Property tried to set forth general standards under which Congress would consider individual patent term extensions.<sup>392</sup> Under the proposal, extensions would be limited to delay beyond the control of the patent holder caused by federal governmental misconduct, or other “action or inaction” by the government “of such a nature as to create a moral or ethical obligation . . . to provide relief.”<sup>393</sup> Despite the proposed guidelines, however, both houses of Congress passed private patent term extensions in late 1992.<sup>394</sup> Only an ironic political stalemate<sup>395</sup> and the adjournment of Congress prevented the extensions from becoming law.<sup>396</sup>

In 1993, Procter and Gamble renewed its efforts to obtain a patent extension for the fat substitute Olestra.<sup>397</sup> Olestra had originally been

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<sup>389</sup> Both Ansaid and Lodine fell into this category. Olestra was also under review in the FDA as a drug, rather than as a food additive. *See* note 399, *infra*.

<sup>390</sup> 35 U.S.C. § 156(g)(6)(C) (2000).

<sup>391</sup> S. REP. NO. 102-414 (1992).

<sup>392</sup> H.R. REP. NO. 102-775 (1992).

<sup>393</sup> *Id.* (text of proposed amendment to H.R. 5475).

<sup>394</sup> *See* Cooper, *supra* note 368, at 84-85.

<sup>395</sup> The House Judiciary Committee opposed granting a patent term extension sought by U.S. Bioscience (for Ethiofos) which was championed by Strom Thurmond, the ranking member of the Senate Judiciary Committee; and the Senate had not approved the patent term extension for Lodine which was supported by William J. Hughes, the Chairman of the House Subcommittee on Intellectual Property. *See* Cooper, *supra* note 368, at 85.

<sup>396</sup> *Id.*

<sup>397</sup> On Feb. 18, 1993, Senator John Glenn (D-Ohio) introduced a bill extending three patents on Olestra, S. 409, 103d Cong. (1993), describing it as “unfinished business from the 102d Congress.” 139 CONG. REC. S1914 (daily ed. July 14, 1993).

patented in 1971,<sup>398</sup> but P&G had not submitted a food additive petition with the FDA until 1987;<sup>399</sup> and P&G was concerned that three subsequent Olestra patents<sup>400</sup> would expire before the FDA approved its use, which would render the patents ineligible for extension under the Hatch-Waxman Act.<sup>401</sup> A bill extending the Olestra patents to December 31, 1997 was passed in the Senate,<sup>402</sup> and was incorporated into a House appropriations bill for the Patent and Trademark Office.<sup>403</sup> Before final passage, however, the Olestra extension was replaced with a more general provision allowing the Patent Office to grant “interim” one-year extensions to any patents which were about to expire if the patented product was still undergoing regulatory review.<sup>404</sup> Under the revised bill, as enacted,<sup>405</sup> a key Olestra patent was extended pending FDA approval.<sup>406</sup>

<sup>398</sup> U.S. Patent No. 3,600,186 (Aug. 17, 1971).

<sup>399</sup> According to a GAO study requested by the House Subcommittee on Intellectual Property, “[v]arious factors have contributed to the extended period of time it is taking to obtain FDA approval of Olestra. . . . Because the FDA lacked a clear approval process for such substances in the 1970’s and 1980’s, P&G pursued approval for Olestra not only as a food additive but also as a drug. Between 1975 and 1985, P&G spent significant time and resources exploring the product’s properties and its potential as a drug. . . . In a 1985 meeting with P&G, FDA officials had explained that the agency had liberalized its attitude toward companies making health claims about food products. In light of this meeting, P&G switched its focus to the food approval path and filed a FAP in April 1987.” General Accounting Office, FDA Premarket Approval: Process of Approving Olestra as a Food Additive, *quoted in* H.R. REP. NO. 102-775, at 15, 17 (1992), *available at* 1992 WL 191650.

<sup>400</sup> U.S. Patent Nos. 4,005,195 (Jan. 25, 1977), 4,005,196 (Jan. 25, 1977) and 4,034,083 (July 5, 1977). Under the seventeen-year term then in effect, these patents were due to expire in 1994.

<sup>401</sup> Under Hatch-Waxman, a patent may be extended only if “the term of the patent has not expired before an application is submitted . . . for its extension,” 35 U.S.C. § 156(a)(1) (2000), but P&G could not submit an application for an extension until after its product had been approved by the FDA. *See* 35 U.S.C. § 156(d)(1) (2000).

<sup>402</sup> 139 CONG. REC. S8735-37 (daily ed. July 14, 1993).

<sup>403</sup> 139 CONG. REC. S15,634 (daily ed. Nov. 10, 1993) (approving Glenn Amendment No. 1161 to H.R. 2632).

<sup>404</sup> 139 CONG. REC. H10,256-57 (daily ed. Nov. 19, 1993). Rep. Brooks explained: “No provision was made [in Hatch-Waxman] for products for which the regulatory review is so long that the 17-year patent expires before approval. The House amendment allows patent holders who are eligible for a patent extension under the 1984 legislation to receive — prior to the expiration of the patent — an interim patent extension while awaiting regulatory approval. When such approval is received, the patent could then be extended pursuant to the [Hatch-Waxman] Act.” *Id.* at H10,257.

<sup>405</sup> Pub. L. No. 103-179, § 5, 107 Stat. 2040 (1993) (codified at 35 U.S.C. § 156(d)(5) (2000)).

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The FDA approved Olestra on January 24, 1996,<sup>407</sup> and the patent was extended for an additional two years under the provisions of the Hatch-Waxman Act.<sup>408</sup>

In 1993, two bills were introduced to grant an additional two-year period of “market exclusivity” to G.D. Searle for oxaprozin,<sup>409</sup> a non-steroidal anti-inflammatory drug (NSAID) marketed under the name Daypro.<sup>410</sup> Oxaprozin was a pipeline drug which had been patented in 1971,<sup>411</sup> but which was not approved by the FDA until 1992.<sup>412</sup> “As a result of this delay, the patent for oxaprozin expired before Daypro could be brought to market.”<sup>413</sup> The 1993 bills died in committee,<sup>414</sup> but two similar bills were introduced in 1995.<sup>415</sup> The language of these bills was

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<sup>406</sup> U.S. Patent No. 4,005,196 (Jan. 25, 1977) was due to expire on Jan. 25, 1994. It received an interim extension, and was reissued on May 24, 1994 as U.S. Patent No. RE 34,617. Later that year, under the terms of the URAA (see notes 223-229 and accompanying text), the term was changed to twenty years from the date of filing, extending the patent to Feb. 12, 1996.

<sup>407</sup> <http://www.fda.gov/bbs/topics/NEWS/NEW00524.html> (last visited July 2, 2001).

<sup>408</sup> U.S. Patent No. RE 34,617 (May 24, 1994). The patent term was extended “for the period of Two years from January 30, 1996, the effective date of *receipt* of permission for commercial marketing or use.” *Id.* at 15 (emphasis added).

Section 5 of Pub. L. No. 103-179 was widely perceived as applying specifically to Olestra. See, e.g., S. REP. NO. 104-343, at 59-60 (1996) (reporting passage of Olestra extension bill); Statement of Peter Barton Hutt before House Subcommittee on Courts and Intellectual Property (May 21, 1998) (listing Olestra as the recipient of a “Statutory Patent Term Restoration” in 1993), <http://www.house.gov/judiciary/42014.htm> (last visited July 2, 2001). It appears, however, that at least one other product, Remeron, received an interim extension under this law. See U.S. Patent No. 4,062,848 (Dec. 13, 1997) (originally due to expire Dec. 13, 1994; extended to Mar. 23, 1996, by the URAA; interim extension granted pending FDA approval; and extended two years from date of FDA approval on June 14, 1996).

<sup>409</sup> S. 1734 and H.R. 3552, 103d Cong. (1993). Instead of extending Searle’s patent, which had already expired, these bills instead prohibited the FDA from accepting or approving a New Drug Application for a generic competitor.

<sup>410</sup> See Statement of Sen. Paul Simon (D-Illinois), 139 CONG. REC. S16,492 (daily ed. Nov. 19, 1993); Statement of Rep. Cardiss Collins (D-Illinois), 139 CONG. REC. E2980 (daily ed. Nov. 19, 1993).

<sup>411</sup> U.S. Patent No. 3,578,671 (May 11, 1971).

<sup>412</sup> <http://www.fda.gov/cder/ob/default.htm> (last visited July 2, 2001).

<sup>413</sup> Statement of Rep. Dennis Hastert (R-Illinois), 141 CONG. REC. E1917 (daily ed. Oct. 11, 1995).

<sup>414</sup> *Bill Summary & Status for the 103rd Congress*, at <http://thomas.loc.gov> (last visited July 2, 2001).

<sup>415</sup> H.R. 2467 and S. 1496, 104th Cong. (1995). Unlike the 1993 bills, the 1995 bills granted Searle a new two-year patent, incorporating by reference the remedies for patent infringement under Title 35.

inserted into an appropriations measure by a conference committee,<sup>416</sup> resulting in a two-year patent revival for oxaprozin.<sup>417</sup>

In 1996, shortly after the Daypro legislation was enacted, four separate attempts were made to pass a patent extension for Lodine that had failed in 1992.<sup>418</sup> The first effort was made in a Senate amendment to a Defense authorization bill<sup>419</sup> and was removed by a conference committee.<sup>420</sup> Similar language was included in an Agriculture appropriations bill<sup>421</sup> and was again removed by a conference committee.<sup>422</sup> One day later, the Lodine extension was inserted into a health insurance bill during the deliberations of a conference committee.<sup>423</sup> After several members of Congress objected that the change had been made improperly,<sup>424</sup> the

<sup>416</sup> H.R. REP. NO. 104-537, at 330-31 (1996). The Conference Committee included two co-sponsors of the Daypro legislation, Rep. John E. Porter (R-Illinois) and Sen. Christopher S. Bond (R-Missouri). It is fair to criticize the Daypro measure as stealth legislation: the Conference Committee report was filed on Apr. 25, 1996, at 1:49 p.m.; it was presented for debate in the House at 3:13 p.m.; the House approved the lengthy appropriations bill at 4:56 p.m.; the Senate approved it at 7:43 p.m.; and the President signed the bill the next day. *Bill Summary & Status for the 104th Congress*, at <http://thomas.loc.gov> (last visited July 2, 2001).

<sup>417</sup> Pub. L. No. 104-134, § 2105, 110 Stat. 1321, 1321-320 (1996); see Notice of Two-Year Exclusivity Period; DAYPRO® Oxaprozin, 61 Fed. Reg. 25636 (May 22, 1996).

<sup>418</sup> See notes 388-396 and accompanying text.

<sup>419</sup> H.R. 3230, § 1080(d), 104th Cong. (as amended in Senate, July 10, 1996). In debating S. 1745, Senators Pryor, Brown and Chaffee introduced an amendment to reconcile the GATT extension with the Hatch-Waxman Act. S. Amdt. No. 4365, 142 CONG. REC. S7113-01 (daily ed. June 27, 1996). Senator Hatch proposed a substitute amendment that included the Lodine provision, which was approved. S. Amdt. No. 4366, 142 CONG. REC. S7113-01 (daily ed. June 27, 1996). Senator Hatch had previously argued that Lodine “was under FDA NDA review for over 8 years, and presents a factual case in many respects similar to Daypro.” 142 CONG. REC. S6594 (daily ed. June 20, 1996). The provisions of S. 1745, as amended, were then incorporated into H.R. 3230, *Bill Summary & Status for the 104th Congress*, at <http://thomas.loc.gov> (last visited July 10, 2001).

<sup>420</sup> H.R. CONF. REP. NO. 104-724, at 801 (1996), reprinted in 1996 U.S.C.C.A.N. 3130, 3308 (deleting § 1080).

<sup>421</sup> H.R. 3603, § 732, 104th Cong. (June 7, 1996); see also 142 CONG. REC. S8608 (daily ed. July 24, 1996) (remarks of Sen. Hatch).

<sup>422</sup> H.R. CONF. REP. NO. 104-726, at 34 (1996) (Amendment No. 121), available at 1996 WL 431982.

<sup>423</sup> H.R. CONF. REP. NO. 104-736, § 281, at 106 (1996), available at 1996 WL 579893.

<sup>424</sup> See 142 CONG. REC. H9778 (daily ed. Aug. 1, 1996) (remarks of Rep. Waxman); 142 CONG. REC. S9463-64 (daily ed. Aug. 2, 1996) (remarks of Sen. Kennedy); *id.* at S9465 (remarks of Sen. Wellstone); *id.* at S9469 (remarks of Sen. Wyden).



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Lodine extension was removed by a concurrent resolution.<sup>425</sup> Finally, after the summer recess the Senate reported a bill to “reconcile” the GATT extension with the Hatch-Waxman Act that included the Lodine provision.<sup>426</sup> This bill was not enacted.<sup>427</sup>

The issue of patent term extensions for “pipeline” drugs continued to occupy Congress during the next four years. In 1996, a bill was introduced granting a two-year extension to any pipeline drugs which had been reviewed by the FDA for more than five years.<sup>428</sup> The principal beneficiary of the legislation would have been Schering-Plough, manufacturer of the antihistamine Claritin, which had received FDA approval in 1993.<sup>429</sup> Claritin was rapidly becoming one of the best-selling drugs ever produced,<sup>430</sup> but it was approaching the end of its patent life.<sup>431</sup> During the next few years, Schering-Plough made several more attempts to extend Claritin’s patent,<sup>432</sup> culminating in two bills which were introduced in

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<sup>425</sup> H. Con. Res. 208, 104th Cong. (1996); see 142 CONG. REC. H9897-98 (daily ed. Aug. 2, 1996); *id.* at S9526; see also *id.* at S9499-501 (debate on S. Con. Res. 68 regarding Lodine).

<sup>426</sup> S. 1277, § 4, 104th Cong. (as amended Oct. 1, 1996); see S. REP. NO. 104-394, at 4, 22 (1996).

<sup>427</sup> *Bill Summary & Status for the 104th Congress*, at <http://thomas.loc.gov> (last visited July 10, 2001).

<sup>428</sup> S. 2154, 104th Cong. (1996).

<sup>429</sup> <http://www.fda.gov/cder/ob/default.htm> (last visited June 30, 2001).

<sup>430</sup> According to Schering-Plough’s website, Claritin had \$1.15 billion in worldwide sales in 1996. <http://www.sgp.com/news/financial/earnings/1-23-97.html> (last visited July 16, 2001). Worldwide sales of Claritin increased to \$3 billion in 2000. <http://www.sgp.com/news/financial/earnings/01-25-01.html> (last visited July 16, 2001).

<sup>431</sup> The patent application covering Claritin was filed on June 19, 1980 and was granted on Oct. 4, 1981. U.S. Patent No. 4,282,233 (Oct. 4, 1981). Without any extensions, the patent would have expired on Oct. 4, 1998. The patent received a two-year extension under Hatch-Waxman and a GATT extension of twenty-two months, and is now due to expire on June 19, 2002. In addition, under a provision added by the FDA Modernization Act of 1997, 21 U.S.C. § 505A(c)(2)(A), Claritin will receive an additional six months of post-patent “market exclusivity” in exchange for having conducted pediatric trials on Claritin. See *FDA Extends Claritin Patent Six Months*, WALL ST. J., Aug. 17, 2000, at B15.

<sup>432</sup> According to Rep. Henry Waxman (D-Calif.), “[i]n 1996, Schering tried unsuccessfully to attach Claritin patent extensions to the omnibus appropriations bill, the continuing resolution and the agriculture appropriations bill.” 144 CONG. REC. E2121-03 (daily ed. Oct. 13, 1998). Subsequently, “[i]n May 1997, the company attempted to add a patent extension amendment to the Omnibus Patent Act of 1997, an effort that was blocked in the Senate Judiciary Committee. In the closing moments of the 1997 congressional session, there was a second attempt to extend the patent through the appropriation process, while a bill was in conference. That effort was also rejected. Last year there was an attempt to add this proposal to the 1998 Omnibus Appro-

1999.<sup>433</sup> The case for the term extensions focused on the fact that “pipeline” drugs had been limited to a two-year extension under Hatch-Waxman, while non-pipeline competitors could receive a five-year extension.<sup>434</sup> The proposed bills faced intense opposition from consumer advocates and the generic drug industry,<sup>435</sup> citing a study which estimated that a three-year patent extension for Claritin would cost consumers \$7.36 billion over a ten-year period.<sup>436</sup> Despite a multi-million dollar lobbying effort by Schering,<sup>437</sup> both bills died in Committee,<sup>438</sup> and an effort to add the legislation to a military construction appropriations bill in 2000 also failed.<sup>439</sup>

In addition to the efforts to obtain patent term extensions by the pharmaceutical industry, several other individual patent term extension

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priations Bill. That initiative failed as well.” Testimony of Bruce L. Downey before House Subcommittee on Courts and Intellectual Property, 1999 WL 20009817 (July 1, 1999).

<sup>433</sup> H.R. 1598 and S. 1172, 106th Cong. (1999). A pharmaceutical industry study identified eight drugs that would have benefitted from the legislation: Claritin (loratidine), Relafen (nabumetone), Daypro (oxaprozin), Cardiogen-82 (rubidium), Eulexin (flumatide), Nimotop (nimopidine), Dermatop (prednicarbate), and Penetrex (enoxacin). PRIME Institute, College of Pharmacy, University of Minnesota, *Patent Extension of Pipeline Drugs: Impact on U.S. Health Care Expenditures* (July 28, 1999), tbl. 1, <http://www.house.gov/berry/prescriptiondrugs/schoncharts.htm> (last visited July 16, 2001).

<sup>434</sup> Testimony of Jonathan Spicehandler, M.D., Schering-Plough Research Institute, before House Subcommittee on Courts and Intellectual Property, 1999 WL 20009820 (July 1, 1999).

<sup>435</sup> See, e.g., *Claritin Bill Targeted at Grassroots*, Congress Daily A.M., 1999 WL 27685516 (Nov. 8, 1999); Hearing Before House Subcommittee on Courts and Intellectual Property: Testimony of Bruce L. Downey, 1999 WL 20009817 (July 1, 1999); Testimony of Andrew M. Berdon, 1999 WL 20009818 (July 1, 1999); Testimony of Maura Kealy, 1999 WL 20009824 (July 1, 1999).

<sup>436</sup> PRIME Institute, College of Pharmacy, University of Minnesota, *Patent Extension of Pipeline Drugs: Impact on U.S. Health Care Expenditures* (July 28, 1999), *Executive Summary*, <http://www.house.gov/berry/prescriptiondrugs/schondelmeyer.htm> (last visited July 16, 2001).

<sup>437</sup> One consumer organization estimated that Schering has spent \$28 million since 1996 in attempting to obtain a patent extension for Claritin. See Public Citizen Congress Watch, *Schering-Plough Political Money Pushes Claritin Patent Extension and Distorts GAO Report* (Mar. 2001), <http://www.citizen.org/congress/drugs/factshts/patentextension/report.pdf> (last visited July 16, 2001).

<sup>438</sup> *Bill Summary & Status for the 106th Congress*, at <http://thomas.loc.gov> (last visited July 10, 2001).

<sup>439</sup> See Stephen S. Hall, *Prescription for Profit*, N.Y. TIMES MAGAZINE, Mar. 11, 2001, at 59; *Drug Patent Extension Measure is Blocked from Military Spending Bill*, GENERIC LINE, 2000 WL 31703053 (July 14, 2000).

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bills were introduced in the last decade. In 1993<sup>440</sup> and again in 1995,<sup>441</sup> a bill was introduced to renew and extend six patents<sup>442</sup> covering a medical device which had been banned from sale in the U.S. by the FDA from 1972 to 1987.<sup>443</sup> In 1997, a quixotic twelve-year effort to obtain a patent term extension on a stock-market “quotation monitoring unit”<sup>444</sup> ended when the last in a series of twelve bills died in Committee.<sup>445</sup> Finally, in 2000 Senator Judd Gregg (D-N.H.) tried to attach a patent term extension that would have benefitted his alma mater, Columbia University, to two appropriations bills.<sup>446</sup> The patent covered a process for inserting DNA

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<sup>440</sup> See H.R. 3579, 103d Cong. (1993).

<sup>441</sup> See H.R. 2113, 104th Cong. (1995).

<sup>442</sup> The bill would have revived for ten years five patents owned by the Diapulse Corporation of America that had already expired: U.S. Patent Nos. 3,670,737 (June 20, 1972); 3,566,877 (Mar. 2, 1971); 3,464,010 (Aug. 26, 1969); 3,181,535 (May 4, 1965); and 3,043,310 (July 10, 1962). Reviving the latter two patents apparently would have been a futile gesture, since both had been declared invalid in 1967. See *Diapulse Corp. of Am. v. Rochester Leasing Corp.*, 286 F. Supp. 74, 80 (W.D.N.Y. 1967).

In addition, the bill would have extended for ten years U.S. Patent No. 4,226,246 (Oct. 7, 1980), which was assigned to Carba Societe Anonyme, a Swiss corporation. The author assumes this assignee is a successor to Carba, Ltd., a Swiss corporation that was an exclusive distributor of Diapulse machines in Switzerland and Germany in the 1970s. See *Diapulse Corp. of Am. v. Carba, Ltd.*, 626 F.2d 1108, 1109 (2d Cir. 1980).

<sup>443</sup> For a summary of the lengthy dispute between Diapulse and the FDA, see *United States v. Diapulse Corp. of Am.*, 748 F.2d 56 (2d Cir. 1984); Paul Schreiber, *Diapulse Wins 15-Year Feud with FDA to Market Device*, NEWS-DAY, May 18, 1987, at 5.

<sup>444</sup> U.S. Patent No. 3,387,268 (June 4, 1968).

<sup>445</sup> See H.R. 381, 105th Cong. (1997); H.R. 901, 104th Cong. (1995); S. 2013, 103d Cong. (1994); H.R. 3057, 103d Cong. (1993); S. 2689, 102d Cong. (1992); H.R. 2192, 102d Cong. (1991); S. 463, 101st Cong. (1989); H.R. 926, 101st Cong. (1989); S. 1102, 100th Cong. (1987); H.R. 1274, 100th Cong. (1987); S. 1573, 99th Cong. (1985); H.R. 1012, 99th Cong. (1985).

“The patent holder argued that FCC regulations in force at the time his patent was granted effectively denied him use of his patent,” H.R. REP. NO. 102-775, at 17 (1992), available at 1992 WL 191650, but this explanation was expressly rejected by the House Judiciary Committee in 1992. *Id.* at 17-19. The Committee followed the negative recommendation of the Department of Commerce, which explained in a letter that the patent specification and claims attached “no importance” to the use of FCC-approved radio channels in implementing the patented invention. *Id.* at 18.

<sup>446</sup> See Charles R. Babcock, *Senator Tries to Extend Alma Mater’s Patent: Columbia Would Gain \$100 Million a Year*, WASH. POST, May 19, 2000, at E3; Ronald Rosenberg, *Gregg Draws Ire Over Columbia Patent Move*, BOSTON GLOBE, July 13, 2000, at A1.

The initial effort was an Agriculture Appropriations Bill, S. 2536, § 2801, 106th Cong. (introduced May 10, 2000). The Committee report explained: “Since this patent is not subject to Food and Drug Administration review, current

used to manufacture proteins into animal cells.<sup>447</sup> Gregg abandoned the effort when it became clear that the term extension could not be enacted before the patent expired.<sup>448</sup>

What lessons about the meaning of the Patent and Copyright Clause can be drawn from the history of private patent term extensions? This question is analyzed in Section III-C, below.

### B. *Design Patents*

Unlike utility patents, which govern products, processes and machines,<sup>449</sup> design patents are issued for “any new, original and ornamental design for an article of manufacture.”<sup>450</sup> The term of a design patent is fourteen years from the date of the grant.<sup>451</sup> When design patents were first added to the Patent Act in 1842, they were granted for a seven-year term,<sup>452</sup> which could be extended by statute for an additional seven years.<sup>453</sup> In 1861, the term of a utility patent was increased to seventeen years, and extensions were prohibited;<sup>454</sup> but applicants for design patents were permitted to elect a term of either 3.5 years, seven years or fourteen years, which could be extended for an additional seven years.<sup>455</sup> In 1870, the seven-year extension of design patents was repealed, but was preserved for design patents issued prior to the 1861 Act.<sup>456</sup> The initial election of a term of 3.5 years, seven years or fourteen years was carried forward in both the 1870 Act<sup>457</sup> and the 1952 Act.<sup>458</sup> In 1982, Congress replaced the three alternative terms with a single term of fourteen years

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law does not provide a mechanism by which non-profit organizations can seek term extensions.” S. REP. NO. 106-288, at 197 (2000). When the agriculture bill stalled, some of its spending provisions were proposed as an amendment to a Defense Appropriations bill. See Amend. No. 3374 to H.R. 4576, § 2801, 146 CONG. REC. S5033, S5050 (daily ed. June 13, 2000). This amendment was ordered to lie on the table. *Id.* at S5033.

<sup>447</sup> U.S. Patent No. 4,399,216 (Aug. 16, 1983). The draft bills covered an “elemental biologic,” defined as “a genetically engineered cell, or method of making thereof, used in manufacturing five or more new drugs, antibiotic drugs, or human biological products.” S. 2536, § 2801, 106th Cong. (May 10, 2000).

<sup>448</sup> See Editorial, *The Old College Try*, BOSTON GLOBE, July 17, 2000, at A10.

<sup>449</sup> 35 U.S.C. § 101 (2000) (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”).

<sup>450</sup> *Id.* § 171.

<sup>451</sup> *Id.* § 173.

<sup>452</sup> See Patent Act of 1842, § 3, 5 Stat. 543, 543-44 (1842).

<sup>453</sup> See Patent Act of 1836, § 18, 5 Stat. 117, 124-25 (1836).

<sup>454</sup> See Patent Act of 1861, § 16, 12 Stat. 246, 249 (1861).

<sup>455</sup> *Id.*, § 11, 12 Stat. at 248.

<sup>456</sup> See Patent Act of 1870, § 74, 16 Stat. 198, 210 (1870).

<sup>457</sup> *Id.*, § 73, 16 Stat. at 210.

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for all design patents.<sup>459</sup> The 1982 amendment was not made retroactive,<sup>460</sup> so it did not result in the extension of any existing design patents. The Uruguay Round Agreements Act, which changed the term of utility patents to twenty years from filing,<sup>461</sup> left the term of design patents unchanged.<sup>462</sup>

Although design patents were supposed to be granted only to ornamental designs on an article of manufacture, several service organizations, such as the Daughters of the American Revolution<sup>463</sup> and the Disabled American Veterans,<sup>464</sup> applied for and received design patents on their badges and insignia.<sup>465</sup> As those design patents began to expire, some of these organizations sought and received special congressional extensions of the terms of their design patents.<sup>466</sup> Often these extensions were not granted until after the original term or previous extension had expired, resulting in renewals of expired design patents as well as extensions. With one exception, these design patent extensions have routinely been granted.<sup>467</sup>

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<sup>458</sup> See Patent Act of 1952, Pub. L. No. 82-593, § 1, 66 Stat. 792, 805 (1952) (codified at former 35 U.S.C. § 173; repealed 1982).

<sup>459</sup> See Pub. L. No. 97-247, § 16, 96 Stat. 317, 321 (1982) (codified at former 35 U.S.C. § 173).

<sup>460</sup> Section 16 reads: “Patents for designs *shall be* granted for the term of fourteen years,” *id.* (emphasis added), indicating that it is prospective only. See also *id.*, § 17(a) (“Sections 3 and 16 of this Act shall take effect on October 1, 1982.”).

<sup>461</sup> See notes 223-229 and accompanying text.

<sup>462</sup> To emphasize that no change was being made, the URAA did clarify that the fourteen-year term was to run “from the date of the grant.” Pub. L. No. 103-465, Title V, § 532(c)(3), 108 Stat. 4809, 4987 (1994) (codified at 35 U.S.C. § 173).

<sup>463</sup> U.S. Patent No. D21,053 (Sept. 22, 1891).

<sup>464</sup> U.S. Patent No. D59,560 (Nov. 1, 1921).

<sup>465</sup> The probable explanation is that it would have been difficult to register these badges and insignia as trademarks prior to the enactment of the Lanham Act in 1946. “The Lanham Act significantly changed and liberalized the common law to ‘dispense with mere technical prohibitions.’” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 171 (1995).

<sup>466</sup> See, e.g., Priv. L. No. 64-14, ch. 84, 39 Stat. 1260 (1916) (Daughters of the American Revolution); Priv. L. No. 71-3, ch. 126, 46 Stat. 1633 (1930) (same); Priv. L. No. 79-692, ch. 470, 60 Stat. 1241 (1946) (same); Pub. L. No. 74-627, ch. 468, 49 Stat. 1389 (1936) (Disabled American Veterans); Priv. L. No. 81-522, ch. 292, 64 Stat. A69 (1950) (same).

<sup>467</sup> In addition to the design patents discussed at notes 466 and 468-471, see also U.S. Patent No. D25,909 (Aug. 11, 1896) (United States Daughters of 1812), *renewed and extended by* Pub. L. No. 66-398, ch. 170, 41 Stat. 1440 (1921); Pub. L. No. 74-551, ch. 278, 49 Stat. 1257 (1936) (same); U.S. Patent No. D119,187 (Feb. 27, 1940) (Massachusetts Dep’t of United Am. Veterans of

In 1992, the House Judiciary Committee reported a bill to extend design patents for the insignia of the United Daughters of the Confederacy,<sup>468</sup> and the badges of the American Legion,<sup>469</sup> the American Legion Women's Auxiliary,<sup>470</sup> and the Sons of the American Legion.<sup>471</sup> Each of these design patents had been extended several times.<sup>472</sup> The Committee explained its decision as follows:

The Committee is not convinced of the appropriateness of the original decisions, renewed several times since, to utilize design patent laws to protect these insignia and badges. Trademark or some form of sui generis protection may be more appropriate.

However, the Committee takes note of the long precedent for utilization of design patent protection for these emblems, and the fact that such an approach appears to achieve the desired purpose with no detrimental effects upon the public interest. For these reasons, the Committee has recommended renewal and extension of design patent protection for the insignia and badges of these patriotic organizations.<sup>473</sup>

The House bill was not enacted because of disagreement between the House and Senate over several pharmaceutical patents that were also contained in the bill.<sup>474</sup> When the design patent extensions were re-introduced in 1993,<sup>475</sup> Senator Carol Moseley-Braun (D-Ill.) offered an amendment in the Senate Judiciary Committee to remove the extension for the insignia of the United Daughters of the Confederacy, which con-

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the United States of Am., Inc.), *renewed and extended* by Pub. L. No. 89-295, 79 Stat. 1070 (1965).

<sup>468</sup> U.S. Patent No. D29,611 (Nov. 8, 1898), *renewed and extended* by Pub. L. No. 69-242, ch. 327, 44 Stat. 562 (1926); Pub. L. No. 77-220, ch. 369, 55 Stat. 633 (1941); Pub. L. No. 88-213, 77 Stat. 421 (1963); Pub. L. No. 95-168, 91 Stat. 1349 (1977).

<sup>469</sup> U.S. Patent No. D54,296 (Dec. 9, 1919), *renewed and extended* by Pub. L. No. 74-230, ch. 427, 49 Stat. 510 (1935); Priv. L. No. 81-121, ch. 252, 63 Stat. 1121 (1949); Priv. L. No. 87-439, 76 Stat. 1319 (1962); Priv. L. No. 94-39, 90 Stat. 2971 (1976).

<sup>470</sup> U.S. Patent No. D55,398 (June 1, 1920), *renewed and extended* by Pub. L. No. 74-231, ch. 428, 49 Stat. 510 (1935); Priv. L. No. 81-122, ch. 253, 63 Stat. 1122 (1949); Priv. L. No. 87-438, 76 Stat. 1318 (1962); Priv. L. No. 94-40, 90 Stat. 2971 (1976).

<sup>471</sup> U.S. Patent No. D92,187 (Jan. 25, 1934), *renewed and extended* by Priv. L. No. 81-123, ch. 254, 63 Stat. 1122 (1949); Priv. L. No. 87-437, 76 Stat. 1318 (1962); Priv. L. No. 94-38, 90 Stat. 2970 (1976).

<sup>472</sup> See notes 468-471.

<sup>473</sup> H.R. REP. NO. 102-775 (1992).

<sup>474</sup> See notes 388-396 and accompanying text.

<sup>475</sup> S. 409, 103d Cong. (1993) (as introduced).

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tained a replica of the Confederate flag.<sup>476</sup> The amendment passed by a vote of 12 to 3.<sup>477</sup> Later that term, Senator Jesse Helms (R-N.C.) proposed the extension as an amendment to another bill.<sup>478</sup> A motion to table the amendment initially failed 48-52,<sup>479</sup> but Senator Moseley-Braun successfully staged a filibuster and succeeded in persuading the Senate to reconsider<sup>480</sup> and to table the amendment by a vote of 75-25.<sup>481</sup> The other three design patent extensions, for the badges of the American Legion and its two affiliates, were enacted into law.<sup>482</sup>

It has frequently been pointed out that “this recurrent renewal procedure is unnecessary.”<sup>483</sup> The insignia of these service organizations are not really ornamental designs on an article of manufacture; instead, they serve the source-identifying function of a trademark.<sup>484</sup> Specifically, they fall within the Lanham Act’s definition of a collective mark:

The term “collective mark” means a trademark or service mark . . . used by the members of a cooperative, an association or other collective group or organization . . . and includes marks used to indicate membership in a union, an association or other organization.<sup>485</sup>

Accordingly, “the parties currently holding these design patents would apparently lose no rights if the patents were converted into trademarks. In-

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<sup>476</sup> The flag on the insignia is the Stars and Bars, the first national flag of the Confederate States of America, rather than the more familiar Confederate battle flag. U.S. Patent No. D29,611 (Nov. 8, 1898).

<sup>477</sup> See Report on the Activities of the Committee of the Judiciary During the 103d Congress, S. REP. NO. 104-343, at 60 (1996).

<sup>478</sup> See Helms Amend. 610 to S. 919, 103d Cong. (1993), *published at* 139 CONG. REC. S9251 (daily ed. July 22, 1993).

<sup>479</sup> 139 CONG. REC. S9256 (daily ed. July 22, 1993).

<sup>480</sup> 139 CONG. REC. S9268 (daily ed. July 22, 1993). The vote on the motion to reconsider was 76-24.

<sup>481</sup> *Id.* The record of this extraordinary debate is preserved at 139 CONG. REC. S9251-68 (daily ed. July 22, 1993). See also *Freshman Turns Senate Scarlet*, WASH. POST, July 27, 1993, *reprinted at* 139 CONG. REC. E1907 (daily ed. July 28, 1993).

<sup>482</sup> Pub. L. No. 103-179, § 7, 107 Stat. 2040, 2042 (1993).

<sup>483</sup> Benagh, *supra* note 286, at 12.

<sup>484</sup> A trademark is defined as “any word, name, symbol, or device, or any combination thereof, used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others.” 15 U.S.C. § 1127 (2000).

<sup>485</sup> *Id.* § 1127.

deed, such a measure would eliminate the need to periodically approach Congress for renewal.”<sup>486</sup>

Moreover, Congress has already granted *sui generis* trademark protection to a large number of federally-chartered service organizations in Title 36 of the United States Code.<sup>487</sup> These statutes typically provide that the organization has the “exclusive right” to use the name, badge, emblem, or insignia of the organization;<sup>488</sup> although a few are limited (for no apparent reason other than historical accident) to the name alone.<sup>489</sup> At least two of the organizations which frequently sought design patent extensions have received such protection. The charter of the Daughters of the American Revolution was amended in 1976 to include the exclusive right to use the “seals, emblems, and badges” adopted by them;<sup>490</sup> and the statutes incorporating the American Legion were amended in 1953 to include “the exclusive right to manufacture, and to control the right to manufacture, and to use, such emblems and badges as may be deemed necessary.”<sup>491</sup> In addition, the badges of the American Legion and other veterans organizations are protected by a criminal statute, first adopted in 1940,<sup>492</sup> which states:

Whoever knowingly manufactures, reproduces, sells or purchases for resale, either separately or on or appended to, any article of merchandise manufactured or sold, any badge, medal, emblem, or other insignia or any colorable imitation thereof, of any veterans' organization incorporated by enactment of Congress, . . . or knowingly prints, lithographs, engraves or otherwise reproduces on any poster, circular, periodical, magazine, news-

<sup>486</sup> Benagh, *supra* note 286, at 12. Registered trademarks which continue to be used may be renewed every ten years upon filing of an affidavit and payment of a fee. 15 U.S.C. § 1058 (2000).

<sup>487</sup> A First Amendment challenge to one such statute was rejected by the U.S. Supreme Court in *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522 (1987). See notes 530-532 and accompanying text.

<sup>488</sup> See, e.g., 36 U.S.C. § 22306 (2000) (American Symphony Orchestra League); *id.* § 30905 (Boy Scouts); *id.* § 80305 (Girl Scouts); *id.* § 130506 (Little League); *id.* § 152907 (National Society, Daughters of the American Colonists); § 170307 (Pearl Harbor Survivors Association); *id.* § 230105 (Veterans of Foreign Wars).

<sup>489</sup> See, e.g., 36 U.S.C. § 22505 (2000) (American War Mothers); *id.* § 50305 (Disabled American Veterans).

<sup>490</sup> Pub. L. No. 94-443, § 2, 90 Stat. 1475 (1976) (now codified, as amended, at 36 U.S.C. § 153104 (2000)).

<sup>491</sup> Pub. L. No. 83-80, ch. 153, § 1, 67 Stat. 82 (1953) (now codified, as amended, at 36 U.S.C. § 21705 (2000)).

<sup>492</sup> Pub. L. No. 76-663, ch. 426, 54 Stat. 571 (1940) (now codified, as amended, at 18 U.S.C. § 705 (2000)).



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paper, or other publication, or circulates or distributes any such printed matter bearing a reproduction of such badge, medal, emblem, or other insignia or any colorable imitation thereof, except when authorized under rules and regulations prescribed by any such organization, shall be fined under this title or imprisoned not more than six months, or both.<sup>493</sup>

The existence of these special civil and criminal statutes demonstrates that the design patent extensions obtained by the American Legion in 1962, 1976 and 1993<sup>494</sup> were wholly unnecessary.<sup>495</sup> Such extensions should be recognized for what they really are: honorary recognition by Congress of patriotic organizations,<sup>496</sup> and private trademark legislation that has little, if anything, to do with traditional patent law.<sup>497</sup>

Analytically, the repeated extension of design patents for these service organizations results in patent protection that is essentially perpetual in duration.<sup>498</sup> If such repeated extensions were granted for any other type of design or utility patent, it is likely that the extension would be invalidated on the ground that perpetual patent protection is unconstitu-

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<sup>493</sup> 18 U.S.C. § 705 (2000). In *United States v. Dettra Flag Co.*, 86 F. Supp. 84 (E.D. Pa. 1949), this statute was challenged “on the grounds that this statute is an unconstitutional delegation of legislative powers by Congress.” 86 F. Supp. at 85. The District Court held the statute was constitutional. *Id.* at 90. See also *American Legion v. Matthew*, 144 F.3d 498 (7th Cir. 1998) (law prohibiting duplication of American Legion’s badge, medal or emblem did not prohibit use of word “Legionaire” as a trademark for caps imitating “the distinctive headgear of the French Foreign Legion.”).

<sup>494</sup> See notes 469-482 and accompanying text.

<sup>495</sup> Cf. *United States v. Dettra Flag Co.*, 86 F. Supp. at 86-87 (“The committee reports in Congress state that the purpose of the Act is to protect these organizations and the public from the unauthorized use of their insignia, . . . [because] patent infringements suits have been ineffective.”).

<sup>496</sup> The honorary aspect of these patent extensions was discussed in the 1993 debate concerning the proposed design patent extension for the United Daughters of the Confederacy. See 139 CONG. REC. S9253 (daily ed. July 22, 1993) (remarks of Sen. Moseley-Braun) (“It is a rare honor given to an organization.”); *id.* at S9254 (“Why would we give an extraordinary honor to a symbol which is counter to the symbol that we as Americans . . . all know and love?”).

<sup>497</sup> *Id.* at S9253 (“it is not only extraordinary but probably inappropriate to have a design patent issued in this regard.”); Benagh, *supra* note 286, at 13 (“It appears, in light of the traditional function of private legislation to honor the equitable and moral debts of the United States, that the original grant of such extensions by Congress may have been erroneous.”).

<sup>498</sup> Cf. *Eldred v. Reno*, 239 F.3d 372, 381 (D.C. Cir. 2000) (Sentelle, J., dissenting) (“there is no apparent substantive distinction between permanent protection and permanently available authority to extend originally limited protection.”).

tional.<sup>499</sup> By contrast, trademarks which remain in continuous use can be protected indefinitely.<sup>500</sup> Indefinite protection for trademarks is constitutionally permissible because trademark law is not based upon the Patent and Copyright Clause,<sup>501</sup> nor is it based on that Clause's incentive rationale, under which the government grants exclusive rights for a limited period of time as an incentive to creation or invention.<sup>502</sup> Instead, trademark law arises solely under the Commerce Clause,<sup>503</sup> and traditionally it is based on a consumer protection rationale, the prevention of confusion among consumers in the market.<sup>504</sup> Thus, if design patent

<sup>499</sup> See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) ("Congress may not create patent monopolies of unlimited duration."); see also *United States v. Moghadam*, 175 F.3d 1269, 1281 (11th Cir. 1999) ("the 'Limited Times' requirement . . . forbids Congress from conferring intellectual property rights of perpetual duration.").

<sup>500</sup> 15 U.S.C. § 1058 (2000); *Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 637 (7th Cir. 1993) ("Although patent rights are limited in duration by statute, trademark rights may continue as long as the mark is used to distinguish and identify.").

<sup>501</sup> See *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879) ("While such legislation may be a judicious aid to the common law on the subject of trade-marks, . . . we are unable to see any such power in the constitutional provision concerning authors and inventors, and their writings and discoveries.").

<sup>502</sup> See *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, \_\_\_, 121 S.Ct. 1255, 1262 (2001) ("The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of patent law and its period of exclusivity."); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995) ("It is the province of patent law, not trademark law, to encourage invention by granting an inventor a monopoly over new product designs or functions for a limited time."); *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1446 (3d Cir. 1994) ("Of course, it is not the purpose of unfair competition law, under the guise of either consumer protection or the protection of business good will, to implement a policy of encouraging innovative designs by protecting them once designed. Those issues are the province of copyright and patent laws.").

<sup>503</sup> See *United States v. Moghadam*, 175 F.3d 1269, 1278 (11th Cir. 1999) ("modern trademark law is built entirely on the Commerce Clause"); *United We Stand Am., Inc. v. United We Stand, Am. New York, Inc.*, 128 F.3d 86, 92 (2d Cir. 1997) ("The history and text of the Lanham Act show that 'use in commerce' reflects Congress's intent to legislate to the limits of its authority under the Commerce Clause.").

<sup>504</sup> See *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 198 ("The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers."); *Star Financial Servs., Inc. v. Aastar Mortgage Corp.*, 89 F.3d 5, 9 (1st Cir. 1996) ("The purpose of trademark laws is to prevent the use of the same or similar marks in a way that confuses the public about the actual source of the goods or services.").

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extensions for service organizations can legitimately be characterized as private trademark legislation, the “limited Times” provision of the Patent and Copyright Clause would not present a constitutional barrier to their validity.<sup>505</sup>

In order for the “limited Times” restriction of the Patent and Copyright Clause to be meaningful, there must be some way of distinguishing potentially indefinite trademark protection from the protection afforded by patent and copyright law, which can only be granted for “for limited Times.”<sup>506</sup> Traditionally, three doctrines have served to keep trademark law separate from patent and copyright protection.<sup>507</sup> First, a trademark must serve a source identifier; that is, it must serve to distinguish the goods or services of the mark owner from those of others.<sup>508</sup> Second, trademark protection cannot be granted to the functional features of a product.<sup>509</sup>

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<sup>505</sup> See *United States v. Moghadam*, 175 F.3d 1269, 1278 (11th Cir. 1999) (“The Supreme Court’s analysis in the Trade-Mark Cases stands for the proposition that legislation which would not be permitted under the [Patent and] Copyright Clause could nonetheless be permitted under the Commerce Clause.”); *but see id.* at 1280 n.12 (“We assume arguendo, without deciding, that the Commerce Clause could not be used to avoid a limitation in the Copyright Clause if the particular use of the Commerce Clause . . . were fundamentally inconsistent with the particular limitation in the Copyright Clause.”); *cf.* Heald & Sherry, *supra* note 25, at 1160-66 (explaining why trademark law does not exceed implied limits placed on Congress by the Patent and Copyright Clause).

<sup>506</sup> See David S. Welkowitz, *Trade Dress and Patent — The Dilemma of Confusion*, 30 RUTGERS L.J. 289, 299 (1999) (“Trademarks are unlimited in time, while patents have limits in time. . . . If trademarks are perceived as better protection than design patents, then the design patent scheme that Congress has created, with its explicit trade off between incentive and public access, is eviscerated.”); *id.* at 306 (“to the extent there are similarities between the tests, there must be strong discernable lines separating them. Otherwise, the harmonization between patent and trademark will be a false one.”).

<sup>507</sup> See Welkowitz, *supra* note 506, at 306-07.

<sup>508</sup> 15 U.S.C. § 1127 (2000) (defining “trademark” as “any word, name, symbol, or device” used “to identify and distinguish his or her goods . . . from those manufactured and sold by others and to indicate the source of the goods”); *see also id.* (definition of “service mark”); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995) (“It is the source-distinguishing ability of a mark . . . that permits it to serve these basic purposes.”); *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 35 (1st Cir. 1998) (“A primary purpose of trade dress or trademark protection is to protect that which identifies a product’s source.”).

<sup>509</sup> *Qualitex*, 514 U.S. at 164 (“The functionality doctrine prevents trademark law . . . from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.”); *Wilhelm Pudenz, GmbH v. Littlefuse, Inc.*, 177 F.3d 1204, 1211 (11th Cir. 1999) (“The functionality doctrine serves the extremely important function of avoiding conflict between the trademark law and the patent law. It does this by denying a perpetual exclusive

Third, trademark infringement requires a showing that there is a likelihood of confusion among consumers in the relevant market.<sup>510</sup>

Application of these doctrines to the insignia and badges of service organizations demonstrates a substantial overlap between their design patent extensions and trademark law. First, the insignia or badges of service organizations often do serve as source identifiers, because they distinguish the goods and services sold or endorsed by those organizations from those of others.<sup>511</sup> On the other hand, at least two cases have held that jewelry displaying the insignia of a fraternal organization does not *necessarily* signify origin or sponsorship by that organization.<sup>512</sup> Second, insignia and badges are not functional under the Supreme Court's definitions of that term. An insignia is not "essential to the use or purpose of the article" on which it appears; nor does it "affect[ ] the cost or quality of the article."<sup>513</sup> Of course, this is true of all design patents, which by definition must be

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right in a wholly functional product feature or configuration under the trademark law, where such a grant under the Patent Act would be unconstitutional.").

<sup>510</sup> *Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 637 (7th Cir. 1993) ("Compared to patent protection, trademark protection is relatively weak because it precludes competitors only from using marks that are likely to confuse or deceive the public."); *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 337 (7th Cir. 1985) ("The trademark owner has an indefinite term of protection, it is true, but in an infringement suit must also prove secondary meaning [i.e., source identification] and likelihood of confusion, which the owner of a design patent need not do; there is therefore no necessary inconsistency between the two modes of protection.").

<sup>511</sup> *See Int'l Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 918 (9th Cir. 1980) ("the name 'Job's Daughters' and the Job's Daughters insignia are indisputably used to identify the organization, and members of Job's Daughters wear the jewelry to identify themselves as members. In that context, the insignia are trademarks of Job's Daughters."); *United States v. Dettra Flag Co.*, 86 F. Supp. 84, 86-87 (E.D. Pa. 1949) ("It is proper that Congress should seek . . . to protect the interest of these organizations in self-identification.") (insignia of the American Legion).

<sup>512</sup> *See Job's Daughters*, 633 F.2d at 920 (upholding finding that "consumers did not ordinarily purchase their fraternal jewelry from only 'official' sources"); *Supreme Assembly, Order of Rainbow for Girls v. J.H. Ray Jewelry Co.*, 676 F.2d 1079, 1083 (5th Cir. 1982) (upholding finding that "there is no historical custom or practice . . . that would provide a reasonable basis for buyers of Rainbow jewelry to assume that such jewelry can only be manufactured with Rainbow's sponsorship or approval."). Both cases distinguished *Boston Prof'l Hockey Ass'n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1010-12 (5th Cir. 1975), which held that professional sports team logos *do* constitute source identifiers.

<sup>513</sup> *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, \_\_\_, 121 S.Ct. 1255, 1261 (2001); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982).

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ornamental and not functional.<sup>514</sup> Some courts have developed the concept of “aesthetic functionality” to try to deal with this problem;<sup>515</sup> and some have suggested that “aesthetic functionality” exists whenever buyers purchase a good merely to display the logo itself.<sup>516</sup> However, the Supreme Court seems to have limited aesthetic functionality to situations in which the “exclusive use of [the design] would put competitors at a significant non-reputation-related disadvantage.”<sup>517</sup> Using this standard, there is no indication that using the insignia of a service organization confers any competitive advantage except to enhance the reputation of the goods on which it appears.

Third, it appears that avoidance of consumer confusion was a significant purpose behind the design patent extensions for these service organizations.<sup>518</sup> Indeed, the test for infringement of a design patent is expressly stated in terms of confusion:

[I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.<sup>519</sup>

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<sup>514</sup> 35 U.S.C. § 171 (2000); *Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1563 (Fed. Cir. 1988).

<sup>515</sup> See generally *Welkowitz*, *supra* note 506, at 334-43.

<sup>516</sup> See *Job's Daughters*, 633 F.2d at 918 (“in the context of this case, the name and emblem are functional aesthetic components of the jewelry, in that they are being merchandised on the basis of their intrinsic value, not as a designation of origin or sponsorship.”); *Order of Rainbow*, 676 F.2d at 1083 n.5 (declining to address the issue). The problem with this inquiry is that, as applied, it seems to merely duplicate the source-identification inquiry. See *Welkowitz*, *supra* note 506, at 341-43.

<sup>517</sup> *Qualitex Co.*, 514 U.S. at 165; see *Traffix Devices*, 532 U.S. at \_\_\_, 121 S.Ct. at 1261-62 (explaining use of this standard in cases of aesthetic functionality).

<sup>518</sup> See, e.g., 139 CONG. REC. S8736 (daily ed. July 14, 1993) (remarks of Sen. Glenn) (“Unfortunately, this worthy organization [the American Legion] has frequently fallen prey to profiteers who use the Legion emblems without permission to solicit contributions and to sell counterfeit products.”); cf. *United States v. Dettra Flag Co.*, 86 F. Supp. 84, 86-87 (E.D. Pa. 1949) (“It is proper that Congress should seek to protect the public from frauds perpetrated by imposters. . . . The committee reports in Congress state that the purpose of the Act is to protect these organizations *and the public* from the unauthorized use of their insignia.”) (emphasis added).

<sup>519</sup> *Gorham Co. v. White*, 81 U.S. 511, 528 (1871). This test is still used today, supplemented by the “point of novelty” test, which seeks to determine whether the allegedly infringing product uses the features that distinguish the design from the prior art. *Unidynamics Corp. v. Automatic Prods. Int'l, Ltd.*, 157 F.3d 1311, 1323 (Fed. Cir. 1998).

This test is a combination of the “ordinary observer” test for assessing “substantial similarity” in copyright infringement cases,<sup>520</sup> and the “likelihood of confusion” test for trademark infringement.<sup>521</sup> The distinction, if one exists, is that design patent infringement requires only confusion as to the design itself,<sup>522</sup> whereas trademark requires confusion as to the source of goods bearing the design.<sup>523</sup> Presumably, a perceptive consumer could understand that the source of the goods was different, even though the two designs were identical.<sup>524</sup> However, to the extent that design patent law allows a finding of infringement without a showing of confusion as to source, it resembles the protection afforded by trademark dilution statutes,<sup>525</sup> such as the Federal Trademark Dilution Act.<sup>526</sup> These statutes are based on the theory that even non-confusing uses of a trademark may cause harm to the senior user of a famous mark, by lessening the distinctiveness and thus the commercial value of the mark.<sup>527</sup> While one court has suggested that trademark dilution law may violate the Patent and Copyright Clause as applied to product configurations,<sup>528</sup> the same court indi-

<sup>520</sup> See *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (finding infringement where “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.”).

<sup>521</sup> See Welkowitz, *supra* note 506, at 344-46.

<sup>522</sup> *Unidynamics*, 157 F.3d at 1323 (“the ordinary observer must be deceived by the features common to the claimed and accused designs that are ornamental, not functional”).

<sup>523</sup> *Unette Corp. v. Unit Pack Co.*, 785 F.2d 1026, 1029 (Fed. Cir. 1986) (“Likelihood of confusion *as to the source of goods* is not a necessary or appropriate factor for determining infringement of a design patent.”) (emphasis added).

<sup>524</sup> *But see* Welkowitz, *supra* note 506, at 327-30 (noting that the expansion of trademark law in allowing evidence of post-sale confusion amounts to a ban on copying).

<sup>525</sup> See Welkowitz, *supra* note 506, at 358-66.

<sup>526</sup> 15 U.S.C. § 1125(c) (2000). See David S. Welkowitz, *Oh, Deere, What's to Become of Dilution? (A Commentary on the New Federal Trademark Dilution Act)*, 4 UCLA ENT. L. REV. 1 (1996).

<sup>527</sup> See *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522, 539 (1987) (citing Frank Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 825 (1927)). For a critique, see David S. Welkowitz, *Reexamining Trademark Dilution*, 44 VAND. L. REV. 531 (1991).

<sup>528</sup> *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 32 (1st Cir. 1998) (“Kohler has raised serious constitutional concerns”); *id.* at 35 (“Kohler’s constitutional claim [is] that dilution protection of trade dress of product design amounts to an unconstitutional perpetual monopoly under the Patent Clause of the Constitution”); *id.* at 53 (Boudin, J., concurring) (“In the case of patents and copyrights, the foreclosure of competition is deemed a price worth paying . . . but only for a limited time. Is this policy of time-limited protection, constitutional at its core, overcome wherever dilution is

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cated that dilution could constitutionally be applied to non-functional insignia which serve as a source identifier.<sup>529</sup> Similarly, in *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*,<sup>530</sup> the U.S. Supreme Court held that a special trademark statute that did not require a showing of likelihood of confusion could be based on a dilution theory without violating the First Amendment.<sup>531</sup> While there are possible grounds upon which that ruling could be distinguished,<sup>532</sup> it seems likely that a special statute protecting the insignia of a service organization would also be constitutional (at least in the vast majority of circumstances) as an exercise of Congress' power under the Commerce Clause to regulate trademarks.

In sum, the insignia of service organizations serve a trademark function, and renewals and extensions of the design patents for those insignia have more in common with trademark law than with design patent law. As applied to design patents, those renewals and extensions are constitutionally suspect; but if the insignia are viewed as trademarks, the renewals and extensions stand on firm constitutional footing. Consequently, this category of extensions should not be viewed as precedent for the extension of patents and copyrights generally.

### C. Analysis

The history of private patent term extensions can be interpreted in two very different ways. One view is that the Constitution gives to Con-

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threatened—even though no confusion can be proved and any impairment of the trademark may be only potential and directed primarily to protecting the seller rather than the public?”).

<sup>529</sup> *Id.* at 52 (Boudin, J., concurring) (“By contrast to a trademark consisting of a name or insignia, a product design will not often qualify as a trademark inviting protection from dilution.”); *id.* at 52-53 (“Where only a word or symbol is forever preempted, this protective approach toward the trademark may make sense, and in all events does not pose much risk to the policies of the patent and copyright clauses.”).

<sup>530</sup> 483 U.S. 522 (1987).

<sup>531</sup> *Id.* at 539-40.

<sup>532</sup> First, the statute at issue in *SFAA* only prohibited unauthorized use of the word “Olympic” and certain Olympic symbols “for the purpose of trade, to induce the sale of any goods or services, or to promote any theatrical exhibition, athletic performance, or competition.” Former 36 U.S.C. § 380 (now codified, as amended, at 36 U.S.C. § 220506 (2000)). The Court relied on these limitations in upholding the statute, 483 U.S. at 536-41, and it indicated that purely expressive uses might still be protected by the First Amendment. *Id.* at 536 n.14 (citing *Stop the Olympic Prison v. United States Olympic Committee*, 489 F. Supp. 1112 (S.D.N.Y. 1980)). Second, given that the Court expressly concluded that a likelihood of confusion existed, 483 U.S. at 539, the portion of the opinion discussing trademark dilution could be dismissed as dicta.

gress complete discretion over whether and how long patent terms may be extended.<sup>533</sup> Certainly that is the import of the many opinions rejecting constitutional challenges to private patent term extensions,<sup>534</sup> including opinions written by Justices Story<sup>535</sup> and Washington.<sup>536</sup> Indeed, those opinions hold that Congress can even revive an expired patent;<sup>537</sup> and the question was considered so well-settled that in some instances counsel simply conceded the point.<sup>538</sup> This view is supported by general statements on the subject of Congress' power by the U.S. Supreme Court,<sup>539</sup> and bolstered by the fact that during the patent term extension debates of the last

<sup>533</sup> See 2 ERNEST BAINBRIDGE LIPSCOMB III, *WALKER ON PATENTS* § 8:8, at 496 (3d ed. 1985) ("It has been held that patents may be extended by Congress at any time, either before or after their expiration."); 2 ANTHONY WILLIAM DELLER, *WALKER ON PATENTS* § 238 (1937) (same); 2 WILLIAM C. ROBINSON, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* § 835, at 642 (1890) ("In this country the propriety of such extensions in special cases has always been conceded."); *id.* § 845 at 655 ("Congress may extend a patent by special act . . . at any time before or after the expiration of the original term.").

Similarly, the leading contemporary treatise simply states that "Congress itself on occasion extended patents by special act," and notes many examples of general term extension provisions, without discussing or mentioning the possibility that such term extensions might be unconstitutional. See 5 CHISUM ON PATENTS, *supra* note 224, § 16.04[1] at 16-187 & nn.4-5; § 16.04[5] (Hatch-Waxman Act); and § 16.04[6] (URAA).

<sup>534</sup> See, e.g., *Evans v. Robinson*, 8 F. Cas. 886, 888 (C.C.D. Md. 1813) (No. 4,571) (Congress is "not restrained from renewing a patent or prolonging the time of its continuance."), discussed at notes 266-268 and accompanying text; *Bloomer v. Stolley*, 3 F. Cas. 729, 731 (C.C.D. Ohio 1850) (No. 1,559) ("congress had the power to extend the patent"), discussed at notes 297-303 and accompanying text; and *Jordan v. Dobson*, 13 F. Cas. 1092, 1095 (C.C.E.D. Pa. 1870) (No. 7,519) ("It is not said when those limited times shall commence, how long they shall continue, or when they shall end. All that is left to the discretion of Congress."), discussed at notes 305-310 and accompanying text.

<sup>535</sup> See *Blanchard v. Sprague*, 3 F. Cas. 648, 650 (C.D.D. Mass. 1839) (No. 1,518) ("it rests in the sound discretion of Congress to say, when and for what length of time and under what circumstances the patent for an invention shall be granted."), discussed at notes 288-295 and accompanying text.

<sup>536</sup> See *Evans v. Eaton*, 8 F. Cas. 846, 848-49 (C.C.D. Pa. 1816) (No. 4,559), *rev'd on other grounds*, 16 U.S. (3 Wheat.) 454 (1818), *on remand*, 8 F. Cas. 856 (C.C.D. Pa. 1818) (No. 4,560), *aff'd*, 20 U.S. (7 Wheat.) 356 (1822), discussed at notes 278-284 and accompanying text.

<sup>537</sup> *Evans v. Eaton*, *Evans v. Robinson*, *Blanchard v. Sprague* and *Jordan v. Dobson* all involved patents that had expired prior to their extension by Congress.

<sup>538</sup> See notes 296 & 304 and accompanying text.

<sup>539</sup> See *Pennock & Sellers v. Dialogue*, 27 U.S. 1, 16-17 (1829); *McClurg v. Kingsland*, 42 U.S. 202, 206 (1843). These opinions are discussed at notes 616-627 and accompanying text.



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two decades, apparently there was not a single suggestion in Congress, even by opponents of one or more extensions, that such extensions might be unconstitutional.<sup>540</sup> If this view is correct, then the only course open to opponents of copyright term extension is to argue that copyrights are somehow different than patents, such that copyrights may not be extended even though patents may be.<sup>541</sup> Such an argument is obviously an uphill climb; but Nimmer and others have argued that such a limitation may be found in the First Amendment, reasoning that copyright law imposes restrictions on freedom of speech,<sup>542</sup> whereas patent law does not.<sup>543</sup>

The opposite view is that, despite the raft of relatively broad pronouncements, the question has not been settled. This view relies on the fact that the U.S. Supreme Court has never squarely addressed the meaning of the phrase “limited Times” or the issue of whether patent (or copyright) term extension is constitutional under the Patent and Copyright Clause. While individual members of the U.S. Supreme Court, sitting as Circuit Judges, have expressed their opinions,<sup>544</sup> the issue has never been addressed in a written opinion by the Court as a whole.<sup>545</sup> Several cases involving extended patents have been heard by the Court; but in each of those cases, the issue of whether the extension violated the Patent and Copyright Clause was either never raised<sup>546</sup> or was conceded by the appellant’s counsel.<sup>547</sup> Under this view, the U.S. Supreme Court could treat all of the previous examples of patent term extension and the circuit court

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<sup>540</sup> By contrast, the constitutionality of copyright term extension was repeatedly raised as an issue by opponents of the Copyright Term Extension Act. *See* notes 23 & 146 *supra*.

<sup>541</sup> *Cf.* Heald & Sherry, *supra* note 25, at 1153 (“Congress’s justifications for patent extensions are not necessarily applicable to copyright.”).

<sup>542</sup> *See* 1 NIMMER ON COPYRIGHT, *supra* note 43, § 1.10[C][1], at 1-85; *see also* Lawrence Lessig, *Copyright’s First Amendment*, 48 UCLA L. REV. 1057 (2001); Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1 (2001); *cf.* Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston, Inc., 515 U.S. 557, 569 (1995) (First Amendment “unquestionably shield[s] [the] painting of Jackson Pollock, music of Arnold Schoenberg, or Jabberwocky verse of Lewis Carroll.”).

<sup>543</sup> *But see* Dan L. Burk, *Patenting Speech*, 79 TEX. L. REV. 99 (2000) (noting First Amendment difficulties raised by decisions allowing patent protection of computer software).

<sup>544</sup> *See* notes 535-536 and accompanying text.

<sup>545</sup> The Supreme Court did summarily affirm the decision in *Radio Position Finding Corp. v. Bendix Corp.*, 205 F. Supp. 850 (D. Md. 1962), *aff’d mem.*, 371 U.S. 577 (1963). *See* notes 340-367 and accompanying text. The precedential effect to be given to this summary affirmance is discussed at notes 548-563 and accompanying text.

<sup>546</sup> *See* notes 276-277, 282-284, 304, 311 and accompanying text.

<sup>547</sup> *See* notes 296 & 304 and accompanying text.

opinions upholding them as non-binding authority, and address the issue on a clean slate.

The choice between these two views depends in large measure on how one interprets the Supreme Court's summary affirmance in *Radio Position Finding Corp. v. Bendix Corp.*<sup>548</sup> Unlike denials of certiorari, which do not carry any precedential weight,<sup>549</sup> summary affirmances are ostensibly decisions on the merits which are binding on lower federal courts.<sup>550</sup> Some scholars have questioned whether summary affirmances should be given any precedential effect, noting that prior to 1988 summary dispositions essentially served the same function as petitions for certiorari.<sup>551</sup> Despite this widely-acknowledged reality,<sup>552</sup> the Supreme Court has indicated that summary dispositions are entitled to a "limited precedential effect";<sup>553</sup> but it has cautioned that "the precedential effect of a summary

<sup>548</sup> 205 F. Supp. 850 (D. Md. 1962), *aff'd mem.*, 371 U.S. 577 (1963). See notes 340-367 and accompanying text.

<sup>549</sup> See *United States v. Carver*, 260 U.S. 482, 490 (1923) (Holmes, J.) ("The denial of a writ of certiorari imports no expression of opinion upon the merits of the case, as the bar has been told many times."); *accord*, *Teague v. Lane*, 489 U.S. 288, 296 (1989); *Missouri v. Jenkins*, 515 U.S. 70, 85 (1995).

<sup>550</sup> See generally 16B CHARLES F. WRIGHT, ARTHUR MILLER AND EDWARD B. COOPER, FEDERAL PRACTICE AND PROCEDURE, JURISDICTION § 4003 (1996); ROBERT L. STERN, EUGENE GRESSMAN, STEPHEN M. SHAPIRO & KENNETH S. GELLER, SUPREME COURT PRACTICE §§ 4.28-4.29 (7th ed. 1993).

<sup>551</sup> See Erwin N. Griswold, *Rationing Justice—The Supreme Court's Caseload and What the Court Does Not Do*, 60 CORNELL L. REV. 335, 345 (1975) ("In most cases there is no longer any practical distinction between appeal and certiorari."); Philip B. Kurland, *Jurisdiction of the United States Supreme Court: Time For a Change?*, 59 CORNELL L. REV. 616, 624 (1974) ("The fact is that the Court doesn't seem to treat appeals any differently from the way it treats petitions for certiorari."); see also WRIGHT, MILLER & COOPER, *supra* note 550, § 4003, at 18 ("Most observers outside the court had come to believe that the actual practice was to treat appeals in substantially the same way as petitions for certiorari"); STERN, GRESSMAN, ET AL., *supra* note 550, § 4.26, at 211 ("one function of the jurisdictional statement was similar to that of the petition for certiorari, to induce the court to hear oral argument.").

<sup>552</sup> See *Hogge v. Johnson*, 526 F.2d 833, 836 (4th Cir. 1975) (Clark, J., concurring) ("during the eighteen Terms in which I sat [on the U.S. Supreme Court] . . . appeals from state court decisions received treatment similar to that accorded petitions for certiorari and were given about the same precedential weight."); Harold B. Wiley, *Jurisdictional Statements on Appeals to the U.S. Supreme Court*, 31 A.B.A. J. 239, 239 (1945) ("Jurisdictional statements and petitions for certiorari now stand on practically the same footing."). At the time, Wiley was a deputy clerk at the U.S. Supreme Court.

<sup>553</sup> *Anderson v. Celebrezze*, 460 U.S. 780, 784 (1983); see also *Edelman v. Jordan*, 415 U.S. 651, 671 (1974) ("these three summary affirmances obviously are of precedential value in support of the contention . . . . Equally obviously,

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affirmance extends no further than the precise issues presented and necessarily decided by those actions. A summary disposition affirms only the judgment of the court below, and no more may be read into our action than was necessary to sustain the judgment.”<sup>554</sup> Consequently, lower court judges must examine the jurisdictional statement as well as the opinion below to determine which issues, if any, were necessarily decided by the Court.<sup>555</sup>

The jurisdictional statement on appeal in the *Bendix* case presented eleven questions grouped into four categories.<sup>556</sup> Six of the questions specifically concerned “the precise scope of authority delegated to the Congress by the patent clause of the Constitution,”<sup>557</sup> including arguments that the private law did not “promote the progress of science and useful arts”<sup>558</sup> and violated the “limited Times” requirement.<sup>559</sup> Significantly, however, it appears that none of these arguments were raised at the district court level. In the lower court, the only argument based on the Patent and Copyright Clause was Congress’ alleged failure to grant “an exclusive right,”<sup>560</sup> not an alleged violation of the “limited Times” provision. The other arguments raised below were based upon the Due Process Clause of the Fifth Amendment, not upon the Patent and Copyright

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they are not of the same precedential value as would be an opinion of this Court treating the question on the merits.”).

<sup>554</sup> Anderson, 460 U.S. at 784 n.5; *accord*, *Montana v. Crow Tribe of Indians*, 523 U.S. 696, 714 n.14 (1998); *see also* *Mandel v. Bradley*, 432 U.S. 173, 176 (1977) (per curiam) (“The District Court erred in believing that our [summary] affirmance in [a prior case] adopted the reasoning as well as the judgment of the three-judge court in that case.”).

<sup>555</sup> *See* *Mandel v. Bradley*, 432 U.S. 173, 176 (1977) (per curiam) (“Because a summary affirmance is an affirmance of the judgment only, the rationale of the affirmance may not be gleaned solely from the opinion below . . . . Summary affirmances . . . reject the specific challenges presented in the statement of jurisdiction.”); *id.* at 180 (Brennan, J., concurring) (to determine the precedential effect of a summary disposition, lower courts “must (a) examine the jurisdictional statement in the earlier case to be certain that the constitutional questions presented were the same and, if they were, (b) determine that the judgment in fact rests upon decision of those questions and not even arguably upon some alternative nonconstitutional ground.”).

<sup>556</sup> Jurisdictional Statement at 2-5, 12, *Bendix Corp. v. Radio Position Finding Corp.*, 371 U.S. 57 (1963) (No. 645). The statement presented twelve numbered questions, one of which was withdrawn in the accompanying brief. *Id.* at 12 n.9.

<sup>557</sup> *Id.* at 12.

<sup>558</sup> *Id.* at 2-3 (Questions Presented Nos. 1 and 4).

<sup>559</sup> *Id.* at 3 (Question Presented No. 3).

<sup>560</sup> *See* notes 349-352 and accompanying text. This argument was renewed on appeal. *See* Jurisdictional Statement, *supra* note 556, at 3 (Question Presented No. 5).

Clause.<sup>561</sup> Consequently, the Court might have declined to give the appeal plenary consideration because it considered the arguments based on the Patent Clause to have been waived.<sup>562</sup> The arguments based on substantive and procedural due process were renewed on appeal in the U.S. Supreme Court,<sup>563</sup> and must therefore be considered to have been rejected; but, as noted above, a summary affirmance does not necessarily affirm the reasoning of the court below. In addition, the case did not involve the extension of an existing patent, but the granting of a patent to the original inventor despite a delay of several years. Consequently, the three-judge District Court's approval of dicta from prior Circuit Court opinions cannot be considered to have received the imprimatur of the U.S. Supreme Court.

Assuming the issue is analyzed as one of first impression, how should the Court construe the phrase "for limited Times"? Textually, it should be noted that the phrase is worded in the plural form ("for limited Times" rather than "for a limited Time"); but this can easily be explained as merely granting Congress the power to prescribe different times for patents and copyrights,<sup>564</sup> to prescribe different times for different categories of "writings"<sup>565</sup> or "discoveries,"<sup>566</sup> or to allow renewal terms when authorized at the outset of the initial term.<sup>567</sup> Beyond this observation, there are three possible interpretations of the phrase. The broadest possible interpretation is that Congress is only prohibited from granting a perpetual exclusive right, but that it may grant an exclusive right (or an extension) for any finite (and therefore limited) term.<sup>568</sup> The narrowest interpretation is that whatever "limited Times" Congress chooses to bestow upon patents or copyrights, those times cannot be extended retroactively for any

<sup>561</sup> See notes 353-365 and accompanying text.

<sup>562</sup> Cf. *Tacon v. Arizona*, 410 U.S. 351, 352 (1973) (per curiam) ("Upon reviewing the record, . . . it appears that these broad questions were not raised by the petitioner below. . . . We cannot decide issues raised for the first time here.").

<sup>563</sup> Jurisdictional Statement, *supra* note 550, at 4-5 (Questions Presented Nos. 8-11).

<sup>564</sup> Compare 35 U.S.C. § 154(a)(2) (twenty-year patent term) with 17 U.S.C. § 302(a) (life-plus-seventy year copyright term).

<sup>565</sup> Compare 17 U.S.C. § 302(a) (life-plus-seventy year term for individual authors) with 17 U.S.C. § 302(c) (ninety-five years from first publication or 120 years from creation for works made for hire).

<sup>566</sup> Compare 35 U.S.C. § 154(a)(2) (twenty-year term for utility patents) with 35 U.S.C. § 173 (fourteen-year term for design patents).

<sup>567</sup> See, e.g., Copyright Act of 1790, § 1, 1 Stat. 124, 124 (1790; repealed 1831) (providing for fourteen-year initial term and fourteen-year renewal term); Patent Act of 1836, §§ 5, 18, 5 Stat. 117, 119, 124-25 (1836) (fourteen-year initial term; seven-year renewal term).

<sup>568</sup> See notes 571-574 and accompanying text.

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reason.<sup>569</sup> An intermediate position would be that Congress can extend the terms of patents and copyrights for some purposes but not for others.<sup>570</sup>

While there is widespread agreement that Congress cannot grant an exclusive right that is expressly perpetual,<sup>571</sup> the vast majority of commentators further agree that, in order to be meaningful, the phrase “for limited Times” must be interpreted to prohibit ostensibly finite terms that would, as a practical matter, amount to the same thing.<sup>572</sup> Thus, “extension of protection to a term of several hundred years would at some point present a ‘line-drawing’ problem as to what period of years is tantamount to perpetual protection.”<sup>573</sup> Likewise, if Congress were to grant twenty-year term extensions at regular intervals, at *some* point those extensions must be held to violate the Patent and Copyright Clause. Otherwise, Congress could accomplish indirectly what it is expressly prohibited from accomplishing directly.<sup>574</sup>

The narrow interpretation, by contrast, finds support in the Supreme Court’s opinion in *Graham v. John Deere Co.*,<sup>575</sup> in which the Court described the Clause as follows:

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<sup>569</sup> See notes 575-597 and accompanying text.

<sup>570</sup> See notes 598-608 and accompanying text.

<sup>571</sup> See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) (“Congress may not create patent monopolies of unlimited duration.”); *Eldred v. Reno*, 239 F.3d 372, 377 (D.C. Cir. 2001) (“If the Congress were to make copyright protection permanent, then it surely would exceed the power conferred upon it by the Copyright Clause.”); *United States v. Moghadam*, 175 F.3d 1269, 1281 (11th Cir. 1999) (“the ‘Limited Times’ requirement . . . forbids Congress from conferring intellectual property rights of perpetual duration.”); 1 NIMMER ON COPYRIGHT, *supra* note 43, § 1.05, at 1-66.13 (“A federal copyright statute that purported to grant copyright protection in perpetuity would clearly be unconstitutional.”); Patry, *Protecting the Idle Rich*, *supra* note 17, at 910 (“Any effort to grant a perpetual copyright would violate the clause.”).

<sup>572</sup> See, e.g., 1 NIMMER ON COPYRIGHT, *supra* note 43, § 1.05, at 1-66.13 (“Furthermore, it seems likely that a grant of copyright protection for what is nominally a ‘limited time’ but is in fact the equivalent of perpetual protection (e.g., a one thousand year term) would likewise be held invalid.”); Heald & Sherry, *supra* note 25, at 1172 (“Given the seriousness with which the framers viewed the granting of exclusive rights, it is unlikely that they intended the limited-time provision to be rendered a dead letter by linguistic manipulation.”).

<sup>573</sup> 1 NIMMER ON COPYRIGHT, *supra* note 43, § 1.05, at 1-66.13.

<sup>574</sup> See *Eldred v. Reno*, 239 F.3d 372, 382 (D.C. Cir. 2001) (Sentelle, J., dissenting); Peter Jaszi, *Caught in the Net of Copyright*, 75 OR. L. REV. 299, 303 (1996) (describing the CTEA as “down payment on perpetual copyright on the installment plan.”).

<sup>575</sup> 383 U.S. 1 (1966).

The clause is both a grant of power and a limitation. . . . The Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose. Nor may it enlarge the patent monopoly without regard to the innovation, advancement or social benefit gained thereby. *Moreover, Congress may not authorize the issuance of a patent whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available.* Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must ‘promote the Progress of . . . useful Arts.’ This is the standard expressed in the Constitution, and it may not be ignored.<sup>576</sup>

Construing the phrase “for limited Times” in light of this language, it seems that the proper interpretation is that whatever “limited Time” is provided, that time cannot be extended after it has expired, because to do so would be “to remove existent knowledge from the public domain.”<sup>577</sup> Under this view of the Patent and Copyright Clause, the private term extension granted to Thomas Blanchard<sup>578</sup> clearly violated the Constitution. Blanchard’s patent had already expired, and the knowledge that it disclosed had entered the public domain.<sup>579</sup> This view would also invalidate the patent extensions granted to Oliver Evans,<sup>580</sup> John Goulding<sup>581</sup> and William Graham,<sup>582</sup> effectively undermining all but one of the nineteenth-century precedents upholding patent term extension.<sup>583</sup> With one exception, Congress itself appears to have acquiesced in this view in recent years.<sup>584</sup> Thus, if *Graham* correctly expresses the Supreme Court’s view

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<sup>576</sup> *Id.* at 5-6 (emphasis added). The Court immediately added that “Within the limits of the constitutional grant, the Congress may, of course, implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim.” *Id.* at 6. This observation begs the question as to just what “the limits of the constitutional grant” are.

<sup>577</sup> *Id.* at 6.

<sup>578</sup> See notes 288-296 and accompanying text.

<sup>579</sup> See *Bonito Boats, Inc. v. Thunder Craft, Inc.*, 489 U.S. 141, 152 (1989) (“We have long held that after the expiration of a federal patent, the subject matter of the patent passes to the free use of the public as a matter of federal law.”).

<sup>580</sup> See notes 235-284 and accompanying text.

<sup>581</sup> See notes 305-311 and accompanying text.

<sup>582</sup> See notes 312-321 and accompanying text.

<sup>583</sup> The sole remaining exception is the patent of William Woodworth, discussed at notes 297-304 and accompanying text.

<sup>584</sup> From 1962 until 1976, Congress repeatedly extended the terms of existing copyrights on an ostensibly “interim” basis, so that those copyrights would be able to receive the benefit of the extension made in the 1976 Act. See

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of the Patent and Copyright Clause (as it must be presumed to do),<sup>585</sup> the only remaining question is whether Congress has the power to extend a patent (or a copyright) *before* it has expired.

The Supreme Court has made it clear that an author or inventor does not have a natural right to his or her invention or work of authorship once it is disclosed to the public.<sup>586</sup> In *Graham*, the Court reviewed Thomas Jefferson's views concerning monopolies<sup>587</sup> and inferred from them the following principle:

The patent monopoly was not designed to secure to the inventor his natural right in his discoveries. Rather, it was a reward, an inducement, to bring forth new knowledge. The grant of an exclusive right to an invention was the creation of society—at odds with the inherent free nature of disclosed ideas—and was not to be freely given. Only inventions and discoveries which furthered human knowledge, and were new and useful, justified the special inducement of a limited, private monopoly.<sup>588</sup>

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notes 116-133 and accompanying text. This action would have been unnecessary had Congress believed it had the power to revive expired copyrights. Likewise, the CTEA did not attempt to extend copyrights which had already entered the public domain. *See* note 154, *supra*. Finally, during the patent term extension debates in the 1980s and 1990s, Congress was careful to extend only patents which had not yet expired. The one exception was the drug Oxaprozín, which received a two-year period of “marketing exclusivity” after its patent had expired. *See* notes 368-448 and accompanying text.

It should be noted that Congress has also renewed several expired design patents on the insignia of service organizations; however, as explained above, those renewals are more properly viewed as private trademark legislation rather than as patent term extension. *See* notes 449-532 and accompanying text.

<sup>585</sup> In recent years, the Court has repeatedly emphasized that the Patent and Copyright Clause limits the manner in which Congress may act. *See, e.g.,* *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991) (“Originality is a constitutional requirement.”); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) (“the [Patent] Clause contains both a grant of power and certain limitations upon the exercise of that power.”).

<sup>586</sup> *See* *Wheaton v. Peters*, 33 U.S. 591, 654-61 (1834).

<sup>587</sup> The Court explained: “Because of his active interest and influence in the early development of the patent system, Jefferson's views on the general nature of the limited patent monopoly under the Constitution . . . are worthy of note.” 383 U.S. at 7. For a different view of Jefferson's contributions, see Edward C. Walterscheid, *The Use and Abuse of History: The Supreme Court's Interpretation of Thomas Jefferson's Influence on the Patent Law*, 39 IDEA J.L. & TECH. 195 (1999); Edward C. Walterscheid, *Patents and the Jeffersonian Mythology*, 29 J. MARSHALL L. REV. 269 (1995).

<sup>588</sup> *Id.* at 9; *see also* *Feist*, 499 U.S. at 346 (“Originality is a constitutional requirement.”).

This view follows from the fact that, under the Clause, patents and copyrights may be granted only “[t]o promote the Progress of Science and useful Arts.”<sup>589</sup> Elsewhere, the Court has explained that “[a]s employed, the terms ‘to promote’ are synonymous with the words ‘to stimulate,’ ‘to encourage,’ or ‘to induce.’”<sup>590</sup> A retroactive term extension, however, does not stimulate, encourage or induce anyone to produce anything new.<sup>591</sup> Instead, it merely serves to grant an additional reward to an author or inventor (or his or her heirs or assigns) after the fact, for having produced something valuable in the past.<sup>592</sup> In general, therefore, the extension of existing patents and copyrights violates the principles underlying the Patent and Copyright Clause, as expressed in *Graham*, even if the extension is granted before the initial term has expired.<sup>593</sup> Construing the phrase “for limited Times” to forbid retroactive extension therefore vindicates the incentive rationale embodied in the Patent and Copyright Clause.

Construing the phrase “for limited Times” to forbid retroactive extensions also serves the purposes of the Clause in other ways. One of the important purposes of the Patent and Copyright Clause is to limit the imposition of monopoly-like costs upon the public;<sup>594</sup> another is to ensure that there is a rich public domain of materials available for future authors and inventors to borrow from and build upon in fashioning new works and

<sup>589</sup> U.S. CONST. art. I, § 8, cl. 8; *see also Feist*, 499 U.S. at 349 (“The primary objective of copyright is not to reward the labor of authors, but ‘[t]o promote the Progress of Science and useful Arts.’”).

<sup>590</sup> *Goldstein v. California*, 412 U.S. 546, 555 (1973).

<sup>591</sup> *See Heald & Sherry*, *supra* note 25, at 1169 (“The retroactive extension of the copyright term cannot possibly provide any incentive for Gershwin — or even a living author — to create an already existing work.”). Even a proponent of strong intellectual property protection who believes that intellectual property is “under strenuous attack” agrees. *See Doris Estelle Long, First, “Let’s Kill All the Intellectual Property Lawyers!”: Musings on the Decline and Fall of the Intellectual Property Empire*, 34 J. MARSHALL L. REV. 851, 867 (2001) (“it is difficult to see how an extra twenty years of protection after the author’s death incentivizes creation. In the absence of such incentivization, the harm to the public domain by removing these works for additional periods of time seems unjustified.”) (emphasis in original).

<sup>592</sup> *See Heald & Sherry*, *supra* note 25, at 1170 (“Although it is entirely possible that the recipient of the income stream will do something beneficial with their extra profit, this possibility is as irrelevant now as it was in 1623 and 1709. Congress must buy American citizens something when it imposes monopoly-like costs upon them.”).

<sup>593</sup> *Id.* at 1169 (“It would be difficult to imagine a more overt violation of the Quid Pro Quo principle than [the] CTEA.”).

<sup>594</sup> *Id.* at 1154-55 (“the notion of limiting the term of protection was likely one mechanism by which the framer sought to minimize monopoly costs and assure the valuable inventions and writings would inevitably belong to the public.”); *id.* at 1160-62.



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inventions.<sup>595</sup> Placing copyrighted works in the public domain at the end of a specified period of time serves both of these purposes. If the phrase “for limited Times” is construed to allow repeated extensions, the public will continue to suffer monopoly costs without obtaining anything new, and the public domain will not be replenished with a steady stream of new works, allowing it to become stagnant.<sup>596</sup>

The narrow interpretation also avoids entangling the courts in the inherently arbitrary line-drawing question of whether a particular term does or does not “Promote the Progress of Science and useful Arts.”<sup>597</sup> Instead, it provides a non-arbitrary bright-line rule: whatever term is selected by Congress, it cannot be extended retroactively. Such a rule would reduce the incentive for existing patent and copyright owners to besiege Congress with self-serving requests for term extension, since they would not receive any benefit from such an extension until years after the legislation had passed.

The intermediate view requires a careful examination of the various circumstances which prompted Congress to act by means of private legislation, to determine if the extensions which have been upheld share any characteristics which distinguish them from term extension generally.<sup>598</sup> It appears that in most instances, Congress acted to restore to the inventor

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<sup>595</sup> *Id.* at 1165-66; L. RAY PATTERSON & STANLEY W. LINDBERG, *THE NATURE OF COPYRIGHT: A LAW OF USER'S RIGHTS* 50-51 (1991); Jessica Litman, *The Public Domain*, 39 *EMORY L.J.* 965, 968 (1990); *see also* *Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141, 151 (1989) (“The ultimate goal of the patent system is to bring new designs and technology into the public domain”).

<sup>596</sup> Under the 1909 Act, all works published before 1922 would have entered the public domain on or before Jan. 1, 1978, the effective date of the 1976 Act. Since that time, due to copyright extensions, only one additional year of copyrighted works (works first published in 1922) has entered the public domain; and under the CTEA, no published works will enter the public domain for the next eighteen years.

<sup>597</sup> Opponents of term extension argue that the CTEA does not “Promote the Progress of Science” because the present value of an additional twenty years at the end of a seventy-five year term (or a life-plus-fifty-year term) is essentially zero. *See* Affidavit of Hal R. Varian, *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999), *available at* <http://cyber.law.harvard.edu/eldredvreno/varian.pdf> (last visited Nov. 30, 2001) (noting that the total present value of \$1 per year in years 76-95 is 1 cent). While persuasive, such evidence raises the difficult question of where a court (as opposed to a legislature) should draw the line: how large must the marginal incentive to authors be in order to make a given term extension constitutional?

<sup>598</sup> *Cf.* Heald & Sherry, *supra* note 25, at 1152 (“there are circumstances suggesting that these patent extensions were consistent with a limiting purpose of promoting innovation.”). For a similar proposal, see *Merges & Reynolds*, *supra* note 25, at 64-68.

some period of time which he or she had expected to receive under existing law, but which had been lost due to circumstances beyond the inventor's control. This was the case with Oliver Evans (administrative error),<sup>599</sup> Louis Aronson (judicial corruption),<sup>600</sup> William Blair (war),<sup>601</sup> and all of the pharmaceutical patent term extensions of the late twentieth century (delay in FDA approval).<sup>602</sup> While Congress may have, in some cases, gone beyond what was necessary to compensate the patent owner,<sup>603</sup> in each case its intention was to vindicate the patent owner's expectation interest, rather than to grant the patent owner an additional subsidy.<sup>604</sup> Only during the period between 1844 and 1879 did Congress take the position that a patent owner was entitled to "adequate compensation" for his or her invention, instead of merely the opportunity to earn such compensation during the term originally granted;<sup>605</sup> and that period can be explained as a historical aberration which has subsequently been repudiated by Congress.

Under the intermediate view, therefore, the patent term extension cases discussed above stand for the proposition that the principles underlying the Patent and Copyright Clause are not violated by a statute whose purpose and effect is to ensure that an author or inventor receives the benefit of his or her bargain. If an author or inventor relied upon the existing term, but did not receive the benefit of the full term for reasons beyond his or her control, then Congress may constitutionally extend the exclusive right (before its expiration)<sup>606</sup> to compensate the author or in-

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<sup>599</sup> See notes 249-259 and accompanying text.

<sup>600</sup> See notes 329-339 and accompanying text.

<sup>601</sup> See notes 340-346 and accompanying text.

<sup>602</sup> See notes 368-417 and accompanying text.

<sup>603</sup> See notes 215-216 & 260 and accompanying text.

<sup>604</sup> Cf. Heald & Sherry, *supra* note 25, at 1162-63 & 1171-72 (arguing that under the Intellectual Property Clause, any grant of exclusive rights must be in the form of quid pro quo, rather than in the form of gift-plus-hope).

<sup>605</sup> See Benagh, *supra* note 286, at 8-9; *id.* at 11 ("There was a period in the mid-nineteenth century when the Congress attempted to assure adequate compensation to every inventor with the device of private legislation, but the concept of guaranteed income proved to be too time-consuming and open to frivolous claims.").

<sup>606</sup> This view leaves open the question of whether Congress may constitutionally revive an exclusive right that has already expired. That question is not presented by the CTEA, which expressly applies only to copyrights which have not yet entered the public domain. However, even if all such revivals are prohibited, Congress may use direct subsidies to compensate authors or inventors who may not have received the benefit of their bargain. See note 608 and accompanying text.

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ventor for the lost time.<sup>607</sup> Otherwise, Congress is without power to extend an exclusive right under the Patent and Copyright Clause.

Two additional points concerning the intermediate view must be emphasized. First, the bargain which the author or inventor accepted was the *opportunity* to earn money by exploiting his or her exclusive right for a limited period of time, not the *guarantee* that he or she would profit financially during that time. Thus, Congress cannot constitutionally extend patents or copyrights merely by asserting that circumstances have changed. For example, while it is certainly true that digital technologies and international markets present both new opportunities and new challenges to copyright owners, those changes have not deprived copyright owners of the benefit of their bargain, because those changes have not prevented copyright owners from earning money through licensing of their copyrighted works. If the owner of an exclusive right was able to receive royalties during the entire period of time promised to him or her by Congress, then Congress cannot extend that period retroactively. Only if the owner was actually prevented from exploiting his or her work for a period of time, for reasons comparable to those which prompted Congress to act in previous cases, may Congress act to extend the limited time by a comparable period.

Second, placing limits on the ability of Congress to extend patents and copyrights does not leave Congress entirely without recourse. It may, if it wishes, grant a direct subsidy to an author or inventor; but it may not do so indirectly by reviving or extending his or her exclusive right, except in the limited circumstances described above. This limitation therefore helps ensure political accountability by ensuring that such subsidies are debated openly, rather than disguised in the form of patent or copyright term extensions.<sup>608</sup>

#### IV. ELDRED V. RENO

##### A. *District Court Opinion*

Shortly after the CTEA was enacted, a lawsuit was filed in the District of Columbia to enjoin the Attorney General from enforcing criminal copyright penalties with respect to works that otherwise would have en-

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<sup>607</sup> See Merges & Reynolds, *supra* note 25, at 65 (“where extensions are based on some specific and identifiable government error . . . they are less suspect than they would be if based on other considerations.”). Under this view, all of the private term extensions granted to utility patents in the twentieth century would be valid, with the possible exception of the two-year period of “market exclusivity” granted to the patentee of Oxaprozin.

<sup>608</sup> This point is made and explained in greater detail in Heald & Sherry, *supra* note 25, at 1174-75.

tered the public domain.<sup>609</sup> The lawsuit was filed by Eric Eldred, an individual who publishes public domain works on the Internet under the name Eldritch Press.<sup>610</sup> Eldred was later joined by nine other plaintiffs who regularly publish or use public domain works.<sup>611</sup> The Second Amended Complaint alleged three theories under which the CTEA was unconstitutional: that it violated the Patent and Copyright Clause of the Constitution;<sup>612</sup> that it violated the the First Amendment;<sup>613</sup> and that it violated the Public Trust Doctrine.<sup>614</sup>

The district court summarily rejected all three theories.<sup>615</sup> With regard to the Patent and Copyright Clause, the court relied upon dicta from two U.S. Supreme Court cases: *Pennock & Sellers v. Dialogue*<sup>616</sup> and *McClurg v. Kingsland*.<sup>617</sup> First, it quoted from Justice Story's opinion for the Court in *Pennock*, in which he stated:

The constitution of the United States . . . contemplates, therefore, that this exclusive right shall exist but for a limited period,

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<sup>609</sup> Complaint, *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999), available at [http://cyber.law.harvard.edu/eldredvreno/complaint\\_orig.html](http://cyber.law.harvard.edu/eldredvreno/complaint_orig.html) (last visited Oct. 31, 2001). As amended by the No Electronic Theft Act, Pub. L. No. 105-147, 111 Stat. 2678 (1997), the Copyright Act provides criminal penalties for making or distributing copies having a total retail value of more than \$1000. 17 U.S.C. § 506(a)(2) (2000). If the copies have a total retail value of more than \$2500, penalties can include up to five years' imprisonment, and up to ten years' imprisonment for subsequent offenses. 18 U.S.C. § 2319(b) (2000).

<sup>610</sup> <http://eldritchpress.org> (last visited Oct. 31, 2001).

<sup>611</sup> The nine included three publishers: Dover Publications, Inc., Higginson Book Co. (genealogy & history), and Tri-Horn International (golf); three users of public domain sheet music: Jill A. Crandall (church choir director), Luck's Music Library (retailer) and Edwin F. Kalmus & Co. (publisher); two users of public domain movies: American Film Heritage Association (non-profit association devoted to film preservation) and Moviecraft, Inc. (commercial film archive); and Copyright's Commons, a non-profit public domain advocacy organization based at Harvard's Berkman Center for Internet & Society. See Second Amended Complaint, *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999), available at [http://cyber.law.harvard.edu/eldredvreno/complaint\\_amd2.html](http://cyber.law.harvard.edu/eldredvreno/complaint_amd2.html) (last visited Oct. 31, 2001).

<sup>612</sup> *Id.* at 11-14 (Count One); see U.S. CONST. art. I, § 8, cl. 8. The complaint specifically alleged both that retroactive extensions violated the "limited Times" provision and that they did not "promote the progress of science and useful arts." Second Amended Complaint at 13.

<sup>613</sup> *Id.* at 15 (Count Three).

<sup>614</sup> Second Amended Complaint at 14-15 (Count Two).

<sup>615</sup> See *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999), *aff'd*, 239 F.3d 372 (D.C. Cir. 2001), *petition for reh'g and reh'g en banc denied sub nom.*, *Eldred v. Ashcroft*, 255 F.3d 849 (D.C. Cir. 2001).

<sup>616</sup> 27 U.S. 1 (1829).

<sup>617</sup> 42 U.S. 202 (1843).

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and that the period shall be subject to the discretion of congress.<sup>618</sup>

This statement is dicta as applied to term extension. In *Pennock*, the Court held that a patent was invalid if the invention had been known or used by the public prior to the application.<sup>619</sup> In so holding, the Court emphasized both the incentive and public domain rationales underlying the Clause,<sup>620</sup> and it specifically held that “it would materially retard the progress of science and useful arts” if an inventor could retain a monopoly for a period of years before applying for a patent.<sup>621</sup> Thus, although the dicta supports a broad reading of Congress’ power under the Patent Clause, the opinion as a whole seems to support a narrower interpretation of that Clause.

The district court then cited *McClurg* for the proposition that “Congress has authority to enact retrospective laws under the copyright clause.”<sup>622</sup> *McClurg* involved the question whether an 1839 amendment to the Patent Act could be applied retroactively to a patent issued in 1835. The Court stated:

Whether the exceptions are well taken or not, must depend on the law as it stood at the emanation of the patent, together with such changes as have been since made; for though they may be retrospective in their operation, that is not a sound objection to their validity; the powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution, and as there are no restraints on its exercise, there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents.<sup>623</sup>

The Court explained that under *Pennock*, any public use of the invention prior to the date of the patent application would have invalidated the patent.<sup>624</sup> The amendment in question enacted a two-year grace period for applying for a patent, and immunized from liability any person who had

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<sup>618</sup> 27 U.S. at 16-17; see 74 F. Supp. 2d at 3.

<sup>619</sup> 27 U.S. at 18-19.

<sup>620</sup> *Id.* at 19 (“While one great object was, by holding out a reasonable reward to inventors, and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius; the main object was ‘to promote the progress of science and useful arts;’ and this could be done best, by giving the public at large a right to make, construct, use, and vend the thing invented, at as early a period as possible.”).

<sup>621</sup> *Id.*

<sup>622</sup> 74 F. Supp. 2d at 3 (citing *McClurg v. Kingsland*, 42 U.S. 202, 206 (1843)).

<sup>623</sup> 42 U.S. at 206.

<sup>624</sup> *Id.* at 207 (“On this construction of the acts of 1793 and 1800, Harley’s patent would have been void.”).

purchased or used the newly-invented machine prior to the date of the patent application.<sup>625</sup> In upholding the amendment, the court held only that it did not leave either party any worse off than they would have been under the former law.<sup>626</sup> The case did not present any question of the extension of an existing patent, or the reduction of the public domain. As applied to term extension, therefore, the passage quoted is once again dicta. Moreover, the premise of the quote, that “there are no restraints on [Congress’] exercise” of power under the Patent and Copyright Clause, has been rejected by the U.S. Supreme Court in later years.<sup>627</sup> *McClurg*, therefore, does not support the broad reading given to it by the district court.

Two additional statements by the district court indicate its approval of the broadest possible interpretation of Congress’ power. The district court stated that “the introductory language of the copyright clause does not limit” Congress’ power.<sup>628</sup> This statement is inconsistent with the Supreme Court’s view of the Clause, as expressed in *Graham v. John Deere Co.* and other cases.<sup>629</sup> The district court also stated “[w]ithin the discretion of Congress, any fixed term is a limited time because it is not perpetual. If a limited time is extended for a limited time then it remains a limited time.”<sup>630</sup> Under this view, any period short of an expressly perpetual term would be constitutional.

With regard to the First Amendment, plaintiffs argued that copyright is a content-neutral speech restriction that is subject to intermediate scrutiny.<sup>631</sup> It attempted to distinguish previous cases which held that the First Amendment was not a defense to copyright infringement. For example, in *Harper & Row Publishers, Inc. v. Nation Enterprises*,<sup>632</sup> the U.S. Supreme

<sup>625</sup> *Id.* at 208 (citing Patent Act of 1839, § 7, 5 Stat. 353, 354 (1839)).

<sup>626</sup> *Id.* at 209 (“This [amendment] relieved [plaintiff] from the effects of former laws and their constructions by this court . . . while it puts the person who has had such prior use on the same footing as if he had a special license from the inventor to use his invention; which . . . would justify the continued use after it issued without liability.”).

<sup>627</sup> See notes 575-585 and accompanying text.

<sup>628</sup> 74 F. Supp. 2d at 3 n.6 (citing *Schnapper v. Foley*, 667 F.2d 102, 112 (D.C. Cir. 1981)).

<sup>629</sup> See notes 575-585 and accompanying text.

<sup>630</sup> 74 F. Supp. 2d at 3 n.7.

<sup>631</sup> Memorandum in Support of Plaintiff’s Motion for Judgment on the Pleadings at 32-35, *Eldred v. Reno*, 74 F. Supp. 2d 1 (D.D.C. 1999) [hereinafter Plaintiff’s Memorandum], available at <http://cyber.law.harvard.edu/eldredvreno/legaldocs.html> (last visited Oct. 31, 2001). See *Turner Broad. Sys., Inc. v. Federal Communications Comm’n*, 520 U.S. 180, 189 (1997); Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1 (2001).

<sup>632</sup> 471 U.S. 539 (1985).

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Court held that First Amendment considerations were adequately reflected in existing substantive limitations on copyright, including the idea/expression dichotomy and the fair use doctrine.<sup>633</sup> As the plaintiffs pointed out, however, those cases involved copyrights which were conceded to be valid; whereas term extension involves the threshold issue of whether the copyright was validly extended in the first place.<sup>634</sup> In other words, while the First Amendment interest in reproducing someone else's words remains high over time, the countervailing governmental interest in restricting such copying does not.<sup>635</sup> The district court rejected this argument, holding flatly that "there are no First Amendment rights to use the copyrighted works of others."<sup>636</sup>

With regard to the Public Trust Doctrine, the plaintiffs in *Eldred v. Reno* argued that the granting of a copyright for a period of years "vest[s] in the public a future remainder interest in the right to use the copyrighted work";<sup>637</sup> and that this future interest is public property, which cannot be transferred to a private entity "when the primary purpose of the legislative grant is to benefit a private interest."<sup>638</sup> An assessment of this argument requires an examination of the origins and legal basis of the Public Trust Doctrine.

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<sup>633</sup> 471 U.S. at 560. In so holding, the court relied in part on an influential article by Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180 (1970). In response, Neil Netanel has argued that while "Nimmer's conclusions may have been plausible in 1970, . . . courts have largely ignored subsequent developments in both copyright law and First Amendment doctrine." Netanel, *supra* note 631, at 4.

<sup>634</sup> Plaintiff's Memorandum, *supra* note 631, at 47-48. It is worth noting that Nimmer was of the opinion that retroactive term extension violated the First Amendment. Nimmer, *supra* note 633, at 1195; see 1 NIMMER ON COPYRIGHT, *supra* note 43, § 1.10[C][1], at 1-83.

<sup>635</sup> Restricting copying for a limited period of time encourages creation by allowing the author to earn royalties. But the decision to create a new work is made based on the term of copyright that exists at the time of creation. While prospective term extension may encourage more works to be created in the future, retroactive term extension cannot increase the supply of existing works.

<sup>636</sup> 74 F. Supp. 2d at 3 (citing *United Video, Inc. v. Federal Communications Comm'n*, 890 F.2d 1173, 1191 (D.C. Cir. 1989)).

<sup>637</sup> Plaintiff's Memorandum, *supra* note 631, at 53. See also *Merges & Reynolds*, *supra* note 25, at 62-63.

<sup>638</sup> Plaintiff's Memorandum, *supra* note 631, at 56 (quoting *Lake Michigan Fed'n v. United States Army Corps of Eng'rs*, 742 F. Supp. 441, 445 (N.D. Ill. 1990)). See also Maureen Ryan, *Cyberspace as Public Space: A Public Trust Paradigm for Copyright in a Digital World*, 79 OR. L. REV. 647, 704-19 (2000).

In *Illinois Central Railroad Co. v. Illinois*,<sup>639</sup> the U.S. Supreme Court invalidated an Illinois statute conveying submerged lands underlying Lake Michigan to the Illinois Central Railroad. The Court held that navigable waters were public property, “held in trust for the people of the state”;<sup>640</sup> and that such property “cannot be alienated except . . . when parcels can be disposed of without detriment to the public interest.”<sup>641</sup> The Court stated:

The state can no more abdicate its trust over property in which the whole people are interested, like navigable waters and soils under them, so as to leave them entirely under the use and control of private parties, except . . . when parcels can be disposed of without impairment of the public interest in what remains, than it can abdicate its police powers in the administration of government and the preservation of peace. . . . So with trusts connected with public property, or property of a special character, like lands under navigable waters; they cannot be placed entirely beyond the direction and control of the state.<sup>642</sup>

There are several difficulties in extending the Public Trust Doctrine announced in *Illinois Central* to the right to use works scheduled to enter the public domain upon the expiration of a copyright. First, the Public Trust Doctrine was developed in the context of navigable waters.<sup>643</sup> While in some instances the doctrine has been extended to other public lands and natural resources,<sup>644</sup> it has not previously been extended to intangible property.<sup>645</sup> The argument that it can be so extended is based on the fact

<sup>639</sup> 146 U.S. 387 (1892).

<sup>640</sup> *Id.* at 452.

<sup>641</sup> *Id.* at 455-56.

<sup>642</sup> *Id.* at 453.

<sup>643</sup> *Id.* at 452 (“That the state holds the title to the lands under the navigable waters of Lake Michigan, within its limits, in the same manner that the state holds title to soils under tide water, by the common law, we have already shown;. . . . It is a title held in trust for the people of the state.”); *but see* *Phillips Petroleum Co. v. Mississippi*, 484 U.S. 469, 476-80 (1988) (public trust doctrine extends to non-navigable tidal waters as well as to navigable waters).

<sup>644</sup> *See* Richard J. Lazarus, *Changing Conceptions of Property and Sovereignty in Natural Resources: Questioning the Public Trust Doctrine*, 71 IOWA L. REV. 631, 649-50 (1986) (“the trust doctrine has steadily emerged from the watery depths to embrace the dry sand area of a beach, rural parklands, a historic battlefield, wildlife, archeological remains, and even a downtown area.”) (citing cases); *see also* Ryan, *supra* note 638, at 697-99.

<sup>645</sup> Perhaps the closest analogy is the electromagnetic spectrum of broadcast frequencies, which has been characterized by Congress as a “public trust” obligating broadcast licensees to operate in the public interest. *See Red Lion Broad. Co. v. Federal Communications Comm’n*, 395 U.S. 367, 383 (1969)



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that the language used by the U.S. Supreme Court in *Illinois Central* is illustrative rather than exclusive;<sup>646</sup> but this fact, by itself, says little about where the line should be drawn. Second, while the Public Trust Doctrine has historically been applied to the states, it is unclear whether it also applies to the federal government.<sup>647</sup> Third, while the legal basis of the Public Trust Doctrine is somewhat unclear, plaintiffs argued that it is an interpretation of the Due Process Clause of the Fifth Amendment.<sup>648</sup> Arguably, both the Fifth and Fourteenth Amendments apply to takings of public property for private purposes, as well as takings of private property for public purposes.<sup>649</sup> But to the extent that the Public Trust Doctrine is based on the Due Process Clause, it runs into the Supreme Court's summary affirmance in *Radio Position Finding Corp. v. Bendix Corp.*<sup>650</sup> The three-judge district court in that case specifically held that the public did *not* acquire a vested right in an invention in the public domain that was protected by the Fifth Amendment;<sup>651</sup> and the question was specifically presented to and rejected by the U.S. Supreme Court on appeal (albeit in a summary disposition).<sup>652</sup> However, while this summary affirmance may

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(quoting S. REP. NO. 86-562, at 8-9 (1959)), *reprinted at* 1959 U.S.C.C.A.N. 2571.

<sup>646</sup> 146 U.S. at 453 (“property in which the whole people are interested, *like* navigable waters and soils under them”) (emphasis added); *id.* at 454 (“trusts connected with public property, or property of a special character, *like* lands under navigable waters”) (emphasis added).

<sup>647</sup> *Compare* United States v. 1.58 Acres of Land, 523 F. Supp. 120 (D. Mass. 1981) (public trust doctrine applies to the federal government); *In re Steuart Transportation Co.*, 495 F. Supp. 38, 40 (E.D. Va. 1980) (same) *with* District of Columbia v. Air Florida, Inc., 750 F.2d 1077, 1083 (D.C. Cir. 1984) (declining to address the issue).

<sup>648</sup> Plaintiff's Memorandum, *supra* note 631, at 59-60 (citing Richard A. Epstein, *The Public Trust Doctrine*, 7 CATO J. 411, 426-27 (1987)); *see* U.S. CONST. amend. V.

<sup>649</sup> Epstein, *supra* note 648, at 426 (“The public trust doctrine is the mirror image of the eminent domain clause. Both are designed to place limitations upon the power of legislature to divert property, whether held privately or in common. . . . In principle the public trust doctrine should operate at the constitutional level, as a parallel to the eminent domain clause.”). Of course, the Fifth Amendment contains an express “takings” or eminent domain clause, whereas the Fourteenth Amendment does not; but the U.S. Supreme Court has held that the Due Process Clause of the Fourteenth Amendment includes protection against takings of private property. *See* Chicago, Burlington & Quincy R.R. Co. v. Chicago, 166 U.S. 226, 236 (1897).

<sup>650</sup> 205 F. Supp. 850 (D. Md. 1962), *aff'd mem.*, 371 U.S. 577 (1963).

<sup>651</sup> *See* notes 353-361 and accompanying text.

<sup>652</sup> *See* Jurisdictional Statement at 5, *Bendix Corp. v. Radio Position Finding Corp.*, 371 U.S. 57 (1963) (No. 645) (Question Presented No. 11: “Does the expiration of the limitation period contained in 35 U.S.C. § 102 . . . create a

be binding on lower courts,<sup>653</sup> it would not be an obstacle to the U.S. Supreme Court's reconsideration of the issue, which was never fully argued.<sup>654</sup> While none of these three problems is insurmountable, it would take a court of extraordinary courage and vision to bridge all three gaps in a single bound. It is therefore unsurprising that the district court summarily rejected this argument, holding simply that "the public trust doctrine applies to navigable waterways, not copyrights."<sup>655</sup> The plaintiffs chose not to appeal this portion of the ruling.<sup>656</sup>

### B. Court of Appeals Opinion

On appeal, the D.C. Circuit held 2-1 that neither the First Amendment nor the Copyright Clause "constrains the Congress from extending for a period of years the duration of copyrights."<sup>657</sup> First, it held that under the Supreme Court's opinion in *Harper & Row*<sup>658</sup> and the D.C. Circuit's own opinion in *United Video, Inc. v. Federal Communications Commission*,<sup>659</sup> "copyrights are categorically immune from challenges under the First Amendment."<sup>660</sup> Next, the court rejected the new argument that the "originality" requirement of the Copyright Clause<sup>661</sup> prohibited retroactive term extension, distinguishing "between a new grant of copyright — as to which originality is an issue — and the extension of an existing grant."<sup>662</sup> With respect to the latter, the court stated succinctly: "[a] work with a subsisting copyright has already satisfied the requirement of originality and need not do so anew for its copyright to persist."<sup>663</sup> In so hold-

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substantive right in the public such that the statutory limitation period cannot be waived without violation of Fifth Amendment Due Process?"); *see also id.* at 4-5 (Questions Presented Nos. 9-10, based on "the Fifth Amendment requirements of substantive and procedural due process").

<sup>653</sup> See notes 548-563 and accompanying text.

<sup>654</sup> See STERN, GRESSMAN, ET AL., *supra* note 550, at § 4.28.

<sup>655</sup> 74 F. Supp. 2d at 4.

<sup>656</sup> Appellant's Opening Brief, *Eldred v. Reno*, 239 F.3d 372 (D.C. Cir. 2001) (No. 99-5430), available at <http://eon.law.harvard.edu/openlaw/eldredvreno/appealbrief.html> (last visited Oct. 31, 2001).

<sup>657</sup> 239 F.3d at 373. On appeal, plaintiffs abandoned their argument based on the Public Trust Doctrine, while adding an argument that copyright term extension violated the originality requirement of the Copyright Clause as well as the "limited Times" provision and the First Amendment. Appellant's Opening Brief, *Eldred v. Reno*, 239 F.3d 372 (D.C. Cir. 2001) (No. 99-5430), available at <http://eon.law.harvard.edu/openlaw/eldredvreno/appealbrief.html> (last visited Oct. 31, 2001).

<sup>658</sup> See notes 632-633 and accompanying text.

<sup>659</sup> 890 F.2d 1173 (1989).

<sup>660</sup> *Eldred v. Reno*, 239 F.3d at 375.

<sup>661</sup> See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345-46 (1991).

<sup>662</sup> 239 F.3d at 377.

<sup>663</sup> *Id.*

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ing, however, the court did recognize that *Graham v. John Deere Co.*<sup>664</sup> “would indeed preclude Congress from authorizing . . . a copyright to a work already in the public domain.”<sup>665</sup> Thus, the court drew a distinction between extensions of copyright prior to their expiration (which it held permissible) and revivals of expired copyrights (which, by negative implication, might be unconstitutional).

Finally, the court addressed the Constitutional requirement that copyrights be issued only “for limited Times.” The Court expressly recognized that a perpetual copyright would violate the “limited Times” provision,<sup>666</sup> but it rejected the argument that the Copyright Clause placed any further restriction on the power of Congress. It noted that in *Schnapper v. Foley*,<sup>667</sup> the D.C. Circuit stated “[w]e cannot accept appellant’s argument that the introductory language of the Copyright Clause constitutes a limit on congressional power,”<sup>668</sup> and it therefore declined to interpret the “limited Times” provision in accordance with the preamble.<sup>669</sup> The problem with this reasoning, as Edward Walterscheid has argued, is that it rewrites the language of the Constitution to read that Congress shall have power “to secure for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>670</sup> That is not what the Clause says; it says that Congress has power “to promote the progress of science and useful arts,” and then it prescribes the means by which that power may be exercised. To interpret the “limited Times” restriction to permit term extensions that do not promote progress would violate the very terms of the constitutional grant.<sup>671</sup>

Unfortunately, this argument (that the “limited Times” provision must be interpreted in the light of the preamble to the Copyright Clause) was sidetracked in the Court of Appeals by a contentious procedural argument, precipitated by an apparent (in hindsight) strategic error. Plaintiffs were aware of the D.C. Circuit’s language in *Schnapper v. Foley*, and they tried to avoid it by claiming in their brief they were not questioning its correctness. As the Court characterized the plaintiff’s argument:

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<sup>664</sup> 383 U.S. 1 (1966). See notes 575-585 and accompanying text.

<sup>665</sup> 239 F.3d at 377.

<sup>666</sup> *Id.*

<sup>667</sup> 667 F.2d 102 (D.C. Cir. 1981).

<sup>668</sup> *Id.* at 112.

<sup>669</sup> 239 F.3d at 378.

<sup>670</sup> Walterscheid, *Term Limits*, *supra* note 25, at 392-93.

<sup>671</sup> See *Eldred v. Ashcroft*, 255 F.3d 849, 855 (D.C. Cir. 2001) (Sentelle, J., joined by Tatel, J., dissenting from denial of rehearing en banc) (“This interpretation of *Schnapper* erases from Article I half of the Copyright Clause — indeed, that half which defines the very power bestowed.”).

The plaintiffs, however, disclaim any purpose to question the holding of *Schnapper*; indeed, they expressly acknowledge “that the preamble of the Copyright Clause is not a substantive limit on Congress’ legislative power.” Their argument is simply that “the Supreme Court has interpreted the terms ‘Authors’ and ‘Writings’ in light of that preamble, and that this court should do the same with ‘limited Times.’”

The problems with this argument are manifest. . . . [O]ne cannot concede that the preamble “is not a substantive limit” and yet maintain that it limits the permissible duration of a copyright more strictly than does the textual requirement that it be for a “limited Time.”<sup>672</sup>

By trying to avoid the language in *Schnapper* rather than challenging it directly, the plaintiffs wrote themselves into a logical corner. This could have been considered harmless error, because an amicus brief submitted by the Eagle Forum Education and Legal Defense Fund expressly argued that this language from *Schnapper* was dictum.<sup>673</sup> But the majority maintained that it should not consider the argument made by the amicus, saying “that argument is rejected by the actual parties to this case and therefore is not properly before us.”<sup>674</sup> Thus, what should have been a debate about the substantive limits imposed by the Copyright Clause turned into an argument about the proper scope and function of an amicus brief and a factual dispute over whether the amicus’ argument had been adopted by the plaintiffs.<sup>675</sup> The majority stated that an amicus brief “cannot exceed the scope of appeal to implicate issues that have not been presented by the parties to the appeal”;<sup>676</sup> while the dissent maintained that there is a “difference between introducing issues not raised by the parties on the one hand and making new arguments for issues otherwise properly raised on the other.”<sup>677</sup> The most persuasive point supporting the dissent’s position is that Circuit Rule 29 specifically states that an amicus brief “must avoid repetition of facts or legal arguments made in the

<sup>672</sup> *Eldred v. Reno*, 239 F.3d at 378.

<sup>673</sup> See Brief of Amicus Curiae Eagle Forum Education and Legal Defense Fund, *Eldred v. Reno*, 239 F.2d 372 (D.C. Cir. 2001) (No. 99-5430) [hereinafter Eagle Forum Brief] at 5-6, available at <http://cyber.law.harvard.edu/eldredvreno/legaldocs.html> (last visited Oct. 31, 2001).

<sup>674</sup> 239 F.3d at 378.

<sup>675</sup> These arguments were amplified on petition for rehearing. See notes 692-707 and accompanying text.

<sup>676</sup> 239 F.3d at 378 (quoting *Resident Council of Allen Parkway Vill. v. United States Dep’t of Housing and Urban Dev.*, 980 F.2d 1043, 1049 (5th Cir. 1993)).

<sup>677</sup> *Id.* at 383 (Sentelle, J., dissenting in part).

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principal . . . brief and focus on points not made or adequately elaborated upon in the principal brief.”<sup>678</sup>

Despite erecting this procedural roadblock, the majority nonetheless proceeded to discuss the argument that it insisted was improperly raised. In doing so, the majority made three major points. First, it asserted that the CTEA was “necessary and proper” to the goal of promoting progress in two ways: it “give[s] copyright holders an incentive to preserve older works, particularly motion pictures in need of restoration,”<sup>679</sup> and it “matches United States copyrights to the terms of copyrights granted by the European Union.”<sup>680</sup> Second, it asserted that by making the Copyright Act of 1790 applicable to existing state copyrights, the First Congress (of which many of the Framers were members) conclusively indicated that it had the power to extend existing copyrights.<sup>681</sup> Third, it relied on *McClurg v. Kingsland* for the proposition that retroactive legislation was within Congress’ power under the Patent and Copyright Clause.<sup>682</sup>

Judge Sentelle dissented in part from the majority opinion, expressing his view that retroactive (but not prospective) term extension violated the Copyright Clause.<sup>683</sup> Citing the approach taken by the Supreme Court in *United States v. Lopez*,<sup>684</sup> he attempted to determine “whether the rationale offered in support of such an extension has any stopping point or whether it would lead to the regulation of all human activity.”<sup>685</sup> He explained:

The majority acknowledges that “[i]f the Congress were to make copyright protection permanent, then it surely would exceed the power conferred upon it by the Copyright Clause.” . . . However, there is no apparent distinction between permanent protection and permanently available authority to extend originally limited protection. The Congress that can extend the protection of an existing work from 100 years to 120 years, can extend that protection from 120 years to 140; and from 140 to 200; and from 200 to 300; and in effect can accomplish precisely what the majority admits it cannot do directly. This, in my view, exceeds the proper understanding of enumerated powers reflected in the Lopez principle of requiring some definable stopping point.<sup>686</sup>

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<sup>678</sup> *Id.*

<sup>679</sup> *Id.* at 379 (citing S. REP. NO. 104-315, at 12 (1996)).

<sup>680</sup> *Id.* (citing EU Council Directive 93/98, art. 7, 1993 O.J. (L 290) 9).

<sup>681</sup> *Id.* at 379.

<sup>682</sup> *Id.* at 380.

<sup>683</sup> *Id.* at 380-84 (Sentelle, J., dissenting in part).

<sup>684</sup> 514 U.S. 549 (1995).

<sup>685</sup> 239 F.3d at 381 (Sentelle, J., dissenting in part).

<sup>686</sup> *Id.* at 381-82.

In response to the majority's three points, Sentelle stated first that "[t]he government has offered no tenable theory as to how retrospective extension can promote the useful arts."<sup>687</sup> Moreover, even if preservation of existing works was a proper goal, "the means employed by Congress here are not the securing of exclusive rights for a limited period, but . . . the extension of exclusivity previously secured",<sup>688</sup> and even if harmonization of terms with Europe was desirable, "[n]either the European Union nor its constituent nation states are bound by the Constitution of the United States."<sup>689</sup> In other words, the fact that Europe has adopted a longer term (and made it retroactive) does not by itself give Congress authority to disregard the limits imposed by the U.S. Constitution. Second, Judge Sentelle distinguished the first Copyright Act, saying:

The enactment by the first Congress in 1790 regularizing the state of copyright law with respect to works protected by state acts preexisting the Constitution appears to me to be *sui generis*. Necessarily, something had to be done to begin the operation of federal law under the new federal Constitution. The Act . . . created the first (and for many decades only) federal copyright protection; it did not extend subsisting federal copyrights enacted pursuant to the Constitution.<sup>690</sup>

Judge Sentelle did not specifically respond to the majority's reliance on the dictum of *McClurg v. Kingsland*.<sup>691</sup>

### C. *Opinion on Petition for Rehearing*

Stung by the majority's stated refusal to fully consider the argument raised by the amicus, plaintiffs petitioned the D.C. Circuit for rehearing

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<sup>687</sup> *Id.* at 382. In so stating, Judge Sentelle seems to have fallen victim to the common misunderstanding that copyright exists to promote the "useful Arts." As used in the eighteenth century, the phrase "useful Arts" referred to the technological arts promoted by patent law, while the term "science" referred more broadly to the store of knowledge that was promoted by copyright. See Alan L. Durham, "Useful Arts" in the Information Age, 1999 B.Y.U. L. REV. 1419, 1424-25; WALTERSCHEID, *supra* note 190, at 19.

<sup>688</sup> 239 F.3d at 382 (Sentelle, J., dissenting in part).

<sup>689</sup> *Id.* at 384. Moreover, as others have pointed out, the CTEA does not completely harmonize U.S. copyright terms with those in the European Union. For works made for hire and works created before 1978, it increases the U.S. term of protection from seventy-five years to ninety-five years from first publication, far greater than the European term of seventy years for works made for hire.

<sup>690</sup> *Id.*

<sup>691</sup> See notes 622-627 and accompanying text.

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and for rehearing en banc.<sup>692</sup> That action drew an even stronger rebuke from the panel majority:

First, in their brief the plaintiffs-appellants themselves took the position, diametrically opposed to that of the amicus, “that the preamble of the Copyright Clause is not a substantive limit on Congress’ legislative power”; when expressly offered the opportunity at oral argument to adopt the position of the amicus, the plaintiffs-appellants did not do so. . . .

Second, the point advanced by the amicus . . . implicates discrete terms of the Clause that are not otherwise at issue. . . .

Third, because the plaintiffs-appellants did not take the same tack as the amicus, the Government did not on brief address the district court’s interpretation of this court’s decision in *Schnapper*. . . .

Finally, . . . even if we considered the amicus’s position we would not reach a different result in this case.<sup>693</sup>

With these remarks, the panel majority voted to deny the petition for rehearing.<sup>694</sup> A majority of the judges in active service on the D.C. Circuit voted to deny the petition for rehearing en banc.<sup>695</sup>

Judge Sentelle, joined by Judge Tatel, dissented from the denial of en banc rehearing. He maintained that “the decision . . . is worthy of en banc review on both circuit-specific procedural grounds and fundamental constitutional grounds.”<sup>696</sup>

First, procedurally the Court’s opinion in this case effectively eliminates any role for amicus curiae in the practice of this circuit, when it holds that an argument raised by an amicus may not be considered by the court. . . .

Second, and more importantly, the Court’s construction of the Copyright Clause of the Constitution renders Congress’s power under Art. I, § 8, cl. 8, limitless despite express limitations in the terms of that clause.<sup>697</sup>

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<sup>692</sup> See Appellant’s Petition for Rehearing and Suggestion for Rehearing En Banc, *Eldred v. Ashcroft*, 255 F.3d 849 (D.C. Cir. 2001) (No. 99-5430), available at <http://eon.law.harvard.edu/openlaw/eldredvreno/legaldocs.html> (last visited Oct. 31, 2001).

<sup>693</sup> *Eldred v. Ashcroft*, 255 F.3d 849, 850-51 (D.C. Cir. 2001).

<sup>694</sup> *Id.* at 852.

<sup>695</sup> *Id.*

<sup>696</sup> *Id.* (Sentelle, J., joined by Tatel, J., dissenting from denial of rehearing en banc).

<sup>697</sup> *Id.* at 852, 854.

With regard to the first point, the dissenting judges rebutted the majority's contention that the amicus' argument "was effectively renounced by appellants."<sup>698</sup> They pointed out that the amicus brief was submitted two weeks after the appellants' opening brief,<sup>699</sup> and they quoted the relevant passage from the oral argument on which the majority relied:

THE COURT: Have you adopted any point — any arguments that appear in any of these amicus briefs? Or maybe — I don't remember — there is more than one, but in any brief other than your own?

LESSIG: Well, in particular, Mr. Jaffe's brief is a brief that makes textualist arguments that we believe are quite strong in this way.

THE COURT: Is there any place in which you have adopted them, in your briefs?

LESSIG: We formally acknowledge them in our briefs. I don't believe we have, Your Honor, no.<sup>700</sup>

As this transcript demonstrates, at no time did appellants' counsel renounce the arguments made by the amicus. He simply conceded that plaintiffs "did not formally acknowledge them in our briefs," i.e., in writing. Contrary to the majority's characterization, the plaintiffs were never "expressly offered the opportunity at oral argument to adopt the position of the amicus,"<sup>701</sup> much less did they decline to do so. Instead, as the dissenting judges stated, the transcript "illustrates that appellants had not explicitly adopted amicus's arguments in brief but had no problem taking advantage of amicus's argument."<sup>702</sup>

The majority and dissenting judges also engaged in a metaphysical debate about whether the amicus' argument was or was not a distinct argument from the one made by the appellants.<sup>703</sup> Judge Sentelle concluded this portion of the opinion by saying:

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<sup>698</sup> *Id.* at 853.

<sup>699</sup> *Id.*

<sup>700</sup> *Id.* at 853 n.1. The syntax suggests that Mr. Lessig's penultimate sentence was phrased in the form of a question, i.e., "[Did] we formally acknowledge them in our briefs[?]"

<sup>701</sup> *Id.* at 851.

<sup>702</sup> *Id.* at 853.

<sup>703</sup> Compare *id.* at 851 ("the point advanced by the amicus . . . implicates discrete terms of the Clause that are not otherwise at issue.") with *id.* at 854 ("Contrary to the suggestion of the panel majority, appellants' argument did implicate the 'preamble' of the Copyright Clause, just not in the same fashion as the amicus.").



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Under the panel's holding, it is now the law of this circuit that amici are precluded both from raising new issues and from raising new arguments. If allowed to stand, this holding will effectively bar future amici from adding anything except possibly rhetorical flourish to arguments already outlined and embraced by the parties.<sup>704</sup>

In the remainder of the dissenting opinion, the dissenting judges reiterated Judge Sentelle's points that the majority's interpretation placed no substantive limit on Congress' power;<sup>705</sup> and that the government had not met its burden of demonstrating how retroactive term extension advances the constitutional purpose:

I accept that extending copyright terms for future works may well increase creative efforts at the margin. Once a work is published, however, extending the copyright does absolutely nothing to induce further creative activity by the author — and how could it? The work is already published. A simple finding by Congress to the contrary is not sufficient to demonstrate that the exercise of that power is “necessary and proper.”<sup>706</sup>

The majority responded to this point by asserting that “Preserving access to works that would otherwise disappear — not enter the public domain but disappear — ‘promotes Progress’ as surely as does stimulating the creation of new works.”<sup>707</sup>

It is true that Congress expressed some concern about encouraging the preservation of so-called “orphan” films: films that were deteriorating rapidly but which were not being properly preserved, allegedly because it was not economically worthwhile to do so.<sup>708</sup> There are two responses to this concern. First, the CTEA is not narrowly tailored to serve this objective; it extends all existing copyrights, whether or not the work is in any danger of deterioration. It was not economically marginal films which prompted Hollywood to seek term extension, but the highly profitable landmark films of the 1930s and 1940s. Extending copyright terms indiscriminately merely serves to reward those corporate copyright owners who allowed the films to deteriorate in the first place, without requiring any

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<sup>704</sup> *Id.* at 854.

<sup>705</sup> *Id.* (“The majority never explained how a precedent that would permit the perpetuation of protection in increments is somehow more constitutional than one which did it in one fell swoop.”).

<sup>706</sup> *Id.* at 855.

<sup>707</sup> *Id.* at 851-52 (quoting *Eldred v. Reno*, 239 F.3d at 379).

<sup>708</sup> S. REP. NO. 104-315, at 13 (1996).

restoration efforts at all.<sup>709</sup> Second, the primary obstacle to film restoration today is unduly lengthy durations of copyright. Often those who would like to restore films from the 1920s cannot sort out the tangle of eighty-year-old contractual assignments<sup>710</sup> (drafted before the age of television, videotape and DVDs<sup>711</sup>) to clear the rights. If these films were allowed to enter the public domain sooner rather than later, they would not disappear; instead, they could be restored by organizations such as the American Film Heritage Association, one of the plaintiffs.<sup>712</sup> Of course, if it was simply a question of which policy would best serve the public interest, it would be within Congress' purview to make the choice. But the Framers specified the means by which progress was to be advanced: encouraging the creation of new works by granting an exclusive right of limited duration, and placing the work in the public domain for others to use (and to restore) at the end of that limited time.<sup>713</sup> To borrow a phrase from the U.S. Supreme Court, "[t]his result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art."<sup>714</sup>

## V. CONCLUSION

The view of the Patent and Copyright Clause expressed in *Eldred v. Reno*, that Congress may extend a patent or copyright for any finite term it chooses, does violence to the language and purpose of the Clause, as it has been interpreted by the U.S. Supreme Court. The alternative position that

<sup>709</sup> See Heald & Sherry, *supra* note 25, at 1171 ("the legislation is in the form of gift-plus-hope, not quid pro quo.").

<sup>710</sup> It can be difficult, for example, to determine which parties owned the right of renewal and whether that renewal was properly exercised. See, e.g., *Epoch Producing Co. v. Killiam Shows, Inc.*, 522 F.2d 737 (2d Cir. 1975) (resolving copyright dispute concerning D.W. Griffith's *BIRTH OF A NATION* (1915)).

<sup>711</sup> Often a contract containing an assignment of rights is ambiguous as to whether it does or does not cover new technological means of distribution, rendering it difficult to determine from whom the rights need to be acquired. See, e.g., *Boosey & Hawkes Music Publishers, Ltd. v. The Walt Disney Co.*, 145 F.3d 481 (2d Cir. 1998); *Cohen v. Paramount Pictures Corp.*, 845 F.2d 851 (9th Cir. 1988).

<sup>712</sup> Cf. Brief of Amicus Curiae The Internet Archive in Support of Petitioners, at 9-12, *Eldred v. Ashcroft*, *petition for cert. filed*, 70 U.S.L.W. 3292 (U.S. Oct. 11, 2001) (no. 01-618), available at <http://eol.law.harvard.edu/openlaw/eldredvashcroft/cert/archive-amicus.html> (last visited Feb. 3, 2002).

<sup>713</sup> See Heald & Sherry, *supra* note 25, at 1165 ("The Intellectual Property Clause is designed to encourage a dual benefit through the grant of exclusive rights to authors and inventors: a present benefit in the form of public access to a new work . . . , and a future benefit of free access to the work when it falls into the public domain.").

<sup>714</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350 (1991).

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retroactive term extension is absolutely forbidden by the Patent and Copyright Clause has an appealing simplicity; but it is difficult to maintain in light of the long history of patent term extensions which were upheld in the mid-nineteenth century. A closer examination of those extensions, however, suggests an intermediate position: that Congress may extend patent and copyright terms in limited circumstances, in order to vindicate the expectation interest of authors and inventors who, for reasons beyond their control, did not receive the term of years promised to them at the time the copyright or patent was granted. That position, however, does not support the indiscriminate twenty-year term extension provided by the Sonny Bono Copyright Term Extension Act.

In rejecting a constitutional challenge to the CTEA, the D.C. Circuit not only misinterpreted the Patent and Copyright Clause, but it cast a cloud of confusion over the role of an *amicus curiae* in constitutional litigation, and it unfairly criticized plaintiffs' appellate counsel for allegedly renouncing an argument made by an *amicus* and relied upon by the dissenting judge. It is difficult to understand why the majority chose to rely on this dubious procedural irregularity. Indeed, in granting certiorari, the U.S. Supreme Court expressly declined to review the procedural aspect of the decision below.<sup>715</sup> In deciding the case on its merits, the Court should look beyond the broad dicta of the patent term extension cases discussed above, and should instead interpret the "limited Times" limitation in a manner that is more consistent with the purposes of the Patent and Copyright Clause.

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<sup>715</sup> *Eldred v. Ashcroft*, petition for cert. granted, 70 U.S.L.W. 3324 (Feb. 19, 2002), order amended, 70 U.S.L.W. \_\_\_, 2002 WL 257111 (Feb. 25, 2002) (limiting grant of certiorari to Questions 1 and 2 (no. 01-618)).

