

No. 10-545

IN THE
Supreme Court of the United States

LAWRENCE GOLAN, et al.,

Petitioners,

v.

ERIC H. HOLDER, JR.,
ATTORNEY GENERAL, et al.,

Respondents.

ON WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

**BRIEF FOR GOOGLE, INC.
AS AMICUS CURIAE
IN SUPPORT OF PETITIONERS**

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Secondary Sources

Curtis Bradley & Jack Goldsmith, *Treaties,
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Robert Brauneis, <i>Copyright and the World's Most Popular Song</i> , 56 J. COPYRIGHT SOC'Y U.S.A. 335 (2009).....	14
Mary Sue Coleman, Address to the Professional/Scholarly Publishing Division of the Association of American Publishers, <i>Google, the Khmer Rouge and the Public Good</i> (Feb. 6, 2006), available at www.umich.edu/pres/speech/archive/060206google.php	6
EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES (1879).....	30-31
Jane C. Ginsburg, et al., <i>Symposia: The Constitutionality of Copyright Term Extension</i> , 18 CARDOZO ARTS & ENT. L.J. 651 (2000)	13, 20
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Jed Rubinfeld, <i>The Freedom of Imagination: Copyright's Constitutionality</i> , 112 YALE L.J. 1 (2002).....	23, 27
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Anna Vuopala, Assessment of the Orphan Works Issue and Costs for Rights Clearance (European Commission, May 2010) ..	14

Internet Sources

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STATEMENT OF INTEREST*

Amicus Google, Inc., founded in 1998, is a diversified technology company headquartered in California's Silicon Valley. Google's mission is to organize the world's information and make it universally accessible and useful.¹ Google's history has coincided with, and contributed to, a vast expansion of the internet and computer technologies that have profoundly influenced human society.

Describing the burgeoning potential of the internet around the time of Google's founding, this Court observed that "[t]he Web is * * * comparable, from the readers' viewpoint, to both a vast library including millions of readily available and indexed publications and a sprawling mall offering goods and services," and from "publishers' point of view" "a vast platform from which to address * * * a world wide audience of millions * * * ." *Reno v. ACLU*, 521 U.S. 844, 853 (1997). The ensuing decade saw the erosion of distinctions among groups with fixed roles and "viewpoints": high-speed internet connections, cellphone cameras, and computing and software advances have enabled individual users to participate in politics and culture and to

* Pursuant to Supreme Court Rule 37.6, amicus affirms that no counsel for a party authored this brief in whole or in part and that no person other than amicus and its counsel made a monetary contribution to its preparation or submission. All parties' letters consenting to the submission of amicus briefs have been filed with the Clerk's office.

¹ See www.google.com/about/corporate/company/.

communicate, collaborate, and create for themselves in unprecedented and unforeseen ways.

Less than a decade after the YouTube service (now owned by Google) was launched as a platform for individual internet users to “broadcast themselves,” by publicly posting home videos, major presidential candidates were debating and taking user questions on YouTube; the White House had established a YouTube channel; and people in countries with repressive regimes were using that service and other social media to communicate with each other and the outside world to promote peaceful change.

The creative process has likewise changed fundamentally: aspiring performers now launch careers by placing work before vast audiences without awaiting entertainment industry imprimatur, while new technology, together with eclectic raw materials from an expanding internet, enable those without professional artistic ambitions to express themselves creatively. And the internet has developed so as to enable diverse new forms of reporting and commenting on public affairs; privately published works and low-budget (but internationally and instantly accessible) journals on subjects grand and minute; and blogs that allow citizens to make important journalistic contributions and engage with interlocutors worldwide in free-wheeling debates.

In addition to YouTube and Google Search, the signature service that people the world over, in 120 languages, use billions of times daily to find information on the internet, Google provides a wide array of products and services that help people find, organize, and communicate information, create art,

develop ideas, market their wares, and express and amuse themselves. These include Google Translate, a free language detection and translation service; Picasa, a web-based photograph editing and sharing platform; Blogger, an online self-publication host; Google Docs, which enables authors to work collaboratively on writing projects; Google Maps; Google Earth, a virtual globe, map and geographical information program; and Google Patent Search, which allows users to search millions of U.S. patents and patent applications.

What these have in common is the use of innovative computer and digital technology and the culture and architecture of the internet to increase dramatically the ability of wider groups of people to participate more fully and on more equal terms in the economy, cultural life, and political discourse. Most of the services Google provides are advertiser-supported and available free of charge. They connect people in poorer countries and residents of geographically isolated or disadvantaged communities in this country to historic centers of information, economic and political power. They make available to community college students and users of small-town libraries information, art, and literary and scientific works heretofore found only in the reading rooms of elite research universities. Google Translate makes vast quantities of material usable to those who do not know the author's language and makes it possible for artists, scholars, businesspeople, and individuals across the globe to communicate with one another effectively at no cost.

Many of Google's services depend or build upon public domain materials. For example, Google Scholar makes public domain legal opinions

searchable and available free of charge. The Google Art Project showcases and provides extremely high resolution images of public domain art hanging in many of the world's most famous museums. The wealth of eclectic public domain materials – and of innovative and creative projects using them – is enormous and expanding.²

But Google's largest investment in the public domain is in the area of books. Since its beginnings, the company has focused on using the power of digital technology to collect, and make available and searchable, the vast stores of human knowledge and experience recorded in books. Indeed, Google emerged out of its founders' work on the Stanford Digital Library Project, a National Science Foundation-supported project intended to develop the enabling technologies for an integrated universal library. Google later joined with Oxford University's Bodleian Library to digitize hundreds of thousands of volumes in its collection of nineteenth-century public domain books and has supported the World Digital Library, which makes available on the internet, free of charge and in multilingual format, significant primary materials from countries and cultures around the world. Google has created an online Shakespeare collection, which enables anyone to find and search Shakespeare's complete works, and provides visitors with access to a wealth of

² Numerous other companies and nonprofit entities have undertaken projects that allow users to access and build upon public domain materials, *see, e.g.*, www.flickr.com/commons (Flickr's "The Commons" service); www.archive.org/movies/ (Internet Archive's public domain films).

historical and scholarly resources as well a means of communicating with one another.

In December 2004, Google announced the Google Library Project to convert to digital form the collections of some of the world's largest libraries, in order to make those collections full-text searchable in the same manner as texts on the World Wide Web. The company has invested substantial resources to scan and digitize more than 15 million works, including those in the collections of many of the United States's leading universities, the New York Public Library and national and academic libraries in other countries.

Google has so far scanned and made available in full view in the United States more than three million public domain works. Google makes the entire text of such books available for viewing and reading online and makes the books available for download in their entirety, for free, expanding access to works previously located only in research libraries and special collections, and enabling others, in turn, to build on these digitized public domain texts.

With respect to books under copyright, the Google Library Project functions like a digital card catalog, but one that provides important additional functionalities, including the ability to search the full text of the collection, links to bookstores and libraries where the books may be purchased or borrowed, and the ability to view "snippets" of a few lines of text responsive to a user's search query. Where it has agreements in place with authors and publishers, Google offers additional features, including longer excerpts. (Without those licensing deals, copyrighted texts are never shown to users except in short snippets). Google has entered into

such agreements with tens of thousands of individual rightsholders.³

The enormous social benefits of this and other large-scale digitization efforts have been widely recognized. As President Mary Sue Coleman summarized in explaining the University of Michigan's decision to partner with Google to digitize that university's seven million books, the partnership "offers three overarching qualities that help fulfill our mission: the preservation of books; worldwide access to information; and, most importantly, the public good of the diffusion of knowledge."⁴

The provision at issue in this case and the broader questions it presents are of large practical significance and vital interest to Google and its users. The challenged legislative "restoration" could affect the copyright status of vast numbers of books that have already been scanned as part of the Library Project, and many others yet to be scanned. (The numbers of already-scanned books affected could exceed one million, depending on other factors,

³ The legality of the digitization undertaking with respect to in-copyright materials has been challenged, *see Authors Guild v. Google, Inc.*, No. 05-Civ.-8136 (S.D.N.Y.); *id.*, 2011 WL 986049 (S.D.N.Y. March 22, 2011) (declining to approve proposed class action settlement).

⁴ Mary Sue Coleman, *Google, the Khmer Rouge and the Public Good* (Feb. 6, 2006), *available at* www.umich.edu/pres/speech/archive/060310sym.php.

including the *Twin Books* issue, discussed in Part III, *infra*, as well business considerations).⁵

Google’s mission overlaps with, and depends upon, the core values expressed in and secured by the constitutional provisions at issue in this case: Article I, Section 8, Clause 8 of the U.S. Constitution, which empowers Congress to grant limited exclusive rights in order to promote the “the Progress of Science and useful Arts,” thereby “enriching the general public through access to creative works,” *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 526-27 (1994); and the First Amendment, which guarantees “the freedom of speech,” and “of the press,” and “carries with it * * * freedom to listen,” *Richmond Newspapers v. Virginia*, 448 U.S. 555, 576 (1980), and to “receive information and ideas,” *Kleindienst v. Mandel*, 408 U.S. 753, 762 (1972), and “prohibit[s] government from limiting the stock of information from which members of the public may draw,” *First Nat’l Bank of Boston v. Bellotti*, 435 U.S. 765, 783 (1978).

The protections of copyright law are, Google recognizes, integral to innovation and creativity. But the public domain is, we submit, not a marginal category, and the bright-line principle at stake in this case – “that matter once in the public domain must remain” there – is no abstract dictum. It plays and will continue to play a central, foundational role in many of the large-scale projects Google invests in and develops and is indispensable to the creativity, education, and free expression these projects seek to enable.

⁵ Google has not yet decided how it would treat these books if their status reverted to public domain.

SUMMARY OF ARGUMENT

Section 514 of Uruguay Round Agreements Act breaks with more than two centuries of practice and understanding by imposing copyright law restrictions on the expressive use of “work[s] of authorship” – numbering in the millions – that were “in the public domain in the United States,” 17 U.S.C. § 104A(h)(6)(C), and had been for decades. As such, Section 514 transgresses a “bright line” principle that is definitional to the public domain and is a basic tenet of copyright law, namely, that materials in the public domain remain there permanently for the public to consider, perform, build upon, circulate, and recast into other creations.

In defending the statute and straining to depict it as an unexceptional exercise of legislative policymaking authority akin to the term extension in *Eldred v. Ashcroft*, 537 U.S. 186 (2003), the Government diminishes the legal and practical significance of the public domain. But contrary to the premises of Section 514 and the United States’s defense of it, the public domain is not some marginal or provisional category that exists at the sufferance of Congress or Executive Branch trade negotiators. Instead, it is a central feature of the regime of public creativity that Article I, Section 8, Clause 8 promotes; indeed, enriching the public domain can fairly be termed the end goal of that system.

The need to affirm and protect the integrity of the public domain is of special practical importance now, as new technologies and projects like those Google has undertaken offer unprecedented means for individuals to access materials in the public domain and put them to use, as is their right. Section 514, and the necessary implication that future

“restorations” may also be freely given, unsettle that foundational premise. The statute places an ominous cloud over what had been the property of all Americans, and discourages investment in facilitating access to and use of public domain materials.

Section 514 is plainly a “law abridging the freedom of speech,” and as such merits close, not perfunctory, judicial scrutiny. The First Amendment protects, in undiminished fashion, individuals’ rights to access and use public domain materials created by others. The Government’s contentions that the Free Speech Clause has no role unless an enactment banishes the fair use defense or authorizes copyrighting of ideas rests on a doubtful reading of *Eldred*, one that cannot be squared with constitutional first principles. Neither could Section 514’s limitations on speech be justified as a facilitating the free speech rights of the foreign works’ rightsholders. There is no *constitutional* right to prevent others from using one’s (or one’s predecessor-in-interest’s) expression, let alone in doing so after the expression has entered the public domain.

Finally, this brief calls the Court’s attention to a significant additional development that directly affects the copyright status of many of these same works, both complicating the statute’s intended operation and standing as a practical obstacle to vindicating the clarity, certainty, and national uniformity that petitioners here seek – and, we believe, that the Constitution and legal tradition demand.

As we explain, in two widely-criticized decisions that post-date the enactment of Section 514, *Twin*

Books Corp. v. Walt Disney Co., 83 F.3d 1162 (9th Cir. 1996), and *Société Civile Succession Richard Guino v. Renoir*, 549 F.3d 1182 (9th Cir. 2008), the Ninth Circuit discarded a fundamental norm that even the 1994 restoration statute did not breach (and indeed affirmed): that a work is either protected by copyright or in the public domain. Addressing the copyright status of works published abroad without satisfying U.S. copyright formalities, *Twin Books* recognized for the first time under the 1909 Act, a twilight category, under which these works could be freely copied and exploited in the United States, yet were not in the “public domain” – and therefore could be (and were) later converted to copyright protection.

This rule operates as a source of uncertainty, disuniformity, and unfairness. It illustrates, just as Section 514 does, the importance to the public of stability and predictable rules safeguarding the public domain. Although this case involves works whose public domain status (but for restoration) is not at issue, and arises in a circuit that has not adopted the spurious Ninth Circuit rule, the Court should take care, as it decides this case, to avoid signaling approval of the untenable *Twin Books* regime.

ARGUMENT

I. THE PUBLIC DOMAIN ENJOYS SPECIAL CONSTITUTIONAL STATUS AND DEMANDS RIGOROUS JUDICIAL PROTECTION

The Court should reject the premises implicit in Section 514 – and explicit in the Government’s defense of it below: that legislation imposing

copyright law restrictions on expression that uses works “in the public domain of the United States,” 17 U.S.C. § 104A(h)(6)(C), raises no special constitutional concern.

The distinction between works entitled to copyright protection and those in the public domain is basic to the system of copyright and free expression the Constitution establishes. The extraordinary congressional power asserted is condemned by the Constitution, as well as by centuries of legal tradition. Indeed, enforcing these established limits is especially important here. Not only does this law make copyright infringers of persons who continue to make creative use of works that for decades were lawfully available to them, but the practical effect of the “restoration” is in many cases to withdraw works from any productive use without any benefit to (hypothetical) rightsholders. And it does so at a juncture when technological change has made the public’s historic legal rights of access to these materials a practical reality.

A. The Public Domain Is Of Fundamental Constitutional Significance

The Government’s claims of broad “restoration” power are belied by the text and structure of the Constitution and by legal tradition. The power asserted goes far outside the “traditional contours” of copyright law, *see Eldred*, 537 U.S. at 221, and works a deep incursion into the freedom of speech secured by the First Amendment.

This Court has repeatedly affirmed that permanence is definitional to the public domain – “that matter once in the public domain must remain in the public domain,” *Kewanee Oil Co. v. Bicron*

Corp., 416 U.S. 470, 484 (1974), and that Congress lacks power to enact legislation “whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available,” *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966). But the principle does not derive from particular expressions in judicial opinions; nor is its recognition confined to them.

Respect for the integrity, importance, and inviolability of the public domain has been a feature of every copyright statute Congress has enacted for two centuries, including the impressively long and unbroken run of extension statutes canvassed in *Eldred*. See, e.g., Copyright Act of 1976, Pub. L. No. 94-553, § 103, 90 Stat. 2541, 2599 (“This Act does not provide copyright protection for any work that goes into the public domain before January 1, 1978.”); Copyright Act of 1909, Pub. L. No. 60-349, § 7, 35 Stat. 1075, 1077 (“no copyright shall subsist in the original text of any work which is in the public domain”); see also Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 12, 102 Stat. 2853 (1988).

Indeed, as petitioners explain (Petr. Br. 31-41), permanence was not merely an operative effect of those enactments, but a basic premise. See H.R. Rep. No. 59-7083, at 11 (1907) (expressing law’s intent “to make it clear that the original text of any work which has fallen into the public domain cannot be copyrighted”); H.R. Rep. No. 94-1476, at 180 (1976) (“lost or expired copyrights cannot be revived”); H.R. Rep. No. 87-1742, at 3 (1962) (term extension appropriate because “*it is not possible* to revive expired terms of copyright”) (emphasis added).

The fundamental character of the public domain – and the implausibility of the claimed power to breach it routinely – is apparent from the text and structure of the Constitution. The “limited times” mandate does more than establish that American copyright’s purposes are instrumental: it provides the author with a limited property right in the expression itself and assures that *works* reach the public domain, whereupon members of the public acquire the “federal right to ‘copy and use’” them “at will,” and without restriction, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 165 (1989)); see *Stewart v. Abend*, 495 U.S. 207, 228 (1990) (describing “balance between the artist’s right to control *the work during the term of the copyright protection* and the public’s need for access to creative works”) (emphasis added); *Fogerty*, 510 U.S. at 527 (noting that copyright “ultimately serves the purpose of enriching the general public through access to creative works,” and that successful defense of infringement suit had “increased public exposure to a musical work that could, as a result, lead to further creative pieces”).

And the public domain plays an at least equally foundational role in First Amendment free speech. As petitioners explain, the difference between the “First Amendment” protections built into works that are copyright-protected, and those in the public domain, is the difference between the “right” to play a few bars of Shostakovich or to make use of the “ideas” his composition expresses, and the freedom to perform – or arrange or “re-mix” – that work “at will.” *Dastar*, 539 U.S. at 34; see *Symposia: The Constitutionality of Copyright Term Extension*, 18 CARDOZO ARTS & ENT. L.J. 651, 702 (2000) (Prof.

Jane C. Ginsburg) (“[T]here is a First Amendment right to publish freely works that are in the public domain.”).

Indeed, the gulf separating the speech rights of the public before and after the restoration at issue here is even wider in practice than in theory. Although questions of copyright protection may summon to mind disputes over whether or not users should have to pay creators for use of their work, where works like those at issue here are involved, the difficulty and cost of even locating the relevant “rightsholder” from whom a license might be negotiated are very often insurmountable. The number of older works for which finding rightsholders is prohibitively expensive or that are indeed “orphans” – works in copyright whose rightsholder truly cannot be found – is very large.⁶ And even when a rightsholder steps forward for such works, the passage of time makes it far likelier that others will make competing claims. See Robert Brauneis, *Copyright and the World’s Most Popular*

⁶ See, e.g., Anna Vuopala, *Assessment of the Orphan Works Issue and Costs for Rights Clearance* at 5 (European Commission, May 2010) (“A conservative estimate of the number of orphan books * * * across Europe puts the number at three million * * * (13% of the total number of in-copyright books) * * * . The older the books the higher the percentage of orphan works.”), see http://ec.europa.eu/information_society/activities/digital_libraries/doc/reports_orphan/anna_report.pdf. *Id.* (finding that 95% of pre-1912 U.K. newspapers are orphan works); see also Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485, 497 (2004) (noting study finding that only 174 of 10,027 books published in the United States in 1930 were in print in 2001).

Song, 56 J. COPYRIGHT SOC'Y U.S.A. 335, 418 (2009) (detailing the variety and complexity of claims to copyright in “Happy Birthday to You”).⁷

The definition of the class of works benefitted by this statute – works that are (1) old; (2) of foreign origin; (3) protected under non-U.S. law; and that (4) failed to comply with United States copyright “formalities,” including renewal – reads like a field guide to works whose rightsholders are unlikely to be found. The beneficiaries of Section 514 are uniformly granted “restoration” when they failed to renew, a feature of the statute that is certain to

⁷ Determining whether a work is in the public domain can be difficult. As we explain below, *infra*, pp. 29-35, there has long been disagreement about the status under the 1909 Act of foreign-author works published without the notice required by that Act, with some authorities suggesting that the works were protected, on the theory that notice was required only for U.S. publication, and others concluding that publication without notice outside the United States put the work into the public domain. Two Ninth Circuit decisions venture a third position, namely, that foreign publication without Copyright Act notice placed works in a “limbo” status, which could persist for decades, that was neither copyright nor public domain. *See infra*, pp. 29-35 (discussing *Twin Books*, 83 F.3d at 1162, and *Guino*, 549 F.3d at 1184). As we explain, that rule renders such works ineligible for “restoration” under Section 514 – which requires “public domain” status – and threatens to deny parties who might qualify for the limited “reliance party” rights Section 514 provides.

leave a large body of stranded, unusable, and unremunerative abandoned or orphan works.⁸

Thus, for most of the works covered by Section 514, the effect of the restoration will not be to direct money to the creators' successors-in-interest; it will mean that the works will remain moribund, and that efforts to build upon the works – by performing, by adapting, or by offering to the public – will be discouraged. For the public – including many beyond the “reliance parties” who are petitioners here – the statute will mean a loss of access to many of the affected works.

B. Uncertainty As To The Stability of Public Domain Status Will Deter Investments in Making the Public Domain Accessible

But the implications of this statute – and of approving the theory of congressional power the Government advances to support it – are more serious still. The power asserted unsettles an especially important point of copyright law where a measure of reliable certainty had prevailed: the principle that works in the public domain are there *permanently*. Upholding that claim would alter the status of *every* work currently in the public domain – by rendering provisional their most practically important defining characteristic, that they may be

⁸ Studies have found that approximately 15% of those issued U.S. copyrights between 1923 and 1963 – 8% for books – renewed them, *see* Sprigman, 57 STAN. L. REV. at 519-20, meaning that “[t]he burdens of copyright, therefore, were visited only on those works that had passed through the renewal filter – *i.e.*, only those works for which continuing protection could be expected to provide some return for the author.” *Id.* at 537.

used freely, without restriction, without fear of copyright-law based interference or liability.

Many individual undertakings – and digital compilations – have hewed to public domain materials precisely because these are understood as avoiding complexities, costly historical searches, and legal risk. For an individual contemplating spending months translating a novel; a composer considering rearranging a piece of music; or a library contemplating offering free copies of a public domain work, the instability that such a rule would foster is likely to support a decision not to create. The chilling effect would be no less significant for companies and organizations offering products and programs that facilitate the public’s access to, and ability to enjoy, explore, and create with public domain materials.

Nor is it an answer that this statute applies to just these – millions – of public domain works and that concerns about future “restorations” are “speculative.” Indeed, there is no reason to believe that the rationale and authority for this measure could not be invoked to restore, for example, the works of *United States* authors whose exclusive rights were forfeited based on noncompliance with renewal or other formalities – or that nations from whom the United States seeks future trade advantages would not condition these on Congress’s restoring their authors’ rights.

C. The Need To Uphold And Protect Public Domain Status Is Increasingly Vital

Uncertainty about the stability of public domain status is especially harmful today, because it undercuts ongoing efforts, spurred by new

technology and the widespread public use of the internet, to make creative and productive use of public domain materials. For a small company, or a university or other nonprofit institution, the risk that public domain materials may in the future be the subject of new copyright claims deters investment in public domain resources. Even for a large company like Google, the possibility that works in the public domain will be legislatively deemed copyrighted in the future is a daunting and complicating prospect. A newly recognized congressional power to withdraw materials from the public domain – decades after the fact – will reduce incentives to make public domain works available to the public, efforts that often require large upfront investments (scanning entire libraries of old, oddly shaped books is expensive).

II. SECTION 514 IS A LAW ABRIDGING THE FREEDOM OF SPEECH, WARRANTING SEARCHING FIRST AMENDMENT SCRUTINY

By its terms, the prohibition Section 514 erects is directed at a subset of expressive activities defined by their use of a “work of authorship that * * * is in the public domain in the United States.” 17 U.S.C. § 104A(h)(6)(C). Section 514 regulates petitioners and other “reliance parties,” threatening them with penalties and criminal punishment for, *inter alia*, continuing to perform and distribute works they lawfully created using materials in the public domain – unless they purchase a license from the “rightsholder.” Others were required to cease activities such as performing or experimenting with works they have spent decades mastering, unless they obtain the “rightsholder’s” consent, which may

be withheld for any reason, or no reason at all. See *Stewart*, 495 U.S. at 229 (“[T]his Court has held that a copyright owner has the capacity arbitrarily to refuse to license one who seeks to exploit the work.”). And beyond these burdens, the provision directly and seriously “limits the stock of information from which members of the public may draw.” *Bellotti*, 435 U.S. at 783, as well as “freedom to listen, and receive information and ideas.” *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 756-57 (1976).

As with its arguments about congressional power, the Government’s responses to petitioners’ First Amendment claim have been based heavily on *Eldred*, which rebuffed a free speech challenge, noting, *inter alia*, the shared concerns and temporal proximity of the Copyright Clause and the First Amendment, 537 U.S. at 219; the presence of protections for free speech interests “built in” to copyright doctrine (namely fair use and idea/expression dichotomy), *id.*; and observing that the First Amendment “bears less heavily when speakers assert the right to make other people’s speeches,” *id.* at 221. From this, the Government has argued that an exercise of the Copyright Power should be upheld so long as it leaves intact these two “traditional” free speech-accommodating “contours,” Br. in Opp. 21-22 (citing *Eldred*, 537 U.S. at 221).

But as the Tenth Circuit recognized, the proposed rule of decision does not reflect a sound reading of *Eldred*, and is irreconcilable with bedrock constitutional principles. Not only is Section 514 well outside the historic contours of copyright, but what it regulates – a wide array of expression that makes use of works then (and long) “in the public

domain in the United States” – is at the core, not the outer reaches, of what the First Amendment protects.

A. The Free Speech Rights Burdened By Section 514 Are Important, Not Marginal

The *Eldred* Court’s statement that the First Amendment “bears less heavily when speakers assert the right to make other people’s speeches” addressed the novel constitutional claim pressed in that case – a “Free Speech” right to access and exploit works still within an unexpired and temporally-limited copyright term. It is not an accurate statement of general First Amendment principles. *Cf. Cohens v. Virginia*, 19 U.S. 264, 399 (1821).

While it would be possible to say the law in *Eldred*, by postponing access for a limited additional time, did “not violate ‘the freedom of speech’ to which the First Amendment refers,” there is no “long-established tradition” of regulating speech that makes use of “other people’s” words fixed in public domain works. *See Nevada Comm’n on Ethics v. Carrigan*, 2011 WL 2297793 (U.S. June 13, 2011). On the contrary, “once [someone else’s] speech is in the public domain, it is an element of information, and the concept of free speech would include reiterating unprotected information * * *. There is a First Amendment right to publish freely works that are in the public domain.” *Copyright Term Extension*, 18 CARDOZO ARTS & ENT. L.J. at 701-02 (Prof. Ginsburg); *see also Kewanee Oil Co.*, 416 U.S. at 484 (“[T]he policy that matter once in the public domain must remain in the public domain is not incompatible with the existence of trade secret

protection. By definition a trade secret has not been placed in the public domain.”).

Any suggestion that expression is *generally* entitled to diminished protection because it makes use of “other people’s” words, fixed in a public domain work, rather than the author’s or performer’s own expression, is wholly contrary to First Amendment precedent and principle. As this Court has recently underscored, the enterprise of assigning lesser or no protection to categories of ostensibly low-value speech is not a growth field, and the Court has held protected categories more apparently problematic than lawfully-created but less-than-fully novel works, *see United States v. Stevens*, 130 S. Ct. 1577, 1585 (2010) (federal criminal law prohibiting videotaped depictions of animal cruelty); *see also Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 124 (1991) (Kennedy, J., concurring); *Hustler Magazine v. Falwell*, 485 U.S. 46, 52 (1988) (explaining that “[f]alse statements of fact” are protected even though they “particularly valueless”).

The right to speech that makes extensive use of (or even reproduces) public domain works authored by “others” is in fact not a poor relation of the First Amendment. Although originality is the “*sine qua non* of copyright,” *Feist Publ’n’s, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991), it occupies no privileged place in First Amendment doctrine, nor could it, given the provision’s textual commitment to freedom of the press. For example, the law at issue in *Turner Broadcasting System, Inc. v. FCC*, 512 U.S. 622, 636 (1994), which the *Eldred* opinion described as implicating “the heart of the First Amendment,” namely, “the principle that each

person should decide for himself or herself the ideas and beliefs deserving of expression, consideration, and adherence,” 537 U.S. at 641, was cited in *Hurley v. Irish-American Gay, Lesbian & Bisexual Group*, 515 U.S. 557, 570 (1995), to refute an argument that the petitioner parade organizing committee enjoyed limited First Amendment protection because it was a “mere[] conduit,” “rather than itself a speaker.” The Court explained:

Cable operators * * * are engaged in protected speech activities even when they only select programming originally produced by others * * * . For that matter, the presentation of an edited compilation of speech generated by other persons is a staple of most newspapers’ opinion pages, which, of course, fall squarely within the core of First Amendment security, *Miami Herald Publishing Co. v. Tornillo*, 418 U.S. 241, 258 (1974), as does even the simple selection of a paid noncommercial advertisement for inclusion in a daily paper, see *New York Times [v. Sullivan]*, 376 U.S. [254, 265-66 (1965)].

515 U.S. at 570.⁹

In *Edwards v. South Carolina*, 372 U.S. 229, 235 (1963), the Court described petitioners’ civil rights march “carrying placards [and] singing The Star Spangled Banner” (itself a work in the public

⁹ Indeed, the expression repeated by the cable system operator plaintiffs in *Turner* was not within the public domain – they obtained it through a compulsory license – and that license, far from rewarding originality, forbade the speaker from altering the original. See 17 U.S.C. §§ 111(c)(3), 111(d).

domain) as “reflect[ing] an exercise of * * * constitutional rights in their most pristine and classic form.” *See also New York Times Co. v. United States*, 403 U.S. 713 (1971) (per curiam) (upholding newspaper’s First Amendment interest in publishing work authored by government employees).

This Court’s opinions recognize that freedom to decide *how* to express something is fully protected – it is not a valid First Amendment defense that the government left open other ways to express the same “idea.” *Cohen v. California*, 403 U.S. 15, 26 (1971); *City of Ladue v. Gilleo*, 512 U.S. 43, 56 (1994); *City of Houston, Tex. v. Hill*, 482 U.S. 451, 461 (1987). Its opinions *demonstrate* the expressive power of verbatim repetition. *See, e.g., Texas v. Johnson*, 491 U.S. 397, 424 (1989) (Rehnquist, C.J., dissenting) (reproducing in full John Greenleaf Whittier’s poem, “Barbara Frietchie”); *United States v. Virginia*, 518 U.S. 515, 601-02 (1996) (Scalia, J., dissenting) (verbatim quotation of “The Code of a Gentleman”).

Indeed, paradigmatic examples of works described as “unquestionably shielded,” *Hurley*, 515 U.S. at 569, and “fully protected” by the First Amendment – such as the “Jabberwocky verse of Lewis Carroll,” *id.*, or “Keats’ poems or Donne’s sermons,” *Stevens*, 130 S. Ct. at 1591 – involve authors who are long dead. People’s rights to publish, read, listen to, or watch recitations of such works are protected, not because of the rights of the late authors, but because Free Speech carries with it a freedom to listen, and to “receive information and ideas.” *Kleindienst*, 408 U.S. at 762; *see* Jed Rubenfeld, *The Freedom of Imagination: Copyright’s Constitutionality*, 112 YALE L.J. 1, 35 (2002) (“[O]ne of the things the First Amendment centrally prohibits is a law that

criminalizes the reading of books, including dead writers' books * * * ."); *Stanley v. Georgia*, 394 U.S. 557, 565 (1970).

But even if creativity and originality were the polestar of the First Amendment, the distinction drawn by Section 514 would still not be sound. This Court has long emphasized that the "originality" needed for copyright does not contemplate "strictly new and original throughout." *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575-76 (1994) (quoting *Emerson v. Davies*, 8 F.Cas. 615, 619 (C.C.D. Mass. 1845) (Story, J.)). "Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before," *id.*, and liability for infringement is not a verdict of unoriginality, *Stewart*, 495 U.S. at 238 (copyright prohibition reaches use that "is insubstantial with respect to the *infringing* work") (quoting *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 565 (1985)).

B. The Categorical First Amendment Immunity the Government Urges Is As Unsound As the One *Eldred* Rejected

Eldred forecloses any argument that copyright legislation is "categorically immune" from First Amendment scrutiny. 537 U.S. at 221. Yet the rule the Government derives from *Eldred* – that copyright statutes that leave intact the two cited "accommodations" (idea/expression and fair use)

intact are perforce constitutional (*see* Br. in Opp. 22) – is itself “categorical,” and unacceptably rigid.¹⁰

The basic constitutional reasons why “immunity” is unsound condemn the United States’s proposal here: The exercise of all powers in the Constitution, including “express” and “affirmative” powers in Article I, is subject to the limitations imposed by the Bill of Rights, *see, e.g., Lamont v. Postmaster General*, 381 U.S. 301 (1965), and enactment of a statute – even one with “built-in” safeguards – cannot alter or “legislatively supersede” constitutional protection, *Dickerson v. United States*, 530 U.S. 428, 437 (2000). *Cf. Fitzgerald v. Barnstable Sch. Comm.*, 555 U.S. 246 (2009).¹¹

Instead, non-constitutional “accommodations” are the beginning, not the end, of constitutional

¹⁰ Indeed, what the Government offers as a substitute is in fact the rule the Court rejected: the D.C. Circuit immunity declaration disavowed in *Eldred* appeared in an opinion that elsewhere stated that the idea/expression dichotomy and availability of fair use “obviate[] further inquiry under the First Amendment.” *Eldred v. Reno*, 239 F.3d 372, 376 (D.C. Cir. 2001).

¹¹ Where two constitutional provisions provide overlapping protection, it is not usual practice to treat one as annulling the other. *See Soldal v. Cook County*, 506 U.S. 56, 70 (1992). One constitutional or statutory provision may be said to “obviate” the need for considering another, only in the sense that the former may provide sufficient protection that the latter becomes superfluous. *See* Steven J. Horowitz, *A Free Speech Theory of Copyright*, 2009 STAN. TECH. L. REV. 2 (proposing that First Amendment principles be read more fully into Copyright Clause).

analysis. *Curtis Publ'g Co. v. Butts*, 388 U.S. 130, 151-52 (1967) (plurality) (noting that First Amendment shield applies to libel law, even though “[t]ruth has become an absolute defense in almost all cases, and privileges designed to foster free communication are almost universally recognized”); *Snyder v. Phelps*, 131 S. Ct. 1207, 1222-23 (2011) (Alito, J., dissenting) (explaining that tort claim invalidated on First Amendment grounds was “very narrow” and had “requirements that ‘are rigorous, and difficult to satisfy’”). Fair use is a capacious and flexible defense that is of great importance to Google and the kinds of dynamic web-driven initiatives described above, *see, e.g., Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146 (9th Cir. 2007), and is undoubtedly necessary to protect First Amendment rights. But neither fair use nor the idea/expression dichotomy addresses all the ways in which copyright restrictions can abridge freedom of speech.

The considerations that made “further First Amendment scrutiny * * * unnecessary” in *Eldred*, 537 U.S. at 221, are absent here, and that decision lends no support to the claim that the boundary between public domain and copyright status is not itself one of the important “traditional contours” protecting free speech. Indeed, accepting the Government’s argument would mean that the limited protections Section 514 provides for “reliance parties” are constitutionally irrelevant, because the statute indisputably leaves fair use and the idea/expression dichotomy undisturbed. On this understanding, a law that simply commanded immediate destruction of any works lawfully created with public domain materials would trigger no meaningful First Amendment scrutiny.

C. “Restoration” Does Not Vindicate Any
Countervailing First Amendment Right

The Government has posited that Section 514 should be understood not as an abridgment of Free Speech, but as a balancing of competing First Amendment interests and, at least obliquely, that countervailing First Amendment rights of authors favor upholding Section 514. See Br. in Opp. 20 (invoking “the constitutionally recognized freedom not to speak”); *id.* at 23 n.12 (citing *Harper & Row*, 471 U.S. at 559).

This is wrong: although the Court in *Harper & Row* suggested an affinity between unapproved copying of an author’s words and the constitutional shield against government-compelled expression, 471 U.S. at 559, that analogy, offered in a case involving interference with the right of first publication – of the author’s memoir – has great potential to mislead. “No one has a First Amendment right to be the only speaker of certain words.” Rubinfeld, 112 YALE L. J. at 29.

Other private speakers’ use of authors’ words is not the same thing as a governmental requirement that “limits what [authors] may say [or requires them to say anything.” *Rumsfeld v. FAIR, Inc.*, 547 U.S. 47, 60 (2006), and “when it comes to preventing others from copying these books, filming them, or writing sequels to them, the copyright holder has only statutory rights, not First Amendment rights.” Rubinfeld, 112 YALE L. J. at 29.¹²

¹² The works restored by Section 514 were published in the United States and abroad, rendering *Harper & Row*’s solicitude for pre-publication rights inoperative here.

As explained above, under the Copyright Clause, (eventual) loss of this sort of control is not merely a risk, but a certainty – indeed a constitutional command. And fair use gives preferential treatment for immediate “critic[al]” uses of an author’s words that are likely to be especially unwelcome, 17 U.S.C. § 107, and statutory licenses prescribed in Title 17 likewise drastically restrict a creator’s control over a work once published.¹³ *Cf.* Curtis Bradley & Jack Goldsmith, *Treaties, Human Rights, and Conditional Consent*, DUKE L. FAC. SCHOLARSHIP PAPER 1177 (2000) (noting United States’s First-Amendment-based refusal to implement restrictions on “hate speech” prescribed in international agreements).

Finally, while *Eldred* noted that an author familiar with relevant history “would reasonably comprehend” the statutory quid pro quo to include protection under later-enacted extensions, 537 U.S. at 214-15, the authors whose works are restored would have had no expectation that public domain status would or could be undone. The 1909 Act, in effect at the time most were created, made clear that “any work which has fallen into the public domain cannot be copyrighted,” *see supra*, p. 12., and permanence was understood then – and before and after – to be definitional. (Of course, if

¹³ The statutory license for musical compositions, for example, means that a songwriter cannot prevent a recording of her song once it has been published. 17 U.S.C. § 115. Of course, the rights conferred by Section 514 are not limited to authors and may be enforced by “rightsholders” who are successors of long-deceased speakers.

encouragement or overcoming chill had anything to do with the statute, it is odd that similarly-situated American authors, especially those whose works entered the public domain for failure to renew, would be excluded).

III. THE COURT SHOULD ENSURE THAT ITS DECISION PROMOTES NATIONALLY UNIFORM RULES GOVERNING THESE WORKS' COPYRIGHT STATUS

In considering this case, the Court should take account of an important intervening development that is, in many ways, intertwined with Section 514. The same year that Congress's restoration was to go into effect, the Ninth Circuit issued the first of two decisions, *Twin Books*, 83 F.3d at 1162, and *Guino*, 549 F.3d at 1184, that embraced a startlingly novel understanding of which foreign works were and were not in the public domain in the absence of the "restoration" Section 514 sought to effect (and which ones it would "restore"). In those cases, the Ninth Circuit established, through judicial interpretation, a regime similar in some respects to the one Congress enacted in 1994 – where works effectively in the public domain could obtain copyright protection decades later. The Ninth Circuit's understanding of public domain status is, of course, inconsistent with that advanced in this brief. But it is also irreconcilable with the premises underlying the 1994 Act, which saw belated acquisition of copyright status to be consequential enough to require special provisions for reliance parties. We would urge the Court explicitly to acknowledge here these serious, fundamental defects, but if it does not do so, it should take care that its disposition not be interpreted as giving tacit approval to this

“untenable” regime. See 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 4.01[C][1] (2011) (criticizing *Twin Books* as, among other things, “wrong-headed,” “perverse[],” and “untenable”).

In *Twin Books*, the Ninth Circuit, straining to uphold rights claimed to be derived from a 1954 renewal, held that a book first published abroad in 1923 without the copyright notice required under the 1909 Copyright Act was entitled to protection based upon a second publication in Germany, this time with proper U.S.-required notice, three years later (thereby rendering timely the renewal 28 years after that). To support that decision, the Ninth Circuit resorted to reasoning other courts and commentators have derided: (1) that the 1923 publication in Germany had not released the work to “the public domain in the United States” – and therefore did not “preclude the author from subsequently obtaining copyright protection in the United States” – but *also* (2) that during the 1923-1926 time period, “anyone could have sold the * * * book in the United States.” 83 F.3d at 1168.

“[N]o court before or since has suggested that a work could be freely copied in the United States, but somehow not be in the public domain in the United States.” Tyler T. Ochoa, *Protection for Works of Foreign Origin Under the 1909 Copyright Act*, 26 SANTA CLARA COMPUTER & HIGH TECH. L.J. 285, 307 (2010); see also David Nimmer, *An Odyssey Through Copyright’s Vicarious Defenses*, 73 N.Y.U. L. REV.

162, 172-73 (1998) (suggesting *Twin Books*' analysis is "patently absurd").¹⁴

¹⁴ Although the *Twin Books* court seemed to be groping toward a rule that would treat foreign publication as entirely irrelevant, that rationale "would have contradicted a century of precedent." Ochoa, 26 SANTA CLARA COMPUTER & HIGH TECH. L.J. at 303 (citing EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 295-96 (1879) ("[T]here can be no doubt that * * * an author forfeits his claim to copyright in this country by a first, but not by a contemporaneous, publication of his work abroad."); and *Tribune Co. v. Associated Press*, 116 F. 126, 128 (N.D. Ill. 1900)).

Nor can *Twin Books* be justified as a kind of free-floating equitable adjustment for foreign authors. The authors there (and in this case) would not have expected U.S. copyright law to treat them on par with, let alone better than, their American counterparts. See SAM RICKETSON & JANE C. GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBORING RIGHTS: THE BERNE CONVENTION AND BEYOND § 1.20 at 19 (2d ed. 2005) ("[Most countries] did not regard the unauthorized exploitation of foreign works as either unfair or immoral."). Indeed, as Professor Ochoa observes, the 1909 Act's requirements of U.S. *printing* were likely intended to effectively limit U.S. copyright to works published first or simultaneously here. See 26 SANTA CLARA COMPUTER & HIGH TECH. L.J. at 291-92 & nn.34-35, 310 & nn.148-49. Moreover, any modern intuition against forfeiture based on failure to comply with statutory "formalities" cuts deeply against the grain of U.S. copyright history, including this Court's first landmark copyright decision, *Wheaton v. Peters*, 33 U.S. 591, 665 (1834). See generally Sprigman, 57 STAN. L. REV. at 485.

The improbable reasoning of *Twin Books* was extended – and given broad and incongruous practical effect – in *Guino*, where a work published abroad in 1917 was held, on authority of *Twin Books*, ineligible for restoration under Section 514, because it was not in the public domain (never having emerged from the *Twin Books* twilight state), but entitled instead to a full “life plus 70” term under a provision of the 1976 Act, 17 U.S.C. § 303, extending protection, commencing January 1, 1978, to works then “not in the public domain or copyrighted.” See *Guino*, 549 F.3d at 1187-90. Indeed, *Guino* adhered to the *Twin Books* interpretation after expressly acknowledging that a work published abroad – without notice – “millennia ago” would not be treated as in the public domain. *Id.* at 1190; see also *id.* (noting that “the reasoning of *Twin Books* can be, and has been, criticized”).

But as the history of the 1976 Act statute makes plain, the language of Section 303 was not meant to align it with the odd “copyright limbo” the *Twin Books* court would fashion two decades later – but instead to protect then-*unpublished* works, consistently with the epochal shift wrought by the 1976 Act from publication-based to “fixation”-based copyright. Directly contrary to the *Twin Books* rule, Congress understood that all *published* works were either “copyrighted” or “in the public domain.” See Ochoa, 26 SANTA CLARA COMPUTER & HIGH TECH. L.J. at 307-08 (“The notion that there were works that had been published, but were neither in the public domain nor copyrighted, simply did not exist in the minds of the legislature.”).

The *Twin Books* regime differs from Section 514’s in that it works an even sharper break with

tradition: it lacks congressional imprimatur; it shows even less concern for those who lawfully use public domain works; and it sows disagreement and uncertainty as to which works are subject to protection under Section 514. The *Twin Books* rule, indeed, is so extreme that the Court might find it constitutionally deficient (as well as statutorily erroneous) even if it were to rule for the Government on the constitutional power questions. But however the Court resolves those questions, it should take care not to allow the widely disuniform treatment of similar cases to persist – and should, at the least, take care to avoid even a tacit endorsement of the Ninth Circuit’s idiosyncratic and irretrievably flawed rule.

Even before the Ninth Circuit’s destabilizing decision, the question of foreign publication without notice had generated disagreement. Some authorities interpreted the 1909 Act as placing such works in the public domain, *see, e.g.*, 2 STEPHEN P. LADAS, *THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY* § 324, at 698 (1938) (“[N]o person is entitled to claim statutory copyright under the Act, unless, when first publishing the work abroad or in the United States, he has affixed the statutory notice.”), and the Copyright Office has long agreed, 37 C.F.R. § 202.2(a)(3) (2007), an approach Congress embraced unambiguously in the 1976 Act (but modified in 1989). By contrast, the Second Circuit in *Heim v. Universal Pictures Co.*, 154 F.2d 480 (2d Cir. 1946), viewed publication without notice abroad as triggering U.S. copyright protection.

But the distance between these competing approaches is nothing beside the wide expanse dividing both from the *Twin Books* regime. Both

rules – like Section 514, but not the Ninth Circuit’s rule – accept the essential public domain/protected dichotomy, without creating a third category.¹⁵ Moreover, although they do not always produce identical results, both rules, unlike the Ninth Circuit’s, make ascertaining public domain status (relatively) straightforward: Publication abroad without U.S. copyright notice either initiates public domain status or starts the copyright term, so publication dates determine both public domain status and eligibility for restoration (with earlier-published works in the permanent public domain and not restored under either).

In contrast, the *Guino* decision produces greater uncertainty and greater copyright protection for some older foreign works. It gives rise to terms of protection that start decades after a work is created and published, leading to situations where the work does not enter the public domain in the Ninth Circuit until 100 years after it would under the Second Circuit rule, and 130 years later than under the rule the Copyright Office identified as correct.¹⁶

¹⁵ Recognizing the public domain’s permanence, the *Twin Books* court carefully avoided calling the twilight copyable-but-also-copyrightable status by that name, see 83 F.3d at 1166 (“[A] publication of a work in the United States without the statutory notice of copyright fell into the public domain, *precluding forever any subsequent copyright protection of the published work.*”) (emphasis added).

¹⁶ For Google and others, the safest course in response to this confusion and conflict with respect to older foreign works is to err on the side of caution – thereby giving the court that has taken the most grudging view of what falls

It also denies parties who made use of the work after 1917, as *Twin Books* assured they lawfully could, even the limited protection the 1994 Act provides for reliance parties.

A decision granting petitioners judgment on their constitutional claims would necessarily indict the Ninth Circuit's *Twin Books* rule. As just explained, while the "restoration" effected by the 1994 Act was at least plainly intended by Congress, the Ninth Circuit's decision rests on a textually implausible and self-contradictory interpretation of a prior statute that contains not a hint of authority for a "limbo" status (and in fact supports the inviolability of the public domain), nor for preferential treatment of works by foreign authors first published outside the United States.

Even if the Ninth Circuit cases were not so manifestly infirm on conventional statutory interpretation grounds, the failure to provide even minimal protection for parties who created derivative works or otherwise exploited works during the decades they were, on the Ninth Circuit's own reasoning, subject to lawful copying makes its regime more constitutionally deficient than even the one before the Court. Thus, if the Court were to affirm the decision below and hold that the public domain is not entirely impregnable, it should take care to disclaim endorsement of these flawed lower court decisions.

within the public domain an effective veto over courts whose decisions are manifestly more legally sound.

CONCLUSION

The judgment of the court of appeals should be reversed.

Respectfully submitted,

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