# ADDRESS

# THE BALANCE OF ROBERT KASTENMEIER

LAWRENCE LESSIG*

*The Fifteenth Annual Kastenmeier Lecture*
*University of Wisconsin Law School*
*October 24, 2003*

Article I, Section 8, Clause 8 of the U.S. Constitution gives Congress the power "to promote the Progress of Science."[1] Congress exercises this power by granting "authors" and "inventors" limited-term monopolies for their creativity. Monopolies were the nuclear weapons of eighteenth century government—rarely, if ever, to be used, and inherently, and unavoidably, dangerous. Thus, the Framers were quite explicit about the narrow purpose for which these monopolies might be granted—"Progress"—and explicit about the limits that would restrict their scope—they were to be granted only "to Authors and Inventors," only for "Writings and Discoveries," and only for "limited Times."[2]

The Progress Clause is unique within the power granting clauses of Article I, Section 8.[3] It is the only clause that "describes both the objective which Congress may seek and the means to achieve it."[4] It was the first clause relied upon by the U.S. Supreme Court to strike a

---

* Professor Lawrence Lessig, C. Wendell and Edith M. Carlsmith Professor of Law, Stanford Law School. I am grateful to Adam Goldman, Alina Ng, and Darien Shanske for their excellent research support.

1. U.S. CONST. art. I, § 8, cl. 8.

2. *Id.*

3. *See* Lawrence B. Solum, *Congress's Power to Promote the Progress of Science:* Eldred v. Ashcroft, 36 LOY. L.A. L. REV. 1, 20 (2002) ("[T]he Intellectual Property Clause grants the power to pursue a goal and then qualifies that power by specifying the permissible means. In this respect, the Intellectual Property Clause is unique among the powers granted by the eighth Seetion of the first Article."); *see also* Eldred v. Reno, 239 F.3d 372, 382 (D.C. Cir. 2001) ("*Eldred I*") (Sentelle, J., dissenting in part); Dan T. Coenen & Paul J. Heald, *Means/Ends Analysis in Copyright Law:* Eldred v. Ashcroft *in One Act*, 36 Loy. L.A. L. REV. 99, 105–06 (2002). Judge Sentelle applied a means analysis to the Sonny Bono Copyright Term Extension Act of 1998, and concluded that "the means employed by Congress here are not the securing of the exclusive rights for a limited period, but rather are a different animal altogether: the extension of exclusivity previously secured. This is not within the means authorized by the Copyright Clause, and it is not constitutional." *Eldred I*, 239 F.3d at 382.

4. Goldstein v. California, 412 U.S. 546, 555 (1973).

statute of Congress for exceeding Congress's power:[5] long before there was a debate about the implied federalism limits in the grant of Article I powers,[6] without dissent, the Court had recognized the implied and express limits in the Progress Clause.

Yet when the Court was asked again in *Eldred v. Ashcroft* ("*Eldred*")[7] to enforce the limits of the Progress Clause, it balked. It is Congress, the Court held, that has the primary responsibility for enforcing the limits of the Clause.[8] The Court would not intervene so long as copyright remained within its "traditional contours."[9] This result was welcomed by some as an appropriate limit for the judicial role.[10] It was criticized by many more as essentially erasing any limit on Congress's power to extend terms.[11]

---

5. *See* The Trade-Mark Cases, 100 U.S. 82, 93–94 (1879) (holding an act of Congress unconstitutional for exceeding the grant of authority in the Progress Clause).

6. For a discussion of this debate in connection with the Commerce Clause, see, for example, Justice Souter's dissent in *United States v. Morrison*:

> [F]or significant periods of our history, the Court has defined the commerce power as plenary, unsusceptible to categorical exclusions, and this was the view expressed throughout the latter part of the 20th century in the substantial effects test. These two conceptions of the commerce power, plenary and categorically limited, are in fact old rivals, and today's revival of their competition summons up familiar history, a brief reprise of which may be helpful in posing what I take to be the key question going to the legitimacy of the majority's decision to breathe new life into the approach of categorical limitation.

529 U.S. 598, 640 (2000) (Souter, J., dissenting).

7. 537 U.S. 186 (2003).

8. *See id.* at 222.

9. *See id.* at 221 ("[W]hen, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary."). For an analysis of this language, see *infra* notes 66–68 and accompanying text.

10. *See, e.g.*, Thomas B. Nachbar, *Constructing Copyright's Mythology*, 6 GREEN BAG 2D 37, 43 (2002) ("Congress is in a much better position to decide what promotes progress than courts are. Indeed, it is virtually inconceivable that a world in which the Supreme Court decides what promotes the progress of knowledge would be better than a world in which Congress does."); Thomas B. Nachbar, *Judicial Review and the Quest to Keep Copyright Pure*, 2 J. ON TELECOMM. & HIGH TECH. L. 33, 34 (2003) [hereinafter Nachbar, *Judicial Review*] ("[*Eldred*] is a cause for celebration, not consternation, that the Court has decided to leave to Congress the task of making American copyright policy.").

Professor Nachbar criticizes the effort to "constitutionalize" copyright restrictions by suggesting the aim of *Eldred* was to constitutionalize "copyright policy":

> [O]pponents of copyright's expansion have turned to constitutional litigation in an effort to trump politics as a source of American copyright policy. Their claim is that the copyright policies embodied in the Constitution—and enforced by courts—represent a better vision of copyright law than what is currently being produced by the federal legislative process.
>
> These attempts to constitutionalize copyright law are misguided in both form and substance. Attempts to make the judiciary the guardian of

As counsel of record in *Eldred*, I won't pretend to agree with the Court's conclusion. But I do want to consider the conditions under which the decision makes sense. For however strained it is to imagine that our current Congress would adequately balance the legitimate need to secure authors' rights against the equally legitimate need to protect the public domain, I do believe there are conditions under which such a balance can be drawn. Indeed, there is a history to prove it.

My aim in this brief essay is to recount one small part of that history. Nothing general can be said about this one instance. Yet something particular can be learned. To the extent the institutional practice of copyright produced balance, this history demonstrates how tenuous this practice of balance is.

---

> copyright policy fail to acknowledge that judicial intervention in the legislative process can be justified only in narrow circumstances and that the making of copyright policy is not one of them.

Nachbar, *Judicial Review*, *supra*, at 33–34 (footnote omitted). This is just mistaken. As counsel for plaintiffs, I indicated directly in the very opening to the argument, petitioners did not advance

> a general theory of the Copyright Clause, or a general constraint under which Congress must operate. . . . It's not about general power of Congress to exercise its copyright authority. Petitioners have advanced a particular interpretation of the only express limits in the Copyright Clause designed to give those limits meaning.

Transcript of Oral Argument, *Eldred* (No. 01-618), *available at* 2002 WL 31309203, at *3. The question raised by *Eldred* was not whether the Court should set copyright *policy*; the question was whether the Court should set limits to the policy that Congress could set. 537 U.S. at 198. That Congress's role was to set limits seemed to be precisely what the Court had indicated in *Graham v. John Deere Co.*: "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. This is but a corollary to the grant to Congress of any Article I power." 383 U.S. I, 6 (1966).

11. *See, e.g.*, Cecil C. Kuhne, III, *Forcing the Copyright Genie Back into the Bottle: Public Policy Implications of Copyright Extension Legislation*, 33 SW. U. L. REV. 327, 328 (2004) ("[N]o legal principle has been expounded by the Supreme Court which would prevent yet another extension by Congress when the present term expires, and so this process could, theoretically at least, continue on *ad infinitum*, rendering meaningless the restriction in the Constitution that copyrights be for 'limited times.'"); Pamela Samuelson, *The Constitutional Law of Intellectual Property After* Eldred v. Ashcroft, 50 J. COPR. SOC'Y 547, 548 (2003) ("[S]ome expect the *Eldred* decision to 'deconstitutionalize' intellectual property law and reduce to a trickle further scholarly discourse about limits that the Intelleetual Property Clause, the First Amendment, or other provisions of the U.S. Constitution place on Congressional power to regulate in this field."); *cf.* WILLIAM M. LANDES & RICHARD A. POSNER, THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW 211 n.7 (2003) ("In light of [*Eldred*], it is unlikely that a system of indefinite renewals . . . would be held unconstitutional.").

### 1. EXTENDING TERMS

In 1998, Congress enacted the Sonny Bono Copyright Term Extension Act ("CTEA"),[12] which extended existing and future copyrights by twenty years.[13] CTEA had initially been proposed in 1995.[14] It was stalled by the insistence of some that an exemption for small restaurants be included in the statute.[15] In 1998, that exemption was agreed to, and the bill was enacted on a voice vote, without opposition.[16]

CTEA was opposed by a wide range of academics, led by Dennis Karjala.[17] But the opposition of the academics had little effect in Congress. That terms would be extended—for the eleventh time in forty years—was taken for granted by Congress.[18] As Congresswoman Mary Bono famously stated on the floor of the House:

> Sonny wanted the term of copyright protection to last forever. I am informed by staff that such a change would violate the Constitution. I invite all of you to work with me to strengthen our copyright laws in all of the ways available to us. As you know, there is also Jack Valenti's proposal for [a] term to last forever less one day. Perhaps the Committee may look at that next Congress.[19]

Bono's proposal confirmed an idea that had become the norm in Congress—that a term should be as long as it could possibly be. But the idea that terms should be extended has not always been obvious. Indeed, in light of the uncontroversial extension in 1998, it is useful to look back to a recent time when the idea was at least contested.

In 1962, leaders in Congress were convinced that Congress would soon complete a general revision of the Copyright Act of 1909. They were also convinced that the general revision would substantially

---

12. Pub. L. No. 105-298, 112 Stat. 2827 (1998) (amending 17 U.S.C.).

13. *See id.* § 102(b), (d), 112 Stat. at 2827–28 (amending 17 U.S.C. §§ 302, 304 (1994)).

14. Copyright Term Extension Act of 1995, S. 483, 104th Cong. (1995).

15. *See, e.g.*, 142 CONG. REC. S2192–93 (daily ed. Mar. 15, 1996) (statement of Sen. Hatch) (introducing an amendment to exempt small commercial establishments).

16. S. 505, 105th Cong. § 202(a) (1998) (enacted) (codified at 17 U.S.C. § 110(5)(B) (2000)); *see also* CONG. QUARTERLY: 1998 ALMANAC E-13 (1999) (noting that the CTEA passed both houses by voice vote).

17. *See, e.g.*, Dennis S. Karjala, *Judicial Review of Copyright Term Extension Legislation*, 36 LOY. L.A. L. REV. 199 (2002).

18. *See infra* notes 21–23 and accompanying text (citing ten extensions of copyright terms between 1962 and 1976).

19. 144 CONG. REC. H9951–52 (daily ed. Oct. 7, 1998) (statement of Rep. Bono).

increase the copyright term. Historically, Congress's practice had been to grant to existing copyright holders the benefit of any increase pursuant to a general revision of copyright; therefore, there were many copyright holders, whose copyrights were to expire in 1962, who felt that Congress's slowness was working a substantial unfairness to them. Congress's delay meant their loss, and that led some to ask Congress to insure them against its delay—by extending the term of copyrights set to expire in 1962.[20]

One could well question the sense of injustice relied upon by these copyright holders. When the authors who created those works copyrighted them in 1906, they expected a maximum term of fifty-six years. Congress had not reneged on that bargain; it had delivered on its promise to secure to the author and his assigns a monopoly for a length that was twice the maximum length our Framers had established. Adding years onto the term now was not demanded by any justice related to the actual work created. It was instead a justice grounded in the desire to minimize unfairness surrounding an undeserved windfall. No doubt, no one deserved to have his copyright term extended. But *if* terms were going to be extended, it wouldn't be fair, some thought, for particular copyright holders to lose the benefit of that undeserved gain merely because Congress was slow.

No doubt there are stronger claims to justice. But Congress doesn't necessarily deal with the stronger claims first. And without any recorded opposition, Congress passed the extension of existing copyright terms: those that had not expired before the law was passed were extended through 1965.[21]

This single act became a habit which would be repeated nine times in the next fifteen years. In each year, the argument was much the

---

20. For example, Herman Finkelstein, General Attorney for the American Society of Composers, Authors & Publishers (ASCAP), testified:

> The purpose of House Joint Resolution 627 is to preserve the copyright status of those works which would otherwise fall into the public domain during the next 5 years, so that those works can enjoy the benefits of the revised law, even though the revision may not become law until after the copyrights would otherwise expire. It will put these works in the same class as those whose subsisting copyrights may not expire until after the enactment of general revision of the copyright law.

*Extending the Duration of Copyright Protection in Certain Cases: Hearing on H.J. Res. 627 Before Subcomm. No. 3 of the House Comm. on the Judiciary*, 87th Cong. 78 (1962) [hereinafter *Hearing on H.J. 627*] (testimony of Herman Finkelstein, General Attorney, ASCAP).

21. Act of Sept. 19, 1962, Pub. L. No. 87-668, 76 Stat. 555 ("[I]n any case in which the renewal term of copyright subsisting in any work on the date of approval of this resolution would expire prior to December 31, 1965, such term is hereby continued until December 31, 1965.").

same. In 1965, Congress was again not finished with the general revision of copyright law. It was again not likely to complete the law anytime soon. Copyright holders from 1907 felt they should be entitled to the same benefit Congress had granted copyright holders in 1962. In response, Congress passed another extension of existing copyright terms; the same thing happened again in 1967, 1968, 1969, 1970, 1971, 1972, and 1974.[22]

So much is familiar to anyone familiar with the decision in *Eldred*. Plaintiffs made this practice, culminating in the Copyright Act of 1976, which extended the terms of existing copyrights by nineteen years,[23] and then CTEA, first introduced nineteen years after the Copyright Act of 1976 and extending terms twenty years,[24] a core element in their attack.[25] Congress was in the habit of extending existing terms.[26] There was nothing to indicate that this habit would change. And indeed, there was everything to predict that when the latest extension expired, the same interests that had produced that extension would be back asking for more. As Judge Sentelle observed, "Congress may at or before the end of each such 'limited period' enact a new extension, apparently without limitation."[27]

But this litigation story hides a more complicated history. And this more complicated history reveals much about a balance that existed around copyright legislation until relatively recently.

---

22. Act of Dec. 31, 1974, Pub. L. No. 93-573, 88 Stat. 1873; Act of Oct. 25, 1972, Pub. L. No. 92-566, 86 Stat. 1181; Act of Nov. 24, 1971, Pub. L. No. 92-170, 85 Stat. 490; Act of Dec. 17, 1970, Pub. L. No. 91-555, 84 Stat. 1441; Act of Dec. 16, 1969, Pub. L. No. 91-147, 83 Stat. 360; Act of July 23, 1968, Pub. L. No. 90-416, 82 Stat. 397; Act of Nov. 16, 1967, Pub. L. No. 90-141, 81 Stat. 464; Act of Aug. 28, 1965, Pub. L. No. 89-142, 79 Stat. 581.

23. Pub. L. No. 94-553 § 304(a), 90 Stat. 2541, 2573–74 (1976).

24. § 102(b), (d), 112 Stat. at 2827–28; *see also supra* notes 12–13 and accompanying text.

25. Brief for Petitioners at 2–3 & n.1, *Eldred* (No. 01-618).

26. *See supra* notes 21–22 and accompanying text.

27. Eldred v. Ashcroft, 255 F.3d 849, 854 (D.C. Cir. 2001) ("*Eldred II*") (Sentelle, J., dissenting from denial of rehearing en banc). Judge Sentelle raised a similar objection in his dissent from the *Eldred I* decision:

> [T]here is no apparent substantive 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.

239 F.3d at 382 (Sentelle, J., dissenting in part).

## II. PRINCIPLED INTUITIONS

Though in defending Congress's most recent extension of copyright terms, the government could find nothing to question about either the wisdom or validity of such extensions, this was not always the government's view. In 1962, the U.S. Department of Justice (DOJ), when asked about extending the terms of existing copyrights, opposed that extension. In response to an inquiry by Congressman Emanuel Celler, Chairman of the Committee on the Judiciary, Acting Deputy Attorney General Nicholas Katzenbach replied:

> The Department of Justice is opposed to lengthening the period of copyrights. Copyrights (and patents) are forms of monopolies and should not be extended for periods longer than those now provided by law. The present 56-year monopoly granted to authors is in our view fully adequate to reward authors for their contributions to society. Considering this matter from the viewpoint of the public, which is interested in the early passing of copyrighted material into the public domain, it would seem unwise to extend further the copyright monopoly.[28]

While the reasoning behind this opposition was not fully developed, the intuitions are obvious—Congress is granted the power to secure monopolies as a means to promote progress. No doubt the contours that will best advance progress are complex. But if that progress is meant to create an incentive for the creation of new works, then extending the term of an existing copyright does not promote progress. Rather, extending an existing right—in exchange for no new creativity at all—is simple rent-seeking, precisely the pathology the Framers were seeking to avoid.

This intuition guided Katzenbach's advice. Congress was not abolishing the traditional nature of limited term copyright. There was therefore no principled reason not to simply allow existing copyrights to expire according to their term. By extending these copyrights once, Congress risked precisely the pattern that it would soon enter into—repeated extensions with no balancing limit.

The DOJ's advice was ignored in 1962. And from the direct record we have, there was not any more sustained opposition to Congress's practice until 1967. In that year, Congressman John

---

28. *Hearing on H.J. 627*, *supra* note 20, at 88–89 (letter from Nicholas deB. Katzenbach, Acting Deputy Attorney General, to Congressman Emanuel Celler (May 2, 1962)).

Dingell, Jr. began a crusade against these extensions that is all but forgotten today.[29]

Dingell was an unlikely advocate for the public domain. Elected in 1955[30] to the seat his father had held since 1933,[31] Dingell's legislative focus was energy and commerce.[32] But the character of these extensions troubled the Congressman. And in November 1967, he began a war against extensions that would never ultimately succeed, but that did mark the last sustained congressional opposition to this repeated practice of Congress. As Dingell stated on the floor of the House:

> [W]e are essentially conferring additional rights not contemplated by law, nor sanctioned by practice, and not required by any reasonable protection legitimate of interest of those persons who are the holders of copyrights.
>
> . . . This legislation as a matter of public policy is very bad. This establishes a new copyright policy that is not in conformity with the requirements of the American people . . . that those works of literary value and genius should be protected for a reasonable period of time because of the need to stimulate and to encourage the contribution of those who participate in the creative arts.
>
> . . . .
>
> There is no justification for this. . . .
>
> . . . .
>
> This is the sheerest kind of special interest legislation.[33]

One member of the subcommittee of the House Judiciary Committee that dealt with copyright policy[34] was Congressman Robert Kastenmeier. Kastenmeier responded to Dingell with a tone that expressed more impatience than disagreement: "Mr. Speaker, the House has already spoken many times on the question that the

---

29. *See* 113 CONG. REC. 31,300-01 (1967) (statement of Rep. Dingell).

30. CQ'S POLITICS IN AMERICA 2002: THE 107TH CONGRESS 530 (Brian Nutting & H. Amy Stern eds., 2001).

31. *Id.*

32. *Id.* at 530-31.

33. 113 CONG. REC. at 31,300-01 (statement of Rep. Dingell).

34. At the time, this subcommittee was referred to simply as Subcommittee No. 3. *See* CHARLES B. BROWNSON, 1967 CONGRESSIONAL STAFF DIRECTORY 250 (1967).

gentleman from Michigan has raised. The House has decided that existing copyrights should be continued while the Congress was in process of general revision."[35]

This was the party line. Copyrights were to be extended while Congress was in the process of general revision.

Yet, when the issue returned two years later, Dingell remained unconvinced. Congress was still not finished with the revision. It was not even clear when the revision would be complete. Yet, Congress was being asked for the seventh time to extend existing copyrights.[36] Dingell wanted to know when this practice would end: "I would also ask the gentleman how many more times are we going to [find] the House extending copyrights, and preventing [work] from properly going into the public domain as the framers of copyright law intended."[37]

This time, Kastenmeier, now chair of the subcommittee, had an answer:

> I would say that the Librarian of Congress in his report to the House . . . stated:
>
> It is important that this fifth interim extension of subsisting copyright be the last of the series—
>
> I can say personally, and I think I speak for the members of my subcommittee on this, that we expect this to be the last. I do not expect to again come back and ask for another one of these extensions.[38]

Congressman Richard Poff then promised that this would be his last time voting to support an extension of existing terms.[39]

But it was not Congress's last time. In 1972, Congress was asked again to extend existing terms. Dingell was no happier about this extension than any before:

> [T]he fact of the matter is this bill stinks. . . . [I]t does not take care of the public's interest.

---

35. 113 CONG. REC. at 31,301 (statement of Rep. Kastenmeier).

36. This was the fifth interim extension of existing copyrights, and the seventh overall: 1831, 1909, 1962, 1965, 1967, 1968, and 1969. 83 Stat. 360; 82 Stat. 397; 81 Stat. 464; 79 Stat. 581; 76 Stat. 555; Act of Mar. 4, 1909, ch. 320, §§ 23–24, 35 Stat. 1075, 1080–81; Act of Feb. 3, 1831, ch. 16, §§ 1, 16, 4 Stat. 436, 436, 439; *see also Eldred*, 537 U.S. at 194–96 (noting that the 1831 and 1909 acts extended existing copyright terms).

37. 115 CONG. REC. 36,065 (1969) (statement of Rep. Dingell).

38. *Id.* (statement of Rep. Kastenmeier).

39. *Id.* (statement of Rep. Poff).

. . . .

. . . [W]e are not talking about rewarding people who have done something, we are talking about their heirs and assignees. I think it ought to be very plain that what we are doing here is not seeking to reward initiative or invention, or anything of that sort; we are simply rewarding somebody because they made a clever deal and have gotten through the Congress provisions year after year after year for the extension of a copyright. This does nothing except put it to the people at large.

Everybody knew what those copyrights did when they got them, and everybody knew what they did when they inherited them, or bought them, but here is the Congress of the United States extending them again at the expense of the public. Somebody has got to pay the money that is going to fall into the hands of people who are going to be unjustly enriched by this legislation, and it is the public. And I say as the public's representatives we ought to reject this outrageous bill for good and all.[40]

This time, however, the chairman of the subcommittee finally agreed. As Kastenmeier explained:

We are asked to breathe life into something which has expired, which is dead or should have died. We are asked to extend the life of a copyright obtained 56 years ago under the law as it then existed.

. . . .

. . . [W]e got into this situation 10 years ago, in 1962, when we granted a 3-year extension of subsisting copyrights because in the warm glow of anticipation of copyright revision we thought it was an equitable thing to do . . . . I believe we have long since concluded we were wrong, because in 1965 we were asked to extend the matter 2 years, which we did; in 1967 for another year, which we did; in 1968 for I more year, which we did.

40. 118 CONG. REC. 35,065 (1972) (statement of Rep. Dingell).

> Then some of us on this subcommittee promised our colleagues we would be back no longer asking for these annual extensions. So in 1969 Mr. Poff and 1 said it would be the last time.
>
> In 1970, our chairman took up the cudgel, and in 1971 he himself indicated he would no longer seek these extensions . . . .
>
> Yet we are here again tonight doing so, 1 regret to say.
>
> . . . .
>
> We should in fact allow them to die, as they were intended to die in the year 1909. At that time we told the author he would have 56 years and not a day more.[41]

Kastenmeier opposed that extension. And then in 1974, he raised the issue again:

> I cannot concur in the action of my colleagues in ordering a further extension of expiring renewal terms of copyright. I continue to be of the opinion that in too many instances the measure will operate to provide an unjustifiable windfall at the expense of the public domain.[42]

And Dingell, with pleasure, piled on:

> And what is the real thrust of the bill? The real thrust of the bill is to extend copyrights—to extend copyrights. And whom does it extend them for? For the authors, for their heirs, for a bunch of poor old ladies who hold copyrights? By no means—not for old ladies, not for heirs, not for anybody other than the big publishing houses who are going to have their copyrights extended for the ninth time.
>
> . . . .
>
> Mr. Speaker, they are going to figure out how to extort further from the reading public, the listening public, and the consuming public.[43]

---

41. *Id.* at 35,064 (statement of Rep. Kastenmeier).
42. 120 CONG. REC. 41,414 (1974) (statement of Rep. Kastenmeier).
43. *Id.* at 41,416-17 (statement of Rep. Dingell).

This shift in the position of Kastenmeier is the point upon which I want to focus. When perhaps the most important member of Congress, with respect to intellectual property, confesses error, it is a confession to note. Yet, this confession evinces a practice, not an exception. It is an instance of the character that Kastenmeier brought to deliberations about intellectual property.

Kastenmeier was no softy when it came to the importance of intellectual property. As chair of the Courts, Intellectual Property, and the Administration of Justice Subcommittee of the House Committee on the Judiciary from 1969 to 1990,[44] he oversaw a broad range of changes to copyright and patent law.[45] These changes, in general, strengthened the scope and protection of intellectual property.[46]

But they were changes undertaken within a framework that Kastenmeier set. That framework was familiar to the tradition that defined copyright law from the founding. That tradition asks not how to maximize intellectual property protection. It asks, instead, how to balance the necessary protections of copyright—necessary to assure commercial incentives to create—with the important limitations to assure public and consumer access to creative work.

That balance, however, has historically been complicated with a second set of welfare-based objectives. Copyright law has always, secondarily, been concerned with assuring an adequate reward to authors and their heirs, so as to perfect the incentives that authors have to create copyrightable work. This interest has been called the equity interest—to assure equity to creators. And that guarantee, no doubt, was the original motivation for the extensions of copyright term.

But as Kastenmeier recognized, that justification, however vague, must have a limit. And twelve years into these interim extensions, that limit was reached. Kastenmeier then insisted that in the final revision to

---

44. The subcommittee dealing with intellectual property has changed names several times over the years. Called Subcommittee No. 3—Patents, Trademarks, Copyrights, and Revision of the Laws in 1962, and still in 1969 when Kastenmeier became chair, it was renamed the Subcommittee on Courts, Civil Liberties and Administration of Justice in 1973. *See* HOUSE COMM. ON THE JUDICIARY, 97TH CONG., HISTORY OF THE COMM. ON THE JUDICIARY OF THE HOUSE OF REPRESENTATIVES 10–12 (Comm. Print 1982); *see also* David Corn, *Alas, Kastenmeier: A Non-Rascal Thrown Out*, NATION, Dec. 17, 1990, at 768 (Kastenmeier served as chairman of the subcommittee for twenty-one years). In 1990, Kastenmeier's final year as chair of the subcommittee, it was called the Subcommittee on Courts, Intellectual Property, and the Administration of Justice. *See* 1989–1990 OFFICIAL CONGRESSIONAL DIRECTORY: 101ST CONGRESS 397 (1989); *see also Fond Farewell*, NAT'L L.J., Nov. 26, 1990, at 12 (noting that Kastenmeier was not reelected in 1990).

45. *See* Ralph Oman, *Bob Kastenmeier and the Legislative Process: Sui Generis and Proud of It*, 55 LAW & CONTEMP. PROBS., Spring 1992, at 241.

46. *See id.* at 242.

the Copyright Act of 1976, every copyright holder would get the same extension, but no more: a total of seventy-five years of protection (the fifty-six years from the 1909 Act, plus nineteen in extensions), rather than adding nineteen years to whatever term the copyright owners had in 1976. As such, this was not seen so much as an addition of nineteen years, but rather, a shift from a fifty-six-year term to a seventy-five-year term. The goal was to reach a plateau, or end point, of seventy-five years. This was to reward the author, whose average longevity had measurably increased since 1909.[47] The focus was long term: what had changed since 1909, not what had changed recently.[48]

### *A. Practice of Balance*

The judgment reflected in the limit that Kastenmeier would have drawn in the extensions to existing terms was not the product of an equation. It was instead the consequence of a practice. As others have noted before, Kastenmeier used his power as chairman to practice this balance in the manner in which copyright reform was considered.[49] The balance Kastenmeier's practice sought to achieve included not only creators and consumers, but also distributors-publishers; hence, his goal of maintaining the balance of a "three-legged stool."[50]

---

47. *See* 122 CONG. REC. 31,981 (1976) (statement of Rep. Hutchinson).

48. *See, e.g., id.* (statement of Rep. Hutchinson) ("First, life expectancy has increased considerably since the present 56-year maximums were written into law in 1909. Second, the tremendous growth in communication media has substantially lengthened the commercial life of a great many works."); *id.* at 2834 (statement of Sen. McClellan) ("As life expectancy has increased, the existing 56-year term does not insure that an author and his dependents will receive reasonable monetary recognition throughout their life.").

49. On Kastenmeier's record generally, see the essays collected in his honor in Symposium, *Copyright and Legislation: The Kastenmeier Years*, 55 LAW & CONTEMP. PROBS., Spring 1992, at 1, and particularly the contributions from John A. Kidwell, *Congressman Robert Kastenmeier and Professor John Stedman: A Thirty-Five Year Relationship*, 55 LAW & CONTEMP. PROBS. 129, Spring 1992, at 132–34 (describing Kastenmeier as an exemplary listener and detailing in particular his listening to Professor John Stedman, whose "touchstone was the public interest"); Oman, *supra* note 45 (describing working with Kastenmeier and giving him significant credit for the success of copyright industries during his tenure because of the balance he helped strike); Leo J. Raskind, *Grading the Performance of a Legislator*, 55 LAW & CONTEMP. PROBS., Spring 1992, at 267 (evaluating Kastenmeier's tenure as a success because of his concern with the public interest, manifested both through the laws he passed and the testimony he contributed); Michael J. Remington, *Robert W. Kastenmeier: Copyright Legislator* Par Excellence, 55 LAW & CONTEMP. PROBS., Spring 1992, at 297 [hereinafter Remington, *Copyright Legislator*] (detailing Kastenmeier's legislative career and philosophy as justifying the praise he received from both sides of the aisle when he left Congress).

50. Michael J. Remington, *The Ever-Whirling Cycle of Change: Copyright and Cyberspace*, 3 N.C. J.L. & TECH. 213, 247–48 (2002). Kastenmeier was also interested in achieving balance in the sense of partisan politics, an endeavor in which he was

Kastenmeier himself recognized that this practice needed to be institutionalized because it transcended the skills, interests, and integrity of any one legislator.[51] Reflecting on the approach that had been taken to the Semiconductor Chip Protection Act of 1984, Kastenmeier and his committee's chief counsel, Michael Remington, wrote a well-regarded article that detailed the test that was used, and should be used in the future, to evaluate the provision of additional copyright protection.[52] Explicitly following David Lange,[53] they proposed a "civil procedure" for the ad hoc extension of copyright protection, articulating their oft-cited four-part political test.[54]

The four parts of the test are briefly as follows:

---

apparently rather successful given the accolades he received from across the aisle. *See* Remington, *Copyright Legislator*, *supra* note 49, at 300–01; *Federal Bench Mourns Loss of Kastenmeier*, NAT'L L.J., Nov. 26, 1990, at 5 (quotes from Chief Justices Rehnquist and Burger). This respect was echoed by the editors of the *National Law Journal*. *See Fond Farewell*, *supra* note 44, at 12.

51. On Kastenmeier's personal integrity, see Corn, *supra* note 44, at 768, 770 ("Kastenmeier did not milk the subcommittee, nor did he run it to score political points. He chaired it to promote a set of principles.").

52. Robert W. Kastenmeier & Michael J. Remington, *The Semiconductor Chip Protection Act of 1984: A Swamp or Firm Ground?*, 70 MINN. L. REV. 417 (1985).

53. *Id.* at 440.

54. *Id.* As Kastenmeier and Remington put it:

> Without the application of a set of strict standards to a new proposal in copyright legislation there is a danger that the proposal will creep outside of the larger copyright scheme, creating an inconsistency with prior law and causing ramifications for the public and creative community far beyond the initial error.
>
> Therefore, in the tradition of courts of law and other deliberative institutions, the consideration of intellectual property issues should be governed by standards and procedures that are understood in advance and applied uniformly from case to case. At the outset, the proponents of change should have the burden of showing that a meritorious public purpose is served by the proposed congressional action. Whether the proponents of change have met this burden can be measured against a political test.

*Id.* at 439–40 (footnote omitted). This test is cited as generally providing the appropriate approach and in greater detail evaluating specific pieces of legislation. For examples of the test applied generally, see Mark A. Lemley, *The Constitutionalization of Technology Law*, 15 BERKELEY TECH. L.J. 529, 532 n.17 (2000); Michael J. Madison, *Legal-Ware: Contract and Copyright in the Digital Age*, 67 FORDHAM L. REV. 1025, 1079 & n.190 (1998); Harvey S. Perlman, *Taking the Protection-Access Tradeoff Seriously*, 53 VAND. L. REV. 1831, 1840 (2000); Letter from Pamela Samuelson, Professor of Law, University of California at Berkeley, to Representative Howard Coble, Chairman, Subcommittee on Courts and Intellectual Property (Oct. 23, 1997), http://www.arl.org/info/frn/copy/psamlet.html (last updated Apr. 30, 1998). For examples of the test applied in detail, see Stuart Talley, *Performance Rights in Sound Recordings: Is There Justification in the Age of Digital Broadcasting?*, 28 BEVERLY HILLS B. ASS'N J. 79, 85–101 (1994); Edward C. Walterscheid, *The Need for a Uniform Government Patent Policy: The D.O.E. Example*, 3 HARV. J.L. & TECH. 103, 155–64 & nn.210, 248 (1990).

First, the proponent of a new interest ought to show that the interest can fit harmoniously within the existing legal framework without violating existing principles or basic concepts. The proponent must further indicate whether fundamental aspects of current law, such as the term of protection and exclusive rights, are compatible with the protection sought for the new interest. Degradation of current law must not be allowed. . . .

Second, the proponent of a new intellectual property interest must be able to commit the new expression to a reasonably clear and satisfactory definition. The interest should be defined both in terms of what it is and what it is not. Lack of definitional clarity is unfair to the agency that administers the law and the courts that interpret it. Further, any legal interest that cannot be explained to elected members of Congress certainly should not be scheduled for a vote. Uncertainty in the law is perhaps most unfair to the public, which must understand the law to obey and exercise its rights. Proponents must be scrupulously honest on the issue of retroactivity (today's protection for yesterday's rights) or retrospectivity (tomorrow's protection of yesterday's rights), because ambiguity affecting the public domain can wreak havoc with both individual rights and previously made financial decisions. Additionally, any exception to the new protectable interest, be it defined in terms of fair use, reverse engineering, or innocent infringement, must be clarified and reaffirmed.

Third, the proponent of change should present an honest analysis of all the costs and henefits of the proposed legislation. The proponent must show the difference between the status quo and the future contemplated by the legislation. . . .

Fourth, any advocate of a new protectable interest should show on the record how giving protection to that interest will enrich or enhance the aggregate public domain. The aggregate public benefit should outweigh the proprietary gains which result from protection. Congress can safely move forward if the cost to the public of the monopoly is deemed to

> be less than the value to the public of the total benefits caused by the law.[55]

These principles set a framework within which intellectual property law was directed and this framework was institutionalized by Kastenmeier's chairmanship. Proposals to change the contours of copyright were limited, or supported, by this framework of analysis. It set the terms upon which the debate over intellectual property was set.

This practice is the very best that one might hope for from a legislative process defining the scope of copyright. Against the background of these principles, and the practice they evinced, the deference to Congress that the Court recognized in *Eldred* made sense. No doubt these questions are hard and contestable. No doubt there are many right answers. And where there are many right answers, the courts should stay away.

Yet, this history also reveals an extraordinary contingency in this practice of balance. For without the leadership of this single Congressman, there is no assurance that the institution will continue the practice. It is the benefit of the power of the chair that Kastenmeier could force intellectual property through this rationalizing process. But it is the cost of the power of the chair that when the chair changes, practices change. And without Kastenmeier's discipline, the expectation of many—realized in the results—was that balance would be lost. The interests favoring the extension of protection have no obvious counter. There is, so far, no effective lobby for the public domain. There is, therefore, no obvious set of interests to resist the expansion of control. And thus, without an institutional commitment to the principle of balance, such balance would be lost.

That loss of balance, through the loss of this practice, is the history of the last thirteen years. Kastenmeier left the House in 1991.[56] With Kastenmeier's departure, the subcommittee lost "the most knowledgeable member of Congress with respect to [copyright] issues."[57] And since his departure, the subcommittee chairmanship has

---

55. Kastenmeier & Remington, *supra* note 52, at 440–42 (footnotes omitted).

56. *See Fond Farewell*, *supra* note 44, at 12 (noting that Kastenmeier lost reelection in 1990).

57. Sheldon W. Halpern, *Copyright Law in the Digital Age:* Malum in Se *and* Malum Prohibitum, 4 MARQ. INTELL. PROP. L. REV. 1, 12 (2000). Professor Halpern explains:

> One of the changes that occurred . . . was when Robert Kastenmeier was not reelected. For literally decades, he was the center of all intellectual property activity in Congress. He was the most knowledgeable member of Congress with respect to these issues, and nothing could happen to change the Copyright Act without his intervention. The result was that the learning—the expertise that had been developed—also served as a kind of

changed hands four times.[58] As Professor Sheldon W. Halpern has observed, the result has been "a group of very specialized interests with very specialized concerns fighting about minutiae. The congressional response has been to try to accommodate those interests, so we get very specialized, overspecified legislation. I think that would not have happened with the kind of leadership that Kastenmeier had."[59] But it is equally clear that the absence of such an influence upon the legislative process will mean that the product of such legislation will not have characteristics meriting deference.[60]

This was certainly the case by the time of Congress's second major extension of copyright terms in 1998.[61] The CTEA extended the terms of existing and future copyrights by twenty years.[62] By this point, some works' copyrights had already been extended eleven times.[63] The

---

public interest representation in Congress. Well, he's not there, and no one has really emerged to take his place.

*Id.*

58. Congressman William J. Hughes (D-N.J.) led the subcommittee from 1991 to 1994. *See* 1991 CONGRESSIONAL STAFF DIRECTORY/1, at 617 (Ann L. Brownson ed., 1991); 1992 CONGRESSIONAL STAFF DIRECTORY/1, at 604 (Ann L. Brownson ed., 1992); 1993 CONGRESSIONAL STAFF DIRECTORY/1, at 723 (Ann L. Brownson ed., 1993); 1994 CONGRESSIONAL STAFF DIRECTORY/1, at 724 (Ann L. Brownson ed., 1994). Congressman Carlos J. Moorhead (R-Cal.) chaired the subcommittee from 1995 to 1996. *See* 1995 SUMMER CONGRESSIONAL STAFF DIRECTORY/1, at 717 (Ann L. Brownson ed., 1995); 1996 CONGRESSIONAL STAFF DIRECTORY SUMMER 758 (1996). Congressman Howard Coble (R-N.C.) headed the subcommittee from 1997 to 2002. *See* 1997 CONGRESSIONAL STAFF DIRECTORY SUMMER 754 (1997); 1998/SUMMER CONGRESSIONAL STAFF DIRECTORY 789 (1998); 1999/SUMMER CONGRESSIONAL STAFF DIRECTORY 680 (1999); 2000/FALL CONGRESSIONAL STAFF DIRECTORY 686 (2000); 2001/SUMMER CONGRESSIONAL STAFF DIRECTORY 691 (2001); 2002/SUMMER CONGRESSIONAL STAFF DIRECTORY 706 (2002). Congressman Lamar Smith (R-Tex.) has led the subcommittee since 2003. *See* 2003/SUMMER CONGRESSIONAL STAFF DIRECTORY 712 (2003); 2004/SUMMER CONGRESSIONAL STAFF DIRECTORY 719 (2004).

59. Halpern, *supra* note 57, at 12.

60. For a compelling description of how Congress defers to special interests in matters of copyright legislation, see William F. Patry, *Copyright and the Legislative Process: A Personal Perspective*, 14 CARDOZO ARTS & ENT. L.J. 139 (1996).

61. William Patry describes an effort that he, as copyright counsel to the U.S. House of Representative's Judiciary Committee, rebuffed in 1994. William Patry, *The United States and International Copyright Law: From Berne to* Eldred, 40 HOUS. L. REV. 749, 754 (2003) [hereinafter Patry, *From Berne to* Eldred]. As he comments, "[w]ith the Republican takeover of the House after the 1994 elections, a new regime was installed in the House and the efforts to pass a term extension bill were met with a quite receptive audience." *Id.* at 754.

62. § 102(b), (d), 112 Stat. at 2827–28; *see supra* notes 12–13 and accompanying text.

63. For example, a 1906 work whose copyright was registered and later renewed would have had its term extended in 1909, 1962, 1965, 1967, 1968, 1969, 1970, 1971, 1972, 1974, and 1976. § 304(a), 90 Stat. at 2573–74; 88 Stat. 1873; 86 Stat. 1181; 85 Stat. 490; 84 Stat. 1441; 83 Stat. 360; 82 Stat. 397; 81 Stat. 464; 79 Stat. 581; 76 Stat. 555; ch. 320, §§ 23–24, 35 Stat. at 1080–81. U.S. Representatives John

justifications for this extension (as applied retrospectively) were no stronger than the justifications rejected by Kastenmeier in the past. But by now, the voices of Kastenmeier, and Dingell, were silent. The march toward "perpetual copyright on the installment plan"[64] was all but unstoppable.

## III. CONCLUSION

The scope of a court's jurisdiction cannot turn upon the membership of a House subcommittee. But the conditions under which deference to a legislative process make sense certainly can.

What's striking about the Supreme Court's jurisprudence of deference is not that it defers, but that the theory behind its deference has no obvious relation to either the facts about how Congress functions, or the nature of the interests affected. That the Court refuses to defer in the context of federalism—where the interests assuring balance have strong institutional standing, and where any "limits" in the Constitution are uncertain at best—and yet defers in the context of the speech regulation we call copyright—where the interests assuring balance are accidental, and the constitutional limits clear—is, we might say, charitably, so far unexplained.

One can well believe that significant deference to Congress is merited in this context, as in others. But the concern that *Eldred* raises, in light of the loss of institutional balance, is that lobbyists will read the decision as obliterating any limit at all. As William Patry, former copyright counsel to the House Judiciary Committee comments: "Without the check that the Court provides on Congress, there may be little incentive for Congress to act cautiously. Without that check, we will all lose in the end."[65] Or, one might note, without the check of a conscientious legislator.

There is in fact some hope in the Court's decision in *Eldred*. Significantly, this hope ties to the tradition of balance that Kastenmeier helped build. In rejectiug both the plaintiffs' request that every

---

Dingell and Robert Kastenmeier discussed this fact on the floor of the U.S. House of Representatives:

> Mr. DINGELL. Let me ask my friend, the gentleman from Wisconsin . . . How old are some of the oldest copyrights involved in this?
>
> Mr. KASTENMEIER. . . . [T]hey are from 1906 . . . . Normally those obtained in 1906 would expire 56 years thereafter, in 1962. In 1962 Congress decided to extend these copyrights and they will have been extended nine times [between 1909 and 1962].

120 CONG. REC. at 41,417 (statements of Rep. Dingell and Rep. Kastenmeier).

64. *The Copyright Term Extension Act of 1995: Hearing on S. 483 Before the Senate Comm. on the Judiciary*, 104th Cong. 73 (1997) (prepared statement of Peter A. Jaszi, Professor, American University, Washington College of Law).

65. Patry, *From Berne to* Eldred, *supra* note 61, at 757–58.

copyright act be tested under First Amendment review, and the government's request to affirm a decision that had held copyrights "'categorically immune from challenges under the First Amendment,'"[66] the Court instead anchored First Amendment review to the "traditional contours" of copyright protection.[67] If Congress preserves that tradition, no "further First Amendment scrutiny" is necessary.[68] But if Congress changes those "traditional contours," then, by implication, further First Amendment review is appropriate.

This rule ratifies a tradition; it focuses judicial scrutiny upon changes in that tradition. It thus permits the consequences of this loss in institutional balance to be recognized, against a background built by a different practice, and different institution. The shadow of Kastenmeier may thus not constrain Congress directly. But *Eldred* means that it may continue to constrain Congress, indirectly.

66. *Eldred*, 537 U.S. at 221 (quoting *Eldred I*, 239 F.3d at 375).
67. *Id.*
68. *See id.*

*  *  *