Traditional Contours in IP: Before and After Golan and Prometheus

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TRADITIONAL CONTOURS IN INTELLECTUAL PROPERTY: BEFORE AND AFTER GOLAN AND PROMETHEUS

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The U.S. Supreme Court will hear two intellectual property cases this term: *Golan v. Holder*, asking whether foreign works can have their copyrights restored without violating traditional contours of copyright law, and *Mayo v. Prometheus*, asking whether a patent on medical diagnostic test violates the traditional boundaries of patentable subject matter. Interestingly, both petitioners have asserted First Amendment arguments, which harkens back to Ginsburg’s statement in *Eldred v. Ashcroft* that so long as traditional contours of copyright law were not violated, no First Amendment analysis was necessary. Just what are traditional contours of copyright law? And does traditional contours apply to patent law as well? *Eldred* left the term undefined. This article begins with *Eldred*, explores the last ten years of case law and scholarship, and then turns to the recent U.S. Supreme Court *Golan v. Holder* decision, where we see Ginsburg now authoring a very different version of traditional contours, even less developed than in *Eldred*. The article then turns to imagining what a well-thought out traditional contours definition would look like in both patents and copyright, for if traditional contours exist in copyright surely they exist in patents as well. The paper then turns to patent law to see how traditional contours might assist in understanding and sorting through the boundaries of patentable subject matter (looking at *Bilski* and *Prometheus*) and the America Invents Act. The paper concludes with some thoughts of the place of traditional contours in patent and copyright jurisprudence.

**I. INTRODUCTION: IN SEARCH OF TRADITIONAL CONTOURS**

§101. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Patent Act of 1952

“The Congress shall have the Power to enact...[t]o Promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”

“[W]hen, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.”

For the 2011-12 season, the Supreme Court has accepted only the second case that looks directly at the concept of “traditional contours” in intellectual property. The case, *Golan v. Holder*, concerns the boundaries of copyright law, and whether Congress had altered the traditional contours of copyright protection when they removed foreign works from the public domain, restoring copyright to previously public domain works.\(^1\) Traditional contours was a concept that began with *Eldred v. Ashcroft* in 2003 where Justice Ginsberg found that extending the term of copyright did not violate the traditional contours of copyright protection.\(^2\) But it is a second case that the Supreme Court has accepted for cert that may prove interesting in the context of traditional contours and intellectual property: *Mayo v. Prometheus*, and the question of the boundaries of patentable subject matter.\(^3\)

The question in *Mayo v. Prometheus* centers on the patenting of a diagnostic test.\(^4\) The Petitioners are arguing that the results are merely a correlation between a naturally occurring process in the body and a doctor’s knowledge of what that result means. To patent this would be to contravene long established notions abstract ideas that do not qualify for patentable subject matter. In addition, the patenting of such a test, the petitioner’s argue, actually creates a First Amendment violation, as it restricts a doctor’s “freedom to think.” One amicus brief quickly made the connection: if there is a First Amendment violation within an intellectual property context, surely *Eldred*’s traditional contours language would come into play.\(^5\) This essay looks directly at that intersection: what role does traditional contours play in both copyright and patent law.

The two cases at first blush seem very different. *Golan v. Holder* concerns the boundaries of how far Congress can legislatively go in enacting laws; *Mayo v. Prometheus* concerns clarifying judge-made exceptions to patentability. Yet, both cases struggle with how far protection can extend, and both Petitioners believe that the law has crossed over into unnatural territory, violating basic principles of intellectual property. Both cases see the system as in jeopardy if the law is allowed to stand, either as a statutory amendment in the case of *Golan v. Holder*, or as an interpretation of judge-made concept of preemption, or nonpatentability, as seen in *Mayo v. Prometheus*. Both cases show the struggles of a system to define boundaries and to stay true to the

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3 Prometheus Laboratories, Inc. v. Mayo Collaborative Services, 628 F.3d 1347 (Fed.Cir.2010), cert. granted, 131 S.Ct. 3027 (2011).
5 For more on the Cato Institute’s amicus brief in Prometheus, see Section ____.
See also Mike Masnick, Do Patents On Medical Diagnostics Violate The First Amendment?, TechDirt (Sept.15, 2011), http://www.techdirt.com/blog/?tag=traditional+contours.
underlying functions that drive protection. Both cases challenge the court to better define the public domain.6

This article suggests that “traditional contours” could become a powerful doctrinal tool within the theoretical arsenal of intellectual property law. While the concept began as a conclusionary sentence in Eldred, the phrase “traditional contours” may be able to provide balance, guidance, and structure to an otherwise ever changing and expanding laws of intellectual property law. When are new laws merely an expansion necessary to keep up with technology, a global economy and new ways of thinking, and when do these laws go beyond the “traditional contours” of intellectual property, potentially upsetting the balance, the physics, of the system?

Copyright and patents are bound together by the IP clause: 1.8.8. Both serve the public good by granting for “limited Times” monopolies to inventors and authors. For over two hundred years, a discourse filled with certain expectations has developed in both copyright and patent law. The question is what components are essential for a working system in each area, and which elements can be altered. Restoring foreign works was a dramatic moment in copyright law. Did it alter the traditional contours of copyright law? We will have to wait to see what the U.S. Supreme Court decides. But if restoring works may alter tradition, certainly the Bilski-Prometheus line of patentable subject matter cases, along with the new America Invents Act, bring up just as many questions regarding the boundaries and requirements of the IP system.

The Fall brought so many new events that all seemed to be calling for “traditional contours” analysis. Part II, “Traditional Contours as a Tool for Evaluating Four Major Events and One Minor Event in 2011,” describes five events in particular: the America Invents Act, ACTA, Golan v. Holder, Prometheus v. Mayo, and the Sound Recording Simplification Act. Could a traditional contours test help us better evaluate new legislation, and better guide courts in dealing with global trade, new technologies, and unexpected applications?

Part III, “Towards a Traditional Contours Test for Copyright Law, 2003-2011,” looks at how “traditional contours” as a concept, test and/or doctrine has developed today from Eldred until the second Golan appellate decision and also at scholarship since the Eldred decision in 2003. In almost a decade since Eldred, traditional contours have remained fairly undefined and under-utilized.


traditional contours discourse, and suggests how principles like those espoused by Merges, Dinwoodie and Samuelson might create vibrant ground for traditional contours. This section argues that “traditional contours” affords greater insight into the particular issue at hand than merely a doctrinal or minimalist historical or functional reading of a particular law.

Part VI, “Applying Traditional Contours to Patentable Subject Matter,” then turns to patent law. How do traditional contours allow us to sort through the current struggles in patentable subject matter? In particular, the section will look at the Bilski-Prometheus line of patentable subject matter cases, along with the America Invents Act. Part VII, “Prometheus and Traditional Contours of Patent Law: A Test Case,” turns to Prometheus, looking at the petitioner and respondent’s U.S. Supreme Court briefs, along with select amici briefs for two purposes: 1) can we see each side forming a traditional contours argument, and 2) since Prometheus claims a violation of the First Amendment in the “freedom to think,” how does that relate to the “traditional contours” analysis in Eldred and Golan? Part VIII, “The America Invents Act and Traditional Contours,” turns briefly to the America Invents Act, looking at whether “traditional contours” have been altered in the change from first-to-file system and the ban on tax strategies and human organisms.

Part IX concludes the paper by answering the question how is traditional contours helpful in analyzing issues arising in patents and copyrights. The paper concludes that traditional contours helps us to be more aware of what we are doing—how are we using history—what history are we using—are we arguing for or against history, for example. Traditional contours, then could be defined, in the end, as a functional and historical analysis of a particular issue/law within the context of underlying principles of the system.

II. TRADITIONAL CONTOURS AS A TOOL EVALUATING FOUR MAJOR EVENTS AND ONE MINOR EVENT IN 2011

In the Fall of 2011, intellectual property found itself confronting assaults and change from all angles. Four major, potentially system-altering events took place. First, in September 2011, the Congress passed and the President signed the first major revision of the patent law in sixty years, including the dramatic move of shifting the U.S. from a first-to-invent system to a first-to-file system. The America Invents Act would have many changes. For patentable subject matter, the most interesting, however, was the addition specific named categories of works that are ineligible for patents: tax strategies and human organisms. Have previous patents acts included specific categories ineligible for protection? Does this sort of enumeration fall outside the boundaries of the traditional contours of patent law?

A month later, the U.S. was one of the first signatories to the Anti-Counterfeiting Trade Agreement, an agreement created outside of the WTO, WIPO and other international mechanisms in order to beef up enforcement mechanisms. Many are calling

into question whether the Executive Power has the authority to commit the U.S. to such an agreement without involving Congress and how much of the U.S. Copyright Act will have to be altered to meet the ACTA commitments in the U.S. Can U.S. Copyright law—where authority of law granted to the Congress to enact legislation by the U.S. Constitution—be altered by the needs resulting from an executive agreement? While a detailed look at ACTA is beyond the scope of this paper, I hope to show that a “traditional contours” analysis might help in sorting out the boundaries of what a trade treaty can and cannot do to alter how copyright and/or patent law has previously operated.

Third, the U.S. Supreme Court accepted cert. on two cases: Golan v. Holder and Mayo v. Prometheus. The former looks at whether Congress can restore copyright to works in the public domain in the U.S., and the latter looks at the boundaries of patentable subject matter. Both sets of plaintiffs claimed a First Amendment right to use materials that were either being re-copyrighted or patented. Golan Petitioners argued that once works were in the public domain, the works were public property, not to be privatized through limited government monopolies. Mayo Petitioners argue that certain readings of test results is not patentable subject matter, as they exist as natural phenomenon, rather than the private property of a patent holder. Both cases get to the heart of each area of intellectual property: what should be protected by limited government monopoly?

Finally, a minor event, unnoticed by most occurred during this same time period. A small piece of legislation was introduced that would federalize pre-1972 sound recordings. The Copyright Office had been asked to conduct a study on the problems and issues that might arise in bringing pre-1972 sound recordings out from under state law protection, where they currently reside until February 16, 2067, and federalizing them. Comments and replies had been submitted at the U.S. Copyright Office in the Spring of 2011. The Sound Recording Clarification Act, simply proposed eliminating the exception of federal preemption, bringing all sound recordings under federal protection. Could this actually occur?

These five events—two legislative actions (with one passing into law), one Executive trade agreement, and two Supreme Court cases—seem to indicate that copyright law is in the midst of an identity crisis or, at the least, an identity shift. This essay posits that strengthening the discourse surrounding “traditional contours” may prove useful in such a dramatic sea of change. This essay will begin with the idea of “traditional contours,” and suggest how the Eldred phrase could be used to navigate through the new patent law, ACTA, the two Supreme Court case, and even the sound recording amendment. All of the events either directly or indirectly, are a response to outside international and/or trade pressures. The question becomes how much should domestic law alter for the needs of foreign pressure? The “traditional contours” framework may provide assistance in understanding the pressures and search for balance.

III. TOWARDS A TRADITIONAL CONTOURS TEST FOR COPYRIGHT LAW: 2003-2011
“Eldred v. Ashcroft is a significant case because it represents the first direct challenge to the constitutionality of any portion of federal copyright legislation to reach the Court since the first statute became law in 1790.”

“As copyright law continues to expand into new territories and in unpredictable ways, and as new bills are introduced at a staggering rate to further the scope of the rights of copyright owners, it is crucial that we study the contours of copyright law.”

The term “traditional contours of copyright law” originated with Eldred v. Ashcroft, where Justice Ginsburg wrote acknowledged that in certain situations copyright might require First Amendment scrutiny, but only when “Congress alters the ‘traditional contours of copyright law.’” Eldred did not present that situation. In Eldred, “traditional contours” was not defined. Golan v. Holder, now in front of the U.S. Supreme Court, further defined “traditional contours,” by addressing whether public domain works themselves carry First Amendment protection—that is, can users depend on the public domain status once the works are no longer under copyright, or can the Government re-copyright the works to serve legitimate state interests? The Tenth Circuit, in looking into the issue of traditional contours, began to define the term as having a functional and historical component.

Except for the Tenth Circuit decision, the potential as a doctrinal tool has remained undeveloped. Only a handful of courts have addressed “traditional contours,” and only a handful of scholars have directly parsed through the concept of “traditional contours” in their work. Of course, many wrote about the Eldred and Golan cases, but most did not look at how traditional contours would operate or be developed into a fully functioning concept, doctrine and/or test. This section first looks at the development or underdevelopment of the phrase within the courts, looking at Eldred, Kahle, Luck’s Music, Silver, and Golan. How have lower courts worked through creating a test for “traditional contours”? Then the section turns to scholars’ work with “traditional contours.”

A. Eldred

“Traditional contours of copyright law” originated with the 2003 U.S. Supreme Court case, Eldred v. Ashcroft. Eldred v. Reno did not include the phrase, nor had it been used in any Supreme Court case before. So, where did “traditional contours” come from?

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10 Ashcroft, 537 U.S. at 221. See also Robert Kasunic, Preserving the Traditional Contours of Copyright, 30 Colum. J.L. & Arts 397, 397-98 (2007).
12 A search on ___ revealed on Eldred as a case including the phrase “traditional contours.”
Two years before *Eldred*, an Eleventh Circuit case, *Suntrust v. Miflin* found Alice Randall’s *The Wind Done Gone*, a novel that parodies and comments on *Gone with the Wind*, was protected by the First Amendment. As Neil Netanel noted, “It marks the first time an appellate court has applied the First Amendment's Free Speech Clause to constrain the enforcement of a copyright.”\(^\text{13}\) The *Eldred* court, however, would not cite to this case. It would take a different approach—traditional contours of copyright protection.

So, we return to *Eldred*. The plaintiff’s brief did not include “traditional contours” as a phrase. The Government discusses “traditional copyright policy” as part of its brief. One can see the Government working to establish previous historical and functional authority for extending the term, and “traditional” did play a role in forming this argument. But “traditional contours of copyright” did not come from the Government, at least not in its formal brief. The Government also discusses “Congress’ traditional authority for setting copyright terms.”\(^\text{14}\) In a footnote, the Government refers to “traditional copyright considerations” and “traditional safeguards of free speech.”\(^\text{15}\) If Justice Ginsburg had adopted this last language, the implication would be fall more limited. One would have to identify the traditional safeguards for free speech, and whether idea/expression and fair use satisfied the needed traditional safeguards. The discussion would be over. But Ginsburg uses the phrase “traditional contours of copyright protection.”\(^\text{16}\) Surely, this is different.

*Eldred* concerned the extension of the copyright term by twenty years. From the beginning, Justice Ginsburg frames the argument as a constitutional question: “This case concerns the authority the Constitution assigns to Congress to prescribe the duration of copyrights.”\(^\text{17}\) Congress acted within its authority and did not transgress constitutional limitations.\(^\text{18}\) To get to this decision, the Court placed the extension within historical and functional perspective.\(^\text{19}\) “Text, history, and precedent, we conclude, confirm that the Copyright Clause empowers Congress to prescribe ‘limited Times’ for copyright protection and to secure the same level and duration of protection for all copyright holders, present and future.”\(^\text{20}\) Functionally, every time Congress extended the term, they did so on future and existing works.\(^\text{21}\) The extension of the term does not violate “limited Times” because the term is still limited and not perpetual.\(^\text{22}\) The Court turned to history of what Congress had done in the past regarding duration; how patent law (*McClurg*)


\(^{14}\) “As an initial matter, Congress’s traditional authority to extend copyright terms for both subsisting and future works enables Congress to select shorter terms in the first instance (as it did in 1831, 1909, and 1976), since those shorter terms can be replaced if they prove inadequate.” http://cyber.law.harvard.edu/openlaw/eldredvashcroft/supct/government-brief.pdf


\(^{16}\) Ashcroft, 537 U.S. at 221.

\(^{17}\) Ashcroft, 537 U.S. at 192.

\(^{18}\) Id. at 194.

\(^{19}\) Id. at 193-196.

\(^{20}\) Id. at 186, 199.

\(^{21}\) Id.

\(^{22}\) Id. at 199-200. The Court looks to dictionary definitions at the time of the enactment of the Constitution for “limited.”
applied laws retroactively to works already in existence; and that Congress acted rationally in its enactment of the extension.\textsuperscript{23}

The “traditional contours” language comes in the second half of the opinion, when the Court turns to the petitioner’s argument that the CTEA is a “content-neutral regulation of speech that fails heightened judicial review under the First Amendment.”\textsuperscript{24} The Court rejects this argument as well. Justice Ginsburg begins again with history, that the adoption of the Copyright clause and the First Amendment came close in time, and “As Harper & Row observed: ‘[T]he Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas.’”\textsuperscript{25} The court noted that copyright contains built-in First Amendment accommodations, specifically the idea/expression dichotomy and fair use.\textsuperscript{26} The Court identifies these two as “traditional First Amendment safeguards.”\textsuperscript{27} But then notes that the CTEA contained additional safeguards. Is this to be read that there are additional First Amendment safeguards, that there are more than two? If so, it would be the task of other courts to identify the safeguards. The Court uses the example of the libraries ability to create preservation, scholarship or research copies of works in the last twenty years of the copyright if no commercial copy is available, and the restaurant homestyle exception, allowing the playing of music in restaurants without the requirement of a license.\textsuperscript{28} These two examples are puzzling as to what the court is indicating. But maybe each indicates that additional safeguards beyond fair use and idea/expression are available and can be employed by Congress to assure a proper balance of needs. It seems that by including two examples of “supplements to the traditional First Amendment safeguards,” there may be others outside of the CTEA, and even outside of the Copyright Act itself.\textsuperscript{29}

The “traditional contours” language comes in the final paragraph of this section. First, the Court rejects the idea that \textit{Turner Broadcasting} applies to this case. There, the statute had a “must-carry” provision for cable operators, requiring them to broadcast certain programming, which implicated the First Amendment: “Those ‘must-carry’ provisions, we explained, implicated ‘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.’”\textsuperscript{30}

The Court then turns to the CTEA. Here, the Court found that in contrast to \textit{Turner Broadcasting}, no one is being required to reproduce speech against one’s will: “Instead, it protects authors' original expression from unrestricted exploitation. Protection of that order does not raise the free speech concerns present when the government compels or burdens the communication of particular facts or ideas.”\textsuperscript{31} The Court

\begin{footnotesize}
\begin{enumerate}
\item Id. at 208.
\item Id. at 218.
\item Id. at 219.
\item Id. at 219-20
\item Id.
\item Id. at 220.
\item Ashcroft, 537 U.S. at 220.
\item Id.
\item Id. at 221.
\end{enumerate}
\end{footnotesize}
explained, “The First Amendment securely protects the freedom to make—or decline to make—one's own speech; it bears less heavily when speakers assert the right to make other people's speeches.”

The Copyright Act generally provides built-in First Amendment safeguards for those who would like to use a copyrighted work that are “generally adequate to address them.”

What does the “generally” indicate? Are these the additional safeguards exemplified in the CTEA? We get a hint: Justice Ginsburg scolds the D.C. Circuit: “We recognize that the D.C. Circuit spoke too broadly when it declared copyrights ‘categorically immune from challenges under the First Amendment.’” And then we get the grand finale: “But when, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary. See Harper & Row & San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.”

These two cases an important element. With this example, the Court leaves open the possibility that when Congress does alter the traditional contours, a First Amendment analysis may be necessary that goes beyond fair use and idea/expression.


Harper & Row is cited as an example where traditional contours have not been altered and San Francisco Arts & Athletics, Inc. v. United States Olympic Committee as an example of where it had. Miller explains “the Court upheld a statute that altered traditional trademark rights by giving additional trademark protection to the United States Olympic Commission on use of the word ‘Olympic,’” but not without First Amendment review. He posits two possibilities of how to read the court’s analysis. First, “If San Francisco Arts serves as a guide, then one ‘traditional contour’ could be the equal application of law to copyrightable works. In other words, whatever the copyright laws, they are to be the same for all works of the same type.” Alternatively, “‘traditional contours of copyright’ modifies ‘protection.’ In other words, the Court may have been talking about the traditional protections, or exclusive rights, granted by copyright.”

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32 Id.
33 Id.
34 Id.
35 Id. (internal citations omitted).
36 Matt worked with me as a law student and is co-inventor with me on the Durationator® patent. The entire footnote reads: “We are not persuaded by Petitioners' attempt to distinguish Harper & Row on the ground that it involved an infringement suit rather than a declaratory action of the kind here presented. As respondent observes, the same legal question can arise in either posture. See Brief for Respondent 42. In both postures, it is appropriate to construe copyright's internal safeguards to accommodate First Amendment concerns. Cf. United States v. X–Citerment Video, Inc., 513 U.S. 64, 78, 115 S.Ct. 464, 130 L.Ed.2d 372 (1994) (“It is ... incumbent upon us to read the statute to eliminate [serious constitutional] doubts so long as such a reading is not plainly contrary to the intent of Congress.”).” Eldred v. Ashcroft, 537 U.S. 186, 221, 123 S. Ct. 769, 790, 154 L. Ed. 2d 683 (2003). J. Matthew Miller III, The Trouble with Traditions: The Split over Eldred's Traditional Contours Guidelines, How They Might Be Applied, and Why They Ultimately Fail, 11 Tul. J. Tech. & Intell. Prop. 91, 98 (2008).
38 Id.
39 Id.
40 Id. at 99.
The question, then, the Court does not answer: what are traditional contours of copyright protection? We are left with many questions. First, did the court itself perform a traditional contours test, when it performed a text (dictionary definition; determining what the words mean), history (looking to what Congress has done in the past), and precedent test regarding duration? What are additional safeguards beyond fair use and idea/expression, as indicated by the examples of a library exception and restaurant homestyle exemption? Why does the Court say that the built-in First Amendment safeguards of fair use and idea/expression are “generally adequate”? Is the traditional contours test one more narrowly focused on Turner Broadcast-like test, when the freedom to make or decline to make is implicated? And of course, the greatest question of them all: what constitutes “traditional contours of copyright protection”? And finally, where did the language “traditional contours” come from? Most believe the origin was Justice Ginsburg herself.41

But it does not appear to be an empty turn of hand. We get a couple of clues following the phrase of the scope of meaning of “traditional contours.” Justice Ginsburg concludes, “As we read the Framers’ instruction, the Copyright Clause empowers Congress to determine the intellectual property regimes that, overall, in that body’s judgment, will serve the ends of the Clause. …Congress, but was “satisfied that the legislation before us remains inside the domain the Constitution assigns to the First Branch.”42 This harkens back to the often-quoted (in this case both the majority and dissent) phrase from John Deere that the IP Clause serves as “both a grant of power and a limitation” and that Congress “may not overreach the restraints imposed by the stated constitutional purpose.”43 Second, Justice Ginsburg earlier writes, “The ‘constitutional command,’ we have recognized, is that Congress, to the extent it enacts copyright laws at all, create a ‘system’ that ‘promote[s] the Progress of Science.’ Thus, a system—or perhaps the traditional contours of copyright protection—is created to support the IP clause.”44 Third, when Congress goes outside its duties from the Copyright Clause, the judiciary will step in. Traditional Contours, then, could be an analysis of the boundaries for the legislation in context of the IP clause.

There is a lot to take away from this case. The Congress is constrained by the IP Clause, and when it goes beyond that mandate, the Courts will step in. The First Amendment generally is protected by fair use and idea/expression dichotomy—what the Court class built-in First Amendment mechanisms, built-in because they are already part of the statute or because they are required by the IP Clause is not clear. These are not the only mechanisms that protect the First Amendment—others are included in the Copyright Act already, even though generally fair use and idea/expression are enough. But, the Court concludes that there may be times when that is not enough, when the particular law

41 Conversation with Tony Falzone. Also, see ___ which shows that no prior Supreme Court cases had used the term.
42 Id.
44 Id.
“alters the traditional contours of copyright protection.” Then, the Court would step in to sort through the boundary questions (did Congress exceed its First Branch authority) and First Amendment issues (in this case, “freedom to make—or decline to make—one’s own speech.”)

Finally, Justice Stevens dissent in Eldred speaks to what the IP clause historically has come to mean, which might prove useful for sorting through traditional contours of copyright based on a system, including an historical account of the enactment of the first Patent and Copyright Acts, which, inter alia, included an example of a recognized limitation: “This recognition of a categorical constitutional limitation is fundamentally at odds with the majority's reading of Article I, § 8, to provide essentially no limit on congressional action under the Clause.”

B. Cases following Eldred

There have only been a few cases so far that have taken up the “traditional contours of copyright protection” challenge. All but one of them have been brought by the Stanford Center for Internet and Society, where Eldred originated. In many ways, the discussion over definition has continued to be a Lessig project. Eldred was part of four test cases promulgated by Larry Lessig “to challenge various aspects of a decade-long expansion of copyright-- and corresponding diminution of the public domain--enacted by Congress in the 1990s.” The 1990s saw the enactment of the Copyright Renewal Act (1992), the CTEA (1998), the DMCA (1998), and the URAA (1994).

Kahle is the most thoughtful case regarding traditional contours, until Golan. In the unreported district court decision, the Plaintiffs explained that the system now incorporated all works, while previously only those copyright holders that affirmatively sought protection gained the additional renewal term, and that without the required renewal, the notice requirement had been dramatically altered from traditional expectations. The court responded. “The Supreme Court has not identified the entire universe of protections that it considers to be within such “traditional contours.” The phrase “traditional contours of copyright protection” originates in Eldred and appears in no other federal court decision prior to Eldred. The concepts of copyright law that the Supreme Court suggests fall within those contours-the idea/expression dichotomy and the fair use exception-each relate to the scope of copyright protection.”

The district court found, however, that registration, renewal and deposit focused on the procedures for obtaining copyright protection (“mere formalities”), rather than the scope of protection, and therefore, did not fall under traditional contours of copyright protection. “Such formalities do not alter the scope of copyright protection, but merely determine the procedures necessary to obtain or maintain such protection. Because changes to

47 Ochoa, Irrevocable?, supra.
48 Kahle v. Gonzales, 474 F.3d 665 opinion amended and superseded on denial of reh'g, 487 F.3d 697 (9th Cir. 2007) and aff'd sub nom. Kahle v. Gonzales, 487 F.3d 697 (9th Cir. 2007).
requirements of this nature do not alter the substantive rights granted by copyright, this Court finds that the challenged amendments do not alter the “traditional contours of copyright protection.”

No substantive changes occurred, and so no violation of traditional contours occurred. The Ninth Circuit affirmed the decision.

Under *Kahle*, subject matter, ownership, duration, infringement and defenses then would be included. Formalities, including registration, renewal, notice, and deposit, would not fall under traditional contours, and therefore, would not be subject to analysis under a traditional contours framework. One problem with that division is seen in *Golan*: a case regarding duration that implicates formalities and subject matter. Foreign works were restored because the foreign works had not met the formality requirements under the 1909 Act, and in that case, the Tenth Circuit applied a traditional contours test. Nevertheless, *Kahle* stands as the first attempt to delineate what “traditional contours” into meaningful categories or a test.

In *Luck's Music Library v. Ashcraft*, the district court did not find the enactment of Section 514 (restoration of foreign works) of the URAA altered the traditional contours of copyright protection, in part, because it had built-in safeguards, including procedures for restored works being used in derivative works and a transition period for users of the works to sell off copies or negotiate with the restored copyright owner for a license. The decision was affirmed in the DC Court of Appeals without further discussion.

The district court in *Golan* would also not find any violation of traditional contours of copyright protection with regard to Section 514 of the URAA, but the Tenth Circuit in *Golan* would take up the same question and come to the opposition conclusion.

*Silvers v. Sony Pictures Entertainment* (9th circuit, 2005) also looked at traditional contours. Here, Nancy Silvers, wrote the script, “The Other Woman” as a work for hire, but she was assigned the right to sue. The court found that in order to bring suit, the plaintiff must have a legal or beneficial interest in the copyright. The court looks to patent law and other circuits for support. It is in the dissent that we see the analysis of traditional contours. The dissent defines “traditional contours” as a tool available to sustain the careful balance between “the interests of authors and inventors in the control and exploitation of their writings and discoveries on the one hand, and society’s competing interest in the free flow of ideas, information, and commerce on the other hand.” The dissent concluded “I see nothing in the assignment of accrued claims of Frank & Bob Films for infringement of a work created by Silvers to Silvers that violates these background principles.”

For this court, in contrast to *Kahle*, traditional contours help to achieve a utilitarian balance between authors and the public, and that something like assignment of right to sue could be weighed under traditional contours.

C. *Golan*

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49 Kahle v. Ashcroft, C-04-1127 MMC, 2004 WL 2663157 (N.D. Cal. Nov. 19, 2004) aff’d sub nom. Kahle v. Gonzales, 474 F.3d 665 opinion amended and superseded on denial of reh'g, 487 F.3d 697 (9th Cir. 2007) and aff’d sub nom. Kahle v. Gonzales, 487 F.3d 697 (9th Cir. 2007)


51 Id. at 893-94.
The *Golan* suit was filed in September 2001—two years before *Eldred* would be decided by the U.S. Supreme Court, but it would eventually, ten years later in October 2011, be the case that would pick up the question of “traditional contours of copyright law,” before the U.S. Supreme Court. A decade in the making, *Golan* gives us the most thorough vision of “traditional contours,” adding the elements of functional (“contours”) and historical (the modifier “traditional” to contours.).

*Golan* concerned the restoration of foreign works that had fallen into the public domain, either through lack of formalities, subject matter, or lack of treaty relations. The works were restored under Section 514 of the URAA.

The district court ruled on a motion for summary judgment. There was no mention of the phrase “traditional contours of copyright protection,” although the court did look at historical precedent, comparison to patents, and discussion of various copyright acts.

The Tenth Circuit engaged in a significant discussion of what constituted “traditional contours of copyright protection,” finding that restoring foreign works from the public domain altered the traditional contours of copyright protection. While Congress has the power to enact such legislation, because it altered the traditional contours of copyright protection, First Amendment scrutiny is necessary. The court engages in a two-part analysis.

For Judge Henry traditional contours is a set of principles derived from the IP clause and the grant of power and limitations placed on Congress. He identifies one principle: “once a work enters the public domain, no individual—not even the creator—may copyright it.” Judge Henry first looks at the CTEA and the URAA with the new principle in mind. He begins with the IP clause as his guide, and the question of whether life plus 70 years is more than “limited Times,” and “effectively perpetual.” Judge Henry rejects the idea, citing to *Eldred* and the 9th circuit’s decision in *Kahle*, both of which found the CTEA within the bounds of Congress’ authority under the IP clause.

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52 Id. at 1217. After the plaintiff’s initial complain and the defendant’s motion to dismiss, the district court stayed *Golan* when the Supreme Court accepted *Eldred*. Once *Eldred* decided, plaintiff’s filed an amended complaint, and the defendants filed a Renewed Motion to Dismiss. The District Court’s opinion, then, came in 2004, a year after *Eldred*.


54 *Golan v. Gonzales*, 501 F.3d 1179 (10th Cir. 2007). See Townsend Gard, supra at

55 For a particularly good account of the public domain and the impact of restoration, see Ochoa, Irrevocable, supra. (Writing about *Golan* on the eve of oral arguments before the U.S. Supreme Court, Ochoa explained the future impact of the decision on the public domain: “Ultimately, what is at stake in *Golan* is nothing less than the entire corpus of works in the public domain, and even the entire concept of a public domain. If the Court holds that the Patent and Copyright Clause or the First Amendment prohibits removal of material from the public domain, then the public domain will indeed be irrevocable, and the public will have a bright-line constitutional safeguard against future incursions by Congress. If the Court holds that material may be removed from the public domain, but only for specified reasons or only within certain limits, then any future congressional action regarding the public domain will at least be subject to constitutional challenge. But if the Court holds that Congress has the discretion to remove material from the public domain whenever it chooses, the potential future consequences will be staggering: if Congress can validly take any work out of the public domain and put it back under copyright protection, then there is nothing to keep Congress from taking all works out of the public domain and putting them back under copyright protection.”)

56 Id.

57 *Golan v. Gonzales*, 501 F.3d 1179, 1185 (10th Cir. 2007) (citing Aplts’ Br. at 55).

58 “As the Ninth Circuit observed, the *Eldred* Court ‘clearly grasped the role ‘limited Times’ play in the copyright scheme and the Framers’ understanding of that phrase.’ Indeed, the *Eldred* Court emphasized that our constitutional
Regarding whether the URAA exceeded Congress’ Article I authority, Judge Henry writes, “We agree it would be troubling if Congress adopted a consistent practice of restoring works in the public domain in an effort to confer perpetual monopolies. But this argument is similar to one the Eldred plaintiffs raised, and, like the Eldred Court, we are mindful that ‘a regime of perpetual copyrights is clearly not the situation before us.’ Eldred, 537 U.S. at 209, 123 S.Ct. 769.”59 Here, the works restored had “limited Times” in that their new copyright expired. The Plaintiffs cite to Graham for the proposition that works in the public domain cannot be patented, or in this case copyrighted. The court turns to Luck’s Music Library, which distinguished patents from copyrights. “Thus, we conclude that plaintiffs have thrust onto Graham a burden it was never intended to bear. We decline to read Graham as standing for the proposition that, in the context of copyright, the public domain is a threshold that Congress may not ‘traverse in both directions.’”60 Justice Ginsburg would later adopt this same logic in Golan v. Holder. For now, it is interesting that Judge Henry is not willing to go as far as to preclude Congress from re-copyrighting public domain works, rejecting the opportunity to apply Graham, and even cites to Graham that it is up to Congress to set the appropriate policy to fulfill the IP clause.61 “Here, we do not believe that the decision to comply with the Berne Convention, which secures copyright protections for American works abroad, is so irrational or so unrelated to the aims of the Copyright Clause that it exceeds the reach of congressional power.”62 Most do not remember this part of the Tenth Circuit decision.

But Judge Henry does not stop there:

Nevertheless, legislation promulgated pursuant to the Copyright Clause must still comport with other express limitations of the Constitution. ...Thus, even if Congress has not exceeded its Article I authority, § 514 may still be subject to First Amendment review.63

So, while Congress may have the authority to enact Section 514, the law may still be subject to First Amendment review. This is the second prong of his analysis, and is an interesting structural move. The First Amendment comes into play as another area of law, separate from Congress’ authority, which creates an external hurdle to copyright law. It may be that the laws themselves, enacted by Congress and interpreted by the courts, comport with the IP clause; but they may not comport, however, with the First Amendment.

scheme charges Congress, and not federal courts, with ‘the task of defining the scope of the limited monopoly that should be granted to authors.’ (internal quotation marks omitted). As the Kahle court reasoned, ‘the outer boundary of ‘limited Times’ is determined by weighing the impetus provided to authors by longer terms against the benefit provided to the public by shorter terms. That weighing is left to Congress, subject to rationality review.’ Kahle, This rationale is clearly consistent with Eldred (reviewing the CTEA merely to determine ‘whether it is a rational exercise of the legislative authority conferred by the copyright clause’).” Golan v. Gonzales, 501 F.3d 1179, 1185 (10th Cir. 2007) (internal citations omitted).
59 Id.
60 Id.
61 Id.
62 Id.
63 Id.
Judge Henry begins the heart of his analysis regarding traditional contours, with the heading, “Congress's Removal of Works from the Public Domain Alters the Traditional Contours of Copyright Protection and Requires First Amendment Scrutiny.”  

He begins again with Eldred: “[W]e address the Eldred Court's holding that the CTEA's extension of existing copyrights did not require First Amendment scrutiny and discuss the Court's suggestion that an act of Congress would only be subject to First Amendment review if it 'altered the traditional contours of copyright protection.'”  

“Based on the Eldred Court's analysis, we examine the bedrock principle of copyright law that works in the public domain remain there and conclude that § 514 alters the traditional contours of copyright protection by deviating from this principle.”  

So, while Congress can create laws, they still may violate the traditional contours and require additional scrutiny.

“We begin our analysis of § 514 by exploring the traditional contours of copyright protection.”  

Judge Henry notes that Eldred did not define “traditional contours,” nor does it appear in any other federal authority.  “Nevertheless, the term seems to refer to something broader than copyright's built-in free speech accommodations,” Judge Henry identifies both a functional and historical component to “traditional contours”.  First, he looks to the dictionary definition for “contours,” finding it to mean “outline” or “general form of something, a process, the ordinary procedure.”  This harks back to Eldred—where Justice Ginsburg found an underlying “system” based on the requirements of the IP clause.  Here “contours” fulfills the same requirement.  “Because the term copyright refers to a process as well as a form of intellectual property rights, we assess whether removing a work from the public domain alters the ordinary procedure of copyright protection.”  

Judge Henry then turns to the word “traditional,” which modifies “contours,” which he believes “suggests that Congress's historical practice with respect to copyright and the public domain must inform our inquiry.”  The Court concludes “that the traditional contours of copyright protection include the principle that works in the public domain remain there and that § 514 transgresses this critical boundary.”

To get to this conclusion, he begins with the idea of a copyright sequence.  The process of copyright begins when an author creates a work.  Whether under previous systems or the 1976 Copyright Act, “[u]ntil § 514, every statutory scheme preserved the same sequence. A work progressed from 1) creation; 2) to copyright; 3) to the public domain. Under § 514, the copyright sequence no longer necessarily ends with the public domain: indeed, it may begin there. Thus, by copyrighting works in the public domain,

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64 Id.
65 Id. (internal citations omitted).
66 Id. at 1187-88.
67 Id. at 1188.
68 Id.
69 Id. at 1189.
70 Id.
71 See supra Part III.A.
72 Golan v. Gonzales, 501 F.3d 1179, 1189 (10th Cir. 2007).
73 Id.
74 Id.
75 Id.
the URAA has altered the ordinary copyright sequence.” The system, the contours, has been upset.

Next, he turns to the idea of the “public domain.” He looks to the copyright sequence in combination with the principle of the public domain: “The significance of the copyright sequence, combined with the principle that no individual may copyright a work in the public domain, is that ordinarily works in the public domain stay there.” Otherwise, it contravenes the contours of the system.

He returns then to the modifier of “traditional”. He writes, “The history of American copyright law reveals no tradition of copyrighting works in the public domain.” He looks to the Framers and Congress’ past practices. The Framers provide little guidance. He turns to the 1790 Copyright Act, where he agrees with the Plaintiff that preexisting works had been protected by state common law, rather than being in the public domain when they were federalized under the new system. This would become a key point debated between parties and amici briefs when the court headed to the Supreme Court in 2011. Still, he notes that we cannot know the Framers’ view on removing works from the public domain. “Given the scarcity of historical evidence, we cannot conclude that the Framers viewed removal of works from the public domain as consistent with the copyright scheme they created. Nor do we discern at the dawn of the Republic any burgeoning tradition of removing works from the public domain.”

He turns to the history of Congressional action, where he notes that a “series of private bills” restored copyright in a few cases: “But ‘[t]hese private bills do not support the [government's] historical gloss, but rather significantly undermine the historical claim.’ Eldred, 537 U.S. at 234, 123 S.Ct. 769 (Stevens, J., dissenting). Far from providing evidence that copyrighting works in the public domain is within the traditional contours of copyright protection, the fact that individuals were forced to resort to the uncommon tactic of petitioning Congress demonstrates that this practice was outside the normal practice.” Wartime acts also point to restoration as being out of the normal system or practices: “However, a review of the historical record reveals that these emergency wartime bills, passed in response to exigent circumstances, merely altered the means by which authors could comply with the procedural rules for copyright; these bills were not explicit attempts to remove works from the public domain.” Judge Henry writes, “The statutory context of these acts reveals that they were, at most, a brief and limited departure from a practice of guarding the public domain.” He noted that the 1919 Wartime exception allowed Americans to use the work: “…Congress emphasized that it was not attempting to interfere with the rights of Americans who had relied on the foreign works. For example, the 1919 Act stated that ‘nothing herein contained shall be construed to deprive any person of any right which he may have acquired by the republication of such foreign work in the United States prior to approval of this Act.’ One

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76 Id.
77 Id. at 1189-90
78 Id. at 1190
79 Id. at 1179, 1191.
80 Id.
81 Id. at 1179, 1191-92.
82 Id. at 1179, 1192.
of the Acts to which the 1919 Act referred was the 1909 Copyright Act. That Act made clear that ‘no copyright shall subsist in the original text of any work which is in the public domain.’ (emphasis supplied).’ He concludes that removal was an exception rather than a traditional contour.83 “In sum, by extending a limited monopoly to expressions historically beyond the pale of such privileges, the URAA transformed the ordinary process of copyright protection and contravened a bedrock principle of copyright law that works in the public domain remain in the public domain. Therefore, under both the functional and historical components of our inquiry, § 514 has altered the traditional contours of copyright protection.”84

Once establishing that section 514 altered the traditional contours of copyright protection, Judge Henry turns to the plaintiff’s First Amendment interests. First, “works in the public domain belong to the public,” giving the plaintiff a non-exclusive right and a First Amendment interest to use the work unrestrained and unrestricted.85 The built-in First Amendment safeguards discussed in Eldred, namely fair use and idea/expression are not adequate once a work enters the public domain. Here the works are expression, but they are in the public domain. “[T]he threat to free expression lies not in what is being copyrighted, but in the fact that the works are being removed from the public domain. The idea/expression dichotomy is simply not designed to determine whether Congress' grant of a limited monopoly over an expression in the public domain runs afoul of the First Amendment.”86

As with idea/expression, fair use is not a safeguard that is appropriate once a work is in the public domain, as the public is entitled to use all of a work without seeking permission. These two safeguards concern works that are still under copyright, and not once the works are in the public domain.87 “Once a work has entered the public domain, however, neither the author nor the author's estate possesses any more right to the work than any member of the general public. Because § 514 bestows copyrights upon works in the public domain, these built-in safeguards are not adequate to protect plaintiffs' First Amendment interests.”88 Finally, the court finds that the URAA provides no additional safeguards, as the Eldred court had identified additional safeguards in the CTEA.89

Judge Henry remanded to the district court to determine whether to apply a content-neutral or content-based standard of review. Judge Babcock, who had decided the first district court decision, now found that the URAA’s provision for restoration was broader than necessary to achieve the government’s interest.90 To date—and even after Justice’s Ginsburg’s opinion in Golan v. Holder—Judge Babcock’s opinion stands as the most thorough and thoughtful account of not only what would constitute a traditional contours test, but also the first attempt at applying a First Amendment analysis. Here we

83 Id.
84 Id.
85 Id at 1192-93
86 Id.
87 Id.
88 Id at 1195.
89 Id. at 1196 (internal citations omitted).
90 Golan v. Holder, 611 F. Supp. 2d 1165, 1168 (D. Colo. 2009) rev’d, 609 F.3d 1076 (10th Cir. 2010) cert. granted, 131 S. Ct. 1600, 179 L. Ed. 2d 516 (U.S. 2011)
see Judge Babcock engaged in a traditional contours discussion, as well as the application of a First Amendment analysis.

After reviewing the Tenth’s Circuit understanding of the relationship between copyright and the First Amendment, Judge Babcock explains that since the traditional contours were altered, the Tenth Circuit then asks how the alterations impact on the plaintiff. This is a much clearer test in some ways. Step one: was traditional contours altered? (using functional and historical analysis). Step two: how did that alteration harm the plaintiffs? Here Judge Babcock explains that before the works were re-copyrighted or copyrighted for the first time, the plaintiffs “had, subject to constitutionally permissible restraints, a non-exclusive right to ‘unrestrained artistic use of these works’ that was protected by the First Amendment. See Golan,” and “that once the works at issue became free for anyone to copy, plaintiffs in this case had vested First Amendment interests in the expressions, and § 514’s interference with plaintiff’s rights is subject to First Amendment scrutiny.”

§ 514 interfered with that right by restoring copyright to public domain works and in some cases, “by making the cost of using the works prohibitive.” Judge Babcock then noted that neither the built-in First Amendment nor specific supplemental § 514 safeguards adequately address the problem. Therefore, a First Amendment analysis is required.

Judge Babcock then turns to the First Amendment analysis—the first court to actual engage in such analysis within a “traditional contours of copyright protection” framework. He quickly agrees with the parties that the restriction is content-neutral:

“Here, the speech restricted is a general category of speech-namely, speech created by foreign authors. The justification for the restriction lies in the protection of the authors' interests in the expressions themselves, not the ideas the works encompass.” Because it is content-neutral, one needs to next determine whether the restriction advances an important government interest, which is what the remainder of the opinion then focuses upon. In some ways, this could be seen as whether there was justification for altering the traditional contours. To determine whether the restriction is substantially broader, Judge Babcock looks to the Governments interests balanced against the Plaintiff’s interests.

One appeal, the Tenth Circuit would reverse the Tenth Circuit, and find that Section 514 of the URAA (Section 104A of the copyright act) did not create violation a First Amendment. In this case, the Tenth Circuit did not engage in analyzing or even mentioned “traditional contours,” but instead focuses on the second part of a First Amendment analysis, of whether there was a legitimate government interest for the regulation, which the court found there was.

The Supreme Court granted cert. in Golan v. Holder in 2011. The Petitioner’s brief frames the Golan traditional contours argument by starting with Eldred. “The Court

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91 Id. (internal citations omitted).
92 Id.
93 Id. at 1170. The Yale brief once Golan got to the U.S. Supreme Court would argue that it is content-based. [put more in here]
94 “In Eldred v. Ashcroft, 537 U.S. 186 (2003), this Court affirmed Congress’s power to extend the terms of existing copyrights. The Court relied principally on an uninterrupted tradition of two hundred years of congressional amendments to the copyright laws, which had consistently extended the terms of copyright protection and applied those
reasoned that although statutes conforming to “historical contours” may be presumed constitutional because of that historical compatibility, substantial deviations from those “traditional contours” cannot be presumed constitutional on that basis, and must be assessed under ordinary First Amendment review.”

Restoring foreign works from the public domain deviates from tradition and history, and violates a “bedrock principle” that once works enter the public domain, they remain there. The Petitioners examine the bedrock principle, along with the speech interest that is harmed by the deviation. “Unlike the term extension statute that was before the Court in Eldred, Section 514 takes away vested and established public speech rights.” The Petitioners explain, “The ‘federal right to copy and use’ material in the public domain is not simply a ‘traditional contour of copyright protection.’ It is a defining feature of American copyright law, and an essential safeguard that ensures copyright remains ‘compatible with free speech principles.’ Section 514 departs from the time-honored tradition of leaving the public domain intact, and dismantles the speech protections that tradition provided to both Petitioners and the public. It cannot escape First Amendment scrutiny.”

Here the Petitioners have identified a key “bedrock” principle that is included in traditional contours of copyright protection, and find that Section 514 of the URAA violated that principle, thus triggering First Amendment scrutiny. The Petitioners look to history and tradition—the expectations associated with copyright for over two hundred years as a way to define traditional contours.

The Government responded that the Court of Appeals erred when the found Section 514 violated the traditional contours of copyright protection. “Section 514 does not alter the traditional balance between protected and prohibited conduct that is built into the Copyright Act. The idea/expression dichotomy and the ‘fair use’ defense apply fully to exploitation of restored works subject to Section 514.”

The Petitioner’s reply brief takes the question of how should Eldred be interpreted head on: “The government tries to avoid First Amendment scrutiny by insisting the only ‘traditional contours’ that trigger it are the fair use doctrine and the ‘idea/expression dichotomy.’ But Eldred implies no such limitation. It recognized these doctrines represent two ‘built-in First Amendment accommodations’ or ‘safeguards’ that are extensions to existing copyrights. The Court looked to that tradition to identify the limits of Congress’s power under the Copyright Clause. It looked to that same tradition to define the “traditional contours of copyright protection” and determine whether the term extension statute before the Court was subject to First Amendment scrutiny.”

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95 Id., citing Eldred at 221.
96 Id.
97 Id.
98 Id. (internal citations omitted).
99 “The court of appeals erred in holding that Section 514 alters the “traditional contours of copyright protection” and is therefore subject to heightened scrutiny. In Eldred, this Court discussed the various features of traditional copyright law that ensured its consistency with the First Amendment. Those features include the “idea/expression dichotomy,” the “fair use” defense, and the fact that traditional copyright protections restrict only the unauthorized exploitation of other people’s expression. So long as Congress legislates in a manner consistent with those traditional features of copyright law, the First Amendment inquiry is essentially at an end.”
100 Id.
‘generally adequate’ to address First Amendment concerns. It does not say or suggest these are the only ‘accommodations’ or ‘safeguards,’ or that any specific set of ‘accommodations’ or ‘safeguards’ exhaust the ‘traditional contours of copyright protection.’”101 The Reply explains that *Eldred* concentrated on the limits necessary when works are still under copyright protection.102 “The public’s right to copy and use works in the public domain is a third safeguard that attaches once that period ends, and is designed to provide complete and permanent protection for all First Amendment interests. Copyright’s protection of First Amendment interests has always progressed from partial protection to complete protection of those interests. The government’s suggestion that Congress can reverse that sequence at will is precisely the departure from tradition that triggers First Amendment scrutiny.”103

As to the amici briefs, some mention “traditional contours of copyright protection,” but most do not analyze what would make up the “traditional contours of copyright protection.” Tomas Gomez-Arostegui and Tyler Ochoa do not directly address “traditional contours” but frame the question more narrowly on whether there was precedent for removing works from the public domain.104 This seems to indirectly speak to the “traditional contours” question on the historical side of the argument, and maybe even the functional. Has Congress done this before, and how did they do it? The Google amicus brief asserts that “The power asserted [by Congress in enacting Section 514] goes far outside the ‘traditional contours’ of copyright law.”105

In conclusion, to date, we have only had three meaningful definitions from the courts on what comprises the “traditional contours of copyright.” The district court in *Kahle* saw it as substantive scope of copyright law, rather than procedural elements of copyright. The dissent in the Ninth Circuit’s *Silvers v. Sony Pictures Entertainment* saw traditional contours as reflecting a balancing test between “the interests of authors and inventors in the control and exploitation of their writings and discoveries on the one hand, and society’s competing interest in the free flow of ideas, information, and commerce on the other hand.” This allows for a broader reading than merely First Amendment related issues, and here assignment of interests could be weighed under a traditional contours analysis. The court of appeals in *Golan* created a two-part test of analyzing “traditional contours of copyright protection” as historical and functional. Until January 18, 2011, this was as far as we had come.

D. Scholarship parsing through traditional contours 2003-2011

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101 Id. (internal citations omitted).
102 Id.
103 Id.
104 “The chief issue this brief addresses is whether, in enacting the 1790 Act, the First Congress restored works from the public domain, thereby creating a First Congress precedent for the URAA. The parties and the lower courts disagree on this point. This brief discusses the historical record and concludes that the record does not support the view that the First Congress believed it was removing works from the public domain. If anything, it is more likely that members of the First Congress believed that they were limiting and preempting preexisting copyrights based on the common law.” Brief of H. Tomas Gomez-Arostegui and Tyler T. Ochoa as Amici Curiae in Support of Petitioners, *Golan v. Holder*, No. 10-545 (June 17, 2011), 2011 WL 2470823.
1. Defining traditional contours

Michael Birnhack wrote in September 2003, “As copyright law continues to expand into new territories and in unpredictable ways, and as new bills are introduced at a staggering rate to further the scope of the rights of copyright owners, it is crucial that we study the contours of copyright law.” In the last decade, there has been a good deal of scholarship surrounding Eldred and the CTEA, but not as much as one would have thought regarding the parsing and analyzing of what constitutes a test for traditional contours of copyright protection. This section surveys the response of scholars to describing what a traditional contours test might look like. What kind of scholarship has been done over the past decade, since in the Eldred decision, and are we any closer to a fully developed concept of “traditional contours of copyright protection”?

A year after Eldred, Marshall Leaffer wrote, “In my opinion, the First Amendment issue in Eldred ultimately may have more impact on the future of copyright law than the Court’s status quo, inherently deferential reading of Article I.… [W]hat Justice Ginsburg said about the interplay of copyright and the First Amendment indicates real constraints on the scope of copyright law.” Many felt this way. For Leaffer, Ginsburg’s

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"traditional contours of copyright protection" phrase as potentially powerful in the future: “These remarks about the relationship between copyright law and the First Amendment are apt to have an influence beyond the narrow issue of term extension. They may be the most important feature of the Court's opinion on future developments in copyright law. When does legislation alter those “traditional contours?”

Leaffer only poses the question, however, leaving it for others to answer at another time. Many would ask the same question. Brett Frischmann, for example, acknowledged that the phrase could be interpreted in many ways: “Traditionally, it at least evokes historical consideration. But of what exactly? What are the relevant contours? I would argue that the contours of the legal system mediate the intersection, or relationship, between the First Amendment and copyright law, those functional and structural contours that determine the relationship between markets in copyright-protected works and the amorphous marketplace of ideas. We can dive into other First Amendment values if we wish.”

We see elements of the Golan decision here. He also thinks traditional contours may come into play more because of the dramatic shift of consumers on the Internet into users. This creates more interest in protecting speech, as never before. In light of the current issues of the day (gripe sites, fan sites, fan fiction, sampling, YouTube, and Wikipedia), he asks the following questions: “What are the traditional contours? How are they defined historically, functionally and, I would argue, in relationship to the First Amendment? Can this inquiry arise as an applied challenge, or must there be formal change in the contours due to explicit congressional action—in other words, must Congress step in and change fair use in order for us to ask whether fair use is an adequate safeguard in a given context? Or might the contours functionally defined be tested as a result of changes in the underlying environment?”

He sees substantive areas of copyright law ripe for a traditional contours discussion, including idea expression, merger, fair use, de minimus copying, and derivative works: “There is plenty of fertile ground to test those various internal doctrines that mediate the relationship between copyright and First Amendment.”

More recently, David Lange, along with his students, Risa J. Weaver and Shiveh Roxana Reed, analyzed “traditional contours” within the context of the U.S. Supreme Court review of Golan. They ask, “What are we to understand the “traditional contours” of copyright to be? What does it mean when we speak of these contours in the context of the First Amendment? And why should it matter?”

They see the questions as “enormously” important: “Whatever the traditional configurations of copyright may be,

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111 Id. at 1113-14.
112 Frischmann, Panel II, supra. at 115.
they are surely relevant to the more important question of copyright's potential for conflict with freedom of expression.”

They believe that the "The doctrinal safeguards are presumably close to the center of whatever Justice Ginsburg may have meant when she spoke in passing of copyright's ‘traditional contours.’ But copyright's doctrines and contours define the nature of their conflict with the First Amendment, not an excuse for wishing it away.”

They see the URRA’s removal of works from the public domain as “anything but traditional.”

Two-hundred years of harmony. David Olson has written on the “traditional contours” and First Amendment arguments. The focus of Olson’s work looks to the vast changes in copyright law over the past thirty years that have, through legislative changes, “shrunk” the public domain. These include Kahle-like arguments regarding formalities, and of course, Golan’s issue involving restoration of foreign works. Following the lead of the Tenth Circuit in Golan, Olson believes that First Amendment protection must be expanded beyond merely idea/expression and fair use: “due to the significant changes to the traditional contours of copyright, which have resulted in a vastly-diminished public domain, the idea/expression dichotomy and fair use doctrines cannot come close to adequately protecting the public's interests in speech that once would have entered the public domain quickly and is now locked up for a century or more.” He reads Eldred as a statement of judicial economy:

Eldred makes two simple and straightforward assumptions. First, the copyright laws that have developed over the last 200-plus years in the United States have adequately protected speech interests, and are therefore constitutional. Second, if a copyright law conforms to these ‘traditional contours of copyright protection’ developed over the last 200 years, a court may presume that the law adequately protects speech interests, and may forgo First Amendment review. But where a copyright law does not conform to long-standing historical practice, no presumption of First Amendment compliance can be made.

Traditional battles. In 2004, at a Keynote address at Columbia Law School, Graeme Austin discussed the importance/impact of the traditional contours language from Eldred within the context of “traditional battles:” “In future debates about the future direction of copyright law and policy, we may see copyright's ‘traditional contours’ playing a similar ‘gotcha’ role to that of the Copyright Clause--invoked in support of every conceivable side of an issue. The phrase may provoke a battle of ‘traditions’--my tradition is better or more venerable than yours. If you win the battle of traditions, you've probably got a better chance of also winning the constitutional battle.” This will require, in Austin’s

114 Id.
115 Id.
116 Id.
117 put in david olson’s papers here
118 David S. Olson, First Amendment Interests and Copyright Accommodations, 50 B.C. L. Rev. 1393, 1413 (2009).
119 Id. at 1414.
120 Graeme W. Austin, Keynote Address Sponsored by the Columbia Journal of Law & the Arts and the Kernochan Center for Law, Media & the Arts Columbia University School of Law October 29, 2004, 28 Colum. J.L. & Arts 397, 400-401 (2005)
opinion, defining the system itself. "The first sentence in Justice Ginsburg's opinion artfully juxtaposes authors' rights and publishers' privileges." If you see the system as an incentive-based public goods system, extending copyright term on existing works provides no new incentives: "If we think of the copyright system as reflecting a bargain between authors and society--a quid pro quo--we're likely to be deeply disturbed by changes, exemplified by the Copyright Term Extension Act, that appear to give copyright owners considerably more quid for the same quo." And then he recognizes scholars like Mark Lemley and Tony Reese have noted technology puts great pressure on “traditional” ideas “on copyright's justificatory principles,” as the cost of dissemination goes down and access to dissemination becomes widely available. “When there is relatively little middle ground in this tug of war between users and copyright owners, the stakes involved in identifying fundamental principles--now ‘traditional contours’--are increasingly heightened.”

Austin sees constitutional arguments surrounding copyright as falling into two categories. “First, there are cases in which courts follow the strategy described by Justice Marshall in Marbury v. Madison of laying the Constitution and the statute down next to each other and comparing them. That the Constitution must win out if they are inconsistent was illustrated recently with United States v. Martignon in the Southern District of New York in which section 1101 of the Copyright Act, the anti-bootlegging statute, was struck down for conflicting with the ‘limited Times’ restriction in the Copyright Clause.” The second kind of constitutional challenge are “cases in which courts are asked to test the constitutionality of copyright law against some set of asserted underlying principles,” where “rights” claims are asserted. He sees the “traditional contours” test as falling into this category. He also thinks that Justice Ginsburg has gone a long way of implying that fair use is “constitutionally required…” In the end, Austin does not believe that “traditional contours” becomes an opening for constitutional challenge “every time Congress amends the copyright laws,” and he agrees (as the Kahle district court found) that limiting “traditional contours” to substantive, rather than procedural claims, makes sense. His conclusion is cautionary, but does not dismiss “traditional contours” all together:

In copyright law, as in most legal activity, it is incumbent upon us to be attentive, intelligent, reasonable and responsible in the “stories [we] tell” and the “visions [we] project.” For a time at least, debate over the meaning of copyright's traditional contours is likely to continue. It is part of a broader contest over what is fundamental to the copyright system. Treating copyright law as largely a matter of social and economic policy, accompanied by significant legislative freedom to adapt copyright law to meet the challenges of the digital era, risks getting things

121 Id. at 401.
122 Id.
123 Austin, Keynote, supra. at 402.
124 Id. at 403.
125 Id. at 404.
126 Id.
127 Id. at 406-07.
128 Id. at 406.
129 Id. at 410.
terribly wrong. Yet we should be wary of adopting perspectives on copyright law that would impede the task of making things a little better, particularly for individual authors—those ‘blockheads’ whose ‘creative sparks’ provide the reason, quoting *Eldred* once again,’ that works are eligible for copyright protection at all.130

It appears that Austin sees a place for traditional contours, as a way to ensure that we continue to be responsible in the “stories we tell” legislatively, and getting things “terribly wrong.” Combining a historical and functional analysis to copyright at key points might prove helpful.

**Nontraditional legislation.** Peter Yu brings up the point that Congress has not always enacted “traditional” legislation. In “The Escalating Copyright Wars,” Yu cites as “nontraditional” legislation: the Semiconductor Chip Protection Act of 1984, the anti-bootlegging provisions, the URAA, and the Vessell Hull Design Protection Act. “It is very unlikely that the Court will invalidate all of these statutes, just as it was unlikely that the Court would invalidate all the copyright statutes that were enacted since 1790.”131 But I think this is what many see as hopeful about “traditional contours.” It calls into question the very “nontraditional” additions to the copyright act, and suggests that perhaps copyright is not the place to be working out such problems. If “traditional contours” is to be used, Miller suggests the Tenth Circuit *Golan* test as a better fit: “Tenth Circuit tried to come up with clear rationale for showing that what was done was outside of tradition.”132

**What courts should do when traditional contours have been altered.** As part of a symposium (and later a law review article) at Columbia Law School, Robert Kasunic addressed the question of what courts should do when Congress’ alters the traditional contours of copyright protection.133 First he identifies elements of traditional contours, namely judicially created safeguards that may eventually become statutory, as in the case of fair use and idea/expression dichotomy. “Thus, although Congress has full authority to create the law, the contours of the law or the limits of the law have been shaped by the courts in ways that avoid conflict with the First Amendment.”134 He poses the question, “So how might Congress alter the traditional contours of copyright?” He thinks a court has four options in that case. First, a court could look to see if Congress created First Amendment safeguard mechanisms.135 Then, if no safeguards were found, the court “could seek to construe the statute in a manner that would avoid the result the statute

130 Austin, *Keynote*, supra, at 418.
132 Miller, *The Trouble with Traditions*, supra, at 111.
133 “Essentially, I read the Eldred opinion to stand for two propositions regarding the First Amendment. First, the internal First Amendment safeguards of copyright law, the idea/expression dichotomy and the fair use doctrine prevent First Amendment conflicts. In terms of judicial surprises, this is not really news, but what is surprising is the second proposition in Eldred: that this could change, that the traditional contours could be altered. And in my talk today, I’m going to focus on the second proposition. In particular, how might the traditional contours of copyright change, and what would happen if Congress altered the traditional contours? In other words, what should courts do?” Robert Kasunic, *Copyright and Freedom of Expression*, 30 Colum. J.L. & Arts 319 (2007).
134 Id.
135 Id. at 321.
appears to demand” to comply with First Amendment safeguards. Third, a court could apply heightened First Amendment scrutiny. (This is what Golan would do in 2009, of course). Courts could create equitable limiting principles, as they had with fair use and idea/expression. “I believe nothing stands in the way, and I believe this would be an optimal approach.”

He notes that courts might want to look at equitable approaches not only from the owner’s perspective, but also the user’s perspective. “Courts would be free to fashion factors to address the problems that they come across and find ways to balance the needs of a user with legitimate interests of copyright owners on a case-by-case basis.”

He looks to Section 12 of the Copyright Act, the Digital Millenium Copyright Act: “In particular factual situations, § 1201 could have the capacity to disrupt the traditional contours of copyright law,” in part, because fair use and other noninfringing uses may be precluded in the inability to circumvent technology. But Kasunic suggests that lawful access has always been part of the traditional contours of copyright, and Section 1201 is no different. “It is, in fact, relatively difficult to create a hypothetical in which § 1201 alters the traditional contours, and few factual situations have arisen that actually implicate real First Amendment concerns.” But he suggests another scenario of a whistleblower, where circumventing technology is necessary to gain access to the documents. In this case, idea/expression and fair use would be stifled, calling into question violation of the First Amendment.

His analysis focuses on how traditional contours can be used to protect First Amendment concerns. Kasunic explicitly believes “traditional contours” should be used to expand to a historical analysis: “If you look at that language, that one phrase within that opinion, it comes after many pages that are dealing with two free speech safeguards, fair use and the idea/expression dichotomy. I think that it was a mistake even to use that term “traditional,” because now we are looking at “traditional” in terms of historical changes, and that is just not the right approach.”

Function and Purpose. Steven J. Horowitz in “A Free Speech Theory of Copyright,” finds problems with the “traditional contours” as a trigger for First Amendment analysis. First, in his opinion, it privileges the old over the new: “the latter is almost certainly consistent with the traditional contours of copyright, whereas the former may not be.” This misunderstands “traditional” as a synonym for old. By equating “tradition” with “old”, he continues, “Tradition is not a First Amendment value, and the constitutionality of legislation should not depend on a threshold tradition inquiry.” Second, Horowitz believes that the traditional contours approach incentives Congress to create incremental legislation, because small changes would not depart from

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136 Kasunic, Copyright and Freedom of Expression, supra, at 321.
137 Id. at 322.
138 Id. at 323.
140 Id. at 407.
141 Frischmann, Panel II, supra, at 1134.
143 Id.
the system. This again, I think misunderstands and simplifies “traditional contours.” 144 Traditional contours, rather, requires a deeper thinking to the purpose and theoretical underpinning of any legislation, allowing for consistency and dependability in the system, rather than a radical upheaval on the whim of Congress.

He wants to go back to the Copyright Clause itself for guidance, rather than old laws. Traditional contours of copyright law does just that. The essence of his argument is “that the Copyright Clause is itself an expression of First Amendment values, and that the clause's limits on congressional power ought to be carefully enforced as free speech protections.”145 He rejects the “traditional contours” test from *Eldred* as useful, and instead makes a structural argument between the Copyright Clause and the First Amendment. I would argue that Horowitz’s work comes under a traditional contours test. He seeks to get at the heart of why and how the system works—the contours. Horowitz begins with the idea of consistency—something I argue is at the heart of a traditional contours test. Laws must be predictable, knowable and consistent. Horowitz seems the need consistency in the constitutional balance between the First Amendment and the Copyright Clause.146 I would argue that this kind of thinking could be incorporated into a traditional contours test. The test is flexible, rather than rigid, but seeks to thinker bigger and more theoretical regarding the boundaries of law. Traditional contours, then, stands on its own as an analysis, or in conjunction with other areas of law, like the First Amendment.147

Horowitz uses the anti-bootlegging laws as an example of the problems—a new law violating the traditional contours of the Copyright Clause while trying to fulfill a treaty obligation.148 Anti-bootlegging contains no duration limit nor fixation requirement, but courts have consistently found anti-bootlegging to fall under the Commerce clause, with no such limits. Horowitz writes, “Elsewhere, I have argued that Copyright Clause limits ought to apply to any law that ‘allocates exclusive rights in expression in order to create market incentives to produce such expression.’ This test is narrow enough to be workable and specific enough to be useful. If a law performs the function of copyright—allocating exclusive rights in expression—and the purpose of copyright—doing so in order

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144 Id.
145 Id. at 36.
146 Id. at 38.
147 One of the most interesting aspects of Horowitz’s articles comes in his discussion of the treaty powers in relationship to the Copyright Clause. He writes, “Treaty-implementing laws that contravene specific constitutional prohibitions are invalid, but treaty-implementing laws that simply extend beyond Congress's enumerated powers are constitutional. Steven J. Horowitz, A Free Speech Theory of Copyright, 2009 Stan. Tech. L. Rev. 2, 85 (2009) (citing See Reid v. Covert, 354 U.S. 1, 16-17 (1957); Missouri v. Holland, 252 U.S. 416, 433-34 (1920)); see also David M. Golove, Treaty-Making and the Nation: The Historical Foundations of the Nationalist Conception of the Treaty Power, 98 MICH. L. REV.1075, 1097 (2000) He uses the URAA as an example: “The copyright and copyright-like laws of the URAA, which implemented the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs), thus pose an interesting problem, at least insofar as they are inconsistent with Copyright Clause limits. If the clause's limits are treated like specific constitutional prohibitions, then the parts of the URAA that exceed those limits are invalid. But if the limits are treated simply as the boundaries of Congress's Copyright Clause power, then the URAA should not be subject to Copyright Clause scrutiny at all.” Id at 85 It is here that I think the traditional contours test might prove most useful to sort through the differences between implementing legislation that violates the Copyright Clause (or traditional contours of copyright law) and Congress' authority to create new copyright laws. If a traditional contours test was used here, the question would encompass both. Congress would have a limit on their ability to create new legislation that violated the traditional contours of the Copyright Clause, including treaty-implementation legislation.”
148 Id at 86-87.
to stimulate the creation of such expression--then it is sufficiently copyright-like to be subject to Copyright Clause limits.” A functional and purpose of copyright law is, in essence, what the Tenth Circuit also comes to see when delineating a traditional contours test. How does the law function within copyright law, and what is its purpose? For the Tenth Circuit, the argument is framed slightly more simple as functional and historical, but I would argue that underlying the historical argument is the question – what is the purpose of the law, particularly when we look to evidence in the past?

For example, Horowitz argues, “The durational limitation comes from the Copyright Clause, and it should be applied to anti-bootlegging laws because they perform copyright's function for copyright's purpose. Since the anti-bootlegging laws provide perpetual protection, they should be struck down.” This fits perfectly with a traditional contours test. His traditional contours test, then would be two parts: 1) does the law perform the function of copyright—allocating expression in order to create market incentives to produce such expression? If yes, then 2) is the law mimicking the purpose of copyright—doing so in order to stimulate the creation of such expression? If so, then Copyright Clause limits would apply. Those Copyright Clause limits are delineated into a traditional contours of copyright law. We believe that if one reads “traditional” more theoretically than merely old, one can find a very useful tool for understanding those Copyright Clause limits in complicated situations.

**Negative Reactions to Traditional Contours.** First Amendment scholar Paul Bender rejects the idea of a traditional contours test, suggesting that “ordinary free expression principles” should apply when there is a conflict between copyright and free expression.” And some scholars, such as Joseph P. Bauer, worry about how “traditional” will get defined—would that include subject matter not previously covered, or the inclusion of unpublished works? Bauer suggests First Amendment jurisprudence would be more appropriate. Still others feel that “traditional contours” might be too confining a concept. Christopher A. Mohr describes the *Eldred* language as a “shapeless contour:” “not only did the Court leave the phrase ‘traditional contours of copyright protection’ undefined, it also does not appear in any preexisting federal authority and it invites mischievous interpretations by creative litigants.” After reviewing *Kahle*, and *Luck’s Music*, he turned to *Golan*, and noted that “he court's expansive reading of the ‘traditional contours’ language could have repercussions far beyond § 514.” He uses the example of the DMCA, but thinks “Ultimately, it may well be that the Supreme Court will have to flesh out copyright's new-found ‘traditional contours.’”

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150 Id.
152 Id. at 197.
154 Mohr, *Traditional Contours of Copyright Silver Lining or Storm Clouds?*, 1 Landslide 30, 31 (2008).
155 Id. at 34.
156 Mohr, *Silver Lining or Storm Clouds?*, supra at 34. For others analyzing whether the DMCA would fit under “traditional contours,” see Peter K. Yu, *The Escalating Copyright Wars*, 32 Hofstra L. Rev. 907 (2004).
2. Applying Traditional Contours

Some scholars have started to see the application or need for traditional contours of copyright protection language in the context of specific problems in copyright law. This section will look at some of these arguments, namely those written by Alfred Yen, Jessica Litman, Christina Bohannan, Michael Carroll, and others.

Alfred Yen has written some of the most thoughtful analysis on traditional contours to date. Two pieces in particular prove useful in sorting through both *Eldred* and the creation of a traditional contours test. The first piece, in 2003, describes what Yen terms “aggressive copyright claims” – claims where the plaintiff is using copyright to achieve greater control than copyright law was intended: “these claims aggressively test the boundaries of copyright by urging courts to adopt unconventional or novel readings of doctrine that would extend copyright well beyond its core of preventing individuals from reproducing the copyrighted works of others.”

The second piece “A Preliminary First Amendment Analysis of Legislative Treating New Aggregation as Copyright Infringement,” Yen discusses traditional contours in the context of expanding copyright to news aggregation: “As the Article will show, legislation that treats news aggregation as copyright infringement changes the traditional contours of copyright in ways that expose copyright to serious First Amendment scrutiny.” The article focuses on aggregation control legislation. Here, a new technology is disrupting old expectation in a dying news industry. Aggregators pull headlines and the first sentence or two of a story from news sources to create new sites for readers, and so readers see adds at the aggregators sites rather than at the site of the original new source. Huffington Post is one example of a new aggregator. Legislation would use copyright to stop such activity. Yen sees the application of the First Amendment as a critical step. Yen’s analysis gives an example of how traditional contours can assist in sorting through new technologies, old and new interests, speech interests and copyright law. To be successful, aggregation control legislation would need to make illegal linking materials on the Internet. “Thus, aggregation control legislation will not really help newspapers unless it alters copyright to prohibit people from linking or using headlines and lead sentences without permission. These changes to copyright law would mean converting public domain material into private property and reducing the scope of fair use. Courts have already stated that such changes to copyright would create First Amendment problems.” Here, we see the perfect interaction and use of a traditional contours analysis that implicates both Copyright and the First Amendment.

As scholars before, Yen returns to *Eldred* as a starting point for traditional contours. Noting that the court saw idea/expression and fair use as limits on restricting speech, Yen writes, “This did not mean, however, that Congress had complete freedom to rewrite copyright as it pleased. To the contrary, copyright legislation could escape more

159 *Id.* at 952.
searching First Amendment scrutiny only if ‘Congress has not altered the traditional contours of copyright protection.’”\textsuperscript{160} His traditional contours is a balancing test, where the needs of further, new incentivizing is the focus. If traditional contours of copyright law encompasses the Copyright Clause itself, one can easily see this as a component of a traditional contours test—maybe the limiting elements of a test. If Congress weakened or eliminated idea/expression, for example, “courts should apply elevated scrutiny to such a change in copyright’s traditional contours in order to make sure that copyright’s incentives still justify its restrictions on speech.”\textsuperscript{161} Yen explains, “Brief reflection reveals further traditional contours that Congress should not be able to alter without exposing copyright to elevated scrutiny. Weakening or eliminating fair use would restrict speech in ways that the Eldred Court considered important to the copyright/First Amendment balance. Additionally, extending copyright protection to unoriginal material would have an effect similar to the elimination or weakening of the idea/expression dichotomy. People presently have the freedom to use unoriginal material in the same manner as ideas because both are in the public domain. Extending copyright protection to unoriginal material would therefore burden speech just as eliminating or weakening the idea/expression dichotomy would. Finally, consider what would happen if Congress began adding entirely new substantive rights to copyright. Each of those new rights would prohibit free uses of works that people presently enjoy, uses that would otherwise be considered free speech.”\textsuperscript{162} Since aggregated control legislation would introduce new subject matter, First Amendment scrutiny would be required.\textsuperscript{163} “Making newspaper headlines and lead sentences copyrightable subject matter would push copyright beyond the boundaries that the idea/expression dichotomy and originality set.”\textsuperscript{164} Under traditional contours, then, the court therefore would be required “make sure that copyright's encouragement of speech outweighs its suppression of speech.”\textsuperscript{165} This would have been true for architectural works as well, which was added as a protectable copyrightable subject in 1990.\textsuperscript{166}

Jessica Litman discusses traditional contours in relationship to her work on personal uses.\textsuperscript{167} In Real Copyright Reform, Litman turns to “traditional contours of copyright protection” in her discussion of what true copyright reform might look like, particularly in the face of a user-generated generation—the general public may for the first time might have a personal stake at what copyright law looks like.\textsuperscript{168} It is when she turns to “reader empowerment” that she engages in a discussion of traditional contours. She takes up the relationship between the First Amendment and copyright law: “That seems paradoxical: copyright laws regulate expression more directly that most laws that routinely undergo First Amendment review. The key to the paradox is that copyright laws have traditionally encouraged expression while preserving the liberty to read, listen, and view the expression copyright protects. The importance of reading, listening, and viewing

\textsuperscript{160} Yen, Preliminary, supra at 963 (citing Eldred at 221).
\textsuperscript{161} Id.
\textsuperscript{162} Id. at 963-64.
\textsuperscript{163} Id.
\textsuperscript{164} Id.
\textsuperscript{165} Yen, Preliminary, supra.
\textsuperscript{166} Id.
\textsuperscript{167} Jessica Litman, Real Copyright Reform, 96 Iowa L. Rev. 1 (2010).
\textsuperscript{168} Litman, Real Copyright Reform, supra, at 6-7.
is a vital reason that copyright laws get special treatment. The freedom to read, listen, and view are essential attributes of human freedom, so much so that we take them for granted. They are inextricable from the freedom to think. The liberties to read, listen, and view are crucial foundational liberties on which all copyright systems are built. Without those liberties, no copyright system makes any sense.

Litman has identified a principle in traditional contours, one different from that described by Golan. She describes “white spaces” – areas where previous copyright laws had focused on “exclusive rights to print, reprint, publish, and vend,” leaving “readers, listeners, and viewers are at liberty to enjoy copyright works the way they want to.” She identifies these “white spaces” as “part of the traditional contours the Supreme Court mentioned in Eldred--they advance copyright's goals and the First Amendment by securing liberty to read, listen, look at, and think. In Lawful Personal Use, I called these reader, listener, and viewer rights ‘copyright liberties.’ They have been embedded in the fabric of U.S. copyright law since its early history and are essential to its design.”

Christina Bohannan looks at the derivative work right, and brings up the point of what counts as history: “The extent to which the derivative works right alters the traditional contours of copyright under Eldred might depend on what time period in copyright's history is considered copyright's ‘traditional’ baseline. Under the first Copyright Act, enacted in 1790, it seems that copyright did not protect derivative uses at all but only protected the copying and sale of the original copyrighted work in its original form.” She cites Lessig’s idea that the derivative work right would have looked bizarre in 1790. She believes “traditional contours” is inadequate to address First Amendment concerns, because copyright law has always changed and expanded.

Michael Carroll in “The Struggle for Music Copyright” begins the article by referencing Eldred and the traditional contours language as a means of including specific history related to music within the current copyright debates: "Importantly, the Eldred Court signaled that copyright history would continue to supply relevant authority in future cases, particularly with respect to any limits the First Amendment might place on rights under copyright. Since disputes about music copyright rank among the most pressing issues of the day in contemporary intellectual property law, it is time that the nuances of music copyright's evolution be better understood. If the question presented in future cases entails copyright's governance of music, copyright law's traditional contours should be ascertained with acknowledgment and understanding of the distinct evolution of music copyright." He explains, "Defining copyright law's ‘traditional contours,’ id., necessarily will require a recitation and reliance upon copyright history." His work

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169 Id. at 37-38.
170 Id. at 38.
171 Id.
173 "Eldred's traditional contours approach is incapable of addressing the enormous First Amendment concerns arising from copyright law and produces a good deal of confusion besides. The main problem with this approach is that the scope of copyright protection has been constantly expanding since the first Copyright Act." Id. at 691.
175 Id. at fn 22 at 961.
does just that: presents a contextual history of the relationship of music and copyright law.\footnote{Id. at 912.}


In \textit{Eldred}, Ginsburg did not leave us with a clear map of “traditional contours of copyright protection,” but she left clues. She considered fair use and idea/expression dichotomy built-in mechanisms to protect the First Amendment, and she identified other safeguards, including library exceptions and the homestyle music exception for restaurants. That is was in 2003. Nearly a decade later, in \textit{Golan} we see a different Ginsburg—one anxious to put the “traditional contours” discussion back into Pandora’s box. On January 18, 2012, Justice Ginsburg delivered the opinion in \textit{Golan v. Holder}, 6-2, with Kagan taking no part. Ginsburg’s \textit{Golan} opinion is fascinating, when compared to her opinion in \textit{Eldred}—and all of the scholarship that \textit{Eldred} produced. It is as if she seeks to turn back time, to revise \textit{Eldred}. She had not meant to start “traditional contours of copyright protection.” Now, she is trying to stop it.

Ginsburg begins her opinion with the Berne Convention, and that the URAA did not “transgress constitutional limitations of Congress’ authority.” This was what the original Tenth circuit opinion had also found, and so no change occurred. But it is with the next conclusion that Ginsburg dramatically alters the traditional contours of copyright protection herself. She writes, “Neither the Copyright and Patent Clause nor the First Amendment, we hold, makes the public domain, in any and all cases, a territory that works may never exist.”\footnote{\textit{Golan v. Holder}, 10-545, 2012 WL 125436 (U.S. Jan. 18, 2012)}

In the briefs and amici briefs, the fight in \textit{Golan} had been over history—whether we had previously seen in history the removal of works in the public domain. Each side had vigorously shown how history their version of history. They were reacting to the “tradition” in traditional contours. What did history tell us about removal?

Ginsburg takes a far more radical approach, extending herself further than necessary to uphold the law. She could have done one of two things. First, she could have traveled the path of the government’s brief that the removal was necessary and therefore did not violate the First Amendment. Second, she could have limited her decision to exceptions that had occurred throughout history—with the first U.S. copyright act in 1790 (if you believe that version of history), after wars, and now in harmonizing global copyright. But she did not do either of these more limited choices. Nor did she “kill” the concept of “traditional contours of copyright protection.”

She had a moment where she could have merely limited her decision. In writing about Congress’ authority to remove works from the public domain, she writes “installing a federal copyright system and ameliorating the interruptions of global war, it is true,
presented Congress with extraordinary situations.” Following this line of thinking, a traditional contour is removal for extraordinary situations. She does not follow this line of thinking. She continues, “Yet the TRIPS accord, leaving the United States to comply in full measure with Berne, was also a signal event. Given the authority we hold Congress has, we will not second-guess the political choice Congress made between leaving the public domain untouched and embracing Berne unstintingly.” This would have been a sufficient argument.

She takes up her argument with the Tenth’s Circuit “bedrock principle” of “one works enter the public domain, they do not leave.” Ginsburg had a number of choices. She could have found the government had satisfied their burden to overcome the First Amendment. But she did not do that. She could have found that Section 104A had enough protection for reliance parties, as Luck’s Music had found. But that is not the direction she went. She could have found that “traditional contours” did not apply because most of the issues involved in Golan were procedural, rather than substantive, as in Kahle. She could have found that the balance between author and society had not been altered as in the Silver dissent.

Instead, she wrote, “We next explain why the First Amendment does not inhibit the restoration authorized by Section 514.” She begins with Eldred. “We then described the ‘traditional contours’ of copyright protection, i.e., the ‘idea/expression dichotomy’ and the ‘fair use’ defense. Both are recognized in our jurisprudence as “built-in First Amendment accommodations.” The language is interesting. Why does she quote “traditional contours” and not the “traditional contours of copyright protection”—the complete phrase from Eldred? I would suggest that she is signaling something about “traditional contours”. She also uses i.e., which stands for “that is.” She has limited “traditional contours” to mean idea/expression and fair use. But she had not done so in Eldred. In that opinion, as we have already learned, she included “other safeguards” as well. Why the grammatical shift? What happened to the 2003 Ginsburg?

Ginsburg goes on to discuss idea/expression and fair use as the “first” and “second” “traditional contour.” Why is she using quotes around “traditional contour”? I would argue that she is uncomfortable with the phrase—the phrase she created in Eldred. She writes, “Given the “speech-protective purposes and safeguards” embraced by copyright law, we concluded in Eldred that there was no call for the heightened review petitioners sought in that case.” She seems to indicate that only fair use and idea/expression are the safeguards. But let’s go back to her language in Eldred. After discussion fair use and idea/expression, she writes, “The CTEA itself supplements these traditional First Amendment safeguards in two prescriptions: The first allows libraries and similar institutions to reproduce and distribute copies of certain published works for scholarly purposes during the last 20 years of any copyright term, if the work is not already being exploited commercially and further copies are unavailable at a reasonable

178 Id.
179 Id.
180 Id.
181 Id.
182 Id.
price, § 108(h); the second exempts small businesses from having to pay performance royalties on music played from licensed radio, television, and similar facilities, § 110(5)(B).”183 In Eldred, she also discussed why Turner did not apply. Then, the famous phrase concludes her analysis: “When, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.”184

In Golan, Ginsburg seems to limited “traditional contours” on the one hand to idea/expression and fair use. But in the next instance, she turns to the transitional elements of Section 514—for reliance parties. She notes that they are included, but with no follow-up commentary. We are left to wonder if they protect “traditional contours.”

As to the petitioner’s argument that once a work enters the public domain, the public gains “vested rights,” and that idea/expression and fair use are “no substitute for the unlimited use they enjoyed before Section 514’s enactment.”185 But, she writes, that because the public domain is not untouchable by Congress, and the “vested rights” argument is “backwards:” “to copyright lawyers, the ‘vested rights’ formulation might sound exactly backwards: Rights typically vest at the outset of copyright protection, in an author or a rightholder. Once the term of protection ends, the work does not revest in any rightholder. Instead, the works simply lapse into the public domain. Anyone has free access to the public domain, but no one, after the copyright term has expired, acquires ownership rights in the once-protected works.”186 Ginsburg sidesteps the idea that the public has an interest in public domain works completely. She then turns to the idea that at times Copyright law has expanded its scope of what is protected, and in some instances, to works already in the public domain. “If Congress could grant protection to the works without hazarding heightened First Amendment scrutiny, then what free speech principle disarms it from protecting works prematurely cast in the public domain for reasons antithetical to the Berne Convention?”187

She belittles the Petitioner’s argument that fair use and idea/expression is very different than using an entire work, and that equity requires foreigners to not have their work available at “artificially low (because royalty-free) cost.”188 We have moved away from a “traditional contours” argument entirely. She writes, “By fully implementing Berne, Congress ensured that most works, whether foreign or domestic, would be governed by the same legal regime.” This is just not true. Foreign works and domestic works of the same era are now treated dramatically differently—for the same reason in some cases, that is failure to follow formalities.

Ginsburg’s opinion in Golan is a disappointment, because she does not actually engage in the discussion set out by the petitioner’s, the 10th circuit, and even the government. Her views focus on Berne, but without much depth—and even in some

185 Golan
186 Id.
187 Id.
188 Id.
instances ignoring the fact that the law actually does not implement Berne’s requirements! But for this paper, what is most disturbing is her neglect and carelessness regarding “traditional contours.” So, why did this happen? One imagines that it was not intentional. She does not want, it seems, traditional contours growing into a viable doctrine, and she seems to try to muffle it—without the courage to kill it entirely. But she cannot let go of it…she uses it herself for justification, and in that sense, “traditional contours” of copyright protection, as she writes in *Golan* or “traditional contours of copyright protection” as she wrote in *Eldred* lives on.

Judge Henry in the Tenth Circuit decision identified a “bedrock principle,” which Ginsburg mentions but does not engage in discussion. In a footnote, she writes, “On the initial appeal in this case, the Tenth Circuit gave an unconfined reading to our reference in *Eldred* to ‘traditional contours of copyright.’” 501 F.3d, at 1187–1196. That reading was incorrect, as we here clarify.” But in fact, Ginsburg does not clarify “traditional contours” but rather what safeguards are included within copyright law that protect those traditional contours. She identifies fair use and idea/expression as traditional contours. But this does not make any sense when read with *Eldred*.

The dissent does not discuss directly “traditional contours.” Written by Breyer, however, he once again employs the phrase, “text, history, and precedent,” the exact phrase used in his *Bilski* concurrence. He also asserts, “By removing material from the public domain, the statute, in literal terms, ‘abridges’ a preexisting freedom to speak,” an argument we saw in *Prometheus*. It will be interesting to see if courts in future years will pick up on this line of thinking—the “freedom to speak” and the “freedom to think.” It appears that increased property rights in patents and copyrights put these questions to the forefront.

The question, then, is what does a traditional contours test look like after *Golan*, and how useful could it be for patent law?

**V. TRADITIONAL CONTOURS AFTER GOLAN: SEARCHING FOR PRINCIPLES**

So, where does “traditional contours of copyright protection” stand after *Golan*? In a footnote, Ginsburg tells us that the Tenth Circuit did not get it right, but we get not further guidance. We see her try to narrow traditional contours to idea/expression and fair use, but also acknowledge additional safeguards that contribute to the decision that a First Amendment analysis is not necessary. I would suggest that Ginsburg 2003 and Ginsburg 2012 could be read as the following: *Eldred* Ginsburg was looking at safeguards in an expansive sense, and *Golan* Ginsburg is looking for a more restrictive reading on safeguards. But neither interpretation actually defines “traditional contours.” She merely looks at the safeguards to the traditional contours. We are left, then to still parse through what a traditional contour might look like, and how that would affect one’s

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191 *Bilski*
reading of “traditional contours of copyright protection.” This section suggests a roadmap for analyzing “traditional contours” language that fits with either reading of Ginsburg.

I suggest that one must understanding the underlying mechanisms of the system—and in doing so, one can then understand why Ginsburg’s reading in Eldred is different from Golan. Eldred looks at the internal workings of a domestic system with a long traditional of expansion of the duration of copyright law. Golan, in contrast, is looking to bridging the gap between U.S. visions of copyright law, and the requirements joining the international community in the form of the Berne Convention. It is a clash, in some ways, of traditional contours of two different systems, one based on the civil law, and the other on common law principles. She struggles with this transition, and perhaps this is why she begins the opinion with the Berne Convention. Traditional contours, ironically, might have helped her explain the transitions, and why in this case removal was an exception to the ordinary, rather than making statements that destabilize the public domain in general. Traditional contours, interestingly, could help Ginsburg, if she was willing to engage in a more robust discussion.

This section will suggest that traditional contours could include three elements: underlying principles of the system at issue, along with a historical and traditional analysis of the issue itself. Two potential tests seem to be afoot. First, one could try to continue with the idea of a functional and historical analysis of a particular law within the context of principles. This would be the Tenth Circuit’s approach in Golan. Alternatively, one could see “traditional contours” as traditional safeguards provided by fair use and idea/expression, and in this case, even Ginsburg herself adds in additional safeguards as well (again as she did in Eldred). So, we are left asking what are the safeguards, and moreover, what are we safeguarding?? I suggest we must still parse through traditional contours to understand the needs and dimensions of safeguards, and whether the safeguards adequately protect First Amendment interests.

A. Underlying Principles

One of the interesting elements of the Tenth Circuit decision is the phrase “bedrock principle” to describe the functional element of the public domain. Ginsburg does not engage in a systemic analysis, as she had in Eldred, instead focusing on what needed to change in the U.S. system to comply with Berne. By bypassing the larger question of the system—of what she did in Eldred—we lose a key element. How does our system alter when external pressures require change? I think if she had engaged in this sort of analysis, rather than justifying why the change was necessary, we might have had a more narrow ruling.

The Tenth Circuit’s analysis of a “bedrock principle” looked only at one principle identified by Judge Henry: that once a work came into the public domain, it stayed in the public domain. He himself acknowledged that it was not a limitation on Congress, however. Over the years, one question that has haunted me was what were the other principles? Surely there are more, and surely if there are principles, there should be a more systematic system in place. If that was so, would Ginsburg have adopted
underlying principles supporting a system based on I.8.8? This is what she had advocated in Eldred. Somehow this got lost in the Golan decision.

The following suggests a couple of ways the principles underlying traditional contours might be understood. This section uses Merge’s midlevel principles as way to understand how principles might operate within a traditional contours test. The section looks at the tenth’s circuit categories of functional and historical elements, stemming from the term “traditional” and “contours.” Finally, it looks at Pam Samuelson’s Copyright Principles Project to see how they might inform “traditional contours” in an expanded Eldred-like reading (rather than the more narrow Golan reading).

1. Merges’ Justifying Intellectual Property

Since the publication of the two pieces unpacking “traditional contours of copyright law,” I have come to see defining or creating a test as a more flexible tool, even when using the Tenth Circuit’s categories of functional and historical. Traditional contours as a tool allows us to bring in larger ideas about the issue at hand, to place it within context, and to evaluate through a larger lens. A great deal of theoretical work being done could be included within a traditional contours framework, allowing for a robust discussion and test to be developed.

But it was after reading Merge’s Justifying Intellectual Property that I could see the true possibilities of a “traditional contours” test for copyright but also for other areas of intellectual property. His thoughtful reasoning of negotiating between old foundational elements of intellectual property and the new, exciting growth within the field, seemed to offered concrete, flexible, and manageable means for creating a “traditional contours” test. This is not to say that Merges is the only scholar working on theoretical structures.

Robert Merges’ in Justifying Intellectual Property (2010) sets out to evaluate and structure a theory of intellectual property. He begins with the metaphor that intellectual property is like a “sprawling, chaotic metacities of the developing world.” His goal is to understand a foundational structure for the sprawl and “to make sure that with each new extension of the old city, basic themes and motifs from the historical core are picked up, replicated, and carried forward. As the city grows, I want it to retain its essential character.” From the beginning his work seems like it would complement a “traditional contours” reading of intellectual property. He, however, does not himself place his work within a “traditional contours” project.

He sees his work as conceptual. He writes, “in extending property to intangible items, what are the best justifications, and how do they shape the contours and limits of the field? In other words, what are the conceptual patterns, the basic formative ideas, that have inspired and animated the ‘cityscape’ I am surveying?”

194 Id at 2.
195 Id at 2.
traditional contours discussion, Merges enlightens with just this one sentence. Traditional contours could be seen as both the shape of the field and the limits, what the Silver court had interpreted traditional contours to mean. Merges’ language also suggests that traditional contours could be the conceptual patterns, the basic formative ideas, and most importantly, the spirit behind the laws as they stand—what inspired them in the first place. All of these concepts fit neatly into function and historical components of traditional contours.

His work is interesting because of its flexibility. After discussion three theories of property—Locke, Kant and Rawls— he writes that his system, the midlevel principles of intellectual property, can operate within any of the three foundational rationales. The goal of the midlevel principles is to bring disparate visions together to agree on basic understandings of intellectual property. His mid-level principles form the basic core of what the intellectual property system is setting out to accomplish. He defines four mid-level principles: efficiency, non-removal, proportionality, and dignity. His mid-level principles could replace a functional/historical test, or could be elements within each category of functional/historical. For example, why do we need efficiency in a functional context, and how has efficiency been attempted within a historical context? Traditional contours could have four midlevel principles each of which are then tested from a functional and historical realm.

The Golan case and the Bilski-Prometheus line of cases both have at the center of their controversies the question of non-removal directly. Does Congress have the constitutional authority to remove foreign works from the public domain and re-copyright them, asks the Golan court? What is the line between an abstract idea and a patented medical method, asks Prometheus, with the Plaintiffs fearful that the patent in this case has removed too much, impeding the ability of doctor’s “freedom to think.” Both cases are framed within a First Amendment wrapper, but each is really trying to get at Merges’ mid-level principles. Both Plaintiffs in Golan and Prometheus feel that the current status of the law has “altered the traditional contours.”

Before turning to patentable subject matter, let’s suggest how Merges’ work might be more fully incorporated into a traditional contours test. Merges’ work suggests the possibility of a balancing fair-use like test. One could imagine four factors that are used to determine whether a particular law alters the traditional contours of copyright or patent law. Take Merges’ own categories: Non-removal, proportionality, dignity, and efficiency. A plaintiff could argue that a particular law did not meet the traditional contours of copyright, because it violated the non-removal principle. Alternatively, defendant could raise the defense that the law violates or alters the traditional contours, and uses the four or a combination of the element to prove that assertion. A court could do a four-part traditional contours analysis to better understand whether a law alters the traditional contours. Finally, the Congress in its writing of new legislation could address the traditional contours of the legislation in the legislative history to better guide further conflict.

2. Dinwoodie’s Internationalist argument
In many ways, the issues that create a struggle with the U.S. Constitution and First Amendment seem to stem from our international obligations, although some also stem from the digital age, of course. Traditional contours, then, may be read with U.S. traditional contours, as compared to a larger global world or even a Berne outlook. Is this really a battle between the IP clause on the one hand, and the Treaty clause on the other? If so, traditional contours must be structured with that in mind. Graeme Dinwoodie suggests “that courts faced with reviewing copyright laws reliant upon the Treaty Clause for their constitutional legitimacy examine a matrix of at least three variables.” First is the law enacted to meet direct treaty obligations? Second, was the law enacted in a formal treaty process, with substantive political checks in the process, rather than more modern alternative processes that do not have the same substantive political checks? Dinwoodie explains, “For example, the leading multilateral intellectual property agreement, the TRIPS Agreement, is not a treaty in the formal sense used by the U.S. Constitution. It is a congressional-executive agreement. Finally, what limits does the Copyright Clause, and have they been properly implemented?” Dinwoodie asks, “do the limits in the Copyright Clause rise to the level of fundamental constitutional principle warranting intrusive judicial scrutiny?” This could be rephrased as a traditional contours of copyright protection inquiry.

Ginsburg’s arguments in Eldred and Golan do not need to be seen in conflict. One addresses domestic continuity and the other addresses international pressures. Unfortunately, the two arguments are conflated into one, rather than recognizing the pressures on traditional contours within the U.S. may require exceptions to long held principles within the U.S.

196 “... a large number of the provisions of the Copyright Act that have been challenged in recent years can be traced to some international influence. The plaintiffs in Golan and Luck’s Music questioned the restoration of copyright in works that had fallen into the public domain through failure to comply with formalities under Berne Convention-inconsistent U.S. law. Restoration was enabled by Section 104A of the Copyright Act, implementing Berne obligations to which the United States committed itself in the TRIPS Agreement. The TRIPS Agreement was also the impetus for the amendment of the Copyright Act to provide protection against bootlegging, challenged as unconstitutional in Moghadam, KISS Catalog and Martignon. The legislation that prompted the Eldred litigation was in large part designed to harmonize copyright terms with the European Union and thus ensure equal protection for American authors in Europe, which had previously been denied by the reciprocity clause of the EU Term Directive. The group of reforms reducing copyright formalities, which the Kahle plaintiffs characterized as effecting an unconstitutional switch from an ‘opt-in’ system of copyright to one of ‘opt-out,’ reflected an attempt to bring the United States into line with the requirements of the Berne Convention. Finally, the anti-circumvention provisions introduced by the Digital Millennium Copyright Act 1998 (DMCA) and challenged in Corley and Elcom purported to implement obligations assumed by the United States in the WIPO Copyright Treaty in 1996. Graeme B. Dinwoodie, Copyright Lawmaking Authority: An (Inter)nationalist Perspective on the Treaty Clause, 30 Colum. J.L. & Arts 355, 358-59 (2007).

197 Dinwoodie, (Inter)nationalist Perspective, supra, at 363.

198 “Some domestic laws are adopted in order to implement international obligations. Others are adopted to improve the negotiating posture of the United States in the international environment. Yet others reflect a desire to protect the interest of Americans abroad. Finally, some international motivations can only be described as a desire to be in the vanguard of international standards regardless of international obligations.” Id.

199 Id.

200 “Finally, some of the limits in the Copyright Clause should be more effective than other limits in constraining alternative lawmaking grants. The argument that the judiciary is ill-equipped to engage in the policy assessments underlying the adoption of particular laws is arguably particularly strong in the case of international calculations. But it is also surely the case that some limits implicate harder and more uncertain policy choices than others. Thus, for example, judicial review of the ‘limited times’ language should be stricter than assessment of whether a particular provision of the copyright statute ‘promotes the progress of science and the useful arts.’” Id.

201 Id. at 365.

202 Dinwoodie, (Inter)nationalist Perspective, supra, at 381.
3. Samuelson’s Copyright Principles Project

Pam Samuelson at U.C. Berkeley headed the Copyright Principles Project, which gathered together scholars and industry experts in copyright law to discuss what core elements are needed for a model copyright law. Released in September 2010, “Crafted over three years by a group of legal academics, private practitioners, and corporate attorneys, the report examines several ways to improve and update the law in an era of rapid technological change.”

They begin with guiding principles: “A well-functioning copyright law carefully balances the interests of the public and of copyright owners.” This utilitarian notion is something well-established; we saw in it Eldred, in Silver, even in the Golan case(s). To achieve this goal, the CPP suggests the following principles. First, “Copyright should encourage and support the creation, dissemination, and enjoyment of works of authorship in order to promote the growth and exchange of knowledge and culture,” allowing the copyright “ecosystem” to include a “diverse range of works” with copyright embodied in “rules that are clear and sensible, yet flexible enough to apply to a changing environment.” The rules should identify “which works and parts of protected works can be protected by copyright law, in whom copyright ownership initially vests, and which rights the copyright owner enjoys,” and what constitutes infringement. Creation and dissemination is promoted by encouraging capital, “promising creators opportunities to convey their works to their intended audiences,” through the ability of exclusive rights in licensing and assignments, and by “limiting control over uses of creative works, as appropriate, to aid education, cultural participation, the creation of new works, and the development of new forms of creative output.” They also believe limitations on copyright owners rights should be well articulated. Finally, the U.S. should “develop its copyright law in a manner that respects the global system in which creative activity occurs,” but also the U.S. should “seek to ensure that international law leave room to allow domestic laws to fully comport with these principles.”

Turning back to Ginsburg’s decision in Golan, the principles might have helped guide her. She would have had a principle to allow her concerns regarding compliance with Berne, but she would have also been able to use a principle to make sure international law within a U.S. setting comports with larger principles of the system. One might also notice that there is no explicit talk of the public domain, but rather the balance between copyright holders and society’s use of the materials. Again, looking to Ginsburg’s decision in Golan, the principles might have led to a discussion on the exclusive rights and limitations of copyright holders rights in a more constructive manner.

After introducing the reader to the basic general principles, the CCP then evaluates how well the U.S. law adheres to the principles currently: “U.S. copyright law is fully consistent with some principles…, partly consistent with others, but inconsistent
Regarding duration (the subject of both Eldred and Golan), the CCP briefly discusses the history of duration, recognizing that the members of the CCP did not reach of consensus on ideal length of a term of copyright. They did agree that incentives for registration in order to find copyright holders would help the system, as well as legislation for orphan works (something discussed in Ginsburg’s Golan decision). Finally, they thought an easy procedure for authors to dedicate their works to the public domain, if desired, would also be helpful.

In the end, the CPP recommended twenty-five specific reform proposals—all emanating from the original principles. For purposes, the CPP discusses specific reforms with regard to the public domain, and also idea/expression and fair use, among other elements. Recommendation is rather interesting: “Limitations and exception to copyright law ought to be based on principles, rather than being largely the product of successful lobbying.” This is the essence of traditional contours, particularly with a set of principles identified. Here, they use the example of an exemption for horticultural fairs, but not other kinds of fairs.  

B. Historical and Functional Analysis

In previous work, W.R. Gard and myself have discussed the need to more fully investigate defining history. History can be defined in narrow sense to encompass a reading of the Constitution, framer’s intent, and precedent. It can be defined as encompassing a long-view of two-hundred year history, or a short view of the past thirty years. For the Gards, we see evaluating copyright history as both a long view history (beginning before the Statute of Anne for large principles) but also a more modernist history, beginning with the turn into the twentieth century. Defining history becomes key and each court in a traditional contours test would be free to determine those boundaries. But the beauty of traditional contours – is that the court stops to analyze what traditionally has been done in the field, and not merely adopts long-established principles without thinking them through. This leads to more thoughtful approaches to new problems, and doing away with unnecessary elements, unneeded as circumstances change. In many ways, one does not become blindly beholden to history. In other ways, one recognizes the need for continuity and stability that history provides. The functional element of the historical analysis, or separately as a functional analysis (i.e. why do we require authorship to obtain a copyright) also provides analysis outside of the distinct problem being argued. It allows the court to bring in additional, relevant information, and think through problems that might not have an obvious solution.

The functional component requires careful attention as well. Functional is both the larger system, based on the IP clause, as well as the expectations built-into the system over time. These are Merges’ mid-level principles: non-removal, efficiency, proportionality and dignity. If one alters the system, how do the expectations—the balance within each midlevel principle change? Merges’ mid-level principles are what the Gards in previous papers have called “physics.” What does one expect to happen,

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207 Id at 8.
208 Id at 57.
and does the alteration dramatically change those expectations? The functional question harkens back to Lessig’s statements regarding Kahle: “But what it does mean is that, if Congress changes the fundamental architecture of the system, then the First Amendment ought to apply. That analysis would ask, “Are you restricting speech more than necessary to achieve whatever legitimate purpose you are trying to advance?”

Eldred teaches us that the intellectual property system is governed by the IP clause from the Constitution, and when Congress goes beyond its proscribed powers, the judiciary steps in. Traditional contours, then, becomes a judicial analysis of the boundaries of legislative restrictions and judge-made law within a IP-clause proscribed system. When does a restriction trigger a “traditional contours” analysis? Eldred saw the IP as a “system” based upon the requirements of the IP Clause. Merges identified four midlevel principles, and Jessica Litman has recognized an “ecology” in copyright law.

The Tenth Circuit was more oblique, applying a functional and historical analysis to the particular problem. Kahle saw traditional contours as substantive rather than procedural elements. In short, there are many ways to define “traditional contours.” Starting from the Tenth Circuit’s structure, we might begin our analysis there—a functional and historical analysis of what the IP clause requires of the particular controversy.

VI. APPLYING TRADITIONAL CONTOURS TO PATENTABLE SUBJECT MATTER

A. Why Traditional Contours?

In Eldred, Justice Ginsburg reminded us of the close relationship between patents and copyrights: “Because the Clause empowering Congress to confer copyrights also authorizes patents, congressional practice with respect to patents informs our inquiry.” Patent law seems to be in a current struggle over defining the boundaries of patentable subject matter. While the law itself has not changed—Section 101 remains consistent and the categories of non-patentability have not altered, but applying the law to specific situations has become challenging. Last year, Bilski reaffirmed that bright-line rules, as the Federal Circuit tried to apply with the “machine-or-transformation test”, are not acceptable, leaving everyone to wonder just exactly how one determines patentability in close cases. The focus of the discussion has become the categories of non-patentability, judge-made doctrine. Then, in 2011, the Supreme Court accepted Mayo v. Prometheus, which included a First Amendment argument! Does this mean that traditional contours must now be applied within a patent context? This section suggests 1) that traditional contours is already at play in the battle for defining patentable subject matter, and that 2) applying traditional contours within a patent context helps us to sort out definitions and boundaries.

209 Lessig, Second Annual Distinguished Lecture, supra, at 42. See also Lessig discussing the role of judicial scrutiny: “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….But Eldred means that it may continue to constrain Congress, indirectly.” Lawrence Lessig, The Balance of Robert Kastenmeier, 2004 Wis. L. Rev. 1015, 1033 (2004).

210 Litman, Real Copyright Reform, supra.

211 Further, although prior to the instant case this Court did not have occasion to decide whether extending the duration of existing copyrights complies with the "limited Times" prescription, the Court has found no constitutional barrier to the legislative expansion of existing patents.” Ashcroft, 537 U.S. at 201-202.
What would a traditional contours of patentable subject matter look like? Patent, of course, does not include idea/expression or fair use, and so it forces us to think beyond the two categories identified by Ginsburg in *Golan*. If “traditional contours” applies to patent law as well as copyright law, what does it look like? What does a historical analysis look like with regard to patentable subject matter? One could do a historical timeline, of course, going back to the beginning of patent protection—what got covered and what didn’t. We see with copyright, however, that that can be filled with problems. Copyrightable subject matter has expanded over time to keep up with technological innovations—photography and films, for example. The same is true of patents. One could look at why particular kinds of works get covered to determine whether the latest version fits the philosophy behind protection. But that might get a bit abstract, and the lines between patentability and abstract ideas is exactly where the current courts are struggling.

One question that comes up over and over again—whether in using traditional contours or merely analyzing the context of a statute and case law—is the historical context from which the current rule applies. W. R. Gard and I have argued elsewhere that defining the historical lens becomes particularly important; understanding the context in which current and past laws were enacted will help one evaluate the worthiness in new settings. Patentable subject matter has an interesting two levels of history: the long-view and the last sixty years view. One is a tale of consistency; the other is a tale of reaction and correction. Traditional contours, then, becomes investigating the history on multiple layers, and then with the information gathered, making an informed decision.

The long history trajectory tells the story of boundaries, that certain categories have always been off-limits, and even though judge-made, these categories have been consistent. One side or the other will argue, for instance, that a particular patent is encroaching on naturally occurring phenomena or abstract ideas. Others see the current patentable subject matter uncertainty as a result of over-patenting in the 1990s and 2000s.

In the second narrative regarding history, the story goes like this. We see with patentable subject matter, and patent protection in general, a pattern of strong protection and then weak protection. They respond to each other. The 19th century saw strong protection; the turn of the century responded with weak protection; mid-20th responded with strong protection; turn into the 21st is questioning the very strong protection and putting more limits on patentability. Recognizing that this is how patentable subject matter keeps itself in balance perhaps is the historical component of the traditional contours model. One could also see the historical approach as personality driven. In this narrative, Giles Rich, with his strong influence, pushed patentable subject matter in a certain direction, through his influence on the writing of the 1952 Patent Act and his decisions as a judge. For fun, let’s take a look at the last version to see how this would interact in a traditional contours analysis. (The other historical trajectories could work just as well, of course, as an example).

Under the *Rich narrative*, traditional contour would be defined as the over influence of one individual. Judge Giles Rich was the most influential single person in
the development of patent law in the second half of the 20th century. He would co-author not only the 1952 Patent Act, but would write key opinions throughout the second half of the century. He would be responsible for the expansion of patentable subject matter, in the from of his opinions that eventually led to Chakrabarty (“anything under the sun made by man”) to the opinion that validated business method patents in State Street (“useful, concrete and tangible result”). He, single-handedly, expanded patentable subject matter beyond the traditional contours of patentable subject matter. OR, he single-handedly created what we now regard as the traditional contours of patentable subject matter.

Rich would be known for co-drafting the 1952 Patent Act, and especially for his work on Section 103. He would become known as the “father” of the Patent Act, and his influence would continue throughout the century. Judge Rich believed not only were computer programs a “machine” but also qualified as a “process” involving no “mental steps” but rather a ‘machine utilizing optics and electronics’ to perform functions.” In 1971, Judge Rich advocated for the patentability of computer programs in In Re Benson, but a year later the Supreme Court would reverse in Gottschalk v. Benson. In re Benson, Judge Rich once again reversed the Patent Office, which believed a computer program in this case included “mental process” with “mathematical steps.” “[Judge Rich] considered the process steps of manipulating numbers with ‘structure’ (here a digital computer) to be statutory subject matter. No information was used or steps done that envisioned human intervention, i.e., ‘mental processes.’” While Benson would be reversed by the Supreme Court, in 1981, the Court would uphold Rich’s vision. Computers were patentable under Diamond v. Diehr: “Arrhenius’ equation is not patentable in isolation, but when a process for curing rubber is devised which incorporates in it a more efficient solution of the equation, that process is at the very least not barred at the threshold by §101.” And by 1988, with State Street, business methods were now legitimate patentable subject matter, and Judge Rich wrote that business methods had been patentable since the enactment of the 1952 Patent Act.

212 Giles Rich was born in 1904. His father was a patent attorney, and after law school at Columbia, he joined his father’s firm in 1929. The first decades of his practice years coincided with the Great Depression and an anti-patent Supreme Court. Then, in 1942 he began a series of five law review articles on patent law. The 1940s found the patent laws in disarray. According to the Rich story, anti-patent sentiment had proceeded from the turn of the 20th century’s love of patents.

213 Neil A. Smith, REMEMBRANCES AND MEMORIAL: JUDGE GILES S. RICH, 1904 – 1999, http://www.law.berkeley.edu/journals/btlj/articles/vol14/Smith/html/text.html. “One Supreme Court justice, Mr. Justice Jackson, summed it up bluntly in 1949: ‘... the only patent that is valid is one which this Court has not been able to get its hands on.’” Id.

214 President Bush did in 1992 [get better citation but attributed in 2 No. 1 LANDSL 8. He would be the first patent attorney appointed to the federal bench, and it would be first at the CCPA, and then at the newly created Federal Court of Appeals that he would wield significant influence for forty-three years. He would influence the development of patents on chemicals, but also on living animals, plants, computers, and business methods. 215 2 No. 1 LANDSL 8. In re Jones (1967) was an early computer case, where Judge Rich reversed the Patent Office, which believed computer programs did not qualify as a “machine.”

216 In re Benson, 441 F.2d 682, 688 (C.C.P.A. 1971).

217 2 No. 1 LANDSL 8

218 Id.

219 Id.
Until Bilski, it looked as if Judge Rich’s opinion eventually won out. “Although Judge Rich was personally stung by the Douglas opinion in Benson, the courts eventually adopted his position. Computer hardware, software, and even business methods may be patentable as long as they are useful and nonobvious…. Much later in In re Alappat, Judge Rich, writing for the majority, was able to limit Justice Douglas’ Benson opinion to its proper scope, as he wrote ‘[i]n this way, the door remains open to the advancement of technologies by the incorporation of digital electronics.’” 220

About the decision to include business methods and software as patentable subject matter, his former law clerk wrote, “and now, with Judge Rich's decision in State Street Bank & Trust Co. v. Signature Financial Group, Inc., financial and business methods. Judge Rich understood, perhaps better than most of us who are here on this Earth for such a short period of its cosmic time, that if the patent system is to survive and fulfill its Constitutional purpose, it has to keep up with and allow for protection for all the new types of inventions made as society changes.” 221 But the question would become a decade later, was this proper? Did it fit within the traditional contours of patentable subject matter, or was did it violate those traditional contours? That was the battle in Bilski, and which continues today with Prometheus.

B. Bilski and Traditional Contours

In 2010, Bilski v. Kappos became the first patentable subject matter U.S. Supreme Court decision since the early 1980s, and in 2011, the Court accepted another: Prometheus v. Mayo. This signaled the uncertainty and confusion that has popped up in the area of patentable subject matter in recent years, especially at the Federal Circuit level. Historical arguments have been employed by many parties. But it is the functional element that seems to be the struggle at the moment. How does one design a test to determine the boundaries of preemption in the form of non-patentability? In part, the science has shifted to make the world more complicated and less clear; in part, State Street exploded the definition of patentable subject matter in ways not previously seen ("useful, concrete and tangible result"), and in part, as Madison pointed out, many became clever and started to patent things that are the patterns of life rather than tied to a particular physical object. Bilski struggles with all of these questions. Many have written on Bilski.222 Here, we want to look at the opinions in Bilski to see if we can find a “traditional contours” argument being made. How do each of the Justices structure their argument, and do they approach it within a “traditional contours of patentable subject matter” kind of way? The Court does not use “traditional contours” in Bilski. But can we see a traditional contours analysis nevertheless? The Bilski decision is made up of the majority opinion, three concurrences in part.

Michael Risch points out that the USPTO set up Bilski to be a test case, because it rejected the application on the grounds of patentable subject matter, and nothing else.223

221 Id.
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According to Risch, this forced the Federal Circuit, and ultimately the Supreme Court, to address the patentable subject matter question. The Court in Bilski responded to the federal circuit, in a manner similar to Eldred’s response to the district court. In Eldred, the Supreme Court rejected a bright line rule that copyright was immune to First Amendment scrutiny. In Bilski, the Supreme Court rejects the Federal Circuit’s replacement of State Street with a bright line “machine-or-transformation” test. The analysis, in both cases, requires more sophistication and nuisance. Bright line rules are the easy way out, and the Supreme Court will have none of that.

1. Justice Kennedy’s Majority

Can we find a traditional contours argument in Kennedy’s decision? This section looks not to the details of the particular case per se, but how Kennedy goes about structuring the decision. He begins with the language of Section 101, noting that Congress intended to give wide scope to patentable subject matter. Next, he turns to the U.S. Supreme Court’s involvement of carving out three “specific exceptions” to “§ 101’s broad principles: ‘laws of nature, physical phenomena, and abstract ideas.’” Why are these exceptions important? Functionally, the support the statutory intent of “new and useful” as a threshold test (with other requirements further refining eligibility) and historically, these exceptions have been part of the patent system for over 150 years. “The concepts covered by these exceptions are ‘part of the storehouse of knowledge of all men ... free to all men and reserved exclusively to none.’”

Kenney next turns to the “machine-or-transformation” test. Kenney first states that functionally, it is not the sole test for determining patentable subject matter eligibility. He support this statement with historically “This Court’s precedents establish that the machine-or-transformation test is a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under § 101. The machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible ‘process.’” Like Ginsburg in Eldred, Kenney scolds the lower court: “the Federal Circuit violated two principles of statutory interpretation: Courts ‘should not read into the patent laws limitations and conditions which the legislature has not expressed,’ Diamond v. Diehr. and, “[u]nless otherwise defined, ‘words will be interpreted as taking their ordinary, contemporary, common meaning.’” The court went beyond legislative intent, and the court took words out of their ordinary meaning, in this case, with the word “process.” Just as in Eldred, the court performs a “text, history, and precedent” test (on the constitutionality of the CTEA), here the court

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225 Id. (citing Diamond v. Chakrabarty, 447 U.S. 303, 309)
226 Id.
227 Id.
228 Id.
229 Id.
230 “The Court of Appeals incorrectly concluded that this Court has endorsed the machine-or-transformation test as the exclusive test,” Bilski, 130 S. Ct. at 3226.
231 Id. at 3227.
232 Id. at 3226 (internal citations omitted).
233 Id.
turns to the text (meaning of the word) as part of its analysis, and then to previous cases to support the idea that a “machine-or-transformation” test was never supposed to be the only test. 234

Kenney then turns to history. “It is true that patents for inventions that did not satisfy the machine-or-transformation test were rarely granted in earlier eras, especially in the Industrial Age, as explained by Judge Dyk’s thoughtful historical review.” 235 We see the historical component of a traditional contours: “but times change.” 236 Justice Kennedy is not taking historical precedent as unchangeable. “Technology and other innovations progress in unexpected ways. For example, it was once forcefully argued that until recent times, ‘well-established principles of patent law probably would have prevented the issuance of a valid patent on almost any conceivable computer program.’” 237 Law must be contextualized—and in essence that is what traditional contours requires. Kennedy explains the functional relevance of the machine-or-transformation test within its original historical construction: “The machine-or-transformation test may well provide a sufficient basis for evaluating processes similar to those in the Industrial Age—for example, inventions grounded in a physical or other tangible form. But there are reasons to doubt whether the test should be the sole criterion for determining the patentability of inventions in the Information Age. As numerous amicus briefs argue, the machine-or-transformation test would create uncertainty as to the patentability of software, advanced diagnostic medicine techniques, and inventions based on linear programming, data compression, and the manipulation of digital signals.” 238 The nature of what is being patented has changed from tangible Industrial objects to more intangible IP-based ones. Understanding the functional and historical context for the machine-or-transformation test helps better assess its strengths and shortcomings. But Kennedy also recognizes the new pressure the Information Age puts on the system: “This Age puts the possibility of innovation in the hands of more people and raises new difficulties for the patent law. With ever more people trying to innovate and thus seeking patent protections for their inventions, the patent law faces a great challenge in striking the balance between protecting inventors and not granting monopolies over procedures that others would discover by independent, creative application of general principles. Nothing in this opinion should be read to take a position on where that balance ought to be struck.” 239

Kenney also analyzes “business methods,” finding that “process” as defined by Section 100b and 101, does not categorically exclude business methods. 240 Again, he turns to a textual and precedent reading of the term. He also reads that some “business methods” must have been contemplated by Congress, because section 273(b)(1) mentions a prior use defense for business method patents. 241 He again turns to the historical context: “Interpreting § 101 to exclude all business methods simply because business

234 Id. at 3222 (citing to Parker v. Flook, 437 U.S. 584, 588, n. 9).
235 Id.
236 Id.
237 Id.
238 Id.
239 Id. at 3228.
240 Id.
241 Id.
method patents were rarely issued until modern times revives many of the previously discussed difficulties."242 But also recognizes a danger: “The Information Age empowers people with new capacities to perform statistical analyses and mathematical calculations with a speed and sophistication that enable the design of protocols for more efficient performance of a vast number of business tasks. If a high enough bar is not set when considering patent applications of this sort, patent examiners and courts could be flooded with claims that would put a chill on creative endeavor and dynamic change.”243 In other words, the contours of what is functionally new and useful has changed, as has what is considered an abstract idea. What might have seen as novel in the Industrial Age, may impede progress if patented in the Information Age. This again, is where a traditional contours argument becomes useful, as it makes one analyze why something is done, rather than accepting it as the only possibility. Here, he finds precedent and the statute itself the most useful tool in determining a limiting principle for business method patents.

Kennedy then turns to the concept of “abstract idea,” a judge-made exclusion to patentability. Using Benson, Flook, and Diehr, he finds “Claims 1 and 4 explain the basic concept of hedging and reduce that concept to a mathematical formula,” which is not patentable.244 “Petitioners' remaining claims, broad examples of how hedging can be used in commodities and energy markets, attempt to patent the use of the abstract hedging idea, then instruct the use of well-known random analysis techniques to help establish some of the inputs into the equation. They add even less to the underlying abstract principle than the invention held patent ineligible in Flook.”245 He starts with Benson, where “‘[a] principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.’”246 In Benson, the court concluded that the practical affect of patenting an abstract idea would occur if “if the formula for converting ... numerals to pure binary numerals were patented in this case.”247 Here, we see a functional argument being applied. The traditional contours of abstract ideas would be altered had the formula been patented. We could have a functional equivalency as part of the traditional contours test. Kennedy then turns to Flook. Here, an algorithm was part of a process and therefore not being patented in its own right, as was the case in Benson. Later, Diamond v. Diehr would explain that Flook stood for “the proposition that the prohibition against patenting abstract ideas “cannot be circumvented by attempting to limit the use of the formula to a particular technological environment” or adding “insignificant post-solution activity.”248 We see the functional argument continue. Then Diehr limited the principle in Benson and Flook, where a mathematical formula was used to complete some of the steps within the patented process. The formula itself could not be patented, but the application of the formula could. “Finally, the Court concluded that because the claim was not ‘an attempt to patent a mathematical formula, but rather [was] an industrial process for the molding of

242 Bilski, 130 S. Ct. at 3229.
243 Id.
244 Id. at 3222.
245 Bilski, 130 S. Ct. at 3222.
246 Id. at 3230.
247 Id.
248 Id.
rubber products,’ it fell within § 101’s patentable subject matter.” The Court does not explain the move from *Flook* to *Diehr*, and the emphasis on “industrial process” is interesting as well. A further traditional contours analysis might prove more useful, as the case of Joshua Sarnoff’s work indicates.

The court, instead of discussing why the move occurs, turns to the patents at hand, and Kennedy writes, “In light of these precedents, it is clear that Petitioners' application is not a patentable ‘process.’” Basic concepts are not protected, and therefore the concept of hedging is not protectable: “The concept of hedging, described in claim 1 and reduced to a mathematical formula in claim 4, is an unpatentable abstract idea, just like the algorithms at issue in *Benson* and *Flook*.”

Traditional contours, then, was used in a number of ways: 1) to distinguish Industrial Age from Information age as an inappropriate comparison for the machine-or-transformation test as the sole test; 2) textual, statutory and precedent to analyze the case. Here, we see traditional elements of the common law system: interpreting the statutory language and looking to precedent. Traditional contours includes these elements but adds a bit more – it looks into the why behind the language and precedent, and makes sure either the spirit of the law continues, or as the case of the majority, that an appropriate test for one age does not misguide another.

2. Justice Steven’s Concurrence

How does Justice Steven’s concurrence interpret or use an unspoken traditional contours model? He begins with the notion that patent law must remain stable and clear. I would argue that traditional contours seeks to assist in this goal—that legislation that is either unstable (changing the nature of the system) or unclear (i.e. 104A) is reviewed with the intent to keep a stable and clear system. Steven’s concurrence believes the court merely had to address whether there was more than merely the machine-or-transformation test and that the Majority did not have to engage in the other elements of the discussion. What is interesting, in terms of traditional contours, is the next statement: “Rather than making any broad statements about how to define the term ‘process’ in § 101 or tinkering with the bounds of the category of unpatentable, abstract ideas, I would restore patent law to its historical and constitutional moorings.” Justice Steven’s concurrence criticizes Justice Kennedy’s opinion as contravening traditional contours!

So, what does Justice Steven’s propose? He turns to history: “For centuries, it was considered well established that a series of steps for conducting business was not, in itself, patentable.” It treats recent history (since *State Street* in 1998) as altering

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249 *Id.*
250 *Bilski*, 130 S. Ct. at 3231.
251 *Id.*
252 *Id.*
253 *Bilski*, 130 S. Ct. at 3231.
254 *Id.* at 3232.
255 “The opinion is less than pellucid in more than one respect, and, if misunderstood, could result in confusion or upset settled areas of the law.” *Id.* at 3234.
traditional contours, and that Congress and the Federal Circuit were merely responding to putting the system back in order.\textsuperscript{256} This “machine-or-transformation test” excluded general methods of doing business as well as, potentially, a variety of other subjects that could be called “processes.”\textsuperscript{257} What Justice Stevens does not like about Justice Kennedy’s opinion was his discussion of “process,” “The language in the Court's opinion to this effect can only cause mischief.”\textsuperscript{258} Justice Stevens wants business methods as a category nonpatentable.\textsuperscript{259} For Stevens, the question comes down to whether patents relate to “technological arts.”

First, Stevens attacks Kennedy’s version of traditional contours. Using the common meaning of words, Stevens writes, is absurd. Second, Stevens does not like Kennedy’s homage to the Information Age, and suggests that the opinion sometimes applies a (correct) historical approach, and then in other situations, as in “times change,” the opinion goes rogue.\textsuperscript{260} Finally, Stevens does not think Kennedy supports his analogy to \textit{Flook} and \textit{Benson}. So, how does Stevens make his own traditional contours argument that business methods should not be included, and were merely a short-term mistake by the lower courts?

Stevens begins with I.8.8 and Section 101 of the 1952 Patent Act, noting that it is “expansive” but not unlimited.\textsuperscript{261} He does not find the statutory definition of “process” helpful. He turns to a close, grammatical reading of the term within the statute itself. But it is to history that Stevens then turns in earnest, quoting Justice Holmes, “sometimes, ‘a page of history is worth a volume of logic.’”\textsuperscript{262} First, he turns to English history. His “traditional contours” is a long view, coupled with the “mistakes” of the recent past (\textit{State Street}). In his “traditional contours,” historically patents protected manufacture. (In our analysis, we would have looked to the economies that were protected, which happened to be industrial and manufacture, and then like Kennedy, recognize that economies shift—that what society wants to protect shifts.) Stevens turns to the dictionary for defining “useful arts,” seeing no irony that he chastised Kennedy for a similar move of ordinary meaning, albeit, Stevens turns to the historical dictionary-Webster’s first edition. Stevens finds that “arts” conveyed a meaning similar to manufacture.\textsuperscript{263} He works hard to show that patents, while not necessarily explicitly defined by manufacture, should be confined because of its historical function to manufacture. Then, he turns to modern patent law, where he continues his focus on business methods being unpatentable. To support his modern day argument, he cites Giles Rich—the author of \textit{State Street}! He writes, “Indeed, Judge Rich, the main drafter of the 1952 Act, later explained that ‘the invention of a more effective organization of the

\textsuperscript{256} Id. at 3232.
\textsuperscript{257} Id.
\textsuperscript{258} Id.
\textsuperscript{259} Bilski, 130 S. Ct. at 3232.
\textsuperscript{260} Id. at 3235.
\textsuperscript{261} “Certain things are “free for all to use.” Id. at 3237 (citing \textit{Bonito Boats, Inc. v. Thunder Craft Boats, Inc.}, 489 U.S. 141, 151 (1989)).
\textsuperscript{262} Bilski, 130 S. Ct. at 3239 (quoting \textit{New York Trust Co. v. Eisner}, 256 U.S. 345, 349 (1921)).
\textsuperscript{263} “Although other dictionaries defined the word “art” more broadly,\textsuperscript{27} Webster’s definition likely conveyed a message similar to the meaning of the word “manufactures” in the earlier English statute. And we know that the term “useful arts” was used in the founding era to refer to manufacturing and similar applied trades.” Id. at 3243.
materials in, and the techniques of teaching a course in physics, chemistry, or Russian is not a patentable invention because it is outside of the enumerated categories of ‘process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.’ ‘Also outside that group,’ he added, was a process for doing business: ‘the greatest invention[n] of our times, the diaper service.’”

In many ways, this is a set up for Stevens main argument, which comes in a section “Anything under the Sun,” a reference to *Chakrabarty*. Stevens explains that the phrase does not mean “any series of steps is a patentable process.”

Here Stevens quotes the Committee Report, where the phrase originated: “Taken in context, it is apparent that the quoted language has a far less expansive meaning. The full sentence in the Committee Reports reads: ‘A person may have ‘invented’ a machine or a manufacture, which may include anything under the sun that is made by man, but it is not necessarily patentable under section 101 unless the conditions of [this] title are fulfilled.’”

Then, he turns finally to *State Street*, the opinion that opened the door to business methods patents. He, interestingly, does not discuss the 1998 opinion itself but the 1999 legislation to limit the decision. He then ends with a functional argument about the role of patents and business innovation. In short, Stevens is structuring a traditional contours argument both in the long-term historical, the functional, and short-term historical mistakes. Traditional contours categories of historical, functional and perhaps textural might were utilized, just as they had been with Kennedy, but I think his argument could have been stronger and better organized had he had used a traditional contours-framed test.

Stevens concludes by returning to the Constitution, and the creation of a “constitutional standard,” which is interpreted as technologically-focused. Stevens writes, “For example, we have held that no one can patent ‘laws of nature, natural phenomena, and abstract ideas.’ *Diehr*. These ‘are the basic tools of scientific and technological work,’ *Benson*, and therefore, if patented, would stifle the very progress that Congress is authorized to promote.”

2. Breyer Concurrence

Breyer holds the same opinion as Stevens that business methods should not be patentable. Regardless of whether one agrees with Stevens, one of the elements I found troubling was the opinion seemed to lack organization. Breyer, in contrast, structures his opinion from the start. He writes, “in my view, the text, history, and purposes of the Patent Act make clear that they are not.”

Text, history and purpose looks an awful lot like traditional contours, and I would assert, are a better test with the addition of text to historical and functional. However, Breyer himself does not engage in a long text, history and/or functional discussion. Instead, Breyer seeks to clarify four points made in the unanimous opinion. First, patentable subject matter is broad, but with limitations. Second, the “machine-or-transformation” test has been part of the patent system for over

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264 Id. at 3248 (internal citations omitted).
265 Id. at 3249.
266 Id. at 3253.
267 Id. at 3253.
268 Bilski, 130 S. Ct. at 3253 (internal citations omitted).
269 Bilski, 130 S. Ct. at 3257.
270 Id. at 32580
a century. Third, the “machine-or-transformation” test is not the sole test. Finally, State Street’s “useful, concrete and tangible” result goes too far, and has not been endorsed by the U.S. Supreme Court.

C. The Year after Bilski

In the first year after Bilski, we saw key Federal Court of Appeal cases focused on patentable subject matter. What is interesting is the spectrum of subject matter: computers, business methods, medical methods, and DNA were all subject to review, and by the end of the first year, the U.S. Supreme Court, had taken another patentable subject matter case for review, Mayo v. Prometheus. Can we see patterns? Can we see a traditional contours? It seemed as if we are still in an upheaval. If there is no bright line test, what approach should a court take? Each of these cases seems to be struggling with coming to terms with which elements should be included and how to approach the undefined standard. Many have written on the chaos that followed Bilski, and it is one of the reasons many believe the Supreme Court took another patentable subject matter case, only a year after Bilski.

Like the courts, scholars started to try to make sense of Bilski. For instance, Pam Samuelson and Jason Schultz wrote, “The Supreme Court’s decision in Bilski v. Kappos made it clear that generalized methods of financial hedging are abstract ideas that are ineligible for patent protection. However, the Court left the framework for determining abstraction versus concreteness in future cases unclear, offering only ‘clues’ for drawing such distinctions.” What is interesting about this scholarship is that they seemed to be engaged in a discussion of the traditional contours of patentable subject matter—how patentable subject matter should operated within today’s climate within the context of its historical function within patent law.

1. Life after Bilski: Four Scholars

“Life after Bilski” exemplifies a traditional contours framework in its purest form. Authored by Mark A. Lemley, Michael Risch, Ted Sichelman, and R. Polk Wagner for a Stanford Law Review Symposium on Bilski, the article begins by identifying the problem: boundaries. “Put simply, the problem is that no one understands what makes an idea “abstract,” and hence ineligible for patent protection, so decisionmakers fall back on the one test that has been articulated.” They suggest that patentable subject matter serves as the functional purpose of an overclaiming test. They write, “We suggest a new way to understand the exclusion of abstract ideas from patentable subject matter. No class of invention is inherently too abstract for patenting. Rather, the rule against patenting abstract ideas is best understood as an effort to prevent inventors from claiming their ideas too broadly. By requiring that patent claims be limited to a specific set of practical applications of an idea, the abstract ideas doctrine both makes the scope of the resulting

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272 Mark A. Lemley et. al., Life After Bilski, 63 Stan. L. Rev. 1315, 1316 (2011)
patent clearer and leaves room for subsequent inventors to improve upon--and patent new applications of--the same basic principle.” 273

What is interesting about this article is their framing of history. Their history begins in the 1970s—it is a short view of history, tracing the development of patenting software as the crux of the “machine-or-transformation” test ultimately adopted in *Bilski* at the Federal Circuit level. They trace the “erosion” of the “requirement that a software invention be tied to a particular machine” through *State Street* in 1998. 274 They see patentable subject matter after *State Street* as a “effectively a dead letter,” until the *Bilski* en banc Federal Circuit decision. 275

After *Bilski*, courts continue to mostly rely on the “machine-or-transformation” test, although they found Research Corp. Technologies v. Microsoft Corp, a federal circuit case, did not apply the machine-or-transformation test. For these authors, they find the “machine-or-transformation test” problematic. 276 They find fault with it functionally. They feel it is filed with ambiguities, including whether it apply to only processes, and if a general purpose computer qualify as a “specific machine,” and leads to restrictive, overinclusive, and bizarre results, of which they give examples of each. After reviewing its flaws as a functional doctrine, they turn to the theory of patentable subject matter.

In the aftermath of *Bilski*, they note that the two elements of patentable subject matter have survived: that one must fit within the Section 101 categories of patentability, and that the invention does not fall into the three judge made exceptions. They write, “Bilski makes clear that while the Supreme Court has no intention of abandoning these old exceptions, neither does it intend to provide further guidance. Perhaps even worse, the guidance we have from the machine-or-transformation test isn't helping. A principled theory is needed.” 277 In doing so, they begin with prior theories of patentable subject matter. They begin, “The traditional way academics think about patentable subject matter is as a gatekeeper: a means of excluding certain types of inventions entirely from the scope of patent protection,” but they believe this has proved “unsatisfactory” because they lead to bright-line rules. 278 We see tradition reevaluated, which is exactly what should happen with a traditional contours test. We see the authors turn to the underlying value – the real traditional contour: “The core mission of patent law is to create incentives for the production, disclosure, and commercialization of socially valuable inventions. The flexibility of any subject matter requirement is paramount given the rapidly changing nature of technology.” 279 They then turn to the theory—the contours—of why patentable subject matter is necessary: the tension between the individual and society. “Understood in this way, the abstract ideas doctrine is not about finding a conceptual category of inventions that is entitled to no protection at all, nor about

273 Id. at 1317.
274 Id. 1318.
275 Id.
276 *The machine-or-transformation test is problematic. It contains a number of ambiguities, leads to some bizarre results, and poorly tracks the stated goal of preventing the patenting of abstract ideas.* Id. at 1322 (2011).
277 Id. at 1326.
278 Id.
279 Id.
determining the quality of the disclosure. Instead, it is about encouraging cumulative innovation and furthering societal norms regarding access to knowledge by preventing patentees from claiming broad ownership over fields of exploration rather than specific applications of those fields. Boiling these principles down to a practical test is a more difficult task. The abstract ideas exception should disallow those claims to ideas unmoored to real-world applications, taking into account the extent to which the claim forecloses after-arising embodiments of the idea, the nature and extent of the prior art, and the level of disclosure by the inventor.\textsuperscript{280}

After discussion Section 112, the paper then looks to the historical context for the theory they espouse—looking at case law. Again, this seems like a traditional contours approach to the problem. First, they look at “historic cases” and modern cases to “illustrate how excluding abstract ideas limits claim scope” to support their idea that patentable subject matter should take an overclaiming approach.\textsuperscript{281} This leads them to suggest a test—that is looking at the historical (including modern history) and functional approaches to patentable subject matter, led them to suggest a new test.\textsuperscript{282} This is how traditional contours should work—that it helps to sort through the key elements, which leads to new results.

2. Samuelson and Schultz’s “Clues”

Samuelson and Schultz want to develop a framework for a jurisprudence of abstractness.\textsuperscript{283} Working from Justice Kennedy’s notion of needing a limiting principle in \textit{Bilski}, “a limiting principle was needed so that the U.S. Patent and Trademark Office (PTO) and the courts could determine which kinds of methods affecting business operations should be eligible (or not) for patent protection.”\textsuperscript{284} They are pursuing a “clue” approach, rather than a bright-line rule. To get to these clues, they “mine the Bilski decision, the precedents on which it relies, as well as the Constitution, the Patent Act, and patent-related policies for clues that may aid in determining whether a claim is too abstract to qualify for patent protection, or is instead sufficiently concrete to be eligible for patenting, assuming other criteria for patentability are satisfied.”\textsuperscript{285} The question this section asks is whether this could be categorized as a traditional contours

\textsuperscript{280} Id. at 1329
\textsuperscript{281} Id. at 1332 (2011)
\textsuperscript{282} “In sum, we believe at least five factors are critical to a proper scope-based determination for patentable subject matter eligibility under § 101:

• Is the claimed invention potentially generative of many kinds of new inventions?
• Does the industry rely heavily on cumulative invention?
• Is the technological field fast-moving?
• Has the patentee disclosed a small number of embodiments but claimed a broad inventive principle?
• Has the patentee made an important contribution relative to the prior art?

No one factor should dominate; we advocate a contextual, common-law approach. Courts and scholars are likely to develop other factors as our approach is applied over time.” Id. at 1341 (2011)

\textsuperscript{283} Id.
\textsuperscript{284} Id. at 111.
\textsuperscript{285} Samuelson & Schultz, "Clues", supra at 112.
approach to determining patentable subject matter. Bright line tests don’t work, says the Supreme Court. Is the “clues” approach another way of describing traditional contours? The “clues” that they identify are 1) case law, particularly Supreme Court jurisprudence; 2) the Constitution itself; 3) and the history and structure of the Patent Act itself. These clues look like traditional contours—at least the primary sources for traditional contours.

3. Joshua Sarnoff’s History and Theory

Joshua Sarnoff believes in patentable subject matter, even though it finds itself in a bit of an identity crisis. In “Patent Eligible Inventions After Bilski: History and Theory,” he “supplies a history and theory of subject matter eligibility to guide” what he sees as the necessary “line drawing.”286 He begins the article: “Legal line drawing is difficult. But it is even more difficult without a theory of why the lines are being drawn, what they are supposed to fence in and out, and whether categorical exclusions are preferable to case-by-case rejections.”287 The key for him is the idea that the “Patent Act (for both eligibility and patentability) has always required and still requires creative, human invention in the application of such categorically excluded discoveries.”288

What is most interesting is that Sarnoff sets out to put the current questions regarding line drawing with a historical and theoretical context. Although he does not call it traditional contours, it looks very much like the Tenth Circuit Golan decision’s categories of historical and functional. He wants to put into context why patentable subject matter is necessary, and then provide a workable framework so that decisions made in different areas (genetic, business methods, etc) are consistent and made with a solid rationale. This is the essence of why traditional contours may provide usefulness in creating tests, evaluating new laws, and sorting through difficult questions.

4. Michael Risch

Risch has written a good deal regarding patentable subject matter, and was one of the four authors on “Life after Bilski.” In “Everything is Patentable,” where he argues that patentable subject matter is an unnecessary part of patent law, as courts generally rely on other elements of the patent process to reject a patent, and not solely on patentable subject matter.289 The question I had, when revisiting this article, was he making that claim within a traditional contours framework? Yes! He does a historical analysis of the case law, and then offers his functional reasoning for why patentable subject matter is unnecessary. Risch’s conclusion is particularly telling

Abandoning judicial subject matter restrictions will not answer all of the difficult patentability questions that have arisen and may yet arise as our nation’s inventors and researchers continue to discover new technologies. Those difficult questions,

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287 Id.
288 Id.
289 “Virtually all of the important historical patentable subject matter cases may be explained by applying each of the other requirements for patentability.” Michael Risch, Everything Is Patentable, 75 Tenn. L. Rev. 591, 598 (2008)
however, should be answered by the general criteria that Congress has established—criteria that have worked for over 150 years to determine whether a particular patent claim should be allowed. The exact contour of the trade-offs between innovation and patent protection are largely unknown. Therefore, the PTO and courts should focus on answering specific questions about how to best apply rigorous standards of novelty, nonobviousness, utility, and specification with a scalpel rather than simply eliminating broad swaths of innovation with a machete.290

He analyzed the case law to find that the function of patentable subject matter actually wasn’t what most thought. He suggests scraping it altogether and relying on the other four elements of patentability. We see a historical (rejecting history) and functional aspect to his argument.

5. Menell: the Last Forty Years of Wandering

Menell contextualizes the Bilski decision, as a hoped-for opportunity for clarifying the boundaries of patentable subject matter. 291 He pinpoints the “turn” into wandering with the Diehr case and Chakrabarty.292 He writes, “The past forty years of patentable subject matter jurisprudence harkens back to the Israelites’ wandering through the wilderness following the exodus from Egypt. But unlike Moses’s leadership, which brought the Israelites to the Promised Land by year forty, the Supreme Court’s Bilski decision has left the patent community in the wilderness.”293 So, how does he propose to find our way back out of the wilderness? He would adopt Justice Stevens’ concurrence. He is very critical of Bilski, writing “Moreover, the failure of the Bilski majority to elucidate the basis—constitutional, statutory, and/or jurisprudential—for deciphering the boundaries of patentable subject matter leaves other important industries and decisionmakers in the wilderness. What the patent community needed was a coherent manual for navigating the boundaries of patentable subject matter. What it got was noncommittal, hypertextual, incoherent rambling.”294 So, how would he proceed? He engages in a historical discussion of patentable subject matter, followed by a functional discussion. He does not call it traditional contours, but that is exactly what it is. Read the language he uses to describe his conclusion: “Part IV points the way toward a coherent, historically faithful, dynamic, and pragmatic framework for delineating the boundaries of patentable subject matter.”295

292 “Diehr reversed course and opened the software patent floodgates. The Patent and Trademark Office (PTO), Federal Circuit, lower courts, and patent community have struggled mightily since that time to make sense of those decisions... The Supreme Court’s Chakrabarty decision approved the patentability of nonnaturally occurring, genetically altered microorganisms, but the Court has yet to confront the patentability of human-isolated, naturally occurring DNA molecules and medical diagnostic tests.” Id. at 1291.
293 Id.
294 Id. at 1291-92.
295 Id. at 1292.
His first section, he titles “the arc of patentable subject matter limitations.” He starts with the language of Section 101, and then does a long-view historical retelling of the language. He begins with the Framers and the enactment of the IP clause.\textsuperscript{296} By 1793, what constituted patentable subject matter had been established, although the “contours of patent law” would continue to develop.\textsuperscript{297} “Two issues emerged: (1) the scope of ‘art,’ and (2) whether natural principles could be patented.”\textsuperscript{298} These are the issues we continue to struggle with today. In the Nineteenth and part of the Twentieth centuries, the scope was defined as “manufacturing methods, manufactures, machinery, and compositions of matter,” with business methods beyond the boundaries of patentable subject matter.\textsuperscript{299} In discussing the exclusions under patent law, he discusses both the historical and functional rationale, where a principle is not patentable, but the application of a principle would be, concluding, “This pragmatic, philosophical explication of the contours of patentable subject matter became the foundation for much patentable subject matter jurisprudence.”\textsuperscript{300} He quickly turns to the Patent Act of 1952 and modern case law until 1981, where he saw continuity in the basic contours of patentable subject matter. He marks \textit{Diamond v. Diehr} as the departure moment. He titles the next section, “1981-2010: Wondering in the Patentable Subject Matter Wilderness”\textsuperscript{301}

Menell turns to the \textit{Bilski} decision. Menell’s criticism looks like a traditional contours argument. He criticizes the majority opinion for its short one-paragraph description of the historical context of patentable subject matter: “These three sentences blithely sweep the fundamental interpretive problem of patentable subject matter—what grounds and guides the contours of the exclusions—under the rug.”\textsuperscript{302} He next criticizes Kennedy’s textural reading. Again, we hear a traditional contours argument in his frustration: “This textualist approach badly misconstrues the 1952 Act and thereby undermines the stability and grounded evolution of patentable subject matter.”\textsuperscript{303} One can see the need for a historical and functional analysis, and that in Menell’s view, Kennedy has failed to engage in either. Again and again we see Menell making a traditional contours argument: “The Bilski majority treats the language in § 101 as though it were enacted in 1952. Yet nearly every word of § 101 traces back to 1790 and 1793. Congress did not intend to supplant more than a century of jurisprudence with the ‘ordinary, contemporary, common meaning’ of the word ‘process.’ Rather, it intended to perpetuate the existing contours of patentable subject matter as expressed in the statute and recognized in patent jurisprudence.”\textsuperscript{304} Menell sees a cost in the majority’s approach: “The Supreme Court's failure to articulate a clear roadmap for navigating the boundaries of patentable subject matter undermines the patent system on multiple levels.”\textsuperscript{305} He believes it will lead to legal uncertain, undermine the functioning of the patent system on an administrative level, and impair the political economy surrounding patents.
Menell’s solution looks like traditional contours. He writes, “Since the founding of our nation, courts have evolved these doctrines within a hybrid constitutional/common law tradition…. By failing to explicate the framework for delineating the scope of patentable subject matter or its contours, the Court shirked its larger constitutional responsibility, thereby contributing to a pathological political dynamic that undermines the patent system.”

His solution is all traditional contours: “The proper interpretive path for patentable subject matter—from constitutional, jurisprudential, and pragmatic standpoints—requires courts to integrate the constitutional and jurisprudential traditions surrounding patentable subject matter with statutory construction principles and forthright recognition of the challenges of applying historic doctrines to unforeseeable technological developments. This can be done only by understanding the historical context for the various provisions and doctrines of patent law.”

VII. PROMETHEUS AND TRADITIONAL CONTOURS OF PATENT LAW: A TEST CASE

A year after Bilski, the Supreme Court accepted another patentable subject matter case. After oral arguments for Mayo v. Prometheus, the Washington Post headline read, “Supreme Court has hard time finding an easy test for patents on medical processes.” The newspaper explained, “Prometheus Laboratories holds patents for how to determine the proper dosage of drugs that treat gastrointestinal and other autoimmune diseases. The problem for the company, defending itself Wednesday at the Supreme Court against a patent challenge from the Mayo Clinic, was that its procedures don’t sound like much of a discovery. You administer the drug. You take a blood sample. If the level of the drug or its components is too low, you increase the dosage. If too high, you decrease.”

Was this merely a set of facts reported, as Justice Kagan suggested? Justice Breyer asks, “What has to be added to a law of nature to make it a patentable process?” This is a question of boundaries and preemption. This section looks at this question from the point of view of how traditional contours might assist with the narratives.

In some ways, Mayo v. Prometheus is a battle of definitions and history. On one side, Prometheus seems to be following the Giles era of expanding patents, the Chakrabarty “anything under the sun made by man,” and State Street’s “useful, concrete and tangible result.” The argument seems almost startled at how anyone could doubt that their invention was not patentable. The Petitioner’s, on the other hand, want to put a stop to the increase in patentable subject matter, to turn back the clock, to push back.

A. The Petitioner’s Story

The brief for the Petitioners believe that Prometheus’ patents “give Prometheus a sweeping monopoly on a biological correlation between drug administration and natural
changes in blood chemistry,” and impedes further medical investigation that improves monitoring drug interaction in a patient “without permission from Prometheus.”312 Does correlations between a blood test and patient results satisfy patentable subject matter, or are the correlations naturally occurring phenomenon, and therefore not patentable?

From its first introductory sentence, the Petitioners begin their argument by situating Section 101 within a historical context (traditional contours?): “For more than a century, this Court has made clear that a patent claim fails under 35 U.S.C. § 101 if it preempts all practical use of an abstract idea, natural phenomenon, or mathematical formula. The Court has explained that these fundamental tools of discovery must be available to all for use in developing new and better inventions.”313 We see traditional contours constructed by the court for over a century. If the patent at issue deviates from the traditional contours of patent law, the patent should be found invalid. “Petitioners ask this Court to reaffirm that basic principle in the context of medical patents covering natural phenomena.”314 Sound like Merges; sounds like traditional contours (ala functional component). The Petitioners suggest that the patent covers a naturally occurring phenomenon with no concrete (useful) results. In Merges’ terms, the Petitioners are arguing against removal of a naturally occurring phenomenon and disproportional power of Prometheus would have, leading to less efficiency. It would, in short, upset the traditional balance, the traditional contours of patentable subject matter.

To understand whether it is a naturally or non-naturally occurring (Chakrabarty), one must delve into the science at hand. Here, the patent focuses on the metabolites, which are “chemicals produced in the blood when a patient metabolizes a drug.”315 Judging what the metabolite levels mean requires adjustment, research, and recognition that there is still patient-to-patient variability. “In making determinations about what metabolite numbers mean for public health, the freedom to question old information and to improve on it is necessary to save lives.”316 Framed in Merges’ discourse, this is a classic framing of non-removal: we all must be able to play with certain elements within culture and society, and therefore some information is not patentable. One can call this a functional requirement of traditional contours, as well. In this case, the drug azathioprine, or thiopurine, is administered to a patient. The Petitioners note that administering and then measuring the metabolites from this kind of drug has been done for decades. Here, the patent covers the use of the drug in inflammatory bowel disease in pediatric patients, and studied found the best possible metabolite levels. The inventors were researchers at a

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313 Id. at 2.
314 Id. at 2.
315 “The correlation between metabolites and patient condition is more consistent across a population than is the correlation between dosage levels and patient condition, so particular metabolite levels correlate generally with patient health. This is much like blood alcohol testing, where a certain blood alcohol level is a better indication of a person’s condition, across a population, than the number of drinks the individual may have consumed…According to Prometheus, Dr. el-Azhary must stop her dermatological research until she purges her memory of the correlations—regardless of how she ultimately may use any test results—because Prometheus’s claims preempt all possible uses of the natural correlations. Indeed, anyone who sees Prometheus’s numbers and a patient test report of metabolite levels is a potential infringer—even someone who reads about those ranges in this brief.” Brief for Petitioners at 3, 13, Mayo v. Prometheus, No. 10-1150 (Sept. 2, 2011) 2011 WL 3919717.
316 Id. at 4.
Montreal university. Prometheus licensed the research from the inventors and the employee hospital where they worked, and then Prometheus filed for and obtained patents. The patent consists of administering the drug, and then measuring the metabolites to see if they fall within the proper range described in their research.

Prometheus marketed the test as Pro-Predict, where hospitals send blood samples to Prometheus for analysis of the metabolite levels, and in response, Prometheus sends back a test result. For a number of years, the Mayo Clinic used the Pro-Predict test, but in 2003, researchers at Mayo Labs saw ways to improve the test with more detailed information. What is interesting about the story is not told here by the Petitioners. Mayo Clinic knew that it was a patented product, and that experimental use defense would probably not cover what they were doing. This is an interesting step, which would seem to contravene the traditional expectations within the patent community. Moreover, in June 2004, Mayo “announced it would offer its own thiopurine metabolite test to compete with the Pro-Predict test.” Mayo did not attempt to patent the product, but gave out freely useful information with the test results, and Mayo wanted to enter the market at 25% less than Pro-Predict. All of this seems fairly suspicious within a patent system. One cannot improve on another’s patent without permission, and then price the original one out of the market. Merges’ categories of proportionality and efficiency quickly come to mind. So, how does Prometheus respond? They sue Mayo.

What was Mayo’s defenses to the Prometheus’ claim of patent infringement? The claims were not patent-eligible under Section 101. The District Court found for Mayo, as describing naturally occurring phenomena: “Prometheus did not ‘create’ the correlation between thiopurine drug metabolite levels and therapeutic efficacy and toxicity. Instead, the correlation results from a natural body process, which as the inventors concede, was pre-existing in the patient population, and it exists in the patient population today.” They found that the steps involved in the methods patent (administering the drug and gathering data) were “merely data-gathering steps.” Using Benson, the court found no “transformation,” and found that “Prometheus’s claims preempt all uses of the physician-recognized natural correlations…” The patents were invalidated. The district court saw the patent as overbroad, contravening the traditional contours of non-patentability, removing the ability to correlate data from naturally occurring phenomenon. All of this fits within a traditional contours test—function and Merges’ categories (non-removal, proportionality, efficiency and even dignity could apply)

317 Id. at 9.
318 Id. at 9.
319 The Petitioners claim that it was in the legislative stage that revealed the breadth of the claims asserted in the patents by Prometheus. Moreover, the Petitioners note that Prometheus believed Mayo researchers infringed the patent relating to metabolites even in disparate fields—a dermatology researcher collecting data on patients using thiopurine infringed the patent because the research described a therapeutic range. Id. at 10-12.
321 Id. at 14 (quoting the District Court (Pet. App. 66a)).
322 Id.
323 Id. at 15.
Reversing the district court, the Federal Circuit applied the “machine-or-transformation” test for process claims. Mayo petitioned the Supreme Court, when Bilski was decided, whereby the Supreme Court remanded the Mayo case back to the Federal Circuit. The Federal Circuit found for Prometheus again. The Federal Circuit found a transformation in the metabolization of the drug in a patient’s body and when the blood was test for metabolites itself, thereby clearing the patentable subject matter hurdle.324

At the Supreme Court level, the Petitioners argue that the patent is invalid as it is overbroad and covers a natural phenomena.325 They also note they have not met the utility requirement, and that all the patent involves is an “open-ended ‘mental step.’” “Prometheus acknowledges that, if its patents are valid, physicians may not consider thiopurine metabolite correlations without a license, and they infringe the patents by determining that Prometheus’s metabolite ranges are medically inappropriate.”326

The Petitioners argue that the steps were long known in practice, but here were applied to a particular set of patients with a particular disease. Nevertheless, say the Petitioners, the steps one takes to determine metabolite levels are true for any research and should not be locked up by one patent holder. Moreover, here the patent is locking up “laws of nature.”327 Not using the traditional contours language itself, the Petitioners both identify that this is a long-standing practice, even older than the current 1952 law, and that it has a functional element as well. They also use Merges’ like language: “Congress never would have intended to allow sweeping patent claims like Prometheus’s that chill research and speech and prevent institutions like Mayo Clinic from identifying better metabolite ranges or marketing more accurate and inexpensive tests, and ultimately ‘retard [rather] than advance innovation, and thus…frustrate the broader goals of patent law.’”328 One can see non-removal, efficiency, dignity, and proportionality all at play in their describing of traditional expectations within the patent system, or more bluntly traditional contours of patent law.329

The Petitioners assert that the patents are invalid under Section 101 because they “monopolize all uses of a natural biological relationship,” even though thiopurine drugs have been used in a variety of medical treatments for over thirty years.330 Moreover, judge-made law traditionally has carved out limits of patentability to include “laws of nature, physical phenomena, [and] abstract ideas.”331 The Petitioners argue this a key principle of patent law, citing Chakrabarty, Funk Brothers, Benson, Parker, Diehr, and Bilski as upholding the strong demarcation. “Bilski reaffirmed the vitality of all of these

324 Id. at 17.
325 Id. at 18.
327 Id. at 20.
328 Id. at 21.
329 “The underlying policy of the patent system [is] that ‘the things which are worth to the public the embarrassment of an exclusive patent’” must “outweigh the restrictive effect of the limited patent monopoly.” Brief for Petitioners at 20, Mayo v. Prometheus, No. 10-1150 (Sept. 2, 2011) 2011 WL 3919717 (citing Bilski, 130 S. Ct. at 3258 (Breyer J., concurring in judgement)).
330 Id. at 23.
331 Id. at 26.
Precedents." Prometheus’ patents fall into this category. Moreover, the process itself was not sufficient to qualify for a patent, and that the steps they described were already “well-known” and “long-prevaleent” in medical practice. Moreover, patenting such a correlation hurts patients’ health.

Finally, the Petitioners turn to the First Amendment argument. “Equally well established was the legal principle that federal legislation must be construed to avoid conflict with First Amendment freedoms whenever possible.” The Petitioners turn to the idea that Prometheus’s patent impedes “the freedom to think.” “Throughout our Nation’s history, the freedom to think—to consider what one has seen, to reach mental conclusions based on those observations, and to change one’s future plans in light of those conclusions—have been deemed sacrosanct.” The patent impacts speech, they suggest. This argument is nodded to in the opening of the brief but does not become fully fleshed out until page 46, where they believe Prometheus’ patents chilled speech, research, and thought. They use the example of the dermatology research and the inability of Dr. el-Azhary to publish her work for fear of an infringement suit.

Two basic questions are at issue: what are the boundaries of patent law with regard to patentable subject matter, and in particular natural phenomena, and how does this interact with the machine-or-transformation test for patentable subject matter? At what point is a machine and/or transformation enough to overcome the preemption of natural phenomena. That is the question of the day. But it is not our question. What this paper is look at is how the arguments themselves are being framed—can we see a place for traditional contours within the discussion, either using the Tenth Circuit’s two part functionality and historical test, or the alternative this paper has used, Merges’ mid-level principles. Functionally, the need to keep certain information free for all to use and free for all to think is vital. The patent, in this case, crossed the line. On a historical level, the Petitioners cite the patentable subject matter line of cases as evidence that there is a long tradition of non-patentability of this sort of data. What is interesting is that the law itself is not being question, but the interpretation of what constitutes natural phenomena. It is a science question. The traditions of the case law remain intact. The argument is how to parse the science and the process.

Using Merges’ four mid-level principles to discern traditional contours from the Petitioners’ point of view, they see the patent as removing work, causing inefficiency, disproportionate gain and restrictions, and in the end, one could argue, impact the dignity of researchers and doctors in not being able to think for themselves without fear of infringement. If his four categories were to stand for traditional contours, even if the patent stood up to a machine-or-transformation test, as it did in the Federal Circuit, the court could still find the patent invalid because it alters the traditional contours, i.e. the traditional expectations for patent law. Traditional contours, then, adds a further layer of discussion to the doctrine, case law, and legislation, just as Merges suggests. One need

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332 Id. at 26-34.
333 “Id. at 35.
334 Id. at 46.
335 Id.
not agree on the outcome or the theory, and one could even disagree on which principles
should be included. But what traditional contours allows is to step a little bit back and
evaluate the larger role of a particular line of cases or statutory materials. If a more solid
test of what was included within traditional contours—if it was more developed, it could
be very powerful, particularly in the face of new technologies and controversies.

The Petitioners use traditional contours to tell their story—how historically and
functionally natural phenomena has been off limits, and that by extending patents to
Prometheus, the government has violated the First Amendment by implicating a doctor’s
“freedom to think” under speech rights. We have also seen that the Petitioners’
argument could fit within Merges’ four midlevel principles. The ultimate question, then,
what does having a traditional contours test (with the Tenth Circuit’s functional and
historical test, Merges’ four midlevel principles or some other construction) add? I
would suggest it brings in contextual elements that would allow a court to further help to
determine whether the changes brought by new law are too sweeping for a stable system.
Traditional contours in many ways are what society has come to expect to have a
knowable, reliable system. Times change and with it, expectations, too. Traditional
contours allow that change not to be so disruptive as to effect efficiency, or what I have
previously called the physics of the system.

B. The Respondent’s Story

The Respondent tells a very different story, and from the beginning signal that they
do not agree with the Petitioner’s framing of the narrative:  “Mayo’s brief distorts the
Prometheus’s claims are not drawn to scientific facts in the abstract, and they do not
“preempt” broad principles like the laws of chemistry or the idea of measuring
metabolites. No one can infringe these claims merely by thinking about correlations. The
claims describe concrete and specific physical processes, employing synthetic drugs and
machines, that are used only to improve the clinical treatment of seriously ill patients.”

In short, the Respondent argues clear, traditional patent infringement. Their reply brief
holds that the Federal Circuit properly ruled, following legal precedent, that their
invention met patentable subject requirements under section 101. Moreover, they accuse
Mayo of trying to make a certain category unpatentable, which is contrary to patent
practice. The invention helps determine the proper dose of a particular medicine,
providing safer medical treatment for chronically ill Chron’s patients.

The respondent explains the basic three-step claim of the patents: “First, most of the
claims begin with the administration of a thiopurine compound to a patient with an
autoimmune disorder. As noted, the thiopurine converts within the body into metabolites
that do not otherwise exist in nature. Second, the patient’s metabolite levels are
determined. Because “metabolite levels are not detectable in raw human tissue,” all
methods for measuring their concentration require “significant chemical and physical
alteration of blood or human tissue” and sophisticated laboratory equipment and
machines…. Third, the metabolite measurements are compared to the patents’ reference

levels, “warning” the physician about the potential efficacy or toxicity of the patient’s dosage. This test, according to the respondent, has improved patients’ lives, is cost-effective, readily available, and reduces medical costs. Prometheus was able to take research and through the patent system, put the information into a useful test.

Mayo wanted to produce a competing commercial test that would have undercut the market created by Prometheus, contrary to how the patent system worked. Mayo had previously purchased Prometheus’ tests “over 17,000 times between 1999 and 2007.” When Prometheus sued for patent infringement, Mayo then claimed the patent was really an abstract idea.

C. The First Amendment Arguments in Golan and Prometheus compared

In both Golan and Prometheus, a First Amendment argument is used—in both cases highly unusual. Golan tries to extend First Amendment protection to the public’s use of works once they are in the public domain, unsuccessfully, however. Prometheus attempts to apply the First Amendment to patents as a means of protection the “freedom to think.”

The Cato Institute wrote an amicus for both Golan and Prometheus. For Golan v. Holder, the Cato Institute, in support of the Petitioners, filed an amicus brief. Interestingly, they did not directly address the “traditional contours” argument in this brief. It would be in their brief for Mayo v. Prometheus, where they would directly address “traditional contours,” but in the context of patents.

For Mayo v. Prometheus, the Cato Institute formulated the question: “Whether someone can patent the process of observing correlations between blood test results and patient health—effectively preempting all uses of the naturally occurring correlations—simply because the methods used to administer prescription drugs and test blood may involve “transformations” of body chemistry.” The Cato Institute argued that the patents at issue did not qualify as a process using a historical argument that historically to qualify for a process, the patent had to include something that had an effect on matter; that the 1990s expanded the scope of patentable subject matter beyond its historically traditional boundaries (“Prometheus’s patents are two among thousands of abstract process patents which have been improvidently granted since the 1990s”) Cato Brief at 2); and a process is a set of actions, but here there is no action involved, no steps actually

338 Id.
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341 In Prometheus, the amicus was joined by the along with the Reason Foundation and the Competitive Enterprise Initiative.
343 Their focus was on the treaty power question.
344 Id.
occur. They set out a historical and functional justification for denying patentability; they also set up a market reason (efficiency) and public domain (non-removal) for denying patentability as well. But most interesting is the development of their First Amendment argument.

The Cato Institute begins its section on the First Amendment: “The government cannot regulate mere thought,” citing First Amendment cases where the Supreme Court found that the First Amendment protects freedom of thought. According to Ashcroft v. Free Speech Coalition, “The right to think if the beginning of freedom…” These patents, the Cato Institute believes, would violate a doctor’s right of freedom of thought. The brief explains, “Before learning of the correlations described in the claimed patents here, Dr. el-Azhary was able to administer drugs and determine the amount of metabolites in patients without risk of patent infringement. Only upon learning the correlations—and presumably thinking about them when she sees the metabolite levels of her patients—did she put her and Mayo’s interests at risk. By forcing Mayo, or any party not covered by 35 U.S.C. § 287(c), to pay damages for infringing the patents at issue here, the government engages in punishment for mere thought.”

But the Cato brief goes a lot further. “Enforcing the patents at issue here constitutes a content-based regulation of thought.” Patents, like copyrights are subject to First Amendment scrutiny because they both fall under the same Progress clause. The amicus brief turns to Eldred v. Ashcroft, which expressed the limited role the First Amendment would play in the context of copyright law: “the patents at issue here should be invalidated as an unprecedented content-based regulation of thought that ventures far beyond the traditional contours of patent protection.” The brief explains cites Eldred’s explanation that the First Amendment and copyright clause are compatible, being enacted close in time, and that for the most part, copyright’s “built-in free speech safeguards are generally adequate to address [First Amendment concerns].” But sometimes “copyright law could still run afoul of the First Amendment,” that “copyright law was not ‘categorically immune from challenges under the First Amendment,’” and “Where Congress ‘alter[s] the traditional contours of copyright protection,’ First Amendment scrutiny may be necessary.”

345 Id.
347 Id. at 28 (citing Stanley v. Georgia, 394 U.S. 557, 565-66 (1969) (“[T]he right to control the moral content of a person’s thoughts . . . is wholly inconsistent with the philosophy of the First Amendment. . . . [The government] cannot constitutionally premise legislation on the desirability of controlling a person’s private thoughts.”); see also United States v. Ballard, 322 U.S. 78, 86 (1944) (“Freedom of thought . . . is basic in a society of free men.”); see also Wallace v. Jaffee, 472 U.S. 38, 51 (1985) (acknowledging that freedom of thought is protected by the First Amendment); see also Wooley v. Maynard, 430 U.S. 705, 714 (1977) (same)).
348 Id. at 29 (citing 535 U.S. 234, 253 (2002)).
349 Id.
350 Id.
351 Id.
352 Id.
354 Id. (citing Eldred v. Ashcroft, 537 U.S. at 219, 221).
very different role in patents and copyrights.” Patents, in contrast to copyright, “generally do not raise First Amendment issues.” The process of obtaining a patent—the enablement requirement—means that for the most part, that patents are “widely disseminated” to the public through the application process itself. “Patent law has not developed the ‘free speech safeguards’ of copyright law because patent law does not usually exist in tension with the First Amendment freedoms.” The Cato Brief suggests that because, unlike copyright with built-in First Amendment safeguards, patent law, in this case, should be subject to “strict scrutiny because enforcing them places individuals who think particular thoughts, after doing otherwise non-infringing activities, at risk of punishment.”

The Cato Institute then turns to Eldred’s “traditional contours of protection” as a second First Amendment argument, because with these patents “the traditional contours of copyright protection were altered.” The brief explains, “The patents at issue here represent an unprecedented departure from the traditional contours of patent protection. Patents have traditionally protected objects and actions. Only recently have parties sought patent protection for claims which final element encompasses pure thought. The patents at issue here extend far beyond the traditional contours of patent protection and have frightening First Amendment implications. Even if they cover otherwise patentable subject matter, the claimed patents should be invalidated as unconscionable violations of the freedom of thought.” Cato is using a functional and historical argument.

D. The U.S. Supreme Court Decides…

VIII. AMERICA INVENTS ACT AND TRADITIONAL CONTOURS

The America Invents Act was signed into law on September 16, 2011 by President Obama. The act dramatically changed how one determines the priority of who “gets” a patent. Where previously the U.S. functioned on a first-to-invent system, now the U.S. joins the world in adopting a first-to-file system. Novelty and statutory bar has dramatically altered under the new act, as has countless other aspects of the law. We have seen dramatic alterations on how one configures the boundaries of intellectual property law. The U.S. moved from a publication-based term to a life-plus term in 1978. The function of the law shifted, as did the rationale, theoretical underpinnings, and scope. The question is how much did the new act alter the traditional assumptions and physics of the system, and how should we understand these changes? This section will look at three changes, two of which appear to contravene the spirit of the traditions of patent law,

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356 Id.
357 Id.
358 Id.
360 Id. at 31 (citing Eldred at 221).
361 Id.
while the third, the change to first-to-file, one can see the Congress trying to retain the spirit of the traditions in supplemental aspects of the new novelty standard.

A. First To File

Some may believe that changing from a “first to event” system to “first to file” system would violate the “traditional contours” of patent law, as it dramatically alters who gets a patent as it defines the trigger for federal protection. However, if we take our “cues” from copyright history, and in particular the Tenth Circuit’s analysis and Ginsburg’s analysis in *Golan*, both of which describe a similar transformation in copyright law, from publication to creation as the trigger for federal protection, it appears that how one enters the system does not necessary violate traditional contours when it is changed. When, in 1978, we moved from a dual system, of unpublished works protected by state common law and/or state statute to one where unpublished works were protected by the 1976 Copyright Act, Congress made sure to give adequate time for the change to occur in a number of ways. It appears with the eighteen months transition period to the new system, the America Invents Act has provided the same kind of transition period.

B. Banning Tax Patents: Breaking with the “traditional contours” of patent law?

In 2011, when the America Invents Act was signed into law, tax strategies were explicitly “banned” from patent eligibility. The concern over tax strategy patents had a decade or longer history. *State Street*, the opinion, which penned the test, “concrete and tangible result” test, concerned a tax strategy patent. Currently, tax strategy patents are one sub-class of business methods patents, and these patents have been the subject of litigation on more than one occasion. Tax strategy patents have remained controversial, with some believing the PTO does not have the expertise to evaluate the novelty and obviousness requirement, and others have raised policy questions that patents on tax strategies could privatize the tax system, a system that all citizens “are obliged to pay and report.” Patents may also give the appearance of government approval (in the form of an issued patent) in the particular tax strategy. Their fears, however, could be alleviated, through a “traditional contours” argument. Ellen Aprill explained in “The Supreme Court’s Opinion in *Bilski* and the Future of Tax Strategy Patents,” “[M]embers of the patent bar explain that many fields have had similar reactions when patents entered

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362 See Townsend Gard, [put in unpublished copyright articles – here]
363 In a one-page press release of the new act put out by Senator Leahy, the last point listed is titled “Bans Tax Patents,” explains, “The America Invents Act will benefit tax payers directly by prohibiting patents on tax strategies, which often lead to additional fees on taxpayers who are simply complying with the tax laws.” http://leahy.senate.gov/imo/media/doc/PRESS-Summary-OnePager-FINAL.pdf
365 The PTO not only considers tax strategies as a type of business method but also has established a special subclass for them. As of 7/31/10 there were 112 issued patents in that subclass. (Patents frequently are listed in more than one subclass.) These patents cover a number of areas of tax practice—employee benefits, charitable giving, employee compensation, and financial products, to name a few.” Ellen P. Aprill, *THE SUPREME COURTS OPINIONS IN AND THE FUTURE OF TAX STRATEGY PATENTS*, 113 JTAX 81, 84 (August 2010).
366 Id. at 84.
367 Id. at 85.
their area, that patents exist in other areas related to compliance with federal law, and that Congress has decided that the benefits of a broad definition of patentable subject matter and the encouragement of innovation outweigh the burdens patents impose. ‘Careful application of the traditional requirements for patentability will eliminate virtually all of the criticisms that have been directed to patents on tax-related methods.’ Patent lawyers ask for evidence that tax strategy patents have undermined collection of revenue or the efficacy of our tax laws.»368

Three bills in 2007 were introduced to prohibit tax strategy patents. After Bilski, practitioners and scholars alike tried to determine what would the new standards were—what was patentable, and this was also true with tax strategy patents. Then, Section 14 was included in the America Invents Act.

Section 14 addresses “tax strategies.” What is interesting is that tax strategies are not banned under Section 101 (patentable subject matter). Instead, the bill structured ineligibility for patenting under a prior art analysis. “For purposes of evaluating an invention under section 102 or 103 of title 35, United States Code, any strategy for reducing, avoiding, or deferring tax liability, whether known or unknown at the time of the invention or application for patent, shall be deemed insufficient to differentiate a claimed invention from the prior art.”369 The section did include exceptions: “This section does not apply to that part of an invention that—(1) is a method, apparatus, technology, computer program product, or system, that is used solely for preparing a tax or information return or other tax filing, including one that records, transmits, transfers, or organizes data related to such filing; or (2) is a method, apparatus, technology, computer program product, or system used solely for financial management, to the extent that it is severable from any tax strategy or does not limit the use of any tax strategy by any taxpayer or tax advisor.”370

The section ends with a “rule of construction”: “Nothing in this section shall be construed to imply that other business methods are patentable or that other business method patents are valid.”371 This is a fairly negative statement, and seems to be calling back the dissent in Chakrabarty. No endorsement of business method patents can be inferred by the limiting of business method patents in the act. Section 14 applies immediately, including to any patent already in process.372 No transition period is given.

Under a traditional contours analysis, I find Section 14 fairly troublesome. Tax strategies (along with human organisms) appear to create specific excludable categories. We have not seen this before. Traditionally, patentability was subjected to sections 101-103. Now, at least two interest groups had injected absolute categories. Under the traditional contours analysis, the court could find these two elements beyond the scope of “traditional contours of patent law.” It would be up to the court to determine whether tax

368 Id. at 85. Aprill also cites Figg, Should the Patent Laws Exempt Certain Innovations from Patent Eligibility?, ABA IPL Newsletter, Summer 2006.
369 Section 14 http://judiciary.house.gov/issues/Patent%20Reform%20PDFS/112hr1249eh.pdf
370 Id.
371 Id.
372 Section 14(e), America Invents Act.
strategies were patentable, rather than be an explicitly excluded category. It is also interesting that the exclusion is over prior art, rather than patentable subject matter. Can a specific category of prior art be excluded within the statute itself? Does this go beyond the bounds of patent law?

Michael Risch in “Everything is Patentable” addressed tax strategy patents as a question of patentable subject matter. He wrote, “Under a rigorous patentability test, however, most tax minimization methods would be considered obvious. While creative, pure tax methods are merely an obvious combination of transactions that are considered nontaxable under the Internal Revenue Code. Tax methods may even be automated, but automation alone is not patentable unless the means for automation are novel and nonobvious.”373 In this context, there is no need for Section 14. Other areas of patent law would take care of the worries of patentable tax strategies.

C. Banning “human organisms”

Section 33 of the America Invents Act reads: “—Notwithstanding any other provision of law, no patent may issue on a claim directed to or encompassing a human organism.” It applies to any pending patent, but not issued patents, at the time of enactment. Like the case of the tax strategy patents, a ban patenting “human organisms” presents interesting questions on traditional contours, and brings us back to Chakrabarty. On September 20, the USPTO issued to the Patent Examining Corp a memo directly addressing “Claims Directed to or Encompassing a Human Organism.”374 The memo states that the inclusion of Section 33 does not alter “existing law or long-standing USPTO policy” regarding human organisms, taking the position that section 33(a) codifies MPEP Section 2105, which reads, “If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter.”375 There is no further direction given to the examiners, however, on what constitutes “whole.” For a non-patent specialist, this turn of events seems troubling, as there seems to be a significant different in what the Patent Office does as its procedure, and what the statute includes. Patent law, previously, did not include specific exclusions within the patent act. There was more fluidness to this. One wonders why there was a need to include “human organisms” as unpatentable, and moreover, is this the first of many specific categories that will be inserted as unpatentable. This seems to violate the spirit of the patent act, both historically and functionally.

IX. DEFINING “TRADITIONAL CONTOURS” FOR PATENTS AND COPYRIGHT

Eldred tells us a there is a system is created to support the IP clause, and only when the traditional contours of that system are altered, does one turn to the First

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375 Id.
Amendment. We see also from Eldred and now Golan that the IP system has built-in First Amendment safeguards, as well as additional safeguards. Identifying those safeguards, then becomes key. This could be a list or something more like Merges’ more abstract categories, something more generic like the balance between the individual and society, or specific legislative and judicially created safeguards. For the Eldred court, the safeguards were quite concrete including the “homestyle” exemption for restaurants and a library exception under the CTEA, and Golan gave us no further clue except to write that the Tenth Circuit did not approach the problem correctly.

Bilski saw the justices struggling to define boundaries without bright-line rules. The “system” created by the IP clause was historically and functionally not premised on bright-line categories but a more thoughtful approach. Prometheus may signal that patents too have a First Amendment boundary—where what is being properitized violates the First Amendment rights of others. This may give us a “clue” (in Samuelson/Schultz fashion) that the First Amendment does have a role to play in the IP clause beyond fair use and idea/expression in copyright, as Eldred had indicated. Raising a First Amendment concern, then calls into question the traditional contours of copyright or patent law, when what is being proposed may go beyond the boundaries of the IP clause itself and to greatly alter the spirit or function of “system” created.

And so we are left with the articulation of Justice Ginsburg in Golan, which found the built-in First Amendment mechanisms of fair use and idea/expression sufficient for the Golan plaintiffs. Will they always be sufficient? These same mechanisms are not built into patent law, and so it will be interesting to see if this once again opens up the question “what are the traditional contours” of intellectual property law, and what happens when they are altered?

Traditional contours, however, is bigger than Justice Ginsburg. Traditional contours define the battles of our times—over how we want our system to look and what can fall by the wayside as times change. Patentable subject matter seems in a battle for defining traditional contours, as demonstrated by the cases over the last year and the scholars’ writing as well. Whether Justice Ginsburg foreclosed further discussion on the nature of the public domain is yet to be seen, but she certainly altered the traditional contours in her latest opinion.

And so, what does traditional contours look like? Traditional contours is a flexible tool that helps define the scope and boundaries of a particular area of law. It is firmly grounded in the common law and precedent, but it also looks deeper to understand the historical context of the cases and practices, as well as the functional aspect as well. Traditional contours, then, becomes a tool for help with the hard cases, for boundaries, for new situations of first impression. It could be seen as a supped up version of our current common law practices—a little more thoughtful on tradition and a little deeper on the policy, theory, and functionality of a particular law. Or, perhaps, it is merely a recognition that every analysis is a traditional contours analysis, giving us the explicit opportunity to engage in the structure, function and purpose of the system. But I think, in
the end, traditional contours helps us to be more aware of what we are doing—how are we using history—what history are we using—are we arguing for or against history, for example. Traditional contours, then could be defined, in the end, as a functional and historical analysis of a particular issue/law within the context of underlying principles of the system. How each of those elements gets defined is the fun part of the process…