

STEVENS, J., dissenting

SUPREME COURT OF THE UNITED STATES

No. 01–618

ERIC ELDRED, ET AL., PETITIONERS *v.* JOHN D.
ASHCROFT, ATTORNEY GENERAL

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

[January 15, 2003]

JUSTICE STEVENS, dissenting.

Writing for a unanimous Court in 1964, Justice Black stated that it is obvious that a State could not “extend the life of a patent beyond its expiration date,” *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U. S. 225, 231 (1964).¹ As I shall explain, the reasons why a State may not extend the life of a patent apply to Congress as well. If Congress may not expand the scope of a patent monopoly, it also may not extend the life of a copyright beyond its expiration date. Accordingly, insofar as the 1998 Sonny Bono Copyright Term Extension Act, 112 Stat. 2827, purported to extend the life of unexpired copyrights, it is invalid. Because the majority’s contrary conclusion rests on the mistaken premise that this Court has virtually no role in reviewing

¹Justice Harlan wrote a brief concurrence, but did not disagree with this statement. Justice Black’s statement echoed a portion of Attorney General Wirt’s argument in *Gibbons v. Ogden*, 9 Wheat. 1, 171 (1824): “The law of Congress declares, that all inventors of useful improvements throughout the United States, shall be entitled to the exclusive right in their discoveries for fourteen years *only*. The law of New-York declares, that this inventor shall be entitled to the exclusive use of his discovery for thirty years, and as much longer as the State shall permit. The law of Congress, by limiting the exclusive right to fourteen years, in effect declares, that after the expiration of that time, the discovery shall be the common right of the whole people of the United States.”

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congressional grants of monopoly privileges to authors, inventors and their successors, I respectfully dissent.

I

The authority to issue copyrights stems from the same Clause in the Constitution that created the patent power. It provides:

“Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” Art. I, §8, cl. 8.

It is well settled that the Clause is “both a grant of power and a limitation” and that Congress “may not overreach the restraints imposed by the stated constitutional purpose.” *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1, 5–6 (1966). As we have made clear in the patent context, that purpose has two dimensions. Most obviously the grant of exclusive rights to their respective writings and discoveries is intended to encourage the creativity of “Authors and Inventors.” But the requirement that those exclusive grants be for “limited Times” serves the ultimate purpose of promoting the “Progress of Science and useful Arts” by guaranteeing that those innovations will enter the public domain as soon as the period of exclusivity expires:

“Once the patent issues, it is strictly construed, *United States v. Masonite Corp.*, 316 U. S. 265, 280 (1942), it cannot be used to secure any monopoly beyond that contained in the patent, *Morton Salt Co. v. G. S. Suppiger Co.*, 314 U. S. 488, 492 (1942), . . . and especially relevant here, when the patent expires the monopoly created by it expires, too, and the right to make the article—including the right to make it in precisely the shape it carried when patented—passes

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to the public. *Kellogg Co. v. National Biscuit Co.*, 305 U. S. 111, 120–122 (1938); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169, 185 (1896).” *Sears, Roebuck & Co.*, 376 U. S., at 230.

It is that ultimate purpose that explains why a patent may not issue unless it discloses the invention in such detail that one skilled in the art may copy it. See, e.g., *Grant v. Raymond*, 6 Pet. 218, 247 (1832) (Marshall, C. J.) (“The third section [of the 1793 Act] requires, as preliminary to a patent, a correct specification and description of the thing discovered. This is necessary in order to give the public, after the privilege shall expire, the advantage for which the privilege is allowed, and is the foundation of the power to issue the patent”). Complete disclosure as a precondition to the issuance of a patent is part of the *quid pro quo* that justifies the limited monopoly for the inventor as consideration for full and immediate access by the public when the limited time expires.²

Almost two centuries ago the Court plainly stated that public access to inventions at the earliest possible date was the essential purpose of the Clause:

“While one great object was, by holding out a reasonable reward to inventors, and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius; the main object was ‘to promote the progress of science and useful arts;’ and

²Attorney General Wirt made this precise point in his argument in *Gibbons v. Ogden*, 9 Wheat., at 175: “The limitation is not for the advantage of the inventor, but of society at large, which is to take the benefit of the invention after the period of limitation has expired. The patentee pays a duty on his patent, which is an effective source of revenue to the United States. It is virtually a contract between each patentee and the people of the United States, by which the time of exclusive and secure enjoyment is limited, and then the benefit of the discovery results to the public.”

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this could be done best, by giving the public at large a right to make, construct, use, and vend the thing invented, at as early a period as possible, having a due regard to the rights of the inventor. If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should for a long period of years retain the monopoly, and make, and sell his invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure; and then, and then only, when the danger of competition should force him to secure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any farther use than what should be derived under it during his fourteen years; it would materially retard the progress of science and the useful arts, and give a premium to those, who should be least prompt to communicate their discoveries.” *Pennock v. Dialogue*, 2 Pet. 1, 18 (1829).

Pennock held that an inventor could not extend the period of patent protection by postponing his application for the patent while exploiting the invention commercially. As we recently explained, “implicit in the Patent Clause itself” is the understanding “that free exploitation of ideas will be the rule, to which the protection of a federal patent is the exception. Moreover, the ultimate goal of the patent system is to bring new designs and technologies into the public domain through disclosure.” *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U. S. 141, 151 (1989).

The issuance of a patent is appropriately regarded as a *quid pro quo*—the grant of a limited right for the inventor’s disclosure and subsequent contribution to the public domain. See, e.g., *Pfaff v. Wells Electronics, Inc.*, 525 U. S. 55, 63 (1998) (“[T]he patent system represents a carefully crafted bargain that encourages both the creation and the

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public disclosure of new and useful advances in technology, in return for an exclusive monopoly for a limited period of time”). It would be manifestly unfair if, after issuing a patent, the Government as a representative of the public sought to modify the bargain by shortening the term of the patent in order to accelerate public access to the invention. The fairness considerations that underlie the constitutional protections against *ex post facto* laws and laws impairing the obligation of contracts would presumably disable Congress from making such a retroactive change in the public’s bargain with an inventor without providing compensation for the taking. Those same considerations should protect members of the public who make plans to exploit an invention as soon as it enters the public domain from a retroactive modification of the bargain that extends the term of the patent monopoly. As I discuss below, the few historical exceptions to this rule do not undermine the constitutional analysis. For quite plainly, the limitations “implicit in the Patent Clause itself,” 489 U. S., at 151, adequately explain why neither a State nor Congress may “extend the life of a patent beyond its expiration date,” *Sears, Roebuck & Co.*, 376 U. S., at 231.³

Neither the purpose of encouraging new inventions nor the overriding interest in advancing progress by adding

³The Court acknowledges that this proposition is “uncontroversial” today, see *ante*, at 11, n. 6, but overlooks the fact that it was highly controversial in the early 1800’s. See n. 11, *infra*. The Court assumes that the *Sears* holding rested entirely on the pre-emptive effect of congressional statutes even though the opinion itself, like the opinions in *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1 (1966), and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U. S. 141 (1989), also relied on the pre-emptive effect of the constitutional provision. That at least some of the Framers recognized that the Constitution itself imposed a limitation even before Congress acted is demonstrated by Madison’s letter, quoted in n. 6, *infra*.

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knowledge to the public domain is served by retroactively increasing the inventor's compensation for a completed invention and frustrating the legitimate expectations of members of the public who want to make use of it in a free market. Because those twin purposes provide the only avenue for congressional action under the Copyright/Patent Clause of the Constitution, any other action is manifestly unconstitutional.

II

We have recognized that these twin purposes of encouraging new works and adding to the public domain apply to copyrights as well as patents. Thus, with regard to copyrights on motion pictures, we have clearly identified the overriding interest in the "release to the public of the products of [the author's] creative genius." *United States v. Paramount Pictures, Inc.*, 334 U. S. 131, 158 (1948).⁴ And, as with patents, we have emphasized that the overriding purpose of providing a reward for authors' creative activity is to motivate that activity and "to allow the public access to the products of their genius after the limited period of exclusive control has expired." *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U. S. 417, 429 (1984). *Ex post facto* extensions of copyrights result in a gratuitous transfer of wealth from the public to authors, publishers, and their successors in interest. Such retroactive extensions do not even arguably serve either of the purposes of the Copyright/Patent Clause. The reasons

⁴"The copyright law, like the patent statutes, makes reward to the owner a secondary consideration. In *Fox Film Corp. v. Doyal*, 286 U. S. 123, 127, Chief Justice Hughes spoke as follows respecting the copyright monopoly granted by Congress, 'The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors.' It is said that reward to the author or artist serves to induce release to the public of the products of his creative genius." 334 U. S., at 158.

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why such extensions of the patent monopoly are unconstitutional apply to copyrights as well.

Respondent, however, advances four arguments in support of the constitutionality of such retroactive extensions: (1) the first Copyright Act enacted shortly after the Constitution was ratified applied to works that had already been produced; (2) later Congresses have repeatedly authorized extensions of copyrights and patents; (3) such extensions promote the useful arts by giving copyright holders an incentive to preserve and restore certain valuable motion pictures; and (4) as a matter of equity, whenever Congress provides a longer term as an incentive to the creation of new works by authors, it should provide an equivalent reward to the owners of all unexpired copyrights. None of these arguments is persuasive.

III

Congress first enacted legislation under the Copyright/Patent Clause in 1790 when it passed bills creating federal patent and copyright protection. Because the content of that first legislation, the debate that accompanied it, and the differences between the initial versions and the bills that ultimately passed provide strong evidence of early Congresses' understanding of the constitutional limits of the Copyright/Patent Clause, I examine both the initial copyright and patent statutes.

Congress first considered intellectual property statutes in its inaugural session in 1789. The bill debated, House Resolution 10—"a bill to promote the progress of science and useful arts, by securing to authors and inventors the exclusive right to their respective writings and discoveries," 3 Documentary History of the First Federal Congress of the United States of America, March 4, 1789–March 3, 1791, p. 94 (L. DePauw, C. Bickford, & L. Hauptman, eds.,

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1977)—provided both copyright and patent protection for similar terms.⁵ The first Congress did not pass H. R. 10, though a similar version was reintroduced in the second Congress in 1790. After minimal debate, however, the House of Representatives began consideration of two separate bills, one covering patents and the other copyrights. Because, as the majority recognizes, “congressional practice with respect to patents informs our inquiry,” *ante*, at 9, I consider the history of both patent and copyright legislation.

The Patent Act

What eventually became the Patent Act of 1790 had its genesis in House Resolution 41, introduced on February 16, 1790. That resolution differed from H. R. 10 in one important respect. Whereas H. R. 10 would have extended patent protection to only those inventions that were “not before known or used,” H. R. 41, by contrast, added the phrase “within the United States” to that limitation and expressly authorized patent protection for “any person, who shall after the passing of this act, first import into the United States . . . any . . . device . . . not before used or known in the said States.” 6 Documentary History, *supra*, at 1626–1632. This change would have authorized patents of importation, providing United States patent protection for inventions already in use elsewhere. This change, however, was short lived and was removed by a floor amendment on March 5, 1789. Walterscheid 125. Though exact records of the floor debate are lost, correspondence from House members indicate that doubts about the con-

⁵A copy of this bill specifically identified has not been found, though strong support exists for considering a bill from that session as H. R. 10. See E. Walterscheid, *To Promote the Progress of Useful Arts: American Patent Law and Administration, 1798–1836*, pp. 87–88 (1998) (hereinafter Walterscheid). This bill is reprinted in 4 Documentary History 513–519.

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stitutionality of such a provision led to its removal. Representative Thomas Fitzsimmons wrote to a leading industrialist that day stating that the section “allowing to Importers, was left out, the Constitutional power being Questionable.” *Id.*, at 126 (quoting Letter from Rep. Thomas Fitzsimmons to Tench Coxe (March 5, 1790)). James Madison himself recognized this constitutional limitation on patents of importation, flatly stating that the constitution “forbids patents for that purpose.” 13 Papers of James Madison 128 (C. Hobson & R. Rutland, eds. 1981) (reprinting letter to Tench Coxe (March, 28 1790)).⁶

The final version of the 1790 Patent Act, 1 Stat. 109, did not contain the geographic qualifier and thus did not provide for patents of importation. This statutory omission, coupled with the contemporaneous statements by legislators, provides strong evidence that Congress recognized significant limitations on their constitutional authority under the Copyright/Patent Clause to extend protection to a class of intellectual properties. 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. If early congressional practice does,

⁶“Your idea of appropriating a district of territory to the encouragement of imported inventions is new and worthy of consideration. I can not but apprehend however that the clause in the constitution which forbids patents for that purpose will lie equally in the way of your expedient. Congress seem to be tied down to the single mode of encouraging inventions by granting the exclusive benefit of them for a limited time, and therefore to have no more power to give a further encouragement out of a fund of land than a fund of money. This fetter on the National Legislature tho’ an unfortunate one, was a deliberate one. The Latitude of authority now wished for was strongly urged and expressly rejected.” Madison’s description of the Copyright/Patent Clause as a “fetter on the National Legislature” is fully consistent with this Court’s opinion in *Graham*.

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indeed, inform our analysis, as it should, then the majority's judicial excision of these constitutional limits cannot be correct.

The Copyright Act

Congress also passed the first Copyright Act, 1 Stat. 124, in 1790. At that time there were a number of maps, charts, and books that had already been printed, some of which were copyrighted under state laws and some of which were arguably entitled to perpetual protection under the common law. The federal statute applied to those works as well as to new works. In some cases the application of the new federal rule reduced the pre-existing protections, and in others it may have increased the protection.⁷ What is significant is that the statute provided a general rule creating new federal rights that supplanted the diverse state rights that previously existed. It did not extend or attach to any of those pre-existing state and common-law rights: "That congress, in passing the act of 1790, did not legislate in reference to existing rights, appears clear." *Wheaton v. Peters*, 8 Pet. 591, 661 (1834); see also *Fox Film Corp. v. Doyal*, 286 U. S. 123, 127 (1932) ("As this Court has repeatedly said, the Congress did not sanction an existing right but created a

⁷Importantly, even this first Act required a *quid pro quo* in order to receive federal copyright protection. In order to receive protection under the Act, the author was first required to register the work: "That no person shall be entitled to the benefit of this act, in cases where any map, chart, book or books, hath or have been already printed and published, unless he shall first deposit, and in all other cases, unless he shall before publication deposit a printed copy of the title of such map, chart, book or books, in the clerk's office of the district court where the author or proprietor shall reside." §3, 1 Stat. 124. This registration requirement in federal district court—a requirement obviously not required under the various state laws protecting written works—further illustrates that the 1790 Act created new rights, rather than extending existing rights.

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new one”). Congress set in place a federal structure governing certain types of intellectual property for the new Republic. That Congress exercised its unquestionable constitutional authority to *create* a new federal system securing rights for authors and inventors in 1790 does not provide support for the proposition that Congress can *extend pre-existing* federal protections retroactively.

Respondent places great weight on this first congressional action, arguing that it proves that “Congress thus unquestionably understood that it had authority to apply a new, more favorable copyright term to existing works.” Brief for Respondent 12–13. That understanding, however, is not relevant to the question presented by this case—whether “Congress has the power under the Copyright Clause to extend retroactively the term of existing copyrights?” Brief for Petitioners i.⁸ Precisely put, the question presented by this case does not even implicate the 1790 Act, for that Act created, rather than extended, copyright protection. That this law applied to works already in existence says nothing about the First Congress’ conception of their power to extend this newly created federal right.

⁸ Respondent’s reformulation of the questions presented by this case confuses this basic distinction. We granted certiorari to consider the question: “Did the D. C. Circuit err in holding that Congress has the power under the Copyright Clause to extend retroactively the term of existing copyrights?” Respondent’s reformulation of the first question presented—“Whether the 20-year extension of the terms of all unexpired copyrights . . . violates the Copyright Clause of the Constitution insofar as it applies to works in existence when it took effect”—significantly changes the substance of inquiry by changing the focus from the federal statute at issue to irrelevant common-law protections. Brief for Respondent I. Indeed, this reformulation violated this Court’s Rule 24(1)(a), which states that “the brief [on the merits] may not raise additional questions or change the substance of the questions already presented in” the petition for certiorari.

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Moreover, members of Congress in 1790 were well aware of the distinction between the creation of new copyright regimes and the extension of existing copyrights. The 1790 Act was patterned, in many ways, after the Statute of Anne enacted in England in 1710. 8 Ann., c. 19; see *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U. S. 643, 647–648 (1943). The English statute, in addition to providing authors with copyrights on new works for a term of 14 years renewable for another 14-year term, also replaced the booksellers’ claimed perpetual rights in existing works with a single 21-year term. In 1735, the booksellers proposed an amendment that would have extended the terms of existing copyrights until 1756, but the amendment was defeated. Opponents of the amendment had argued that if the bill were to pass, it would “in Effect be establishing a perpetual Monopoly . . . only to increase the private Gain of the Booksellers”⁹ The authors of the federal statute that used the Statute of Anne as a model were familiar with this history. Accordingly, this Court should be especially wary of relying on Congress’ creation of a new system to support the proposition that Congress unquestionably understood that it had constitutional authority to extend existing copyrights.

IV

Since the creation of federal patent and copyright protection in 1790, Congress has passed a variety of legislation, both providing specific relief for individual authors and inventors as well as changing the general statutes

⁹“A LETTER to a Member of Parliament concerning the Bill now depending . . . for making more effectual an Act in the 8th year of the Reign of Queen Anne, entituled, An Act for the Encouragement of Learning by . . . Vesting the Copies of Printed Books in the Authors or Purchasers.” Document reproduced in Goldsmiths’—Kress Library of Economic Literature, Segment 1: Printed Books Through 1800, Microfilm No. 7300 (reel 460).

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conferring patent and copyright privileges. Some of the changes did indeed, as the majority describes, extend existing protections retroactively. Other changes, however, did not do so. A more complete and comprehensive look at the history of congressional action under the Copyright/Patent Clause demonstrates that history, in this case, does not provide the “volume of logic,” *ante*, at 9, necessary to sustain the Sonny Bono Act’s constitutionality.

Congress, aside from changing the process of applying for a patent in the 1793 Patent Act, did not significantly alter the basic patent and copyright systems for the next 40 years. During this time, however, Congress did consider many private bills. Respondent seeks support from “Congress’s historical practice of using its Copyright and Patent Clause authority to extend the terms of individual patents and copyrights.” Brief for Respondent 13. Carefully read, however, these private bills do not support respondent’s historical gloss, but rather significantly undermine the historical claim.

The first example relied upon by respondent, the extension of Oliver Evans’ patent in 1808, ch. 8, 6 Stat. 70, demonstrates the pitfalls of relying on an incomplete historical analysis. Evans, an inventor who had developed several improvements in milling flour, received the third federal patent on January 7, 1791. See Federico, *Patent Trials of Oliver Evans*, 27 J. Pat. Off. Soc. 586, 590 (1945). Under the 14-year term provided by the 1790 Patent Act, this patent was to expire on January 7, 1805. Claiming that 14 years had not provided him a sufficient time to realize income from his invention and that the net profits were spent developing improvements on the steam engine, Evans first sought an extension of his patent in December 1804. *Id.*, at 598; 14 Annals of Congress 1002. Unsuccessful in 1804, he tried again in 1805, and yet again in 1806, to persuade Congress to pass his private bill. Undaunted,

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Evans tried one last time to revive his expired patent after receiving an adverse judgment in an infringement action. See *Evans v. Chambers*, 8 F. Cas. 837 (No. 4,555) (CC Pa. 1807). This time, his effort at private legislation was successful and Congress passed a bill extending his patent for 14 years. See An Act for the relief of Oliver Evans, 6 Stat. 70. This legislation, passed January 21, 1808, restored a patent monopoly for an invention that had been in the public domain for over four years. As such, this Act unquestionably exceeded Congress' authority under the Copyright/Patent Clause: "The Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose. . . . *Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available.*" *Graham*, 383 U. S., at 5–6 (emphasis added).

This extension of patent protection to an expired patent was not an isolated incident. Congress passed private bills either directly extending patents or allowing otherwise untimely applicants to apply for patent extensions for approximately 75 patents between 1790 and 1875. Of these 75 patents, at least 56 had already fallen into the public domain.¹⁰ The fact that this repeated practice was patently unconstitutional completely undermines the majority's reliance on this history as "significant." *Ante*, at 9.

¹⁰See, e.g., ch. 74, 6 Stat. 458 (patent had expired for three months); ch. 113, 6 Stat. 467 (patent had expired for over two years); ch. 213, 6 Stat. 589 (patent had expired for five months); ch. 158, 9 Stat. 734 (patent had expired for over two years); ch. 72, 14 Stat. 621 (patent had expired nearly four years); ch. 175, 15 Stat. 461 (patent had expired for over two years); ch. 15, 16 Stat. 613 (patent had expired for six years); ch. 317, 16 Stat. 659 (patent had expired for nearly four years); ch. 508, 17 Stat. 689 (patent had expired for over two years).

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Copyright legislation has a similar history. The federal Copyright Act was first amended in 1831. That amendment, like later amendments, not only authorized a longer term for new works, but also extended the terms of unexpired copyrights. Respondent argues that that historical practice effectively establishes the constitutionality of retroactive extensions of unexpired copyrights. Of course, the practice buttresses the presumption of validity that attaches to every Act of Congress. But, as our decision in *INS v. Chadha*, 462 U. S. 919 (1983), demonstrates, the fact that Congress has repeatedly acted on a mistaken interpretation of the Constitution does not qualify our duty to invalidate an unconstitutional practice when it is finally challenged in an appropriate case. As Justice White pointed out in his dissent in *Chadha*, that case sounded the “death knell for nearly 200 other statutory provisions” in which Congress had exercised a “legislative veto.” *Id.*, at 967. Regardless of the effect of unconstitutional enactments of Congress, the scope of “the constitutional power of Congress . . . is ultimately a judicial rather than a legislative question, and can be settled finally only by this Court.” *United States v. Morrison*, 529 U. S. 598, 614 (2000) (quoting *Heart of Atlanta Motel, Inc. v. United States*, 379 U. S. 241, 273 (1964) (Black, J., concurring)). For, as this Court has long recognized, “[i]t is obviously correct that no one acquires a vested or protected right in violation of the Constitution by long use, even when that span of time covers our entire national existence.” *Walz v. Tax Comm’n of City of New York*, 397 U. S. 664, 678 (1970).

It would be particularly unwise to attach constitutional significance to the 1831 amendment because of the very different legal landscape against which it was enacted. Congress based its authority to pass the amendment on grounds shortly thereafter declared improper by the Court. The Judiciary Committee Report prepared for the House of Representatives asserted that “an author has an

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exclusive and perpetual right, in preference to any other, to the fruits of his labor.” 7 Gales & Seaton, Register of Debates in Congress cxx (1831). The floor debate echoed this same sentiment. See, *e.g.*, *id.*, at 423 (statement of Mr. Verplanck (rejecting the idea that copyright involved “an implied contract existing between an author and the public” for “[t]here was no contract; the work of an author was the result of his own labor” and copyright was “merely a legal provision for the protection of a natural right”)). This sweat-of-the-brow view of copyright, however, was emphatically rejected by this Court in 1834 in *Wheaton v. Peters*, 8 Pet., at 661 (“Congress, then, by this act, instead of sanctioning an existing right, as contended for, created it”). No presumption of validity should attach to a statutory enactment that relied on a shortly thereafter discredited interpretation of the basis for congressional power.¹¹

In 1861, Congress amended the term of patents, from a 14-year term plus opportunity for 7-year extension to a flat 17 years with no extension permitted. Act of Mar. 2, 1861, ch. 88, §16, 12 Stat. 249. This change was not retroactive, but rather only applied to “all patents hereafter granted.” *Ibid.* To be sure, Congress, at many times in its history, has retroactively extended the terms of existing

¹¹In the period before our decision in *Wheaton*, the pre-emptive effect of the Patent/Copyright Clause was also a matter of serious debate within the legal profession. Indeed, in their argument in this Court in *Gibbons v. Ogden*, 9 Wheat., at 44–61, 141–157, the defenders of New York’s grant of a 30-year monopoly on the passenger trade between New Jersey and Manhattan argued that the Clause actually should be interpreted as confirming the State’s authority to grant monopoly privileges that supplemented any federal grant. That argument is, of course, flatly inconsistent with our recent unanimous decision in *Bonito Boats v. Thundercraft Boats, Inc.*, 489 U. S. 141 (1989). Although Attorney General Wirt had urged the Court to endorse our present interpretation of the Clause, its implicit limitations were unsettled when the 1831 Copyright Act was passed.

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copyrights and patents. This history, however, reveals a much more heterogeneous practice than respondent contends. It is replete with actions that were unquestionably unconstitutional. Though relevant, the history is not dispositive of the constitutionality of Sonny Bono Act.

The general presumption that historic practice illuminates the constitutionality of congressional action is not controlling in this case. That presumption is strongest when the earliest acts of Congress are considered, for the overlap of identity between those who created the Constitution and those who first constituted Congress provides “contemporaneous and weighty evidence” of the Constitution’s “true meaning.” *Wisconsin v. Pelican Ins. Co.*, 127 U. S. 265, 297 (1888). But that strong presumption does not attach to congressional action in 1831, because no member of the 1831 Congress had been a delegate to the framing convention 44 years earlier.

Moreover, judicial opinions relied upon by the majority interpreting early legislative enactments have either been implicitly overruled or do not support the proposition claimed. *Graham* flatly contradicts the cases relied on by the majority and respondent for support that “renewed or extended terms were upheld in the early days.” *Ante*, at 10.¹² *Evans v. Jordan*, 8 F. Cas. 872, 874 (No. 4,564) (CC

¹² It is true, as the majority points out, *ante* at 11, n. 5, that *Graham* did not expressly overrule those earlier cases because *Graham* did not address the issue whether Congress could revive expired patents. That observation does not even arguably justify reliance on a set of old circuit court cases to support a proposition that is inconsistent with our present understanding of the limits imposed by the Copyright/Patent Clause. After all, a unanimous Court recently endorsed the precise analysis that the majority now seeks to characterize as “wishful thinking.” *Ante*, at 11, n. 5. See *Bonito Boats*, 489 U. S., at 146 (“Congress may not create patent monopolies of unlimited duration, nor may it authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials

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Va. 1813) (Marshall, J.); *Evans v. Robinson*, 8 F. Cas. 886, 888 (No. 4,571) (CC Md. 1813); and *Blanchard v. Sprague*, 3 F. Cas. 648, 650 (No. 1,518) (CC Mass. 1839) (Story, J.) all held that private bills passed by Congress extending previously expired patents rights were valid. *Evans v. Jordan* and *Evans v. Robinson* both considered Oliver Evans' private bill discussed above while *Blanchard* involved ch. 213, 6 Stat. 589, which extended Thomas Blanchard's patent after it had been in the public domain for five months. Irrespective of what circuit courts held "in the early days," *ante*, at 10, such holdings have been implicitly overruled by *Graham* and, therefore, provide no support for respondent in the present constitutional inquiry.

The majority's reliance on the other patent case it cites is similarly misplaced. Contrary to the suggestion in the Court's opinion, *McClurg v. Kingsland*, 1 How. 202 (1843), did not involve the "legislative expansion" of an existing patent. *Ante*, at 10–11. The question in that case was whether the former employer of the inventor, one James Harley, could be held liable as an infringer for continuing to use the process that Harley had invented in 1834 when he was in its employ. The Court first held that the employer's use of the process before the patent issued was not a public use that would invalidate the patent, even if it might have had that effect prior to the amendment of the patent statute in 1836. 1 How., at 206–208. The Court then disposed of the case on the ground that a statute enacted in 1839 protected the alleged infringer's right to continue to use the process after the patent issued. *Id.*, at 209–211. Our opinion said nothing about the power of Congress to extend the life of an issued patent. It did note that Congress has plenary power to legislate on the subject of patents provided

already available'" (quoting *Graham*, 383 U. S., at 6)).

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“that they do not take away the rights of property in existing patents.” *Id.*, at 206. The fact that Congress cannot change the bargain between the public and the patentee in a way that disadvantages the patentee is, of course, fully consistent with the view that it cannot enlarge the patent monopoly to the detriment of the public after a patent has issued.

The history of retroactive extensions of existing and expired copyrights and patents, though relevant, is not conclusive of the constitutionality of the Sonny Bono Act. The fact that the Court has not previously passed upon the constitutionality of retroactive copyright extensions does not insulate the present extension from constitutional challenge.

V

Respondent also argues that the Act promotes the useful arts by providing incentives to restore old movies. For at least three reasons, the interest in preserving perishable copies of old copyrighted films does not justify a wholesale extension of existing copyrights. First, such restoration and preservation will not even arguably promote any new works by authors or inventors. And, of course, any original expression in the restoration and preservation of movies will receive new copyright protection.¹³ Second,

¹³Indeed, the Lodging of the Motion Picture Association of America, Inc., as *Amicus Curiae* illustrates the significant creative work involved in releasing these classics. The Casablanca Digital Video Disc (DVD) contains a “documentary *You Must Remember This*, hosted by Lauren Bacall and featuring recently unearthed outtakes” and an “[a]ll-new introduction by Lauren Bacall.” Disc cover text. Similarly, the Citizen Kane DVD includes “[t]wo feature-length audio commentaries: one by film critic Roger Ebert and the other by director/Welles biographer Peter Bogdanovich” and a “gallery of storyboards, rare photos, alternate ad campaigns, studio correspondence, call sheets and other memorabilia” in addition to a 2-hour documentary. Disc cover text.

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however strong the justification for preserving such works may be, that justification applies equally to works whose copyrights have already expired. Yet no one seriously contends that the Copyright/Patent Clause would authorize the grant of monopoly privileges for works already in the public domain solely to encourage their restoration. Finally, even if this concern with aging movies would permit congressional protection, the remedy offered—a blanket extension of all copyrights—simply bears no relationship to the alleged harm.

VI

Finally, respondent relies on concerns of equity to justify the retroactive extension. If Congress concludes that a longer period of exclusivity is necessary in order to provide an adequate incentive to authors to produce new works, respondent seems to believe that simple fairness requires that the same lengthened period be provided to authors whose works have already been completed and copyrighted. This is a classic *non sequitur*. The reason for increasing the inducement to create something new simply does not apply to an already-created work. To the contrary, the equity argument actually provides strong support for petitioners. Members of the public were entitled to rely on a promised access to copyrighted or patented works at the expiration of the terms specified when the exclusive privileges were granted. On the other hand, authors will receive the full benefit of the exclusive terms that were promised as an inducement to their creativity, and have no equitable claim to increased compensation for doing nothing more.

One must indulge in two untenable assumptions to find support in the equitable argument offered by respondent—that the public interest in free access to copyrighted works is entirely worthless and that authors, as a class, should receive a windfall solely based on completed creative

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activity. Indeed, Congress has apparently indulged in those assumptions for under the series of extensions to copyrights, only one year's worth of creative work—that copyrighted in 1923—has fallen into the public domain during the last 80 years. But as our cases repeatedly and consistently emphasize, ultimate public access is the overriding purpose of the constitutional provision. See, e.g., *Sony Corp.*, 464 U. S., at 429. *Ex post facto* extensions of existing copyrights, unsupported by any consideration of the public interest, frustrate the central purpose of the Clause.

VII

The express grant of a perpetual copyright would unquestionably violate the textual requirement that the authors' exclusive rights be only "for limited Times." Whether the extraordinary length of the grants authorized by the 1998 Act are invalid because they are the functional equivalent of perpetual copyrights is a question that need not be answered in this case because the question presented by the certiorari petition merely challenges Congress' power to extend retroactively the terms of existing copyrights. Accordingly, there is no need to determine whether the deference that is normally given to congressional policy judgments may save from judicial review its decision respecting the appropriate length of the term.¹⁴ It

¹⁴Similarly, the validity of earlier retroactive extensions of copyright protection is not at issue in this case. To decide the question now presented, we need not consider whether the reliance and expectation interests that have been established by prior extensions passed years ago would alter the result. Cf. *Heckler v. Mathews*, 465 U. S. 728, 746 (1984) ("We have recognized, in a number of contexts, the legitimacy of protecting reasonable reliance on prior law even when that requires allowing an unconstitutional statute to remain in effect for a limited period of time"). Those interests are not at issue now, because the act under review in this case was passed only four years ago and has been

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is important to note, however, that a categorical rule prohibiting retroactive extensions would effectively preclude perpetual copyrights. More importantly, as the House of Lords recognized when it refused to amend the Statute of Anne in 1735, unless the Clause is construed to embody such a categorical rule, Congress may extend existing monopoly privileges *ad infinitum* under the majority's analysis.

By failing to protect the public interest in free access to the products of inventive and artistic genius—indeed, by virtually ignoring the central purpose of the Copyright/Patent Clause—the Court has quitclaimed to Congress its principal responsibility in this area of the law. Fairly read, the Court has stated that Congress' actions under the Copyright/Patent Clause are, for all intents and purposes, judicially unreviewable. That result cannot be squared with the basic tenets of our constitutional structure. It is not hyperbole to recall the trenchant words of Chief Justice John Marshall: “It is emphatically the province and duty of the judicial department to say what the law is.” *Marbury v. Madison*, 1 Cranch 137, 177 (1803). We should discharge that responsibility as we did in *Chadha*.

I respectfully dissent.

under challenge in court since shortly after its enactment.