

Golan and *Prometheus* as Misfit First Amendment Cases?

*Elizabeth Townsend Gard**

I. Introduction

For the past several years, a good deal of my research has focused on *Golan v. Holder* and the statute at issue in that case, Section 104A of the 1976 Copyright Act.¹ Passed under the fast-track provision for implementing legislation for the United States' joining the World Trade Organization, the Uruguay Round Agreements Act (which included an agreement on trade-related intellectual property, or TRIPs), Section 104A restored foreign copyrighted works that had come into the public domain in the United States but were still under copyright in their country of origin. Some believed that this legislation violated the traditional conception of copyright protection by removing from the public domain works that had already moved into it.² But the Supreme Court thought otherwise, and in January

* Associate Professor of Law, and Co-Director and Founder, Tulane Center for IP, Media and Culture, Tulane University Law School.

¹ *Golan v. Holder*, 132 S. Ct. 873 (2012). My previous work on this topic includes the following three articles: *Eldred v. Ashcroft* (2003) and *Golan v. Holder* (2012), *DePaul L. Rev.* (forthcoming); *In the Trenches with Section 104A: An Evaluation of the Parties' Arguments in Golan v. Holder as It Heads to the U.S. Supreme Court*, 64 *Vand. L. Rev.* 199 (2011) (cited twice by the Breyer dissent in *Golan*); and *Copyright Law v. Trade Policy: Understanding the Golan Battle within the Tenth Circuit*, 34 *Colum. J.L. & Arts* 131 (2011). I have also co-authored two pieces that further tease out the Tenth Circuit's decision in *Golan* with W. Ron Gard, *Marked by Modernism: Reconfiguring the "Traditional Contours of Copyright Law" for the Twenty-First Century*, in *Modernism and Copyright 155–72* (Paul Saint-Amour ed., Oxford University Press 2010); and *The Present (User-Generated Crisis) is the Past (1909 Copyright Act): An Essay Theorizing the "Traditional Contours of Copyright" Language*, 28 *Cardozo Arts and Ent. L.J.* 455–99 (2011).

² This was Judge Robert H. Henry's view in the first Tenth Circuit decision. See *Golan v. Gonzales*, 501 F. 3d 1179 (10th Cir. 2007).

2012 declared that Section 104A was both within Congress's legislative powers and the removal of works from the public domain did not violate the First Amendment.³

My work has always focused on the technical aspects of the statute: how does one actually determine which works were restored? I have argued previously that (1) Congress actually did not fulfill our treaty obligations with the enactment of Section 104A (that it actually got the math wrong) and that (2) restoring works from the public domain creates a physics problem in understanding the expectations of the copyright system. I also have argued elsewhere that Justice Ruth Bader Ginsburg didn't have to go as far as she did in her majority opinion in *Golan*—that she could have narrowly tailored her decision to meeting treaty obligations. That is, she put the entire copyright system in jeopardy by declaring that all rules and expectations are off: Congress can do as it sees fit.⁴ The Tenth Circuit had also found that Congress had the right to do as it saw fit, but found that the First Amendment acted as a boundary to test when that power had gone too far. Ginsburg, as will be discussed more below, dismantles that safeguard almost entirely.

As I was researching an invited paper on *Golan*, I read all of the Supreme Court *amicus curiae* briefs filed in the case.⁵ I was struck by the Cato Institute's brief.⁶ Cato, more than anyone else, framed the question not as a First Amendment issue but as a trade and policy question. Indeed, Justice Ginsburg would also frame her opinion in such a manner, but she never directly addressed the trade policy or treaty clause issue at all. Yet as we will soon see, she begins her opinion discussing our obligations under the Berne Convention, an international copyright agreement. For the moment, I put the Cato brief aside and continued my work. I finished the paper, which was published in the *Vanderbilt Law Review* just before oral arguments in *Golan*. It would be this piece that Justice Breyer would cite, as well as, to my joy, the work on sorting through Section 104A that we've been doing at Tulane University Law School. (We've created

³ *Golan*, 132 S. Ct. 873.

⁴ See *Is There a Traditional Contours of IP Protection?*, *supra* note 1.

⁵ See *In the Trenches with Section 104A*, *supra* note 1, at 199.

⁶ Brief of Cato Institute as Amicus Curiae Supporting Petitioner, *Golan v. Holder*, 132 S. Ct. 873 (2012) (No. 10-545).

a software program to determine the copyright status of works and, as part of this project, we mapped and coded Section 104A, which took thousands of my own and student research hours because of some of the complications involved.)

After I finished that paper, I turned my focus to patent law—the new America Invents Act and *Mayo v. Prometheus*, which would be heard by the Supreme Court in December 2011.⁷ As part of preparation for my intellectual property (IP) law survey course, I assigned the students the briefs for *Mayo*, a patentable subject matter case, including the *amicus* briefs. The petitioners in this patent case included an explicit First Amendment argument. Two IP cases in the same term contained a First Amendment argument? This was unheard of. Only one previous such case had directly addressed First Amendment issues: *Eldred v. Ashcroft*.⁸ Now, *Golan* was being heard, which made sense because it was the follow-up case by the same underlying group that had pursued *Eldred*. But *Prometheus*? This was amazing.

Mayo v. Prometheus concerns how far patent law can go—what counts as patent-eligible subject matter. The Court the previous year had decided *Bilski v. Kappos*, which informed the U.S. Court of Appeals for the Federal Circuit that it could not merely rely on a “machine or transformation” test, but that it had to think more broadly.⁹ The court could use that test, but it was not the only test that they should rely upon.¹⁰ Patentable subject matter had been the site of much confusion and chaos, particularly in the Federal Circuit. Did *State Street’s* “tangible, concrete, and useful result” still stand? Were business methods, DNA, medical diagnostics, and software patentable?¹¹ How far was too far? Not since *Diamond v. Chakrabarty* in 1980 had the Court commented on patentable subject matter “anything under the sun made by man,” including non-naturally

⁷ *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012).

⁸ 537 U.S. 186 (2003).

⁹ *Bilski v. Kappos*, 130 S. Ct. 3218 (2010).

¹⁰ See generally Michael Risch, Forward to the Past, 2009–2010 Cato Sup. Ct. Rev. 333 (2010) (analyzing *Bilski v. Kappos* and its consequences).

¹¹ *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998).

occurring microorganisms.¹² Now, in the space of a year the Court had accepted *two* patentable subject matter cases. And to top it off, the petitioners were arguing a First Amendment “right to read” as a reason for invalidating Prometheus’s patent. A patent case with a First Amendment argument? As Vizzini in *The Princess Bride* often says, “Inconceivable!”¹³

But the tale does not end there. With *Prometheus*, I once again read all of the *amicus* briefs to prepare for my IP survey course. If I was going to make my students read all of the *Golan* materials collectively as a class, surely I should do the same for the patent case that was also now at the Court. To my utter amazement, only the Cato brief made the same connection I did. If the petitioners were to make a First Amendment argument, surely they should see how *Eldred v. Ashcroft* and the “traditional contours” language applied to the sister area of patents. After all, if “traditional contours” existed for copyright, they also must exist in patent law, as they share the same constitutional clause for their justification—Article I, Section 8, Clause 8. And if they both shared “traditional contours,” Ginsburg’s analysis in *Eldred* suggested that a First Amendment analysis was the necessary next step after finding a violation of those contours. Cato’s brief showed that analysis. Both cases were handed down in winter 2012. Justice Ginsburg upheld Section 104A and Justice Breyer (this time for a unanimous Court) struck down Prometheus’s patent.

This essay unpacks both of these decisions from a limited view, analyzing the First Amendment issue in each, or rather discusses how each case directly sidesteps or completely ignores the First Amendment argument. The essay also reads the Cato briefs in the context of these decisions and provides insight into why the Court might have decided each as it did, in relation to the First Amendment. In many ways, the two decisions demonstrate the Court’s uneasiness with intellectual property’s commingling with the First Amendment.

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. While they seem different, both cases struggle with how far IP protection can extend, with

¹² *Diamond v. Chakrabarty*, 447 U.S. 303 (1980).

¹³ *The Princess Bride* (Act III Communications 1987).

both petitioners arguing that the law had crossed over into unnatural territory, violating basic principles of intellectual property. Both cases see the system as jeopardized if the law were allowed to stand, either as a statutory amendment in the case of *Golan*, or as a judgment regarding preemption or nonpatentability, as seen in *Prometheus*. Both show the struggles of a system to define boundaries and stay true to the underlying functions that drive protection. Both cases challenged the Court to better define the public domain.¹⁴

II. *Golan*

A. *Golan's* First Amendment Argument

Golan v. Holder concerns the question of whether Congress can re-attach copyrights to works already in the public domain. The petitioning group of musicians and other users of artistic works sought to have an amendment to the Copyright Act found unconstitutional because it took foreign works that had been in the public domain and re-copyrighted them. This was something that had never been done before, at least not on the mass scale envisioned by the new legislation. The petitioners argued that removing these works from the public domain violated the First Amendment. The Tenth Circuit agreed. Six justices would not.

The idea that the First Amendment could apply to the situation created by Section 104A originated in a Supreme Court case from nearly 10 years earlier, *Eldred v. Ashcroft*. In that case, Justice Ginsburg found that extending the term of copyright by an additional 20 years created no need for First Amendment analysis because copyright had built-in First Amendment safeguards, including fair use and idea/expression dichotomy, both of which allow use of a copyrighted work during its term. Justice Ginsburg ended her analysis, with her now famous phrase, “[W]hen, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.”¹⁵ The petitioners, whose case had begun before the decision in *Eldred*, added to their

¹⁴ For the importance of preserving the public domain, see Tyler T. Ochoa, *Is the Copyright Public Domain Irrevocable? An Introduction to Golan v. Holder*, 64 Vand. L. Rev. 123 (2011); Diane Leenheer Zimmerman, *Is There a Right to Have Something to Say? One View of the Public Domain*, 73 Fordham L. Rev. 297 (2004).

¹⁵ *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003).

case that restoring foreign works violated the traditional contours of copyright protection. The Tenth Circuit agreed and remanded the decision to the district court for further analysis of what level of scrutiny should be applied. The district court also found a First Amendment violation, and then the court of appeals found that the government had a legitimate governmental interest, and therefore, reversed the district court's finding that the government had not had a legitimate interest. The Supreme Court affirmed that decision, but that end-result is a bit misleading. Actually, Justice Ginsburg found no First Amendment analysis necessary rather than determining that the government had a legitimate interest in restoring foreign works. And so ended the long journey of the *Golan* case.

B. The Cato Institute's Amicus Brief

The present case centrally concerns Cato because it represents an opportunity to clarify the limits that the Constitution places on federal power.

—Interest of *Amicus Curiae*, Cato Institute brief in *Golan*

From the beginning of its brief, Cato framed the question in *Golan* not as one regarding the First Amendment or even the Copyright Clause but as involving a larger constitutional powers issue relating to the treaty power—focusing its analysis on *Missouri v. Holland*.¹⁶ The brief begins with the premise that one need not turn to the question of the First Amendment but can resolve the case based on the legislation that implemented the relevant treaty, the Uruguay Round Agreements Act.

The URAA, enacted on December 8, 1994, was the implementing legislation that allowed the United States to join the WTO, including necessary changes to U.S. law in many areas: anti-dumping and countervailing duty provisions, textiles, agriculture, the tax code, and intellectual property. Title V included four copyright provisions: Section 511, rental rights in computer programs; Sections 512 and 513, criminal and civil penalties for unauthorized fixation of live

¹⁶ 252 U.S. 416 (1920).

musical performances; and Section 514, restored foreign works, the subject of *Golan*.¹⁷

Throughout the *Golan* cases, the federal government had “expressly argued that, regardless of the scope of Congress’s ordinary powers, Congress can automatically implement treaties. It argued, in other words, that treaties can, and did, increase congressional power.”¹⁸ The Tenth Circuit seemed to agree, writing that “Congress’s treaty . . . power may provide Congress with the authority to enact § 514.”¹⁹ Cato made the important connection: “The point is not just that the treaty power might be an additional power on which the government could—and did—rely. It is that the scope of the treaty-implementation power cannot be disaggregated from the Copyright Clause or First Amendment issues.”²⁰ Cato’s brief explained the connection: “The government argues that the URAA was a rational exercise of the copyright power *precisely because it implements the Berne Convention*, and it insists that the Act should survive First Amendment scrutiny *precisely because it is required by treaty*.”²¹

How, then, is one to determine whether Congress exceeded its treaty-implementing powers? One must turn to *Missouri v. Holland*, a 1920 Supreme Court decision by Justice Oliver Wendell Holmes Jr., and the question, now in the 21st century, can a treaty increase Congress’s power?

Missouri v. Holland concerned a 1916 U.S. treaty with Great Britain that protected certain migratory birds as they made their way between the United States and Canada. Congress passed implementing legislation in 1918; when the federal game warden, Ray P. Holland, threatened to arrest Missouri citizens for violating that law,

¹⁷ Title V of the URAA also included for trademarks, Section 521, a definition of “abandoned”; Section 522, nonregistrability of misleading geographic indications for wines and spirits; and Section 525, the effective date. For patents, the URAA included Section 531, treatment of inventive activity; Section 532, patent term and internal priority; Section 533, patent rights; and Section 534, effective dates. The URAA changed the patent term from 17 years from issuance to 20 years from filing date. See Uruguay Round Agreements Act, Pub. L. 103-465, § 108 Stat. 4809 (1994).

¹⁸ Cato Institute *Golan* brief, *supra* note 6, at 4.

¹⁹ *Id.* at 4 (citing *Golan v. Gonzales*, 501 F.3d 1179, 1196 n.5 (10th Cir. 2007)).

²⁰ *Id.* at 5.

²¹ *Id.* (emphasis in the original).

the State of Missouri stepped in to legally challenge the treaty. The question centered on whether the treaty infringed on state powers under our federal system. Justice Holmes found that it did not because the treaty concerned national interest of protecting migratory wild life across state lines.²²

As the Cato brief points out, the key holding here was that “[if] the treaty is valid, there can be no dispute about the validity of the [implementing] statute under Article I, § 8 as a necessary and proper means to execute the powers of government.”²³ Cato interpreted this language to give unfixed and limitless power to Congress with regard to treaty implementation.²⁴ The brief continues:

Justice Holmes provided neither reasoning nor citation for that proposition. Indeed, the entire opinion takes up all of five pages in the United States Reports. Yet that one conclusory sentence has the radical implication that Congress’s legislative power can be increased, not only by constitutional amendment, but also by treaty. That idea is in deep tension with constitutional text, history, and structure, and with the fundamental principle of limited and enumerated legislative powers. The Court should clarify that this sentence cannot mean what it seems to say.²⁵

Cato then looks at the relationship between the treaty power given to the president and the Necessary and Proper Clause given to Congress. Its brief suggests that Holmes misconstrued the grammatical interplay between the two clauses, unduly enlarging the scope of Congress’s power. The brief suggests that reading the two clauses together shows a difference between *making* a treaty and giving it domestic legal effect: “The URAA may or may not have been necessary to *implement* the Berne Convention, but it was certainly neither necessary nor proper to *make* the Berne Convention. And so the Berne Convention did not, and could not, confer power on Congress to enact the URAA.”²⁶

²² *Missouri v. Holland*, 252 U.S. at 435.

²³ See Cato Institute Golan brief, *supra* note 6, at 6 (citing *Missouri v. Holland*, 252 U.S. at 432).

²⁴ *Id.* at 6–7.

²⁵ *Id.*

²⁶ *Id.* at 11.

The United States signed the Berne Convention for the Protection of Literary and Artistic Works (via the URAA) more than 100 years after its original signing. Cato's brief suggests that this fact creates a different situation from *Missouri v. Holland*, that in that case Congress enacted legislation to "make" the new treaty, whereas the Berne Convention existed independent and irrespective of any U.S. legislation. The problem, of course, is that what's really at stake in the URAA is that the United States joined the WTO, which included TRIPs (the trade-related IP agreement), which incorporated the Berne Convention. One could argue, then, that the URAA does help *make* the treaty because the treaty at issue is related to the WTO rather than Berne itself. But Cato's brief does not stop there.

The brief then turns to the three branches of government and how the vesting clauses interact, from Chief Justice John Marshall's 1803 opinion in *Marbury v. Madison* to his 1824 opinion in *Gibbons v. Ogden*. "The powers of the legislature are *defined, and limited*; and that those limits may not be mistaken, or forgotten, the constitution is written."²⁷ Congress *makes* laws, the executive enforces laws, and the judiciary interprets them. Congress only can enact legislation pursuant to constitutionally granted powers: "In other words, the subject-matter jurisdiction of the executive power can be expanded by acts of Congress; it is not fixed by the Constitution. By contrast, the scope of the legislative power is not contingent on the acts of the other branches. It is fixed and defined by the Constitution."²⁸ Congress's power cannot therefore be expanded by treaty, due to the phrase "herein granted" in Article I, Section 1. This is in contrast to the judicial and executive branches, which do not have such restrictions.²⁹

The Cato brief urged the Court to review *Missouri* and, in the light of the proliferation of treaties at the end of the 20th century,

²⁷ *Id.* at 14 (citing *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 176 (1803)) (emphasis added).

²⁸ *Id.* at 16.

²⁹ "The Court realized this long before *Missouri v. Holland*, in a case that Justice Holmes failed to cite. As the Court explained in 1836: 'The government of the United States . . . is one of limited powers. It can exercise authority over no subjects, except those which have been delegated to it. Congress cannot, by legislation, enlarge the federal jurisdiction, nor can it be enlarged under the treaty-making power.'" *Id.* at 20 (citing *Mayor of New Orleans v. United States*, 35 U.S. (10 Pet.) 662, 736 (1836) (emphasis added)).

suggested that “this Court should hold that treaties cannot vest Congress with new legislative power.”³⁰ It found that the basis for the continued reliance on *Missouri* came from one treatise by Professor Louis Henkin that interpreted the omission of the “to enforce treaties” from the Constitution as superfluous.³¹ But Professor Henkin was mistaken, according to Cato. As recent scholarship has demonstrated, “he simply misread constitutional history”³² because “the words ‘to enforce treaties’ never appeared in any draft of the Necessary and Proper Clause.”³³ Cato thus asked the Court to revisit the case: “the President may make political promises by treaty that Congress lacks the legal power to keep.”³⁴

The Cato brief warns of the danger of allowing *Missouri* to continue to be good law: “[T]his prospect will constitute a powerfully perverse incentive to enter into treaties that go beyond enumerated powers. This is just the sort of self-aggrandizing ‘flexibility’ that the Constitution was designed to prohibit.”³⁵

The strange part of the *amicus* brief—and for me the disappointing part—is that Cato’s view of the treaty power does not actually apply it to Section 104A. How would overturning *Missouri* impact the URAA? Would it limit what Congress could have enacted? Would the Court look to whether Section 104A went beyond Congress’s legislative powers? We are left wondering.

But the brief is important nonetheless because Cato engaged in the underlying debate: What happens when a treaty goes beyond the traditional expectations of a particular area of law? Are there limits to implementing legislation? Does anything go as long as it connects to a treaty? In some ways, Justice Ginsburg indirectly addresses and reaffirms *Missouri*.

C. Ginsburg’s Decision for the Court Majority

Justice Ginsburg begins her opinion by describing the United States’ joining of the Berne Convention and the necessity of enacting

³⁰ *Id.* at 5.

³¹ *Id.* at 27 (citing 2 M. Farrand, *The Records of the Convention of 1787*, at 382 (rev. ed. 1966)).

³² *Id.* at 28.

³³ *Id.*

³⁴ *Id.* at 29 (citing *Reid v. Covert*, 354 U.S. 1 (1957)).

³⁵ *Id.* at 30.

the URAA. She describes Section 104A and the need to restore foreign works that had not entered the public domain in their country of origin.

Justice Ginsburg then starts her analysis, “In accord with the judgment of the Tenth Circuit, we conclude that § 514 does not transgress constitutional limitations on Congress’s authority.”³⁶ To reach that conclusion, she lists the government’s obligations under Berne: national treatment and minimum terms (generally life of the author plus 50 years). When a new country joins the convention, it must provide protection for works still under copyright in the other member countries. Justice Ginsburg focuses on the history of foreign copyrights in the United States (one paragraph) and then on our relationship with the Berne Convention itself (a longer paragraph). When first joining Berne, the United States took a minimalist approach to the changes needed to the Copyright Act in order to be in compliance—which, according to Ginsburg, a number of countries found lacking. (She uses statements from the Office of the U.S. Trade Representative and the Recording Industry Association of America as evidence, and that Turkey, Egypt, and Austria thought we hadn’t gone far enough.) Where before the Berne Convention had no enforcement mechanism, now, with the WTO and its dispute settlement mechanism, we could no longer be out of compliance.

I have written extensively about the flaws and strangeness of the above argument.³⁷ First, Section 104A did not measure the term of restored works required by Berne terms: Restored works are not given the minimum term of life of the author plus 50 years as required by Berne. Instead, they are measured under the old pre-Berne system of 95 years from publication. This means that some works, such as some of Matisse’s art, should have been restored, but, because of improper measuring, remain in the public domain. Moreover, Ginsburg’s concern about avoiding international disputes remains: Section 104A violates Article 18 of the Berne Convention because (1) we have not complied with the minimum terms of Berne for restored works, and (2) some works that were supposed to be restored were not because of mismeasurement of the term.

³⁶ Golan, 132 S. Ct. at 878.

³⁷ See, e.g., the articles cited *supra* note 1.

The battle in the case was defining whether works could be removed from the public domain, and to this Justice Ginsburg now turns. She uses *Eldred* to affirm that nothing in the Copyright Clause keeps the public domain from not being re-copyrighted. “Limited Times” does not limit how a work can be limited, merely that the term must not be perpetual. She also asserts that applying the same term to foreign works of the same published year seems fair rather than getting a “zero” copyright term and going into the public domain.³⁸ What is problematic about her argument is that there are important distinctions between *Eldred* (extending existing copyrights) and *Golan* (putting new copyrights on existing public domain materials). This distinction, however, is not addressed. She concludes, “In aligning the United States with other nations bound by the Berne Convention, and thereby according equitable treatment to once disfavored foreign authors, Congress can hardly be charged with a design to move stealthily toward a regime of perpetual copyrights.”³⁹

Of course, Section 104A did not actually align the United States with other nations of the Berne Convention *at all*. Foreign authors still have not been made whole. Moreover, in some cases, foreign authors are now treated much better than Americans who made the same formal mistakes. The question, of course, is when legislation will be introduced to restore American works that had suffered the same “zero” copyright fate as their foreign counterparts.

Justice Ginsburg’s opinion falls short in three basic respects. First, I would have much preferred her to analyze the public domain question from a variety of opinions and not rest on merely that the works can be taken out of the public domain. As in *Missouri v. Holland*, the case called for more analysis than it received. To take such a dramatic step—making public domain status reversible—deserves more careful analysis. Second, she should have struck down 104A for *not complying* with the Berne Convention and requiring Congress to get it right. She did not analyze whether Congress had actually met the treaty requirements. Third, I would have appreciated a more direct discussion of the relationship of treaty implementation to existing laws. *Golan* really is a treaty-power case,

³⁸ *Golan*, 132 S. Ct. at 884–85.

³⁹ *Id.* at 885.

as the Cato brief discussed. She bypassed that argument entirely, missing a good opportunity.

Regarding the removal of works from the public domain, Ginsburg goes *radically* far. First, she writes of the decision to enact 104A: “The URAA’s disturbance of the public domain hardly escaped Congress’ attention.”⁴⁰ Her word choice of “disturbance” is interesting. It seems to indicate that she acknowledges that the law is unusual. Later in the opinion, we see the uneasiness again. She writes, “Historical practice corroborates our reading of the Copyright Clause to permit full U.S. compliance with Berne. Undoubtedly, federal copyright legislation generally has not affected works in the public domain.”⁴¹ There is a confidence that historically this removal from the public domain is allowable—even though historians disagree and the evidence arguably favored the plaintiffs. But then again, this confidence always seems to be paired with the reality that removing works from the public domain is unusual.

Justice Ginsburg accepts the reading of history that works were removed from the public domain upon enactment of the 1790 Copyright Act, although *amici* historians did not agree with that interpretation.⁴² She also includes the evidence of private bills’ removing works from the public domain in patents and copyrights as examples, where others used these to show that removal was an anomaly. She then turns to the restoration of works because of World Wars I and II. “Installing a federal copyright system and ameliorating the interruptions of global war, it is true, presented Congress with extraordinary situations. Yet the TRIPS accord, leading the United States to comply in full measure with Berne, was also a signal event.”⁴³ I think that she could have stopped there because those truly were extraordinary times. But she ensures that Congress has the power to do anything it wants, and this, as I have written in other contexts, is troubling. Combined with the arguments presented in the Cato brief, the federal-power implications become even more

⁴⁰ *Id.* at 883.

⁴¹ *Id.* at 885.

⁴² Brief of H. Tomas Gomez-Arostegui & Tyler T. Ochoa as Amici Curiae Supporting Petitioner at 24, *Golan v. Holder*, 132 S. Ct. 873 (2012) (No. 10-545).

⁴³ *Id.* at 888.

troubling. As the Cato brief suggests, anything *potentially* could be dramatically altered.

To ameliorate the effects of removing works from the public domain, Ginsburg notes that Section 104A “imposed no liability for any use of foreign works occurring before restoration.”⁴⁴ That is, the new law did not retroactively punish a use that had been lawful before the new implementing legislation. Also, Section 104A gave a one-year grace period to continue to use the work, satisfying the Fifth Amendment Takings Clause, and some users could continue to use the work until the restored copyright holder filed either a notice of intent at the Copyright Office or actual notice with the reliance party. What is interesting here is that somehow for Ginsburg these provisions make it less disturbing to remove works—that the URAA accounted for the anomaly and, therefore, it makes it all okay.

Ginsburg’s opinion then focuses on the First Amendment. Justice Ginsburg 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 exit.”⁴⁵ Ginsburg finds that the “First Amendment does not inhibit the restoration authorized by § 514.”⁴⁶ The phrasing is curious. What does she mean by the First Amendment “does not inhibit”? Ginsburg references “our pathmarking decision in *Eldred*,”⁴⁷ a particularly strange phrase since she wrote the *Eldred* decision. What made it so “pathmarking”? Well, she begins with the idea that copyright and the First Amendment were enacted close in time, and then reminds us that *Eldred* quoted *Harper and Row* and the recognition that copyright protection provides an “engine of free expression.”⁴⁸ Next, she turns to the concept of “traditional contours” of copyright protection. What is interesting here is that she is trying to constrain the First Amendment protections in copyright to idea/expression dichotomy and fair use. The *Eldred* opinion included other safeguards. Why the retraction?

Strangely, neither idea/expression nor fair use is at issue in the case, but Justice Ginsburg spends a paragraph on each, describing

⁴⁴ *Id.* at 883.

⁴⁵ *Id.* at 878.

⁴⁶ *Id.* at 889.

⁴⁷ *Id.*

⁴⁸ *Id.* (citing *Harper & Row v. Nation Enter.*, 471 U.S. 539, 558 (1985)).

how they allow others to use a copyrighted work. The problem, of course, is that once work is in the public domain, all restrictions are off, making the discussion of fair use and idea/expression irrelevant. Her response to this argument is, again, curious: She says that because the Court has already decided that a work can come out of the public domain, that concern (the First Amendment rights surrounding a work once in the public domain) becomes irrelevant, and that the petitioners, once the work is re-copyrighted, can rely on the traditional mechanisms of fair use and idea/expression. This is very strange thinking.

She takes up the Tenth's Circuit analysis that once a work entered the public domain, the petitioners had a vested right to use the work without restraint. She does not like this idea and fixates on the word "vested." It is here that Justice Ginsburg undervalues the public domain—it is a place where works simply "lapse into the public domain," a waiting pool rather than the public being vested with rights of using the works. The re-copyrighting vests new rights to the copyright holder, making the work useful again. We see no serious discussion on the merits of the public domain itself. Rather, the public domain seems more like a wasteland, where restoration comes almost as a blessing.

She then discusses the fact that the Copyright Act has over time been extended to include new copyrightable subject matter. Ironically, one of the examples she uses is architectural works which became a separate copyrightable category in order to comply with the Berne Convention. The United States did *not* apply protection to such works retroactively, even though that violates the convention.

She then turns to the market analysis. While the petitioners now have to pay to use works that had previously been free to use, Ginsburg believes this evens out the marketplace for domestic and foreign contemporaries. This explanation is a simplification of the issue at hand, neglecting the more complex policy arguments. She addresses the "orphan works" problem—a work whose author can't be found—and again misses the issues entirely. She sees the reliance provisions as an added benefit (not clear if she means another First Amendment mechanism). She wants to see *Golan* as the same as *Eldred*.

The strangest element about this "First Amendment" copyright case is the lack of First Amendment analysis. At one point, Justice

Ginsburg writes, “the First Amendment does not inhibit the restoration authorized by § 514.”⁴⁹ No follow-up is given.

Justice Ginsburg concludes thus: “Congress determined that U.S. interests were best served by our full participation in the dominant system of international copyright protection.” The United States actually has not fully participated, and is still in noncompliance with Section 104A, along with 110(5) and architectural works as subject matter, to name only three. Ginsburg continues: “Those interests include ensuring exemplary compliance with our international obligations, securing greater protection for U.S. authors abroad, and remedying unequal treatment of foreign authors. . . . It is our obligation, of course, to determine whether the action Congress took, wise or not, encounters any constitutional shoal. For the reasons stated, we are satisfied it does not.”

Is this a First Amendment case? Ginsburg doesn’t want it to be. Is this a treaty powers case? No discussion exists on that point either. Is it, as Justice Ginsburg suggests from the beginning, a treaty obligation case? If so, she should have come down harder on Congress’s mistakes. In the end, the case is merely one where Ginsburg is trying to stop the use of “traditional contours” and the application of the First Amendment to the Copyright Act in any broader way.

D. Breyer’s Dissent

Justice Stephen Breyer dissented, as he had done in *Eldred*. He begins with the Copyright Clause, rather than Berne. This is a tell-tale sign of where he places his emphasis. Whereas Justice Ginsburg is looking to be a responsible member of the international copyright community, Breyer is concentrating on the system at home.

Justice Breyer begins with the concept that the Copyright Clause is based on the idea that giving exclusive rights to the holder incentivizes new works. Section 104A, in contrast, gives copyright without requiring the incentive of creation of any new works.⁵⁰ Moreover, because works are re-copyrighted, dissemination of those same works is impeded without any additional benefits. In his introduction, he concludes, “In my view, the Copyright Clause does not authorize Congress to enact this statute.”⁵¹

⁴⁹ *Id.*

⁵⁰ *Id.* at 900 (Breyer, J., dissenting).

⁵¹ *Id.*

So how does Breyer get to this statement? He begins with copyright's history and the "economic philosophy behind the Copyright Clause."⁵² Copyright is granted as a private right for a public reason, understanding that because it is conferring a monopoly, balance is necessary. He discusses the dangers of the Stationer's Company system (perpetual monopolies with censorship in England) and the change to the Statute of Anne in 1710, where monopolies became "limited Times."⁵³ The colonies, and later the young United States, modeled their copyright laws on the Statute of Anne. All of these laws saw the essence of the system as encouraging creativity for the benefit of the public by granting limited monopolies to the creator, creating productive utility. He looks to the Founders' ideas of copyright to support this reading, then to case law and congressional reports:

The upshot is that text, history, and precedent demonstrate that the Copyright Clause places great value on the power of copyright to elicit new production. . . . But does the Clause empower Congress to enact a statute that withdraws works from the public domain, brings about higher prices and costs, and in doing so seriously restricts dissemination, particularly to those who need it for scholarly, educational, or cultural purposes—all *without providing any additional incentive* for the production of new material? That is the question before us. And, as I have said, I believe the answer is no. Congress in this statute has exceeded what are, under any plausible reading of the Copyright Clause, its permissible limits.⁵⁴

He turns to analyzing Section 104A itself. He explains the technical elements of the statute and the three kinds of works were restored: foreign works that had not met the U.S. formality requirements, foreign works from countries with whom we did not have treaty relations, and sound recordings.⁵⁵

⁵² *Id.* (quoting Eldred, 537 U.S. at 212).

⁵³ *Id.* at 901.

⁵⁴ *Id.* at 903 (emphasis in original).

⁵⁵ *Id.* at 904. Breyer interestingly wrote: "The third category covers all sound recordings from eligible foreign countries published after February 15, 1972. The practical significance of federal copyright restoration to this category of works is less clear, since these works received, and continued to receive, copyright protection under state law. See 17 U.S.C. § 301(c)." Some have believed that all foreign sound recordings are protected by federal law now, but this reading suggests that this is not so. *Id.*

Works restored by Section 104A are re-copyrighted, and dissemination of the works is restricted, according to Justice Breyer, in two ways. Works previously available for free now may require payment and add administrative costs, “such as the costs of determining whether a work is the subject of a ‘restored copyright,’ searching for a ‘restored copyright’ holder, and negotiating a fee.”⁵⁶ Many times all of these tasks are time-consuming, or the information is impossible to determine, resulting in “orphan works,” works whose copyright holder cannot be found. “There are millions of such works.”⁵⁷ Where these millions of works were previously free to use for all, now they are encumbered by copyright. “This statute analogously restricts, and thereby diminishes, Americans’ preexisting freedom to use formerly public domain material in their expressive activities.”⁵⁸ He sees no countervailing benefit equivalent to the detriments and expenses created by the removal of works from the public domain: “Indeed, unlike *Eldred* where the Court had to decide a complicated line-drawing question—when is a copyright term too long?—here an easily administrable standard is available—a standard that would require works that have already fallen into the public domain to stay there.”⁵⁹

Justice Breyer turns to what he describes as speech-related harms. He mentions that the removal of works from the public domain “‘abridges’ a preexisting freedom to speak.”⁶⁰ He discusses Congress’s and the Court’s attempts to protect the public domain. Unfortunately, he does not discuss further the idea of the freedom to speak in relation to the public domain. He mentions that while the statute is not content-based, this feature does not disclose a First Amendment problem and cites *Turner Broadcasting* as an example.⁶¹ Once again, we see First Amendment language without significant First Amendment analysis. Breyer concludes:

Taken together, these speech-related harms (e.g., restricting use of previously available material; reversing payment

⁵⁶ *Id.* at 905.

⁵⁷ *Id.*

⁵⁸ *Id.* at 906.

⁵⁹ *Id.*

⁶⁰ *Id.* at 907.

⁶¹ *Id.* (citing *Turner Broadcasting Sys., Inc. v. FCC*, 512 U.S. 622, 659 (1994)).

expectations; rewarding rent-seekers at the public's expense) at least show the presence of a First Amendment interest. And that is enough. For present purposes, I need not decide whether the harms to that interest show a violation of the First Amendment. I need only point to the importance of interpreting the Constitution as a single document—a document that we should not read as setting the Copyright Clause and the First Amendment at cross-purposes. Nor need I advocate the application here of strict or specially heightened review. I need only find that the First Amendment interest is important enough to require courts to scrutinize with some care the reasons claimed to justify the Act in order to determine whether they constitute reasonable copyright-related justifications for the serious harms, including speech-related harms, which the Act seems likely to impose.⁶²

Why doesn't he engage in a more thorough First Amendment analysis? We had *five* decisions in this case before the case got to the Supreme Court. At some point, we should have had a full First Amendment analysis. Yet the only court to engage in a First Amendment analysis in any significant way was the remanded district court opinion.

Justice Breyer turns back to the statute itself; he finds that Section 104A does not incentivize new works because copyright is granted to works “already produced,” lacking any “significant copyright-related *quid pro quo*.”⁶³ In response to the majority's view that history—including private bills and wartime restoration—proves that the public domain can be a two-way street, Breyer refers to these as special exceptions. He finds that congressional practice actually shows an “unbroken string of legislation preventing the withdrawal of works from the public domain,” including the Berne Convention Implementation Act, and the Copyright Acts of 1909 and 1976.⁶⁴

Finally, Breyer turns to Article 18 of the Berne Convention, the underlying justification for the need for Section 104A. He notes that we had implemented Berne without Article 18 in 1988, and no additional benefit seems to have been gained by adding Section 104A. Moreover, Article 18(3) allows legislation to be enacted to

⁶² *Id.* at 907–08.

⁶³ *Id.* at 908.

⁶⁴ *Id.* at 909.

determine “the conditions of application of this principle.”⁶⁵ Breyer suggests compulsory licensing of public domain works, requiring a copyright holder to provide necessary administrative information to enforce a copyright, or insisting upon “reasonable royalties” are three examples. “[N]either Congress nor the Executive took advantage of less-restrictive methods of compliance that the Convention itself provides.”⁶⁶

Justice Breyer concludes: “The fact that, by withdrawing material from the public domain, the statute inhibits an important preexisting flow of information is sufficient, when combined with the other features of the statute that I have discussed, to convince me that the Copyright Clause, interpreted in the light of the First Amendment, does not authorize Congress to enact this statute.”⁶⁷

D. *Where Is the First Amendment?*

Neither the majority nor the dissent directly places *Golan* within a significant First Amendment context. They each include the First Amendment, but we are still left wondering about the relationship between copyright law and the freedom of expression. The remanded district court had engaged in a First Amendment analysis, and the second Tenth Circuit decision had found within that context that the government had a legitimate reason for the enactment. But that is all we get.

III. *Mayo v. Prometheus*

A. *The Case*

On March 20, 2012, Justice Breyer delivered a 9-0 opinion in *Mayo v. Prometheus*, reversing the *en banc* U.S. Court of Appeals for the Federal Circuit.⁶⁸ The case concerned the boundaries of patentable subject matter and clarified the distinction between a law of nature and an *application* of a law of nature. The case itself is the latest in a flurry of activity regarding patentable subject matter that included *Bilski v. Kappos*, the Supreme Court’s case from the previous term.

⁶⁵ *Id.* at 911.

⁶⁶ *Id.* at 912.

⁶⁷ *Id.*

⁶⁸ *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012).

Many have written on this subject, and will continue to do so. This essay focuses on the secondary argument made by the petitioners.

Prometheus concerns a medical diagnostics test that analyzes the level of metabolites (the chemicals produced in the blood when a patient metabolizes a drug) once a particular drug is administered to a patient.⁶⁹ The patent at issue concerned three steps: administering the drug, the patient's body transforming the drug, and then the patient's metabolite levels were read by the doctor.⁷⁰ Once the levels were ascertained, one could correlate the information to adjust to proper levels. The researchers licensed their research to Prometheus, which patented and commercialized the research as a blood test for thiopurine metabolites under the name Pro-Predict.

Mayo Clinic and Mayo Medical Laboratories (collectively, "Mayo") used Pro-Predict. Then, in 2003, Mayo thought they could improve on Pro-Predict and decided, even though it was a patented test, to make their own with different metabolite levels evaluated and at a lower price. Prometheus sued for patent infringement. Mayo responded: The patent should be invalidated because the process was merely a description of a law of nature.

The district court found for Mayo. The Federal Circuit reversed, twice finding that Prometheus met the "machine-or-transformation" test—once before *Bilski* and once after. The Supreme Court reversed again, invalidating Prometheus's patent.

B. The First Amendment Argument

After making the argument that Prometheus's patent was merely a description of a law of nature, the petitioners included a First Amendment argument in their brief to the Supreme Court.

⁶⁹ "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." Brief of Petitioner-Appellant at 3, *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2011) (No. 10-1150).

⁷⁰ *Id.* at 5. The drug at issue is known as azathioprine, or thiopurine, and has been around for decades. The patent was not for the drug itself, but for a process patent. "The inventors of the patents at issue here studied the correlations between thiopurine metabolite levels and the conditions of patients suffering from gastrointestinal autoimmune diseases." *Id.* They used well-known methods to measure the metabolite levels, and recognized correlations between particular levels and a patient's well-being.

“[E]qually well established was the legal principle that federal legislation must be construed to avoid conflict with First Amendment freedoms whenever possible.”⁷¹

The petitioners focus on the concept of 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,” which “has been deemed sacrosanct.”⁷² The petitioners turn to several traditional First Amendment cases where the right to think is the “beginning of freedom,” and “speech is the beginning of thought.”⁷³

The petitioners alleged that Prometheus’s sweeping patent impinged on the right to think. The American Medical Association also expressed concerns in patents like Prometheus’s because they “entangle physicians in “a vast thicket of exclusive rights” to “basic diagnostic information” that is “critical” to “providing sound medical care,” to “the detriment of the nation’s health.”⁷⁴ In particular, the petitioners use the example of Dr. Rokea el-Azhary, who was accused of patent infringement by Prometheus for conducting research on metabolite ranges in dermatology patients. (Prometheus’s patent was for pediatric Crohn’s disease and ulcerative colitis patients, but its patent was broad enough to incorporate other research and applications.) Dr. el-Azhary was prohibited from “thinking” and publishing her research because of the threat of an overbroad patent. The petitioners cite the ACLU’s brief in *Bilski* for the proposition that “patents like those here and in *LabCorp* amount ‘to a patent on pure thought or pure speech’; courts ‘should interpret patent law doctrines’ to ‘avoid the difficult application of First Amendment doctrines.’”⁷⁵

The petitioners then turn to the application of Prometheus’s patents in a real-world setting. “It is unthinkable that Congress intended the patent laws to embargo independent research and thought about a natural correlation based on someone’s suggestion

⁷¹ *Id.* at 46.

⁷² *Id.*

⁷³ *Id.* (quoting *Ashcroft v. Free Speech Coal.*, 535 U.S. 234, 253 (2002)).

⁷⁴ *Id.* at 47 (quoting Brief for American Coll. of Med. Genetics, et al. as Amici Curiae Supporting Respondents at 5–6, 20–21, Mayo, 132 S. Ct. 1289 (No. 10-1150)).

⁷⁵ *Id.* (quoting Brief for ACLU as Amicus Curiae Supporting Appellee at 5–7, 14, In re *Bilski*, No. 2007-1130 (Fed. Cir. Apr. 3, 2008)).

of numbers that he deems relevant, but which others may reasonably reject.”⁷⁶ The petitioners make an economic argument as well, noting that medical diagnostics do not entail large regulatory, research and development costs. “Indeed, the work behind Prometheus’s patents was done by physicians who only later sold the right to patent their research to Prometheus at a minimal price. It is no exaggeration to say that Prometheus invested in litigation, not research.”⁷⁷

C. *The Cato Institute’s Amicus Brief*

Cato, along with the Competitive Enterprise Institute, Information Society Project at Yale, and Reason Foundation, submitted an *amicus* brief supporting Mayo. The brief argued that the relevant processes do not qualify under Section 101, that enforcing the patents would stifle innovation and drive up medical costs, and that the patent removes essential knowledge from the public domain. It is this fourth argument that focuses on freedom of thought under the First Amendment.

The brief’s fourth section begins, “The government cannot regulate mere thought.”⁷⁸ The Supreme Court has recognized this point in numerous cases. Here, I want to explore the cases discussed in the Cato brief to better understand the “freedom to think” argument in the context of *Mayo*.

The first case Cato cites, *Paris Adult Theatre I v. Slaton*, involves the showing of an allegedly obscene movie, which the Supreme Court of Georgia enjoined.⁷⁹ The U.S. Supreme Court wrote that Georgia’s obscenity laws can prevent the showing of the film as long as they met First Amendment standards. As part of that discussion, the Court addressed the question of “freedom of thought,” distinguishing between the regulation of an act (showing an obscene film or, say, drug use) and the thoughts associated with that act.

⁷⁶ *Id.* at 47–48. “[U]nder the Prometheus patents, as the AMA and other medical groups explained, a physician or researcher ‘would become an infringer if he or she merely considered what to do about the results [of a test of metabolite levels] in light of relevant scientific information,’ while a laboratory would induce infringement simply ‘by publishing articles or brochures discussing the correlation’ between those levels and drug efficacy.” *Id.* at 54 (emphasis in original).

⁷⁷ *Id.* at 52.

⁷⁸ Brief for Cato Institute, et al. as Amici Curiae Supporting Petitioners at 28, Mayo, 132 S. Ct. 1289 (No. 10-1150).

⁷⁹ *Paris Adult Theatre I v. Slaton*, 413 U.S. 49 (1973).

“The fantasies of a drug addict are his own and beyond the reach of government, but government regulation of drug sales is not prohibited by the Constitution.”⁸⁰

The brief then quotes from *Stanley v. Georgia*, noting that “the 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.”⁸¹ In *Stanley*, again a Georgia obscenity case, this time involving a search that uncovered three reels of eight-millimeter film that an officer concluded were obscene, the Court concluded that a statute punishing the possession of obscene matter violated, among other things, the First Amendment.⁸²

The *Stanley* Court notes that numerous cases tell us that commercial distribution of obscene materials are not constitutionally protected, but here we have “mere private possession of such material.”⁸³ Here is where this case gets interesting in the context of doctors and medical diagnostics: “It is now well established that the Constitution protects the right to receive information and ideas,” which the court found is “fundamental to our free society.”⁸⁴ The Court continued:

The makers of our Constitution undertook to secure conditions favorable to the pursuit of happiness. They recognized the significance of man’s spiritual nature, of his feelings and of his intellect. They knew that only a part of the pain, pleasure and satisfactions of life are to be found in material things. They sought to protect Americans in their beliefs, their thoughts, their emotions and their sensations. They conferred, as against the government, the right to be let alone—the most comprehensive of rights and the right most valued by civilized man.⁸⁵

⁸⁰ *Id.* at 68.

⁸¹ *Stanley v. Georgia*, 394 U.S. 557, 565–66 (1969).

⁸² *Id.* at 558.

⁸³ *Id.* at 563–64.

⁸⁴ *Id.* at 564 (citations omitted).

⁸⁵ *Id.* (quoting *Olmstead v. United States*, 277 U.S. 438, 478 (1928) (Brandeis, J., dissenting)).

The Court combined these concepts with the right to be free from “unwanted intrusions into one’s privacy.”⁸⁶ Here, the Court found that the appellant was asserting the “right to read or observe what he pleases—the right to satisfy his intellectual and emotional needs in the privacy of his own home.”⁸⁷ The Court then concludes: “If the First Amendment means anything, it means that a State has no business telling a man, sitting alone in his own house, what books he may read or what films he may watch. Our whole constitutional heritage rebels at the thought of giving government the power to control men’s minds.”⁸⁸ Applied to the Prometheus patent, this becomes a very powerful statement. When a patent goes so far as to control what a doctor or researcher can think without infringing a patent, the state has gone too far.

Next, the Cato brief quotes *United States v. Ballard*: “Freedom of thought . . . is basic in a society of free men.”⁸⁹ This case concerned using the mail to defraud through the “I Am Movement,” a religious movement. Here the freedom of thought came up in the context of the “truth” or falsity of the particular religious beliefs. “Freedom of thought, which includes freedom of religious belief, is basic in a society of free men.”⁹⁰ The Court upheld the district court’s opinion that such matters of deciding the truth of a particular religion were not to be put to a jury to decide.

The Cato brief then turns to the 2002 *Ashcroft v. Free Speech Coalition* decision, where the Court wrote, “The right to think is the beginning of freedom.”⁹¹ *Ashcroft* concerned the government’s attempt to prevent virtual child pornography:

The Government submits further that virtual child pornography whets the appetites of pedophiles and encourages them to engage in illegal conduct. This rationale cannot sustain

⁸⁶ *Id.*

⁸⁷ *Id.* at 565.

⁸⁸ *Id.*

⁸⁹ 322 U.S. 78, 86 (1944).

⁹⁰ *Id.* (“It embraces the right to maintain theories of life and of death and of the hereafter which are rank heresy to followers of the orthodox faiths. Heresy trials are foreign to our Constitution. Men may believe what they cannot prove.”).

⁹¹ Brief for Cato Institute et al. in Mayo, *supra* note 67, at 29 (quoting *Ashcroft*, 535 U.S. at 253).

the provision in question. The mere tendency of speech to encourage unlawful acts is not a sufficient reason for banning it. The government “cannot constitutionally premise legislation on the desirability of controlling a person’s private thoughts.”⁹²

The Court explained that “First Amendment freedoms are most in danger when the government seeks to control thought or to justify its laws for that impermissible end” because “[t]he right to think is the beginning of freedom, and speech must be protected from the government because speech is the beginning of thought.”⁹³ The distinction between thought and action is clear: The government cannot regulate thought.

How does the Cato brief use these cases? It turns to *Rokea el-Azhary*, the doctor charged with infringing Prometheus’s patent for research using metabolite levels in a different area of medicine—dermatology instead of digestive medicine:

Enforcing the patents at issue here would violate individuals [sic], such as Dr. el-Azhary’s, freedom of thought. 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—

⁹² Ashcroft, 535 U.S. at 253 (quoting *Stanley*, 394 U.S. at 566).

⁹³ 535 U.S. 234, 253. See *id.* (“To preserve these freedoms, and to protect speech for its own sake, the Court’s First Amendment cases draw vital distinctions between words and deeds, between ideas and conduct.” (citing *Kingsley Int’l Pictures Corp. v. Regents of the Univ. of New York*, 360 U.S. 684, 689 (1959))); *id.* (“The normal method of deterring unlawful conduct is to impose an appropriate punishment on the person who engages in it” (quoting *Bartnicki v. Vopper*, 532 U.S. 514, 529 (2001))); *id.* (“The government may not prohibit speech because it increases the chance an unlawful act will be committed ‘at some indefinite future time.’” (citing *Hess v. Indiana*, 414 U.S. 105, 108 (1973) (*per curiam*))); *id.* (“The government may suppress speech for advocating the use of force or a violation of law only if ‘such advocacy is directed to inciting or producing imminent lawless action and is likely to incite or produce such action.’” (citing *Brandenburg v. Ohio*, 395 U.S. 444, 447 (1969) (*per curiam*))); *id.* at 253–54 (“There is here no attempt, incitement, solicitation, or conspiracy. The Government has shown no more than a remote connection between speech that might encourage thoughts or impulses and any resulting child abuse. Without a significantly stronger, more direct connection, the Government may not prohibit speech on the ground that it may encourage pedophiles to engage in illegal conduct.”).

Golan and Prometheus as Misfit First Amendment Cases?

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.⁹⁴

The Cato brief has made a case for freedom of thought versus action, and the overbreadth of the patent issued to Prometheus, with Dr. el-Azhary as an example. But the Cato *amici* do not stop there. They turn to the question of whether patents are subject to First Amendment scrutiny. Here is where the connection to *Eldred* and *Golan* gets interesting. The Cato brief argues that the patent at issue “constitutes a content-based regulation of thought” that “ventures far beyond the traditional contours of patent protection.”⁹⁵ In other words, the Cato brief connects *Prometheus* to *Eldred*.

Recall that *Eldred* suggested that the First Amendment would play a role in copyright law when Congress “alter[s] the traditional contours of copyright protection.”⁹⁶ And as Justice Ginsburg has now pointed out both in *Eldred* and *Golan*, First Amendment concerns are generally protected in copyright law by fair use and idea/expression. Patents, however, do not include either of these elements, and moreover, “[i]n contrast [to copyrights], patents generally do not raise First Amendment issues.”⁹⁷ Patent law operates on a system of disclosure as part of the patent process and has “not developed the ‘free speech safeguards’ of copyright law” because it “does not usually exist in tension with First Amendment freedoms.”⁹⁸ Therefore, Cato suggests, strict scrutiny is necessary because free speech safeguards aren't built into patent law.

The brief then returns to its *Eldred* “traditional contours” argument:

The patents at issue here represent an unprecedented departure from the traditional contours of patent protection. Patents have traditionally protected *objects* and *actions*. Only

⁹⁴ Brief for Cato Institute et al. in Mayo, *supra* note 67, at 29.

⁹⁵ *Id.*

⁹⁶ *Id.* at 30.

⁹⁷ *Id.*

⁹⁸ *Id.* at 30–31.

recently have parties sought patent protection for claims whose 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.⁹⁹

D. Justice Breyer's Decision for a Unanimous Court

In 2006, Justice Breyer wrote a strong dissent from the dismissal of certiorari as improvidently granted in *Laboratory Corp. of America Holdings v. Metabolite Labs*, where he wrote that patenting broad medical processes prevents “doctors from using their best medical judgment,” “forces doctors to spend unnecessary time and energy to enter into license agreements,” “diverts resources from the medical task of health care to the legal task of searching patent files for similar simple correlations,” and “raises the cost of health care while inhibiting its effective delivery.”¹⁰⁰ Now, in 2012, Breyer’s earlier dissent has won a *unanimous* Court: Prometheus’s patents are unnecessary and inhibiting.

Justice Breyer’s dissent in *Metabolite* thus becomes a preview of his opinion in *Prometheus*. Like *Prometheus*, *Metabolite* concerned a medical process, and measuring levels, this time of an amino acid called homocysteine. In his dissent, Breyer focuses on whether the process was merely a law of nature, which would be unpatentable. There, the claim at issue protected the process of “correlating” test results to potential vitamin deficiencies, and parties were infringing if *any* test was used that “determines whether a body fluid had an ‘elevated level of total homocysteine.’”¹⁰¹ At trial, the researchers explained that “correlating” would occur in any physician’s mind that knew that elevated homocysteine levels mean a cobalamin or folate deficiency. When the doctors used LabCorp’s test, rather than Metabolite’s, LabCorp induced doctors to infringe Claim 13, because “in reviewing the test results, doctors would [infringe the patent]” by making the connection. And since LabCorp taught the doctors

⁹⁹ *Id.* at 31 (emphasis in original).

¹⁰⁰ *Lab. Corp. of Am. Holdings v. Metabolite Labs, Inc.*, 548 U.S. 124, 139 (2006) (dismissing cert. as improvidently granted) (Breyer, J., dissenting).

¹⁰¹ *Id.* at 129.

about the correlation, they induced the infringement. Even though the case was dismissed because of LabCorp's failure to cite Section 101 at the district court level, Breyer turns to the merits. He sees a distinction between a law of nature and, as *Metabolite* suggests, *an application of a law of nature*. Breyer rejects the application and writes that "they cannot avoid the fact that the process is no more than an instruction to read some numbers in light of medical knowledge."¹⁰² He then turns to the impact on doctors if the patent is held valid:

To fail to do so threatens to leave the medical profession subject to the restrictions imposed by this individual patent and others of its kind. Those restrictions may inhibit doctors from using their best medical judgment; they may force doctors to spend unnecessary time and energy to enter into license agreements; they may divert resources from the medical task of health care to the legal task of searching patent files for similar simple correlations; they may raise the cost of healthcare while inhibiting its effective delivery.¹⁰³

One could see a "right to think" argument beginning, but Breyer ends shortly after that with little discussion and certainly no reference to the freedom-of-thought cases.

Justice Breyer then pens the 9-0 decision in *Prometheus* six years later. The language, analysis, and supporting case law are strikingly similar to *Metabolite*. Again, he focuses on the "laws of nature" versus "application of the laws of nature." The question for this essay, however, is do we also see a First Amendment argument (implicitly or explicitly)? Breyer describes the issue:

The case before us lies at the intersection of these basic principles. It concerns patent claims covering processes that help doctors who use thiopurine drugs to treat patients with autoimmune diseases determine whether a given dosage level is too low or too high. The claims purport to apply natural laws describing the relationships between the concentration in the blood of certain thiopurine metabolites and the likelihood that the drug dosage will be ineffective or induce harmful side-effects. We must determine whether the claimed processes have transformed these unpatentable natural laws

¹⁰² *Id.* at 137.

¹⁰³ *Id.* at 138.

into patent-eligible applications of those laws. We conclude that they have not done so and that therefore the processes are not patentable.¹⁰⁴

The process patent contained three steps. First, administer the drug. The next step tells the doctor the relevant natural laws, “at most adding a suggestion that he should take those laws into account when treating his patient.”¹⁰⁵ In the third step, the doctor “determines” “the level of the relevant metabolites in the blood, through whatever process the doctor or the laboratory wishes to use.”¹⁰⁶

Breyer is not impressed:

The upshot is that the three steps simply tell doctors to gather data from which they may draw an inference in light of the correlations. To put the matter more succinctly, the claims inform a relevant audience about certain laws of nature; any additional steps consist of well-understood, routine, conventional activity already engaged in by the scientific community; and those steps, when viewed as a whole, add nothing significant beyond the sum of their parts taken separately. For these reasons we believe that the steps are not sufficient to transform unpatentable natural correlations into patentable applications of those regularities.¹⁰⁷

He then turns to the relevant precedents. *Diehr* involved a well-known math equation used to determine when to open a rubber press, which the Court found patentable.¹⁰⁸ In contrast, *Flook* involved an alarm used in monitoring the limits of chemical processes, which process the Court determined not to be patentable.¹⁰⁹ Justice Breyer equates Prometheus’s patents with *Flook* and then looks to a series of English cases to support the distinction between laws of nature or mathematical algorithms and the applications of those laws.¹¹⁰

¹⁰⁴ Prometheus, 132 S. Ct. at 1294.

¹⁰⁵ *Id.* at 1297.

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* at 1298.

¹⁰⁸ *Diamond v. Diehr*, 450 U.S. 175 (1981).

¹⁰⁹ *Parker v. Flook*, 437 U.S. 584 (1978).

¹¹⁰ Prometheus, 132 S. Ct. at 1300 (citations omitted).

Merely using a law of nature is not enough: “The Court has repeatedly emphasized . . . a concern that patent law not inhibit further discovery by improperly tying up the future use of laws of nature.”¹¹¹

The opinion addresses the concerns of Prometheus and some of its *amici*, and it is here that we find hidden the right-to-think versus right-to-invent argument. Prometheus asserted that denying patent coverage would interfere with medical research because diagnostic research will become too expensive. Mayo and the experts on their side suggest the opposite conclusion, arguing that “if claims to exclusive rights over the body’s natural responses to illness and medical treatment are permitted to stand, the result will be a vast thicket of exclusive rights over the use of critical scientific data that must remain widely available if physicians are to provide sound medical care.”¹¹² The Court recognized that patent law is a “two-edged sword,” and that there would be differences of opinion between incentivizing invention and the flow of information. “We need not determine here whether, from a policy perspective, increased protection for discoveries of diagnostic laws of nature is desirable.”¹¹³

In short, Breyer does not engage in the First Amendment argument raised by the petitioners because the “laws of nature” versus “application of laws of nature” take care of the issue. This approach looks an awful lot like the idea/expression distinction that Justice Ginsburg had earlier seen as the built-in First Amendment mechanism in copyright law. One could argue that the First Amendment is protected in patents by the same kind of mechanism: the exclusions of patentability, including laws of nature.

IV. How to Read These Cases Together

In a 2001 *Stanford Law Review* article, Neil Netanel addressed the question of the relationship of the First Amendment to copyright law in court decisions. At the time, one Eleventh Circuit case stood out as “extraordinary.” The case concerned Alice Randall’s novel, *The Wind Done Gone*, a rewriting from the slave’s viewpoint of the famous Margaret Mitchell novel, *Gone with the Wind*. According to

¹¹¹ *Id.* at 1301.

¹¹² *Id.* at 1304–05 (citing Brief for Am. Coll. of Med. Genetics et al. as Amici Curiae Supporting Petitioners at 7, Mayo, 132 S. Ct. 1289 (No. 10-1150)).

¹¹³ *Id.* at 1305.

Netanel, the case “marks the first time an appellate court has applied the First Amendment’s Free Speech Clause to constrain the enforcement of a copyright.”¹¹⁴ While scholars have discussed the relationship of the First Amendment to copyright law for many years, according to Netanel, “[i]n almost every instance, courts have assumed that First Amendment values are fully and adequately protected by limitations on copyright owner rights within copyright doctrine itself.”¹¹⁵ Netanel’s thorough argument suggests that except for the Eleventh Circuit, courts have gotten the relationship wrong, thinking that copyright takes care of all of the First Amendment concerns. Netanel argues that both copyright and the First Amendment have changed dramatically since the 1970s, however, especially with the expansion of both copyright and the First Amendment. Unfortunately, Ginsburg’s opinion in *Golan* replicates the lower courts.

In *Golan*, Justice Ginsburg does not go beyond the built-in First Amendment mechanisms of fair use and idea/expression. She is essentially stopping the flood that might open if *Golan* had found Section 104A unconstitutional. Finding Section 104A unconstitutional would have allowed other trade-agreement-implementing legislation to be reviewed through the First Amendment lens.

What about patents? How are we to understand the relationship of patents to the First Amendment? This path is less clear, but I propose the following reading: Justice Breyer’s opinion reminds us of the importance of the exceptions to patentable subject matter, giving us space to think, explore, and invent. We do not want to lock up the building blocks of our world. “Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.”¹¹⁶ The monopolization of those tools through the grant of a patent, Breyer writes, might tend to impede innovation more than it would tend to promote it.¹¹⁷ *Mayo v. Prometheus* thus gives us an example of patents going too far, interfering

¹¹⁴ Neil Weinstock Netanel, *Locating Copyright within the First Amendment Skein*, 54 *Stan. L. Rev.* 1, 2, 86 (2001) (citing *Suntrust Bank v. Houghton Mifflin Co.*, 252 F.3d 1165 (11th Cir. 2001) (*per curiam*)).

¹¹⁵ *Id.*

¹¹⁶ *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972).

¹¹⁷ *Prometheus*, 132 S. Ct. at 1293.

Golan and Prometheus as Misfit First Amendment Cases?

with laws of nature and even the freedom to think. I would posit that those exceptions for patent law *are* the built-in mechanisms that protect the First Amendment.

Patentable subject matter, then, serves First Amendment goals. Like copyright law, the laws surrounding patent usually take care of protecting the First Amendment. In *Prometheus*, Justice Breyer protected the freedom to think by ensuring that laws of nature are not eligible for patents.

And so what are we to make of the Supreme Court's two IP cases this year? Both *Golan* and *Prometheus* focused on the internal issues and structures of their respective areas of copyright and patent law. In both, plaintiffs asserted a First Amendment argument. *Golan* rejected the need for First Amendment scrutiny because restoring foreign works did not alter the traditional contours of copyright protection. *Prometheus* never addressed the First Amendment issues directly. The First Amendment thus remains, unfortunately, on the sidelines of both areas of intellectual property and, at least in 2011–2012, plays little to no role in evaluating copyright and patent boundaries.