

The Constitutional Law of Intellectual Property After *Eldred v. Ashcroft*

By

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I. Introduction

The past decade has witnessed an extraordinary blossoming of scholarship on the constitutional law of intellectual property,¹ much of which focuses on copyright law.² Had the Supreme Court ruled in favor of Eldred's challenge to the constitutionality of the Copyright Term Extension Act,³ this body of scholarship would have undoubtedly proliferated with alacrity. Many scholars would have been eager to offer interpretations of implications of an Eldred-favorable decision for other intellectual property disputes.⁴ Given the Ashcroft-favorable outcome, some may expect the *Eldred* decision to "deconstitutionalize" intellectual property law and reduce to a trickle further scholarly

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¹ See, e.g., Dan L. Burk, *Patenting Speech*, 79 Tex. L. Rev. 99 (2000); Paul J. Heald and Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. Ill. L. Rev. 1119 (2000); Robert Patrick Merges and Glenn Harlan Reynolds, *The Proper Scope of the Copyright and Patent Power*, 37 J. Legis. 45 (2000); Mark A. Lemley, *The Constitutionalization of Technology Law*, 15 Berkeley Tech. L.J. 529 (2000); Malla Pollack, *Unconstitutional Incontestability? The Intersection Of The Intellectual Property And Commerce Clauses Of The Constitution: Beyond A Critique Of Shakespeare Co. v. Silstar Corp.*, 18 Seattle U. L. Rev. 259 (1995); Edward C. Walterscheid, *The Nature of the Intellectual Property Clause: A Study in Historical Perspective (Part I)*, 83 J. Pat. & Trademark Off. Soc'y 763 (2001).

² See, e.g., Symposium, *Eldred v. Ashcroft: Intellectual Property, Congressional Power, and the Constitution*, 37 Loyola L.A. L. Rev. 1 (2002); Edwin C. Baker, *First Amendment Limits on Copyright*, 55 Vand. L. Rev. 891 (2002); Yochai Benkler, *Free as The Air To Common Use: First Amendment Constraints on Enclosure of The Public Domain*, 74 N.Y.U. L. Rev. 354 (1999); Julie E. Cohen, *A Right to Read Anonymously: A Closer Look at Copyright Management in Cyberspace*, 28 Conn. L. Rev. 981 (1996); Niva Elkin-Koren, *Cyberlaw and Social Change: A Democratic Approach to Copyright*, 14 Cardozo Arts & Ent. L.J. 215 (1996); Marci A. Hamilton, *Copyright at the Supreme Court*, 47 J. Cop. Soc'y 317 (2000); Mark A. Lemley and Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 Duke L.J. 147 (1999); LAWRENCE LESSIG, *CODE AND OTHER LAWS OF CYBERSPACE* (2000); Glynn S. Lunney, *The Death of Copyright: Digital Technology, Private Copying, and the DMCA*, 87 Va. L. Rev. 813 (2001); Neil W. Netanel, *Locating Copyright in the First Amendment Skein*, 54 Stan. L. Rev. 1 (2002); L. Ray Patterson, *Understanding the Copyright Clause*, 47 J. Cop. Soc'y 365 (2000); Jed Rubenfeld, *The Freedom of Imagination: Copyright's Constitutionality*, 112 Yale L.J. 1 (2002). I confess to having contributed to this literature as well. See Pamela Samuelson, *Economic and Constitutional Influences on Copyright Law In the United States*, 23 Eur. Intell. Prop. Rev. 409 (Sept. 2001); Pamela Samuelson, *Copyright and Freedom of Expression in Historical Perspective*, 11 J. Intell. Prop. L. (forthcoming 2003).

³ *Eldred v. Ashcroft*, 123 S.Ct. 769 (2003). Justices Stevens and Breyer dissented with separate opinions, the former offering an alternative historical and constitutional analysis, and the latter mainly focusing on the economic effects of the CTEA. See *id.* 790-801 (Stevens dissent) and 801-15 (Breyer dissent).

⁴ See, e.g., Heald & Sherry, *supra* note 1 (analyzing constitutional vulnerability of several intellectual property rules, including the CTEA). A successful challenge to the CTEA would have made these other challenges more likely.

discourse about limits that the Intellectual Property Clause, the First Amendment, or other provisions of the U.S. Constitution place on Congressional power to regulate in this field.⁵ This article suggests that the scholarly debate will and should continue and that the proponents of constitutional limits are likely to enjoy some successes in the future, even if they did not do so in the *Eldred* case itself.

Why might this be so? For one thing, a substantial consensus exists within the community of American intellectual property scholars that the CTEA *is* unconstitutional.⁶ Some legal scholars will have the temerity to contend that the Supreme Court was wrong on issues about which both they and the Court have opinions.⁷ The post-*Eldred* scholarship will undoubtedly include articles dissecting flaws in Justice Ginsburg's opinion or offering narrow interpretations of the decision,⁸ as well as commentary

⁵ See, e.g., Siva Vaidhyanathan, *After the Copyright Smackdown*, Salon, Jan. 17, 2003, available at <http://www.archive.salon.com/tech/feature/2003/01/17/copyright.html> (quoting Shubha Ghosh as predicting that the *Eldred* decision will “deconstitutionalize” copyright policy). See also Justin Hughes, *Of World Music and Sovereign States*, Chi. Loyola L. Rev. (forthcoming 2003)(predicting a significant decline in this scholarly literature after *Eldred*).

⁶ Among the lawyers representing *Eldred* were several law professors who have written about intellectual property issues, including Lawrence Lessig, Edward Lee, William Fisher, and Jonathan Zittrain. Approximately sixty intellectual property scholars were signatories of amicus curiae briefs submitted to the Court in *Eldred*. See Brief Amicus Curiae of Intellectual Property Professors, Brief Amicus Curiae of Historians, and Brief Amicus Curiae of Malla Pollack, all of which are available at <http://eldred.cc/legal/supremecourt.html>. One intellectual property scholar submitted an amicus brief in support of General Ashcroft. See Brief Amicus Curiae of Edward Samuels, available at <http://www.nyls.edu/samuels/copyright/beyond/cases/eldredamicus.htm>. Copyright treatise author Paul Goldstein served as co-counsel on an amicus brief submitted by the American Society of Composers, Authors, and Publishers (ASCAP) et al, available at <http://eldred.cc/legal/supremecourt.html>.

Most of the law review literature on Congress' extension of existing copyright terms argued against its constitutionality. See, e.g., Erwin Chemerinsky, *Balancing Copyright Protections and Free Speech: Why the Copyright Extension Act is Unconstitutional*, 36 Loy. L.A. L. Rev. 83 (2002); Richard A. Epstein, *The Dubious Constitutionality of the Copyright Term Extension Act*, 36 Loy. L.A. L. Rev. 123 (2002); Heald & Sherry, *supra* note 1, Dennis S. Karjala, *Judicial Review of Copyright Term Extension Legislation*, 36 Loy. L.A. L. Rev. 199 (2002); Lawrence Lessig, *Copyright's First Amendment*, 48 UCLA L. Rev. 1057 (2000); Merges & Reynolds, *supra* note 1; Tyler Ochoa, *Patent and Copyright Term Extension and the Constitution: An Historical Perspective*, 49 J. Cop. Soc'y 19 (2002); William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 Geo. Wash. L. Rev. 359 (1999). Some scholars regarded the CTEA as constitutionally sound before the Court so ruled. See, e.g., Edward Samuels, *Eldred v. Ashcroft: Intellectual Property, Congressional Power, and the Constitution*, 36 Loyola L.A. L. Rev. 389 (2002); Symposium, *The Constitutionality of Copyright Term Extension: How Long Is Too Long?*, 18 Cardozo Arts & Ent. L.J. 651 (2000) (remarks of Jane C. Ginsburg and Arthur Miller).

⁷ See, e.g., Yochai Benkler, *Through the Looking Glass: Alice and the Constitutional Foundations of the Public Domain*, 66 Law & Contemp. Probs. 173 (2003)(criticizing *Eldred* for its misconstruction of the Intellectual Property Clause and flawed understanding of the First Amendment); L. Ray Patterson, *What's Wrong With Eldred? An Essay on Copyright Jurisprudence*, 10 J. Intell. Prop. L. (forthcoming 2003) (criticizing *Eldred's* adoption of a natural rights approach to copyright law rather than the positive law concept that has generally prevailed in U.S. copyright tradition and is most consistent with the U.S. constitutional tradition).

⁸ See, e.g., Stephen McJohn, *Eldred's Aftermath: Tradition, the Copyright Clause, and the Constitutionalization of Fair Use* (criticizing the Court's failure to reconcile *Eldred* with its federalism decisions and suggesting that nontraditional copyright rules may be subject to heightened First Amendment scrutiny after *Eldred*) (manuscript on file with the author).

arguing that the outcome in *Eldred* decision was sound but should have been based on a different rationale.⁹ The boldest may even see in *Eldred* some ammunition for other challenges to intellectual property rules.¹⁰ The pre-*Eldred* scholarship brought into being many interesting theories, analytical frameworks, and historical arguments that will be grist for the scholarly mill.¹¹ Moreover, several constitutional questions posed in *Eldred*, which the Court chose not to address, have significance for other constitutional challenges to intellectual property rules.¹² Speculation about what the Court will ultimately do with these questions is still fair game for scholarly discussion. The *Eldred* case certainly did not exhaust the range of possible issues in this domain, and some scholarly debate about the constitutional law of intellectual property law may now shift to these other domains.¹³

II. From *Feist* to *Eldred*

The Supreme Court has no one but itself to blame for the burst of scholarly productivity on the constitutional law of intellectual property. In many of its decisions, but particularly in *Feist v. Rural Telephone*,¹⁴ the Court has waxed eloquent about the

⁹ See, e.g., Paul M. Schwartz & William Michael Treanor, *Eldred and Lochner: Copyright Term Extension and Intellectual Property as Constitutional Property*, 112 Yale L. J. (forthcoming 2003) (arguing that because copyright is a form of constitutional property, it should be subject to deferential review as other constitutional property has been); Thomas B. Nachbar, *Judicial Review and the Quest to Keep Copyright Pure* (manuscript on file with the author) (arguing that the Court was right to reject *Eldred*'s challenge because courts are ill-suited to making political judgments about copyright law).

¹⁰ See, e.g., Jack Balkin, *Is the Digital Millennium Copyright Act Unconstitutional Under Eldred v. Ashcroft?*, available at http://balkin.blogspot.com/2003_01_12_balkin_archive.html (Jan. 17, 2003); Michael D. Birnhack, *Copyright Law and Free Speech After Eldred v. Ashcroft*, 76 S. Cal. L. Rev. (forthcoming 2003); Alfred C. Yen, *Eldred, the First Amendment, and Aggressive Copyright Claims*, Houston L. Rev. (forthcoming 2004). See *infra* notes 98-128 and accompanying text for further discussion.

¹¹ For example, a lively literature has emerged on what the Framers meant (or should be understood to have meant) by the "progress" that Congress is supposed to be promoting through grants of exclusive rights under the Intellectual Property Clause. See, e.g., Michael D. Birnhack, *The Idea of Progress in Copyright Law*, 1 Buffalo Intell. Prop. L.J. 3 (2001) (discussing the meaning of progress in political theory from the Enlightenment to contemporary copyright law); Malla Pollack, *What is Congress Supposed to Promote?: Defining "Progress" in Article I, Section 8, Clause 8 of the United States Constitution, or Introducing the Progress Clause*, 80 Neb. L. Rev. 754 (2001) (arguing that the progress meant the dissemination of knowledge at the time the Constitution was adopted, not quantitative or qualitative advancement, as some commentators have assumed); Julie E. Cohen, *Copyright and the Perfect Curve*, 53 Vand. L. Rev. 1799 (2000) (criticizing certain models of progress in copyright as an oversimplification the economics of creativity); Edward C. Walterscheid, *Conforming the General Welfare Clause and the Intellectual Property Clause*, 13 Harv. J. Law & Tech. 87 (1999) (discussing views of the Framers about Congressional powers to promote progress of science and the useful arts and to promote the general welfare); Margaret Chon, *Postmodern "Progress": Reconsidering the Copyright and Patent Power*, 43 DePaul L. Rev. 97 (1993) (arguing for a postmodern interpretation of progress requiring access to knowledge preserved in the public trust). Given that the Supreme Court provided little guidance on this in *Eldred*, discussion and debate about the meaning of this term may continue. See also Michael D. Birnhack, *The Copyright Law and Free Speech: Making-Up and Breaking-Up*, 43 IDEA: J. L. & Tech. 233 (2003) (analyzing denials of conflicts between copyright and the First Amendment in Freudian terms). See also Birnhack, *supra* note 10 (post-*Eldred* analysis of conflict denial).

¹² See *infra* notes 51-52 and 73-96 and accompanying texts.

¹³ See *infra* notes 97-153 and accompanying text.

¹⁴ *Feist Pub., Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991).

constitutional underpinnings of intellectual property law and limitations inherent in the Intellectual Property Clause.¹⁵ The *Feist* decision was, in fact, a linchpin of Eldred's challenge to the CTEA.¹⁶

A unanimous Supreme Court in *Feist* invoked the U.S. Constitution at least thirteen times,¹⁷ saying, among other things, that "originality is a constitutionally mandated prerequisite for copyright protection."¹⁸ The constitutional analysis in *Feist* came as a surprise to many intellectual property scholars because there was an adequate statutory basis for the Court's ruling that copyright law did not allow Rural to protect the white pages listings of its telephone directories.¹⁹ The Copyright Act of 1976 defined the term "compilation" as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship."²⁰ For Rural's "sweat of the brow" theory of "originality" to be statutorily sound, this definition would have had to stop at the first reference to "data."²¹ Because the definition went on to require selection, coordination and arrangement and a resulting work that was original, it was fair to conclude that Congress had intended to establish a creativity-based standard of originality as a criterion for copyright protection for compilations of information.²²

¹⁵ See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966) ("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. Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of...useful Arts.' This is the standard expressed in the Constitution and it may not be ignored."); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) ("The Patent Clause itself reflects a balance between the need to encourage innovation and the avoidance of monopolies which stifle competition without any concomitant advance in the 'Progress of Science and useful Arts.'"); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 431-32 (1984) ("The limited scope of the copyright holder's statutory monopoly, like the limited copyright duration required by the Constitution, reflects a balance of competing claims upon the public interest: Creative work is to be encouraged and rewarded, but private motivation must ultimately serve the cause of promoting broad public availability of literature, music, and the other arts. The immediate effect of our copyright law is to secure a fair return for an 'author's' creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good. 'The sole interest of the United States and the primary object in conferring the monopoly,' this Court has said, 'lie in the general benefits derived by the public from the labors of authors.'" (citations omitted)); *Harper & Row Publ. v. Nation Enterp.*, 471 U.S. 539, 558 (1985) ("the Framers intended copyright itself to be the engine of free expression"). See also Hamilton, *supra* note 2, Appendix C (Copyright Decisions Involving Constitutional Principles).

¹⁶ See Hughes, *supra* note 5 (characterizing *Feist* as a "miscue" that set in motion constitutional challenges to intellectual property rules, such as the CTEA).

¹⁷ See Paul Goldstein, *Copyright*, 38 J. Cop. Off. Soc'y 109, 119 (1991) (noting the 13 references in *Feist* to the Constitution).

¹⁸ *Feist*, 499 U.S. at 351.

¹⁹ See, e.g., Hamilton, *supra* note 2, at 322 (noting the anomaly of *Feist*'s constitutional analysis in view of the Court's general inclination to decide cases on statutory grounds); Paul Heald, *The Vices of Originality*, 1991 Sup. Ct. Rev. 143, 144 (1992) (noting at least four narrower alternative grounds for the *Feist* decision than the constitutional analysis the Court embraced).

²⁰ 17 U.S.C. sec. 101.

²¹ *Feist*, 499 U.S. at 357 (making this point).

²² *Id.*

In support of its constitutional analysis, *Feist* quoted from a law review article that criticized, on constitutional as well as doctrinal grounds, claims of copyright in legal decisions and statutes,²³ thereby seeming to endorse that article's broad constitutional conception of copyright law. *Feist* also resurrected interest in a musty late nineteenth century opinion by relying on *The Trade-Mark Cases*, which held that Congress could not justify enactment of a federal trademark law under the Intellectual Property Clause of the Constitution because trademarks did not satisfy constitutional creativity-based requirements for intellectual property protection.²⁴ *Feist* provided a cornucopia of constitutionally rich dicta such as: "It may seem unfair that much of the fruit of the compiler's labor may be used by others without compensation. As Justice Brennan has correctly observed, however, this is not 'some unforeseen byproduct of a statutory scheme.' It is rather 'the essence of copyright' and a constitutional requirement. The primary objective of copyright is not to reward the labor of authors, but 'to promote the Progress of Science and useful Arts.'"²⁵ It is no wonder, then, that *Feist* set off an intense scholarly debate about the copyright and the Constitution.²⁶

²³ *Feist* quoted from L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. Rev. 719, 763, n.155 (1989) ("The originality requirement is constitutionally mandated for all works.") (emphasis in Court's decision). *Feist*, 499 U.S. at 347. See also *id.* at 348 (further citing Patterson & Joyce).

²⁴ 100 U.S. 82, 94 (1879) ("The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when under the act of Congress it is sought to establish it by registration, neither originality, invention, discovery, science, nor art is in any way essential to the right conferred by that act. If we should endeavor to classify it under the head of writings of authors, the objections are equally strong. In this, as in regard to inventions, originality is required. And while the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints, &c., it is only such as are original, and are founded in the creative powers of the mind. The writings which are to be protected are the fruits of intellectual labor, embodied in the form of books, prints, engravings, and the like. The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it. At common law the exclusive right to it grows out of its *use*, and not its mere adoption. By the act of Congress this exclusive right attaches upon registration. But in neither case does it depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation. We look in vain in the statute for any other qualification or condition. If the symbol, however plain, simple, old, or well-known, has been first appropriated by the claimant as his distinctive trade-mark, he may by registration secure the right to its exclusive use. While such legislation may be a judicious aid to the common law on the subject of trade-marks, and may be within the competency of legislatures whose general powers embrace that class of subjects, we are unable to see any such power in the constitutional provision concerning authors and inventors, and their writings and discoveries."). *The Trade-Mark Cases* were quoted and cited with approval in *Feist*, 499 U.S. at 346-47, 351, 362. The valorization of *The Trade-Mark Cases* in *Feist* gave them new life in arguments about the constitutionality of other intellectual property legislation. See, e.g., Yochai Benkler, *Constitutional Bounds of Database Protection, The Role of Judicial Review in the Creation and Definition of Private Rights in Information*, 15 Berkeley Tech. L. J. 535, 539-49 (2000) (discussing implications of *The Trade-Mark Cases* for sui generis protection of databases).

²⁵ *Id.* at 349 (citation omitted).

²⁶ See, e.g., Symposium, *Copyright Protection for Computer Databases, CD-ROMs, and Factual Compilations, Parts I & II*, 17 U. Dayton L. Rev. 323 (Winter & Spring 1992).

The reaction to *Feist* was quite mixed. Some commentators were enthusiastic about the Court's constitutional interpretation.²⁷ Some agreed with the Court's conclusion, but criticized its rationale.²⁸ Other commentators were less sanguine. Then Register of Copyrights, Ralph Oman stated that the Supreme Court's *Feist* decision had "dropped a bomb" on American copyright law.²⁹ Other commentators suggested that the Court's constitutional analysis could be ignored as dicta,³⁰ and some directly challenged the Court's constitutional interpretation and recommended that Congress enact legislation protecting compilations.³¹

In the decade that followed, *Feist* was widely cited as a significant precedent about the limitations of copyright law in the case law and law review literature about compilations of information³² as well as other controversial copyright issues, such as the proper scope of copyright protection for computer programs.³³ This helps to explain why *Feist* became an important component of Eldred's theory that the Copyright Term Extension Act (CTEA) violated the Intellectual Property Clause of the U.S. Constitution.³⁴ Most succinctly stated, the theory posited that this Clause forbade Congress to grant exclusive rights to anyone without a newly created original work of authorship (or inventive technology) as a quid pro quo to justify the grant. Stanford professor Lawrence Lessig, counsel for Eldred, wove an elegantly complex, yet powerful, argument in support of this theory drawing upon many prior Supreme Court decisions in intellectual property cases with constitutional overtones.³⁵

²⁷ See, e.g., L. Ray Patterson, *Copyright Overextended: A Preliminary Inquiry into the Need for a Federal Statute of Unfair Competition*, 17 U. Dayton L. Rev. 385 (1992); David Lange, *Sensing the Constitution*, 17 U. Dayton L. Rev. 367 (1992).

²⁸ See, e.g., Heald, *supra* note 19 (criticizing *Feist* for its broad constitutional ruling because of its implications for creating appropriate legal protection for compilations of data); Pamela Samuelson, *The Originality Standard for Literary Works Under U.S. Copyright Law*, 42 Am. J. Compar. L. 393, 399-400 (1994)(questioning the epistemology underlying the *Feist* decision's rationale for not protecting facts).

²⁹ See Jessica Litman, *After Feist*, 17 U. Dayton L. Rev. 607, 607 (1992)(quoting Ralph Oman).

³⁰ See, e.g., Dennis S. Karjala, *Copyright and Misappropriation*, 17 U. Dayton L. Rev. 885, 889 (1992).

³¹ See, e.g., Jane C. Ginsburg, *No 'Sweat'? Copyright and Other Protection for Works of Information After Feist v. Rural Telephone*, 92 Colum. L. Rev. 338, 341, 381-83 (1992) (suggesting that Congress had power to enact copyright or copyright-like legal protection for unoriginal databases). See also Goldstein, *supra* note 17, at 119.

³² See, e.g., *CCC Information Services, Inc. v. MacLean Hunter Market Reports, Inc.*, 44 F.3d 61 (2d Cir. 1994)(compilation of automobile resale price evaluations held protectable by copyright); *Warren Pub., Inc. v. Microdos Data Corp.*, 115 F.3d 1509 (11th Cir.)(en banc), cert. denied, 118 S.Ct. 397 (1997)(selection and arrangement of data in cable television factbook held uncopyrightable). See also Samuelson, *supra* note 28, at 397-408 (discussing compilation caselaw after *Feist*).

³³ See, e.g., *Computer Associates, Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 711-12, 721 (2d Cir. 1992)(citing and quoting from *Feist*); *Sega Enterp. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1527 (9th Cir. 1992) (quoting *Feist*). See also Heald, *supra* note 19, at 167-68 (predicting that *Feist* would mean that computer programs would have only thin protection); Samuelson, *supra* note 28, at 408-13 (discussing the implications of *Feist* for computer program copyright cases). One commentator who studied the post-*Feist* caselaw through 2000 found ninety-two decisions citing *Feist*, only eleven of which concerned originality of compilation issues. See Victoria Smith Ekstrand, *Drawing Swords After Feist: Efforts to Legislate the Database Pirate*, 7 Comm. L. & Pol'y 317, 328 (2002).

³⁴ See Brief for Petitioners in *Eldred v. Ashcroft*, at 20-21, 32-33, available at <http://eldred.cc/legal/supremecourt.html> (discussing *Feist*).

³⁵ See *id.* at 11-33 (Copyright Clause argument), 33-47 (First Amendment argument).

The Court's principal reaction in *Eldred* to the intricate architecture of Lessig's argument about the Intellectual Property Clause was this: "To comprehend the scope of Congress' power under the Copyright Clause," said the Court, "a page of history is worth a volume of logic."³⁶ Congress had extended the terms of existing copyrights, as well as of patents, numerous times in the past two centuries, including in 1790.³⁷ "Thus, history reveals an unbroken congressional practice of granting to authors of works with existing copyrights the benefit of term extensions so that all under copyright protection will be governed evenhandedly under the same regime."³⁸ The Court regarded *Feist* as concerning a totally different legal issue.³⁹

Lessig sought to distinguish the CTEA from prior copyright extensions on several grounds,⁴⁰ but the Court seems to have found these distinctions jesuitical. Lessig insightfully pointed out that General Ashcroft's main argument—that Congress believed the CTEA would promote progress because it would induce distribution of older works—had no apparent endpoint.⁴¹ (That is, the argument could as easily be used to justify grants of copyright in the works of Shakespeare or Mozart.⁴²) Yet, Lessig's main argument had no clear endpoint either, so far as the majority could tell. The *Eldred* opinion is laced with expressions of concern that if the Court struck down the CTEA, the next law attacked would likely be the Copyright Act of 1976, which also included copyright term extensions.⁴³ A decision in *Eldred*'s favor would have emboldened constitutional challenges to other copyright rules, and would have had significant spillover effects in litigation about other intellectual property rules as well.⁴⁴ The Court

³⁶ *Eldred*, 123 S.Ct. at 778, quoting *New York Trust Co. v. Eisner*, 256 U.S. 345, 349 (1921).

³⁷ *Eldred*, 123 S. Ct. at 775-76 (discussing copyright extensions), 779-80 (discussing patent extensions).

³⁸ *Id.* at 778.

³⁹ *Id.* at 784 ("*Feist*...did not touch on the duration of copyright protection").

⁴⁰ The first copyright law, enacted in 1790, was meant as a transitional measure to create a uniform federal right and displace state statutory and/or common law protections for authors. The 1831, 1909, and 1976 Acts extended existing copyright terms as part of an overall revision of the copyright laws, rather than as a stand-alone measure. A third category of copyright term extensions was those enacted in anticipation of the revision of the 1976 Act. See Petitioners' Brief, *supra* note 34, at 28-29. See also Addendum to Reply Brief for the Petitioners in *Eldred v. Ashcroft* (chart distinguishing CTEA from other extensions), available at <http://eldred.cc/legal/supremecourt.html>. See also Ochoa, *supra* note 2 (distinguishing the CTEA from prior copyright and patent term extensions).

⁴¹ See, e.g., Reply Brief of Petitioners to the U.S. Supreme Court in *Eldred v. Ashcroft*, available at <http://eldred.cc/legal/supremecourt.html> at 1-2.

⁴² See *Eldred*, 123 S.Ct. at 811 (Breyer's dissent characterized the publisher-based rationale for copyright as "constitutionally perverse" and pointed out that this rationale could be used to justify grants of new copyrights in the works of Mozart and Shakespeare).

⁴³ See, e.g., *id.* at 790 (suggesting that *Eldred*'s theory would make the retrospective copyright term extensions of the 1976 Act vulnerable to challenge). See also *id.* at 788, n. 23 (raising line drawing questions about the implications of *Eldred*'s First Amendment claims for prospective vs. retrospective extensions and for scope of protection issues).

⁴⁴ See, e.g., Heald & Sherry, *supra* note 1 (arguing that some intellectual property laws adopted in recent decades and others that have been proposed may be vulnerable to constitutional challenge); Merges & Reynold, *supra* note 1 (arguing that patent term extensions, as well as copyright term extensions, should be closely scrutinized under the Intellectual Property Clause).

was clearly worried about putting itself in the position of second-guessing Congress on a wide range of intellectual property issues.⁴⁵

Given the history of previous extensions, the lack of an endpoint to Lessig's argument, and Lessig's concession that copyright term extension was constitutionally acceptable prospectively applied,⁴⁶ General Ashcroft's victory was not surprising. The CTEA may have been unwise, said the Court, but it was not unconstitutional.⁴⁷

Viewed from one angle, the *Eldred* case presents a narrow issue of very little significance because copyright term extensions are relatively rare and the extra costs the extensions impose on the public, while substantial in the aggregate, are nevertheless diffuse and relatively invisible.⁴⁸ Viewed from another angle, the *Eldred* case could not have been more significant. The government argued in *Eldred* that Congress had virtually unfettered power to enact intellectual property legislation under the Intellectual Property clause, whereas *Eldred* argued that the Clause imposed significant limitations on Congressional power.⁴⁹ Whether the CTEA should be subject to rational basis review or to some form of heightened scrutiny was squarely presented in the *Eldred* case.⁵⁰ The Court's answer to the standard of review question was certain to have significant implications for other potential constitutional challenges to intellectual property rules.

Among the other significant questions presented in *Eldred* were these: If Congress does not have power to enact a particular intellectual property rule under the Intellectual Property Clause, can it invoke its Commerce Clause powers instead?⁵¹ Or does Congress' power to regulate foreign commerce allow it to enact legislation that

⁴⁵ See, e.g., Schwartz & Treanor, *supra* note 9.

⁴⁶ *Eldred*, 123 S.Ct. at 778.

⁴⁷ Courts are "not at liberty to second-guess congressional determinations and policy judgments . . . , however debatable or arguably unwise they may be." *Id.* at 783. Calibrating economic impacts of copyright legislation was, in the Court's view, a task the Constitution had assigned to Congress. *Id.* at 782-83.

⁴⁸ See *id.* at 804 (Breyer's dissent cited a study estimating that the CTEA would result in a transfer of "several billion extra royalty dollars" to copyright owners).

⁴⁹ See Brief for Respondents to the U.S. Supreme Court in *Eldred v. Ashcroft*, available at <http://eldred.cc/legal/supremecourt.html>; Petitioners' Brief, *supra* note 34.

⁵⁰ See, e.g., Epstein, *supra* note 6 (discussing heightened scrutiny standards).

⁵¹ See, e.g., Brief Amicus Curiae of Intellectual Property Owners to the U.S. Supreme Court in *Eldred v. Ashcroft*, available at <http://eldred.cc/legal/supremecourt.html>. At least one court has ruled that Congress can invoke Commerce Clause powers to enact intellectual property legislation. See *United States v. Moghadan*, 175 F.3d 1269 (11th Cir. 1999)(unsuccessful constitutional challenge to anti-bootlegging law protecting live performances based on failure to satisfy the "writings" requirement of the Intellectual Property Clause; Commerce Clause provided alternative basis for legislation). Some commentators contend there are limits on Congress' ability to use the Commerce Clause to enact intellectual property legislation. See, e.g., Benkler, *supra* note 24; Patry, *supra* note 6. See also Andrew M. Hetherington, *Constitutional Purpose and Inter-Clause Conflict: The Constraints Imposed on Congress by the Copyright Clause*, 9 Mich. Telecomm. Tech. L. Rev. (forthcoming 2003)(suggesting that Congress may have power to adopt some legislation under the Commerce Clause that could not be justified under the Intellectual Property Clause, but that such legislation should be closely scrutinized by courts to ensure that it promotes the progress of science and useful arts).

could not be justified under the Intellectual Property Clause?⁵² Are Congressional judgments under the Intellectual Property Clause, categorically immune from First Amendment challenges, as the D.C. Circuit opined?⁵³ If not, must Congressional judgments about intellectual property rules be subject to strict scrutiny analysis insofar as they favor one set of speakers (e.g., Walt Disney and other major content industry firms) to the detriment of others (e.g., Eric Eldred and his co-plaintiffs)?⁵⁴ Or should intermediate First Amendment scrutiny be applied to the constitutional challenges to IP laws such as CTEA, insofar as the law, although content-neutral (i.e., all existing terms were extended), restricts the free speech/press rights of those who want to make public domain works available to the public or create new works from existing ones (as Disney has so imaginatively done as to public domain fairytales)?⁵⁵

The Supreme Court's *Eldred* decision addressed some, but by no means all, of these questions. By holding that enactment of the CTEA was within the broad powers of Congress under Article I, the Court followed the tradition of deference to Congress' Article I powers.⁵⁶ In addition, the Court rebuffed the First Amendment challenge to the CTEA, saying that copyright's idea/expression distinction and the fair use defense are "generally adequate" to resolve tensions between copyright and free speech interests, including those posed by people such as Eldred who wished to republish other people's speech.⁵⁷ The Court repudiated the D.C. Circuit's conclusion that copyright law was "categorically immune" from First Amendment scrutiny,⁵⁸ and arguably opened up a new basis for First Amendment challenges to copyright rules insofar as they change the "traditional contours" of copyright law.⁵⁹

⁵² See, e.g., Brief Amicus Curiae of International Coalition for Copyright Protection to the U.S. Supreme Court in *Eldred v. Ashcroft*, available at <http://eldred.cc/legal/supremecourt.html>.

⁵³ See *Eldred v. Reno*, 239 F.3d 372, 375 (D.C. Cir. 2001).

⁵⁴ See Reply Brief, *supra* note 41, at 15.

⁵⁵ *Id.* at 16 (pointing to Disney's use of public domain works).

⁵⁶ *Eldred*, 123 S.Ct. at 777-78.

⁵⁷ *Id.* at 789. Two scholars have recently suggested that fair use law should evolve to mediate tensions between copyright term extensions and free speech interests, such as those arising from educational uses of older works. See, e.g., Justin Hughes, *Fair Use Over Time*, 50 UCLA L. Rev. 775 (2003); Joseph P. Liu, *Copyright and Time: A Proposal*, 101 Mich. L. Rev. 409 (2002).

⁵⁸ *Eldred*, 123 S.Ct. at 789-90.

⁵⁹ *Id.* at 790. Birnhack argues that there is a "prima facie conflict" between copyright and the First Amendment, given "the dramatic expansion of copyright law." Birnhack, *supra* note 10, at 234.

The rights accorded to authors are stronger than ever before, their duration has been extended, and they have conquered the digital environment where they have recruited ancillary devices of protection. As our lives go online, we have transferred many daily activities from the analog world to the digital environment, including the acquisition of information, communication with other people, participation in public discourse, entertaining ourselves, and the spending of money. Copyright law affects each of these activities more than ever before, and as the public domain keeps shrinking, it becomes clear that our freedom of speech is affected.

Id. at 234-35. The Court in *Eldred* did not perceive this, but might do so in a different case. See Balkin, *supra* note 10 (suggesting that under *Eldred*, the DMCA anti-circumvention rules are constitutionally suspect because they change the contours of traditional copyright law); Yen, *supra* note 10 (arguing that First Amendment considerations will be more relevant in copyright cases after *Eldred*, rather than less so, insofar as courts or Congress grapple with aggressive copyright claims that would narrow or eliminate fair use).

III. Implications of *Eldred* for Other Constitutional Challenges

The *Eldred* decision will certainly not be the Supreme Court's last word on the constitutional law of intellectual property; it will simply be the first stage of the next chapter on this subject. This section will discuss six challenges to intellectual property rules with constitutional overtones. Some are already underway, while others are likely to be litigated or legislated in the not too distant future. Several of these challenges concern the public domain. Others concern fair uses and related limitations on intellectual property rights.

The Supreme Court was noticeably silent about the constitutional significance of the public domain in *Eldred*, even though two polar opposite conceptions of this domain vied for Supreme Court endorsement. One view holds that the public domain lacks value. Jack Valenti, president of the Motion Picture Association of America (MPAA), epitomized this view when he characterized the public domain as "an orphan."⁶⁰ This view holds that there is too little incentive to invest in preserving or distributing public domain works, and justifies the CTEA as providing a needed inducement to publishers to continue to make these works available to the public.⁶¹ The alternative view is that the public domain is a vast repository of raw material out of which new creations are made and vast repository of a society's cultural heritage from which all should be able to draw once the period of protection that induced the works' creation has expired (or should have).⁶² Many motion pictures, for example, are derivatives of public domain works, and many public domain works (e.g., plays of Shakespeare) continue to be widely available notwithstanding their public domain status.⁶³ In this view, the public domain has a very positive value.

⁶⁰ JESSICA LITMAN, DIGITAL COPYRIGHT 77 (2001)(quoting Valenti). I have argued elsewhere that both views of the public domain are correct and offered a "map" of this domain to facilitate assessment of those parts of the public domain are the most and least socially important. See Pamela Samuelson, *Mapping the Public Domain: Threats and Opportunities*, 66 Law & Contemp. Probs. 147, 147-48, 151 (2003).

⁶¹ See, e.g., Brief of Senator Orrin G. Hatch as Amicus Curiae in Support of Respondent in *Eldred v. Ashcroft*, available at <http://eldred.cc/legal/supremecourt.html> (emphasizing the need for CTEA incentives to distribute and preserve existing older works). See also Brief Amicus Curiae of AOL Time Warner in *Eldred v. Ashcroft*, available at <http://eldred.cc/legal/supremecourt.html> at 27-28 (offering five reasons why the CTEA promotes progress of science and useful arts).

⁶² Among the works taking this positive view of the public domain, see, e.g., James Boyle, *The Second Enclosure Movement and the Construction of the Public Domain*, 66 Law & Contemp. Probs. 33 (2003); Jessica Litman, *The Public Domain*, 39 Emory L.J. 965 (1990); David Lange, *Recognizing the Public Domain*, 44 L. & Contemp. Probs. 147 (Autumn 1981). See generally Symposium, *The Public Domain*, 66 Law & Contemp. Probs. 33 (2003).

⁶³ The Internet Archive, Project Gutenberg, and Intel Corp. joined *Eldred* in emphasizing that the Internet had enhanced the potential for the public domain to be more robust and vital than ever before, and suggested that the Court should consider this in analyzing the significance of the CTEA. See Brief Amicus Curiae The Internet Archive, Prelinger Archive, and Project Gutenberg Literary Archive Foundation in Support of Petitioners in *Eldred v. Ashcroft*, <http://cyber.law.harvard.edu/openlaw/eldredvashcroft/supct/amici/internet-archive.html> ("[I]n the digital world older works are much more likely to be preserved and made available to the public once their copyright expires. The ease and economy of digitally capturing, storing, and distributing have reduced these costs to the point of insignificance. Works in the public domain are being digitized and made freely

Dastar v. Twentieth Century Fox provides the Court with another opportunity to articulate its views about the public domain.⁶⁴ The case concerns a television series entitled “Crusade in Europe” made by Fox in 1949 based upon a book by Dwight Eisenhower about the allied campaign in Europe during World War II. Fox neglected to renew the copyright on this television series, causing it to expire in 1977.⁶⁵ In 1995 Dastar purchased tapes of the Crusade series, edited the material, added some new material, and then commenced selling videotapes under the title “Campaigns in Europe.” Fox sued Dastar, claiming that its sale of the Campaigns series without crediting Fox as the author of the original series constituted reverse passing off under the Lanham Act.⁶⁶

Dastar argues that Campaigns is a derivative of a public domain work and that Fox is seeking to recapture through its Lanham Act claim a proprietary right in this public domain work.⁶⁷ Dastar says Fox has put it in a no-win position: Dastar’s silence about Fox’s authorship is alleged to be unlawful reverse passing off, yet if Dastar credited Fox, the latter would undoubtedly claim that this would confuse consumers into thinking that Fox had authorized it to sell the tapes and sue for passing off.⁶⁸ In Dastar’s view, Fox is indirectly trying to recapture the copyright that expired in 1977.

available at an astonishing rate. By contrast, the overwhelming majority of works from the 1920s and 1930s—those first affected by the CTEA—are not available from copyright owners at any price. Extending the copyright term retroactively gives copyright owners a windfall for a few works that they still consider valuable enough to release, while depriving the world of the benefit of tens of thousands of works each year that digital archives are ready, willing, and able to provide.”); Brief of Amicus Curiae Intel Corp. in Partial Support of Petitioners, available at <http://eldred.cc/legal/supremecourt.html> at 3 (“The capacity and accessibility of connected computing and networking technologies, the creative tools made possible by digital computing, and the eventual software contributions to an already engaged open source community, give unprecedented new meaning to the phrase ‘public domain.’”)

⁶⁴ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 2002 WL 649087 (9th Cir. 2002), cert. granted, 123 S.Ct. 1382 (2003).

⁶⁵ Fox also brought a copyright claim against Dastar. Although Fox failed to renew its copyright in the Crusades series, Doubleday renewed the copyright in Eisenhower’s book. Fox then reacquired a license from Doubleday for television and videotape versions of the book. Fox claimed that Dastar’s Campaigns series infringed the reacquired copyright license Fox obtained from Doubleday. The trial court ruled in favor of Fox’s motion for summary judgment on that claim. However, the Ninth Circuit overturned this ruling on the ground that there was a triable question of fact as to whether Doubleday owned the copyright in Eisenhower’s book as a work made for hire. *Dastar*, 2002 WL 649087 at 2. The copyright issue is not before the Supreme Court.

⁶⁶ The Restatement of Unfair Competition defines the tort of reverse passing off: “One is subject to liability to another under the rule....if, in marketing goods or services manufactured, produced, or supplied by the other, the actor makes a representation likely to deceive or mislead prospective purchasers by causing the mistaken belief that the actor or a third person is the manufacturer, producer, or supplier of the goods or services if the representation is to the likely commercial detriment of the other....” AMERICAN LAW INSTITUTE, RESTATEMENT (3D) OF UNFAIR COMPETITION, sec. 5 (1993). The Ninth Circuit characterized Dastar’s Campaign series as “a bodily appropriation” of the Crusade series, 2002 WL 649087 at 2 (9th Cir. 2002), and ruled that bodily appropriation violated the Lanham Act without regard to consumer confusion. *Id.* at 3.

⁶⁷ See, e.g., Brief for Petitioners, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 2003 WL 367729 (U.S. Brief) at 9.

⁶⁸ *Id.* at 9, 20.

While the case mainly turns on a matter of statutory interpretation,⁶⁹ it is redolent with constitutional overtones, especially in the aftermath of *Eldred*.⁷⁰ Fox's position in *Dastar* is consistent with Valenti's view of the public domain (even if Fox does not directly invoke it), and *Dastar*'s position is consistent with Eldred's view of the public domain. Whatever the Court says about the public domain in *Dastar*, public domain detractors and advocates can be expected to closely scrutinize the decision, and one camp or the other will claim some sort of victory.

Also in the litigation pipeline is a set of constitutional challenges to Congressional legislation "restoring" copyrights in foreign works that were in the public domain for many years because they did not comply with U.S. statutory formalities.⁷¹ The Berne Convention for the Protection of Artistic and Literary Works,⁷² to which the U.S. acceded in 1989, forbids member nations from imposing formalities, such as the requirement that every copy of a copyrighted work contain a standard copyright notice, as a condition of copyright protection.⁷³

The constitutional challenge to the "restoration" of foreign copyrights would seem to have a better chance than Eldred's attack on the CTEA for at least two reasons. First, there is virtually no precedent in the U.S. for conferring copyright protection on works

⁶⁹ The first of two questions the Court has decided to consider is whether Section 43(a) of the Lanham Act, 15 U.S.C. sec. 1125(a)(1), protects creative works from uncredited copying even without the likelihood of consumer confusion. Petitioners' Brief, *supra* note 67, at 1. The second question concerns the enhanced damages that the trial court awarded to Fox for the Lanham Act violation. *Id.*

⁷⁰ *Dastar*'s brief invokes the Constitution repeatedly, saying, for example that "[t]he patent and copyright clause of the Constitution does not allow copyright owners to obtain permanent protection against the copying of their works. It lets Congress grant authors and inventors 'exclusive rights' only 'for limited Times.' After that, imitators may exercise a 'federal right to copy and to use' products that have entered the public domain." *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989)." Petitioners' Brief, *supra* note 67, at 9. See also *id.* at 11 ("For more than a century, this Court has regularly been obliged to remind authors and inventors that the 'limited Times' applicable to their exclusive rights is just that—limited—and may not be extended by imaginative readings of trademark and unfair competition laws.") Even the Solicitor General's brief in support of *Dastar* cloaks its argument partly in constitutional terms. See Brief for the United States as Amicus Curiae Supporting Petitioner, 2003 WL 544536 (U.S. Brief) at 11-13.

⁷¹ Until 1989, publication of copies of original works of authorship without proper copyright notices generally resulted in the dedication of the work to the public domain. Congress "restored" copyrights in motion pictures created in Mexico and Canada in 1993 as part of the North American Free Trade Agreement (NAFTA) Implementation Act, Pub. L. No. 103-182, Sec. 334(a), 107 Stat. 2115. In 1994 Congress extended copyright restoration to all foreign works in the public domain in the U.S. but not in the source country as part of the Uruguay Round Agreements Act, Pub. L. No. 103-465, Sec. 514, 108 Stat. 4976, now codified at 17 U.S.C. sec. 104A. The cases challenging the constitutionality of these restoration provisions are: *Golan v. Ashcroft*, No. 01-B-1854 (BNB) (D. Colo.); *Luck's Music Library v. Ashcroft*, No. 1:01CV02220 (D.D.C.); *Dam Things from Denmark v. Russ Berrie Co.*, No. 0104008 (NHP). See, e.g., Edward Lee, *The Public's Domain: Evolution of Legal Restraints on the Government's Power to Control Public Access Through Secrecy or Intellectual Property*, 55 *Hastings L. J.* (forthcoming 2003)(discussing the legal basis for this challenge).

⁷² Berne Convention for the Protection of Literary and Artistic Works, September 9, 1886, as last revised at Paris, July 24, 1971, and amended in 1979, 828 U.N.T.S. 221.

⁷³ *Id.*, Art. 18.

that have for many years actually been in the public domain.⁷⁴ Second, the Supreme Court has repeatedly stated that the Constitution forbids grants of exclusive rights in that which is already in the public domain.⁷⁵ If the Court rules in favor of *Dastar* and endorses the public domain as a constitutionally valuable repository for creation of new works, this would enhance the prospects for success of “restoration” challenges.

Defenders of the “restoration” of foreign copyrights argue that this action is permissible in view of the broad latitude Congress has to enact copyright legislation under the Intellectual Property Clause.⁷⁶ They also assert that U.S. treaty obligations under the Berne Convention for Protection of Literary and Artistic Works and the treaty power of the Constitution authorize this Congressional action, even if Article I does not.⁷⁷ Whether treaty obligations can override constitutional constraints is an interesting and much contested issue that the courts will have to address in dealing with the “restoration” challenge.⁷⁸ How courts resolve this question will have implications for future legislation

⁷⁴ Congress passed private legislation to resurrect the copyright in Mary Baker Eddy’s writings. Priv. L. No. 92-60, 85 Stat. 857 (1971). However, this law was struck down on establishment of religion grounds. See *United Christian Scientists v. Christian Science Board*, 829 F.2d 1152 (D.C. Cir. 1987). For a discussion of patent term extensions, including patents that had expired or been deemed invalid, see Ochoa, *supra* note 6, at 57-72. In his dissent in *Eldred* Justice Stevens stated that *Graham v. John Deere Co.*, 383 U.S. 1 (1966) had overridden old case law upholding patent term extensions. *Eldred*, 123 S.Ct. at 796-97. The majority opinion characterized this interpretation of *Graham* as “wishful thinking.” *Id.* at 779, n. 7.

⁷⁵ See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 5-6 (1966) (“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. Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must ‘promote the Progress of...useful Arts.’ This is the standard expressed in the Constitution and it may not be ignored.”); *Bonito Boats, Inc. v. Thundercraft Boats, Inc.*, 489 U.S. 141, 146 (1989). See also Lee, *supra* note 71 (arguing that the public domain principle applies equally well to subject matters of copyright as well as of patent protection).

⁷⁶ See *Eldred*, 123 S.Ct at 781 (giving substantial deference to Congressional decisions on copyright legislation). See also *id.* at 781-82 (giving attention to international considerations as partly justifying enactment of the CTEA).

⁷⁷ See, e.g., Memorandum in Support of Defendant’s Motion to Dismiss for Failure to State a Claim on Which Relief Can Be Granted, *Golan v. Ashcroft*, Civ. No. 01-B-1854 (Dec. 13, 2001)(on file with the author)(“The URAA is also an acceptable exercise of the power of the United States to make and implement treaties.”). In support of this proposition, the government relies on *Missouri v. Holland*, 252 U.S. 416, 432 (1920)(“If the treaty is valid, there can be no dispute about the validity of the [implementing] statute under Article I, sec. 8, as a necessary and proper means to execute the powers of the Government.”) But see *Reid v. Covert*, 354 U.S. 1, 16-18 (1957)(noting that nothing in the language of the Supremacy Clause “intimates that treaties...do not have to comply with the provisions of the Constitution....[*Holland*] carefully noted that the treaty involved was not inconsistent with any specific provision of the Constitution”).

⁷⁸ See, e.g., Heald & Sherry, *supra* note 1, at 1182-83 (arguing that Congress’ restoration of foreign copyrights cannot be justified under the treaty power); Thomas Healy, Note, *Is Missouri v. Holland Still Good Law? Federalism and the Treaty Power*, 98 Colum. L. Rev. 1726 (1998)(discussing recent Supreme Court decisions that call *Holland v. Missouri* into question). For a thorough analysis of *Missouri v. Holland* vis-à-vis federalism issues, see Curtis A. Bradley, *The Treaty Power and American Federalism*, 97 Mich. L. Rev. 390 (1998)(challenging the nationalist view that the Constitution allows the federal government to enter into binding treaties without regard to subject matter or federalism limitations); Daniel Golove, *Treaty-Making and the Nation: The Historical Foundations of the Nationalist Conception of the Treaty Power*, 98 Mich. L. Rev. 1075 (2000)(defending the nationalist view).

implementing other international treaties, such as one currently under consideration to protect folklore and traditional knowledge.⁷⁹

The constitutional significance of the public domain would almost certainly be debated in any constitutional challenge to database protection legislation akin to the “sui generis” (of its own kind) legal regime adopted in 1996 in the European Union.⁸⁰ Under the European Directive on the legal protection of databases, firms that invest substantial resources in making a database have fifteen years of exclusive rights to control the extraction and reuse of data from the databases.⁸¹ Making further investments in database development (e.g., by updating the contents or reformatting the data) gives rise to renewed periods of protection under the Directive, seemingly allowing database developers to enjoy perpetual protection as long as they update or maintain their databases.⁸²

The EU Directive, in effect, creates an intellectual property right in the data in databases.⁸³ Although this intellectual property right is tempered by a non-waivable right of lawful users to take insubstantial parts,⁸⁴ the Directive provides no criteria for determining which extractions or reuses are “insubstantial,” and indicates that substantiality may be judged in qualitative or quantitative terms.⁸⁵ The purpose of the extraction or reuse of the data, always an important factor in U.S. fair use law, is

⁷⁹ See, e.g., Christine Haight Fairley, *Protecting Folklore of Indigenous Peoples: Is Intellectual Property Law the Answer?*, 30 Conn. L. Rev. 1 (1997); Paul Kurak, *Protecting Folklore Under Modern Intellectual Property Regimes: A Reappraisal of the Tensions Between Individual and Communal Rights in Africa and the United States*, 48 Am. U. L. Rev. 769 (1999). See also Lester I. Yano, Comment, *Protection of the Ethnobiological Knowledge of Indigenous People*, 41 UCLA L. Rev. 443 (1993).

⁸⁰ European Parliament and Council Directive 96/9/EC of 11 March 1996 on the Legal Protection of Databases, 1996 O.J. (L 77) 20, available at http://europa.eu.int/comm/internal_market/en/intprop/docs/. Some scholars have concluded that EU-style database protection would be unconstitutional in the U.S. See, e.g., Benkler, supra note 24, at 580-83; Marci A. Hamilton, *A Response to Professor Benkler*, 17 Berkeley Tech. L.J. 605, 627-28 (2000); Heald & Sherry, supra note 1, at 1178; Malla Pollack, *The Right To Know?: Delimiting Database Protection At The Juncture of The Commerce Clause, The Intellectual Property Clause, and The First Amendment*, 17 Cardozo Arts & Ent. L.J. 47, 50 (1999); J.H. Reichman and Pamela Samuelson, *Intellectual Property Rights In Data?*, 50 Vand. L. Rev. 51, 56 (1997). However, other scholars disagree. See, e.g., Ginsburg, supra note 30, at 381-83. See also James Weinstein, *Database Protection and the First Amendment*, 28 U. Dayton L. Rev. (forthcoming 2003) (arguing that database protection legislation is consistent with the First Amendment).

⁸¹ Database Directive, supra note 80, arts. 7, 10. The Directive was intended both to induce new investments in database development and to harmonize the laws of member states of EU about both copyright and sui generis protection for databases. *Id.*, recitals 1-12. For an assessment of the impacts of this law on the database industry in the EU, see P. Bernt Hugenholtz, Stephen M. Maurer & Harlan J. Onsrud, *Europe's Database Experiment*, 294 Science 789 (2001).

⁸² Database Directive, supra note 80, art. 10(3).

⁸³ See, e.g., Benkler, supra note 24, at 564-65; Reichman & Samuelson, supra note 80, 87-89 (arguing that the EU sui generis database right creates exclusive rights in data in databases).

⁸⁴ Database Directive, supra note 80, art. 8. Member states of the EU are also allowed under the Directive to adopt one or more of three other exceptions: one allowing private use extractions from non-electronic databases, one allowing extractions and reuses for scientific research or teaching purposes, and one for extractions and reuses for public security, administrative, or judicial purposes. *Id.*, art. 9.

⁸⁵ *Id.*, arts. 7, 8. See, e.g., Reichman & Samuelson, supra note 80, at 91-94 (expressing skepticism about the Directive's insubstantial part exception and the three public interest exceptions the Directive allows).

apparently irrelevant in determining whether an “insubstantial part” of a database has been appropriated under the EU Directive.⁸⁶

The principal reason to question the constitutionality of EU-style database legislation derives from the Supreme Court’s unanimous decision in *Feist*.⁸⁷ As noted above, *Feist* invoked the Constitution repeatedly in ruling that a creativity-based originality standard was necessary before copyright protection could be granted to compilers of data.⁸⁸ Presumably, this would preclude a copyright-like form of legal protection for data compilations as well.

Constitutional concerns have caused proponents of EU-style database legislation to redraft the grant of rights provision and claim the revised bill as a regulation of unfair competition.⁸⁹ U.S. critics of EU-style database legislation contend that the unfair competition characterization is misleading, and argue that legislation, which effectively grants copyright-like exclusive rights in informational works, must meet constitutional standards, even if the term “exclusive rights” is omitted from the statutory grant.⁹⁰

If the Court believed that Congress was invoking the Commerce Clause in order to circumvent constitutional limitations on its powers under the Intellectual Property Clause, the Court might be disinclined to permit this subterfuge.⁹¹ The Court might also

⁸⁶ Cf. *id.*, art. 7; 17 U.S.C. sec. 107 (U.S. fair use provision). One recent German case, *Mainpost v. NewsClub*, held that deep-linking to information within a site violates the German database right. Munich Upper Court, July 5, 2002, translated opinion available at <http://www.newsbooster.com/?pg=judge&lan=eng>. For a synopsis of case law under the EU Database Directive, see, e.g., P. Bernt Hugenholtz, *The New Database Right: Early Case Law from Europe*, available at <http://www.ivir.nl/publications/hugenholtz/fordham2001.html>.

⁸⁷ 499 U.S. 340 (1991).

⁸⁸ See *supra* note 17 and accompanying text.

⁸⁹ See Collections of Information Anti-Piracy Act, H.R. 354, 106th Cong., (1999). See, e.g., Hamilton, *supra* note 79, at 619 (attributing the redrafting and recharacterization of database legislation to concerns about the likely unconstitutionality of copyright-like *sui generis* protection for databases because of *Feist*).

⁹⁰ See, e.g., Benkler, *supra* note 24, at 580-83. Although Benkler argues that H.R. 354 is unconstitutional, he regards a narrower and true unfair competition bill, H.R. 1858, 106th Cong. (1999) to be constitutional. Hamilton, however, regards both bills as unconstitutional. Hamilton, *supra* note 80, at 627-28. It is interesting to note that the EU initially considered an unfair competition model for *sui generis* database protection, but ultimately adopted an exclusive property rights approach. See Samuelson & Reichman, *supra* note 80, at 76-84 (discussing this transformation).

⁹¹ See, e.g., Benkler, *supra* note 24, at 600; Heald, *supra* note 19, at 168-75 (concluding that the Intellectual Property Clause limits Congress’ power under the Commerce Clause to enact copyright-like protection for unoriginal compilations of data). However, some commentators argue that the Commerce Clause can provide a constitutional basis for database legislation. See, e.g., Michael B. Gerdes, Comment, *Getting Beyond Constitutionally Mandated Originality as a Prerequisite for Federal Copyright Protection*, 24 *Ariz. St. L.J.* 1461 (1992)(concluding that Congress could protect unoriginal compilations of data under its Commerce Clause powers); Ginsburg, *supra* note 30 (Commerce Clause would permit compensatory scheme to protect database developers). *Feist* recognized that collections of information could be properly protected against market-destructive appropriations by unfair competition law, citing to *International News Service v. Associated Press*, 248 U.S. 215 (1918)(INS held liable for unfair competition based on appropriation of “hot news” from Associated Press). See *Feist*, 499 U.S. at 354.

be troubled by the ongoing renewability of database rights upon new expenditures given the “limited Times” requirement of the Intellectual Property Clause.⁹²

The Court might also be more attentive to a First Amendment challenge to EU-style database legislation than was to this kind of challenge to the CTEA. The *Eldred* decision makes clear that the exclusion of ideas and information from the scope of copyright protection is essential to the general compatibility of copyright law and the First Amendment.⁹³ Database protection legislation that, in effect, removes information and data from the public domain and proprietizes them would raise serious First Amendment concerns.⁹⁴ Given the exceptionally broad EU definition of “database” as “a collection of independent works, data or other materials arranged in a systematic or methodical way and individually accessible by electronic or other means,”⁹⁵ the Court might well be troubled by legislation that would permit publishers to recapture proprietary rights in public domain works simply by spending money to package them together.⁹⁶

While it is fair to read *Eldred* to mean that legislative changes to copyright and patent law will generally be subject to rational basis review, it is far from clear that the same standard would or should apply to constitutional challenges to sui generis intellectual property legislation, such as database protection, insofar as it dramatically changes the contours of traditional intellectual property law.⁹⁷ Perhaps such laws should be subject to heightened scrutiny akin to that which the Second Circuit Court of Appeals

⁹² See, e.g., Jonathan Band, *Armageddon on the Potomac: The Collections of Information Anti-Piracy Act*, D-Lib. Mag., vol. 5, issue 1 (Jan. 1999), available at <http://www.dlib.org/dlib/january99/01band.html> (raising constitutional concerns about the perpetual nature of protection for databases under EU-style legislation); Reichman & Samuelson, *supra* note 80, at 56 (arguing that EU-style database protection would be unconstitutional in the U.S. because of its perpetual character). See also Statement of Andrew Pincus, General Counsel of the U.S. Dept. of Commerce before the Subcommittee on Courts and Intellectual Property of the House Judiciary Committee, on H.R. 354, March 18, 1999, available at <http://www.uspto.gov/web/offices/dcom/olia/hr354.html> (suggesting changes to database legislation to deal with the problematic perpetual nature of EU-style database protection).

⁹³ *Eldred*, 123 S. Ct. at 789.

⁹⁴ See, e.g., Benkler, *supra* note 24, at 587-600 (concluding that under intermediate scrutiny H.R. 354 would not satisfy First Amendment standards because it is not narrowly drawn to accomplish an important government purpose); Pollack, *supra* note 80, at 82-89 (accord). But see Weinstein, *supra* note 80 (arguing that database protection is consistent with the First Amendment, taking issue with Benkler’s conception of the First Amendment).

⁹⁵ Database Directive, *supra* note 80, art. 1(2). This definition was expressly intended to include literary, artistic, musical and other collections of works or material such as texts, sound, images, or numbers. *Id.*, recital 17. H.R. 354 defined “information,” compilations of which it intended to protect, as “facts, data, works of authorship, or any other intangible material capable of being collected and organized in a systematic way.” H.R. 354, 106th Cong. (1999).

⁹⁶ See, e.g., Lee, *supra* note 71 (discussing Supreme Court decisions affirming the constitutional significance of the public domain); Hamilton, *supra* note 80, at 620.

⁹⁷ See *supra* note 59 and accompanying text (discussing changed contours as a constitutionally significant factor calling for closer judicial scrutiny in *Eldred*).

applied in *Universal City Studios, Inc. v. Corley* when assessing a First Amendment challenge to the Digital Millennium Copyright Act anti-circumvention provisions.⁹⁸

The DMCA forbids circumvention of access controls used by copyright owners to protect their works as well as development and distribution of technologies primarily designed to circumvent technical measures used to protect copyrighted works.⁹⁹ Corley, a journalist, posted machine-executable versions of a computer program known as DeCSS on the Internet as part of his magazine's coverage of a controversy about the development of DeCSS.¹⁰⁰ The controversy concerned a Norwegian teenager who reverse engineered the Content Scramble System (CSS), an encryption program used by major motion picture studios to protect DVD movies. This teenager figured out how CSS worked, developed the DeCSS program to bypass CSS, and then posted the program on the Internet, to the dismay of major motion picture studios.¹⁰¹ Corley's principal defense was that DeCSS was First Amendment-protected speech that he had a constitutional right to republish.¹⁰² Corley also argued that the DMCA was unconstitutional under the First Amendment because it did not permit fair uses of copyrighted works.¹⁰³

The Second Circuit responded to Corley's code-as-speech argument by opining that the functionality of computer program code limited the scope of First Amendment protection programs such as DeCSS could enjoy,¹⁰⁴ and that lesser First Amendment protection should be accorded to this program because the Internet was such a dangerous place for copyright owners.¹⁰⁵ The court responded to the lack-of-fair-use argument by questioning whether fair use was constitutionally required,¹⁰⁶ and concluding that the DMCA was narrowly tailored enough to satisfy constitutional standards.¹⁰⁷

⁹⁸ *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 454-55 (2d Cir. 2000)(analyzing the constitutionality of 17 U.S.C. sec. 1201(a)(2) insofar as it forbade republication of certain computer programs on the Internet).

⁹⁹ 17 U.S.C. sec. 1201 (a)(1)(A), 1201(a)(2), 1201 (b)(1). These rules and the legislative history pertaining to them are discussed at some length in Pamela Samuelson, *Intellectual Property and the Digital Economy: Why the Anti-Circumvention Regulations Need To Be Revised*, 14 Berkeley Tech. L.J. 519 (1999).

¹⁰⁰ *Corley*, 273 F.3d at 436-39. As the Second Circuit observed, "2600.com was only one of hundreds of web sites that began posting DeCSS near the end of 1999." *Id.* at 439. The posting of DeCSS on the Internet has also been challenged as a misappropriation of trade secrets. See *DVD Copy Control Association v. McLaughlin*, 2000 WL 48512 (Cal. Super. Ct. 2000), rev'd sub nom., *DVD Copy Control Ass'n v. Bunner*, 93 Cal. App.4th 648, 113 Cal. Rptr.2d 338 (2001), appeal granted, 117 Cal. Rptr.2d 167, 41 P.3d 2 (2002). DVD CCA's theory is that reverse engineering of the Content Scramble System constituted trade secret misappropriation because it was done in violation of a shrinkwrap license restriction and further that Bunner and his 520 co-defendants knew or should have known that DeCSS embodied or was substantially derived from stolen CSS trade secrets. *Bunner* is discussed infra notes 125-27 and accompanying text.

¹⁰¹ *Corley*, 273 F.3d at 437 (discussing the development of DeCSS).

¹⁰² *Id.* at 454. The Second Circuit's discussion of computer programs as First Amendment protected speech was quite extensive. *Id.* at 445-50.

¹⁰³ *Id.* at 458.

¹⁰⁴ *Id.* at 451-52. The Second Circuit's conclusion is criticized at length in David McGowan, *The Code-Speech Conundrum*, 64 Ohio St. L.J. (forthcoming 2003)

¹⁰⁵ *Corley*, 279 F.3d at 453.

¹⁰⁶ *Id.* at 458 ("we note that the Supreme Court has never held that fair use is constitutionally required," although going on to say that "[w]e need not explore the extent to which fair use might have constitutional protection, grounded on either the First Amendment or the Copyright Clause, because whatever validity a

The Second Circuit's First Amendment analysis in *Corley* was disappointingly weak and arguably wrong, ignoring, as it did, almost completely the journalistic character of Corley's publication¹⁰⁸ and failing also to consider a variety of other contextual factors (including whether source and object code forms of programs should be treated differently for First Amendment purposes).¹⁰⁹ It is, moreover, difficult to square the Second Circuit's view that the dangerousness of the Internet means that lesser First Amendment protection should be accorded to Corley's posting of information on the Internet, given that the Supreme Court in *Reno v. ACLU* held that Internet-based communications should enjoy the highest form of First Amendment protection.¹¹⁰ For most Americans, the societal interest in protecting children from harmful material on the Internet is a far more compelling a governmental interest than protecting copyrights.¹¹¹ If the First Amendment constrained Congressional power when protecting children, it should also constrain what Congress can do to protect copyrights.

The Second Circuit did not consider whether the DMCA anti-circumvention rules were beyond Congress' power under the Intellectual Property Clause.¹¹² On the face of it, these rules are difficult to square with the Intellectual Property Clause because they grant exclusive rights of unlimited duration, without requiring a showing of originality or invention, and they forbid, rather than require, disclosure of the protected technological innovation.¹¹³ The *Eldred* decision emphasized the constitutional importance of these dimensions of the Intellectual Property Clause.¹¹⁴ Hence, the DMCA seems vulnerable to

constitutional claim might have as to an application of the DMCA that impairs fair use of copyrighted materials, such matters are far beyond the scope of this lawsuit...").

¹⁰⁷ *Id.* at 454.

¹⁰⁸ See, e.g., McGowan, *supra* note 104, (criticizing the *Corley* decision for failure to give weight to the journalistic character of Corley's actions).

¹⁰⁹ *Id.* (developing a rich, contextual argument that Corley had a viable First Amendment defense).

¹¹⁰ *Reno v. American Civil Liberties Union*, 521 U.S. 844, 870 (1997) ("our cases provide no basis for qualifying the level of First Amendment scrutiny that should be applied to this medium [i.e., the Internet].")

¹¹¹ The Supreme Court accepted that the government had a compelling interest in protecting children from indecent and obscene materials. *Id.* at 869-70.

¹¹² *Corley*, 279 F.3d at 444-45 (declining the opportunity to rule on the Intellectual Property Clause argument because it was made for the first time in a footnote in Corley's appellate brief).

¹¹³ See, e.g., Brief Amicus Curiae of Copyright Property Professors In Support of Plaintiff's Opposition to Defendant's Motion for Partial Summary Judgment, 321 Studios v. Metro-Goldwyn-Mayer Studios, Inc., (on file with the author) (arguing that the DMCA is unconstitutional under the Intellectual Property Clause). One judge has ruled that the DMCA is constitutional under the Intellectual Property Clause. See *United States v. Elcom, Ltd.*, 203 F. Supp.2d 1111, 1127-42 (N.D. Cal. 2002). However, this decision was rendered before *Eldred*, and did not have the benefit of *Eldred*'s insights or recent commentary questioning the DMCA under the Intellectual Property Clause. See, e.g., Craig Allan Nard, *The DMCA's Anti-Device Provisions: Impeding the Progress of the Useful Arts*, 8 Wash. U. J. L. & Pol'y 19, 34-35 (2002); L. Ray Patterson, *The DMCA: A Modern Version of the Licensing Act of 1662*, 10 J. Intell. Prop. L. 33, 57 (2002); Eugene R. Quinn, *An Unconstitutional Patent in Disguise: Did Congress Overstep Its Constitutional Authority in Adopting the Circumvention Prevention Provisions of the Digital Millennium Copyright Act?*, 41 Brandeis L.J. 33, 37 (2002). For a discussion of ways in which the DMCA rules outlaw access to and disclosure of information, see, e.g., Pamela Samuelson and Suzanne Scotchmer, *The Law and Economics of Reverse Engineering*, 111 Yale L.J. 1575, 1630-31, 1642-46 (2002).

¹¹⁴ *Eldred*, 123 S.Ct. at 778-79, 784, 786 (discussing the Intellectual Property Clause as to limited times, creativity standards, and disclosure).

challenge for failure to abide by these limits.¹¹⁵ Moreover, to the extent that the DMCA dramatically expands the contours of copyright protection without fair use limitations to mediate tensions with free speech values,¹¹⁶ the *Eldred* decision raises serious questions about the constitutional compatibility of the DMCA with the First Amendment.¹¹⁷ In light of *Eldred*'s constitutionalization of fair use law,¹¹⁸ the Second Circuit should not have been so dismissive of the constitutional challenge to the DMCA based on the absence of fair use limitations.

Even if the DMCA anti-circumvention rules could withstand a facial challenge under the Intellectual Property Clause, the First Amendment may limit the reach of the DMCA rules as applied to some defendants. Consider, for example, the First Amendment defense that Professor Edward Felten and his co-authors could have raised if the Recording Industry Association of America (RIAA) had followed through on its threat to sue Felten et al. for violating the DMCA for presenting and publishing a paper at a scholarly conference about flaws in digital watermarking technologies that RIAA firms planned to use to protect digital music.¹¹⁹ Consider also the First Amendment as a defense to a DMCA claim brought against the author of an educational website entitled a "Gallery of CSS Descramblers," which displays various expressions of ideas about ways of defeating CSS.¹²⁰ Under the trial and appellate court decisions in *Corley*, this gallery would seem to violate the DMCA proscriptions.¹²¹ Yet, the First Amendment would, in

¹¹⁵ See supra note 113 and accompanying text.

¹¹⁶ *Eldred*, 123 S.Ct. at 789-90 ("when...Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is not necessary"). As Balkin observed, "for those of us who think the DMCA is a bad statute, *Eldred* creates a new argument for its repeal or for a constitutional challenge." Balkin, supra note 10. Scholars may debate whether the DMCA anti-circumvention rules are an expansion of copyright protection, a sui generis (of its own kind) form of intellectual property protection, or a "paracopyright" form of protection, see id. But the First Amendment surely limits Congress' power no matter which characterization is most apt.

¹¹⁷ Balkin, supra note 10 (arguing that the DMCA alters traditional bounds of copyright in two ways. "First, it creates a new property right that allows copyright owners to do an end run around fair use, effectively shrinking the public domain. Second, it extends that property right to prohibit the use and dissemination of technologies that would protect fair use and vindicate fair use rights. Congress has exceeded the traditional bounds of copyright protection, superimposing a new form of intellectual property protection that undermines the 'built-in free speech safeguards' crucial to the holding in *Eldred*." See also, Benkler, supra note 2; Ginsburg, supra note 2; Lunney, supra note 2; Netanel, supra note 2 (emphasizing the lack of fair use limits as a constitutional deficiency of the DMCA).

¹¹⁸ See supra note 57 and accompanying text.

¹¹⁹ Felten and his coauthors sought a declaratory injunction that their paper did not violate the DMCA and that they had a First Amendment right to present and publish the paper. See Complaint, Felten v. Recording Industry Ass'n of America, Case No. CV-01-2669 (GEB) (D. N.J. June 6, 2001), available at http://www.eff.org/IP/DMCA/Felten_v_RIAA/20010606_eff_felten_complaint.html. After the RIAA withdrew its objections to presentation of the paper, this lawsuit was dismissed. See, e.g., Joseph P. Liu, *The DMCA and the Regulation of Scientific Research*, 17 Berkeley Tech. L.J. (forthcoming 2003). See also Pamela Samuelson, *Anti-Circumvention Rules Threaten Science*, 293 Science 2028 (Sept. 2001); Fred von Lohmann, *Unintended Consequences: Four Years Under the DMCA* (January 2003), available at http://www.eff.org/IP/DMCA/20030102_dmca_unintended_consequences.html.

¹²⁰ See, e.g., Gallery of CSS Descramblers, available at <http://www-2.cs.cmu.edu/~dst/DeCSS/Gallery/> (last visited May 9, 2003).

¹²¹ Touretzky's Gallery website shows various expressions of ways to descramble the same CSS code that DeCSS descrambles. Since the courts in *Corley* enjoined posting of source as well as object code forms of

my view, shield the author of this site from liability. The First Amendment should also protect copyright professor Jane Ginsburg against a DMCA claim based on a link on her copyright course website to sites where DeCSS could be found.¹²² People who wear T-shirts emprinted with the source code of DeCSS as an expression of protest against the DMCA and the motion picture industry's litigation to suppress DeCSS should have viable First Amendment defenses to DMCA claims.¹²³

Moreover, the Second Circuit's First Amendment analysis of code-as-speech in *Corley* is, as the court recognized,¹²⁴ inconsistent with a California Court of Appeal ruling in *DVD Copy Control Association v. Bunner*.¹²⁵ Bunner, like Corley, posted DeCSS on his website, and like Corley, Bunner claimed a First Amendment right to do so.¹²⁶ Unlike Corley, however, Bunner won (at least so far). *Bunner* and *Corley* do, of course, differ in some respects: Bunner is charged with trade secret misappropriation, not a DMCA violation; he posted source code, not object code; and the California Court of Appeal was reviewing a preliminary, not a permanent, injunction. Yet, the California Court of Appeal ruled that DeCSS was First Amendment protected speech and that Bunner had a right to republish it.¹²⁷ Yet, because the Second Circuit enjoined Corley from publishing DeCSS in source as well as object code form,¹²⁸ there is no way to reconcile these two decisions.

Beyond the code-as-speech issue, Bunner fits the profile of trade secret defendants who have won on First Amendment grounds: Bunner did not himself misappropriate the secret; he obtained the secret without violating the law; and he sought to publish the information to communicate its contents with others.¹²⁹ Bunner may win

DeCSS, many, even if not all, CSS descrambler expression would seem to be equally vulnerable to challenge under the DMCA.

¹²² See, e.g., Ginsburg, *supra* note 2 (mentioning the link this professor created on her copyright course website to a website where DeCSS could be found). The Second Circuit in *Corley* upheld an injunction against linking to, as well as posting of, DeCSS, and questioned whether a heightened First Amendment standard should be applied to DMCA claims of liability for linking. *Corley*, 279 F.3d at 456-58.

¹²³ See, e.g., Gallery, *supra* note 120 (giving example of T-shirt with source code of DeCSS printed on the front). Such shirts can be purchased at

http://www.copyleft.net/item.phtml?page=product_1174_front.phtml (last visited May 9, 2003).

¹²⁴ *Corley*, 279 F.3d at 455, n. 30 (declining to follow the California Court of Appeal's *Bunner* decision).

¹²⁵ 93 Cal. App.4th 648, 113 Cal. Rptr.2d 338 (2001), appeal granted, 117 Cal. Rptr.2d 167, 41 P.3d 2 (2002).

¹²⁶ *Bunner*, 113 Cal. Rptr.2d at 347.

¹²⁷ *Id.* at 347-52.

¹²⁸ *Corley*, 279 F.3d at 447-48 (finding no basis for distinguishing between object code and more human-readable forms of programs); 455, 460 (affirming injunction against linking to source or object code forms of programs).

¹²⁹ See, e.g., *Proctor & Gamble Co. v. Bankers Trust Co.*, 78 F.3d 219 (6th Cir. 1996)(Business Week received nonpublic information that had been subjected to a nondisclosure order as a trade secret from another person and sought to publish the information in its magazine); *Ford Motor Co. v. Lane*, 67 F. Supp.2d 745 (E.D. Mich. 1999)(website published non-public information about new designs of Ford products obtained from employees in violation of duties of confidence); *Oregon ex rel. Sports Management News v. Nachtigal*, 324 Ore. 80, 921 P.2d 1304 (1996)(newsletter published non-public information about new adidas sneaker designs obtained from adidas employees who had a duty not to disclose this trade secret information). See also *Bartnicki v. Vopper*, 532 U.S. 514 (2000)(First Amendment shielded broadcast of

on both trade secrecy and First Amendment grounds.¹³⁰ Yet, even those who disagree with this conclusion cannot deny that the constitutional law of intellectual property will evolve further as cases such as *Bunner* continue to appear in the courts.

IV. Other Constitutional Intellectual Property Issues

As the *Bunner* case illustrates, copyright is not the only form of intellectual property protection for informational works in which tensions with the First Amendment have arisen. From time to time, First Amendment defenses have been successful in trademark,¹³¹ right of publicity cases,¹³² and trade secrecy cases.¹³³ Courts have found merit in these defenses even though, like copyright, those intellectual property regimes have limiting doctrines that perform similar functions to the fair use doctrine of copyright law.¹³⁴ Perhaps a fuller appreciation of these intellectual property decisions will help the Court to perceive that the First Amendment has greater relevance in the copyright domain than as a foundational principle for the idea/expression distinction and the fair use

illegally intercepted cell phone conversation on matter of public concern in part because the broadcaster lawfully acquired the intercepted communication and did not act in league with the initial wrongdoer).

¹³⁰ See Pamela Samuelson, *Trade Secrets vs. Free Speech*, 46 Comm. ACM (forthcoming June 2003) (discussing the merits of *Bunner*'s First Amendment defenses); Pamela Samuelson, *Reverse Engineering Under Siege*, 45 Comm. ACM 15 (Nov. 2002) (discussing the merits of *Bunner*'s trade secrecy defenses).

¹³¹ See, e.g., *Cliff Notes, Inc. v. Bantam Doubleday Dell Pub. Group, Inc.*, 886 F.3d 490 (2d Cir. 1989) (vacating injunction against parody of Cliff Notes on First Amendment grounds); *L.L. Bean, Inc. v. Drake Pub., Inc.*, 811 F.2d 26 (1st Cir. 1987), cert. denied, 483 U.S. 1013 (1987) (successful First Amendment defense in trademark dilution case involving parody of L.L. Bean catalog); *Stop the Olympic Prison v. United States Olympic Committee*, 489 F. Supp. 1112 (S.D.N.Y. 1980) (allowing use of Olympic symbol in protest against building a prison on a former Olympic site).

¹³² See, e.g., *Parks v. LaFace Records*, 76 F.Supp.2d 775 (1999), rev'd in part, 2003 WL 21058571 (6th Cir. 2003) (reversing summary judgment for defendant, but indicating that First Amendment may provide a defense in a right of publicity case against songwriter who named a song for civil rights activist); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996) (successful First Amendment defense in right of publicity case); *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978) (denying right of publicity claim brought by heirs of Agatha Christie against maker of film about an episode in her life based in part on First Amendment considerations). See also *Comedy III Productions, Inc. v. Saderup, Inc.*, 21 P.3d 797, 106 Cal. Rptr. 2d 126 (Ca. 2001) (recognizing First Amendment limitations on right of publicity claims, although ruling against it as to a defendant who had made non-transformative uses of celebrity images).

¹³³ See, e.g., *CBS, Inc. v. Davis*, 510 U.S. 1315 (1994); *Proctor & Gamble Co. v. Bankers Trust Co.*, 78 F.3d 219 (6th Cir. 1996); *Ford Motor Co. v. Lane*, 67 F. Supp.2d 745 (E.D. Mich. 1999); *Oregon ex rel. Sports Management News v. Nachtigal*, 324 Ore. 80, 921 P.2d 1304 (1996). See also David Greene, *Trade Secrets, the First Amendment, and the Challenges of the Internet Age*, 23 Hastings Comm. & Ent. L. J. 537 (2001) (giving broad interpretation to First Amendment constraints on trade secret law); Lemley & Volokh, supra note 1, at 229-31 (preliminary injunctions in trade secret cases that raise serious First Amendment concerns). But see Andrew Beckerman-Rodau, *Prior Restraints and Intellectual Property: The Clash Between Intellectual Property and the First Amendment from an Economic Perspective*, 12 Fordham Intell. Prop., Media, & Ent. L.J. 1 (2001) (trade secret law should be categorically immune from First Amendment scrutiny because trade secrets are property rights).

¹³⁴ Trademark law, for example, generally regulates only confusing uses of trademarks and has a fair use defense. See RESTATEMENT, supra note 66, secs. 20-24, 28 (1995). Trade secrecy law regards reverse engineering as a fair means of acquiring secrets. *Id.*, sec. 43. Cf. *Sega Enterp. Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1992) (reverse engineering held to be a fair use of copyrighted software).

defense.¹³⁵ The Court should consider, for example, whether current standards for issuing preliminary injunctions in copyright cases are consistent with the rigorous requirements of the Court's prior restraint decisions.¹³⁶ Also worthy of consideration is the consistency of appellate review standards in copyright cases with First Amendment-sensitive standards routinely applied in other kinds of cases.¹³⁷ The First Amendment may also have implications for the issuance of subpoenas requiring an Internet service provider to reveal the identity of customers alleged to be infringing copyrights but against whom no copyright infringement lawsuit has been filed.¹³⁸

With the expansion of patents into protection of purely information inventions, the First Amendment may even acquire significance in the patent field.¹³⁹ Patent cases have not traditionally raised First Amendment concerns because writing, teaching, or otherwise communicating about a mechanical or chemical invention could not infringe the patent rights to make, use or sell the patented invention.¹⁴⁰ Moreover, courts have long recognized a limited experimental use defense for scientific purposes,¹⁴¹ even if this defense appears to be receding to a near vanishing point in the hands of the Court of Appeals for the Federal Circuit.¹⁴² However, as patent boundaries have expanded to protect information-based innovations, such as user interface designs, mathematical algorithms, and data structures,¹⁴³ it may now be possible, depending on the precise

¹³⁵ See supra notes 58-59 and accompanying text. As Yen observes, “[t]here is no particular reason to believe that copyright accommodates all First Amendment requirements, especially when the relevant doctrines do not even mention “free speech.” Yen, supra note 10.

¹³⁶ See, e.g., Mark A. Lemley and Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 Duke L.J. 147 (1998) (arguing that courts should require copyright owners to show irreparable harm and a high likelihood of success before being entitled to preliminary injunctions in copyright cases given the high standards that the prior restraint decisions establish as necessary to accommodate First Amendment concerns).

¹³⁷ See, e.g., Brett McDonnell & Eugene Volokh, *Freedom of Speech and Appellate and Summary Judgment Review in Copyright Cases*, 107 Yale L.J. 2431, 2431 (1998) (noting that “the Court has time and again held, certain procedural safeguards must accompany even substantively valid speech restrictions. One such safeguard is independent judicial review, by appellate courts after trial, by the trial court after trial, and by the trial court on summary judgment,” and questioning whether copyright cases should be immune from application of the same standards).

¹³⁸ See, e.g., *In re Verizon Internet Services, Inc.*, 2003 WL 1946489 at 11-14 (D.D.C. 2003)(ruling against Verizon's motion to quash subpoena which questioned the power of the court on various constitutional grounds, including First Amendment-protected anonymity and privacy interests of subscribers). This decision is on appeal to the D.C. Circuit.

¹³⁹ See Burk, supra note 1.

¹⁴⁰ 35 U.S.C. sec. 271(a).

¹⁴¹ See, e.g., *Whittemore v. Cutter*, 29 F. Cas. 1120, 1121 (C.C.D. Mass. 1813) (No. 17,600) (“it could never have been the intention of the legislature to punish a man, who constructed such a [patented] machine merely for philosophical experiments, or for the purpose of ascertaining the sufficiency of the machine to produce its described effects”). See generally Rebecca S. Eisenberg, *Patents and the Progress of Science: Exclusive Rights and Experimental Use*, 56 U. Chi. L. Rev. 1017 (1989).

¹⁴² See, e.g., *Roche Prods. v. Bolar Pharm. Co.*, 733 F.2d 858 (Fed. Cir. 1984)(construing the common law experimental use defense narrowly). Congress has, however, created a special statutory experimental use defense for makers of generic drugs embodying patented inventions during preparations for FDA approval. See 35 U.S.C. § 271(e)(1).

¹⁴³ See, e.g., Pamela Samuelson, *Benson Revisited: The Case Against Patent Protection for Algorithms and Other Computer Program-Related Inventions*, 39 Emory L. J. 1025 (1990)(discussing traditional patent doctrines limiting patent protection for information inventions and how the Federal Circuit eroded them);

language of claims, to infringe a patent by teaching or writing about it.¹⁴⁴ Although no patentee has yet brought an infringement claim based on such communicative activities, it is perhaps only a matter of time before patent law will either have to evolve a fair use defense to mediate tensions with the First Amendment or to accept that the First Amendment may limit the scope of patent protection as to communicative uses of some information-based inventions.¹⁴⁵

Another fertile field for further evolution of the constitutional law of intellectual property law may lie in challenges to mass-market license terms that limit or prohibit activities vis-à-vis copyrighted works that would, in the absence of the license restriction, be considered fair uses or otherwise be lawful as a matter of copyright law.¹⁴⁶ The constitutional issue here is generally characterized as supremacy of federal law over conflicting state law under the U.S. Constitution or preemption of state law because federal legislation occupies the field.¹⁴⁷

One well-known case from the mid-1980's, *Vault Corp. v. Quaid Software Ltd.*, opined that enforcement of a shrinkwrap license clause that forbade reverse engineering of copyrighted software would conflict with federal copyright policy.¹⁴⁸ In subsequent years, several appellate courts ruled that reverse engineering of computer programs is a fair and noninfringing use of copyrighted software, thereby reinforcing the holding in *Vault*.¹⁴⁹ The law review literature is overwhelmingly supportive of these fair use decisions and of *Vault*'s conclusion that anti-reverse-engineering clauses should be unenforceable because they conflict with copyright policy.¹⁵⁰ However, in *Bowers v.*

Burk, supra note 1. See also Dan L. Burk and Mark A. Lemley, *Policy Levers in Patent Law* (manuscript on file with the author) (discussing expanded bounds of patent law and policy levers within patent law that may provide balancing principles to tailor patent law appropriate to different fields of invention).

¹⁴⁴ See, e.g., Donald Chisum, *The Patentability of Algorithms*, 47 U. Pitt. L. Rev. 959, 1017-18 (1985).

¹⁴⁵ See Burk, supra note 1; Maureen O'Rourke, *Toward a Doctrine of Fair Use in Patent Law*, 100 Colum. L. Rev. 1177 (2000).

¹⁴⁶ See, e.g., See Mark A. Lemley, *Beyond Preemption: The Federal Law and Policy of Intellectual Property Licensing*, 87 Cal. L. Rev. 111 (1999); Charles R. McManis, *The Privatization (Or "Shrink-Wrapping") of American Copyright Law*, 87 Cal. L. Rev. 173 (1999). But see Joel Wolfson, *Contracts and Copyright are Not at War*, 87 Cal. L. Rev. 79 (Jan. 1999).

¹⁴⁷ See, e.g., *Goldstein v. California*, 412 U.S. 546 (1973) (discussing preemption and supremacy analysis vis-à-vis state intellectual property rules). See also Lemley, supra note 146.

¹⁴⁸ *Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255 (5th Cir. 1988).

¹⁴⁹ See *Sony Computer Entertainment v. Connectix Corp.*, 203 F.3d 596 (9th Cir. 2000); *Sega Enterp. Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1992); *Atari Games Corp. v. Nintendo of Am., Inc.*, 975 F.2d 832 (Fed. Cir. 1992).

¹⁵⁰ See, e.g., JONATHAN BAND & MASANOBU KATOH, *INTERFACES ON TRIAL: INTELLECTUAL PROPERTY AND INTEROPERABILITY IN THE GLOBAL SOFTWARE INDUSTRY* 167-225 (1995); *Brief Amicus Curiae of Eleven Copyright Professors, Sega Enterp. Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1992), published in 33 *Jurimetrics J.* 147 (1992); Julie E. Cohen, *Reverse Engineering and the Rise of Electronic Vigilantism: Intellectual Property Implications of 'Lock-out' Programs*, 68 S. Cal. L. Rev. 1091 (1995); Lawrence Graham & Richard O. Zerbe, Jr., *Economically Efficient Treatment of Computer Software: Reverse Engineering, Protection and Disclosure*, 22 *Rutg. Comp. & Tech. L.J.* 61 (1996); Dennis S. Karjala, *Copyright Protection of Computer Software, Reverse Engineering and Professor Miller*, 19 *U. Dayton L. Rev.* 975 (1994); Robert A. Kreiss, *Accessibility and Commercialization in Copyright Theory*, 43 *UCLA L. Rev.* 1 (1995); *LaST Frontier Conference Report on Copyright Protection for Computer Software*, 30 *Jurim. J.* 15 (1989); Ronald S. Laurie & Stephen M.

Bay State Technologies,¹⁵¹ the Court of Appeals for the Federal Circuit, over the dissent of Judge Dyk, ruled that an anti-reverse engineering clause of a mass market license for software was enforceable as a matter of contract law, thereby creating a conflict with the *Vault* ruling.¹⁵² At some point, the Supreme Court may have to rule on whether the Fifth Circuit or the Federal Circuit was correct on this issue. Other license restrictions on fair uses may also be subject to preemption or Supremacy Clause challenges.¹⁵³

V. Conclusion

Scholarly discourse about the constitutional law of intellectual property will continue for at least the next decade, notwithstanding the Supreme Court's recent *Eldred* decision (and in part because of it). Significant constitutional questions exist about numerous intellectual property issues discussed in this article.

Currently before the Supreme Court is the issue of whether authors of expired copyrighted works can recapture proprietary interests in these works through trademark and unfair competition law, or whether the public domain status of a work allows unauthorized derivative works to be created and marketed without attribution to the authors. Although the Court may well decide this case on statutory grounds, the case is being argued in part on constitutional grounds. Those engaged in the debate about whether the public domain is a constitutionally significant interest are likely to construe whatever the Court decides in constitutional terms.

Also making its way through the courts are constitutional challenges to legislation granting copyright in works that were for many years in the public domain due to failure to comply with U.S. formalities for copyright protection. The Court has repeatedly insisted that Congress cannot create intellectual property rights in public domain works in constitutionally inspired rulings. *Eldred* may have decided that Congress could extend the terms of existing copyrights, but it did not deal with the resurrection of dead copyrights, as the new cases do.

Everett, *Protection of Trade Secrets in Object Form Software: The Case for Reverse Engineering*, Computer Law., July 1984, at 1; Charles R. McManis, *Intellectual Property Protection and Reverse Engineering of Computer Programs in the United States and the European Community*, 8 High Tech. L. J. 25 (1993); David A. Rice, *Sega and Beyond: A Beacon for Fair Use Analysis...At Least As Far As It Goes*, 19 U. Dayton L. Rev. 1131 (1994); Pamela Samuelson, *Fair Use for Computer Programs and Other Copyrightable Works in Digital Form: The Implications of Sony, Galoob, and Sega*, 1 J. Intell. Prop. L. 49 (1993); Samuelson & Scotchmer, *supra* note 113; Timothy Teter, Note, *Merger and the Machines: An Analysis of the Pro-Compatibility Trend in Computer Software Copyright Cases*, 45 Stan. L. Rev. 1061 (1993). But see Anthony L. Clapes, *Confessions of an Amicus Curiae: Technophobia, Law and Creativity in the Digital Arts*, 19 U. Dayton L. Rev. 903 (1994); Duncan Davidson, *Common Law, Uncommon Software*, 47 U. Pitt. L. Rev. 1037 (1985); Arthur R. Miller, *Copyright Protection for Computer Programs, Databases and Computer-Generated Works: Is Anything New Since CONTU?*, 106 Harv. L. Rev. 977 (1993).

¹⁵¹ 320 F.3d 1317 (Fed. Cir. 2003)

¹⁵² See, e.g., Petition for Certiorari of Bay State Technologies (on file with the author).

¹⁵³ See, e.g., McManis, *supra* note 146 (giving examples); David Nimmer, Elliot Brown & Gary N. Frischling, *The Metamorphosis of Contract into Expand*, 87 Cal. L. Rev. 17 (Jan. 1999)(giving examples). See also Lemley, *supra* note 146 (discussing preemption and supremacy challenges to mass market license terms).

Also much in dispute is the constitutionality of database protection legislation. In 1996, the EU created a new legal regime that confers on publishers an exclusive right to control extraction and reuse of data from databases. By investing resources in compiling data (the definition of which includes public domain works), publishers can obtain new proprietary interests in them. Some publishers have sought to persuade Congress to adopt an equivalent law. Given that the Court in *Feist* insisted that the Constitution required a creativity-based standard for copyright (and presumably for copyright-like) protection of databases, EU-style database protection may not be constitutionally permissible in the U.S. The Supreme Court in *Eldred* may not have accepted the extension of the principles of *Feist* for which Eldred argued, but it did not abjure its ruling in *Feist*. Hence, the scholarly debate about the constitutionality of this form of intellectual property protection may continue as long as proponents of database protection legislation keep seeking its reintroduction in Congress.

Changes to the traditional contours of intellectual property law, such as database protection or the DMCA anti-circumvention rules may also trigger closer scrutiny under the First Amendment than was applied in *Eldred*, at least if the Court is to be taken at its word. Even if such laws can surmount facial challenges to their constitutionality, it seems quite likely that “as applied” challenges will sometimes be successful, as examples discussed in this article have argued.

Over time, the Supreme Court may come to see that the First Amendment has broader implications for the contours of copyright law than mediating tensions between these laws through the idea/expression distinction and the fair use defense. Other forms of intellectual property law have limiting principles that serve similar functions to these doctrines, and yet First Amendment defenses are sometimes successful even when those limits do not apply. The First Amendment also has implications for preliminary injunctive relief in copyright cases that the courts as yet have not perceived.

Finally, the proliferation of mass-market licenses that restrict activities that would be permissible as a matter of copyright, trade secrecy, or other legal rules, such as reverse engineering of mass-marketed products, present Supremacy Clause issues, about which the case law is presently quite mixed. The Supreme Court has yet to opine on these issues, but in the meantime, the scholarly debate on them is certain to go on.

My optimism about the further progress of scholarly discourse on the constitutional law of intellectual property law may be heartening news to some readers, even if disappointing to others. *Eldred* was a setback to some constitutional theories, but it opened up other possibilities, as well as leaving many important questions open for resolution another day. *Eldred* may, in fact, not be as much of a setback for constitutional discourse about intellectual property law, as it might initially seem. In some respects, the outcome in *Eldred* was over-determined because Congress had extended copyright terms so many times before and because life plus seventy years is, as Eldred conceded, a limited time (at least applied prospectively). The Supreme Court has not lost interest in the constitutional law of intellectual property, and neither should we.