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## Copyright/Commerce Clause Collision: A Subject Matter Approach

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## THE COPYRIGHT/COMMERCE CLAUSE COLLISION: A SUBJECT MATTER APPROACH

*Kevin J. Hickey\**

*This Article provides a novel theory of how the Constitution’s Copyright Clause limits congressional legislation enacted pursuant to other enumerated powers. The Copyright Clause is both a grant of power and a limitation on the reach of that power: it provides that Congress may create “exclusive Right[s]” in the “Writings” of “Authors,” but that those rights must “promote the Progress of Science and useful Arts” and last only for “limited Times.” Congress possesses other enumerated powers, however, including expansive Commerce Clause authority. As intellectual property substantially affects interstate commerce, may Congress avoid the limitations of the Copyright Clause by legislating pursuant to the Commerce Clause?*

*Analyzing the structure of the Copyright Clause and the key precedents on inter-Clause conflicts, the Article proposes a subject matter approach to resolve this question. The subject matter approach determines whether the law at issue is truly a “copyright law” that must comply with the Copyright Clause by examining the nature of the material regulated, the actions proscribed, and the scope of the rights granted by the law. The touchstone is whether the challenged law grants authors generalized property rights in expression. By contrast, if a law does not bear these hallmarks of traditional copyright protection, it may be permissible economic regulation within the Commerce Clause power, even if it relates to intellectual property.*

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## I. INTRODUCTION

The Supreme Court’s landmark decision in *Golan v. Holder* held that Congress’s restoration of copyright protection to certain works in the public domain did not violate the limitations of the Constitution’s Copyright Clause.<sup>1</sup> In reaching this result, the Court left unanswered a

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1. *Golan v. Holder*, 132 S. Ct. 873, 878 (2012).

critical antecedent question: why does Congress need to comply with the Copyright Clause at all? Congressional power under the Copyright Clause carries with it express textual limitations, such as the requirement that copyright protection be afforded only for a “limited Time[.]”<sup>2</sup> But other applicable congressional powers, such as the Commerce Clause, are not so constrained. The legislation at issue in *Golan* affected millions of artistic works,<sup>3</sup> many of which have significant commercial value.<sup>4</sup> This is undoubtedly a matter that “substantially affects” interstate commerce, and therefore within Congress’s authority under the Commerce Clause.<sup>5</sup> Thus, even if the Court in *Golan* had ruled that the Copyright Clause power may not be used to remove a work from the public domain, why could Congress not simply rely on the Commerce Clause as an alternative source of authority?

The question of whether Congress can constitutionally avoid the limitations of one enumerated power by legislating under another enumerated power has arisen in fields as diverse as bankruptcy,<sup>6</sup> civil rights,<sup>7</sup> and congressional spending.<sup>8</sup> Though the problem is at least a century old in the intellectual property context,<sup>9</sup> the Supreme Court has never addressed it directly. Nor has any generally-accepted theory emerged from case law as to how to approach these issues. Indeed, in the copyright context, constitutional challenges to the Digital

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2. U.S. CONST. art. I, § 8, cl. 8 (granting power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”); *Eldred v. Ashcroft*, 537 U.S. 186, 199 (2003) (interpreting the Copyright Clause’s “limited Times” requirement to mean that copyright terms must be “confined within certain bounds”).

3. *See Golan*, 132 S. Ct. at 900 (Breyer, J., dissenting).

4. For example, the popular works of the great Russian composers Dmitri Shostakovich and Igor Stravinsky are among the works whose copyright was restored by the legislation at issue in *Golan*. *See* Tyler T. Ochoa, *Is the Copyright Public Domain Irrevocable? An Introduction to Golan v. Holder*, 64 VAND. L. REV. EN BANC 123, 139 (2011); *Golan*, 132 S. Ct. at 904 (Breyer, J., dissenting) (noting seven-fold increase in price of Shostakovich scores following copyright restoration).

5. *See* U.S. CONST. art. I, § 8, cl. 3 (“The Congress shall have the power . . . To regulate commerce . . . among the several states . . .”); *United States v. Lopez*, 514 U.S. 549, 558–59 (1995) (providing that the Commerce Clause allows Congress to regulate activities bearing a “substantial relation” to interstate commerce).

6. *See* *Ry. Labor Executives’ Ass’n v. Gibbons*, 455 U.S. 457, 468–69 (1982) (holding Congress may not avoid limits on Bankruptcy Clause power through Commerce Clause authority).

7. *See* *Heart of Atlanta Motel v. United States*, 379 U.S. 241, 252–57 (1964) (holding Title II of Civil Rights Act constitutional on Commerce Clause grounds despite limitation on Fourteenth Amendment powers).

8. *See* *South Dakota v. Dole*, 483 U.S. 203, 207 (1987) (holding that Congress may employ spending power to achieve objectives outside of the scope of enumerated powers by attaching conditions to the receipt of federal funds).

9. *See* *The Trade-Mark Cases*, 100 U.S. 82, 94–98 (1879) (holding federal trademark legislation unconstitutional under both Copyright and Commerce Clauses).

Millennium Copyright Act<sup>10</sup> (the DMCA) and the so-called “anti-bootlegging statutes”<sup>11</sup> revealed a confused and conflicting array of results, approaches, and judicial tests.<sup>12</sup>

The academic commentary, while impressive in quantity,<sup>13</sup> is frequently not much more satisfying. Too often, analysis of the issue focuses solely on whether the Copyright Clause’s limitations should (or should not) apply to one particular piece of legislation,<sup>14</sup> without articulating a broader approach to the conflict at the intersection of the Copyright and Commerce Clauses.<sup>15</sup> Such inter-Clause conflict is not

10. 17 U.S.C. §§ 1201–1205 (2012).

11. 17 U.S.C. § 1101 (2012); 18 U.S.C. § 2319A (2012).

12. With regard to the criminal enforcement provision of the anti-bootlegging laws, *compare* *United States v. Moghadam*, 175 F.3d 1269, 1276–80 (11th Cir. 1999) (upholding the law as a valid exercise of Commerce Clause authority because it was not “fundamentally inconsistent” with the Copyright Clause), *with* *United States v. Martignon*, 346 F. Supp. 2d 413, 419–28 (S.D.N.Y. 2004) [hereinafter *Martignon SDNY*] (striking down the law because it was “copyright-like” yet did not comply with the limitations of the Copyright Clause). The latter case was reversed by *United States v. Martignon*, 492 F.3d 140, 153 (2d Cir. 2007) [hereinafter *Martignon*]. With regard to the civil enforcement provisions, *compare* *KISS Catalog v. Passport Int’l Prods.*, 350 F. Supp. 2d 823, 837 (C.D. Cal. 2004) [hereinafter *KISS I*] (striking down the statute as outside of Copyright Clause powers because the specific provisions of the Copyright Clause trump the general Commerce Clause power), *with* *KISS Catalog v. Passport Int’l Prods.*, 405 F. Supp. 2d 1169, 1171–76 (C.D. Cal. 2005) [hereinafter *KISS II*] (reversing *KISS I*, reasoning that the Commerce Clause and Copyright Clauses are independent grants of authority).

13. For example, the district court decision in the *Martignon* case, which found the anti-bootlegging statutes unconstitutional, has by itself inspired a small subfield of commentary. *See generally, e.g.*, Craig W. Mandell, *Balance of Powers: Recognizing the Uruguay Round Agreement Act’s Anti-Bootlegging Provisions as a Constitutional Exercise of Congress’s Commerce Clause Authority*, 54 J. COPYRIGHT SOC’Y U.S.A. 673 (2007); Hugh C. Hansen et al., *U.S. v. Martignon—Case in Controversy*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1223 (2006); David Patton, *The Correct-Like Decision in United States v. Martignon*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1287 (2006); Yavar Bathaee, Note, *A Constitutional Idea-Expression Doctrine: Qualifying Congress’ Commerce Power When Protecting Intellectual Property Rights*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 441 (2008); Brian Danitz, Comment, *Martignon and Kiss Catalog: Can Live Performances Be Protected?*, 15 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1143 (2005); Adam Giuliano, Note, *Steal This Concert? The Federal Anti-Bootlegging Statute Gets Struck Down, But Not Out*, 7 VAND. J. ENT. L. & PRAC. 373 (2005); Andrew B. Peterson, Note, *To Bootleg or Not to Bootleg? Confusion Surrounding the Constitutionality of the Anti-Bootlegging Act Continues*, 58 OKLA. L. REV. 723 (2005); Michael C. Shue, Case Note, *United States v. Martignon: The First Case to Rule that the Federal Anti-Bootlegging Statute is Unconstitutional Copyright Legislation*, 60 U. MIAMI L. REV. 131 (2005).

14. *See, e.g.*, Giuliano, *supra* note 13, at 375–76 (concluding, without extending analysis or considering other fields, that Commerce Clause power can be used to uphold anti-bootlegging statutes as they complement copyright protection); Peterson, *supra* note 13, at 737–44 (concluding Congress cannot resort to Commerce Clause power to uphold anti-bootlegging statutes without examining consequences in other areas); Michael B. Gerdes, Comment, *Getting Beyond Constitutionally Mandated Originality as a Prerequisite for Federal Copyright Protection*, 24 ARIZ. ST. L.J. 1461, 1468–70 (1992) (concluding Congress may use Commerce Power to uphold *sui generis* protection of databases without articulating any general theory).

15. There are several important and thoughtful exceptions to this generalization. *See, e.g.*, Jeanne C. Fromer, *The Intellectual Property Clause’s External Limitations*, 61 DUKE L.J. 1329 (2012); Thomas B. Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272 (2004); Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property*

unique to the anti-bootlegging statutes or the DMCA, after all—parallel questions arise in assessing the constitutionality of federal trademark, trade secret, and database protection. A complete theory, therefore, must answer the question of when each of the Copyright Clause’s limitations will be applied externally to other enumerated powers across all of these diverse areas. The problem of the Copyright and Commerce Clause’s “collision”<sup>16</sup> thus remains under-theorized.<sup>17</sup>

This Article analyzes the structure of the Copyright Clause and the key judicial precedents on inter-Clause conflicts to conclude that the limitations of the Copyright Clause must, in some cases, constrain the exercise of Commerce Clause power.<sup>18</sup> Having reached that conclusion, the more difficult question becomes defining *when* the limitations of the Copyright Clause will apply externally to the exercise of other congressional powers. Relying on a novel analysis of the theories in the existing literature, this Article maintains that a subject-matter-based approach is the most defensible as a matter of copyright and constitutional law and policy.<sup>19</sup>

The subject matter approach advanced here is a multifactor test that looks to the nature of the material regulated, the actions proscribed, and the particular rights granted to determine whether the law at issue is truly a “copyright law” that must comply with the limitations of the Copyright Clause. The touchstone is whether the challenged law grants authors generalized property rights in expression—in particular, the right to proscribe unauthorized reproduction of their works. If a law does not bear these hallmarks of traditional copyright protection, it is permissible economic regulation within the Commerce Clause power, even though it may impact intellectual property. The subject matter

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*Clause as an Absolute Constraint on Congress*, 2000 U. ILL. L. REV. 1119 (2000). The theoretical contributions of these and other commentators are discussed in detail in Part IV, *infra*.

16. This term is taken from the title of an article by Professor William Patry. See William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 GEO. WASH. L. REV. 359 (1999). I will also use the expression “Copyright/Commerce Clause conflict” to refer to the issue.

17. See, e.g., Fromer, *supra* note 15, at 1335 (“Some [commentators] propose that the [Copyright] Clause restrains Congress’s other powers. These works, however, tend to be undertheorized.”). This may be in part due to the sparse—and seemingly contradictory—Supreme Court precedent. See *KISS I*, 350 F. Supp. 2d 823, 834 (C.D. Cal. 2004) (noting that only a “small number of cases . . . touch on the constitutional question”); *United States v. Moghadam*, 175 F.3d 1269, 1279 (11th Cir. 1999) (noting “tension” in the relevant Supreme Court precedents); Dotan Oliar, *Resolving Conflicts Among Congress’s Powers Regarding Statutes’ Constitutionality: The Case of Anti-Bootlegging Statutes*, 30 COLUM. J.L. & ARTS 467, 488 (2007) (“Unfortunately, the highly relevant cases [on the enumerated powers collision problem] differ in their holding—two of them do not allow Congress to circumvent limitations in one enumerated power by acting through another while three others do—and in their reasoning.”).

18. See *infra* Part III.

19. See *infra* Parts IV & V.

approach thus preserves a robust role for the Copyright Clause's limitations but confines them to their traditional purview. Moreover, the subject matter inquiry does not depend on malleable notions of "structural purpose," "fundamental inconsistencies," "constitutional norms," and the like— notions that have dominated the academic literature on the issue.<sup>20</sup> The subject matter approach instead provides a simple, workable, and coherent doctrinal framework to resolve the Copyright/Commerce Clause conflict.

This Article's approach is distinct from those proposed by other commentators. Some scholars have concluded that the Copyright Clause limitations simply do not apply externally—that is, Commerce Clause power operates independently from any Copyright Clause constraints.<sup>21</sup> Others, while agreeing that the Copyright Clause limitations sometimes apply to some purported Commerce Clause legislation, define both those limits and the scope of their applicability quite differently. Professor Jeanne Fromer, for example, would apply the Copyright Clause's limitations to any legislation with the "structural purpose" of "promoting the progress of science and useful arts," *unless* Congress proves by clear and convincing evidence that it intended to further legitimate non-"Progress"-promoting interests.<sup>22</sup> By contrast, the subject matter approach is not dependent on difficult-to-ascertain notions of congressional purpose, and would apply the Copyright Clause limitations absolutely—albeit within a smaller sphere of legislative actions. Professors Paul Heald and Suzanna Sherry take another, quite different approach, relying on the history of the Copyright Clause to deduce "implied limits"—such as a "public domain principle"—that apply whenever "legislation . . . imposes monopoly-like costs on the public through the granting of exclusive rights."<sup>23</sup> Their theory thus differs both in the limitations that apply to Congress and in which congressional actions will trigger those limits.

This Article makes three core contributions to the existing literature. First, it collects and analyzes the various theories that have been proposed to reconcile conflicts between the Copyright and Commerce

20. *See infra* Part IV.

21. *See, e.g.,* Nachbar, *supra* note 15, at 277 ("The Intellectual Property Clause and its limits do not represent generally applicable constitutional norms and Congress may therefore legislate pursuant to the Commerce Clause without regard to the Intellectual Property Clause."). Edward C. Waterscheid takes a related view, in that he does not consider the Copyright Clause's power to "secur[e] for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries," to limit a more general authority to "promote the Progress of Science and useful Arts" by whatever means Congress chooses. *See* Edward C. Waterscheid, *To Promote the Progress of Science and Useful Arts: The Anatomy of a Congressional Power*, 43 IDEA 1, 20–23 (2002).

22. *See* Fromer, *supra* note 15, at 1372.

23. *See* Heald & Sherry, *supra* note 15, at 1119, 1160.

Clause powers, offering a novel and useful organization of the existing case law and commentary. Second, it offers a defense of the subject matter approach as doctrinally and normatively superior to the alternative theories. Third, it details a proposed framework to give precise, substantive content to the subject matter test—what is and is not a “copyright law” for the purposes of Copyright/Commerce Clause collision—to transform it into a clear and workable standard. The resulting multifactor approach culls the strongest ideas from existing commentary and offers a compelling reconciliation of the existing case law.

The Article begins by identifying four key areas in which the Commerce Clause power has been advanced to support legislation arguably outside of the Copyright Clause’s limits: trademarks, database protection, the DMCA, and the anti-bootlegging statutes. It next reviews the relevant case law, beginning with the historical Supreme Court precedents on inter-Clause conflicts, and then discusses more recent copyright-related challenges to the DMCA and the anti-bootlegging statutes.

Having laid the necessary groundwork, the Article moves to theory. Part III sets out the boundaries of the debate. On the one hand, treating the enumerated powers as completely independent grants of authority seems to write the Copyright Clause’s limitations out of the Constitution, allowing, for example, patents on obvious inventions or perpetual copyrights under the Commerce power. Such a result cannot easily be reconciled with Supreme Court precedent. On the other hand, holding the Copyright Clause’s limitations applicable to anything “intellectual property-like” would seem to sound the death knell for, *inter alia*, federal trademark law or trade secret protections, which stand on equally firm legal ground. Existing doctrine thus implies that the limitations of the Copyright Clause must be to some degree externally applicable, but they cannot be so applied in every instance. To be consistent with Supreme Court precedent, a theory of the Copyright/Commerce Clause collision must articulate principles which define a closed set of cases in which a given Copyright Clause limitation will be externally applied.

Part IV critically analyzes the leading theories found in the case law and commentary, organizing them into five conceptual categories. The first group, which this Article calls “structural” theories, relies primarily on inferences from the Constitution’s structure, arguing for broad external application based on analogies to various other constitutional provisions. The second group of theories focuses on the text of the Copyright Clause, arguing that external application is only appropriate when the language at issue is an affirmative limitation, as opposed to a



mere lack of authority. This Article labels this view the “textualist” approach, though it is distinct from any particular view of statutory interpretation. “Purpose-based” theories, the third group, look to the purposes behind the two enumerated powers at issue as the critical factor. The fourth and largest group, which this Article calls “values-based” theories, argues that Copyright Clause limitations should be applied to the Commerce Clause only when some normative trigger is satisfied—e.g., when the law at issue is “fundamentally inconsistent” with the Copyright Clause, or when the limitation at issue rises to the level of a “constitutional norm.” The final group is termed “subject matter” approaches. They answer the question of whether the Copyright Clause ought to apply externally by reference to the substance of the challenged law, such as the material it regulates and the specific rights granted.

Part V defends and expounds upon the subject matter approach. It argues that the subject matter test offers a consistent, workable approach to the problem that resolves the conflicts in existing precedent. Next, it defines explicit criteria as to what makes a particular piece of legislation a “copyright law,” looking to (1) the actions proscribed, (2) the material protected, and (3) the character of the rights afforded (including the means of enforcing those rights). Finally, Part VI illustrates how the subject matter test works in practice by applying this proposed framework to several prominent examples of the Copyright/Commerce Clause collision.

## II. THE COPYRIGHT/COMMERCE CLAUSE COLLISION

The Copyright Clause<sup>24</sup> of the Constitution reads: “The Congress shall have the Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” It is well recognized that the clause is “both a grant of power and a limitation.”<sup>25</sup> In particular, the Clause has been interpreted to embody at least five limitations attendant to the use of Copyright Clause power.<sup>26</sup> First, as rights secured are to the “Writings” of “Authors,” it is clear that only original works may be copyrighted.<sup>27</sup> As a corollary, only expression,

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24. U.S. CONST. art. I, § 8, cl. 8. Since the clause is read to grant Congress the power to establish both copyright and patent law, the clause is more accurately referred to as the “Copyright/Patent Clause” or the “Intellectual Property Clause.” Since this Article concerns itself principally with the power to grant copyrights, I will refer to it as simply the “Copyright Clause” as a convenient shorthand.

25. *Graham v. John Deere Co.*, 383 U.S. 1, 5 (1966).

26. Caroline T. Nguyen, Note, *Expansive Copyright Protection for All Time? Avoiding Article I Horizontal Limitations Through the Treaty Power*, 106 COLUM. L. REV. 1079, 1084 (2006).

27. See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345–46 (1991) (“The *sine qua*

and not facts or ideas themselves, can be the subject of a copyright.<sup>28</sup> Third, from the phrase “limited Times,” copyright protection must only persist for a finite period.<sup>29</sup> Fourth—and controversially<sup>30</sup>—since only “Writings” can be protected, the object of a copyright must be fixed in a tangible medium, i.e., some physical rendering of the fruits of intellectual labor.<sup>31</sup> Finally, the preamble of the Copyright Clause establishes that the legislation must “promote the Progress of Science,”<sup>32</sup> though this requirement has been interpreted broadly and deferentially.<sup>33</sup>

If a piece of intellectual property-like legislation fails to satisfy one or more of these limitations, is it therefore unconstitutional, or may the Commerce Power—or another enumerated power<sup>34</sup>—be relied upon to save it? The first section of this Part lays out four important areas in which this question arises: trademarks, database protection, the DMCA, and the anti-bootlegging statutes. Though this list is by no means

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*non* of copyright is originality. . . . Originality is a constitutional requirement.”).

28. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547 (1985) (“[Under the copyright statute,] no author may copyright facts or ideas.”). The *Feist* Court arguably constitutionalized this so-called “idea-expression” dichotomy—embodied in 17 U.S.C. § 102(b)—by making clear that originality requires independent *creation* in addition to minimal creativity. *Feist*, 499 U.S. at 345. According to *Feist*, facts are discovered, not created, and therefore are not original. *Id.* at 347–48. Ideas would seem to be non-original by the same line of reasoning. See Nguyen, *supra* note 26, at 1086–87 (arguing that the idea-expression distinction was given a “constitutional basis” in *Feist*). Of course, ideas may be protected under the Copyright Clause’s patent power as “Discoveries.”

29. See *Eldred v. Ashcroft*, 537 U.S. 186, 199 (2003) (interpreting “limited Times” to mean that copyright terms must be “confine[d] within certain bounds”).

30. No Supreme Court case has explicitly held that fixation is a constitutional requirement, though that is the view of a majority of commentators and some lower courts have so held. Nguyen, *supra* note 26, at 1087–89. The crux of the argument hinges on the meaning given to the word “Writing” as used in the Copyright Clause. The majority view argues that “Writings” implies fixation, see David Nimmer, *The End of Copyright*, 48 VAND. L. REV. 1385, 1409 (1995) (“[N]o respectable interpretation of the word ‘Writings’ embraces [unfixed expression].”), though critics argue that fixation is merely a creature of the copyright statute, opting for a broader view of “Writings,” see PAUL GOLDSTEIN, COPYRIGHT § 17.6.1, at 17:56 (3d ed. 2005) (“There is little doubt that performances subject to protection are ‘writings’ in the constitutional sense for, beyond literalism, there is nothing in the mechanical act of fixation to distinguish writings from nonwritings.”).

31. *Goldstein v. California*, 412 U.S. 546, 561 (1973).

32. “Science,” in the context of the Copyright Clause, means “knowledge and learning”; the “useful Arts” refers to Congress’s power to grant patents. See *Golan v. Holder*, 132 S. Ct. 873, 888 (2012) (“Perhaps counterintuitively for the contemporary reader, Congress’ copyright authority is tied to the progress of science; its patent authority, to the progress of the useful arts.”) (citations omitted).

33. See *Golan*, 132 S. Ct. at 887–89 (copyright legislation is constitutional so long as Congress “rationally could have concluded” that it “may promote knowledge and learning”).

34. This Article is limited to the intersection of the Copyright Clause and the Commerce Clause, though the Commerce Clause is not the only alternate source of authority on which Congress might rely when enacting copyright-like legislation that fails to satisfy the Copyright Clause’s limitations. For example, in the context of the anti-bootlegging statutes—which were enacted to satisfy the United States’ international treaty obligations—it is often argued that the Treaty Clause, instead of the Copyright Clause, may be relied upon to support the legislation. See generally, e.g., Symposium, *Copyright Lawmaking Authority: An (Inter)nationalist Perspective on the Treaty Clause*, 30 COLUM. J.L. & ARTS 287 (2007); Nguyen, *supra* note 26.

exhaustive,<sup>35</sup> these fields represent some of the principal controversies in the Copyright/Commerce Clause conflict, and will be used as examples throughout this Article to help analyze the theories proposed to resolve the conflict. Having gained a better sense of the contours of the controversy, this Part's second section discusses the Supreme Court and other precedents that speak most directly to the issue.

### *A. Areas of Tension*

#### 1. Trademarks

Though their historical roots lie in the law of unfair competition,<sup>36</sup> today trademarks are usually classified as a species of intellectual property.<sup>37</sup> Federal trademark laws prohibit, *inter alia*, any person (other than the registrant) from using a registered mark in commerce in ways likely to confuse consumers.<sup>38</sup> Trademarks thus afford exclusive rights in (certain uses of) expression—the words, symbols, and pictorial elements that make up a particular mark.

But these rights cannot be granted under the power contained within the Copyright Clause, for two reasons. First, unlike copyrights and patents, trademarks are not granted for “limited Times.” So long as the mark remains in use in commerce<sup>39</sup> and does not become a generic term,<sup>40</sup> trademark rights can exist in perpetuity,<sup>41</sup> at least in theory.

35. Other areas of potential controversy include federal trade secret legislation, *see* The Economic Espionage Act of 1996, 18 U.S.C. § 1831–1839 (2012), and the restoration of the copyrights in certain foreign works that had fallen into the public domain, *see* 17 U.S.C. § 104A (2012).

36. *See, e.g.*, Henry E. Smith, *Intellectual Property As Property: Delineating Entitlements In Information*, 116 YALE L.J. 1742, 1754 (2008) (noting trademark has its origins in, and is indeed an “outgrowth” of, the law of unfair competition); Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1072 (2005) (“[I]n another era we treated intellectual property as a species of business tort [instead of intellectual property].”).

37. It is common, for example, for introductory law school surveys on “intellectual property” to cover copyright, patent, and trademark as the three main “species” of intellectual property. *See generally, e.g.*, ROGER E. SCHECHTER & JOHN R. THOMAS, *INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS & TRADEMARKS* (2003) (casebook covering copyright, patent, and trademark law as forms of intellectual property); CRAIG A. NARD ET AL., *THE LAW OF INTELLECTUAL PROPERTY* (2006) (same). *See also e.g.*, BLACK’S LAW DICTIONARY (8th ed. 2004) (defining “intellectual property” as “compris[ing] primarily trademark, copyright, and patent rights”); Edward C. Walterscheid, *Divergent Evolution of the Patent Power and the Copyright Power*, 9 MARQ. INTELL. PROP. L. REV. 307, 308 n.8 (2005) (“In the modern era, trademarks are treated as a separate species of intellectual property, distinct from patents and copyrights . . .”).

38. 15 U.S.C. § 1114(1) (2012).

39. *See* 15 U.S.C. § 1064(3) (2012) (providing for cancellation of a mark that has been “abandoned”).

40. *See id.* (providing for cancellation of a mark that has become “the generic name for the goods or services”).

41. *See* Christopher Springman, *Indirect Enforcement Of The Intellectual Property Clause*, 30

Second, there is no requirement that the marks protected be original (a constitutional requirement for copyrights)<sup>42</sup> or nonobvious (the analogous constitutional requirement for patents).<sup>43</sup> In other words, trademarks are often not the work of “Authors” or “Inventors.” For example, provided certain statutory requirements are met,<sup>44</sup> there is nothing to prevent acquiring a trademark on, for example, the mark “Yummy Cookies,” though this phrase is obvious and does not satisfy even the minimal amount of creativity required for a copyright.<sup>45</sup>

In the *Trade-Mark Cases*, the Supreme Court struck down one of Congress’s early attempts at federal trademark legislation,<sup>46</sup> finding it outside of Copyright Clause authority for the reasons outlined in the preceding paragraph. Federal trademark regulation was also found to be beyond the scope of Commerce Clause authority,<sup>47</sup> though the *Trade-Mark Cases* were decided before New Deal expansions of Commerce Clause power. There is little doubt that the current trademark statute—the Lanham Act of 1946<sup>48</sup>—passes muster under modern Commerce Clause doctrine,<sup>49</sup> in large part because it contains an express jurisdictional limitation, restricting its applicability to marks used in commerce that Congress has the power to regulate.<sup>50</sup> After more than fifty years without constitutional challenge, it is clear that trademarks represent a valid exercise of Congress’s Commerce Clause power.<sup>51</sup>

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COLUM. J.L. & ARTS 565, 586 (2007) (“[T]he federal rights created under the Lanham Act are perpetual.”).

42. See *supra* note 27 and accompanying text.

43. See *Graham v. John Deere Co.*, 383 U.S. 1, 5–6 (1966) (establishing that nonobviousness requirement of patent law is mandated by “constitutional command”).

44. In particular, since “Yummy Cookies” is a descriptive mark—it describes a characteristic of the goods sold, see 15 U.S.C. § 1052(e) (2012)—the registrant would need to establish “secondary meaning,” i.e., that the mark “has become distinctive of the applicant’s goods in commerce,” 15 U.S.C. § 1052(f) (2012), to register the mark.

45. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 362 (1991) (“[T]he Constitution mandates some minimal degree of creativity [as a prerequisite to copyright.]”).

46. *Trade-Mark Cases*, 100 U.S. 82, 94, 99 (1879).

47. *Id.* at 96–99.

48. Trademark Act of 1946 (Lanham Act), 60 Stat. 427 (1946) (codified at 15 U.S.C. §§ 1051–1141).

49. The modern boundaries of Commerce Clause authority allow Congress to regulate: (1) the use of the channels of interstate commerce; (2) the instrumentalities of interstate commerce, or persons and things in interstate commerce; and (3) activities having a substantial relation to interstate commerce. *United States v. Lopez*, 514 U.S. 549, 558–59 (1995).

50. See 15 U.S.C. § 1127 (2012) (limiting the Lanham Act’s applicability to marks used in commerce “which may lawfully be regulated by Congress”). It is unclear whether a trademark law like the 1876 Act, containing no jurisdictional limitation, would be found to comport with modern conceptions of Commerce Clause authority were it enacted today. See *infra* note 96 (discussing the issue).

51. See, e.g., *Dawn Donut Co. v. Hart’s Food Stores, Inc.*, 267 F.2d 358, 365 (2d Cir. 1959) (“Clearly Congress has the power under the commerce clause to afford protection to marks used in interstate commerce.”).

Trademarks thus stand as a well-established example of a permissible use of the Commerce Clause power to enact intellectual property legislation that falls outside of the Copyright Clause's grant of authority.<sup>52</sup>

## 2. Database Protection

In the landmark case of *Feist Publications v. Rural Telephone Service Company*,<sup>53</sup> the Supreme Court considered the extent to which factual compilations, or databases, may be copyrighted. The case was a dispute between two publishers of telephone directories; one company had copied the listings of the other and was sued for copyright infringement.<sup>54</sup> The Supreme Court held that originality—defined as independent creation plus a minimal degree of creativity<sup>55</sup>—is a constitutional prerequisite for copyright protection.<sup>56</sup> Since telephone directories consist of facts (which are discovered and not created), copyright protection can exist only if the selection or arrangement of the facts is (minimally) creative.<sup>57</sup> As an alphabetic listing of names and phone numbers is not original, no copyright existed in the telephone directories in *Feist*.<sup>58</sup>

In holding that copyrighted works must be original, the Supreme Court departed from a line of cases that had allowed copyright in non-original databases on the basis of the work that went into compiling the information—the so-called “sweat of the brow” doctrine.<sup>59</sup> Such cases argued that the labor expended in collecting facts was a form of authorship, and should be protected lest others copy and free-ride off these labors.<sup>60</sup> After *Feist*, producers of databases argued that protection against copying is needed to stop piracy and maintain economic incentives to create and compile databases.<sup>61</sup> The European Union, seeking to create such positive incentives for commercial database

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52. See Patry, *supra* note 16, at 391 (“Trademark protection is the prime example of permissible Commerce Clause legislation in the area of intellectual property”).

53. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

54. *Id.* at 342–44.

55. *Id.* at 345.

56. *Id.* at 345–46.

57. *Id.* at 347–48.

58. *Id.* at 363.

59. *Id.* at 352–54.

60. See, e.g., *Jeweler's Circular Pub. Co. v. Keystone Pub. Co.*, 281 F. 83, 88–89 (2d Cir. 1922) (famously articulating the “sweat of the brow” doctrine).

61. See 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, 90 (1999) (“Sponsors characterize [U.S. database protection] as a necessary measure to protect American companies from bankruptcy due to post-*Feist* pirates . . .”) (citation omitted).

creation, has passed a form of intellectual property protection for databases.<sup>62</sup>

Responding to similar pressures, several proposals for *sui generis* (non-copyright) database protection have been advanced in the U.S. Congress.<sup>63</sup> Given *Feist*, there is little doubt that such legislation cannot be supported by Congress's power under the Copyright Clause.<sup>64</sup> Whether Congress may instead rely on Commerce Clause power to establish a system of database protection, however, remains an open and controversial question. As none of the proposals advanced has been enacted, there is as of yet no case law on the issue, but the academic debate on the issue has been intense, with strong voices on both sides.<sup>65</sup>

### 3. The DMCA's Anti-Circumvention Provisions

The anti-circumvention provisions of the Digital Millennium Copyright Act prohibit the circumvention of certain technological measures protecting copyrighted works.<sup>66</sup> The DMCA distinguishes between technological means that restrict particular *uses* of copyrighted works—e.g., Apple's former restriction that songs purchased through iTunes may be used only on a limited number of devices<sup>67</sup>—and those that prevent *access* to a copyrighted work—e.g., a website using passwords and encryption to allow only paying users to view copyrighted material. With regard to access restrictions, Congress proscribed both the act of circumventing the protections as well as trafficking in a device designed to circumvent such technological

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62. Directive 96/9/EC, of the European Parliament and of the Council of 11 March 1996 on the Legal Protection of Databases, 1996 O.J. (L 77) 20. See generally Mark Powell, *The European Union's Database Directive: An International Antidote to the Side Effects of Feist?*, 20 FORDHAM INTL. L.J. 1215, 1215–23 (1997) (describing and giving background on the EU system of database protection).

63. E.g., H.R. 354, 106th Cong. (1st Sess. 1999); H.R. 1858, 106th Cong. (1st Sess. 1999); H.R. 2652, 105th Cong. (1st Sess. 1998).

64. See DEPARTMENT OF JUSTICE, MEMORANDUM FOR THE ASSOCIATE WHITE HOUSE COUNSEL, CONSTITUTIONAL CONCERNS RAISED BY THE COLLECTIONS OF INFORMATION ANTIPIRACY ACT, available at <http://www.justice.gov/olc/righto.htm> (concluding that legislation protecting databases could not be supported under the Intellectual Property Clause) [hereinafter Dep't of Justice, CIAA Memo].

65. Compare, e.g., Justin Hughes, *How Extra-Copyright Protection of Databases Can Be Constitutional*, 28 U. DAYTON L. REV. 159, 160–61 (2002) (contending that “substantial arguments” support the constitutionality of database protection), with Pollack, *supra* note 61, at 49 (contending that a proposal for database protection is “both unconstitutional and ill-considered”), and 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, 537–39 (2000) (arguing that some of the proposed database protections pass constitutional muster but others do not).

66. 17 U.S.C. § 1201(a)–(b) (2012).

67. See Monika Roth, Note, *Entering the DRM-Free Zone: An Intellectual Property and Antitrust Analysis of the Online Music Industry*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 515, 524 (2008) (explaining Apple's policy).

restrictions.<sup>68</sup> With regard to use restrictions, only trafficking in devices designed to circumvent such restrictions was prohibited.<sup>69</sup> The act of circumventing use restrictions was not proscribed so as to preserve fair use rights.<sup>70</sup>

Most of the constitutional challenges made against the DMCA allege it violates the First Amendment by restricting speech or being unconstitutionally overbroad.<sup>71</sup> Though these are serious and important arguments, since this Article is concerned with the limitations of the Copyright Clause—and not the First Amendment—it will assume that the DMCA survives First Amendment scrutiny, as several courts have so held.<sup>72</sup>

But even if the DMCA's anti-circumvention provisions do not violate the First Amendment, they may still be unconstitutional as outside of the scope of Congress's enumerated powers. The primary claim is that the DMCA violates the "limited Times" provision of the Copyright Clause by granting copyright owners *de facto* perpetual rights through technological protection measures.<sup>73</sup> Though the DMCA applies only to works still covered by copyright, there remains a practical concern that allowing technological protection measures to be embedded into works will prevent free copying and dissemination once the copyright (but not the technological protection measure) expires.<sup>74</sup> The reasoning goes as follows: assume that a copyright owner sells only copy-protected versions of his work while it remains under copyright. Once the copyright expires, the owners of individual copies are theoretically free to copy and disseminate what is now a public domain work. Practically,

68. 17 U.S.C. § 1201(a)(1), (2) (2012).

69. 17 U.S.C. § 1201(b) (2012).

70. See H.R. Rep. 105-551, pt. 1, at 18 (1998) ("[W]here the access is authorized . . . an individual . . . would be able [to circumvent technological protections] in order to make fair use of a work he or she has acquired lawfully.").

71. See, e.g., *Universal Studios, Inc. v. Reimerdes*, 111 F. Supp. 2d 294, 325–41 (S.D.N.Y. 2000) (rejecting various First Amendment challenges to the DMCA).

72. See *id.*; *United States v. Elcom Ltd.*, 203 F. Supp. 2d 1111, 1125–37 (N.D. Cal. 2002) (rejecting First Amendment challenges to DMCA). I will also ignore the claim that the DMCA unconstitutionally limits fair use rights, as fair use rights, if constitutionally required at all, likely find their source in the First Amendment and not the Copyright Clause, though the law is not clear on this point. See *Elcom*, 203 F. Supp. 2d at 1133–34 n.4.

73. See *Elcom*, 203 F. Supp. 2d at 1141.

74. The scenario laid out here is but one line of reasoning under which the DMCA may allow the creation of a *de facto* perpetual copyright. Another common concern is the fear that public domain (or other non-copyrighted) works will be tied to a copyrighted "fig leaf"—some insignificant matter placed together with and under the same technological protection as the public domain work. Because the fig leaf is copyrighted, circumvention will violate the access restrictions of the DMCA, even if the only work truly sought is in the public domain. See, e.g., Jerome H. Reichman et al., *A Reverse Notice and Takedown Regime to Enable Public Interest Uses of Technically Protected Copyrighted Works*, 22 BERKELEY TECH. L.J. 981, 1022 n.219 (explaining how such "fig leaves" are used to protect uncopyrightable information).

however, they cannot—though there is no legal reason they cannot circumvent the technological protection measures themselves, many users will lack the technical expertise to do so. Further, in all likelihood, they will not be able to rely on the technical expertise of others to circumvent the copy protection. Any device designed to circumvent the protection will likely also circumvent the protection of other, non-public domain works, and will therefore be in violation of the DMCA if it is distributed to others.<sup>75</sup> Though no court has found the DMCA unconstitutional on such grounds, the anti-circumvention provisions represent another regulatory area in which Congress might wish to rely on Commerce Clause authority to avoid the limitations of the Copyright Clause.

#### 4. The Anti-Bootlegging Statutes

The anti-bootlegging statutes were passed in 1994 as part of the Uruguay Round Agreement Act, pursuant to agreements the United States had made in certain international intellectual property treaties.<sup>76</sup> The statutes consist of a civil and criminal provision. The civil provision (Section 1101) makes liable, “to the same extent as an infringer of copyright,” a person who “without the consent of the performer . . . fixes the sounds or images of a live musical performance in a copy or phonorecord,” *or* transmits, sells, or distributes any copy or phonorecord of said bootlegged performance.<sup>77</sup> The criminal provision (Section 2319A) prohibits the same activities, but associates a different penalty: up to 5–10 years imprisonment.<sup>78</sup> As a criminal statute, it additionally requires that the bootlegger “knowingly” made the recordings for financial gain.<sup>79</sup>

The anti-bootlegging statutes are arguably outside of the scope of the Copyright Clause power for at least two reasons.<sup>80</sup> The first derives

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75. If access to a significant number of public domain works is blocked by technological protections, it is possible that a sufficiently narrowly-tailored technology could be designed and trafficked in without running afoul of the DMCA. Since any device marketed with knowledge of its illegal circumventing use, 17 U.S.C. § 1201(a)(2)(C) (2012), or primarily designed for circumvention, *id.* § 1201(a)(2)(A), is prohibited, any legal device must be conceived and designed with only its permissible use—circumventing protection of public domain works—in mind. Finally, there will need to be enough public domain works under technological measures such that obtaining access to public domain works constitutes a “commercially significant purpose” that is more than “limited.” *Id.* § 1201(a)(2)(B).

76. Nguyen, *supra* note 26, at 1091–92.

77. 17 U.S.C. § 1101 (2012).

78. 18 U.S.C. § 2319A (2012).

79. *KISS I*, 350 F. Supp. 2d 823, 830 (C.D. Cal. 2004).

80. Some commentators have argued that, in addition to the “limited Times” and fixation arguments, the anti-bootlegging statutes may violate other limitations of the Copyright Clause. *See*



from the language of the Copyright Clause, which only allows Congress to protect “Writings.”<sup>81</sup> Though the Supreme Court has never made the limitation explicit, most commentators (and some lower courts) believe that inherent in the word “Writings” is a constitutional requirement of fixation, i.e., that the creative work of the author must be embodied in some physical, tangible form before it may be the subject of copyright.<sup>82</sup> Assuming fixation is indeed constitutionally mandated, the first argument for the unconstitutionality of the anti-bootlegging statutes runs roughly thus: Since live musical performances are not fixed, they cannot be protected under the Copyright Clause; therefore, the anti-bootlegging statutes are unconstitutional if Congress cannot rely instead on its Commerce Clause (or some other) power.

Though the requirement of fixation may seem rather technical or formalistic to a reader unfamiliar with copyright, it has been a part of federal copyright law since its inception<sup>83</sup> and advances important copyright policies. First, fixation serves significant manageability and evidentiary concerns. If every fleeting expression—e.g., all the utterances of everyday conversation—could be copyrighted, courts might potentially be inundated with claims of copyright and difficult factual disputes over who said what first.<sup>84</sup> More fundamentally, the fixation requirement can be seen as part of copyright’s quid pro quo between the public and authors of creative works. The fundamental rationale of granting a copyright is to facilitate the creation of works which will benefit the public. After a limited period, the work falls into the public domain and may be freely enjoyed and copied by all.<sup>85</sup>

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Oliar, *supra* note 17, at 492–95 (arguing that the anti-bootlegging statutes may also conflict with the Copyright Clause’s preamble and its requirements of authorship and originality). These arguments have not achieved widespread recognition and have not been advanced in the cases challenging the anti-bootlegging statutes, so I do not elaborate upon them here.

81. U.S. CONST. art. I, § 8, cl. 8.

82. *See supra* notes 30–31 and accompanying text.

83. Stefan Hubanov, *The Multifaceted Nature and Problematic Status of Fixation in U.S. Copyright Law*, 11 INTELL. PROP. L. BULL. 111, 111 (2006) (“There is . . . a general understanding that fixation has been an implicit part of federal copyright law since its very inception.”).

84. *See id.* at 119–20. Of course, since copyright law no longer requires any formalities to secure a copyright, there is already a tremendous amount of material—e.g., all of the emails sent each day—that is automatically copyrighted, so it is arguable how realistic this “inundation” fear is. *Id.*

85. The reader may note some tension between this understanding of the fixation requirement (as a way to ensure copies exist for a robust public domain), and the history of copyright protection under state common law. Before the enactment of the Copyright Act of 1976, federal copyright protection was triggered only when a work was first “published.” Prior to publication, the author possessed exclusive rights in his work under common law copyright, which could persist from the time of creation until publication—that is, potentially, in perpetuity. *See generally* Robert A. Gorman, *An Overview of the Copyright Act of 1976*, 126 U. PA. L. REV. 856, 857–60 (1978). State copyright law thus created some incentive to keep a work private and unpublished (so long as one did not wish to commercially exploit it), yet the Copyright Clause left such regimes untouched. This result may appear anomalous if one reads the Copyright Clause to embody strong pro-public domain policies (via “limited Times” and the

Fixation, by mandating the creation of a tangible copy as a prerequisite to copyright, ensures that there will be something to fall into the public domain when the copyright term ends.<sup>86</sup> Thus, the anti-bootlegging statutes' protection of unfixed works is seen by some as a serious constitutional shortcoming, rather than a formalistic reading of "Writings."<sup>87</sup>

The second way in which the anti-bootlegging statutes may fall outside of Copyright Clause power is more straightforward conceptually. As discussed above, the Copyright Clause explicitly requires that any rights secured last for "limited Times." The anti-bootlegging statutes contain no statute of limitations, thus affording "arguably perpetual" protection of live musical performances.<sup>88</sup> Though some commentators have argued for various interpretations of the statutes that avoid this problem,<sup>89</sup> the overwhelming majority of courts and commentators have concluded the statute as written fails to satisfy the "limited Times" requirement.<sup>90</sup> It would thus appear that the anti-bootlegging statutes afford the kind of perpetual protection that the Copyright Clause expressly proscribes, and so another grant of power must be relied upon if they are to be upheld under the Constitution.<sup>91</sup>

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fixation requirement). However, it is well-established that the Copyright Clause did not preclude state regulation of copyrightable subject matter, *see* *Goldstein v. California*, 412 U.S. 546, 556–57 (1973) ("[T]he Copyright Clause . . . does not indicate that all writings are of national interest or that state legislation is, in all cases, unnecessary or precluded."), at least until Congress chooses to act in the area and preempts state protection, *id.* at 559. With the Copyright Act of 1976, Congress opted to preempt the operation of state copyright law once a work has been fixed in a tangible medium. *See* 17 U.S.C.A. § 301(a) (2012).

86. Joseph C. Merschman, Note, *Anchoring Copyright Laws in the Copyright Clause: Halting the Commerce Clause End Run Around Limits on Congress's Copyright Power*, 34 CONN. L. REV. 661, 663, 681 (2002). A similar function is served by the Copyright Act's deposit provisions, which impose fines if copies of a published work are not deposited with the Library of Congress for posterity. 17 U.S.C. § 407(a)–(d) (2012).

87. *See* Nimmer, *supra* note 30, at 1385, 1409–10 (viewing the anti-bootlegging statutes as part of the "end of copyright").

88. *Id.* at 1411.

89. For example, some commentators have argued that the anti-bootlegging statutes should be read to incorporate general copyright duration provisions. *E.g.*, Susan M. Deas, *Jazzing Up the Copyright Act? Resolving the Uncertainties of the United States Anti-Bootlegging Law*, 20 HASTINGS COMM. & ENT. L.J. 567, 579 (1998). Other commentators have argued there is no "limited Times" problem at all since the protection, properly conceived, only persists for the limited duration of the live performance. *E.g.*, Danitz, *supra* note 13, at 1198–99. While this last argument could be made with respect to the anti-bootlegging statutes' prohibition on *fixing* a live musical performance, it is more difficult to see how it applies to the prohibition on distributing or selling the bootlegged performance.

90. Oliar, *supra* note 17, at 491.

91. This article looks only to the Commerce Clause as an alternate source of support, though others have argued that the anti-bootlegging statutes can be upheld instead under Treaty Clause powers. *See supra* note 34 (citing to articles that evaluate whether the Treaty Clause can support the anti-bootlegging statutes).

### B. Case Law

This section provides an overview of the case law most relevant to the question of whether, and when, Congress may rely on Commerce Clause power to support copyright-like legislation that cannot be sustained under the Copyright Clause. First, it discusses the Supreme Court precedents thought most relevant to the issue, though none of the cases address the question explicitly. Next, it reviews the recent challenges to the constitutionality of the DMCA and the anti-bootlegging statutes that have been heard in the lower federal courts.

#### 1. Supreme Court Precedents

The *Trade-Mark Cases* challenged the constitutionality of the Trademark Act of 1876<sup>92</sup> as beyond Congress's enumerated powers. The Act, somewhat like modern trademark law, punished the fraudulent use and counterfeiting of marks registered with the United States.<sup>93</sup> The Supreme Court struck down the law in its entirety. It first held that the Act could not be supported by the Copyright Clause, since "[t]he ordinary trade-mark has no necessary relation to invention or discovery."<sup>94</sup> In language that laid the ground for *Feist* a century later, the court interpreted "Writings" to require originality,<sup>95</sup> which many trademarks lack. Finding the law outside of the Copyright Clause, the Court turned to the Commerce Clause. Since the Act purported to cover many marks that were used solely within a single state, the Court found that Congress's power to regulate interstate commerce did not reach so far.<sup>96</sup> Since the Court found that neither Clause supported the statute, it did not directly address the issue of an intellectual property law that is within the Commerce Clause power but fails to satisfy Copyright Clause limitations. However, the analytic approach of *The Trade-Mark Cases* appears to evince the notion that each enumerated power operates

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92. Trademark Act of 1876, ch. 274, 19 Stat. 141 (1876).

93. *The Trade-Mark Cases*, 100 U.S. 82, 92 (1879).

94. *Id.* at 94.

95. *See id.* ("[W]hile the word writings may be liberally construed . . . it is only such [works] as are original . . . which are to be protected.")

96. *Id.* at 95–98. The Court relied in particular on the fact that the 1876 Act lacked any jurisdictional limitation limiting its applicability only to marks used in foreign, Indian, or interstate commerce, *id.* at 96–97, such as that found in the modern trademark statute, *see* 15 U.S.C. § 1127 (2012) (limiting applicability to marks used in commerce "which may lawfully be regulated by Congress"). It is unclear whether such a limitation is required under post-New Deal, more expansive views of the Commerce Clause, which may sometimes reach purely intrastate activities. *See, e.g.*, *Wickard v. Filburn*, 317 U.S. 111 (1942) (allowing regulation of farmer's intrastate wheat production for personal consumer under Commerce Power); *United States v. Lopez*, 514 U.S. 549, 559 (1995) (allowing regulation of intrastate activities which "substantially affect" interstate commerce).

independently—that is, falling short of the Copyright Clause’s limitations does not prohibit reliance on Commerce Clause power to support a copyright-like law.

The next important Supreme Court case, *Heart of Atlanta Motel v. United States*,<sup>97</sup> gives further support to this notion of independence of powers, though it arises in a legal context—civil rights—quite distinct from intellectual property. *Heart of Atlanta* adjudged the constitutionality of Title II of the 1964 Civil Rights Act, which prohibited racial discrimination in public accommodations.<sup>98</sup> Standing in the way of the Act was a post-Reconstruction precedent—the *Civil Rights Cases*<sup>99</sup>—which had struck down a similar law as outside the scope of Congress’s powers.<sup>100</sup> The *Civil Rights Cases* held that “state action” was required before the power of the Fourteenth Amendment could be invoked,<sup>101</sup> since the Amendment reads that “No State shall . . . deny to any person within its jurisdiction the equal protection of the laws.”<sup>102</sup> Declining to review that precedent, the Court upheld Title II under Congress’s Commerce Clause power without considering the impact of Fourteenth Amendment powers.<sup>103</sup> Thus, although the Court deals with the conflict of enumerated powers issue only implicitly, *Heart of Atlanta*, like *The Trade-Mark Cases*, appears to endorse the proposition that enumerated powers function largely independently; at the least, falling short of one grant of power does not necessarily foreclose the use of another power. However, given the unique political context of *Heart of Atlanta*, along with the force of stare decisis (i.e., the Court’s reluctance to overrule an 80-year-old precedent), it is unclear how much should be read into the Court’s approach.

On the other side of the issue is a more recent Supreme Court case, *Railway Labor Executives v. Gibbons*,<sup>104</sup> which made clear that the limitations of enumerated powers cannot be avoided through reliance on expansive Commerce Clause powers in all circumstances. At issue in *Gibbons* was the Rock Island Railroad Transition and Employee

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97. *Heart of Atlanta Motel v. United States*, 379 U.S. 241 (1964).

98. *Id.* at 242, 247.

99. *United States v. Stanley*, 109 U.S. 3 (1883) (*Civil Rights Cases*).

100. *Id.* at 10–14.

101. *Id.* at 13. The first section of the Fourteenth Amendment guarantees citizens “equal protection of the laws,” and section 5 grants Congress the “power to enforce, by appropriate legislation, the provisions of this article.”

102. U.S. CONST. amend. XIV, § 1 (emphasis added).

103. *Heart of Atlanta*, 379 U.S. at 257. Justice Douglas wrote separately to express the view that legislation should instead be upheld under section 5 of the Fourteenth Amendment. *Id.* at 280 (Douglas, J., concurring).

104. *Ry. Labor Execs. Ass’n v. Gibbons*, 455 U.S. 457 (1982).

Assistance Act (RITA),<sup>105</sup> passed in response to the bankruptcy and anticipated liquidation of Rock Island Railroad.<sup>106</sup> RITA decreed that economic benefits due to laid-off employees be treated as administrative expenses in bankruptcy, essentially requiring these benefits to be paid from the estate's assets before the claims of other creditors were satisfied.<sup>107</sup> In *Gibbons*, the Court first held that RITA could not be an exercise of Congress's Bankruptcy Clause power, as that Clause only provides for the establishment of "uniform" bankruptcy laws;<sup>108</sup> RITA, as a private bill affecting only one company's reorganization, did not satisfy this requirement of uniformity.<sup>109</sup> Though the United States never advanced the Commerce Clause as an alternate source of authority, the Court, in a stunning bit of dicta, went on to write that the Commerce Clause could not be used to eliminate a limitation in another enumerated power:

[T]he Bankruptcy Clause itself contains an affirmative limitation or restriction upon Congress' power: bankruptcy laws must be uniform throughout the United States. . . . Thus, if we were to hold that Congress had the power to enact nonuniform bankruptcy laws pursuant to the Commerce Clause, we would eradicate from the Constitution a limitation on the power of Congress to enact bankruptcy laws.<sup>110</sup>

Thus *Gibbons* would seem to put to rest the idea that the Commerce Clause can be relied upon as an independent grant of authority in all circumstances; clearly, the limitations of other enumerated powers cannot always be so avoided.

This "trio" of cases—*The Trade-Mark Cases*, *Heart of Atlanta Motel*, and *Gibbons*—are generally considered to be the principal guidance the Supreme Court has offered so far.<sup>111</sup> Unfortunately, little is clear from the cases other than the obvious "tension" between the holdings<sup>112</sup> and the fact that none of the cases can be said to control the resolution of the

105. Pub. L. No. 96-254, 94 Stat. 399 (1980).

106. *Gibbons*, 455 U.S. at 459–61.

107. *Id.* at 461–63.

108. See U.S. CONST. art. I, § 8, cl. 4 ("Congress shall have power . . . [t]o establish . . . uniform Laws on the subject of Bankruptcies throughout the United States").

109. *Gibbons*, 455 U.S. at 471 ("A law can hardly be said to be uniform . . . if it applies only to one debtor.").

110. *Id.* at 468–69 (citations omitted).

111. See *Martignon*, 492 F.3d 140, 145 (2d Cir. 2007) (analyzing the Copyright/Commerce Clause collision by focusing on "a trio of cases—the *Trade-Mark Cases*, *Heart of Atlanta*, and *Gibbons*—in which the Supreme Court has considered issues similar to the one that confronts us"). In addition to these three cases, commentators have looked to a diverse array of precedents for further guidance, see, e.g., Nachbar, *supra* note 15, at 299–308 (examining the relevance of early 20th-century regulatory taxation cases); Olliar, *supra* note 17, at 479–84 (examining the relevance of cases involving Congress's borrowing powers and powers under the Militia Clause).

112. *United States v. Moghadam*, 175 F.3d 1269, 1279 (11th Cir. 1999).

Copyright/Commerce Clause collision.<sup>113</sup> It is thus not too surprising that the lower courts have reached an array of conclusions—and employed a variety of conflicting standards—in adjudging the constitutionality of the DMCA and the anti-bootlegging statutes on enumerated powers grounds. The next section summarizes this case law.

## 2. Modern Copyright Controversies

### *a. The Digital Millennium Copyright Act*

The principal case involving an enumerated powers challenge to the DMCA's anti-circumvention provisions is *United States v. Elcom*.<sup>114</sup> Elcom was the software developer of a product that allowed consumers to circumvent use restrictions associated with Adobe eBooks.<sup>115</sup> Publishers using Adobe were allowed to specify whether purchasers of eBooks were able to, inter alia, make copies of the eBook, print a paper version, or email the document to others.<sup>116</sup> Elcom's technology removed these restrictions, and Elcom was indicted under the DMCA for trafficking in their software.<sup>117</sup> Before reaching the enumerated powers issue, the court rejected challenges to the DMCA on First Amendment<sup>118</sup> and due process grounds.<sup>119</sup>

Acknowledging the force of *Gibbons*, the *Elcom* court stated that “Congress may not use [Commerce Clause] power in such a way as to override or circumvent another constitutional restraint.”<sup>120</sup> Influenced by the *Moghadam* case, discussed below,<sup>121</sup> *Elcom* articulated the proper test as whether the DMCA's use of Commerce Clause power was “irreconcilably inconsistent” with the Copyright Clause.<sup>122</sup> The court first considered whether the DMCA's purpose was inconsistent with the

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113. See *Martignon*, 492 F.3d at 146 (“We find no absolute answers [in the Supreme Court precedents] because none of the cases . . . is directly on point.”).

114. *United States v. Elcom Ltd.*, 203 F. Supp. 2d 1111 (N.D. Cal. 2002). In another prominent case adjudging the constitutionality of the DMCA's anti-circumvention provisions, the Second Circuit declined to reach the issue of whether Copyright Clause limitations precluded Congress's authority to enact the DMCA on procedural grounds. *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 444–45 (2d Cir. 2001).

115. *Elcom*, 203 F. Supp. 2d at 1118.

116. *Id.*

117. *Id.* at 1119.

118. *Id.* at 1125–37.

119. *Id.* at 1122–25.

120. *Id.* at 1138.

121. See *infra* notes 137–142 and accompanying text.

122. *Elcom*, 203 F. Supp. at 1140.

purposes of the Copyright Clause.<sup>123</sup> Viewing anti-circumvention provisions as complementing the existing intellectual property regime by providing effective means to enforce IP rights in a digital world, the court found there was no serious inconsistency.<sup>124</sup> Second, the court looked at the pragmatic costs and benefits of the regulation from a copyright perspective,<sup>125</sup> and concluded that the alleged violations of the Copyright Clause were too “tenuous” to be persuasive.<sup>126</sup>

The other case that has adjudicated a Congressional authority challenge to the DMCA is *321 Studios v. MGM*.<sup>127</sup> 321 Studios, the maker and seller of software which allowed users to copy DVDs despite encryption protections, argued that its software was legal because, inter alia, the anti-circumvention provisions of the DMCA exceeded Congress’s enumerated powers.<sup>128</sup> The court rejected this challenge, but relied heavily on the *Elcom* analysis,<sup>129</sup> thus offering few insights independent of that decision.

In summary, although no court has struck down the DMCA on enumerated powers grounds, there have been few cases directly addressing the issue, and even courts upholding the law acknowledged that the Copyright/Commerce Clause issue presented a “difficult question.”<sup>130</sup> The next section looks at the analogous case law with regard to the anti-bootlegging statutes, where the courts have been more divided and the controversy even more acute.

### *b. The Anti-Bootlegging Statutes*

Three separate cases—*United States v. Moghadam*,<sup>131</sup> *KISS Catalog v. Passport International Products*,<sup>132</sup> and *United States v. Martignon*<sup>133</sup>—have produced five published decisions on whether the anti-bootlegging statutes are a constitutionally valid exercise of congressional power. The results have been mixed, with two decisions

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123. *See id.* at 1140 (accepting argument that “Congress’ intent [in enacting the DMCA] was to protect intellectual property rights and thus promote the same purposes served by the Intellectual Property Clause”).

124. *Id.* at 1140–41.

125. *See Oliar, supra* note 17, at 499 (viewing the *Elcom* analysis as weighing “the DMCA’s copyright-related costs and benefits”).

126. *Elcom*, 203 F. Supp. 2d at 1141.

127. *321 Studios v. MGM Studios, Inc.*, 307 F. Supp. 2d 1085 (N.D. Cal. 2004).

128. *Id.* at 1089–90.

129. *See id.* at 1103–04 (quoting *Elcom* at length and adopting its conclusions).

130. *Elcom*, 203 F. Supp. 2d at 1138.

131. *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999).

132. *KISS I*, 350 F. Supp. 2d 823 (C.D. Cal. 2004), *vacated by* 405 F. Supp. 2d 1169, 1171–76 (C.D. Cal. 2005).

133. *Martignon SDNY*, 346 F. Supp. 2d 413 (S.D.N.Y. 2004), *rev’d*, 492 F.3d 140 (2d Cir. 2007).

finding either the criminal or civil anti-bootlegging statute unconstitutional<sup>134</sup> and three upholding the laws (including both appellate decisions).<sup>135</sup> The facts of each case are similar—a bootlegger is sued or indicted, and challenges the constitutionality of the anti-bootlegging statutes’ civil or criminal provision. The courts all agreed on two central premises: (1) the anti-bootlegging statutes could not be sustained under the Copyright Clause, due to either a lack of fixation or the temporally unlimited protection;<sup>136</sup> and (2) the Commerce Clause power, standing alone, would be enough to support the legislation. They disagreed as to whether it was permissible, in this context, for Congress to avoid a Copyright Clause limitation by using Commerce Clause power. Most interesting for purposes of this Article are the theories and rationales put forth in the opinions. This part surveys the analytical approach of each decision with regard to the Copyright/Commerce Clause collision.

In *Moghadam*, the Eleventh Circuit heard a challenge to the criminal anti-bootlegging statute based on the argument that the Copyright Clause’s “Writings” requires the subject matter protected be fixed in a tangible medium;<sup>137</sup> for procedural reasons, the court did not address the argument that the anti-bootlegging statutes afforded perpetual protection in contravention of “limited Times.”<sup>138</sup> The court assumed *arguendo* that the lack of fixation precluded the use of the Copyright Clause, turning directly to the issue of whether it might nonetheless be supported under Commerce Clause power.<sup>139</sup> The *Moghadam* court concluded Commerce power could be validly relied upon, using two alternate theories. The first theory was that the Copyright Clause’s “Writings” requirement was not intended as an “affirmative limitation”<sup>140</sup>—unlike the “uniform” requirement at issue in *Gibbons* (and, presumably, the “limited Times” requirement)—and thus did not preclude the use of other enumerated powers. The second theory articulated the test as whether “the particular use of the Commerce Clause [is] *fundamentally inconsistent* with the particular limitation in

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134. See *Martignon SDNY*, 346 F. Supp. 2d at 429 (finding the criminal anti-bootlegging statute unconstitutional); *KISS I*, 350 F. Supp. 2d at 837 (finding civil anti-bootlegging statute unconstitutional).

135. See *Moghadam*, 175 F.3d at 1282 (finding criminal anti-bootlegging statute constitutional); *Martignon*, 492 F.3d 140, 152–53 (2d Cir. 2007) (same); *KISS II*, 405 F. Supp. 2d at 1177 (finding civil anti-bootlegging statute constitutional).

136. There is one exception to this generalization, as the *Moghadam* court only heard the fixation-based challenge (and not the “limited Times” argument), and assumed, *arguendo*, that the lack of fixation precluded reliance on the Copyright Clause. *Moghadam*, 175 F.3d at 1274.

137. *Id.* at 1275–77.

138. See *id.* at 1274 n.9 (explaining that *Moghadam* failed to preserve this argument for appeal).

139. *Id.* at 1274.

140. *Id.* at 1280.



the Copyright Clause.”<sup>141</sup> Later courts—e.g., *Elcom*, discussed *supra*<sup>142</sup>—picked up on and followed this “fundamentally inconsistent” test, though *Moghadam* did not elaborate on what it meant by this language.

The *KISS Catalog* cases adjudicated the constitutionality of the civil anti-bootlegging statute. The first district court opinion in *KISS (KISS I)* found the law unconstitutional. Judge Rea found it unnecessary to decide whether the statute violated the fixation requirement, as it clearly could not be supported under Copyright Clause power since the protection afforded was not for “limited Times.”<sup>143</sup> Relying heavily on *Gibbons*,<sup>144</sup> Judge Rea reasoned that allowing recourse to the Commerce Clause in this context would effectively write the Copyright Clause’s limitations out of the Constitution.<sup>145</sup> After Judge Rea’s death, the new judge assigned to the case granted a motion to reconsider (after the United States intervened), and vacated the finding of unconstitutionality in *KISS II*.<sup>146</sup> *KISS II* advanced two alternate grounds for its decision that Section 1101 was a valid exercise of Commerce Clause power. The opinion first advanced a sweeping argument that enumerated powers should simply be analyzed independently:

[O]nce the Court concludes that the Statute does not fall within the purview of the Copyright Clause, it need no longer consider whether it complies with the limitations of the Copyright Clause. . . . One need only find an alternative source of constitutional authority. This Court finds such authority in the Commerce Clause.<sup>147</sup>

In the alternative, the court adopted *Moghadam*’s approach and held Section 1101 was not “fundamentally inconsistent” with the Copyright Clause.<sup>148</sup> It offered several reasons to find no fundamental conflict, relying heavily on the notion that legislation should be presumed constitutional.<sup>149</sup>

The district court opinion in *Martignon (Martignon SDNY)* found the

141. *Id.* at 1280 n.12 (emphasis added).

142. *See supra* notes 114–126 and accompanying text.

143. *See KISS I*, 350 F. Supp. 2d 823, 831–33 (C.D. Cal. 2004). Judge Rea rejected alternative constructions of the statute which implied a time limit from another part of the copyright code as unreasonable. *Id.* at 832–33.

144. *See id.* at 836 (“[T]his Court finds [*Gibbons*] to be the most instructive case on this issue.”).

145. *See id.* at 837 (“The framers . . . included the explicit limits contained in Art. I, § 8, cl. 8. Permitting the current scope of the Commerce Clause to overwhelm those limitations altogether would be akin to a ‘repeal’ of a provision of the Constitution.”).

146. *See KISS II*, 405 F. Supp. 2d 1169, 1171–76 (C.D. Cal. 2005).

147. *Id.* at 1175.

148. *Id.* at 1176 (“Even if a ‘fundamental conflict’ with the Copyright Clause would invalidate the Statute, none exists here.”).

149. *See id.* at 1175–76.

criminal anti-bootlegging statute unconstitutional. Like *KISS II*, *Martignon SDNY* advanced two theories of the Copyright/Commerce Clause collision. Judge Baer's first theory related to whether the anti-bootlegging statute was "copyright-like."<sup>150</sup> If Congress was acting within the copyright field, the reasoning goes, it is bound by the limitations of the Copyright Clause regardless of the existence of Commerce power.<sup>151</sup> Baer looked to the text, history, and purpose of the anti-bootlegging statute to hold it was copyright-like, and therefore unconstitutional.<sup>152</sup> In the alternate, Baer applied the *Moghadam* "fundamental inconsistency" test and concluded, in light of the express "limited Times" language, perpetual protection for live performances was a sufficiently serious inconsistency.<sup>153</sup>

Though the Second Circuit reached the opposite conclusion in reversing Judge Baer, the court seems to adopt a version of his first theory, albeit in stricter form. The test, in their view, was not whether a piece of legislation was "copyright-like"; rather, it was whether it was in fact a "copyright law."<sup>154</sup> The touchstone of copyright law, in the Second Circuit's view, is a grant of "property rights in expression."<sup>155</sup> Relying almost exclusively on the criminal nature of the anti-bootlegging statute before it—enforced not via property rights but instead coercive government action—the court held it was not a copyright law and so the use of Commerce Clause authority was proper.<sup>156</sup> The court expressly left open the question of whether the *civil* anti-bootlegging statute was constitutional under this analysis.<sup>157</sup>

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150. *Martignon SDNY*, 346 F. Supp. 2d 413, 424–25 (S.D.N.Y. 2004).

151. *See id.* at 425 ("Congress' power to act in the copyright field is limited by the confines of the Copyright Clause.").

152. *Id.* at 420–22.

153. *Id.* at 429.

154. *See Martignon*, 492 F.3d 140, 149 (2d Cir. 2007) ("[T]he Supreme Court's cases allow the regulation of matters that could not be regulated under the Copyright Clause in a manner arguably inconsistent with that clause unless the statute *is a copyright law.*") (emphasis added).

155. *Id.* at 150.

156. *See id.* at 152 ("Section 2319A does not create, bestow, or allocate property rights in expression [and so is not a 'copyright law']. We therefore conclude that it was not enacted under the Copyright Clause.").

157. *Id.* at 152 n.8. The reader may also wonder whether this analysis means that the *criminal* copyright enforcement provisions, *see* 17 U.S.C. § 506 (2012) (providing for criminal penalties for "willful" infringement of a copyright for commercial gain), must be supported by an act under the Commerce Clause, and not the Copyright Clause. The issue may be resolved by recognizing that "copyright law" is used in this context as a term of art—defining laws so similar to copyright that they must be scrutinized to comply with the Copyright Clause's limitations—and is *not* coincidental with the limit of Congress's "necessary and proper" powers under the Copyright Clause. *See infra* Part V.B.1.b (explaining this point in more detail).

## III. THE CONTOURS OF THE DEBATE

As the preceding Part illustrates, the courts have taken a diverse and conflicting set of approaches to the Copyright/Commerce Clause collision. As we will see in greater detail later, this diversity extends to the views of the legal commentators who have examined the issue.<sup>158</sup> Before organizing and examining these theories, it is useful to set out the boundaries of the debate. This Part argues that the views at either end of the spectrum—complete independence of powers on the one hand, and complete external application of the Copyright Clause’s limitations on the other—cannot be supported on any reasonable reading of the applicable Supreme Court precedents. Though the simplicity of each of these views may be initially appealing, this Article contends that any doctrinally sound theory of the Copyright/Commerce Clause collision must be more nuanced. In other words, the proper question is not *whether* a Copyright Clause limitation ought to apply to the use of Commerce Clause power, but *when* such a limitation must apply. Any theory offered to answer this question must define some closed set of circumstances under which a given Copyright Clause limitation will be applied to exercises of other enumerated powers if it is to be consistent with the precedents this Part analyzes.

*A. The Independence-of-Powers View*

Based on a naïve textual reading of Article I, Section 8 of the Constitution—which lists the enumerated powers of Congress—one view of the Copyright/Commerce Clause collision would simply read each grant of power in Section 8 as operating independently. After all, each grant of power is listed separately, and makes no explicit reference to any other enumerated power. Why should we read limitations into the Commerce Clause that are not written into the Commerce Clause? The strongest language in *KISS II*,<sup>159</sup> as well as that of some commentators,<sup>160</sup> takes this view of the issue.

This “independence-of-powers” view, despite its textual appeal, cannot be easily reconciled with much of the Supreme Court’s constitutional intellectual property jurisprudence. It is difficult to understand why the Supreme Court in *Feist* expended so much energy articulating a constitutional originality requirement if “sweat of the brow” protection could simply be had via reliance on the Commerce

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158. See *infra* Part IV (reviewing and organizing theories offered in legal commentary).

159. See *supra* notes 146–149 and accompanying text (discussing the reasoning in *KISS II*).

160. See, e.g., Gerdes, *supra* note 14, at 1468 (“[T]he Commerce Clause is not limited by less-than-explicit prohibitions in other constitutional clauses.”).

Clause.<sup>161</sup> The fact that Congress was clearly exercising Copyright Clause power in the provisions of the Copyright Act at issue in *Feist* is not enough to distinguish the case. As a matter of black letter constitutional law, Congress's stated basis of authority is irrelevant in assessing a law's constitutionality;<sup>162</sup> courts are to look to all the possible sources of congressional power regardless of how Congress purports to justify a law. Nor can *Feist* be distinguished on the ground that a Commerce power argument was not raised. Principles of constitutional avoidance<sup>163</sup> would seem to require that courts at least look to potential Commerce Clause authority before laying down a constitutional rule. The *Feist* court never discussed the Commerce Clause, strongly suggesting that it viewed the Copyright Clause as completely governing the issue.

To a similar effect as *Feist* is *Graham v. John Deere Company*, which held a certain level of innovation (i.e., of non-obviousness) to be a constitutional requirement for the issuance of a patent.<sup>164</sup> *Graham* seems particularly in conflict with an independence-of-powers view as it dealt with an *act of Congress* (unlike the judicial interpretations at issue in *Feist*) which appeared to lower the threshold of non-obviousness required for patentability.<sup>165</sup> Making clear that a particular level of innovation (or more) was required by the Constitution's requirement that patents "promote the progress of . . . useful Arts,"<sup>166</sup> the Court interpreted a provision of the 1952 Patent Act to avoid a constitutional violation.<sup>167</sup> If Commerce Clause authority was available to support the legislation, one would assume that the *Graham* court would have looked to this power before invalidating (or at least materially altering) a congressional action.

Perhaps most fatal to the independence-of-powers view is the Supreme Court's approach in *Dastar Corporation v. Twentieth Century*

161. See *supra* Part II.A.2 (discussing the holding in *Feist*).

162. See *Woods v. Cloyd W. Miller Co.*, 333 U.S. 138, 144 (1948) ("[T]he constitutionality of action taken by Congress does not depend on recitals of the power which it undertakes to exercise.").

163. See *Ashwander v. Tennessee Valley Auth.*, 297 U.S. 288, 345–49 (1936) (Brandeis, J., concurring) (listing principles of constitutional avoidance).

164. *Graham v. John Deere Co.*, 383 U.S. 1, 5–6 (1966).

165. *Id.* at 3–4 ("The questions . . . before us, [include] what effect the 1952 Act had upon traditional statutory and judicial tests of patentability . . . . We have concluded that . . . the general level of innovation necessary to sustain patentability remains the same.").

166. See *id.* at 6 ("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.") (citing *A. & P. Tea Co. v. Supermarket Corp.*, 340 U.S. 147 (1950)).

167. See *id.* at 13–17 (rejecting the view that § 103 of the 1952 Act was intended to lower the level of non-obviousness required for patentability and instead construing the statute as enacting judicial views of non-obviousness).

*Fox Film Corporation*.<sup>168</sup> At issue in *Dastar* was how a particular use of Commerce Clause authority—Section 43 of the Lanham Act<sup>169</sup>—should be interpreted. Fox charged that Dastar, by editing and selling a public domain documentary without any attribution to the author, had misrepresented the “origin” of goods in violation of the Lanham Act.<sup>170</sup> Since the Lanham Act is clearly an exercise of Commerce Clause power, the independence-of-powers approach would see the Copyright Clause as having no relevance to the statutory construction issue in *Dastar*. To the contrary, the *Dastar* Court interpreted the Lanham Act with an eye towards avoiding a potential Copyright Clause conflict.<sup>171</sup> The court read “origin” to mean physical source—and not original authorship—since “[t]o hold otherwise would be akin to finding that § 43(a) created a species of perpetual patent and copyright, which Congress may not do.”<sup>172</sup> *Dastar* is thus powerful evidence that the limitations of the Copyright Clause have relevance to the exercise of Congress’s Commerce Clause powers.

### *B. Broad External Application of Copyright Clause Limitations*

At the other end of the spectrum is the view that the Copyright Clause’s limitations ought to apply broadly to any exercise of congressional power that is patent- or copyright-like. This is the strong form of the district court opinion in *Martignon*,<sup>173</sup> and a few commentators have taken such a hard-line approach.<sup>174</sup> The difficulty of this view—if terms like “copyright-like” are given a reasonably broad meaning—is that it is almost impossible to reconcile with the existence of federal trademark and trade secret protection. As discussed above, federal trademark law, though a species of intellectual property that affords rights in expression, is well accepted as a valid exercise of Commerce Clause power.<sup>175</sup> Though trade secret is principally a

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168. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

169. *Id.* at 31. *See also supra* notes 46–52 (explaining how Lanham Act is understood today as a valid exercise of Commerce Clause power).

170. *Dastar*, 539 U.S. at 25–27.

171. *See id.* at 34 (“[I]n construing the Lanham Act, we have been ‘careful to caution against misuse or over-extension’ of trademark and related protections into areas traditionally occupied by patent or copyright.”) (citing *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001)).

172. *Id.* at 37.

173. *See supra* notes 150–153 (discussing the district court decision in *Martignon*).

174. *See, e.g.*, Patton, *supra* note 13, at 1298–99 (agreeing with *Martignon*’s “copyright-like” approach and taking expansive view on when legislation is “within the scope of the Copyright Clause”). Patton notes that the existence of federal trademarks mean that “[n]ot all ‘copyright-like’ legislation . . . will necessary fall within the scope of the Copyright Clause,” *id.* at 1302, but it is unclear why this conclusion should not follow from his analysis.

175. *See supra* Part II.A.1.

creature of state law,<sup>176</sup> Congress has afforded some federal protection for trade secrets through the Economic Espionage Act of 1996 (the EEA).<sup>177</sup> The EEA creates criminal penalties for the misappropriation of another company's trade secrets,<sup>178</sup> thus granting protection for certain economically valuable ideas. If the "intellectual property-like" approach is taken literally, the EEA would rest on suspect constitutional grounds as it does not comport with the limitations of the Copyright (and Patent<sup>179</sup>) Clause—it affords potentially perpetual protection in ideas to individuals (the owners of trade secrets) who are not necessarily inventors or authors. However, like federal trademark protection, it is widely assumed that federal trade secret law is a valid exercise of Commerce Clause power.<sup>180</sup> The Supreme Court's analysis in *Kewanee Oil Corporation v. Bicron Corporation*, which upheld state trade secret law as not preempted by federal patent law or the Copyright Clause,<sup>181</sup> is suggestive of this conclusion. The *Kewanee* court took the view that trade secret and patent operated harmoniously within their separate spheres,<sup>182</sup> and thus trade secret did not seriously violate the purposes and limitations of patent law and the Copyright Clause.<sup>183</sup>

Given that neither the independence-of-powers nor a broad "copyright-like" view can be easily maintained, any approach to the Copyright/Commerce Clause collision must satisfy a few broad criteria if it is to be consistent with Supreme Court precedent. In particular, such a theory must set forth principles which define some sphere—narrow enough to exclude trademark, but broad enough to include core Copyright Act and patent laws like those in *Feist* and *Graham*—where Copyright Clause limitations will apply. Professor Thomas Nachbar is correct in that the question is one of *external application* across enumerated powers, a distinction "between limits that are internal to a particular constitutional provision and limits that apply throughout the

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176. Heald & Sherry, *supra* note 15, at 1194.

177. Pub. L. No. 104-294, 110 Stat. 3488 (codified at 18 U.S.C. §§ 1831–1839 (2012)).

178. See 18 U.S.C. § 1832(a) (2012) (prohibiting unauthorized appropriation of trade secrets).

179. Though I have used "Copyright Clause" as a shorthand for Article I, section 8, clause 8 throughout this piece, the constitutional provision is more completely named as the "Copyright/Patent Clause" since it forms the basis of congressional power for both areas of the law—i.e., protection for both "Writings" (copyright) and "Discoveries" (patent). See *supra* note 24 (establishing this shorthand). Since the EEA provides protection for ideas, it is more nearly "patent-like" than "copyright-like."

180. Heald & Sherry, *supra* note 15, at 1194–95 (using federal trade secret law as example of valid use of Commerce Clause power); Patry, *supra* note 16, at 394 (same).

181. *Kewanee Oil Corp. v. Bicron Corp.*, 416 U.S. 470, 474 (1974).

182. See *id.* at 493 ("Trade secret law and patent law have co-existed in this country for over one hundred years. Each has its particular role to play, and the operation of one does not take away from the need for the other.").

183. *Id.* at 480–92.

Constitution or are, for lack of a better term, external.”<sup>184</sup> But Nachbar is incorrect to view the internal versus external distinction as an all-or-nothing inquiry—i.e., that a Copyright Clause limitation must either (like the First Amendment) apply to all congressional actions, or instead solely to exercises of the Copyright Clause.<sup>185</sup> It is certainly possible that a particular Copyright Clause limitation will be applied externally to *some* uses of other enumerated powers and not to others. In fact, as this Part argues, defining such a sphere of applicability is the only way to make sense of Supreme Court precedent.

#### IV. THEORIES OF THE COPYRIGHT/COMMERCE CLAUSE CONFLICT

This Part reviews and analyzes the principal theories of the Copyright/Commerce Clause collision that have been offered in the case law and legal commentary, organizing them into five broad categories: (1) structural analogies; (2) textualist theories; (3) purpose-based theories; (4) values-based theories; and (5) subject matter theories. This organization synthesizes a voluminous academic literature, and offers a novel way to understand the strengths and shortcomings of the competing theories.

##### *A. Structural Analogy*

Structural-analogy theories typically argue for broad external application of the Copyright Clause’s limitations by likening the Copyright Clause to other constitutional provisions which have been applied to uses of the Commerce Clause or other congressional powers.<sup>186</sup> For example, former Professor William Patry’s analysis relies heavily on Professor Laurence Tribe’s work on the Treaty Clause.<sup>187</sup> Tribe argued that Article II, Section 2 of the Constitution—which requires treaties to be approved by a two-thirds majority of the Senate—precluded reliance on usual Article I powers to approve treaties by a simple majority of both houses.<sup>188</sup> Patry, in an influential law review article, draws an analogy between the Treaty Clause and the Copyright Clause, arguing that the Copyright Clause’s limitations ought

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184. Nachbar, *supra* note 15, at 297.

185. *Id.* at 295–98.

186. This “structural” categorization draws on related analyses offered by two other scholars. See Olliar, *supra* note 17, at 500–01 (discussing “structural inference” approaches); Nachbar, *supra* note 15, at 287–94 (discussing legal academia’s “rhetoric of structure”).

187. Patry, *supra* note 16, at 375–76.

188. See Laurence H. Tribe, *Taking Text Seriously: Reflections on Free-Form Method in Constitutional Interpretation*, 108 HARV. L. REV. 1221, 1249–78 (1995) (arguing that procedures laid on its Constitution’s Treaty Clause provide exclusive procedure for congressional approval of treaties).

to apply externally as well—precluding, in his view, federal database protection.<sup>189</sup> Professors Pollack, Heald, and Sherry have relied on a similar analogy to the Supreme Court’s jurisprudence on the Tenth and Eleventh Amendments, which have been held to limit the exercise of Commerce Clause power based on federalism principles.<sup>190</sup>

There are two serious problems with a structural-analogy approach. First, the worth of these arguments is heavily dependent on one’s view of the relevance and merit of the underlying analogy. All of these analogies will be imperfect since they rely on distinct constitutional contexts, and one can rather easily pick and choose analogies to advance one’s own policy interests.<sup>191</sup> As a result, it is unclear that these analogies really further the debate. Second, and more fundamentally, the structural-analogy view offers an incomplete theory of the Copyright/Commerce Clause collision. Structural analogies, by their nature, can only answer the question of *whether*—yes or no—Copyright Clause limitations should be applied externally. However, as Part III argued, the answer to this question—“sometimes”—is already clear from controlling Supreme Court precedents in the intellectual property context; there is thus no need to rely on distinct areas of constitutional jurisprudence. The true issue in the debate is *when* Copyright Clause limitations will apply externally and when they will not, and structural analogies do little to answer this critical question.

### B. Textualist Theory

Another theory of the Copyright/Commerce Clause collision examines the text of the Copyright Clause and attempts to distinguish between two types of restrictions on enumerated powers: those that represent a simple “lack of authority” to legislate, and those that are “affirmative limitations” on constitutional power. Only the affirmative limitations, the argument goes, will apply externally to uses of other congressional powers. This “textualist” theory stems from an attempt to reconcile the different outcomes in *Gibbons* and *Heart of Atlanta*, relying on the following distinction.<sup>192</sup> The Bankruptcy Clause’s

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189. Patry, *supra* note 16, at 375–76, 395–97.

190. See 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 UNIV. L. REV. 259, 270–74 (1995) (drawing comparison between Copyright Clause and Tenth Amendment limitations on Commerce Clause power); Heald & Sherry, *supra* note 15, at 1124 (finding Tenth and Eleventh Amendment federalism decisions as “very instructive” with regard to Copyright/Commerce Clause collision).

191. See Oliar, *supra* note 17, at 501 (“[C]ommentators applying structural inference [have] reached opposite conclusions . . . based on the context from which they chose to analogize.”).

192. See *Martignon*, 492 F.3d 140, 147–48 (2d Cir. 2007) (explaining this argument).



“uniform” requirement, at issue in *Gibbons*, is an affirmative limitation on congressional power; it requires all bankruptcy laws to be uniform.<sup>193</sup> In contrast, the Fourteenth Amendment—at issue in *Heart of Atlanta*—contains no such express limitations; the “state action” requirement of the *Civil Rights Cases* is merely a jurisdictional restriction that indicates a lack of authority.<sup>194</sup> As a result, the “uniformity” requirement applies to exercises of other congressional powers, but the “state action” requirement does not. This textualist argument was advanced forcefully at the appellate level in *Martignon*,<sup>195</sup> and some language in *Moghadam* suggests reliance on the theory.<sup>196</sup>

The essential failure of the textualist approach is that it offers no clear way to distinguish between affirmative limitations and jurisdictional bounds on grants of power. Consider, for example, the Copyright Clause’s provision that the rights secured be vested in “Authors,” which has been interpreted to mean that only original works may be copyrighted.<sup>197</sup> On the one hand, it is easy to argue this is a *Gibbons*-like affirmative limitation—just as the Bankruptcy Clause requires bankruptcy laws to be uniform, so the Copyright Clause requires copyrighted works to be original. But one could just as easily argue that “Authors” is a jurisdictional requirement. On this view, “Authors” indicates that the Copyright Clause only covers original works, just as the Fourteenth Amendment only relates to “state actions;” thus, the Copyright Clause simply lacks authority over unoriginal works. This insight has been stated more generally by Professor Nachbar: “Because the federal government is one of enumerated powers, it is easy to restate any ‘affirmative limitation’ on a grant of Congress’s power as a ‘lack of authority to legislate,’ and vice versa.”<sup>198</sup> In other words, *any* lack of authority in an enumerated power functions as a limitation on Congress’s power. Textualist theories thus offer little insight into which exercises of Commerce Clause power will be subject to Copyright Clause limitations.

### C. Purpose-Based Approaches

A third group of theories answers the question of when the Copyright

193. See *supra* notes 104–110 (explaining the facts and holding of *Gibbons*).

194. See *supra* notes 97–103 (explaining the facts and holding of *Heart of Atlanta*).

195. *Martignon*, 492 F.3d at 145, 147–48.

196. See *United States v. Moghadam*, 175 F.3d 1269, 1280 (11th Cir. 1999) (“[T]he Copyright Clause does not envision that Congress is positively forbidden from extending copyright-like protection [to unfixed works]. The grant itself is stated in positive terms, and does not imply any negative pregnant that suggests that the term ‘Writings’ operates as a ceiling. . .”).

197. See *supra* notes 53–58 (explaining the *Feist* decision).

198. Nachbar, *supra* note 15, at 295.

Clause's limitations ought to apply to the Commerce Clause by reference to either the purposes underlying each grant of power, or Congress's aim in enacting the legislation at issue. Versions of this approach abound in academic commentary.<sup>199</sup> One variation on this theory employs notions of purpose to classify legislation as an exercise of one power or the other,<sup>200</sup> another version incorporates purpose to weigh the harm done to a particular clause's goals against the valid exercise of the other power.<sup>201</sup>

For example, Andrew Hetherington offers a straightforward version of a purpose-based approach.<sup>202</sup> Hetherington argues that the resolution of the Copyright/Commerce Clause conflict lies in "the relationship between the constitutional purposes of the respective clauses."<sup>203</sup> Determining whether Copyright Clause limitations apply will depend on whether, for a given law, the purpose of "promot[ing] the Progress of Science" under the Copyright Clause predominates over the purpose of "enabling free trade" under the Commerce Clause.<sup>204</sup>

A more sophisticated version of a purpose-based approach was articulated recently by Professor Jeanne Fromer. Professor Fromer's theory, like Hetherington's, looks to the purpose of the challenged legislation as triggering the limitations of the Copyright Clause: "when legislation has the structural purpose of promoting the progress of science and useful arts, it must restrict itself to the means specified in the [Copyright] Clause."<sup>205</sup> There is an important caveat, however, for laws that have multiple purposes. If clear and convincing evidence shows that Congress intentionally chose to supersede the Copyright Clause's limitations pursuant to a legitimate, alternative purpose (say, regulating a national economy), then the law is constitutional.<sup>206</sup>

Purpose-based approaches succeed in the abstract, in that they articulate general principles which may yield an appropriate sphere of

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199. See, e.g., Danitz, *supra* note 13, at 1149 (arguing that "Congress' discretion to enact copyright-like protections is restricted only where the 'essential' purpose of the Copyright Clause is threatened"). See also *infra* notes 200–201 (citing to other purpose-based theories).

200. See Merschman, *supra* note 86, at 689 ("[T]he key question [in the Copyright/Commerce Clause collision] is, under which power does this legislation truly belong? The answer to that question lies in the purposes behind different powers.").

201. See Bathaee, *supra* note 13, at 507 (advocating a balancing test that weighs "how vital the doctrine being circumvented is to the constitutional provision in which it originates from . . . against the burden it will place on the [other] constitutional power").

202. See generally Andrew M. Hetherington, Comment, *Constitutional Purpose and Inter-Clause Conflict: The Constraints Imposed on Congress by the Copyright Clause*, 9 MICH. TELECOMM. & TECH. L. REV. 457 (2003).

203. *Id.* at 460.

204. *Id.* at 504–05.

205. Fromer, *supra* note 15, at 1333.

206. Fromer, *supra* note 15, at 1376–77.

applicability for the Copyright Clause's limitations. But a purpose-based approach simply shifts the existing debate to a different level: What *are*, precisely, the purposes of the Copyright and Commerce Clauses? The text of the Copyright Clause offers some guidance, in that its preamble specifies its intention that Congress may act only "[t]o promote the Progress of Science and useful Arts."<sup>207</sup> But the Copyright Clause is unusual in this respect; the Commerce Clause states only that Congress may "regulate Commerce . . . among the several States."<sup>208</sup> Is its purpose to create a uniform commercial law? To promote economic prosperity? The history of each clause's enactment and common law background will provide some answers to these questions, of course, though they are likely to be contested ones.

Even more contentious will be the inquiry as to when one clause's purpose should "take precedence" over another,<sup>209</sup> how to classify congressional action with multiple purposes,<sup>210</sup> or when a particular piece of legislation is so violative of the Copyright Clause's purposes so as to prohibit reliance on another power.<sup>211</sup> For example, consider federal trade secret legislation. Is the purpose of such protection to promote fair competition (presumably a legitimate Commerce clause aim) or to encourage innovation (in which case Copyright Clause limits apply)?<sup>212</sup> There is no obvious answer. Similar indeterminacy arises when purpose-based views are applied to the anti-bootlegging statutes. In the view of some commentators, these statutes "complement" Copyright Clause purposes by protecting unfixed as well as fixed works;<sup>213</sup> according to others, they undermine core copyright values by granting perpetual protection without requiring creation of a fixed copy to fall into the public domain.<sup>214</sup> At best, a purpose-based approach runs a risk of being indeterminate; at worst, looking to debatable notions of purpose may invite courts to impose their normative view of a piece of

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207. U.S. CONST. art. I, § 8, cl. 8.

208. U.S. CONST. art. I, § 8, cl. 3.

209. See Hetherington, *supra* note 202, at 505 (advocating case-by-case approach in which courts determine which clause's purpose "takes precedence over the other").

210. See Fromer, *supra* note 15, at 1376–77 (proposing burden-shifting framework for evaluating constitutionality of laws with multiple purposes).

211. See Bathae, *supra* note 13, at 507 (advocating a balancing test in which courts engage in such an inquiry).

212. See S. REP. NO. 104-359, § 2 (1996) (describing purposes of EEA as *both* to protect proprietary commercial information from misappropriation, and to secure exclusive rights in authors).

213. See Giuliano, *supra* note 13, at 377 ("Properly understood, the federal anti-bootlegging statute protects copyright, commerce, and free speech concerns by complementing, rather than undermining, the Copyright Clause.")

214. See Merschman, *supra* note 86, at 681–89 (arguing that the fixation requirement is a constitutional, fundamental part of Copyright Clause purposes which Congress can not avoid through reliance on Commerce Clause power).

legislation into the Copyright/Commerce Clause inquiry.

#### *D. Values-Based Theories*

The next group of theories attempts to identify particular normative value(s) that, when implicated, mandate the external application of Copyright Clause limitations. This Part reviews three such theories, one drawn from the case law and two others that have been advanced in leading law review articles.

##### 1. “Fundamental Inconsistency”

The *Moghadam* court—the first modern court to be confronted with the Copyright/Commerce Clause collision—summarized its conclusions in the following language: “[T]he Commerce Clause can provide the source of Congressional power in this case because the extension of copyright-like protection here is not *fundamentally inconsistent* with the fixation requirement of the Copyright Clause.”<sup>215</sup> This “fundamentally inconsistent” test has since become a common view in the case law. The decisions in *KISS II*, *Elcom*, and the district court in *Martignon* have all relied upon notions of fundamental inconsistency in their analysis.<sup>216</sup>

Despite its prevalence, “fundamental inconsistency” has been given no agreed-upon substantive meaning, causing courts to fall back on other approaches. Most of the analysis in *Moghadam* relied on textual notions to reach its conclusion, arguing that “Writings,” properly understood, was not an “affirmative limitation” at all.<sup>217</sup> In contrast, *Elcom* looked to the purposes of the Copyright and Commerce Clauses and the DMCA’s copyright-related costs and benefits.<sup>218</sup> The district court in *Martignon*—perhaps recognizing the ambiguous nature of the phrase—appeared to equate “fundamentally inconsistent” and “inconsistent,” finding the *Moghadam* test satisfied because the Copyright Clause required a durational limitation and anti-bootlegging

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215. *United States v. Moghadam*, 175 F.3d 1269, 1282 (11th Cir. 1999) (emphasis added).

216. See *KISS II*, 405 F. Supp. 2d 1169, 1176 (C.D. Cal. 2005) (“Even if a ‘fundamental conflict’ with the Copyright Clause would invalidate the Statute, none exists here.”); *Martignon SDNY*, 346 F. Supp. 2d 413, 428–29 (S.D.N.Y. 2004) (arguing that anti-bootlegging statute is “fundamentally inconsistent” with Copyright Clause’s “limited Times” requirement); *United States v. Elcom Ltd.*, 203 F. Supp. 2d 1111, 1138–41 (N.D. Cal. 2002) (stating and applying test of “whether the DMCA is nevertheless ‘irreconcilably inconsistent’ with a limitation contained within the Intellectual Property Clause.”).

217. *Moghadam*, 175 F.3d at 1280.

218. *Elcom*, 203 F. Supp. 2d at 1138–41.

statute did not have one.<sup>219</sup> But a simple “inconsistency” test will always result in a finding of unconstitutionality. Any instance of a Copyright/Commerce Clause collision necessarily involves an inconsistency, in that the Copyright Clause contains a limitation or requirement that the legislation at issue fails to satisfy.

Without more substantive content, the “fundamental inconsistency” test does little more than restate the problem. Because any instance of a Copyright/Commerce Clause conflict involves an “inconsistency,” the crux of the issue is when this inconsistency is “fundamental.” Answering that question would seem to require reliance on some outside authority—the purpose, text, or history of the Copyright and Commerce Clauses, policy judgments, etc. Typically, then, the invocation of a “fundamental inconsistency” test merely masks reliance on one of the other theories presented in this Part, or a court’s normative approval or disapproval of the legislation. The array of differing conclusions in the case law about which conflicts are or are not “fundamental” provides strong evidence for this conclusion.<sup>220</sup>

## 2. “Constitutional Norms”

Professor Thomas Nachbar, in one of the leading articles on the Copyright/Commerce Clause collision, argues that Copyright Clause limitations do not in any way restrain Congress’s exercise of Commerce Clause power.<sup>221</sup> Nachbar’s theory draws a line between constitutional limitations like the First Amendment, or notions of federalism found in the Tenth Amendment—which, he agrees, are generally applicable to all exercises of Congressional power<sup>222</sup>—and many other limitations in enumerated powers that do not merit such external application. For example, the Piracy Clause grants Congress the power to punish “Felonies committed on the high Seas,”<sup>223</sup> but no one seriously suggests this phrase limits the ability of Congress to punish land-based felonies pursuant to its Commerce powers.<sup>224</sup> The distinguishing factor between these two extremes, in Nachbar’s view, is the notion of a “constitutional norm,” which he defines as “a rule required by and even inherent in the form of government adopted in the Constitution.”<sup>225</sup> Nachbar’s central

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219. *Martignon SDNY*, 346 F. Supp. 2d at 428–29.

220. See *infra* notes 131–157.

221. See Nachbar, *supra* note 15, at 277 (“The Intellectual Property Clause and its limits do not represent generally applicable constitutional norms and Congress may therefore legislate pursuant to the Commerce Clause without regard to the Intellectual Property Clause or its limits.”).

222. *Id.* at 291, 297 (noting these provisions are applied to all exercises of congressional power).

223. U.S. CONST. art. I, § 8, cl. 10.

224. Nachbar, *supra* note 15, at 295.

225. *Id.* at 317.

claim is that only limitations which rise to the level of a constitutional norm merit external application. After an examination of the history of the Copyright Clause, Nachbar concludes it contains no such constitutional norms, and so the limitations of the Copyright Clause have no relevance to exercises of Commerce Clause power to enact copyright-like legislation.<sup>226</sup>

Though Nachbar makes a forceful case for his conclusion, there are several problems in his analysis. First, as noted above, it is rather difficult to understand the holdings of Supreme Court precedents like *Dastar*, *Feist*, and *Graham* on a complete independence-of-powers view (which, functionally, Nachbar's argument represents).<sup>227</sup> *Gibbons* presents particular problems for Nachbar, though he takes pains to attempt to distinguish the case.<sup>228</sup> Given the result in *Gibbons*, Nachbar concedes—as he must—that the Bankruptcy Clause's "uniformity" requirement represents a "constitutional norm."<sup>229</sup> But if uniform bankruptcy laws are "inherent in the form of government adopted in the Constitution," it is hard to see why, for example, time-limited copyright laws are not equally inherent.

Perhaps the most troubling aspect of Nachbar's analysis is that his all-or-nothing framing of the question seems tailored to lead to his conclusion. As alluded to above,<sup>230</sup> Nachbar is correct to consider the Copyright/Commerce Clause collision as a question of when limitations will be externally applied. However, there is no *a priori* basis to conclude that limitations on enumerated powers must be divided into only two groups, those which are constitutional norms (and so externally applicable to *all* exercises of congressional power), and those which are not (and so *never* externally applicable). No one seriously contends that, for example, the "limited Times" provision of the Copyright Clause means that all congressional actions shall be durationally-limited in the same way that the First Amendment implies that all congressional action not abridge the freedom of speech. The claim, rather, is that the Copyright Clause's limitations should apply to some limited sphere of congressional action within the clause's purview. In short, there is no reason to believe that a limitation must rise to the level of a

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226. *See id.* at 329–50, 361 (examining history surrounding enactment of Intellectual Property Clause and concluding "there is no way to locate in either Supreme Court precedent or constitutional history a sufficiently strong countervailing constitutional norm to warrant the external application of the Intellectual Property Clause's limits").

227. *See supra* Part III.A (detailing difficulties of reconciling an independence-of-powers view with prominent Supreme Court precedents).

228. Nachbar, *supra* note 15, at 314–17.

229. *See id.* at 316–17 ("[T]he Court [in *Gibbons*] perceived the uniformity requirement as mirroring an explicit (and therefore generally applicable) limitation . . .").

230. *See supra* Part III.B.

constitutional norm to be, in some limited degree, externally applicable.

### 3. Fundamental Intellectual Property Principles

A final values-based theory—prominently advanced by Professors Heald and Sherry<sup>231</sup>—looks to “principles” embodied in the Copyright Clause to define certain limitations which absolutely constrain congressional power.<sup>232</sup> Relying on history and common law surrounding the enactment of the Constitution, Heald and Sherry find four “principles of constitutional weight” embedded in the Copyright Clause. These principles, they argue, cannot be violated by Congress in the exercise of any of its powers.<sup>233</sup> The first such principle—termed the “Suspect Grant Principle”—provides a jurisdictional restriction on the theory: the limitations defined by the other three principles apply only to “legislation that imposes monopoly-like costs on the public through the granting of exclusive rights.”<sup>234</sup> The other three principles define substantive limits when Congress acts in this area, and require that (1) exclusive rights only be granted if the public secures a countervailing benefit in return (the Quid Pro Quo Principle);<sup>235</sup> (2) rights may only be granted to authors of new creation (the Authorship Principle);<sup>236</sup> and (3) the public domain must remain inviolate (the Public Domain Principle).<sup>237</sup>

Heald and Sherry amass an impressive quantity of historical evidence in support of their conclusions.<sup>238</sup> Functionally, their “Suspect Grant Principle” may operate in much the same way as the subject matter

231. *See generally* Heald & Sherry, *supra* note 15.

232. There is some superficial similarity between the approach of Heald and Sherry and the purpose-based approaches discussed in Part IV.C, *supra*, in that both inquire into underlying policies behind the Copyright Clause. However, Heald and Sherry’s analysis is far more complete than the typical invocation of “purpose,” in that they have completely specified the values they believe are involved. Thus, I have chosen to classify their argument as a “values-based” approach, though, of course, the lines between these categories are to some degree artificial.

233. *See* Heald & Sherry, *supra* note 15, at 1123 (“[W]e examine the underlying history and structure of the Intellectual Property Clause in order to determine which of its limits are so fundamental that they should absolutely constrain Congress’s power . . . we call [these limitations] ‘principles of constitutional weight.’”).

234. *Id.* at 1160.

235. *See id.* at 1162 (“Congress may grant exclusive rights only if the grant is an attempt to secure a countervailing benefit to the public. We refer to this as the Quid Pro Quo Principle.”).

236. *See id.* at 1164 (“[T]he Authorship Principle demands that Congress initially direct exclusive grants to those who provide the public with the new creation.”).

237. *See id.* at 1165 (“The principle of an inviolable public domain is the necessary implication of the constant emphasis in history and in precedent—and in the wording of the Clause itself—on the requirement that grants be for a limited time.”).

238. *See id.* at 1130–60 (examining wide array of historical sources to support proffered principles of constitutional weight).

approach for which this Article advocates. But it will do so in a curiously circuitous and needless complex manner, as Heald and Sherry's three substantive principles appear to largely trace the limitations traditionally understood to be embodied in the language of the Copyright Clause.<sup>239</sup> Resort to "fundamental principles" derived from historical analysis is not needed when one can reach the same result directly from the text of the Copyright Clause. For example, recourse to a historical "Authorship Principle" is unnecessary when one can simply cite the express text of the Copyright Clause, which provides that rights be granted only to "Authors." Moreover, reliance on contested historical analysis—as opposed to express textual command—may run a risk of undermining the intellectual property principles Heald and Sherry clearly believe in. Despite this non-trivial difference in form, however, the Heald and Sherry theory will often, in practice, reach similar conclusions as the subject matter approach for which this Article advocates.

#### *E. Subject Matter Approaches*

The last group of theories defines when Copyright Clause limitations will apply externally by reference to the material being regulated and the specific rights granted over that material, that is, the subject matter of the challenged law. An expansive subject matter approach is exemplified by the district court opinion in *Martignon*, which held Copyright Clause limitations applicable whenever a piece of legislation is "copyright-like."<sup>240</sup> The problem with this approach—depending on how broadly the phrase "copyright-like" is defined—is that, taken literally, it would seem to render federal trademark and trade secret protection unconstitutional.<sup>241</sup>

The Second Circuit's opinion in *Martignon* relied on a narrower subject-matter-based approach, holding that Copyright Clause limitations apply only to "copyright laws," which it defines as acts which "create, bestow, or allocate property rights in expression."<sup>242</sup>

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239. See *supra* notes 24–31 and accompanying text (explaining four limitations generally understood to be required by the text of the Copyright Clause).

240. See *Martignon SDNY*, 346 F. Supp. 2d 413, 424–25 (S.D.N.Y. 2004) ("In order to give meaning to the express limitations provided in the Copyright Clause, when enacting copyright-like legislation . . . Congress may not . . . enact the law under a separate grant of power . . .").

241. See *supra* Part III.B.

242. *Martignon*, 492 F.3d 140, 150 (2d Cir. 2007). The *Martignon* court took pains to note that it did not mean to "cast doubt" upon the constitutionality of the Lanham Act with this definition, even though the Act "might be thought to allocate property rights in (unoriginal) expression." See *Martignon*, 492 F.3d at 150 n.6. The *Martignon* court indicated it did not believe the Lanham Act could be considered a "copyright law" under this definition, though it did not elaborate on its reasoning. *Id.* For an explanation for why federal trademark law should not be considered a "copyright law" under the



Following on the *Martignon* decision, Professor Aaron Perzanowski has articulated a categorical subject matter approach, arguing that Copyright Clause limitations apply whenever Congress grants “exclusive rights in expression.”<sup>243</sup> For the reasons expressed in the next Part, this Article agrees that a subject matter approach offers the best resolution of the conflict between the Copyright and Commerce Clause. However, the shortcoming of both *Martignon* and Perzanowski’s formulation is that they leave the precise scope of “exclusive rights in expression” undefined, leading to sharply different results in the application of their tests.<sup>244</sup> By contrast, this Article’s proposal offers a more nuanced subject matter test, articulating several factors that determine when a law grants property rights in expression. The details of this proposal are explored in the next Part.

## V. DEFINING THE COPYRIGHT CLAUSE’S SUBJECT MATTER

This Part justifies and elaborates upon the subject matter approach. The first section argues that tying Copyright Clause limitations to a limited subject matter is a workable approach which offers the most defensible understanding of key precedents. Functionally, it operates to protect core copyright values within their traditional sphere, preventing the dilution that might result from broader applicability. The second section more fully elaborates on the factors that constitute the “copyright law” inquiry: the activities proscribed, the material protected, and the specific rights granted.

### A. *The Virtues of a Subject Matter Approach*

#### 1. Protecting Constitutional Copyright Principles

Courts and commentators who oppose the anti-bootlegging statutes or database protection frequently remark that allowing Congress to rely on the Commerce Clause to uphold copyright-like legislation would write the limitations of the Copyright Clause out of the Constitution.<sup>245</sup> This *reducio ad absurdum* argument relies upon the canon of statutory

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subject matter approach, see *infra* Part VI.A.

243. Aaron K. Perzanowski, *The Penumbra Public Domain: Constitutional Limits on Quasi-Copyright Legislation*, 10 U. PA. J. CONST. L. 1081 (2008).

244. See *id.* at 1140–43 (criticizing the *Martignon* decision as failing to “faithfully appl[y]” the subject matter test when it concluded that the criminal anti-bootlegging statute was not a “copyright law”).

245. See, e.g., Peterson, *supra* note 13, at 744 (“If this [independence-of-powers] line of reasoning were applied as a blanket rule, the Commerce Clause would render useless many provisions of the Constitution.”).

construction that one part of a law should not be construed so as to render another part superfluous.<sup>246</sup> Taken literally, this argument proves too much. At its core, it is really an argument against modern, expansive interpretations of the Commerce Clause power, which have undeniably rendered some Article I powers superfluous.<sup>247</sup> Whatever one's views on the original intent of the Commerce power, national economic regulation by Congress is a reality.

As a result, those who wish to maintain any effective constitutional force to the Copyright Clause's limitations are best served by cabining their claims to a limited, well-defined area. Defining a sphere of subject matter through a "copyright law" test is a natural, intuitive way to achieve this. A subject matter test will focus principally on the means—and not the ends—of the congressional action, and thus will not unduly restrict Congress's broad powers to regulate commerce. For example, if Congress, in the exercise of its economic prerogatives, chooses to encourage database creation, it may do so in a variety of ways: tax benefits, criminal penalties, or even something like trade secret protection (which targets misappropriation—not simple copying—and has distinct prerequisites to protection<sup>248</sup>). The only thing it may not do is generally prohibit copying by granting individuals property rights in the expression—i.e., create a "copyright law" for unoriginal works.

The Copyright Clause indeed expresses the balance struck by the Framers between incentives to create and public access, but does so in a particular regulatory area.<sup>249</sup> Expanding the well-defined limitations of the Copyright Clause to a wide subject matter area may, counterintuitively, risk undermining them. For example, imagine that *The Trade-Mark Cases* had upheld the Trade-Mark Act of 1876 under Copyright Clause power, but only insofar as it protected marks that were "original." A predictable consequence of this system would be a loosening of notions of originality, as courts stretch the originality doctrine to cover moderately creative marks like, say, "Tide Detergent," seeking to vindicate the expectations and investment of the first registrant, facilitate commerce, and avoid consumer confusion. These

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246. See *TRW Inc. v. Andrews*, 534 U.S. 19, 31 (2001) ("It is a cardinal principle of statutory construction that a statute ought, upon the whole, to be so construed that, if it can be prevented, no clause, sentence, or word shall be superfluous, void, or insignificant.") (citing *Duncan v. Walker*, 533 U.S. 167, 121 (2001)).

247. See, e.g., U.S. CONST. art. I, § 8, cl. 5 (granting Congress power "[t]o coin Money"). Since money is an "instrumentality of interstate commerce," regulation of money would seem well within the modern scope of the Commerce Clause. See *United States v. Lopez*, 514 U.S. 549, 558–59 (1995).

248. Trade secret protection typically requires that the information protected be "nonpublic" (that is, a secret) and that "reasonable measures to keep such information secret" be employed. See, e.g., 18 U.S.C. § 1839(3) (2012) (defining "trade secret" as used in the Economic Espionage Act of 1996).

249. See *KISS II*, 405 F. Supp. 2d 1169, 1175 (C.D. Cal. 2005) ("[T]he Copyright Clause allows Congress to protect a narrowly defined subject matter within defined parameters.").

diluted notions of originality would then risk importation into the traditional realm of copyright laws.

Similarly, arguing that all Copyright Clause limitations must apply when Congress seeks to protect databases or live musical performance (regardless of the form of protection) may risk watering down these limitations, as courts bend doctrine so as to avoid the grave act of invalidating majoritarian legislation. For example, if protection for live musical performances could only be had via the Copyright Clause, a court may well interpret “Writings” not to require fixation in order to avoid striking down an act of Congress; this holding, though designed to solve a particular pragmatic problem, would have ramifications throughout the whole of copyright law. Thus, keeping the Copyright Clause tethered to a narrow area of “copyright laws” actually promotes Copyright Clause values by maintaining robust notions of originality, fixation, and so on, within their traditional sphere.

## 2. Consistency with Precedent

Another advantage of the subject matter approach is its convincing reconciliation of the leading Supreme Court cases, *Gibbons* and *The Trade-Mark Cases*.<sup>250</sup> Recall that *The Trade-Mark Cases*, considering whether trademark legislation was within Congress’s powers, looked without any comment to the Commerce Clause as an alternate source of authority, while *Gibbons* held a similar move was not possible in the context of the RITA bankruptcy law. The Second Circuit in *Martignon* explained the line between these two decisions as follows:

The *Gibbons* Court considered primarily what RITA *did*, not Congress’s belief as to which clause authorized its action. RITA mandated that an existing bankruptcy proceeding be handled differently from any other bankruptcy in the United States. It also altered the statutory priorities for paying debts and the administrative scheme contemplated by the Bankruptcy Code. . . . The *Gibbons* Court found that RITA was actually a bankruptcy law, not that it was . . . bankruptcy-like.<sup>251</sup>

This distinction goes a long way to understanding the inter-Clause collision precedent. *The Trade-Mark Cases* dealt with legislation that was, at most, copyright-like. Though trademarks grant exclusionary rights to individuals, the activity proscribed—confusing use of another’s mark in commerce—is distinct from the key copyright right, a general prohibition on unauthorized reproduction.<sup>252</sup> In contrast, it is hard to see

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250. See *supra* Part II.B.1 (reviewing the facts and holdings of these cases).

251. *Martignon*, 492 F.3d 140, 149 (2d Cir. 2007) (emphasis added).

252. See *infra* Part VI.A (explaining in greater detail why trademarks are not “copyright laws”).

how RITA is not a bankruptcy statute: it changed the priority of repayment (the key feature of bankruptcy law) in a bankruptcy proceeding.

Note that this analysis does not foreclose Congress from achieving the result it intended in RITA—securing economic benefits for employees laid off by a bankrupt railroad—through other types of legislation. Congress would be free to pass an unemployment benefits package, create a special civil tort action, or offer tax refunds to the employees. Congress might even pass a special tax transferring wealth from the creditors at issue to the employees—though such an act might not survive Takings Clause scrutiny,<sup>253</sup> it is hard to see why it would present problems under the Bankruptcy Clause. On this reading, the core statement of *Gibbons* is “Congress may not pass a nonuniform bankruptcy law.” Similarly, Congress may not pass, for example, a temporally-unlimited copyright law. However, it may (as *The Trade-Mark Cases* implicitly held) pass temporally-unlimited legislation that does not have the core features of a copyright law.

### 3. Workability and Definiteness

In contrast to several of the competing theories,<sup>254</sup> the “copyright law” test is a simple, reasonably definite approach. Instead of relying on, for example, highly contested notions of congressional purpose, or whether values or inconsistencies are “fundamental,” the “copyright law” test relies on concepts—the activities proscribed, the material protected, and the character of the rights granted<sup>255</sup>—which are clear from the face of the statute at issue. Further, the central focus of the inquiry draws on traditional intellectual property notions—like exclusive, individual property rights—with which judges are already familiar and, often, have well-established meanings in existing copyright doctrine. Though there will inevitably be gray areas at the margin, the subject matter approach promises a clear, workable inquiry.

### 4. Empty Formalism?

One primary objection to the subject matter approach is that it is a highly formalist theory: what Congress may or may not do depends on *how* it chooses to act, not on the ultimate results or purposes of its

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253. The Fifth Amendment’s Takings Clause prohibits private property from being taken “for public use” without just compensation. U.S. CONST. amend V.

254. See *supra* Part IV.A–D (reviewing four theories of the Copyright/Commerce Clause collision).

255. See *infra* Part IV.B (defining each of these inquiries).

action. For example, as we shall see below,<sup>256</sup> the subject matter approach advanced here means that Congress may prevent bootlegging of live musical performances through criminal penalties, but not civil liability. The theory is admittedly a formalistic one, but this is largely by design:<sup>257</sup> it is a formalistic solution to a formalistic problem. This approach finds support in *South Dakota v. Dole*,<sup>258</sup> a Supreme Court case on a different conflict of powers that is often overlooked in examining the Copyright/Commerce Clause collision. The constitutional provisions at issue in *Dole* were the 21st Amendment—which has been interpreted to reserve to the states broad powers over the regulation of alcohol<sup>259</sup>—and Congress’s spending power.<sup>260</sup> Pursuant to its spending power, Congress enacted a law which denied states federal highway funds if they did not set the minimum drinking age at 21 years or higher.<sup>261</sup> South Dakota—whose laws allowed 19- and 20-year-olds to buy low-alcohol beer—relied on the 21st Amendment to challenge the federal law as beyond Congress’s power.<sup>262</sup> The Court held that the conditioning of federal funds was valid “even if Congress may not regulate drinking ages directly.”<sup>263</sup>

The lesson of *Dole* is that Congress may often accomplish an objective indirectly, even when the Constitution appears to forbid the most direct means to achieve that goal. This formalism does not make the language of the 21st Amendment—or of the Copyright Clause—into dead letter law. The reason, of course, is that different means of congressional action carry different political costs, and so a restraint on means may well change the legislative outcome. Take the anti-bootlegging statutes as an example. Though Congress easily passed both criminal and civil penalties against bootlegging, it is easy to imagine a world in which the political capital exists to create civil remedies for bootlegging, but Congress is unwilling to bring down the heavy arm of the criminal law on tens of thousands of (voting) Phish

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256. See *infra* Part VI.D (analyzing the anti-bootlegging statutes under a “copyright law” test).

257. See *supra* Part V.A.1 (explaining how the formalistic nature of the “copyright law” inquiry prevents undue encroachment on Congress’s broad power over commerce so as not to undermine Copyright Clause limitations).

258. *South Dakota v. Dole*, 483 U.S. 203 (1987).

259. See *id.* at 205; *California Retail Liquor Dealers Ass’n v. Midcal Aluminum, Inc.*, 445 U.S. 97, 110 (1980) (“The Twenty-first Amendment grants the States virtually complete control over whether to permit importation or sale of liquor and how to structure the liquor distribution system.”).

260. U.S. CONST. art. I, § 8, cl. 1 (“The Congress shall have Power To lay and collect Taxes, Duties, Imposts and Excises, to pay the Debts and provide for the common Defence and general Welfare of the United States . . .”).

261. See 23 U.S.C § 158 (2012).

262. *Dole*, 483 U.S. at 205.

263. *Id.* at 206.

fans.<sup>264</sup> Further, two given means will rarely be *identical* ways of achieving a result. Again using civil versus criminal enforcement as a comparison, the government must exercise prosecutorial discretion and expend government resources in enforcing criminal law; such choices are entirely left to private actors in the civil context.

### B. “Copyright Laws”: Core Factors

The Second Circuit in *Martignon* defined “copyright laws” as legislative acts which “create, bestow, or allocate property rights in expression.”<sup>265</sup> While this is a fine starting point, *Martignon* did not offer an expansive definition of these terms. This section fills that gap by elaborating the key elements of the “copyright law” inquiry: the activity proscribed, the material protected, and the nature of the rights granted. The general “copyright law” approach will be a kind of balancing test which weighs the degree of similarity or dissimilarity across these factors. While strict identity of each element is not required to make an act of Congress a “copyright law,” a significant difference in even a single factor may be enough to make a law merely copyright-like.

#### 1. Caveats

##### a. Avoiding Circularity

At the outset, it is important to observe a critical caveat to the analysis that follows: The express limitations in the Copyright Clause—i.e., limited times, originality, and fixation—may not themselves be relied upon to define what constitutes a “copyright law.” To do so would deny *any* applicability to the limitations of the Copyright Clause, as the alleged constitutional deficiency of a piece of legislation could be relied upon to save it. For example, opponents of anti-bootlegging statutes argue that the laws are unconstitutional because they protect unfixed artistic works in violation of the Copyright Clause’s command that rights may be secured in “Writings” only.<sup>266</sup> Under the approach for which this Article advocates, the resolution of this argument will hinge

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264. Phish is an American rock band known for a devoted fan base that makes recordings of their live performances. See Wikipedia.com, Phish – Live performances, <http://en.wikipedia.org/wiki/Phish> (last visited February 5, 2013) (“Phish fans have been noted for their extensive collections of fan-taped concert recordings . . .”).

265. *Martignon*, 492 F.3d 140, 150 (2d Cir. 2007).

266. See *supra* Part II.A.4 (presenting argument that the anti-bootlegging statutes are unconstitutional).

on whether the anti-bootlegging statutes are “copyright laws.” To maintain that the anti-bootlegging statutes are not copyright laws because copyright laws protect only fixed works (or only original works, or protect only in a time-limited manner) simply begs the question. Courts have generally recognized the “circuitous” nature of such analysis and rejected these arguments.<sup>267</sup>

*b. “Copyright Law” as a Term of Art*

Secondly, it is critical to note that the term “copyright law” is employed here as a term of art for purposes of analyzing the Copyright/Commerce Clause collision. In this context, “copyright law” is used to delineate what this Article has referred to previously as a “sphere of applicability”<sup>268</sup> for the Copyright Clause’s limitations: that is, those laws which are so similar to core copyright protection that they must comply with the Copyright Clause’s limitations. In order to avoid unduly trammeling Congress’s power to regulate national commerce—and thus preserve the robust limitations of the Copyright Clause within their traditional sphere<sup>269</sup>—the definition of “copyright law” that follows is a carefully circumscribed conception, incorporating only the most central elements of copyright law. For example, the definition focuses principally on the proscription against unauthorized reproduction when discussing the actions proscribed by copyright,<sup>270</sup> though many other acts—such as unauthorized creation of derivative works, or unauthorized public performance—are proscribed by the modern copyright statute.<sup>271</sup>

To be clear, “copyright law,” as used below, is *not* meant to represent the limits of Congress’s powers under the Copyright Clause. Obviously, in conjunction with the Necessary and Proper Clause,<sup>272</sup> Congress possesses broad powers to enact laws in the area of intellectual property.

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267. See *Martignon SDNY*, 346 F. Supp. 2d 413, 425 n.17 (S.D.N.Y. 2004) (“The government argues, circuitously, that because the anti-bootlegging statute regulates a subject matter, live performances, that is not copyrightable—by virtue of the lack of fixation and durational limitation—Congress was not bound by the Copyright Clause’s restrictions. I find this argument to be wholly unconvincing.”).

268. See *supra* Part III (arguing that, to be consistent with Supreme Court precedent, any theory of Copyright/Commerce Clause collision must delineate some limited sphere in which the Copyright Clause’s limitations will be externally applied).

269. See *supra* Part V.A.1 (arguing that limited subject matter approach operates to preserve traditional Copyright Clause values and limitations by not stretching them beyond the traditional realm).

270. See *infra* Part V.B.2.

271. See 17 U.S.C. § 106 (2012) (listing exclusive rights of copyright holders).

272. U.S. CONST. art. I, § 8, cl. 18. See also *McCulloch v. Maryland*, 17 U.S. (4 Wheat.) 316, 421 (1819) (defining “necessary and proper” broadly, to include all “appropriate” means to achieve an end that is legitimate, and within the scope of the Constitution).

Thus, for example, the Copyright Act of 1976's criminal enforcement provisions<sup>273</sup> are easily a proper exercise of Copyright Clause powers even though they do not “secure[e] . . . Right[s]”<sup>274</sup> in any individual—enforcement is left to the government.<sup>275</sup> Criminal copyright provisions are thus within the Copyright Clause power, even though they are not a “copyright law” as the term is used below. But however broad the scope of Congress's necessary and proper powers under the Copyright Clause, they cannot be used to enact laws which defy the express restrictions of the Copyright Clause.<sup>276</sup> It is those laws which fail to satisfy a Copyright Clause limitation—and must be justified, if at all, under a different enumerated power—that are subject to the “copyright law” inquiry that follows.

## 2. What Actions are Proscribed

A natural way to begin the “copyright law” inquiry is to look to the particular actions the law at issue proscribes. Though the modern copyright statute provides a variety of actionable violations—prohibiting, *inter alia*, the unauthorized public performance or public display of a copyrighted work<sup>277</sup>—the key proscription is the first listed: the reproduction of a copyrighted work without consent of the copyright holder.<sup>278</sup> The first Copyright Act of 1790—the prototypical “copyright law” for constitutional purposes—unsurprisingly focused its prohibitions against unauthorized reproduction.<sup>279</sup> Copyright laws, as their name suggests, are an exclusive right in *copying*. Thus, before delving into the more nuanced inquiries of the “copyright law” test, it is an often helpful heuristic to ask the simple question: does the law at issue proscribe copying, or another activity? The answer to this question should not necessarily be determinative—as property rights in

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273. See 17 U.S.C. § 506(a) (2012) (providing for criminal penalties for “willful” infringement of a copyright for commercial gain).

274. U.S. CONST. art. I, § 8, cl. 8.

275. See *infra* Part V.B.4 (arguing that criminal laws cannot be considered “copyright” laws because they grant rights to punish to the government, not possessory rights to individuals).

276. It should be noted here that the criminal copyright provisions do not flout any of the Copyright Clause's restrictions. Unlike the criminal anti-bootlegging statutes, they are time-limited, see 17 U.S.C. § 507(a) (2012) (establishing five-year statute of limitations for criminal copyright infringement), and protect only original, fixed works, see *id.* § 506(a)(1) (limiting scope of criminal provisions to willful infringement of a “copyright” under the usual provision of Title 17).

277. 17 U.S.C. § 106(4)–(5) (2012).

278. See *id.* § 106(1) (2012) (“[T]he owner of copyright under this title has the exclusive rights to . . . reproduce the copyrighted work in copies or phonorecords.”).

279. “Vending” the copyrighted work was also prohibited. See Act of May 30, 1790, ch. 15, 1 Stat. 124 (repealed 1831) (providing copyright holders “shall have the sole right and liberty of printing, reprinting, publishing and vending” copyrighted works).



expression may be secured in other ways<sup>280</sup>—but looking to the activity proscribed provides a useful touchstone for the “copyright law” inquiry.

### 3. The Material Protected

The next step in the inquiry is to look at the material granted protection under the law. Copyright laws provide rights in *expression*.<sup>281</sup> The categories of works copyrightable under federal law have expanded greatly since the time of the Constitution,<sup>282</sup> but all share common, expressive features as the “Writings” of “Authors.”<sup>283</sup> The first federal copyright law limited itself to charts, maps, and books.<sup>284</sup> Later acts of Congress extended protection to musical compositions,<sup>285</sup> photographic works,<sup>286</sup> and the fine arts.<sup>287</sup> The modern copyright statute covers several broad categories such as literary, musical, dramatic, and pictorial works.<sup>288</sup> These are all canonical forms of artistic expression. “Expression,” for our purposes, may be defined broadly as the “fruits of intellectual or artistic labor.”<sup>289</sup>

When considering the “material protected” factor, one must be careful to avoid the circularity issues discussed in more detail above.<sup>290</sup> Though it may seem natural to read requirements of originality (or fixation) into this usage of the word “expression,” such affirmative limitations of the Copyright Clause should not be incorporated into the “copyright law” test. To do so would allow the very reasons that the law is suspect in the first instance to save it from Copyright Clause scrutiny.

### 4. The Nature of the Rights Granted

The final—and perhaps most important—element of the “copyright

280. The *Martignon* court recognized this point when it noted that “the word ‘copyright’ does not appear in [the Copyright Clause]. . . . The clause thus empowers Congress to ‘secur[e] . . . Right[s].’” *Martignon*, 492 F.3d 140, 150 (2d Cir. 2007).

281. *See id.* (“[Copyright laws] all seem to share a common feature: They allocate rights in expression.”).

282. *See generally* R. Anthony Reese, *Innocent Infringement in U.S. Copyright Law: A History*, 30 COLUM. J.L. & ARTS 133, 135–40 (2007) (providing a brief overview of evolution of copyrightable subject matter from the Statute of Anne to 1909).

283. U.S. CONST. art. I, § 8, cl. 8.

284. Act of May 30, 1790, ch. 15, § 1, 1 Stat. 124, 124 (repealed 1831).

285. Act of Feb. 3, 1831, ch. 16, § 1, 4 Stat. 436, 436 (repealed 1870).

286. Act of Mar. 3, 1865, ch. 126, § 1, 13 Stat. 540, 540 (repealed 1870).

287. Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212 (repealed 1909).

288. 17 U.S.C. § 102 (2012).

289. *See Goldstein v. California*, 412 U.S. 546, 561 (1973) (“[T]he word ‘writings’ . . . may be interpreted to include any physical rendering of the fruits of creative intellectual or aesthetic labor.”).

290. *See supra* Part V.B.1.a.

law” test looks to the character of the rights granted by the law. This inquiry may be subdivided into three components: (1) whether the interest granted is a property right; (2) to whom the right is granted; and (3) the scope of the right granted.

The rights secured through copyright laws are fundamentally *property* rights.<sup>291</sup> As a consequence, the rights will typically be exclusionary and transferable,<sup>292</sup> two features which are deeply embedded into current federal copyright law.<sup>293</sup> Non-exclusive rights do not trigger the kind of government-backed monopoly (and monopoly costs) that so concerned the Framers of the Copyright Clause.<sup>294</sup> Transferability, while perhaps less central to the inquiry, is a traditional indicia of a property right.

Also critical will be to *whom* the rights are granted. Property rights are usually located in an individual or corporation. If a law instead grants a right to the government, it is unlikely to be a property (and thus a copyright) law. For example, laws granting protection enforced only through criminal enforcement are difficult to characterize as “property rights.” Such rights are not “owned” by anyone; they are given force only at the discretion of the government, not a private possessor of the right. Criminal laws function as an expression of social or moral opprobrium,<sup>295</sup> giving the government a right to punish a misdeed, rather than as an allocation of an exclusive possessory interest.

Finally, as should be apparent from the analysis thus far, the purview of copyright is quite broad. That is, copyright laws, typically, are *generalized* rights against unauthorized reproduction. The existence of restrictions which limit the scope of the protection granted to a narrow area may thus serve to distinguish copyright laws from the mere copyright-like. A comparison of copyright with trademark law is

291. I use the term “property” here in its more traditional, limited sense of transferable and exclusive rights to “possess, use or enjoy a determinate thing.” BLACK’S LAW DICTIONARY 1335 (9th ed. 2009). Broader notions of “new property”—like an expectation in the receipt of government benefits, protected under the 5th and 14th Amendments as a property “interest,” *see, e.g., Mathews v. Eldridge*, 424 U.S. 319, 332 (1976)—will typically not be considered “property rights” for our purposes. *See generally* Charles A. Reich, *The New Property*, 73 YALE L.J. 733 (1964) (recognizing government largess as an increasingly important form of property).

292. *See, e.g.,* Emily Sherwin, *Two- and Three-Dimensional Property Rights*, 29 ARIZ. ST. L.J. 1075, 1079 (1997) (defining property as “one person’s full and exclusive right to use, enjoy, and transfer a tangible thing”).

293. *See* 17 U.S.C. § 201(d)(1) (2012) (providing that “a copyright may be transferred in whole or in part by any means of conveyance or by operation of law”); *id.* § 106 (granting copyright holder series of “exclusive rights”).

294. *See* Heald & Sherry, *supra* note 15, at 1160–62 (explaining that Framers of the Constitution deeply distrusted governmental grants of exclusive rights which imposed monopoly costs on the public).

295. *See* Michael P. Vandenberg, *The Private Life Of Public Law*, 105 COLUM. L. REV. 2029, 2075–76 (2005) (“[A] criminal law typically carries with it a fairly high level of moral opprobrium. In contrast, one may often incur private law liability without triggering moral opprobrium.”) (internal quotation marks and citations omitted).

instructive on this point. Holding a valid trademark does not prevent others from copying or using the mark generally. Rather, exclusive rights adhere only when others use the mark, in commerce, in a way likely to create confusion among consumers.<sup>296</sup> Trademarks are thus specialized, *narrow* grants of rights against particular uses in commerce.<sup>297</sup> This is one reason why, historically, they were viewed as a tort of unfair competition, rather than as intellectual property.<sup>298</sup>

## VI. APPLYING THE THEORY

This Part applies the “copyright law” test derived above to the four areas of the Copyright/Commerce Clause collision that were discussed in the first section of this Article: trademarks, database protection, the DMCA, and the anti-bootlegging statutes.

### A. Trademarks

As the preceding discussion has already made clear,<sup>299</sup> trademark protection cannot be considered a “copyright law.” To be sure, trademark laws do possess some of the indicia of copyright laws. Trademarks are property rights granted to an individual, which are, within their (narrow) scope, exclusive and transferable.<sup>300</sup> Much of the material protected by trademark can be considered expression, in that marks often incorporate pictorial and/or literary elements. Further, trademark laws might be said to proscribe *some* reproductions of a registered mark, in the sense that copying a mark, under certain conditions, triggers liability. However, what is truly proscribed by

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296. See Patry, *supra* note 16, at 391 (“[T]rademark laws . . . are directed at redressing consumer confusion over the origin of products. . . . The focus of trademark protection is not on design qua design (i.e., as a “writing”), but rather on design as a source identifier.”).

297. A similar analysis may be made with regard to federal trade secret law. Federal trade secret protection prohibits unauthorized copying of a trade secret only if the misappropriator has “intent to convert a trade secret” for economic gain to a non-owner. 18 U.S.C. § 1832(a) (2012). To be considered a “trade secret” under the EEA, the information must be nonpublic and economically valuable, and the owner must employ reasonable measures to maintain its secrecy. *Id.* § 1839(3). In sum, like trademark, the protection granted is thus considerably narrower in scope than copyright.

298. See *supra* notes 36–37 and accompanying text (explaining the historical and modern categorization of trademark law).

299. See *supra* notes 295–297 and accompanying text.

300. See 15 U.S.C. § 1115(a) (2012) (establishing that registration constitutes evidence of an “exclusive right to use the registered mark in commerce” in connection with goods or services specified in registration); *id.* § 1060 (providing for the assignment of a trademark to another). With regard to transferability, the trademark law requires that the assignee of the trademark use it only on products similar in kind and quality to those of the assignor. See, e.g., *Marshak v. Green*, 746 F.2d 927, 929–30 (2d Cir. 1984) (explaining that using assigned trademark on dissimilar products constitutes invalid transfer of trademark without associated goodwill).

trademark law is the *use* of a registered mark *in commerce*, in a way likely to confuse consumers.<sup>301</sup> Simple copying alone cannot trigger liability. Trademarks are thus not a generalized right against unauthorized reproduction; they are instead a species of commercial regulation effectuated through limited exclusive rights. As such, they are not “copyright laws,” and need not comport with the Copyright Clause’s limitations.

### *B. Database Protection*

Whether a *sui generis* system of protection for factual compilations and databases is a “copyright law” will depend on the form of database protection enacted. Congress has not chosen to enact such protection, though several proposals were put forward in the wake of *Feist*.<sup>302</sup> Regardless of the form of protection enacted (if any), the material protected will almost certainly be “expression” for our purposes, as the information in databases can usually be considered fruits of intellectual labor.<sup>303</sup> (Though many databases will not satisfy the standard of originality as articulated in *Feist*,<sup>304</sup> affirmative limitations of the Copyright Clause cannot be relied upon to distinguish a copyright law, lest the whole inquiry become circular.<sup>305</sup>) Aside from this factor, however, it is difficult to generalize about database protection in the abstract. Two given forms of database protection may be radically different in terms of either the actions proscribed or the nature of the rights granted—and thus one may be a “copyright law” while another is not.

A comparison between two congressional proposals for database protection,<sup>306</sup> analyzed in greater detail by Professor Yochai Benkler,<sup>307</sup> is instructive on this point. The broader bill, the “Collections of Information Antipiracy Act,” (the CIAA) has the characteristics of a “copyright law” and so is unconstitutional as it protects non-original works in contravention of *Feist*. The CIAA broadly prohibits

301. 15 U.S.C. § 1114(1) (2012) (providing cause of action when a registered mark, without consent of the registrant, is used in commerce in a way “likely to cause confusion” among consumers).

302. See *supra* notes 63–65 and accompanying text (citing to congressional proposals for database protection and academic commentary regarding these proposals).

303. See *supra* Part V.B.3 (defining “expression” for purposes of the “copyright law” inquiry).

304. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 362 (1991) (requiring independent creation and a minimal degree of creativity as a prerequisite to copyright).

305. See *supra* Part V.B.1.a (explaining the circularity issue).

306. H.R. 354, 106th Cong. (1999); H.R. 1858, 106th Cong. (1999). Both bills were referred to and reported out of committee. See H.R. REP. NO. 106-350, pt. 1 (1999) (describing H.R. 354, the “Collections of Information Antipiracy Act”); H.R. REP. NO. 106-349, pt. 1 (1999) (describing H.R. 1858, the “Consumer and Investor Access to Information Act of 1999”).

307. See Benkler, *supra* note 65, at 578–86 (comparing House Bill 354 and House Bill 1858).

“extraction” of the information in a database either to (1) make the information available to others, or (2) in a manner that causes market harm to the producer of the original database.<sup>308</sup> This means the CIAA may reach activities as basic as loaning a CD-ROM database to a friend so she may make a personal copy.<sup>309</sup> Functionally—if “market harm” is given a reasonably broad construction—the CIAA’s prohibitions on extraction operate as a general prohibition on reproduction.<sup>310</sup> As to the nature of the rights granted, the CIAA establishes a private right of action in the creator of the source database<sup>311</sup>—that is, an exclusive, transferable<sup>312</sup> property right. It is difficult to avoid the conclusion that the CIAA is a “copyright law” that must comport with the Copyright Clause’s requirements.

In contrast, the “Consumer and Investor Access to Information Act of 1999” (the CIAIA) is not a copyright law, and instead a permissible commercial regulation under the Commerce Clause. First, the CIAIA’s prohibitions are much more limited than those of the CIAA. The CIAIA does not proscribe the act of duplicating a database, but only selling or distributing copied databases in commerce, and in competition with the original database.<sup>313</sup> Unlike the CIAA, the CIAIA does not reach personal reproductions, targeting only business competitors “free-riding” on the work of the original database creator.<sup>314</sup> It is, like trademark law, a narrow grant of rights, prohibiting only particular uses of copied expression in commerce. Secondly, the CIAIA does not create a private right of action and would instead grant enforcement power to the Federal Trade Commission.<sup>315</sup> As the CIAIA does not create private property rights, nor broadly proscribe unauthorized reproduction, it is not a copyright law. It serves as a good example of how database protection might be accomplished under Commerce Clause authority without violating the limits of the Copyright Clause.

### *C. The DMCA’s Anti-Circumvention Provisions*

The DMCA’s anti-circumvention provisions ultimately survive Copyright Clause scrutiny. First, the provisions enforcing access

308. H.R. 354 § 1402.

309. See Benkler, *supra* note 65, at 579 (using this as an example of the CIAA’s scope).

310. See *id.* at 583 (“In effect, House Bill 354 functions economically like an intellectual property rule.”).

311. H.R. 354 § 1406.

312. See H.R. 354 § 1402 (giving protection to “successors in interest” of the original database creator).

313. H.R. 1858 § 102.

314. See Benkler, *supra* note 65, at 579.

315. H.R. 1858 § 107.

restrictions<sup>316</sup> are not copyright laws. The action proscribed is not reproduction, but only the *circumvention* of a technological protection measure to gain access to a work protected by said measures. Though this aspect of the DMCA tends to strengthen copyright rights by deterring piracy, a law banning contravention of access restrictions is no more a copyright law than a law prohibiting the breaking of a safe in which copyrighted works are stored.<sup>317</sup>

The provisions enforcing use restrictions,<sup>318</sup> however, are of a different character. These might be construed as copyright laws, since they may effectively prohibit an owner or user of a copyrighted work from reproducing the work (or creating a derivative work, or any of the other “rights of the copyright owner” protected by the technological measure).<sup>319</sup> The material protected is identical, as the DMCA applies only to works protected under the copyright statutes.<sup>320</sup> Finally, the rights granted are substantially similar, as the DMCA provides for individual civil (as well as criminal) actions to enforce its anti-circumvention provisions. In sum, the use restrictions create exclusive rights to prohibit conduct (via technological measures) that is often already proscribed by traditional copyright laws. There is one feature, however, that may serve to distinguish the use restriction provisions from typical copyright laws: It is only *trafficking in devices*—not the act of circumvention itself—that is prohibited.<sup>321</sup> Since the personal actions of the user are not controlled by this provision, the right granted is more specialized than the general copyright grant—it may be that, like trademark law, the narrower scope of the right sufficiently distinguishes the use restriction provisions from typical “copyright laws.”<sup>322</sup>

Ultimately, however, it is unclear whether the DMCA’s use restrictions even violate any of the Copyright Clause’s limitations. Most of the concerns about creating *de facto* perpetual rights focus on the access restrictions—which, as we have seen, are unequivocally not “copyright laws”—and not the use restrictions.<sup>323</sup> Further, as the *Elcom*

316. See 17 U.S.C. § 1201(a) (2012).

317. See David Nimmer, *A Riff on Fair Use in the Digital Millennium Copyright Act*, 148 U. PA. L. REV. 673, 686 (2000) (“The basic provision [of the DMCA] is equivalent to breaking into a castle—the invasion inside another’s property is itself the offense. . . . [T]he gravamen here is not copyright infringement.”).

318. See 17 U.S.C. § 1201(b) (2012).

319. See *id.* § 1201(b)(1)(A)–(C) (extending protection only when the “technological measure that effectively protects a right of a copyright owner under this title”).

320. *Id.*

321. See *id.* § 1201(b)(1) (“No person shall manufacture . . . or otherwise traffic in any technology, product, service, device . . .”).

322. See *supra* Part VI.A (arguing that trademarks are not copyright laws due to narrow character of the rights granted).

323. See *supra* notes 73–75 and accompanying text (explaining theories under which the DMCA

court recognized, the series of assumptions required to reach the conclusion that the anti-circumvention provisions create perpetual rights rests on “tenuous” empirical grounds.<sup>324</sup> Such hypothetical scenarios are a weak basis upon which to strike down a statute as facially unconstitutional. The Copyright Clause does not protect against all potential adverse consequences to copyright values; rather, it prohibits the enactment of copyright laws in violation of its express limitations.

#### *D. The Anti-Bootlegging Statutes*

As alluded to previously,<sup>325</sup> the criminal anti-bootlegging statute<sup>326</sup> is not a “copyright law” because it cannot be considered a *property* right. The “rights” granted by Section 2319A are not held by any individual. Though a performer may complain about bootlegging, enforcement is had only at the discretion of the government; the performer does not “own” anything. As a criminal law, the presumed motivation is one of moral disapproval: the law serves as a societal expression that particular conduct is wrong and should be punished. Though it may incidentally trigger the sort of monopoly costs that motivated the Framers of the Copyright Clause,<sup>327</sup> allocation of wealth is not the primary motivation, and the discretionary enforcement mechanism may reduce the incidence of such costs.

The civil anti-bootlegging statute,<sup>328</sup> in contrast, possesses all the characteristics of a copyright law. Its proscriptions are targeted against unauthorized reproduction of live musical performances.<sup>329</sup> Though transmission and distribution of bootlegged copies is also prohibited,<sup>330</sup> the production of a first unauthorized copy will typically be a necessary prerequisite to liability. As to the material protected, it can scarcely be doubted that musical performances constitute expression.<sup>331</sup> Finally, the rights granted are identical to those of usual copyright laws: Section

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may allow for the creation of *de facto* perpetual rights and tie up the public domain).

324. *See* United States v. Elcom Ltd., 203 F. Supp. 2d 1111, 1141 (N.D. Cal. 2002) (“[T]he argument that Congress’ ban on the sale of circumvention tools has the effect of allowing publishers to claim copyright-like protection in public domain works is tenuous and unpersuasive.”).

325. *See supra* Part V.B.4 (explaining that criminally-enforced laws cannot be considered possessory in nature).

326. *See* 18 U.S.C. § 2319 (2012).

327. *See* Heald & Sherry, *supra* note 15, at 1160–62 (explaining that the Framers of the Constitution deeply distrusted governmental grants of exclusive rights which imposed monopoly costs on the public).

328. 17 U.S.C. § 1101 (2012).

329. *Id.* § 1101(a)(1).

330. *Id.* § 1101(a)(2)–(3).

331. “Musical works” are listed second, after only literary works, among the categories of protected works in the current copyright statute. 17 U.S.C. § 102(a)(2).

1101 makes violators liable “to the same extent as an infringer of copyright.”<sup>332</sup> Section 1101 thus allocates exclusive, property rights in an individual (the performer), consisting primarily of a generalized right against unauthorized reproduction.<sup>333</sup> Section 1101 is therefore a “copyright law,” and invalid if it does not comport with the limitations of the Copyright Clause.

The preceding analysis does not necessarily mean that the whole of Section 1101 must be ruled unconstitutional or that the federal government is powerless to regulate bootlegging. Under the theory this Article has advanced, all the Copyright Clause requires is that “copyright laws” satisfy its explicit restrictions. As an initial matter, this means that Section 1101 must contain some sort of statute of limitations—whether added through amendment or judicially implied<sup>334</sup>—to comport with the “limited Times” requirement. The fixation problem is more intractable, though it has not yet been definitively established that fixation is a constitutional requirement.<sup>335</sup> Even if it is so held, the third act prohibited under Section 1101—which bans only trafficking in bootlegged records<sup>336</sup>—might be saved by severing it from the rest of Section 1101. A law banning only sale and distribution of an article in commerce is a much narrower right than the typical, generalized, copyright grant—like trademark, such a prohibition may be construed as a specialized commercial regulation, and thus not a copyright law.<sup>337</sup> Finally, the federal government is free to enforce a policy against bootlegging through other means (like Section 2319A), and there is no barrier to regulation of unfixated performances by the states.

## VII. CONCLUSION

As this Article has endeavored to show, whether Congress may avoid the limitations of the Copyright Clause through reliance on Commerce

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332. *Id.* § 1101(a).

333. There is one potentially relevant distinction between rights under Section 1101 and familiar copyright rights. Section 1101 grants rights contingent on the consent of the “performer or performers involved”—not the owner of copyright in the performance—so it is not immediately apparent whether these rights are transferable to persons other than the performer. This difference, however, is not enough to make Section 1101 not a copyright law.

334. *See supra* note 89 and accompanying text (exploring possibilities to imply statute of limitations for anti-bootlegging statutes).

335. *See supra* note 30 and accompanying text (explaining the debate over whether fixation is a constitutional requirement).

336. 17 U.S.C. § 1101(a)(3) (2012) (making liable anyone who “distributes or offers to distribute, sells or offers to sell, rents or offers to rent, or traffics in any [bootlegged] copy or phonorecord”).

337. *See supra* Part VI.A (arguing that trademarks are not copyright laws due to narrow character of the rights granted).



Clause power is a question in need of a consistent, coherent theory, applicable to areas as diverse as trademark protection and the DMCA. This Article has offered such a unified theory in its subject matter approach. The basic idea is simple: Acts of Congress that are so similar to traditional forms of intellectual property protection so as to be “copyright laws” must comport with the requirements of the Copyright Clause—notwithstanding the availability of an alternative enumerated power. To give substantive content to the “copyright law” inquiry, this Article has articulated and defined several important factors—the activities proscribed, the material protected, and the nature of the rights granted. The “copyright law” test provides a clear, workable resolution to the Copyright/Commerce Clause collision that reconciles seemingly inconsistent precedents. Recognizing Congress’s broad power to legislate in areas significant to national commerce, the “copyright law” test is flexible, allowing Congress to regulate most areas if it so chooses, so long as the means of regulation are carefully crafted. Perhaps most important, the “copyright law” theory functions to maintain, within their traditional sphere of applicability, an effective role for the limitations of the Copyright Clause.