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**THE PENUMBRAL PUBLIC DOMAIN: CONSTITUTIONAL LIMITS
ON QUASI-COPYRIGHT LEGISLATION**

*Aaron K. Perzanowski**

INTRODUCTION

Congress's authority to establish copyright laws, like every grant of legislative authority, contains limits on the scope of federal power. Article I, Section 8, Clause 8 provides Congress with the authority 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."¹ In broad terms, the limits inherent in Clause 8 divide into two categories: limits on the sorts of works in which Congress can grant exclusive rights and limits on the types of exclusive rights that Congress can use to protect those works. The outer edges of this power, at least as much as any other legislative grant, were "defined, and limited . . . [so] that those limits may not be mistaken, or forgotten."²

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1 U.S. CONST. art. I, § 8, cl. 8. Scholars have referred to this clause by a number of names: the "Intellectual Property Clause," Dotan Oliar, *Making Sense of the Intellectual Property Clause: Promotion of Progress as a Limitation on Congress's Intellectual Property Power*, 94 GEO. L.J. 1771, 1771 (2006); Edward C. Walterscheid, *To Promote the Progress of Science and Useful Arts: The Background and Origin of the Intellectual Property Clause of the United States Constitution*, 2 J. INTELL. PROP. L. 1, 1 (1994); the "Patent and Copyright Clause," Robert P. Merges, *One Hundred Years of Solicitude: Intellectual Property Law, 1900–2000*, 88 CAL. L. REV. 2187, 2208 (2000); Giles S. Rich, *The Vague Concept of "Invention" as Replaced by § 103 of the 1952 Patent Act*, 14 FED. CIR. B.J. 147, 150 (2004); the "Progress Clause," Malla Pollock, *What Is Congress Supposed To Promote?: Defining "Progress" in Article I, Section 8, Clause 8 of the United States Constitution, or Introducing the Progress Clause*, 80 NEB. L. REV. 754, 754 (2001); and the "Exclusive Rights Clause," Yochai Benkler, *Through the Looking Glass: Alice and the Constitutional Foundations of the Public Domain*, 66 LAW & CONTEMP. PROBS., 173, 175 (2003). Rather than adopt any of these terms, many of which suggest some ideological bias, this Article refers to "Clause 8."

2 *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 176 (1803); see 1 WILLIAM WINSLOW CROSSKEY, *POLITICS AND THE CONSTITUTION IN THE HISTORY OF THE UNITED STATES* 486

But Congress has other powers—chief among them, its authority to regulate interstate commerce—that could allow it to undermine the limits of Clause 8. The breadth of the modern Commerce Clause³ provides Congress with authority over subject matter once squarely and exclusively within the domain of Clause 8. Unrestrained, this independent commerce power could permit Congress to ignore the limits on its copyright authority.

This Article aims to achieve two objectives. First, recognizing that courts have not yet done so, it outlines a general approach to identifying and resolving inter-clause conflicts. Second, it applies that general framework to the copyright power of Clause 8 in order to define the scope of constitutional prohibitions against quasi-copyright protections.⁴

This Article argues that the limits of Clause 8 apply any time Congress attempts to legislate within the core subject matter of its copyright power—grants of exclusive rights in expression. Unless the limits of Clause 8 cabin the commerce power, those limits are effectively stricken from the Constitution, despite the Framers' best efforts to ensure that they could not be ignored.

Once the limits of Clause 8 are understood to apply regardless of the power Congress recites, a public domain or component thereof⁵ firmly and permanently rooted in the Constitution emerges.⁶ This

(1953) (“Reading the [Clause 8] power, then, in light of the statute of Anne and the then recent decisions of the English courts, it is clear that this power of Congress was enumerated in the Constitution, *for the purpose* of expressing its limitations.”).

³ U.S. Const. art. I, § 8, cl. 3.

⁴ The scope of this Article is limited to the copyright power of Clause 8, but the general principles and some of the limits addressed are equally applicable to the patent power.

⁵ The term “public domain” is used to refer to a number of distinct but overlapping concepts. See generally James Boyle, *The Second Enclosure Movement and the Construction of the Public Domain*, 66 LAW & CONTEMP. PROBS. 33, 68 (2003); Pamela Samuelson, *Enriching Discourse on Public Domains*, 55 DUKE L.J. 783 (2006). To the extent a single public domain exists, it comprises some or all of these interrelated components.

⁶ This Article is not the first to suggest that limits inherent in the Constitution give rise to a mandatory public domain. See Benkler, *supra* note 1 at 201; Robert Patrick Merges & Glenn Harlan Reynolds, Essay, *The Proper Scope of the Copyright and Patent Power*, 37 HARV. J. ON LEGIS. 45, 52–53 (2000); Diane Leenheer Zimmerman, *Is There a Right To Have Something To Say? One View of the Public Domain*, 73 FORDHAM L. REV. 297, 313–15 (2004). Nor is it the first to argue that specific classes of works are beyond the constitutional scope of Clause 8 authority. See generally, Yochai Benkler, *Constitutional Bounds of Database Protection: The Role of Judicial Review in the Creation and Definition of Private Rights in Information*, 15 BERKELEY TECH. L.J. 535, 539–49 (2000); Michael Birnhack, *More or Better? Shaping the Public Domain*, in THE PUBLIC DOMAIN OF INFORMATION (P. Bernt Hugenholtz & Lucie Guibault eds., 2005); Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. ILL. L. REV. 1119 (2000); William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An*

public domain, defined by the limits of Clause 8, includes unoriginal and unwritten expressive works. These two classes of works, as a constitutional matter, cannot be the subject of federal grants of exclusive rights.

Part I examines the source of inter-clause conflicts and suggests that they are primarily a result of the expansion of Congress's commerce authority. Prior to this expansion, Congress's enumerated powers each occupied distinct zones of authority that were infrequently invaded by other clauses. The limits of one clause rarely conflicted with the power granted under another. Since inter-clause conflicts were unanticipated, the Framers neglected to specify whether the limits in one clause could restrain another. The Court has struggled with this ambiguity on the few occasions it has considered inter-clause conflict, and no generally applicable approach has emerged from the Court's efforts.

Part II outlines such an approach. Its starting point is the canon of construction that rejects readings of documents that render text superfluous. If the limits of Clause 8 and Congress's other enumerated powers cannot restrict legislation otherwise justified under the commerce power, those limits will be all but erased from the Constitution. In order to avoid undue restraints on congressional authority, this approach requires the separation of genuine external limits from mere descriptions of the scope of a particular power. This separation, in turn, relies on a comparative analysis that considers each enumerated power in the broader context of Congress's legislative authority as a whole.

After identifying the potential limits on Congress's copyright authority, Part III applies this general approach to Clause 8. This Part isolates the core subject matter of Congress's copyright authority—the power to grant exclusive rights in expression. Because no other enumerated powers permit Congress to grant such rights, the limits of Clause 8 restrain Congress any time it seeks to confer exclusive rights in expressive works regardless of the power under which it attempts to act. Applied externally, the limits of Clause 8 define both a set of exclusive rights and a set of expressive works beyond the reach of Congress—the penumbral public domain.

Imminent Constitutional Collision, 67 GEO. WASH. L. REV. 359 (1999); Malla Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of Shakespeare Co. v. Silstar Corp.*, 18 SEATTLE U. L. REV. 259 (1995).

Part IV examines existing and proposed legislation that invades the penumbral public domain by granting exclusive rights that ignore the limits on Congress's positive authority. In particular, this Part addresses the federal anti-bootlegging statutes, which protect live musical performances from unauthorized recordings ostensibly under the Commerce Clause. Despite the Second Circuit's recent decision in *United States v. Martignon* upholding the constitutionality of the statutes,⁷ they fall within the ambit of Clause 8 and must adhere to its limits.

I. THE PROBLEM OF INTER-CLAUSE CONFLICT

In 1994, when Congress enacted the Uruguay Round Agreements Act ("URAA"),⁸ it faced a dilemma. The URAA implemented the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS").⁹ TRIPS, in part, called for copyright-like protections for unfixed live performances for a term of at least fifty years.¹⁰ The United States—the chief architect and proponent of TRIPS¹¹—encountered a significant hurdle in implementing these protections, namely that Congress's copyright authority under Clause 8 permits exclusive rights only in "Writings." Since unfixed live performances do not qualify as "Writings,"¹² the protections required by TRIPS and embodied in the URAA were impermissible under Congress's Clause 8 power.

Despite the limits inherent in Clause 8, Congress enacted the URAA, creating two statutes, § 1101 of Title 17 and § 2319A of Title 18 of the *United States Code*, that impose civil and criminal penalties for copyright infringement on those who record, reproduce, and distribute unauthorized recordings of live musical performances.¹³ Not

⁷ 492 F.3d 140 (2d Cir. 2007).

⁸ Pub. L. No. 103-465, 108 Stat. 4809 (1994).

⁹ See *id.* § 101(d)(15), § 315. TRIPS was a component of the General Agreement on Tariffs and Trade ("GATT"). See General Agreement on Tariffs and Trade - Multilateral Negotiations (the Uruguay Round): Agreement on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods, Dec. 15, 1993, 33 I.L.M. 81, 87.

¹⁰ *Id.* at 83.

¹¹ *United States Submits TRIPS Proposal to GATT*, 40 Pat. Trademark & Copyright J. (BNA) No. 981, at 72-73 (May 17, 1990).

¹² See *infra* Part III.A.4.

¹³ 17 U.S.C. § 1101 (2000) ("Unauthorized fixation and trafficking in sound recordings and music videos"); 18 U.S.C. § 2319A (2000) ("Unauthorized fixation of and trafficking in sound recordings and music videos of live musical performances"). One may ask why protection above and beyond that already provided by the Copyright Act is necessary for live performances. The composer of the work performed, to the extent the composition

only do the statutes extend copyright-like protections to non-writings, but those protections are perpetual, in direct conflict with the limited times requirement of Clause 8.¹⁴

When these anti-bootlegging statutes were inevitably challenged as improper exercises of Congress's Clause 8 authority, the United States defended them on the grounds that the statutes reflected the exercise of Congress's Commerce Clause authority. According to the United States, as regulations of interstate commerce, the statutes were immune from the limitations that restrict traditional copyright laws.

In the first of these cases, *United States v. Moghadam*,¹⁵ the Eleventh Circuit considered an appeal to a conviction under § 2319A. In analyzing the constitutionality of the statute, the court assumed *arguendo* that § 2319A violated the limits of Clause 8 by protecting unwritten live performances.¹⁶ However, the court recognized that the Commerce Clause offered an alternative source of legislative power since unauthorized recordings substantially affect interstate commerce.¹⁷ Because § 2319A was impermissible under Clause 8, but seemingly within the scope of Congress's commerce authority, the constitutionality of the statute turned on the resolution of this inter-clause conflict. In short, could Congress avoid the limits of Clause 8 by acting under the commerce power?

According to the court, statutes justified as regulations of commerce are bound by the limits of Clause 8 only to the extent the stat-

was fixed prior to performance, possesses a copyright that can be asserted against an unauthorized recordist. However, bootleg producers could utilize the mechanical license provided by § 115 of the Copyright Act to satisfy the composer's interest. 17 U.S.C. § 115 (2000). But the performer, who may own no interest in the composition, possesses no interest in the performance itself under traditional copyright law. Even if the performer records her performance in real time, an unauthorized recordist arguably does not infringe the subsequent copyright that the performer enjoys in her own recording. The performer's recording was not fixed at the time of the unauthorized recording, and the two were independently created. Therefore, at the time the URAA was adopted, a performer had no assertable interest in her performance qua performance under federal law.

14 See 17 U.S.C. § 1101(a) (2000) (providing civil remedies for the unauthorized use, communication, or distribution of sound recordings and music videos of live musical performances without establishing any time limit for protection); 18 U.S.C. § 2319A(a) (2000) (providing criminal penalties for the unauthorized use, communication, or distribution of sound recordings and music videos of live musical performances without establishing any time limit for protection).

15 175 F.3d 1269 (11th Cir. 1999).

16 *Id.* at 1274.

17 *Id.* at 1276.

utes are “fundamentally inconsistent with” those limits.¹⁸ Section 2319A, according to the court, was “in no way inconsistent with the Copyright Clause Quite the contrary, extending such protection actually complements and is in harmony with the existing scheme that Congress has set up under the Copyright Clause.”¹⁹ In the court’s view, since granting exclusive rights in non-writings does not fundamentally conflict with the objectives of Clause 8, § 2319A was a valid exercise of Commerce Clause authority.²⁰ However, the court intimated on three occasions that, had the issue of the perpetual duration of the statute been properly raised, it would have held that the limited times requirement imposed an enforceable limit on the Commerce Clause.²¹

Moghadam’s fundamental inconsistency test is problematic. It suggests that certain limits on Congress’s constitutional authority, like the writings requirement of Clause 8, can be ignored if Congress so decides. Other limits, like the limited times requirement, cannot be disregarded because their violation would result in a fundamental inconsistency with the purposes of other enumerated powers. But *Moghadam* offers little justification for this distinction; nor does it articulate any method by which future courts can separate genuine limits from disposable ones.

Not surprisingly, the next court to address § 2319A declined to adopt *Moghadam*’s reasoning. In *United States v. Martignon*, the proprietor of a retail record shop was charged with “selling unauthorized recordings of live performances by certain musical artists.”²² Martignon, having learned from *Moghadam*’s mistake, argued that the

18 *Id.* at 1281.

19 *Id.* at 1280.

20 *Id.* at 1282. *Moghadam* suffered from an incomplete understanding of the purpose of Clause 8. The court assumed that any expansion of Congress’s ability to grant exclusive rights in expression is consistent with the objective of Clause 8. *See id.* at 1280–82. This position assumes that the protection of creative works is the ultimate aim of Clause 8 and not merely an instrumental goal. The Framers sought to create a system of incentives for the creation, distribution, and eventual use of expressive works—a goal that relied not only on grants of rights, but also on the careful circumscribing of the bounds of that protection. *See infra* Part III. The court’s inability to recognize the constitutional role of the limits of Clause 8 led it to conclude that violations of the writings requirement could be reconciled with the Framers’ objectives. *Moghadam*, 175 F.3d at 1280.

21 *Moghadam*, 175 F.3d at 1274 n.9, 1281 n.15, 1282 n.17. The court refused to consider *Moghadam*’s limited times argument because it was raised for the first time in his reply brief. *Id.* at 1281 n.15.

22 346 F. Supp. 2d 413, 417 (S.D.N.Y. 2004) (internal quotations omitted).

statute violated both the writings and limited times requirements of Clause 8.²³

The *Martignon* district court analyzed the constitutionality of the statute not by asking whether it was fundamentally inconsistent with the objectives of Clause 8, but by asking whether, at its core, § 2319A was “a copyright law or a commercial regulation.”²⁴ The court considered a number of factors, some of which—the actual and intended effects of the statute, for example—offered valuable insight into the statute’s nature; other factors, like the fact that § 2319A was codified in close proximity to the criminal copyright infringement statute, provided less convincing reasons to treat § 2319A as a copyright law for constitutional purposes.²⁵ Ultimately, the court concluded that even if § 2319A was not a copyright law, it was so “copyright-like” that it must be bound by the limits of Clause 8.²⁶ Because it violated those limits, the statute was held unconstitutional.²⁷

But the court’s failure to draw any explicit distinction between copyright laws and their copyright-like counterparts, and the absence of any transparent basis for classifying § 2319A as the latter, render its reasoning little more satisfying than *Moghadam*’s fundamental inconsistency test. Indeed, as discussed *infra*, the Second Circuit overturned the district court’s holding in *Martignon* and adopted yet another ultimately flawed analysis of the inter-clause conflict created by the anti-bootlegging statutes.²⁸

Beyond illustrating the specific tension between Congress’s commerce authority and limits inherent in Clause 8, *Moghadam* and *Martignon* encapsulate the broader question at the heart of all inter-clause conflict: When Congress faces a barrier to legislative action, may it act under an alternative source of authority to achieve an aim foreclosed by another enumerated power?

²³ *Id.* at 416–17.

²⁴ *Id.* at 419.

²⁵ *See id.* at 420–422.

²⁶ *Id.* at 422.

²⁷ *Id.* at 428. The treatment of the civil anti-bootlegging statute under § 1101 further underscores the confusion facing courts over inter-clause conflict. In *KISS Catalog I*, the district court explicitly adopted *Martignon*’s rationale and held § 1101 unconstitutional. *See* *KISS Catalog v. Passport Int’l Prods. (KISS Catalog I)*, 350 F. Supp. 2d 823 (C.D. Cal. 2004). However, after the death of the original presiding judge and the intervention of the United States, the court, on a motion for reconsideration, vacated the prior order. *See* *KISS Catalog, Ltd. v. Passport Int’l Prods. (KISS Catalog II)*, 405 F. Supp. 2d 1169 (C.D. Cal. 2005). *Kiss Catalog II* likewise rejected *Moghadam*’s fundamental inconsistency test, maintaining that the Commerce Clause and Clause 8 were entirely independent sources of authority. *Id.* at 1173–76.

²⁸ *See infra* Part IV.D.

Likewise, these two cases demonstrate that courts faced with inter-clause conflict often struggle to make sense of the relationships between grants of legislative authority. This confusion results, in part, from the inherent ambiguity of the text of Article I, Section 8. The limits contained within each enumerated power do not require, on their face, that Congress yield to those limits when acting pursuant to other legislative powers. This Part begins by exploring the ambiguity of limits on Congress's legislative authority and the Supreme Court's failure to offer the guidance necessary to resolve it. This Part concludes by examining the primary source of inter-clause conflict, the expansion of the Commerce Clause.

A. Internal and External Application of Constitutional Limits

Two propositions illustrate the inherent difficulty in resolving conflicts between constitutional grants of legislative authority. First, because the legislative powers enumerated in the Constitution are cumulative, "what cannot be done under one of them may very well be doable under another."²⁹ Second, and equally true, Congress may not circumvent the limits imposed by one provision of the Constitution simply by acting under another grant of authority.³⁰ These two propositions, although seemingly at odds, are in fact complimentary. In isolation, neither fully accounts for the complex interactions between the provisions of Article I, Section 8, but taken together, they explain that Congress is free to legislate under any sufficient constitutional grant, so long as it does not contravene applicable limitations elsewhere in the Constitution.

But determining whether a limit constrains other grants of authority is not always an easy task. Some limiting language functions purely descriptively. Since Congress's legislative powers are cumulative, these internal limits outline the scope of a particular enumerated power without constraining other grants of authority. Article I, Section 8, Clause 10, for example, provides Congress authority to "define and punish Piracies and Felonies committed on the high Seas."³¹ As a matter of textual interpretation, one would reasonably read the phrase "committed on the high Seas" as a characterization of the scope of the power granted under this clause—one that imposes no

²⁹ *United States v. Moghadam*, 175 F.3d 1269, 1277 (11th Cir. 1999).

³⁰ *See Ry. Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457 (1982).

³¹ U.S. CONST. art. I, § 8, cl. 10.

constraints on Congress's ability to punish felonies committed on land under other grants of authority.

But other limits in the Constitution undoubtedly function proscriptively. These limits not only apply to the provision within which they are situated, but also externally constrain Congress's power under other grants of authority. The First Amendment serves as an obvious instance of a constitutional provision that extends to all enumerated powers.³² Congress, for example, could not disregard the First Amendment by punishing seditious speech uttered on the high seas, despite its power under Clause 10.

Some external limits are easily identified. The requirement that "Congress shall make no law" expressly constrains congressional authority regardless of its source.³³ But most limitations in the Constitution are not expressed in such categorical terms. These limits more closely resemble the language confining congressional authority under Clause 10 to felonies and piracies "on the high Seas."³⁴ Nothing inherent in such text demands external application. The limits of Clause 8, for example, with the potential exception of its "promote the Progress" language, appear textually indistinguishable from other potentially descriptive limits in Article I.

The meaning of the Constitution, of course, is not always self-evident. Traditionally, we rely on the courts, particularly the Supreme Court, to provide the interpretative guidance needed to resolve these ambiguities. However, the Court's limited treatment of inter-clause conflict raises more questions than it answers.

B. The Supreme Court and Inter-Clause Conflict

The Supreme Court has had few opportunities to consider potential conflicts between the authority conferred by one enumerated power and the limits imposed by another. The few cases addressing inter-clause conflicts fail to offer a consistent, generalizable method for recognizing and resolving them. Nonetheless, the Court has demonstrated a general receptiveness to the notion that the limits of one enumerated power may, under appropriate circumstances, restrain Congress from acting under an alternative source of authority.

³² U.S. CONST. amend. I.

³³ *Id.* The prohibitions against titles of nobility, bills of attainder, and ex post facto laws offer some additional examples of express external constraints. *See* U.S. CONST. art. I, § 9, cls. 3, 8.

³⁴ U.S. CONST. art. I, § 8, cl. 10.

Railway Labor Executives' Ass'n v. Gibbons offers the Court's clearest treatment of inter-clause conflict.³⁵ There, the Court held that a limit in the Bankruptcy Clause³⁶ invalidated legislation otherwise permissible under the Commerce Clause.³⁷ In 1975, the Chicago, Rock Island and Pacific Railroad Company ("Rock Island") sought bankruptcy protection.³⁸ Four years later, the company ceased operations, and the reorganization court ordered the liquidation of Rock Island's assets.³⁹ In response, Congress enacted the Rock Island Railroad Transition and Employee Assistance Act ("RITA")⁴⁰ to ensure that former Rock Island employees received \$75 million in benefits from the Rock Island estate.⁴¹

Gibbons, Rock Island's trustee, sought to have RITA declared unconstitutional as a non-uniform, and thus invalid, exercise of the Bankruptcy Clause.⁴² Appellants, along with the United States, contended that RITA was authorized as an exercise of Commerce Clause authority, and thus not subject to the uniformity requirement of the Bankruptcy Clause.⁴³

Railway Labor presented two questions to the Court: first, whether RITA was subject to the uniformity requirement, and second, whether RITA satisfied that requirement. In determining whether RITA was "an exercise of Congress'[s] power under the Bankruptcy Clause . . . or under the Commerce Clause," the Court noted the difficulty of distinguishing between bankruptcy and commerce.⁴⁴ Since RITA directly addressed the subject matter of bankruptcy law by "prescrib[ing] the manner in which the property of the Rock Island estate

35 455 U.S. 457 (1982).

36 U.S. CONST. art. I, § 8, cl. 4. (providing Congress with the power to "establish . . . uniform Laws on the subject of Bankruptcies throughout the United States").

37 *Ry. Labor*, 455 U.S. at 473.

38 *Id.* at 459.

39 *Id.* at 460.

40 Pub. L. No. 96-254, 94 Stat. 399 (1980) (codified in scattered sections of 45 U.S.C.).

41 *Ry. Labor*, 455 U.S. at 462.

42 *Id.* at 463.

43 *Id.*; see also Brief for Appellant at 20, 32-36, *Ry. Labor*, 455 U.S. 457 (Nos. 80-415, 80-1239), 1981 WL 390393; Brief for the Federal Appellees at 23, *Ry. Labor*, 455 U.S. 457 (Nos. 80-415, 80-1239) 1981 WL 390396.

44 *Ry. Labor*, 455 U.S. at 465. In furtherance of this point, the Court quoted James Madison's observation that "[t]he power of establishing uniform laws of bankruptcy is so intimately connected with the regulation of commerce," THE FEDERALIST NO. 42, at 285 (James Madison) (N.Y. Heritage Press, 1945), and cited *Sturges v. Crowninshield* in a parenthetical quote: "The bankrupt law is said to grow out of the exigencies of commerce . . ." 17 U.S. (4 Wheat.) 122, 195 (1819). *Ry. Labor*, 455 U.S. at 465-66.

[was] to be distributed among its creditors,”⁴⁵ the Court held that RITA functioned as a bankruptcy law and was subject to the uniformity requirement.⁴⁶ But because the Act targeted only the creditors and employees of Rock Island, the Court determined that RITA served as “nothing more than a private bill,” and thus lacked uniformity.⁴⁷

The Commerce Clause presented a seemingly independent and sufficient justification for RITA’s regulation of an instrumentality of interstate commerce. But because the subject matter of RITA encroached upon the domain of the Bankruptcy Clause, the uniformity requirement precluded the Act, despite the apparent sufficiency of the commerce power.

Railway Labor is the most frequently cited case restraining Congress from acting under one power on the basis of a limit inherent in another.⁴⁸ But it is arguably not the only one.⁴⁹ In *Perry v. United*

⁴⁵ *Ry. Labor*, 455 U.S. at 467.

⁴⁶ *See id.* at 467–69.

⁴⁷ *Id.* at 471.

⁴⁸ One opponent of external application of Clause 8 limitations attempts to explain away *Railway Labor* as the product of an unstated parallel drawn by the Court to the express limitations of the Contract Clause, U.S. CONST. art. I, § 10, cl. 1. *See* Thomas B. Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272, 314–16 (2004). Article I, Section 10, Clause 1 precludes states from enacting laws that impair the obligations of contracts. The *Railway Labor* Court, under this view, sought to impose a similar restraint on Congress, preventing it from interfering with existing contractual relationships with the railroad’s preferred creditors. According to this reading, in holding that RITA could not be enacted under the commerce power, the uniformity requirement of the Bankruptcy Clause served as a “federal analog of the Contracts Clause” that “mirror[ed] an explicit (and therefore generally applicable) limitation” on states. *Id.* at 315–16. Congress’s inability to enact non-uniform bankruptcy laws under the Commerce Clause, therefore, is not the result of the external application of Bankruptcy Clause limitations, but an outgrowth of the express limitations of the Contract Clause.

This reading of *Railway Labor* dramatically overstates the Court’s reliance on the Contract Clause. The Contract Clause rationale was not addressed in the parties’ briefs and was entertained in only a single question at oral argument. *See* Transcript of Oral Argument, *Ry. Labor Executives’ Ass’n*, 455 U.S. 457 (Nos. 80-415 & 80-1239), reprinted in LANDMARK BRIEFS AND ARGUMENTS OF THE SUPREME COURT OF THE UNITED STATES: CONSTITUTIONAL LAW, 1981 TERM SUPPLEMENT, at 393 (Philip B. Kurland et al. eds., 1983). The *Railway Labor* opinion refers to the Contract Clause by name only twice. *Ry. Labor* 455 U.S. at 472 n.14. In discussing the difficulty of defining the subject matter of bankruptcy regulation, the Court noted that the Bankruptcy Clause “includes the power to discharge the debtor from his contracts and legal liabilities,” something that “the States were forbidden to do.” *Id.* at 466 (quoting *Hanover Nat’l Bank v. Moyses*, 186 U.S. 181, 188 (1902)). Second, the Court suggested in a footnote that the desire for uniformity finds expression in both the text of the Bankruptcy Clause and in the decision to reserve bankruptcy as an exclusively federal concern. *Id.* at 472 n.14.

Neither of these references supports the Court’s posited attempt to apply the uniformity requirement as a federal instantiation of the Contract Clause. At most, these iso-

States,⁵⁰ the Court considered a potential conflict between Congress's power to "coin Money, [and] regulate the Value thereof,"⁵¹ and its power to "borrow Money on the credit of the United States."⁵² The government issued bonds "payable in United States gold coin of the present standard of value."⁵³ Subsequently, Congress enacted legislation rendering these "gold clause[s]" void and permitting payment "in any coin or currency," substantially devaluing the bonds.⁵⁴

According to the Court, "[t]he question [was] whether the Congress can use [the power to regulate the value of money] so as to invalidate the terms of the obligations which the Government has theretofore issued in the exercise of the power to borrow money on the credit of the United States."⁵⁵ Because Congress lacks the authority to alter or destroy its obligations, the legislation exceeded Congress's authority to regulate the value of money.⁵⁶ An inherent limit of one enumerated power⁵⁷ restrained Congress from enacting legislation otherwise justified by another.

Even where the Court has upheld legislation challenged on the basis of inter-clause conflict, it has recognized that one enumerated power may constrain another under appropriate circumstances. The *Head Money Cases*⁵⁸ serve as one example. After Congress enacted legislation imposing a fifty-cent fee on sea vessels for every non-citizen passenger arriving in the United States,⁵⁹ ship owners brought suit. They argued that the Act functioned as a tax, but failed to conform to the uniformity requirement of Article I, Section 8, Clause 1⁶⁰ because the fee did not apply to land-based immigration.⁶¹

lated statements demonstrate the Court's recognition that the Contract Clause, in part, furthered the same policy objective that motivated the Framers to insist upon uniform federal bankruptcy laws. The leap from this recognition to the claim that the uniformity requirement is uniquely suited for external application because it serves as a proxy for the Contract Clause is a long one.

49 For a detailed discussion of the cases relevant to inter-clause conflict, see Dotan Oliar, *Resolving Conflicts Among Congress's Powers Regarding Statutes' Constitutionality: The Case of Anti-Bootlegging Statutes*, 30 COLUM. J.L. & ARTS 467 (2007).

50 294 U.S. 330 (1935).

51 U.S. CONST. art. I, § 8, cl. 5.

52 U.S. CONST. art. I, § 8, cl. 2.

53 *Perry*, 294 U.S. at 347.

54 *Id.* at 349; *see also* S.J. Res. 192, 73d Cong., 48 Stat. 112 (1933).

55 *Perry*, 294 U.S. at 350.

56 *Id.* at 353–54.

57 *See* U.S. CONST. art. I, § 8, cl. 2.

58 112 U.S. 580 (1884).

59 *Id.* at 580–81; *see also* Act of Aug. 3, 1882, ch. 376, 22 Stat. 214.

60 U.S. CONST. art. I, § 8, cl. 1.

61 *Head Money Cases*, 112 U.S. at 594–95.

The Court had little trouble concluding that the Act was within the positive authority granted by the Commerce Clause, as it directly regulated foreign commerce.⁶² Nonetheless, the Court analyzed whether the statute conflicted with the uniformity requirement of the Tax Clause, concluding that because the fee applied to all foreign passengers arriving at all ports, it was sufficiently uniform.⁶³ The Court's consideration of the question of uniformity suggests that it understood that the limits of one clause could impinge Congress's power under another, and that the scope of Congress's positive commerce authority was insufficient to resolve the question of inter-clause conflict.

But at least one case, *Heart of Atlanta Motel, Inc. v. United States*,⁶⁴ arguably supports the contrary proposition—that Congress may enact legislation that violates the limits of one grant of authority by acting under an alternative source of power. In *Heart of Atlanta*, the Court upheld the Civil Rights Act of 1964, which prohibited discrimination by “any inn, hotel, motel, or other establishment which provides lodging to transient guests” on the basis of “race, color, religion, or national origin.”⁶⁵ The motel argued that the Act was not within Congress's commerce authority. The Court disagreed, holding that activities regulated by the Act were sufficiently interstate to fall within the commerce power.⁶⁶

Read in isolation, *Heart of Atlanta* is a case concerned purely with the scope of Congress's positive authority under the Commerce Clause. The issue of inter-clause conflict arises only when *Heart of Atlanta* is read in contrast with the *Civil Rights Cases*,⁶⁷ decided some eighty years earlier. There, the Court considered the Civil Rights Act of 1875, which punished those who denied individuals “full and equal enjoyment of the accommodations . . . of inns . . . and other places of public amusement.”⁶⁸ The Court, writing decades before the expansion of the commerce power, assumed that the power to enact such legislation could be found, if anywhere, in the Thirteenth and Fourteenth Amendments.⁶⁹ But according to the Court, since it penal-

62 *Id.* at 595.

63 *Id.* at 596.

64 379 U.S. 241 (1964).

65 Civil Rights Act of 1964 § 201(a), (b)(1), Pub. L. No. 88-352, 78 Stat. 241, 243.

66 *Heart of Atlanta*, 379 U.S. at 258.

67 109 U.S. 3 (1883).

68 Act of Mar. 1, 1875, ch. 114, 18 Stat. 335, 336.

69 *Civil Rights Cases*, 109 U.S. at 10; *see also* U.S. CONST. amends. XIII–XIV.

ized private conduct rather than state action, the Fourteenth Amendment offered insufficient support.⁷⁰

If the limits of the Fourteenth Amendment invalidated the Civil Rights Act of 1875, one could argue, the Court's subsequent approval of the 1964 Act as an exercise of the commerce power shows that Congress is free to disregard limits found elsewhere in the Constitution by acting under another enumerated power. At the very least, *Heart of Atlanta* reflects an implicit recognition that the limits of Section 5 of the Fourteenth Amendment do not restrain Congress when it seeks to remedy discrimination through the regulation of interstate commerce.⁷¹ But it would be easy to overstate the importance of *Heart of Atlanta* as a window into the Court's thinking about inter-clause conflict. *Heart of Atlanta*, after all, does not explicitly consider, much less reject, the notion that some limits on legislative authority apply externally under appropriate circumstances.⁷²

Railway Labor, Perry, and the *Head Money Cases* all embrace the notion that limits contained within one enumerated power can constrain legislation otherwise permissible under another grant of authority. The contrast between these cases and *Heart of Atlanta*'s silent reluctance to acknowledge and resolve a potential inter-clause conflict reveals in even sharper relief the questions left unanswered by *Railway Labor*—namely, which limits apply externally and under what circumstances. But these unanswered questions cannot be addressed without first exploring the primary cause of inter-clause conflict: the breadth of the modern commerce power.

⁷⁰ *Civil Rights Cases*, 109 U.S. at 24–25. The Court likewise rejected the Thirteenth Amendment as a proper source for Congress's power to pass the Act since the refusal of such accommodations, in the Court's view, had "nothing to do with slavery or involuntary servitude." *Id.* at 24.

⁷¹ In the *Civil Rights Cases*, the Court was confident that Congress made no attempt to act pursuant to its commerce authority. 109 U.S. at 19 ("And whether Congress, in the exercise of its power to regulate commerce amongst the several States, might or might not pass a law regulating rights in public conveyances passing from one State to another, is also a question which is not now before us, as the sections in question are not conceived in any such view."). But the Court suggested that had the Act been limited to interstate commerce, the Constitution would have posed no bar. *Id.* at 18 ("Of course, these remarks [as to lack of congressional power] do not apply to those cases in which Congress is clothed with direct and plenary powers of legislation over the whole subject, . . . as in the regulation of commerce . . . among the several States In these cases Congress has power to pass laws for regulating the subjects specified in every detail, and the conduct and transactions of individuals in respect thereof.").

⁷² The Court distinguished the 1875 Act on the grounds that it regulated a broader category of largely intrastate activity and determined that the *Civil Rights Cases* were "inapposite, and without precedential value" in its consideration of the 1964 Act. *Heart of Atlanta Motel, Inc. v. United States*, 379 U.S. 241, 250 (1964).

C. Commerce Clause Expansion

Although conflicts between alternative sources of congressional authority occasionally arise in other contexts, inter-clause conflict is primarily an outgrowth of the expansive reading of the Commerce Clause that has prevailed for the past seventy years. The original scope of the commerce power is open to debate, but a growing body of opinion agrees that it was far narrower than contemporary doctrine would suggest.⁷³ Prior to the expansion of the commerce power, the grants of legislative authority conferred distinct powers upon the legislature. As a result, Congress and the courts rarely had occasion to question whether a limit in one enumerated power should constrain action under another. The distinct nature of Congress's enumerated powers also explains the Framers' failure to unambiguously identify external limits. But as the commerce power expanded, the likelihood of inter-clause conflicts increased; after the Court's decision in *Wickard v. Filburn*,⁷⁴ they became unavoidable.

The Court's first opportunity to examine the scope of the commerce power came in 1824 when it decided *Gibbons v. Ogden*, a dispute between two rival ferry operators.⁷⁵ Chief Justice Marshall's opinion held that the commerce power was not limited "to traffic, to buying and selling, or the interchange of commodities," but embraced navigation as well.⁷⁶ The Court recognized that "[c]ommerce among the States, cannot stop at the external boundary line of each State, but may be introduced into the interior."⁷⁷ But Chief Justice Marshall excluded the power to regulate commerce that is "completely internal, which is carried on between man and man in a State,

⁷³ See *Gonzales v. Raich*, 545 U.S. 1, 58 (2005) (Thomas, J., dissenting) ("The Clause's text, structure, and history all indicate that, at the time of the founding, the term 'commerce' consisted of selling, buying, and bartering, as well as transporting for these purposes.") (internal quotations omitted); Randy E. Barnett, *New Evidence of the Original Meaning of the Commerce Clause*, 55 ARK. L. REV. 847, 857-62 (2003) (concluding that the public shared a similar understanding of the meaning of "commerce"); Randy E. Barnett, *The Original Meaning of the Commerce Clause*, 68 U. CHI. L. REV. 101, 112-25 (2001) (concluding, on the basis of contemporary sources, that "commerce" referred to trade, rather than economic activity broadly).

⁷⁴ 317 U.S. 111 (1942).

⁷⁵ 22 U.S. (9 Wheat.) 1 (1824).

⁷⁶ *Id.* at 189. This view, as the Court noted, was consistent with the well-accepted understanding of "commerce" at the time of ratification. See *id.* at 190 ("All America understands, and has uniformly understood, the word 'commerce,' to comprehend navigation. It was so understood, and must have been so understood, when the constitution was framed.").

⁷⁷ *Id.* at 194.

or between different parts of the same State, and which does not extend to or affect other States” from Congress’s commerce authority.⁷⁸

In the century following *Gibbons*, the Court’s interpretation of the Commerce Clause evolved in parallel along three distinct fronts. The Court explored the extent to which intrastate journeys that are components of interstate travel are the proper subject of congressional regulation.⁷⁹ It grappled with the relationship between commerce, narrowly defined, and other productive activities like manufacturing and agriculture.⁸⁰ And it considered legislation that used the commerce power to regulate local activities deemed immoral or dangerous.⁸¹ Although this period yielded incremental extensions of the commerce power, the Court retained meaningful and identifiable limits on Congress’s Commerce Clause authority consistent with its approach in *Gibbons*. But with the Court’s decision in *Wickard v. Filburn*,⁸² those longstanding limits were fundamentally altered.

In *Wickard*, the Court upheld an amendment to the Agricultural Adjustment Act of 1938,⁸³ which imposed limitations on the production of wheat and other commodities, as a valid exercise of the com-

78 *Id.* Reading *Gibbons* as sanctioning anything approaching a substantial effects test ignores Chief Justice Marshall’s treatment of inspection laws:

That inspection laws may have a remote and considerable influence on commerce, will not be denied; but that a power to regulate commerce is the source from which the right to pass them is derived, cannot be admitted. The object of inspection laws, is to improve the quality of articles produced by the labour of a country They act upon the subject before it becomes an article of foreign commerce, or of commerce among the States

No direct general power over these objects is granted to Congress

Id. at 203. *But see* Richard A. Epstein, *The Proper Scope of the Commerce Power*, 73 VA. L. REV. 1387, 1402–05 (1987) (criticizing this reading).

79 *See* *The Shreveport Rate Cases* 234 U.S. 342, 353 (1914) (“Congress . . . may prevent the common instrumentalities of interstate and intrastate commercial intercourse from being used in their intrastate operations to the injury of interstate commerce.”); *The Daniel Ball*, 77 U.S. (10 Wall.) 557 (1870) (holding that vessels in intrastate travel are subject to interstate commerce regulations if carrying goods bound for or originating in out-of-state markets).

80 *See* *Carter v. Carter Coal Co.*, 298 U.S. 238, 308 (1936) (holding that “[t]he relation of employer and employee” does not constitute interstate commerce); *United States v. E.C. Knight Co.*, 156 U.S. 1 (1895) (holding that the manufacture of sugar and the regulation of related monopolies were beyond the commerce power); *Kidd v. Pearson*, 128 U.S. 1 (1888) (holding that a statute banning the manufacture of liquor was not a regulation of commerce).

81 *See* *Hammer v. Dagenhart*, 247 U.S. 251 (1918) (holding that a prohibition against interstate shipment of goods manufactured with child labor exceeded Congress’s authority because the goods themselves were not dangerous); *Champion v. Ames (The Lottery Case)*, 188 U.S. 321 (1903) (upholding a statute prohibiting the transport of lottery tickets across state lines).

82 317 U.S. 111 (1942).

83 Act of May 26, 1941, Pub. L. No. 74, 55 Stat. 203.

merce power.⁸⁴ Roscoe Filburn, an Ohio farmer, argued that his growing and harvesting of wheat in excess of the defined quota was not the proper subject of federal regulation since the wheat grown on his farm was exclusively put to his own private use and never entered the stream of commerce, interstate or otherwise.⁸⁵

But the Court held that regulation of Filburn's noncommercial production and consumption of wheat was within the scope of Commerce Clause authority because Filburn's use substantially affected interstate commerce.⁸⁶ Had he not grown the wheat, Filburn likely would have purchased substitute wheat on the market. By opting out of the market, Filburn and others like him decreased interstate demand and interfered with federal efforts to regulate nationwide prices and supply.⁸⁷

After *Wickard*, discerning any limits on the commerce power became a difficult task. For decades, the Court consistently upheld every statute challenged as an invalid exercise of the Commerce Clause.⁸⁸ Not until its 1995 decision in *United States v. Lopez*⁸⁹ did the Court enforce any limits on the commerce power. In *Lopez*, the Court held that the logical connection between carrying guns in school zones and harm to interstate commerce was too attenuated to support the Gun Free School Zones Act.⁹⁰ The Court applied similar logic five years later, striking down the Violence Against Women Act in *United States v. Morrison*.⁹¹

84 See *Wickard*, 317 U.S. at 118–29 (discussing whether the Commerce Clause provides congressional authority to regulate the intrastate production and consumption of wheat and concluding it does).

85 *Id.* at 118.

86 *Id.* at 128–29 (“This record leaves us in no doubt that Congress may properly have considered that wheat consumed on the farm where grown, if wholly outside the scheme of regulation, would have a substantial effect in defeating and obstructing its purpose to stimulate trade therein at increased prices.”). The substantial effects doctrine has its beginnings in *NLRB v. Jones & Laughlin Steel Corp.*, 301 U.S. 1, 37 (1937) (holding that activities that “have such a close and substantial relation to interstate commerce that their control is essential or appropriate to protect that commerce from burdens and obstructions” are within the commerce power).

87 *Wickard*, 317 U.S. at 127.

88 After *Carter v. Carter Coal Co.*, 298 U.S. 238 (1936), the Court invalidated only two such acts, neither of which were held to exceed the internal limits of the Commerce Clause. See *Nat'l League of Cities v. Usery*, 426 U.S. 833 (1976), *overruled by* *Garcia v. San Antonio Metro. Transit Auth.*, 469 U.S. 528 (1985); *New York v. United States*, 505 U.S. 144 (1992) (relying on the Tenth Amendment).

89 514 U.S. 549 (1995).

90 *Id.* at 583.

91 529 U.S. 598 (2000).

Despite this brief flirtation with cabining the commerce power, the Court's most recent major Commerce Clause decision, *Gonzales v. Raich*,⁹² reaffirmed *Wickard* as controlling precedent in cases addressing economic activity, broadly construed. *Raich* held that personal production, possession, and consumption of marijuana for medical purposes, much like Filburn's wheat, contributed to "both the supply and demand sides" of an interstate market and could thus be prohibited under the Controlled Substances Act.⁹³ At least for "economic" activities,⁹⁴ the commerce power continues to enjoy the broad scope set out in *Wickard*.

This broad reading of the Commerce Clause greatly increases the risk of inter-clause conflict.⁹⁵ By encroaching upon formerly distinct spheres of legislative authority, the modern commerce power risks subsuming the remaining enumerated powers, and with them, their limits. If, for example, the Commerce Clause gives Congress independent authority to regulate copyright and related rights—a field that substantially affects interstate commerce—the internal limits of Clause 8 could be rendered dead letters. The scope of Congress's commerce authority, therefore, forces a choice between the external application of the limits of other legislative grants or the effective elimination of constitutional text.

⁹² 545 U.S. 1 (2005).

⁹³ *Id.* at 30.

⁹⁴ The Court was satisfied that the activity in *Raich* was economic despite the fact that the marijuana in question had "never been bought or sold." *Id.* at 57 (Thomas, J., dissenting).

⁹⁵ The *Trade-Mark Cases*, 100 U.S. 82 (1879), offer one clear example of the creeping imperialism of the Commerce Clause and the resulting likelihood of conflicts with the limits of Clause 8. There, the Court struck down Congress's first attempt to create a federal trademark statute. See Act of Aug. 14, 1876, ch. 274, 19 Stat. 141 ("An act to punish the counterfeiting of trade-mark goods and the sale or dealing in of counterfeit trade-mark goods."). First, the Court concluded that trademark legislation—because it required no originality or invention—could not be justified by Clause 8. The Court then determined that the statute was also beyond Congress's then-narrow commerce authority since the legislation regulated non-interstate commerce. *Trade-Mark Cases*, 100 U.S. at 98. Because the statute violated the limits of both sources of authority, the Court had no reason to consider any potential conflicts between them. But reading the *Trade-Mark Cases* with an appreciation of the broad scope of the modern commerce power, the looming inter-clause conflict between Clause 8 and the Commerce Clause is hard to miss. The relationship between contemporary trademark law and the limits of Clause 8 is addressed *infra* at note 255.

II. THE RULE AGAINST SUPERFLUITY AND INTER-CLAUSE CONFLICT

Without a coherent general approach, courts are left to resolve each inter-clause conflict on an ad hoc basis, yielding inconsistent results that lack predictive value.⁹⁶ This Part outlines a method for resolving inter-clause conflicts that preserves the limits on Congress's enumerated powers without forcing a wholesale rejection of the contemporary reading of the Commerce Clause. Under this approach, the commerce power is free to regulate activities that substantially affect interstate commerce so long as it does not strip the limits found in other enumerated powers of their meaning. If legislation justified under the commerce power would effectively eliminate text found

⁹⁶ Other commentators have offered approaches that focus on the unique qualities of Clause 8. Professors Heald and Sherry, for example, have proposed an approach for resolving such conflicts on the basis of historical evidence. Heald & Sherry, *supra* note 6, at 1128–37. They argue that the historical record suggests that Clause 8 was drafted and ratified against a backdrop that regarded federal power to grant monopolies with suspicion and permitted such restraints only in limited and well-defined circumstances. *Id.* at 1144–47. Attempts to use the commerce power to circumvent those limits, therefore, contradict the intent of the Framers.

Although this historical approach provides a compelling narrative, it is inconclusive. Clause 8 was the subject of precious little recorded debate, during both the Convention and ratification. Nachbar, *supra* note 48, at 292; Oliar, *supra* note 1, at 1790–91. Further, the practices of the states, only two of which prohibited state-sanctioned monopolies, cast some doubt on the the notion that monopolies were an overriding concern. Nachbar, *supra* note 48, at 343. And although four states sought the inclusion of a prohibition against the granting of exclusive rights in commerce in the Constitution, that suggestion ultimately failed. *Id.* at 340, 343. In the end, given the incomplete and conflicting record, history alone serves as an insufficient guide in determining the external applicability of the limits of Clause 8.

Professor Patry, in contrast, has approached the issue of inter-clause conflict by characterizing Clause 8 as creating two sorts of rights—a “positive right” that vests in authors and a “negative right” that permits the public to copy unoriginal material. Patry, *supra* note 6, at 364–65. Legislation granting exclusive rights in unoriginal works—if enacted pursuant to other enumerated powers—would not interfere with this positive right. But such a grant would impermissibly impinge upon the public’s negative right.

Patry’s description of this inter-clause conflict is a powerful one. But to the extent his argument justifies external application of Clause 8 limits on the basis of conflict with the public’s negative right to copy, it begs the question. The issue is whether the limits in Clause 8—the originality requirement among them—can constrain congressional action under another grant of power. Reclassification of those limits as “negative rights” assumes the very proposition to be proven. A constitutional right, after all, is shorthand for an interest that is protected from interference by otherwise permissible governmental or private action. To claim that the limits in Clause 8 apply externally because they give rise to negative rights merely restates the question in the form of an affirmative answer. Patry’s characterization of the public’s ability to copy unoriginal material is, in large measure, accurate. But, in the effort to distinguish between internal and external limits, the existence of this right is a conclusion, not a premise.

elsewhere in the Constitution, the Commerce Clause must yield to those external limits.

But a rule against superfluous text cannot resolve inter-clause conflicts on its own. Courts still need a way to distinguish descriptions of a particular enumerated power from limits that restrain other grants of authority. As this Part explains, those distinctions can be drawn by examining potential limits in the broader context of Congress's legislative power as a whole. Through this comparative analysis, courts will find that not all language that looks like a limit functions like one.

A. *Superfluity as a Trigger for External Limits*

Interpretations of a document—whether a contract,⁹⁷ patent,⁹⁸ or statute⁹⁹—that strip text of all meaning are strongly disfavored. Courts assume that the authors of a document include each word or phrase in order to effectuate their intent. Readings that render text meaningless should be rejected in favor of constructions that give effect to all of the text in a document.¹⁰⁰

97 *See, e.g.*, *Sayers v. Rochester Tel. Corp. Supplemental Mgmt. Pension Plan*, 7 F.3d 1091, 1095 (2d Cir. 1993) (“By examining the entire contract, we safeguard against adopting an interpretation that would render any individual provision superfluous.”); *Blake Constr. Co. v. United States*, 987 F.2d 743, 746–47 (Fed. Cir. 1993) (“An interpretation which gives reasonable meaning to all parts of a contract is preferred to one which renders part of it insignificant or useless.”); *Ins. Co. of State of Pa. v. Associated Int’l Ins. Co.*, 922 F.2d 516, 522 (9th Cir. 1990) (noting the principle under California law that “[t]he whole of a contract is to be taken together, so as to give effect to every part, if reasonably practicable, each clause helping to interpret the other” (quoting CAL. CIV. CODE § 1641 (West 1985)) (alteration in original)).

98 *See, e.g.*, *Merck & Co. v. Teva Pharm. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005) (“A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so.”); *Elekta Instrument S.A. v. O.U.R. Scientific Int’l, Inc.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000) (construing claim to avoid rendering a claim limitation superfluous).

99 *See, e.g.*, *Duncan v. Walker*, 533 U.S. 167, 174 (2001) (describing the rule against superfluity as a “cardinal principle of statutory construction” (quoting *Williams v. Taylor*, 529 U.S. 362, 404 (2000))); *Astoria Fed. Sav. & Loan Ass’n v. Solimino*, 501 U.S. 104, 112 (1991) (“[W]e construe statutes, where possible, so as to avoid rendering superfluous any parts thereof.”); *United States v. Menasche*, 348 U.S. 528, 538–39 (1955) (“It is our duty ‘to give effect, if possible, to every clause and word of a statute.’” (quoting *Montclair v. Ramsdell*, 107 U.S. 147, 152 (1883))).

100 *See, e.g.*, *United States v. Ven-Fuel, Inc.*, 758 F.2d 741, 751–52 (1st Cir. 1985) (“All words and provisions of statutes are intended to have meaning and are to be given effect, and no construction should be adopted which would render statutory words or phrases meaningless, redundant or superfluous.”).

Not surprisingly, the Court has looked to potential superfluity in resolving questions of constitutional interpretation. Justice Thomas, concurring with the judgment in *Lopez*, took issue with the Court's failure to explicitly reject *Wickard* for this very reason:

[O]n this Court's understanding of congressional power under . . . [the Commerce and Necessary and Proper] Clauses, many of Congress' other enumerated powers under Art. I, § 8, are wholly superfluous. After all, if Congress may regulate all matters that substantially affect commerce, there is no need for the Constitution to specify that Congress may enact bankruptcy laws, cl. 4, or coin money and fix the standard of weights and measures, cl. 5, or punish counterfeiters of United States coin and securities, cl. 6. Likewise, Congress would not need the separate authority to establish post offices and post roads, cl. 7, or to grant patents and copyrights, cl. 8, or to "punish Piracies and Felonies committed on the high Seas," cl. 10. . . .

Put simply, much if not all of Art. I, § 8 (including portions of the Commerce Clause itself), would be surplusage if Congress had been given authority over matters that substantially affect interstate commerce. An interpretation of cl. 3 that makes the rest of § 8 superfluous simply cannot be correct.¹⁰¹

Likewise, *Railway Labor* relied on the rule against superfluity. The Court explained that RITA was impermissible under the Commerce Clause because "hold[ing] that Congress had the power to enact nonuniform bankruptcy laws pursuant to the Commerce Clause . . . would eradicate from the Constitution a limitation on the power of Congress."¹⁰² Regardless of the scope of Commerce Clause authority, the Court refused to allow Congress to exercise that power where doing so would render constitutional text superfluous.¹⁰³

Just as RITA threatened to eradicate the uniformity requirement of the Bankruptcy Clause, a reading of the Commerce Clause that permits Congress to evade the limits of Clause 8 would render those limits meaningless.¹⁰⁴ Clause 8 enables exclusive rights that serve as economic incentives for the invention and creation of goods distributed through interstate commerce. Congress, therefore, could presumably enact the Patent and Copyright Acts as they exist today using its Commerce Clause authority, even if Clause 8 were stricken from

101 United States v. *Lopez*, 514 U.S. 549, 588–89 (Thomas, J., concurring).

102 *Ry. Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457, 469 (1982).

103 *Id.*

104 See Rochelle Cooper Dreyfuss, *A Wise Guy's Approach to Information Products: Muscling Copyright and Patent into a Unitary Theory of Intellectual Property*, 1992 SUP. CT. REV. 195, 230 ("Restrictions on constitutional grants of legislative power, such as the Copyright Clause, would be meaningless if Congress could evade them simply by announcing that it was acting under some broader authority.")

the Constitution altogether.¹⁰⁵ More importantly, a Commerce Clause unrestrained by external limits would empower Congress to enact legislation that disregards the limits of Clause 8—durational or otherwise. An expanded Commerce Clause unchecked by external limits, therefore, not only renders the positive authority of Clause 8 redundant, it also strips the limits of Clause 8 of all meaning.

This result stands in stark contrast with the Framers' conception of the respective roles of the Commerce Clause and Clause 8. Regardless of the precise scope of the commerce power, intellectual property regimes of the sort found in the Patent and Copyright Acts were thought to require a separate and additional source of authority.¹⁰⁶ Clause 8 provided that authority, but only within the strictures of its limits.

Perhaps, as some have suggested, opponents of quasi-copyright regimes that ignore Clause 8 limits should simply direct "their ire" towards *Wickard*.¹⁰⁷ Certainly, one response to the nullification of constitutional text by the expansion of the commerce power is to reject the Court's Commerce Clause jurisprudence altogether. But short of abandoning the modern regulatory state in favor of a federal government loyal to the Framers' narrow understanding of the Commerce Clause, this Article suggests an approach that may prove more palatable to those reluctant to take the plunge into the deep end of originalism.

In order to preserve meaningful limits while avoiding a strict and potentially disruptive originalism, the rule against superfluity must be applied any time the Commerce Clause would provide Congress with authority denied by other enumerated powers.¹⁰⁸ This approach accommodates the evolution of the Commerce Clause, but it also imposes an important constraint on the outer limits of its expansion.

¹⁰⁵ See *Merges & Reynolds*, *supra* note 6, at 63–64 (acknowledging this possibility).

¹⁰⁶ See generally *Oliar*, *supra* note 1.

¹⁰⁷ Nachbar, *supra* note 48, at 350 (implying that the broad interpretation of the commerce power under *Wickard* makes Clause 8 powers superfluous).

¹⁰⁸ Where the Commerce Clause provides an alternative source of authority to another legislative power, in a strict sense it renders that power superfluous. But to the extent the commerce power is coextensive with the positive authority of another grant, the Commerce Clause confers Congress no additional power. To take an example familiar from *Railway Labor*, assume the modern Commerce Clause grants Congress the power to establish "uniform Laws on the subject of Bankruptcies throughout the United States." U.S. CONST. art. I, § 8, cl. 4. This annexation of bankruptcy authority renders the positive authority provided by Clause 4 superfluous, but it does not alter the scope of Congress's overall authority. Regardless of the clause employed, Congress has the same authority—to uniformly regulate bankruptcy.

Where Congress uses the Commerce Clause to eliminate or ignore a limit within another enumerated power, that limit must be applied externally, and the commerce power must yield.

The Commerce Clause cannot annex the authority defined by other enumerated powers if doing so would read the limits of those clauses out of the Constitution. But it is free to fill the originalist void—that region of legislative space not addressed by other enumerated powers. In large part, the expansion of the Commerce Clause brought within the umbrella of federal regulation power that was not addressed by other legislative powers. The regulation of environmental standards, employment practices, wired and wireless communications, corporate governance, and food and drugs, for example, would remain well within congressional authority if limits on legislative authority were applied externally. The inclusion of these fields of regulation within an expanded Commerce Clause, even if inconsistent with the Framers' intent, creates no risk of superfluity. And so long as the scope of the commerce power is confined to areas not already governed by a separate constitutional provision, the text of each legislative grant will retain meaning.

But this approach faces an important hurdle. The rule against superfluity applies with equal force to all external limits. In order for courts to resolve inter-clause conflict, they must be capable of distinguishing external limits, which constrain other enumerated powers, from internal limits, which merely describe the scope of a particular grant of authority.

B. Identifying Limits on Enumerated Powers

Distinctions between internal and external limits on legislative authority cannot be drawn on the basis of text alone. Instead, these distinctions emerge when limits are analyzed in the broader context of Congress's legislative authority as a whole. Because external limits constrain Congress's power to act under other legislative grants, they define relationships between clauses. The effect of a would-be limit, therefore, cannot be judged without comparing it to the other powers it would act upon.¹⁰⁹

109 See Laurence H. Tribe, *Taking Text and Structure Seriously: Reflections on Free-Form Method in Constitutional Interpretation*, 108 HARV. L. REV. 1221, 1235 (1995) ("Read in isolation, most of the Constitution's provisions make only a highly limited kind of sense. Only as an interconnected whole do these provisions meaningfully constitute a frame of government . . .").

This comparative analysis begins with the clause containing the potential external limit. Each clause confers upon Congress some positive authority to legislate. The scope of that power is defined primarily by its own limits. If those limits are merely descriptive, they are silent about the reach of Congress's other powers. But external limits deny Congress some measure of authority. For example, the Bankruptcy Clause gives Congress the power to enact uniform bankruptcy laws. But since the uniformity requirement is an external limit, it simultaneously denies Congress the power to enact non-uniform bankruptcy laws.

Once the authority that a particular limit would deny Congress has been identified, it should be compared to the authority granted by the other enumerated powers. If another power grants Congress the same authority that the limit would deny, that text cannot reasonably be considered an external limit. In other words, if the legislative power forbidden by the limits of the first clause is granted by the positive authority of another clause, the first contains no enforceable external limits.¹¹⁰ But to the extent the authority forbidden by a limit of one power is not permitted by any other legislative grant, Congress should be precluded from acting in a manner that ignores that limit.

The relationship between the sixth and tenth clauses of Section 8 offers perhaps the clearest instance of text that appears, in isolation, to function as an external limit, but serves a purely descriptive purpose. Clause 6 authorizes Congress to "provide for the Punishment of counterfeiting . . . [the currency] of the United States."¹¹¹ If the phrase "of the United States" functioned as an external limit, Congress would be precluded from punishing the counterfeiting of foreign currency. But a contextual analysis reveals that another enumerated power provided Congress the very authority putatively denied by that phrase. Clause 10, which grants Congress authority to "define and punish . . . Offences against the Law of Nations,"¹¹² em-

110 This approach might help to clarify the apparent inter-clause conflict raised by the *Civil Rights Cases* and *Heart of Atlanta*. See *supra* notes 68–74 and accompanying text. The Court's holding in the *Civil Rights Cases* relied on the fact that the Fourteenth Amendment enabled Congress to legislate with regard to state, but not private, action. Because the Commerce Clause permits Congress to regulate private action, the legislative authority that would be denied by applying the state-action limitation of the Fourteenth Amendment externally is squarely within Congress's commerce power. The state-action limit describes the scope of Congress's additional power under the Fourteenth Amendment, not a restraint on the commerce power or its expansion.

111 U.S. CONST. art. I, § 8, cl. 6.

112 U.S. CONST. art. I, § 8, cl. 10.

powers Congress to punish counterfeiters of foreign currency, as the Court has long recognized.¹¹³ If Congress is entitled to punish counterfeiters of both foreign and domestic currency, the phrase “of the United States” cannot be said to function as an external limit on congressional authority.¹¹⁴ This example, among others,¹¹⁵ demonstrates that not all would-be limits actually constrain Congress from acting under other grants of authority.

Some opponents of robust external limits suggest that they could give rise to counterintuitive constraints on congressional power.¹¹⁶ If Clause 10 empowers Congress to “define and punish Piracies and Felonies committed on the high Seas,” is Congress precluded from punishing felonies that occur on land?¹¹⁷ And if the power to establish

113 *United States v. Arjona*, 120 U.S. 479, 483–84 (1887) (holding that the United States has an obligation under the law of nations to protect foreign currency from counterfeiting). Adding further support to the notion that these two clauses are not in tension is the fact that in an early draft of the Constitution, the power over “the Punishment of counterfeiting . . . the Coin of the United States” and “[the punishment] of Offences against the Law of Nations” were contained in the same clause. *See* 2 THE RECORDS OF THE FEDERAL CONVENTION OF 1787, at 168, 182 (Max Farrand ed., rev. ed. 1966).

114 Conceivably, state currency could constitute non-U.S. currency. During the colonial period, states coined their own currency. *See, e.g.*, Louis Jordan, Colonial Currency, <http://www.coins.nd.edu/ColCurrency/CurrencyText/Contents.html> (last visited Mar. 31, 2008) (providing photographs of and explanations for the developments of colonial currency). But this reading is foreclosed by the Constitution itself; with ratification, the states ceded their authority to “coin Money; [emit] Bills of Credit; [and] make any Thing but gold and silver Coin a Tender in Payment of Debts.” U.S. CONST. art. I, § 10, cl. 1.

115 The Court has also resolved potential conflicts between Congress’s power to “raise and support Armies” and the Militia Clauses by recognizing that the Militia Clauses are subsumed within Congress’s broad power under Clause 12. *See* U.S. CONST. art. I, § 8, cls. 12, 15, 16. In the *Selective Draft Law Cases*, 245 U.S. 366 (1918), the Court upheld a challenge to a selective military draft. Potential draftees argued that the statute was inconsistent with the limitations of the Militia Clauses, which permit Congress to call forth the militia “to execute the Laws of the Union, suppress Insurrections and repel Invasions.” U.S. CONST. art. I, § 8, cl. 15. The Court found that the power to raise an Army gave Congress “complete authority” over the creation and funding of the military. *Draft Law Cases*, 245 U.S. at 382. The Militia Clauses, therefore, serve only as an alternate means by which Congress can establish a military force, one that requires less than the full measure of its authority. The Militia Clauses simply “diminished the occasion for the exertion by Congress of its military power beyond the strict necessities for its exercise by giving the power to Congress to direct the organization and training of the militia.” *Id.* at 383; *see also* *Perpich v. Dep’t of Def.*, 496 U.S. 334, 349 (1990) (“[F]ar from being a limitation on [the powers to ‘provide for the common Defence,’ ‘raise and support Armies,’ [and] ‘make Rules for the Government and Regulation of the land and naval Forces’], the Militia Clauses are—as the constitutional text plainly indicates—additional grants of power . . .”).

116 *See* Nachbar, *supra* note 48, at 295.

117 Clause 10 grants Congress authority to “define and punish Piracies and Felonies committed on the high Seas.” U.S. CONST. art. I, § 8, cl. 10. If “high Seas” functions as an external limit, it could preclude punishing those same offenses on land. Since many federal

criminal statutes are justified under the Commerce Clause, this limit would place a significant constraint on Congress's commerce power. See Steven D. Clymer, *Unequal Justice: The Federalization of Criminal Law*, 70 S. CAL. L. REV. 643, 656 (1997) (explaining that Congress usually relies on its commerce power to enact federal criminal law). But the "high Seas" language functions primarily descriptively and, even at the time of ratification, imposed no limit on Congress's power to define and punish crimes on land, whatever the scope of Congress's authority to enact criminal laws.

Two primary definitions of the phrase "high seas" emerge from the historical record. The first and narrower of these definitions recognizes three distinct zones of navigable waters: inland, or internal waters; the territorial sea, comprised of those waters along a nation's shores; and the high seas, which are international waters outside the territorial sea and not within the dominion of any particular nation. See *United States v. Louisiana*, 394 U.S. 11, 22–23 (1969) (recognizing the international tradition distinguishing these three zones); *The Hamilton*, 207 U.S. 398, 403 (1907) (describing the high seas as "outside the territory in a place belonging to no other sovereign"); *The "Scotland,"* 105 U.S. 24, 29 (1881) (noting that on the high seas, "the law of no particular State has exclusive force, but all are equal"); *United States v. Jackson*, 26 F. Cas. 558, 559 (C.C.S.D.N.Y. 1843) (. . . "[T]he high seas were, properly speaking, within the territory of no state or country"); *United States v. Morel*, 26 F. Cas. 1310, 1312 (C.C.E.D. Pa. 1834) ("[T]he high sea . . . is that which is . . . under the particular right or jurisdiction of no sovereign . . .").

If the high seas were understood to exclude coastal territorial waters and inland waters, application of "high Seas" as an external limit may not implicate congressional authority over crimes committed on *terra firma* at all. Instead, "high Seas" would remove from Congress's reach the power to define and punish crimes that occur in the sea just off of the coast of a state or within its bays and inlets. This reading, however, is inconsistent with legislation enacted by the First Congress, which punished crimes committed not only "upon the high seas" but also "in any river, haven, basin or bay, out of the jurisdiction of any particular state." Act of Apr. 30, 1790, ch. 9, § 8, 1 Stat. 112, 113.

Justice Story provided a second, and significantly broader, definition of the high seas as "the waters on the sea coast below low water mark, whether within the territorial boundaries of a foreign nation, or of a domestic state." See 3 JOSEPH STORY, COMMENTARIES ON THE CONSTITUTION OF THE UNITED STATES § 1159, at 56 (Boston, Hilliard, Gray, & Co. 1833). In other words, the high seas include "that part of the ocean, which washes the sea-coast, and is without the body of any county [sic], according to the common law." *Id.* at 57. This definition, although disfavored by subsequent courts, was adopted in a number of early cases. Compare *United States v. Wiltberger*, 18 U.S. (5 Wheat.) 76, 94 (1820) (defining the high seas as "the ocean which washes a coast"), with *In re Air Crash Off Long Island*, 209 F.3d 200, 206–07 (2d Cir. 2000) (rejecting the argument that high seas means "beyond the low-water mark").

If this definition of "high Seas" served as an external limit, Congress could face a bar to punishing crimes on land. Since a "piracy" is, by definition, a "robbery upon the sea," *United States v. Smith*, 18 U.S. (5 Wheat.) 153, 162 (1820), the class of piracies that occur on land is a null set. Felonies, on the other hand, included all crimes punished by the forfeiture of land or property at common law, particularly those for which capital punishment could be imposed. See STORY, *supra* at § 1155. So a prohibition against legislation punishing felonies on land would indeed be a genuine and significant limit on Congress's power.

But a review of the remainder of the Constitution and the legislation enacted by the First Congress reveals that no limit interfered with the punishment of felonies on land. Article III, Section 3 provides Congress with the power to punish treason, a power the First Congress exercised by imposing capital punishment for traitors. Act of Apr. 30,

“post Roads” contains an external limit, is Congress barred from creating other sorts of roads?¹¹⁸ But once these potential limits are com-

1790, ch. 9, § 1, 1 Stat. 112, 112. Likewise, the First Congress exercised the power granted in Article I, Section 8, Clause 6 by punishing counterfeiting with death. *Id.* § 14. The First Congress also defined and punished murder, dismemberment, and theft both on the high seas and on federal land. *Id.* §§ 3, 13, 16. These forays into criminal law—along with punishing theft of the mail and perjury—traditionally have been understood as exercises of the Necessary and Proper Clause. U.S. CONST. art. I, § 8, cl. 18; *see, e.g., McCulloch v. Maryland*, 17 U.S. (4 Wheat.) 316, 417 (1819).

So even if limits on enumerated powers apply externally, Congress remains free to enact criminal laws targeting activities that occur on land. The precise scope of Congress’s power to criminalize behavior by use of the commerce power is beyond the scope of this Article. But if that power is to be limited, it is certainly not on the basis of the high seas requirement of Clause 10.

118 Clause 7 grants Congress the power to “establish Post Offices and post Roads.” U.S. CONST. art. I, § 8, cl. 7. If “post Roads” serves as a limit on congressional authority and is applied externally to constrain commerce legislation, Congress could be barred from establishing roads other than post roads. But that fear is unjustified.

Clause 7 can be read in two ways. Some contend that the establishment of a post road permitted nothing more than the designation of preexisting roads for carrying the post. *See* STORY, *supra* note 117, § 1123. This reading conforms to early congressional practice. *See* Act of Feb. 20, 1792, ch. 7, 1 Stat. 232 (establishing a post office and post roads within the United States); Act of Apr. 21, 1806, ch. 55, 2 Stat. 408 (establishing additional post roads within the United States). This reading also found support in some early opinions. *See* *Searight v. Stokes*, 44 U.S. (3 How.) 151, 181 (1845) (Daniel, J., dissenting) (noting that the postal power “confers no right to open new roads, but implies nothing beyond . . . the selection amongst various routes . . . most judicious to have the mails transported”); *United States v. R.R. Bridge Co.*, 27 F. Cas. 686, 689 (C.C.N.D. Ill. 1855) (stating that the postal power is “exhausted in the designation of roads on which the mails are to be transported”). Under this reading, Clause 7 is entirely silent on the construction of roads and can impose no bar on Commerce Clause authority.

But this narrow use of “establish” is at odds with the meaning of the term elsewhere in the Constitution. *See* U.S. CONST. art. III, § 1 (authorizing Congress to “ordain and establish” inferior courts); U.S. CONST. art. I, § 8, cl. 4 (granting Congress the power to “establish an uniform Rule of Naturalization”). The Court embraced a more robust reading of the power to “establish” post offices and post roads that included creation as well as designation. *See* *Kohl v. United States*, 91 U.S. 367, 372 (1875).

If Clause 7 provides authority to create post roads, does a prohibition against the creation of non-post roads impose a meaningful limit on Congress? History makes certain that in order for a road to be considered a post road its sole or even primary use need not be the transportation of the post. The Cumberland Road is emblematic of the broad sweep of the postal power. *See* Act of Mar. 29, 1806, ch. 19, 2 Stat. 357 (providing for the construction of the Cumberland road from Maryland to Ohio); Act of Apr. 28, 1810, ch. 30, 2 Stat. 579, 584 (providing for the extension of the Cumberland Road). The federal government not only funded its creation, but directly oversaw its construction. The road’s simultaneous and primary use as a channel for travelers and commodities did not prevent Congress from exercising its postal power.

What then is a non-post road? Given the scope of the postal power and the pervasive reach of the post, the class of non-post roads is exceedingly small. But to the extent the theoretical need for non-post roads remains a concern, long before *Wickard*, courts recognized Congress’s power to create roads pursuant to the commerce power. *See* *California v. Cent. Pac. R.R. Co.*, 127 U.S. 1, 39 (1888) (“The power to construct, or to authorize

pared to Congress's other legislative authority, it becomes clear that these rhetorical counterexamples offer little substantive criticism.

This comparative analysis, it should be noted, incorporates a certain degree of originalist bias. If this analysis occurred against the backdrop of the modern Commerce Clause, it would likely demonstrate that no limits on Congress's power apply externally. After all, whatever authority those limits would deny Congress would be within the scope of another enumerated power, namely the Commerce Clause. In order for this analysis to resolve inter-clause conflicts, the comparison should proceed from a reference point that does not take the modern commerce power as given. Otherwise, it would ignore the very expansion of legislative power that gives rise to inter-clause conflict in the first place. The resolution of these conflicts, after all, is largely meant to gauge the legitimacy of Commerce Clause expansion into zones otherwise governed by other grants of authority. To embed that expansion into the comparative backdrop only begs the question.

Even if courts are able to distinguish external limits from their internal counterparts, they still must determine whether a particular external limit is implicated by a challenged statute. That task is discussed below.

C. *Mapping Challenged Statutes on the Constitutional Topography*

Statutes must conform to the external limits implicated by their subject matters; they are not subject to external limits that address unrelated areas of regulation. Legislation that alters the relationship between debtors and their creditors must conform to the uniformity requirement, but a civil rights bill cannot be challenged for its lack of uniformity. Nor could an act imposing environmental standards be held to exceed Congress's power because it failed to satisfy the lim-

individuals or corporations to construct, national highways and bridges from State to State, is essential to the complete control and regulation of interstate commerce."); *see also* *Monongahela Bridge Co. v. United States*, 216 U.S. 177, 194 (1910) (holding that the erection of a bridge is within "the paramount power of Congress to regulate commerce among the States").

But the postal power did provide Congress with some authority that the pre-*Wickard* Commerce Clause could not. Many early post roads were entirely intrastate, and therefore beyond the scope of the commerce power. So to the extent "post Roads" serves as a limit to legislation enacted under the modern Commerce Clause, at most it precludes Congress from creating intrastate roads on which the post will never be carried. As a practical matter, external application of that limit would not impede Congress in any meaningful way.

ited times requirement of Clause 8. These examples, while perhaps frivolous, demonstrate that if a statute falls so far afield from the subject matter of a particular grant, the statute need not conform to the external limits of that clause. But not all examples are quite so obvious. Distinguishing commercial regulations from taxes, bankruptcy laws, or copyright laws, for example, is not as easy a task.

The Court's prior forays into inter-clause conflict offer some guidance. In both *Railway Labor* and the *Head Money Cases*, the Court was asked to determine whether the limits of one grant of authority were applicable to legislation arguably justified under the Commerce Clause. Although the Court reached different conclusions in these two cases, it approached the question in similar ways. In both cases, the Court saw its primary task as determining which of the two grants served as the true source of Congress's authority to enact the challenged legislation.

In order to decide if the uniformity requirement of the Bankruptcy Clause rendered RITA unconstitutional, the *Railway Labor* Court thought it "necessary first to determine whether the . . . [statute was] an exercise of Congress' power under the Bankruptcy Clause . . . or under the Commerce Clause."¹¹⁹ Acknowledging that this determination was "not an easy task,"¹²⁰ the Court began by considering the subject matter of the Bankruptcy Clause, which contained the limit in question. Bankruptcy, according to the Court, is the "subject of the relations between an insolvent or nonpaying or fraudulent debtor and his creditors, extending to his and their relief."¹²¹

Having defined the subject matter of the Bankruptcy Clause, the Court asked whether RITA fell within it. The Court looked to two factors in making this determination. First, it considered the purpose and effect of the statute as revealed through its text. Because the statute "prescribe[d] the manner in which the property of the Rock Island estate [was] to be distributed among its creditors," it functioned as a bankruptcy law.¹²² Second, the Court considered the statute's legislative history and the events surrounding its enactment. Since Congress announced its intention that "employee protection be imposed

119 *Ry. Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457, 465 (1982). For further details on this case, see *supra* notes 35–49 and accompanying text.

120 *Ry. Labor*, 455 U.S. at 465.

121 *Id.* at 466 (quoting *Wright v. Union Cent. Life Ins. Co.*, 304 U.S. 502, 513–14 (1938)).

122 *Id.* at 467.

in bankruptcy proceedings involving major rail carriers”¹²³ only after Rock Island initiated reorganization proceedings, the Court was confident that RITA reflected an exercise of the bankruptcy power.

The *Head Money Cases*¹²⁴ took a similar approach. There, the Court had to determine whether the uniformity requirement of Clause 1 applied to the fifty-cent fee charged to ship operators. Because the statute at issue appeared to regulate foreign commerce, but also levied a duty,¹²⁵ the rubrics of both taxation and commercial regulation offered potential justifications.

The Court began, much as it did in *Railway Labor*, by considering whether the legislation at issue was an exercise of the commerce power or the taxation power. The *Head Money* Court determined that “the power exercised in this instance is not the taxing power,” but instead the Commerce Clause.¹²⁶ Because “the real purpose and effect of the statute . . . from beginning to end . . . [was] to mitigate the evils inherent in the business of bringing foreigners to this country,”¹²⁷ the 1882 Act, like similar regulations of commerce, “was not subject . . . to the rules which would invalidate an ordinary tax pure and simple.”¹²⁸ Nonetheless, perhaps in recognition of the difficulty inherent in delineating the precise scope of these sources of authority, the Court upheld the statute only after satisfying itself that the requirements of the taxing power, which it claimed were inapplicable, were indeed satisfied.¹²⁹

These two cases, although separated by nearly one hundred years, share some common traits. First, both Courts implicitly embraced the notion that the limits of one clause can constrain legislation otherwise permissible under another. Second, both cases treated the question of the source of Congress’s authority as an initial, and largely determinative, inquiry. If Congress acted pursuant to the power containing the relevant limit, the statute was unconstitutional. But if the legislation was better classified as a commercial regulation, it was permissible.

In adopting this approach, both cases relied on a potentially problematic common assumption—that only one legislative power can

123 *Id.* at 468.

124 112 U.S. 580 (1884). For further details on this case, see *supra* notes 58–63 and accompanying text.

125 *Head Money Cases*, 112 U.S. at 589.

126 *Id.* at 595.

127 *Id.*

128 *Id.* at 596.

129 *Id.*

serve as the true source of congressional authority to enact any particular statute. The *Head Money* Court, operating before the Commerce Clause had reached its full ebb, reasonably understood that Congress's enumerated powers were distinct and non-overlapping. But the expansion of the commerce power complicates efforts by courts to identify the one true source of Congress's power. Legislation that once could have been enacted pursuant to only one congressional power can now, in many instances, reasonably lay claim to an alternate source of authority.

Against the backdrop of the sweeping reach of the Commerce Clause and the external limits that cabin its expansion, what does it mean to ask which power Congress has exercised in enacting legislation? In short, courts must situate challenged statutes within the complex topography of overlapping legislative powers and their external limits.

Mapping this topography of legislative powers requires courts to recognize that the logical space occupied by a particular grant is not defined solely by its positive authority. Instead, it is comprised of a central nucleus of positive authority, surrounded by a space defined by the clause's external limits. A given statute then can fall into one of three regions on the topography of legislative powers with respect to any particular clause. First, a statute that satisfies the limits of a particular clause and addresses its core subject matter falls within the positive authority of that clause. In these scenarios, Congress is entitled to act. Second, a statute that addresses the core subject matter of an enumerated power, but violates one or more of its external limits, falls within the penumbra surrounding the positive authority of that clause. In that case, Congress has no authority to enact the statute, regardless of the power it seeks to use. Otherwise, legislation could escape the external limits of a clause simply by virtue of violating them. Third, when the purpose and function of a statute do not address the core subject matter of a particular enumerated power, that statute is beyond the reach of the external limits of that power.

Taken together, the contours of each grant of positive authority and their corresponding penumbras define the topography of Congress's legislative authority. When a court asks which of two enumerated powers serves as the source of authority for a given act, at bottom, the court is asking where that act falls within this topography. In other words, does the purpose and function of the statute in question fall far enough away from the core concern of the grant so as to be free of its limits? The next Part sketches both the limits and core subject matter of Clause 8.

III. DEFINING THE CLAUSE 8 PENUMBRA

Clause 8 confers upon Congress 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.”¹³⁰ Unlike other enumerated powers, neither the positive authority nor the precise limits of Clause 8 are immediately apparent from its text. This Part identifies the limiting text of Clause 8, sketches the basic restraints it places on Congress’s copyright authority, and considers whether those limits apply externally to constrain the Commerce Clause. This Part concludes that the limits of Clause 8 delineate a zone of potential legislation that runs afoul of the Constitution regardless of the power under which Congress intends to act. This zone defines the penumbral public domain.

A. *The Limits of the Copyright Power*

The text of Clause 8 is unique among Congress’s enumerated powers in several respects. First, Clause 8 incorporates two separate grants of authority. Congress’s power to “promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings”¹³¹ traditionally has been embodied in the Copyright Act, while the power to “promote the Progress of . . . [the] useful Arts . . . by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries”¹³² has been exercised through the Patent Act.¹³³ While other enumerated powers include multiple

¹³⁰ U.S. CONST. art. I, § 8, cl. 8.

¹³¹ *Id.*

¹³² *Id.*

¹³³ See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 56 (1884) (“Under the acts of Congress designed to give effect to [Clause 8], the persons who are to be benefited are divided into two classes, authors and inventors. The monopoly which is granted to the former is called a copyright, that given to the latter, letters patent, or, in the familiar language of the present day, *patent right*.”); *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 684 (1834) (Thompson, J., dissenting) (“This article is to be construed distributively, and must have been so understood; for when congress came to execute this power by legislation, the subjects are kept distinct, and very different provisions are made respecting them.”); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 100 (2d Cir. 1951) (“[T]he Constitution differentiates (a) ‘authors’ and their ‘writings’ from (b) ‘inventors’ and their ‘discoveries.’”); *Taylor Instrument Cos. v. Fawley-Brost Co.*, 139 F.2d 98, 99 (7th Cir. 1943) (identifying “two separate and distinct fields of protection, the copyright and the patent”); L. Ray Patterson, *Understanding the Copyright Clause*, 47 J. COPYRIGHT SOC’Y U.S.A. 365, 367, 367 n.6 (2000) (“Article I . . . contains the patent clause, and reads as follows: ‘The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their

distinct grants of authority,¹³⁴ the two grants within Clause 8 are not explicitly distinguished in the text. Second, Clause 8 is unique in that it includes both a “means” clause and an “ends” clause.¹³⁵ The first half of Clause 8—the to “promote the Progress” language—serves as the purpose of the grant, while the latter half—the “by securing . . . exclusive Right[s]”¹³⁶ language—functions to set out the means by which that end is achieved. Finally, Clause 8, unlike most other grants, includes multiple potential limits on Congress’s authority. Whereas Congress’s bankruptcy and naturalization powers, for example, must simply satisfy the requirement of uniformity, Clause 8 includes a series of limitations on the scope of congressional authority. Each of these potential external limits are discussed below.

1. “Promote the Progress”

The first potential external limit of Clause 8, to “promote the Progress of Science,” has been read by courts and scholars in a variety of ways—as a limit, a grant, neither, and both.¹³⁷

First, this text has been understood as a limit that precludes Congress from exercising its power to grant exclusive rights whenever such rights would fail to promote the progress of science and the useful arts. This reading finds its strongest support in *Graham v. John Deere Co.*, where the Court explained that Clause 8 serves as “both a grant of power and a limitation” and that “Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose.”¹³⁸

respective Writings and Discoveries. . . .’ The parallel construction makes it easy to identify the copyright clause: ‘The Congress shall have Power . . . To promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive right to their . . . Writings.’”); Pamela Samuelson, *Why Copyright Law Excludes Systems and Processes from the Scope of Its Protection*, 85 TEX. L. REV. 1921, 1937 n.103 (2007) (noting that the use of the term “respective” in connection to the “Writings and Discoveries” of “Authors and Inventors” lends support to this reading). *But see* Oliar, *supra* note 1, at 1789–90 n.98, 1823 n.228 (noting that historical evidence casts some doubt on a clear dichotomy between the patent and copyright powers of Clause 8).

¹³⁴ See, e.g., U.S. CONST. art. I, § 8, cls. 1, 4, 5, 10.

¹³⁵ See Dan T. Coenen & Paul J. Heald, *Means/Ends Analysis in Copyright Law: Eldred v. Ashcroft in One Act*, 36 LOY. L.A. L. REV. 99, 106 (2002) (“[W]hen Congress grants copyright protection it can’t rely on any source of authority other than the Intellectual Property Clause. Usually Article I grants of power are not deemed exclusive in this way.”).

¹³⁶ U.S. CONST. art. I, § 8, cl. 8.

¹³⁷ Oliar, *supra* note 1, at 1781–84 (discussing the opposing interpretations).

¹³⁸ 383 U.S. 1, 5–6 (1966); see also *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 860 (5th Cir. 1979) (discussing the limited judicial role in judging whether Congress has exceeded its Article I powers); *Great Atl. & Pac. Tea Co. v. Supermarket*

Others read this text, not as a limit on Congress's authority, but as the very core of the power granted by Clause 8.¹³⁹ The Bankruptcy Clause confers upon Congress the power to "establish . . . uniform Laws on the subject of Bankruptcies."¹⁴⁰ And the Commerce Clause grants the power to "regulate Commerce."¹⁴¹ Likewise, one could argue, Clause 8 confers upon Congress the power to "promote the Progress of Science and the useful Arts." The remainder of the clause, under this view, simply spells out the permissible mechanisms for doing so. Although this reading of the clause is in keeping with the grammatical structure of the rest of Section 8, it has not served as the dominant interpretation.

The prevailing view rejects both of these readings and instead treats the first half of Clause 8 as a mere preamble that serves as neither a grant of authority nor a limit on congressional power. The ascendancy of this view appears to owe its origins, at least in part, to a rather weakly supported passage from *Nimmer on Copyright*.¹⁴² Despite the questionable provenance of this reading, courts considering the question have generally followed *Nimmer* and given the "promote the Progress" language no binding effect, arguably stripping this text of any meaning.¹⁴³

More recently, Professor Oliar—on the basis of Madison and Pinckney's original proposals at the Constitutional Convention—has persuasively argued for a reading of "promote the Progress" that recognizes it as both a grant of authority and a limit.¹⁴⁴ According to this view, the positive authority of Clause 8 is defined by the overlap of its means and ends clauses. Clause 8 grants Congress authority "[t]o promote the Progress" precisely where it does so by exercising its au-

Equip. Corp., 340 U.S. 147, 154 (1950) (Douglas, J., concurring) ("The Congress acts under the restraint imposed by the statement of purpose in Art. I, § 8.").

139 See WILLIAM F. PATRY, *PATRY ON COPYRIGHT* §3:5 (2008) (discussing the proposition that the word "promote" serves as a grant of congressional power and is synonymous with "encourage" and "advance").

140 U.S. CONST. art. I, § 8, cl. 4.

141 U.S. CONST. art. I, § 8, cl. 3.

142 See MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 1.03 (2008). ("This introductory phrase is in the main explanatory of the purpose of copyright, without in itself constituting a rigid standard against which any copyright act must be measured . . . rather than constituting a limitation on Congressional authority, has for the most part tended to expand such authority." (citation omitted)).

143 Edward C. Walterscheid, "Within the Limits of the Constitutional Grant": *Constitutional Limitations on the Patent Power*, 9 J. INTELL. PROP. L. 291, 326 (2002) (arguing that treating the first half of Clause 8 as a preamble renders it superfluous).

144 See Oliar, *supra* note 1, at 1816–18 (arguing that Clause 8 limits Congress's power but also excludes Congress from using other means to exercise that power).

thority “[to secure] exclusive Right[s]” to “Authors and Inventors” in accordance with the other limits inherent in Clause 8.

Assuming that this text functions not as a preamble but, at least in part, as a limit on Clause 8 authority, what does it mean “to promote the Progress of Science”? The term “Science,” as used in the Constitution, is not limited to the modern understanding of the term: the system or process of acquiring knowledge about natural phenomena.¹⁴⁵ Rather—true to its Latin root *scientia*—“Science” refers more broadly to “[k]nowledge acquired by study; acquaintance with or mastery of any department of learning.”¹⁴⁶ This limit, then, requires Congress to encourage or further¹⁴⁷ the advancement¹⁴⁸ of knowledge or learning when exercising its Clause 8 power. But as discussed *infra*, the practical implications of such a limit are ambiguous at best.¹⁴⁹

2. “Limited Times”

The second potential external limit arises from the requirement that Congress grant exclusive rights pursuant to Clause 8 only for “limited Times.” Perhaps more so than any other Clause 8 text, the “limited Times” requirement intuitively appears to function as a limit on congressional authority.

In *Eldred v. Ashcroft*,¹⁵⁰ the Court directly addressed the constraints this text places on Congress’s Clause 8 authority. There, the Court rejected a constitutional challenge to the Sonny Bono Copyright Term Extension Act of 1998,¹⁵¹ in part, on the grounds that the retroactive extension of the term of protection for existing works did not violate the “limited Times” requirement.¹⁵² According to the Court, this requirement does not mean that the term of copyright protec-

145 See AMERICAN HERITAGE SCIENCE DICTIONARY, available at <http://dictionary.reference.com/browse/science> (last viewed August 28, 2007).

146 Lawrence B. Solum, *Congress’s Power To Promote the Progress of Science: Eldred v. Ashcroft*, 36 LOY. L.A. L. REV. 1, 48 (2002) (quoting 14 J.A. SIMPSON & E.S.C. WEINER, THE OXFORD ENGLISH DICTIONARY 648 (2d ed. 1989)).

147 See *id.* at 45; see also *Bauer & Cie v. O’Donnell*, 229 U.S. 1, 10 (1913) (“[The Act of 1790] was passed for the purpose of encouraging useful invention”); *Mitchell v. Tilghman*, 86 U.S. (19 Wall.) 287, 418 (1873) (“Patent laws have for their leading purpose the encouragement of useful inventions.”).

148 Solum, *supra* note 147, at 45–46 (discussing that the First Congress likely believed that promoting the progress meant encouraging that activity). But see Pollack, *supra* note 1, at 760 (discussing potential alternative meanings for progress).

149 See *infra* Part IV.A.

150 537 U.S. 186 (2003).

151 Pub. L. No. 105-298, 112 Stat. 2827 (1998).

152 *Eldred*, 537 U.S. at 222 (holding that the “limited Times” prescription was not violated).

tion, once granted, is “forever fixed or inalterable.”¹⁵³ Instead, the term of a grant of exclusive rights is limited if it is “confine[d] within certain bounds.”¹⁵⁴ At the very least, both the *Eldred* majority and its dissenters would agree that an expressly perpetual copyright would violate the “limited Times” requirement.¹⁵⁵ Although this minimal constraint on congressional authority does not offer a particularly robust reading of “limited Times,” it does provide a bright-line rule that could call into question existing federal legislation.¹⁵⁶

3. “Authors”

The word “Authors” gives rise to two distinct limits on Congress’s Clause 8 authority. First, it identifies the class of those to whom exclusive rights can be granted. Second, it limits the grant of exclusive rights to works that exhibit some minimal level of originality.

The exclusive rights permitted by Clause 8 may not vest in whomever Congress chooses. If Congress extends exclusive rights under its copyright power, those rights must vest in the author of the protected work. An “author” in the constitutionally relevant sense is “he to whom anything owes its origin; originator; maker; one who completes a work of science or literature.”¹⁵⁷ Congress could not, for example, employ its Clause 8 power to enact a copyright lottery that selects random citizens as the lucky recipients of copyrights in newly created works. Such legislation would exceed Congress’s power since the exclusive rights granted are not given to those responsible for creating the protected works.

From this definition of “author” as the originator of a work, courts have understood Clause 8 to impose a distinct and fundamental limit on the scope of copyright protection.¹⁵⁸ As the Court made clear in *Feist Publications, Inc. v. Rural Telephone Service Co.* when it refused to extend copyright protection to unoriginal compilations of data, the

¹⁵³ *Id.* at 187 (internal quotation marks omitted).

¹⁵⁴ *Id.* (alteration in original).

¹⁵⁵ *Id.* at 241 (Stevens, J., dissenting); *see also id.* at 209–10 (discussing the Court’s renewal of copyright extensions notwithstanding the “limited Times” requirement).

¹⁵⁶ *See infra* Part IV.C.

¹⁵⁷ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884); *see also Nottage v. Jackson*, 11 Q.B.D. 627, 635 (1883) (U.K.) (Cotton, L.J., concurring) (stating that authorship requires “originating, making, [or] producing”).

¹⁵⁸ *CDN Inc. v. Kapes*, 197 F.3d 1256, 1259 (9th Cir. 1999) (“[T]he requirement of originality is a constitutional one inherent in the grant to Congress of the power to promote science and the useful arts”); *Mid Am. Title Co. v. Kirk*, 59 F.3d 719, 721 (7th Cir. 1995) (“Originality is both a statutory and constitutional requirement.”).

Constitution demands originality.¹⁵⁹ As a constitutional matter,¹⁶⁰ a copyrightable work must be independently created—rather than copied from another—and exhibit “at least some minimal degree of creativity.”¹⁶¹

Feist cites two decisions, the *Trade-Mark Cases*¹⁶² and *Burrow-Giles Lithographic Co. v. Saroni*,¹⁶³ as the judicial foundation of the originality requirement.¹⁶⁴ According to the *Feist* Court, *Burrow-Giles* understood “Authors” as the situs of that requirement, while the *Trade-Mark Cases* rooted that same limit in the word “Writings.”¹⁶⁵ *Feist* was correct that these two cases articulated a constitutional originality requirement. But the Court misread the *Trade-Mark Cases* by suggesting it understood the originality requirement as a product of the term “Writings.” Rather, the *Trade-Mark Cases*, like *Burrow-Giles*, located the originality requirement in the term “Authors.”

Justice Samuel F. Miller authored the unanimous opinions in the *Trade-Mark Cases* and *Burrow-Giles* in 1879 and 1884, respectively.¹⁶⁶ Aside from the rather puzzling insistence that two decisions written by the same justice, and decided within five years of each other, would locate the same constitutional requirement in two different terms, *Feist*’s reading of the *Trade-Mark Cases* fails to recognize its close ties to the Court’s subsequent, and perhaps more explicit, reasoning in *Burrow-Giles*.

As discussed *supra*, the *Trade-Mark Cases* struck down Congress’s first attempt to enact federal trademark protection.¹⁶⁷ In considering whether trademarks could be considered “writings of authors,” Justice Miller found that the term “writings” had been “liberally construed” to include not only books, maps, and charts, but also engravings, and prints.¹⁶⁸ But regardless of the broad scope of “writings,” trademark protection could find no support in Clause 8 since its power extended only to “writings of authors”—those “such as are *original*, and are founded in the creative powers of the mind.”¹⁶⁹

159 499 U.S. 340, 346 (1991) (“Originality is a constitutional requirement.”).

160 This constitutional mandate is incorporated into the current Copyright Act, which permits protection only for “original works of authorship.” 17 U.S.C. § 102(a) (2000).

161 *Feist*, 499 U.S. at 345.

162 100 U.S. 82 (1879).

163 111 U.S. 53 (1884).

164 *Feist*, 499 U.S. at 346.

165 *Id.* at 346–47.

166 *See Trade-Mark Cases*, 100 U.S. at 82; *Burrow-Giles*, 111 U.S. at 53

167 *See supra* note 95.

168 *Trade-Mark Cases*, 100 U.S. at 94.

169 *Id.*

Justice Miller drew a distinction between the class of all writings and the subset of writings of authors. The first refers to those works sufficiently tangible to be eligible for copyright protection. The second refers to those writings that, in addition to being reduced to physical form, exhibit originality. Not all writings are constitutionally eligible for copyright protection. Instead, “[t]he writings which are to be protected are *the fruits of intellectual labor*.”¹⁷⁰ As the Court’s distinction suggests, a work may be written but not original. Protectable works are not simply writings, but the writings of authors. The term “Authors,” according to the Court, demands originality.

In *Burrow-Giles*, Justice Miller relied on similar reasoning. There, the Court considered a claim of copyright infringement brought by the photographer of a portrait of Oscar Wilde.¹⁷¹ The alleged infringer argued that no copyright could subsist in the photograph since it was “not a writing of which the producer is the author.”¹⁷² The Court rejected this contention, first recognizing that the photographs fell within the broad scope of the term “Writings.”¹⁷³ Since photographs qualify as writings, they are protectable “so far as they are representatives of original intellectual conceptions of the author.”¹⁷⁴ Once again, the implicit distinction between “Writings” and “writings of authors” is at work. The Court admitted the possibility that some photographs, despite satisfying the writings requirement, may lack originality.¹⁷⁵ Only writings that clear the additional hurdle of originality merit protection.¹⁷⁶

The term “Authors” imposes two very different constraints on Congress’s Clause 8 authority. It requires that Congress grant exclusive rights in expression only to authors, and it insists that works subject to those exclusive rights be original.

170 *Id.*

171 *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 54 (1884).

172 *Id.* at 56.

173 *Id.* at 58.

174 *Id.*

175 *Id.* at 59.

176 *Id.* at 59. Given the photographer’s creative contributions, the Court was satisfied that the Wilde portrait was “the product of plaintiff’s intellectual invention, of which plaintiff is the author.” *Id.* at 60. Those contributions included “posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression” *Id.*

4. "Writings"

Although the term "Writings" does not serve as the source of the originality requirement, it does impose an additional limit on Congress's Clause 8 authority. It guarantees that the exclusive rights granted to authors apply only to works embodied in some tangible form of expression, rather than extending to fleeting and ephemeral performances and utterances.

Read literally, "Writings" likely refers only to the "literary productions of . . . authors."¹⁷⁷ But both Congress and the courts have traditionally adopted a flexible and expansive understanding of "Writings." The 1790 Act protected maps and charts, in addition to books.¹⁷⁸ Subsequent legislation significantly expanded the scope of writings to include prints,¹⁷⁹ musical¹⁸⁰ and dramatic compositions,¹⁸¹ photographs,¹⁸² paintings,¹⁸³ drawings,¹⁸⁴ sculptures,¹⁸⁵ motion pictures,¹⁸⁶ and sound recordings.¹⁸⁷

This expansion was enabled by a definition of "Writings" that offered the generality and adaptability necessary to accommodate technological advances. That definition, first provided by the Court in *Burrow-Giles*, embraced "all forms of writing, printing, engraving, etching, etc., by which the ideas in the mind of the author are given visible expression."¹⁸⁸ Nearly a century later, the Court adopted a similar reading in *Goldstein v. California*, explaining that "the word 'writings' . . . may be interpreted to include any physical rendering of the fruits of creative intellectual or aesthetic labor."¹⁸⁹

Despite the flexibility of these definitions, the Court has maintained at least one unyielding limit on the outer boundary of "Writings" protectable under Clause 8. Copyright has not and cannot extend to those works that have not been reduced to some tangible

177 *Id.* at 58.

178 Act of May 31, 1790, ch. 15, 1 Stat. 124.

179 Act of Apr. 29, 1802, ch. 26, 2 Stat. 171.

180 Act of Feb. 3, 1831, ch. 16, 4 Stat. 436.

181 Act of Aug. 18, 1856, ch. 169, 11 Stat. 138.

182 Act of Mar. 3, 1865, ch. 126, 13 Stat. 540.

183 Act of July 8, 1870, ch. 230 § 86, 16 Stat. 198, 212.

184 *Id.*

185 *Id.*

186 Act of Aug. 24, 1912, ch. 356, 37 Stat. 488.

187 Act of Oct. 15, 1971, Pub. L. No. 92-140, 85 Stat. 391.

188 *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

189 412 U.S. 546, 561 (1973).

physical representation.¹⁹⁰ Congress has never protected such works under copyright law¹⁹¹ and explicitly acknowledged this limit in 1954 when it refused to submit to the Berne Convention.¹⁹² According to the Senate Committee on Foreign Relations, it was “impossible to subscribe to the Convention” because it required “protection of ‘oral’ works, such as speeches [that] would have conflicted with Article I, Section 8”¹⁹³ Indeed, the United States agreed to join the Berne Convention only after a revision allowed member countries to deny protection to works not fixed in a tangible medium.¹⁹⁴

“Writings,” like each of the limits above, constrains Congress’s power to enact legislation pursuant to Article I, Section 8, Clause 8. But the question of whether those limits should be interpreted to limit Congress’s authority under other enumerated powers remains.

B. External Application of Clause 8 Limits

In order to determine whether the limits of the copyright authority of Clause 8 restrain Congress’s other legislative powers, we first need to identify the core subject matter of that authority. If, prior to Commerce Clause expansion, another enumerated power enabled Congress to legislate with regard to that subject matter in a manner inconsistent with Clause 8 limits, those limits function merely descriptively. If, on the other hand, no other enumerated powers permitted Congress to reach the subject matter of Clause 8’s copyright authority, those limits externally constrain Congress regardless of the power it attempts to use.

While identifying the subject matter of other enumerated powers, like the Bankruptcy Clause, is a fairly straightforward task, Clause 8 presents a more difficult case, in part because of its unique structure.

190 In the current Copyright Act, this limit is expressed by the fixation requirement, which demands “embodiment in a copy or phonorecord, by or under the authority of the author, . . . sufficiently permanent or stable to permit [the work] to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” 17 U.S.C. § 101 (2000).

191 Though unconstitutional for conferring on unwritten performances exclusive rights that are functionally equivalent to copyrights, the federal anti-bootlegging statutes, discussed at length in *infra* Part IV.C., did not attempt to protect those works through copyright proper.

192 Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, *as revised* at Paris on July 24, 1971, and amended on Sept. 28, 1979, S. TREATY DOC. NO. 99-27, 1161 U.N.T.S. 3 [hereinafter Berne Convention].

193 S. EXEC. DOC. NO. 5 (1954).

194 *See* Berne Convention, *supra* note 193, art. 2(2). The United States entered into the Berne Convention on March 1, 1989. *Id.*

The power conferred by Clause 8 could be situated in either its ends clause or its means clause. The location of Clause 8 power, and, by extension, the definition of the core subject matter of Clause 8's copyright authority could prove determinative of the question of external application of Clause 8 limits.

If Clause 8 is characterized as the power to “promote the Progress of Science,” one could argue that the limits of Clause 8 are not properly externalized. Even before the modern Commerce Clause emerged, Congress could encourage “Science” through a variety of means. For example, legislation enacted in 1798 permitted the appointment of four “teachers of the arts and sciences” for military instruction.¹⁹⁵ And just a few years later, Congress enacted legislation enabling the President to establish the United States Military Academy at West Point.¹⁹⁶ Likewise, Congress promoted the progress of science with the Morrill Act of 1862,¹⁹⁷ which provided states with federal land to establish colleges and universities.¹⁹⁸ The Morrill Act confronted constitutional challenges during congressional debate.¹⁹⁹ Some argued that Clause 8, by defining the exclusive means of promoting the progress of science, precluded the passage of the Act.²⁰⁰ But in the end, the Morrill Act was successfully justified on the basis of Congress's power to dispose of federal land.²⁰¹ If the core power of Clause 8 is the promotion of progress and alternative means of progress promotion were within Congress's legislative authority, the limits of Clause 8 cannot externally restrain Congress.

But there is good reason to doubt a reading that situates the power of Clause 8 exclusively in the ends clause. Such a reading fails to account for the functional authority Congress was granted and has exercised under Clause 8. Each enumerated power enables Congress to take some concrete legislative action—to regulate commerce, to raise an army, to coin money. However, in isolation, the power to

195 Sidney Forman, *Why the United States Military Academy Was Established in 1802*, 29 MIL. AFFS. 16, 22 (1965).

196 7 ANNALS OF CONG. 1312, § 27 (1802); accord Act of Mar. 16, 1802, ch. 9, § 27, 2 Stat. 132, 137.

197 Act of July 2, 1862, ch. 130, 12 Stat. 503; see also Act of Aug. 30, 1890, ch. 841, 26 Stat. 417.

198 Notably, the Framers rejected a direct federal power to establish universities. See Olliar, *supra* note 1, at 1792.

199 See generally John H. Florer, *Major Issues in the Congressional Debate of the Morrill Act of 1862*, 8 HIST. OF EDUC. Q. 459 (1968).

200 See *id.* at 463.

201 See U.S. CONST. art. IV, § 3, cl. 2 (“The Congress shall have Power to dispose of and make all needful Rules and Regulations respecting the Territory or other Property belonging to the United States . . .”).

“promote the Progress” supplies Congress with an amorphous goal, but no explicit power by which to achieve it. In order to exercise its Clause 8 power, Congress must confer exclusive rights utilizing the means clause. The goal of the Framers, after all, was to enable regimes roughly analogous to our patent and copyright systems, subject to the limitations of Clause 8.²⁰² A reading that characterizes the subject matter of Clause 8 as the promotion of progress, rather than the granting of exclusive rights, therefore, disregards its practical application.

If the power granted by Clause 8 is situated in the means clause, the copyright power—stripped of its limits—authorizes Congress to grant exclusive rights in expression. Under this reading, if another enumerated power, prior to the expansion of the Commerce Clause, permitted Congress to grant exclusive rights in expression in a manner inconsistent with a Clause 8 limit, that limit would serve a purely internal and descriptive function. But to the extent granting exclusive rights in expression was the sole domain of Clause 8, its limits are enforceable against the remainder of Congress’s enumerated powers.

Prior to the emergence of the modern Commerce Clause, no enumerated power, other than Clause 8, vested Congress with authority to confer exclusive rights in expression. Indeed, no other enumerated powers countenanced federal grants of monopoly rights in any subject matter. Needless to say, if no other legislative authority reached the core subject matter of Clause 8—the granting of exclusive rights in expression—Congress lacked the power to create such rights in a manner inconsistent with the limits of Clause 8. As such, the limits of Clause 8 apply even when Congress acts in the name of commerce.

Some have argued that preferential taxes enacted by Congress in the early twentieth century functioned as exclusive rights because they hampered competition and increased prices.²⁰³ The Motor Carrier Act of 1935,²⁰⁴ for example, suppressed the nascent trucking industry in favor of the incumbent railroads. Likewise, taxes on oleomargarine advantaged the dairy industry by increasing the costs of butter substitutes.²⁰⁵ By limiting inter-industry competition, the ar-

202 See *Graham v. John Deere Co.*, 383 U.S. 1, 5–6 (1966); Olliar, *supra* note 1, at 1816–17.

203 Nachbar, *supra* note 48, at 353–54.

204 Motor Carrier Act, 1935, ch. 498, 49 Stat. 543.

205 See Act of May 9, 1902, ch. 784, § 2, 32 Stat. 193; see also *McCray v. United States*, 195 U.S. 27 (1904) (discussing the tax on oleomargarine and its implications).

gument goes, these taxes imposed public costs similar to an exclusive rights regime.

But even if some of the economic consequences were similar, these preferential taxes were neither rights nor exclusive. First, these taxes conferred no rights. Instead, they increased the cost of doing business for disfavored industries by direct taxation. Neither the railroad industry nor the dairy industry received a legally enforceable right against their competitors or the public as a result of these taxes. Whatever benefit they indirectly received inured to the favored industry as a whole, rather than any single person or entity. Nor did that benefit permit the favored industries to exclude new competitors within the untaxed industry. A tax that applies to an entire industry and confers no right to exclude is plainly not equivalent to an exclusive right.²⁰⁶

Even assuming other enumerated powers could be construed to enable grants of exclusive rights, none address the granting of such rights in expression—the core subject matter of the copyright power. Because no enumerated powers offered Congress authority that was inconsistent with the limits of Clause 8, those limits apply externally to constrain any congressional action that attempts to invade the subject matter of Clause 8. Part IV addresses legislation, both enacted and proposed, that attempts to regulate the subject matter of Clause 8 in a manner inconsistent with its limits.

IV. ENFORCING CLAUSE 8 LIMITS

If Clause 8 limits apply externally, Congress faces two broad classes of constraints when it seeks to grant exclusive rights in expression. First, Congress must respect limits on the sorts of rights it con-

²⁰⁶ Although not a tax, the Manufacturing Clause of the Copyright Act, 17 U.S.C. § 601 (2000), functioned in much the same way. Prior to 1986, § 601 prohibited the importation of “nondramatic literary material that is in the English language . . . unless . . . such material . . . [was] manufactured in the United States or Canada.” *Id.* § 601(a) In *Author’s League of America, Inc. v. Oman*, the Second Circuit rejected a constitutional challenge to the Manufacturing Clause. 790 F.2d 220 (2d Cir. 1986). The court held that the statute, regardless of whether it promoted the progress of science, was justified under the Commerce Clause. The *Author’s League* court implicitly recognized that the Manufacturing Clause was beyond the scope of Clause 8 subject matter. Section 601 did not grant exclusive rights in expression. Instead, it regulated the importation of goods manufactured abroad on an industry-wide basis. Both the court and Congress understood that the Manufacturing Clause “protect[ed] . . . the domestic printing industry.” *Id.* at 224. It granted no exclusive rights to particular copyright holders. Much like the preferential taxes, § 601 effected a regulation, not an exclusive rights regime. Despite its codification in Title 17, the Manufacturing Clause was a commerce regulation from the outset.

fers; those rights must promote progress, expire in time, and vest in authors. Second, Congress must adhere to limits on the types of works protected by exclusive rights; those works must be both original and written. Taken together, these limits contribute to a constitutionally grounded public domain.

This Part applies both of these classes of Clause 8 limits to analyze the constitutionality of existing and proposed legislation. After considering each class of limits in turn, this Part returns to the question that motivated this discussion of inter-clause conflict—the constitutionality of the federal anti-bootlegging statutes. After analyzing those statutes through the lens of external Clause 8 limits, this Part concludes by evaluating the Second Circuit’s effort to resolve this inter-clause conflict in *Martignon*.

A. *Limits on the Scope and Character of Exclusive Rights*

Three Clause 8 limits restrain the nature of the exclusive rights Congress may grant. Exclusive rights in expressive works must offer protection for only limited times, and that protection must be granted to authors. In addition, Congress has an independent obligation to ensure that grants of exclusive rights in expression “promote the Progress of Science.” Legislation that fails to conform to these limits, regardless of the power under which Congress claims to be acting, exceeds its constitutional authority.

The requirement that exclusive rights in expression promote the progress of science poses the greatest practical difficulty in enforcement. Again, the dominant reading interprets this text as a preamble with no binding effect. But even if courts reject this view in favor of the more supportable position that “promote the Progress” functions as a genuine limit on congressional authority,²⁰⁷ the precise contours of its mandate are not self-evident. Determining whether legislation promotes the advancement of learning requires a forward-looking analysis of an act’s likely effects that is inherently speculative. Perhaps in recognition of the rather indeterminate nature of the command to “promote the Progress,” courts—even those that accept that “promote the Progress” functions as a limit²⁰⁸—have typically yielded to congressional judgment on the question of furthering the constitu-

²⁰⁷ See Oliar, *supra* note 1, at 1810–15.

²⁰⁸ See, e.g., *Figueroa v. United States*, 66 Fed. Cl. 139, 150 (2005) (applying rational basis test to determine whether congressional diversion of patent fees for non-patent purposes was a valid measure aimed to “promote the Progress”).

tional goals of Clause 8.²⁰⁹ As a result, no clear metric for evaluating the promotion of progress has emerged.²¹⁰ Given the inherent imprecision of the inquiry and the Court's resulting deference, robust enforcement of this limit is unlikely. However, this limit could prove important in precluding Congress from indulging its more extreme impulses.

Unlike "promote the Progress," the limited times requirement has a clearly defined outer boundary. As the Court acknowledged in *Eldred*, if the limited times requirement is to have any meaning, it must at the very least prevent Congress from enacting a perpetual term of copyright protection.²¹¹ This limited term of protection is meant to ensure that copyrighted works eventually enter the public domain, where they can be freely copied, distributed, and adapted.²¹² But if "limited" simply means "not infinite," the Constitution may not impose any practical limit on the term of copyright protection. A life plus 10,000-year copyright term, while not perpetual, would imperil rather than secure the public domain. A reading of Clause 8 that permitted a term of such length would render "limited Times" nearly as meaningless as an interpretation that ignored it altogether.

209 See *Eldred v. Ashcroft*, 537 U.S. 186, 212 (2003) ("[I]t is generally for Congress, not the courts, to decide how best to pursue the Copyright Clause's objectives."); *Stewart v. Abend*, 495 U.S. 207, 230 (1990) ("Th[e] evolution of the duration of copyright protection tellingly illustrates the difficulties Congress faces . . . [I]t is not our role to alter the delicate balance Congress has labored to achieve."); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) ("[I]t is Congress that has been assigned the task of defining the scope of the limited monopoly that should be granted to authors . . . in order to give the public appropriate access to their work product."); *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966) ("Within the limits of the constitutional grant, the Congress may, of course, implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim.").

Some early cases held that immoral or obscene works could not be protected under copyright on the basis that such works did not promote progress. See generally, e.g., *Barnes v. Miner*, 122 F. 480 (S.D.N.Y. 1903); *Martinetti v. Maguire*, 16 F. Cas. 920 (C.C.D. Cal. 1867). Although subsequent courts have not followed this practice, see *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 860 (5th Cir. 1979) (refusing to deny copyright protection to material on the basis of alleged obscenity), these early cases suggest that courts can define and enforce limits on the basis of "promote the Progress."

210 Professor Oliar has suggested as a starting point criterion that deems legislation unconstitutional if "its marginal benefits, in terms of creativity and knowledge, are extremely outweighed by its marginal costs in terms of creativity and knowledge." Oliar, *supra* note 1, at 1840.

211 537 U.S. at 241 (Stevens, J., dissenting) ("The express grant of a perpetual copyright would unquestionably violate the textual requirement that the authors' exclusive rights be only 'for limited Times.'").

212 See *Zimmerman*, *supra* note 6, at 374.

But even accepting *Eldred's* anemic reading of "limited times," this requirement still places some meaningful constraints on Congress. External application of the durational limit means that Congress, by announcing its reliance on the Commerce Clause or by phrasing legislation in a manner suggestive of a commercial regulation, cannot avoid adherence to the limited times requirement. As even the staunchest supporters of term extension have realized, the limited times requirement imposes a limit that is not so easily circumvented.²¹³ Although it would appear that Congress could easily comply with the requirement that exclusive rights in expression last for some period short of eternity, as discussed *infra*, existing federal statutes fail to satisfy even that forgiving standard.²¹⁴

In addition to containing a durational limit, exclusive rights granted by Congress in expressive works must be granted to the authors of those works. Whether Congress seeks to amend the Copyright Act, regulate commerce, or create *sui generis* intellectual property protection, only authors are appropriate recipients of exclusive rights in expression.

Of course, Clause 8 permits exclusive rights to fall into the hands of non-authors after they vest. Authors remain free to transfer their rights to non-authors,²¹⁵ and prior copyright acts allowed parties other than authors to renew existing copyrights in the event of the author's death.²¹⁶ In both of these instances, however, authors are the initial recipients of exclusive rights. Under the current Act, copyrights can

213 Congresswoman Mary Bono stated, with reference to her late husband, Rep. Sonny Bono: Sonny wanted the term of copyright protection to last forever. I am informed by staff that such a change would violate the Constitution. . . . As you know, there is also Jack Valenti's proposal for term to last forever less one day. Perhaps the Committee may look at that next Congress.

144 CONG. REC. H9952 (daily ed. Oct. 7, 1998) (statement of Rep. Bono).

214 See *infra* Part IV.C.

215 See 17 U.S.C. § 201(d) (2000).

216 Under all pre-1976 U.S. copyright acts, at the expiration of the original copyright term, the copyright holder could renew the copyright. See R. Anthony Reese, *Is the Public Domain Permanent?: Congress's Power To Grant Exclusive Rights in Unpublished Public Domain Works*, 30 COLUM. J.L. & ARTS 531, 558 (2007). As early as 1831, if the original copyright holder was deceased, the author's spouse or children could exercise the renewal option. See Act of Feb. 3, 1831, ch. 16, § 2, 4 Stat. 436; Act of July 8, 1870, ch. 230, § 34, 16 Stat. 198, 202. Subsequent acts permitted renewal by the beneficiaries of the author's estate. The 1909 Act provided that if the author left no surviving spouse or child, the renewal term could vest in the author's executor or next of kin. See Copyright Act of 1909, Act of Mar. 4, 1909, ch. 320, § 23, 35 Stat. 1075, 1080. This same rule applied to works published before 1978 under the 1976 Act. See 17 U.S.C. § 304(a) (2000).

be transferred, but initially vest in the author.²¹⁷ And renewal terms granted to spouses and executors under pre-1976 regimes were contingent on the initial copyright grants to authors and functioned as extensions of those preexisting rights.²¹⁸

The work-made-for-hire doctrine may likewise raise questions related to the vesting of copyrights in non-authors. Copyright interests in works made for hire may vest in individuals and corporations who fall outside of our intuitive and perhaps romantic notions of authorship. But copyright law recognizes that the term “author” should not be rigidly interpreted so as to exclude those who commission or direct the creation of works of expression made for hire, since they can reasonably be considered the originator of those works. An author, whether an individual or a corporation, need not lay pen to paper to create a work. One who oversees and directs the creation of a work can claim responsibility for its creation and can serve as its author.²¹⁹

But if the term “author” is to remain meaningful, it must contain some limits. Two grants of exclusive rights, one already implemented in the European Union and another under discussion at the World Intellectual Property Organization (“WIPO”), provide examples of exclusive rights that likely cannot be squared with the Constitution’s insistence that exclusive rights in expression extend only to the originators or creators of that expression.

The 1993 European Union Copyright Directive (“Directive”) provides for the granting of exclusive rights to the publishers of previously unpublished public domain works.²²⁰ Under legislation em-

217 See 17 U.S.C. § 201 (2000). Perhaps more problematically, the original copyright term did not always vest in the author herself, but could instead initially vest in the author’s assignee. Under pre-1976 regimes, an author could transfer her interest in a work after its creation, but prior to its publication. Even when an assignee obtained the original copyright, the initial grant depended upon a right that originated with the author and was exercised only by one who stood in the author’s shoes as a result of the author’s decision to transfer that right.

218 That extension, however, was unburdened by the assignments and licenses granted during the original term, leading some courts to refer to the renewal term as a “new estate.” Reese, *supra* note 217, at 558; see also *G. Ricordi & Co. v. Paramount Pictures, Inc.*, 189 F.2d 469, 471 (2d Cir. 1951) (“A copyright renewal creates a new estate, and the few cases which have dealt with the subject assert that the new estate is clear of all rights, interests or licenses granted under the original copyright.”). Nonetheless, a preexisting grant of rights to the author was a necessary condition for the existence of the renewal term.

219 See 17 U.S.C. § 101 (2000) (defining “work made for hire”).

220 Council Directive 93/98, art. 4, 1919 O.J. (L 290) 9, 11 (EC) (“Any person who, after the expiry of copyright protection, for the first time lawfully publishes or lawfully communicates to the public a previously unpublished work, shall benefit from a protection equivalent to the economic rights of the author. The term of protection of such rights shall be

bodily the Directive, the first publisher to make a previously unpublished public domain work available receives exclusive rights in that work for twenty-five years.²²¹ Assuming Congress sought to enact similar legislation, it would be barred by the limits of Clause 8.

Unlike a corporation that directs the creation of a work made for hire, a publisher who merely prints and distributes a long-extant unpublished work is not the creator or originator of that work.²²² The EU publication right confers a right equivalent to a copyright on a party with no necessary connection to the author, aside from possession of a manuscript. Whereas copyright renewals were granted to the author's spouse or executor, the publication rights envisioned by the Directive provide exclusive rights to rank strangers from the author's perspective. While transfers and renewals under prior U.S. law can be read as consistent with the Constitution's call for copyrights granted to authors, the copyright grave robbing permitted under the EU Directive cannot be squared with our Constitution.

The most recent draft of the WIPO Treaty on the Protection of Broadcasting Organizations ("Broadcast Treaty") offers another example of potential legislation that, if adopted by Congress, would likely violate the limits of Clause 8.²²³ The Broadcast Treaty would extend to broadcasters and cablecasters a host of exclusive rights in their transmissions—rights of fixation, reproduction, distribution, retransmission, and communication to the public.²²⁴ Although broadcasters originate the signal that carries the content they transmit, they are often not its authors. But these rights are granted to broadcasters

25 years from the time when the work was first lawfully published or lawfully communicated to the public.”).

221 See, e.g., Copyright and Related Rights Regulations, 1996, S.I. 1996/2967, pt. II, ¶ 16(6) (U.K.) (granting a “publication right” for a twenty-five year duration to first publishers under United Kingdom law).

222 Indeed, since the Framers were likely influenced by the Statute of Anne in crafting the contours of copyright in the United States, and the Statute of Anne was itself a rejection of the Stationers' monopoly, reading “Authors” to include the publishers of existing unpublished works appears particularly inappropriate. See Heald & Sherry, *supra* note 6 at 1144-45 (noting the likely influence of the Statute of Anne and the Stationers' Monopoly on the Framers).

223 For a discussion of other ways in which the Broadcast Treaty may violate the Constitution, see generally Adam R. Tarosky, *The Constitutionality of WIPO's Broadcasting Treaty: The Originality and Limited Times Requirements of the Copyright Clause*, 2006 DUKE L. & TECH. REV. 16.

224 See generally World Intellectual Property Organization, Standing Committee on Copyright and Related Rights, *Revised Draft Basic Proposal for the WIPO Treaty on the Protection of Broadcasting Organizations*, SCCR/15/2 (July 31, 2006), http://www.wipo.int/edocs/mdocs/sccr/en/sccr_15/sccr_15_2.pdf.

regardless of their roles in creating the transmitted content,²²⁵ permitting exclusive rights in material created by others and, in some cases, not even protected by copyright.²²⁶ As a result, legislation creating the rights envisioned by the Broadcast Treaty²²⁷ would extend exclusive rights in expression to non-authors in violation of the limits of Clause 8.²²⁸

Clause 8 imposes three different restrictions on the rights Congress can grant in expression. Those limits restrain the purpose and effect of exclusive rights, the duration of those rights, and to whom they can be extended. The next Section describes how Clause 8 limits restrict the class of works that can be subject to such grants of exclusive rights.

225 Broadcasters could argue that the licensed transmission of television programming interspersed with advertisements results in an independently copyrightable compilation or derivative work entitling them to protection. But to the extent that such a work was both fixed and original, it would require no new legislation and would be protected by existing copyright law in the United States.

226 See, e.g., ELECTRONIC FRONTIER FOUNDATION, BRIEFING PAPER ON THE PROPOSED WIPO BROADCASTING TREATY 2 (June 18, 2007), http://www.eff.org/files/filenode/broadcasting_treaty/EFF_wipo_briefing_paper_062007.pdf (noting the potential impact of the Broadcast Treaty on public domain works).

227 The treaty power offers another potential alternative source of authority for the regulation of exclusive rights in expressive works in a manner inconsistent within the limits of Clause 8. See generally Graeme B. Dinwoodie, *Copyright Lawmaking Authority: An (Inter) Nationalist Perspective on the Treaty Clause*, 30 COLUM. J.L. & ARTS 355 (2007). Some argue that the treaty power is unrestrained by the limits of Clause 8. See Caroline T. Nguyen, Note, *Expansive Copyright Protection for All Time? Avoiding Article I Horizontal Limitations Through the Treaty Power*, 106 COLUM. L. REV. 1079 (2006). A full treatment of potential conflicts with the treaty power is beyond the scope of this Article. But it is worth noting that the limits of Clause 8 are equally superfluous whether they are ignored under the Commerce Clause or the treaty power. See *Reid v. Covert*, 354 U.S. 1, 16 (1957) (Black, J., plurality opinion) (“[N]o agreement with a foreign nation can confer power on the Congress, or on any other branch of Government, which is free from the restraints of the Constitution.”).

228 Under current U.S. law, a broadcaster who is licensed to transmit a copyrighted work may file a copyright infringement suit against a cable or satellite provider that rebroadcasts that work without paying the statutory license for such a rebroadcast. See 17 U.S.C. § 111(b) (2000) (detailing the situations under which secondary transmissions may be actionable as infringement under 17 U.S.C. § 501); see also *id.* § 501(c) (allowing broadcast stations to be treated as beneficial owners, even when a cable system rebroadcasts a particular work in the same local service area). Unlike under the Broadcast Treaty, the right at issue, while asserted by the licensee, is a copyright granted to the author. These provisions do not enlarge the scope of the copyright grant, but merely permit the broadcaster to stand in the shoes of the copyright holder as a procedural matter.

B. *Limits on Protectable Works*

The limits of Clause 8 deny Congress the power to grant exclusive rights in two types of expressive works: those that are unoriginal and those that are unwritten. These two classes of works are not only unprotectable under the Copyright Act and any revisions to it, but they are also beyond the scope of any other grant of legislative authority. Only expressive works that are both original and written are the proper subjects of federal grants of exclusive rights. Taken together, the originality and writings requirements establish a class of works that lies outside the positive authority of Clause 8, but within its exclusive domain and thus beyond the reach of other enumerated powers.

Originality, the central limit on the scope of copyrightable subject matter, has been described as the “*sine qua non*” of the copyright grant,²²⁹ the “premise of copyright law,”²³⁰ and “the core question of copyrightability.”²³¹ As the Court has recognized, although the thresholds for originality under both the Constitution and the Copyright Act are minimal, those works that fail to satisfy it are ineligible for protection.²³²

After *Feist* rejected the notion that unoriginal compilations of data are within the scope of the copyright power, legislators have repeatedly sought to provide protection for such works through other means.²³³ Proponents of such legislation appear to believe that by re-

229 *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

230 *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1368 (5th Cir. 1981).

231 *Eldred v. Ashcroft*, 537 U.S. 186, 211 (2003).

232 *See, e.g., Feist*, 499 U.S. at 345.

233 *See, e.g.*, H.R. 3872, 108th Cong. (2d Sess. 2003) (prohibiting the misappropriation of databases); H.R. 3261, 108th Cong. (2d Sess. 2003) (prohibiting the misappropriation of certain databases); H.R. 1858, 106th Cong. (1st Sess. 1999) (prohibiting the distribution of database duplicates); H.R. 354, 106th Cong. (1st Sess. 1999) (prohibiting the misappropriation of collections of information); S. 2291, 105th Cong. (2d Sess. 1998) (same). These efforts have faced sustained criticism. *See generally* Benkler, *supra* note 1; Heald & Sherry, *supra* note 6, at 1176–79 (analyzing the constitutionality of regulating exchanges of information); Patry, *supra* note 6 at 394–97 (criticizing the Collections of Information Antipiracy Act); Memorandum from William M. Treanor, U.S. Deputy Assistant Attorney General, Office of Legal Counsel, U.S. Dept. of Justice, to the Associate White House Counsel, *Constitutional Concerns Raised by the Collections of Information Antipiracy Act* (July 28, 1998), available at <http://www.usdoj.gov/olc/righto.htm> (noting that legislation granting exclusive rights to unoriginal data “would impermissibly infringe on an implicit limitation contained in the Intellectual Property Clause”). For other commentary on the relationship between constitutional interpretation of Congress’s enumerated powers and intellectual property legislation, see generally Paul Bender, *The Constitutionality of Proposed Federal Database Protection Legislation*, 28 U. DAYTON L. REV. 143 (2002), Jane C. Ginsburg, *No “Sweat”? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*,

fusing to extend copyright protection to unoriginal works *Feist* removed those works from the domain of Clause 8 entirely, leaving them free to be regulated under the less restrictive authority of the Commerce Clause. But far from freeing Congress from the constraints of the copyright power, the Court's holding in *Feist*—coupled with the understanding of Clause 8 limits as external constraints on congressional authority generally—dictates that unoriginal compilations of data are simply not the proper subject of federal grants of exclusive rights.²³⁴ The Constitution mandates that, regardless of the will of Congress, unoriginal expressive works are permanently and inescapably within the public domain.²³⁵

92 COLUM. L. REV. 338 (1992), and Justin Hughes, *How Extra-Copyright Protection of Databases Can Be Constitutional*, 28 U. DAYTON L. REV. 159 (2002).

234 As a consequence of the public's "negative right" to use unoriginal works, Professor Patry likewise concludes that Congress may not, through the exercise of the commerce power, grant exclusive rights in unoriginal compilations of data. See Patry, *supra* note 6, at 394–97. This conclusion is justified, as far as it goes. But while Patry's negative right preserves the originality requirement in the face of the expanded commerce power, it fails to do the same for the writings requirement.

235 Trademark protection, which the Court rejected as an improper exercise of Clause 8 authority, finds justification in Congress's commerce power. See generally Trade-Mark Cases, 100 U.S. 82 (1879) (invalidating statutes which authorized the indictment of persons who counterfeited trademarked material). Although the Lanham Act extends protection to marks regardless of their originality, the constitutionality of its prohibitions against infringement, false designation, and false description is not in doubt. See 15 U.S.C. §§ 1114 & 1125(a) (2000). Traditional trademark protection functions to identify the source or origin of products in the marketplace in order to enable consumers to make informed decisions. As the Court has recognized, trademark law is concerned with identifying the source of a physical product, not the author of any expressive content that product might contain. See, e.g., *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 32 (2003) ("[A]s used in the Lanham Act, the phrase 'origin of goods' is in our view incapable of connoting the person or entity that originated the ideas or communications that 'goods' embody or contain."). In order to avoid conflicts with the exclusive subject matter of copyright law, the Court has recognized that trademark protection cannot extend to the communicative or expressive aspects of goods and services. See *id.* at 33; see also Christopher Sprigman, *Indirect Enforcement of the Intellectual Property Clause*, 30 COLUM. J.L. & ARTS 565, 585 (2007) (characterizing *Dastar* as an indirect external application of Clause 8 limits). Although a trademark can identify the manufacturer of a videotape, the mark does not necessarily indicate the author of the "intellectual content that it conveys." *Dastar*, 539 U.S. at 33. For the purposes of trademark law, a mark functions as an indicator of source, even if the mark itself is separately eligible for copyright or patent protection. Because the communicative aspects of works remain within the sole province of Clause 8, federal trademark law can be regulated under the Commerce Clause. Although beyond the scope of this Article, trademark dilution, because it grants exclusive rights in unoriginal works not tethered to source indication, raises more difficult constitutional questions. See 15 U.S.C. § 1125(c) (2000) (providing remedies for dilution of famous marks in the absence of consumer confusion, false designation, or false description).

Just as unprotectable unoriginal works are within Clause 8's exclusive zone of control, unwritten works also fall within the ambit of Clause 8 but outside of its positive authority. Because Congress is permitted to grant exclusive rights only in writings,²³⁶ unwritten expressive works fall into a no-man's land of federal grants of exclusive rights; they cannot receive protection pursuant to Clause 8, but are simultaneously beyond the reach of other enumerated powers.²³⁷

An unwritten work of expression is not so fundamentally divorced from the subject matter of Clause 8 to justify immunity from its limits. Unwritten works are no farther from the core concerns of the copyright power than unoriginal compilations of data. Indeed, to the extent unwritten works exhibit originality, the key characteristic of copyrightability, they are closer to copyright's central concerns. Both originality and writings are limits on the positive authority granted to Congress under Clause 8 and can lay equal claim to external application. If the basis for external application of these limits is the risk of superfluity, there is no reason to treat one as an enforceable limit on congressional power, while viewing Congress's violation of the other as permission to escape the restrictions imposed by Clause 8.

Admittedly, the policy rationale for denying Congress the ability to grant exclusive rights in unwritten works may not be as immediately apparent as the concerns that militate against protections for unoriginal compilations of data. Opposition to protection for data is rooted in the threat to the free flow of information posed by monopoly rights in facts.²³⁸ The harm that would flow from protection for unwritten works is perhaps less vividly imagined, in part because there have been fewer occasions to consider it.

Unwritten works could take at least two forms—ideas, on the one hand, and performances and utterances, on the other. The term “ideas,” in this context, does not refer to the abstractions or conceptual generalities referred to by the idea/expression distinction. In-

²³⁶ See *supra* Part III.A.4.

²³⁷ The limits of Clause 8 apply to limit the power of the federal government; they do not, on their own, preclude the states from enacting copyright-like protections against the unauthorized recording of live performances. More than twenty states provide such protection. See Keith V. Lee, *Resolving the Dissonant Constitutional Chords Inherent in the Federal Anti-Bootlegging Statute* in *United States v. Moghadam*, 7 VILL. SPORTS & ENT. L.J. 327, 332 n.29 (2000) (collecting statutes). States could likewise make use of the right of publicity to protect performers from unauthorized commercial exploitation of live performances. See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977) (holding that there was no constitutional bar to a state law requiring compensation to a performer for an unauthorized broadcast of his performance).

²³⁸ See Benkler, *supra* note 6, at 558–69.

stead, “ideas” here refers to an author’s internal, unvoiced, and unwritten conceptions. These ideas may be general in nature, or they may be so detailed that, if embodied in some tangible form, they would qualify as copyrightable expression. But even those creations lack the permanence necessary for copyright protection if they are not reduced to a tangible medium. Likewise, a performance or utterance, even if voiced publicly, fails to satisfy the writings requirement unless embodied in some nonfleeting form.

The refusal to extend copyright protection to these unwritten works serves two related functions. The first is evidentiary. By requiring that any work protected by copyright be committed to tangible form, the Constitution avoids problems of proof that would otherwise stymie enforcement efforts.²³⁹ If unwritten works were protected, “copyright law would forever be mired in disputes over the definition and boundaries of the works claiming copyright protection.”²⁴⁰ Every successful film or novel could face claims that it infringed upon exclusive rights in unwritten works, the precise content of which would be known only to few, if any, aside from their authors. These problems of proof and the resulting uncertainty could create unreasonable risks that would deter investment in creative works.

Second, the writings requirement helps to ensure that the copyright system remains faithful to its constitutional directive. Extending protection only to written works encourages authors to put their ideas on paper, where they can best be preserved, copied, and eventually disseminated to the public. To the extent the writings requirement ensures that expressive works are captured in lasting reproducible forms, that requirement furthers the goals of enriching the public domain and promoting progress. Granting protection to unwritten works could undermine those aims. With lessened incentives to fix their works, some authors may deny posterity their value.²⁴¹

Relatedly, grants of exclusive rights in unwritten works could interfere with public discussion and the exchange of information. If

²³⁹ See Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L.J. 683, 730–34 (2003) (discussing the fixation requirement as a rule of evidence).

²⁴⁰ Gregory S. Donat, Note, *Fixing Fixation: A Copyright with Teeth for Improvisational Performers*, 97 COLUM. L. REV. 1363, 1400 (1997); see also Lichtman, *supra* note 240, at 730–34; Russ VerSteeg, *Jurimetric Copyright: Future Shock for the Visual Arts*, 13 CARDOZO ARTS & ENT. L.J. 125, 132 (1994) (discussing the practical problems that the writings requirement addresses).

²⁴¹ See, e.g., Joseph C. Merschman, *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, 681 (2002) (noting that the fixation requirement is critical to the bargain between society and copyright holders).

copyright extended to unfixed expression, “every utterance” could be protected.²⁴² Retelling an anecdote overheard in the neighborhood bar or taking notes on a debate at city hall could give rise to claims of infringement. Copyright protection for unwritten works could transform every public statement or private conversation into a potentially protectable work. Without a written record of the particular expression at issue, the effect of such protection on public discourse could be dramatic.

The Framers, it seems, were justified in limiting the scope of copyrightable subject matter to original writings. Permitting Congress to draft legislation that grants exclusive rights in works of expression that fall within the penumbral public domain would give rise to outcomes antithetical to the stated purpose of Clause 8. Nonetheless, at least one existing piece of federal legislation grants exclusive rights in unwritten expression, and does so without a durational limit.

C. *The Unconstitutionality of the Anti-Bootlegging Statutes*

The civil anti-bootlegging statute, 17 U.S.C. § 1101, treats as a copyright infringer any person who “without the consent of the performer” fixes the sounds of a live musical performance or reproduces, transmits, distributes, sells, rents, or otherwise traffics in such a recording.²⁴³ Likewise, its counterpart, 18 U.S.C. § 2319A, imposes criminal sanctions of up to ten years of imprisonment on those who engage in that proscribed conduct “knowingly and for purposes of commercial advantage or private financial gain.”²⁴⁴

As a matter of policy, Congress’s wisdom in enacting these statutes is doubtful. Although they impose the penalties for copyright infringement, the anti-bootlegging statutes do not incorporate speech-protective defenses to infringement, including fair use.²⁴⁵ But more

²⁴² Falwell v. Penthouse Int’l, Ltd., 521 F. Supp. 1204, 1207 (W.D. Va. 1981) (rejecting a claim to common-law copyright protection for spoken expression); see also Wendy J. Gordon, *An Inquiry into the Merits of Copyright: The Challenges of Consistency, Consent, and Encouragement Theory*, 41 STAN. L. REV. 1343, 1382 (1989) (discussing the role of the fixation requirement in defining the bounds of the protected expression).

²⁴³ 17 U.S.C. § 1101(a) (2000). To refer to such recordings as “fixed” is incorrect. Under the definition of “fixed” provided by the Copyright Act, a work is fixed only if embodied in a tangible medium of expression “by or under the authority of the author.” *Id.* § 101. By definition, these recordings, even though sufficiently tangible, are not made with the authority of the author, unless of course, the recordist is considered the author. As that was clearly not the intention of Congress, the use of this term is mistaken.

²⁴⁴ 18 U.S.C. § 2319A(a) (2000).

²⁴⁵ The First Amendment presents an independent basis for finding the anti-bootlegging statutes unconstitutional. To the extent the statutes are copyright laws, they alter the tra-

fundamentally, these statutes violate the external limits of Clause 8 by conferring perpetual rights to unprotectable works.

In order for the anti-bootlegging statutes to fall within the exclusive scope of Clause 8, they must confer exclusive rights in expression. The subject matter regulated by these statutes, live musical performances and recordings thereof, can safely be assumed to be expressive. Indeed, most, if not all, would satisfy the originality requirement of Clause 8. But do the statutes confer exclusive rights?

This question is perhaps best answered by comparing the rights effectively created by the anti-bootlegging statutes to those granted by the Copyright Act. In part, § 106 confers to copyright holders exclusive rights to reproduce, distribute, sell, rent, and publicly perform their works.²⁴⁶ Under the copyright grant, only the copyright holder is permitted to engage in these activities or to authorize others to do so.²⁴⁷ One who undertakes any of these activities without the permission of the copyright holder, absent some applicable defense, is an infringer.

Liability under the anti-bootlegging statutes is likewise premised on taking action “without the consent of the performer.”²⁴⁸ Those actions—in addition to recording a live performance—include reproducing, distributing, selling, renting, and transmitting.²⁴⁹ By imposing civil and criminal liability on one who takes such action without the authorization of the performer, the anti-bootlegging statutes create exclusive rights remarkably similar to those granted by § 106.

ditional contours of copyright’s internal speech-protective safeguards, including fair use, and are subject to First Amendment scrutiny. *See* *Eldred v. Ashcroft*, 537 U.S. 186, 219–20 (2003) (“[T]he fair use of a copyrighted work . . . is not an infringement of copyright.” (quoting 17 U.S.C. §107 (2000) (first alteration in original)); *see also* *Golan v. Gonzales*, 501 F.3d 1179, 1182 (10th Cir. 2007) (remanding a challenge to § 514 of the URAA for analysis under the First Amendment). To the extent they are commerce legislation, the anti-bootlegging statutes are subject to traditional First Amendment analysis. As argued by amici in *Martignon*, the statutes are both overbroad and vague. *See* Brief for Twenty-Nine Intellectual Property and Constitutional Law Professors as Amici Curiae Supporting Defendant-Appellee at 24–30, *United States v. Martignon*, 492 F.3d 140 (2d Cir. 2007) (No. 04-5649) (asserting that 18 U.S.C. § 2319A merits heightened First Amendment scrutiny). In *Martignon*, the Second Circuit remanded the case to the district court to consider the First Amendment challenge. *See Martignon*, 492 F.3d at 153.

²⁴⁶ *See* 17 U.S.C. § 106 (2000).

²⁴⁷ *See id.* (granting “exclusive rights . . . to do and to authorize” various activities); *id.* § 501 (defining copyright infringement and remedies).

²⁴⁸ 17 U.S.C. § 1101(a) (2000) (defining unauthorized acts as occurring “without the consent of the performer or performers involved”); 18 U.S.C. § 2319A(a) (2000).

²⁴⁹ *See* 18 U.S.C. § 2319A(a) (2000); 17 U.S.C. § 1101(a) (2000).

If the anti-bootlegging statutes fall within the scope of Clause 8 by virtue of granting exclusive rights in expression, are the statutes proper exercises of Clause 8 authority or instead located within the penumbra defined by its limits? The first exclusive right granted to performers under the anti-bootlegging statutes is the right to record a live performance, or to authorize others to do so. The object of this right to initially record a performance—because it necessarily precedes the creation of the recording—is the live performance itself. But since these live performances are ephemeral, they cannot satisfy the writings requirement of Clause 8.

Courts and Congress have construed the term “Writings” liberally.²⁵⁰ In order to account for the inevitability of new methods of reducing the creativity of authors to tangible form, the Court has adopted a broad and flexible understanding of the term that embraces “any physical rendering of the fruits of creative intellectual . . . labor.”²⁵¹ But no court has broadened the definition of “Writings” to include works not embodied in some tangible form. And Congress has never extended the scope of copyrightable works to include unfixed ephemeral performances. Any reading of the term “Writings” that embraces live performances—as opposed to recordings of them—cannot be squared with precedent.²⁵² To do so would strip “Writings” of any meaning by eliminating its sole established limit. Since the live performances protected by the anti-bootlegging statutes are not writings, they cannot be the proper subject of federal grants of exclusive rights, and the exclusive right to record is unconstitutional.

Aside from conferring exclusive rights in unwritten live performances, the anti-bootlegging statutes also provide performers with perpetual exclusive rights over recordings of those performances—recordings that qualify as original, written expression well within the exclusive province of Clause 8. Because these rights are perpetual, the statutes run afoul of the limited times requirement of Clause 8.

Both statutes grant performers the exclusive right to authorize the “reproduc[tion of] copies or phonorecords . . . from an unauthorized

250 See *supra* Part III.A.4.

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

252 See David Nimmer, Essay, *The End of Copyright*, 48 VAND. L. REV. 1385, 1409 (1995) (“[N]o respectable interpretation of the word ‘Writings’ embraces an untaped performance of someone singing at Carnegie Hall.”). But see 3 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 15.6.1 (2d ed. 2005) (“[P]erformances subject to [federal anti-bootlegging] protection are ‘writings’ in the constitutional sense . . .”).

fixation.”²⁵³ Likewise, both grant the performer the exclusive right to authorize distribution and sale of “any copy or phonorecord” of an unauthorized recording.²⁵⁴ These copies, as the “physical rendering[s] of the fruits of creative intellectual or aesthetic labor,” qualify as writings under Clause 8.²⁵⁵ Because recordings of performances are within the reach of Clause 8,²⁵⁶ they are likewise subject to its limits, regardless of the power under which Congress claims to act.

The recordings of musical performances protected from unauthorized reproduction under the anti-bootlegging statute differ in only one respect from those protected under traditional copyright law. Copyrighted sound recordings are initially created with the performer’s authorization; those subject to the perpetual exclusive rights granted by the anti-bootlegging statute are recorded without authorization. This distinction could prove decisive for a number of questions under a constitutionally legitimate statutory regime. It could determine whether a copyright subsists in a work, who may claim it, or whether an infringement has occurred. But this distinction does not establish a line that divides legislation enacted pursuant to Clause 8 and constrained by its limits from legislation justified under the Commerce Clause and thereby immune from those limits.

Congress may well be capable of crafting legislation that confers to performers exclusive rights in recordings of their performances,²⁵⁷

²⁵³ 17 U.S.C. § 1101(a)(1); 18 U.S.C. § 2319A(a)(1).

²⁵⁴ 17 U.S.C. § 1101(a)(3); 18 U.S.C. § 2319A(a)(3).

²⁵⁵ *Goldstein*, 412 U.S. at 561; *see also* *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 664 (2d. Cir. 1955) (Hand, J., dissenting) (asserting that a writing is a “physical object that can be made to reproduce”).

²⁵⁶ *Goldstein*, 412 U.S. at 562.

²⁵⁷ The durational problem raised by the anti-bootlegging statutes could be resolved fairly easily by inserting a time limit on the exclusive rights to reproduce, distribute, and transmit unauthorized recordings of live performances. TRIPS, in fact, required only fifty years of protection. *See supra* note 10.

The more difficult issue in attempting to provide constitutionally authorized protections for live performances is that those performances themselves are not an appropriate subject of exclusive rights under Clause 8. A recording of a performance can be protected, but not the performance itself. One potential solution is to expand the Copyright Act’s simultaneous fixation provision to include untransmitted live performances that are fixed under the authority of the performer at the time of the performance. *See* 17 U.S.C. § 101 (“A work consisting of sounds, images, or both, that are being transmitted, is ‘fixed’ for purposes of this title if a fixation of the work is being made simultaneously with its transmission.”). Under this approach, an unauthorized recording of a simultaneously fixed live performance would be an infringement under traditional copyright doctrine in much the same way a recording of a televised live sports event is today. *See, e.g.*, Posting of Fred von Lohmann to The Patry Copyright Blog, <http://williampatry.blogspot.com/2005/05/constitutionality-of-bootleg-statute.html> (May 18, 2005, 13:29 EST) (“In considering the issue of bootlegging . . . I’ve always wondered why Congress didn’t simply extend the

but it must do so within the confines of Clause 8. But because the Constitution “clearly precludes” perpetual grants of exclusive rights in copyrightable subject matter,²⁵⁸ the failure to include a durational limit in the anti-bootlegging statute—to the extent the objects of its exclusive rights are writings—proves its fatal flaw.

D. The Second Circuit’s Misreading of § 2319A

The district court in *Martignon* recognized the dual constitutional infirmities of the anti-bootlegging statute; it granted perpetual rights, and it granted those rights in unwritten performances.²⁵⁹

On appeal, the United States agreed that § 2319A conferred rights in non-writings, but it argued that by doing so, the statute essentially removed itself from the sphere of Clause 8 power and into legislative terrain governed by the commerce power. *Martignon* and his supporters, on the other hand, maintained that by protecting unwritten works, § 2319A did not escape the limits of Clause 8, but simply violated them. The significance of protection for non-writings looked to be the determinative issue on appeal. But when the Second Circuit issued its opinion, some two years after it heard the case, it ignored this central question. Instead, the court held that because § 2319A is

‘simultaneous fixation’ doctrine, 17 U.S.C. 101 ([definition] of ‘fixed’), so that performers who wanted full copyright protections against bootleggers could simply record their performances. Why not eliminate the ‘transmit’ requirement from the ‘simultaneous fixation’ definition, and delete the strange ‘prior notice’ requirements of 17 U.S.C. 411(b)? Then performers would get the full arsenal of copyright remedies for the full copyright term against any bootleggers, simply by recording their performances on a handheld recorder.”). But this approach, much like the anti-bootlegging statutes, impermissibly extends exclusive rights to a performance that is not a writing. The simultaneous fixation approach at least does so by creating the legal fiction that the performance is fixed, but it nonetheless confers rights in a nonwriting.

A better approach would deem live performers the holders of a copyright in any unauthorized recording of their performances. Once the recording has been made, performers could assert the typical panoply of § 106 rights against infringers. They could not, however, prevent the initial creation of the recording. But to the extent this is viewed as a shortcoming, it is one rooted in limits imposed by the Constitution. This approach would require a change to the statutory definition of “fixed” works. See 17 U.S.C. § 101 (“A work is ‘fixed’ in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”).

²⁵⁸ *Eldred v. Ashcroft*, 537 U.S. 186, 209 n.16 (2003) (quoting S. Rep. No. 104-315, at 11 (2d Sess. 1996)); accord *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (noting that Congress may not create “a species of perpetual . . . copyright”).

²⁵⁹ See *supra* notes 22–28 and accompanying text.

not a copyright law, the limits of Clause 8 were irrelevant to the question of its constitutionality.²⁶⁰

In many respects, the Second Circuit's analysis in *Martignon* serves as a model for courts facing inter-clause conflicts. After considering the relevant Supreme Court precedent, the court recognized that some limits on enumerated powers do constrain Congress when it seeks to act pursuant to an independent grant of authority. The court rightly understood that those limits apply whenever the legislation in question is an exercise of power over the core subject matter of that grant. According to the court, Commerce Clause legislation transgresses the limits of Clause 8 if "(1) the law [Congress] enacts is an exercise of the power granted Congress by the Copyright Clause and (2) the resulting law violates one or more specific limits of the Copyright Clause."²⁶¹

The next step in the Second Circuit's analysis was to determine "whether Section 2319A is a copyright law in the sense that RITA was a bankruptcy law."²⁶² If so, § 2319A, falls within the purview of Clause 8 and is bound by its limits. In the court's words, "in order to demonstrate unconstitutionality, *Martignon* must establish that Section 2319A is a copyright law and not just that it is copyright-like."²⁶³

But the Second Circuit fundamentally misunderstood the district court's use of the term "copyright-like." That term has drawn unwarranted criticism from commentators as well.²⁶⁴ Although undoubtedly imprecise and perhaps unartful, the court's use of the term "copyright-like" roughly equates to the notion of the Clause 8 penumbra described above. In asking whether § 2319A served as a copyright law or a commercial regulation, the district court asked, in essence, whether the limits of Clause 8 govern Congress's power to enact the statute. By classifying § 2319A as copyright-like rather than a copyright law, the court recognized that § 2319A fell within the reach of Clause 8 limits, but outside of its positive authority. As used by the

260 See *United States v. Martignon*, 492 F.3d 140, 152 (2d Cir. 2007).

261 *Id.* at 149.

262 *Id.*

263 *Id.* at 150.

264 See Symposium, *Panel III: United States v. Martignon—Case in Controversy*, 16 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 1223, 1234 (statement of William Patry) ("The idea that [§ 2319A] could be 'copyright-like' I don't quite get either. You are pregnant or you are not pregnant. Either it is a Copyright Clause or it is not a Copyright Clause. It can't be 'copyright-like.'"). But see Patry, *supra* note 6, at 367 n.50 ("By 'copyright-like,' I mean a property right to prevent acts equivalent to those granted under the Copyright Act, such as the right to prevent an unlicensed reproduction of a substantial portion of an original database.").

district court, “copyright-like” referred to statutes that—while impermissible under Clause 8—are nonetheless within the scope of its exclusive control.

Aside from this semantic confusion, the Second Circuit rightly distilled the essence of Congress’s Clause 8 authority. Relying on the term “secure” in Clause 8, the court suggested that copyright laws, as their defining characteristic, “create, bestow, or allocate property rights in expression.”²⁶⁵ This definition of the core function of the copyright power closely resembles the explanation offered above.²⁶⁶ According to the Second Circuit, the limits of Clause 8 preclude Congress from acting under the Commerce Clause any time it would confer exclusive rights in expression in a manner inconsistent with Clause 8 limits. This holding, taken in isolation, is a victory for proponents of external application of Clause 8 limits.

Had the Second Circuit faithfully applied this test to § 2319A, it would have concluded that the statute was, indeed, a copyright law—and an unconstitutional one at that. Instead, the court offered three rationales that it believed distinguished § 2319A from true copyright laws. None of these rationales provide a reasonable basis for the court’s conclusion that § 2319A does not “allocate property rights in expression.”²⁶⁷

First, the court reasoned that because § 2319A imposes a criminal sanction, it does not function to bestow exclusive rights on performers.²⁶⁸ According to the court, much like the law of criminal trespass, § 2319A “does not grant the performer the right to exclude others”;²⁶⁹ it merely “creates a power in the government to protect the interest of performers from commercial predations.”²⁷⁰ The court’s reasoning here conflated the existence or creation of a right with the mechanism by which that right is enforced. Section 2319A does, of course, provide the government with authority to prosecute those who violate the statute, but it simultaneously establishes a protectable interest in the performer whose work is the subject of the statute’s prohibitions. Whether achieved through criminal or civil sanctions, the effect of the anti-bootlegging statutes is the same: performers and performers alone are permitted to engage in, or permit others to engage in, the

265 *Martignon*, 492 F.3d at 152.

266 *See supra* Part III.B.

267 *Martignon*, 492 F.3d at 152.

268 *Id.* at 151.

269 *Id.*

270 *Id.*

recording of live performances and the reproduction and distribution of copies of those recordings. The fact that some state action is required to enforce the exclusive rights conferred by § 2319A does not distinguish them from the rights created by § 106 of the Copyright Act, or from common law property rights for that matter.²⁷¹

Aside from misunderstanding the effect of the statute, the court's analysis leads to two problematic results. First, since § 1101 creates a civil cause of action, the court's primary basis for deeming § 2319A a commerce regulation does not apply. This suggests, rather improbably, that the two anti-bootlegging statutes, which regulate the same material through nearly identical prohibitions, were enacted pursuant to two different grants of authority. Moreover, it raises the possibility that one is constitutional while the other is not. Such a conclusion should have led the court to reconsider its reasoning.

Second, if enforcing grants of exclusive rights through criminal sanctions is sufficient to render a statute a non-copyright law, the long-standing criminal copyright provisions turn out not to be copyright laws either. Criminal copyright enforcement, which has been a component of the copyright code since the nineteenth century,²⁷² would owe no allegiance to Clause 8 under the Second Circuit's reasoning. Indeed the court admitted that, under its reasoning, Congress could impose criminal sanctions for the reproduction of public domain works without running afoul of the Constitution.²⁷³ Here the court bordered on pronouncing its own logic a *reductio ad absurdum*.

The court relied on two additional justifications for its conclusion that § 2319A does not serve as a copyright law. Both of these considerations, because they compare the statute with the current Copyright Act rather than the scope of the copyright power, fail to further the relevant inquiry. The court noted that the Copyright Act affords authors "an extensive bundle of rights."²⁷⁴ By contrast, according to the court, § 2319A, provides only "one right—the right to allow the fixation of his or her performance."²⁷⁵ Aside from mischaracterizing

271 See Shelby D. Green, *Specific Relief for Ancient Deprivations of Property*, 36 AKRON L. REV. 245, 299–300 (2003) ("'Property' . . . bestows on an owner a form of sovereignty over others, because the sovereign state stands behind the owner's assertion of right. Individual property rights thus depend on state power and when the state recognizes and enforces one person's property right, it simultaneously denies property rights in others.").

272 The first criminal provision in our copyright laws was a misdemeanor penalty added in 1897 for unlawful performances and representations of copyrighted dramatic and musical compositions. Act of Jan. 6, 1897, ch. 4, § 4966, 29 Stat. 481.

273 See *Martignon*, 492 F.3d at 152 n.7.

274 *Id.* at 151.

275 *Id.*

the statute, which provides the performer with a bundle of rights nearly identical to those conferred on copyright holders,²⁷⁶ this distinction reveals little about whether § 2319A falls within the purview of Clause 8. The current bundle of rights that constitute a copyright are a matter of congressional policy-making and industry lobbying;²⁷⁷ they are not a reflection of the constitutional scope of the copyright power. As history demonstrates, Congress has significantly and repeatedly altered the rights within this bundle.²⁷⁸ Doing so does not alter the constitutional source of its authority.

The court similarly mistook the current Copyright Act as the proper metric for its constitutional analysis when it suggested that § 2319A was not a copyright law because it did not permit the transfer of the exclusive rights it confers.²⁷⁹ Again, while it is true that the Copyright Act does permit copyright holders to assign or transfer their interests,²⁸⁰ no constitutional mandate requires such a provision. A copyright law without an assignment provision is nonetheless a copyright law. If Congress, in its wisdom, chose to prevent copyright holders from transferring their rights, Clause 8 would pose no barrier.

The Second Circuit rightly understood that limits within particular enumerated powers can impose genuine external constraints on congressional authority. It also recognized that the limits of Clause 8 apply any time Congress seeks to grant exclusive rights in expression. But by focusing on the idiosyncratic characteristics of the Copyright Act rather than the scope of the copyright power, the court incorrectly held that § 2319A was beyond the scope of Clause 8 and its limits. In the end, the Second Circuit failed to articulate a single rea-

276 See *supra* Part IV.C.

277 See Robert C. Denicola, *Freedom to Copy*, 108 YALE L.J. 1661, 1685 (1999) (describing the crafting of copyright legislation as a “series of contract negotiations” between interest groups); see also Jessica D. Litman, *Copyright Legislation and Technological Change*, 68 OR. L. REV. 275, 314–15 (1989) (arguing that the copyright legislative process is largely determined by industry lobbying).

278 The Copyright Act of 1790 Act, for example, granted exclusive rights “to print, reprint, publish, or vend.” Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124. The Copyright Act of 1909 granted rights to translate, deliver, and perform. Act of Mar. 4, 1909, ch. 320, § 1(b)–(d), 35 Stat. 1075. The Copyright Act of 1976 Act replaced these earlier rights entirely with a new set of rights, and surely did so without disturbing the constitutional source of Congress’s authority to confer copyrights. See 17 U.S.C. § 106 (2000) (securing copyright owners the right to reproduce, prepare derivative works, distribute copies, perform publicly, and display publicly).

279 See *Martignon*, 492 F.3d at 151.

280 See, e.g., 17 U.S.C. §§ 201–205 (2000); Act of May 31, 1790, ch. 15, § 1; Act of Mar. 4, 1909, ch. 320, § 27.

soned basis for insisting that § 2319A is not a copyright law in the constitutional sense. Despite the Second Circuit's attempt to salvage the statute, there can be little doubt that § 2319A, like its civil counterpart, is a copyright law in the same way RITA was a bankruptcy law. Since the anti-bootlegging statutes are within the exclusive purview of Clause 8 authority, their failure to impose a durational limit and their extension of exclusive rights in unwritten expression, under the Second Circuit's own test, render them unconstitutional.

CONCLUSION

If the limits of Clause 8 are to retain any relevance in interpreting the scope of Congress's legislative powers in the face of the modern Commerce Clause, those limits must be applied externally to preclude legislation that invades the penumbral public domain. To permit Congress to grant exclusive rights in perpetuity, or to non-authors, or in unoriginal and unwritten works would not just allow Congress to reinterpret the Constitution, but to rewrite it.

The recognition that Clause 8 limits restrain Congress any time it attempts to grant exclusive rights in expression reveals a public domain that is resilient to forces that threaten other, more vulnerable aspects of public domains. The penumbral public domain, defined by the limits of Clause 8, is not subject to congressional whims,²⁸¹ and it is less susceptible to unpredictable judicial decision making.²⁸² Nor must it rely on private ordering.²⁸³ Short of a constitutional amend-

281 The existence of formal requirements necessary for copyright protection and the consequences of failure to comply with such formalities offer one example of the impact of legislative decision-making on the public domain. See Elizabeth Townsend Gard, *January 1, 2003: The Birth of the Unpublished Public Domain and Its International Implications*, 24 *CARDOZO ARTS & ENT. L.J.* 687, 692–93 (2006) (describing implications of failure to comply with copyright formalities). The constitutional public domain is also more resilient to legislative extension of the copyright term. See Dennis S. Karjala, *Judicial Review of Copyright Term Extension Legislation*, 36 *LOY. L.A. L. REV.* 199, 210–11, 218–20 (2002) (describing Congress's consideration of the public domain in extending the term of copyright protection).

282 The fair use defense owes its origins and developments to judicial interpretation, even though it was statutorily recognized by the Copyright Act. See 17 U.S.C. § 107 (2000). Although fair use operates as an affirmative defense to copyright infringement, it falls within some more expansive readings of the public domain. See Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 *N.Y.U. L. REV.* 354, 361–62 (1999) (proposing a definition of the public domain that incorporates fair uses).

283 Private licensing arrangements like those facilitated by Creative Commons licenses and the General Public License ("GPL") contribute to some conceptions of the public domain by permitting the public to make specified uses of copyrighted works without seek-

ment, this public domain is designed to weather the tides of shifting legislative agendas, judicial policy, and industry practice.

But the penumbral public domain defined by the limits of Clause 8 is only part of the broader constitutional public domain. The First Amendment imposes another set of constraints that restricts the exercise of Congress's copyright power. Two copyright doctrines, the fair use defense and the idea/expression distinction, function to reconcile copyright law with the First Amendment. Grants of exclusive rights in expression that fail to respect these "traditional contours" of copyright law may very well run afoul of the Constitution.²⁸⁴ Ideas and fair uses, then, also fall within a public domain defined by constitutional constraints.

Public domains, however, are defined not only by their content, but by the freedoms they provide the public.²⁸⁵ The freedoms offered by the penumbral public domain, although comparatively immune from interference, are limited in a number of important respects. Frequently, the "public domain" refers to a class of material free of intellectual property rights.²⁸⁶ The works within the penumbral public domain are free of federal grants of exclusive rights, but they are not necessarily free from intellectual property rights altogether. Unauthorized recordings of live performances, for example, can be regulated through targeted state legislation or more general state rights of publicity. Regardless of whether these state regulations are, strictly speaking, intellectual property rights, they impose many of the same restrictions on the public's freedom. Likewise, unoriginal compilations of data, even though beyond the scope of congressional authority, could be subject to state trade secrecy protection. State contract law, of course, could further supplement these state law regimes by enforcing private restrictions on both performances and compilations of data.

The "public domain" may also denote public accessibility.²⁸⁷ Even if free of intellectual property rights, works are more valuable to the public if they can be viewed or otherwise utilized. Works within the penumbral public domain occupy the full spectrum of accessibility. Some, like private performances and trade-secret data, are highly in-

ing permission from the copyright holder. See Samuelson, *supra* note 5, at 800–02 (explaining how GPL and Creative Commons could be alternatives to traditional intellectual property rules).

284 See *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003).

285 See Samuelson, *supra* note 5, at 816–19.

286 See *id.* at 791.

287 See *id.* at 798–99.

accessible. Other performances, like the typical concert protected by the anti-bootlegging statutes, are restricted by an admission fee, and perhaps contractual terms, but otherwise open to all. Still other performances are truly public in the sense that no restrictions on access are imposed.

The penumbral public domain, given its susceptibility to restrictions imposed by state law and the potential for inaccessibility, is by no means the most robust public domain we can imagine or to which we should aspire. But the works within this public domain are far freer under a reading of the Constitution that enforces the limits of Clause 8 than one that permits the Commerce Clause free reign over the subject matter of Congress's copyright power. Perhaps more importantly, the penumbral public domain, and the broader constitutional public domain of which it is a component, establishes a floor on the contents of the public domain and the freedoms it provides. Regardless of what the Framers believed the public domain should include, the constitutional public domain represents what it must include. Any robust public domain we construct depends, in part, on this foundation.