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Checks, Balance and Judicial Wizardry: Constitutional Delegation and Congressional Legislation

Robert I. Reis

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CHECKS, BALANCE AND JUDICIAL WIZARDRY: CONSTITUTIONAL DELEGATION AND CONGRESSIONAL LEGISLATION

*Robert I. Reis**

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I. INTRODUCTION AND OVERVIEW—A SPATE OF CASES MEASURED BY DECISIONS OVER TIME

Recent Supreme Court activity regarding “intellectual property” may lead some to believe the increase in cases has some further meaning beyond the decisions themselves.¹ In fact, depending on how many year

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1. Fourth Annual Akron IP Professors Forum, *IP and the Supreme Court* (Nov. 5, 2010). Papers presented at the forum included the following: Jay Dratler, Jr., *The Supreme Court and the Federal Circuit: A Case of Supervision by Generalists*; Susanna Frederick Fischer, *Threatening the Founding Ideal of a Republic of Letters: An Assessment of the Supreme Court’s Copyright Decisions Over the First Decade of the Twenty-First Century*; Thomas C. Folsom, *IP in 4D: Four Degrees of Uncertainty in Intellectual Property*; Liam O’Melinn, *The Supreme Court on Intellectual Property: Judicial Restraint or Irresponsible Avoidance?*; Robert I. Reis, *Checks, Balance and Judicial Wizardry: Constitutional Delegation and Congressional Legislation*; Ryan Vacca, *IP and the Supreme Court: A Historical Perspective*; Elizabeth I. Winston, *The Technological Edge*.

one includes in this calculation, there were several significant cases in the immediate years before the turn of the century that might also qualify for inclusion. In the immediate past, there were six (6) patent cases: *Bilski*,² *Festo*,³ *MedImmune*,⁴ *eBay*,⁵ *KSR*,⁶ and *Quanta Electronics*.⁷ In addition, there were four (4) copyright cases: *Tasini*,⁸ *Eldred*,⁹ *Grokster*,¹⁰ and *Muchnick*.¹¹ Also, some might think it notable that the Court has decided four (4) trademark cases: *Traffix*,¹² *Wal-Mart*,¹³ *Victoria's Secret*,¹⁴ and *Dastar*.¹⁵ The interests they represent and the source of power to enact legislation in the field raise distinct issues that may inform of current judicial interest and concern. These don't necessarily delineate the constitutional role of the Court relative to the delegation under Article I, Section Eight, Clause 8 of the United States Constitution.¹⁶ A gathering of cases using conventional search resources and techniques¹⁷ yielded 666 patent cases¹⁸ and 73 copyright cases.¹⁹

2. *Bilski v. Kappos*, 130 S. Ct. 3218 (2010) (patentable subject matter) (cited in 19 subsequent cases).

3. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002) (doctrine of equivalents) (cited in 30 subsequent cases).

4. *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118 (2007) (declaratory judgments) (cited in 16 subsequent cases).

5. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006) (injunctive remedies) (cited 617 times).

6. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) (obviousness) (cited 509 times). The downstream effects can be found in the recent Federal Circuit decision regarding obviousness. *In re Glatt Air Techniques, Inc.*, 630 F.3d 1026 (Fed. Cir. 2011).

7. *Quanta Computer, Inc. v. LG Elecs., Inc.*, 553 U.S. 617 (2008) (first-sale doctrine) (cited in 50 decisions).

8. *N.Y. Times Co. v. Tasini*, 533 U.S. 483 (2001) (articles in databases) (cited in 55 decisions).

9. *Eldred v. Ashcroft*, 537 U.S. 186 (2003) (copyright term extension) (92 subsequent citing decisions).

10. *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005) (inducing infringement) (cited in 251 decisions).

11. *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2009) (copyright registration) (77 decisions cited case).

12. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001) (trade dress and patents) (cited in 287 decisions).

13. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000) (distinctiveness of trade dress) (cited in 433 decisions).

14. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003) (dilution) (cited in 174 decisions).

15. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (trademark protection creative content) (cited in 283 decisions).

16. U.S. CONST. art. I, § 8, cl. 8.

17. Such as the Westlaw and LexisNexis databases.

18. This statistic should be qualified as "more or less" because a few of the cases cited for patents were copyright cases using patent principles as well the 74 copyright cases, starting with *Keplinger v. De Young*, 23 U.S. 358 (1825), an action for patent infringement.

This essay is not intended as a case-by-case analysis, or an exhaustive source of reference; it is but a sample of these cases. It is a work in progress attempting to simply share thoughts and perspectives raised by the litany of cases heard by the Supreme Court over these two centuries.²⁰

Some of these cases were much anticipated. Most are certainly notable. But what does that mean in the context of the span of two centuries of constitutional intellectual property, or for that matter, those regulatory rights included as intellectual property? Are either the number of cases or fundamentals of decision-making distinguishable from prior activity of the Supreme Court? Do these cases reflect changing perspectives in the exercise of separate but equal and checks and balances? Is the role of the court and use of precedent different when acknowledging deference to either the statutory language of Congress or exercising their constitutional powers of interpretation and application to specific cases and controversies? What are the catalysts of congressional action and subsequent review by the court? Why ask these questions in the first place? It might normally have been expected in the mix of cases that one would find the court exercised its duty and powers as a check on the acts of Congress. How many cases have invalidated either copyright or patent legislation based on a judicial determination that congressional action exceeded the powers delegated to Congress under the “intellectual property clause” of the Constitution²¹—the “check” in checks and balances? In light of what

19. Starting with *Wheaton v. Peters*, 33 U.S. 591 (1834) (cited in 211 decisions).

20. The specter of the most recent case before the Court will have to wait another day for substantive consideration. *Costco Wholesale Corp. v. Omega, S.A.*, 131 U.S. 565 (2010). The judgment was affirmed by an equally divided court. Justice Kagan took no part in the consideration or decision of this case. The case involved the first sale doctrine and gray markets.

21. Other than on free speech. See generally Erwin Chemerinsky, *Balancing Copyright Protections and Freedom of Speech: Why the Copyright Extension Act is Unconstitutional*, 36 LOY. L.A. L. REV. 83 (2002). For due process issues, see generally SIVA VAIDHYANATHAN, *COPYRIGHTS AND COPYWRONGS: THE RISE OF INTELLECTUAL PROPERTY AND HOW IT THREATENS CREATIVITY* (2001); Yochai Benkler, *Through the Looking Glass: Alice and the Constitutional Foundations of the Public Domain*, 66-SPG LAW & CONTEMP. PROBS. 173 (2003). See also *In re Trade-Mark Cases*, 100 U.S. 82 (1879); *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340 (1998); and *Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627 (1999). There are several hundred cases that look at the purpose, expanse and sacrosanctity of the interests created by Article I, Section 8 to the Congress, including the ability of the states to tax interests thus created and delegations by the legislature to the court and vice versa. The question generally other than due process and speech has been whether the purpose of the Article is compromised or balance disturbed. There were just 20 powers requested of the states to be delegated to the federal government. Three of these were the power to create patents, copyrights and establish a national university. These are delegated and limited powers that define delegation to Congress. There is nothing in the language of the Constitution that leads one to believe the passage of time and

one might find the answer to that question to be, how does the currently perceived spate of cases and activity of the Supreme Court inform of the role played by the Court since they first articulated the nature and extent of the deference of the Court to Congress pursuant to the provision of Article I, Section 8, Clause 8 as set forth in *Wheaton v. Peters*?²² In the rather lengthy and well-known quote that follows, consider anew how this informs beyond the issues of the case about the role of the court in the centuries to follow:

[The source of delegation and the exercise thereof]

In the eighth section of the first article of the constitution of the United States it is declared, that congress shall have power 'to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries.' And in pursuance of the power thus delegated, congress passed the act of the 30th of May 1790.

[Judicial construction the meaning of words: constitutional provision and legislation.]

This is entitled 'an act for the encouragement of learning, by securing the copies of maps, charts and books, to the authors and proprietors of such copies, during the times therein mentioned.'

....

In behalf of the common law right, an argument has been drawn from the word secure, which is used in relation to this right, both in the constitution and in the acts of congress. This word, when used as a verb active, signifies to protect, insure, save, ascertain, &c.

....

There is no mode by which the meaning affixed to any word or sentence, by a deliberative body, can be so well ascertained, as by comparing it with the words and sentences with which it stands

circumstance was intended to alter the delegation to the federal government, nor the purpose or balance between purpose and rights created to accomplish those ends. See generally Dotan Oliar, *The (Constitutional) Convention on IP: A New Reading*, 57 UCLA L. REV. 421 (2009); Malla Pollack, *What Is Congress Supposed to Promote?: Defining "Progress" in Article I, Section 8, Clause 8 of the United States Constitution, or Introducing the Progress Clause*, 80 NEB. L. REV. 754 (2001); see also Vivian J. Fong, *Are We Making Progress?: The Constitution as a Touchstone for Creating Consistent Patent Law and Policy*, 11 U. PA. J. CONST. L. 1163 (2009); Robert I. Reis, *Progress, Innovation and Technology: A Delicate "Google" Balance*, BUFF. INTELL. PROP. L. REV. (forthcoming 2011).

22. *Wheaton*, 33 U.S. 591.

connected. By this rule the word secure, as used in the constitution, could not mean the protection of an acknowledged legal right. It refers to inventors, as well as authors, and it has never been pretended, by any one, either in this country or in England, that an inventor has a perpetual right, at common law, to sell the thing invented.

And if the word secure is used in the constitution, in reference to a future right, was it not so used in the act of congress?

....

That congress, in passing the act of 1790, did not legislate in reference to existing rights, appears clear, from the provision that the author, &c. 'shall have the sole right and liberty of printing,' &c. Now if this exclusive right existed at common law, and congress was about to adopt legislative provisions for its protection, would they have used this language? Could they have deemed it necessary to vest a right already vested? Such a presumption is refuted by the words above quoted, and their force is not lessened by any other part of the act.

Congress, then, by this act, instead of sanctioning an existing right, as contended for, created it. This seems to be the clear import of the law, connected with the circumstances under which it was enacted.²³

Do *Keplinger*²⁴ or *Wheaton*²⁵ and the over seven hundred cases heard by the Supreme Court since provide perspective on the more limited but pragmatically significant role of statutory interpretation assumed by the court? Do these cases illuminate the efficacy of the inherent judicial function in balancing constitutional objectives with congressional purpose respecting private rights and public benefit? Is this "balance" the requisite and proper constitutional role of the court in copyright and patent cases?²⁶

This exercise rests on an extraordinary body of prior scholarship. These publications serve as both teaching and validation of a quest for meaningful perspectives regarding past decisions and future paradigms.²⁷ Many scholars have engaged in the gathering of cases on which to base their larger empirical observation.²⁸ One wonders,

23. *Id.* at 660-61.

24. *Keplinger v. De Young*, 23 U.S. 358 (1825).

25. *Wheaton*, 33 U.S. 591.

26. See Robert I. Reis, *The Sony Legacy: Secondary Liability Perspectives*, 3 AKRON INTELL. PROP. J. 205 (2010) and see, e.g., Robert I. Reis, *Rights and Remedies Post eBay v. MercExchange—Deep Waters Stirred*, 2 AKRON INTELL. PROP. J. 1 (2008); Reis, *supra* note 21.

27. *Id.*

28. Pamela Samuelson, *The Constitutional Law of Intellectual Property After Eldred v. Ashcroft*, 50 J. Copyright Soc'y (2003). See also JESSICA LITMAN, *DIGITAL COPYRIGHT* (2006);

however, whether there is a distinctly cognitive visceral perspective to be gained from the gathering and reading as many of the seven hundred cases as possible. Is there a sense of continuity and broader context and appreciation of the attention given intellectual property issues in the immediate past decade? What are the constants in the rules behind these cases? It isn't simply the traditional legal citation and dependence on precedent, but the underlying reason and role of the court that makes precedent serve the purpose of a constitutional directive in endlessly changing circumstances. Certainly, almost two hundred years of stability and apparent balance have been maintained by repeated recitation of the promise of reward for public benefits in the shadows of the perceived pillars of purpose and limitation standing tall in the constitutional provisions of "progress" and "limited times" as fundamentals. Whether these words are actual limitations on the delegated power of Congress, or are "prefatory", they worked as de facto underpinnings in the role played by the court by separation of powers. This may be the unintended sequence or proposition that comes into focus when reviewing and comparing the line of cases from the inception. As already noted, this may not qualify as the check anticipated, but rather a sense of wonderment in the pragmatic exercise of inherent judicial powers in "balance."

What is balance but creatively accepting the delegation of powers under the Constitution to Congress, yet, ensuring constitutional and statutory purpose by exercise of inherent judicial functions of the court? The succession of cases inform of those issues and changes in circumstance of concern, of rights created, of remedies appropriate, goals articulated and consequences understood. These include issues specific not only of congressional concern, but, as well, the rights of the parties and the public interest (benefit or detriment) inherent in the judicial process and province of "balance" which is often the articulated concern of the court in "checks and balances." These constants include clichés, metaphors,²⁹ "marks", "bright lines" and any number of other images of shared understanding. They include: "reward", "detriment to the public" (*eBay*),³⁰ "limited times", "progress", "reversion to the

Jessica Litman, *Revising Copyright Law for the Information Age*, 75 OR. L. REV. 19 (1996); *The Public Domain*, 66-SPG LAW & CONTEMP. PROBS. 1 (2003); Symposium, *Fair Use: "Incredibly Shrinking" or Extraordinary Expanding?*, 31 COLUM. J.L. & ARTS 603 (2008).

29. Maybe this is simply an expanded allusion to Justice Story on metaphysics and metaphors. *Folsom v. Marsh*, 9 F. Cas. 342, 344 (C.C. Mass. 1841).

30. This is the critical element reflecting the public interest *eBay* reminded be considered in the discretionary use of injunctive remedies. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006).

public domain”, “spread of knowledge”, etc. If the focus of these questions is limited to the specific issues and parties in any given case, then the role played by the court in balance may be dimmed.

II. CATALYSTS AND CHALLENGES OF CHANGE: AN ENDLESS EMULSION OF SUBJECT MATTER, TECHNOLOGY, NORMATIVE FORCES, ECONOMIC VALUES, DISTRIBUTIVE ENABLEMENT, INTERNATIONAL RELATIONS AND MORE.³¹

It is no surprise that the specific subject matter in issue before the Court has changed over time. Nor is it a revelation that almost every case had one or more cases on similar issues decided with like results from the earliest of times. The rules have remained relatively constant, but the facts, balance and implications change in each new context. The value of over seven hundred cases is a context in which there are moments of striking familiarity and a growing awareness that there is a pattern, not disconnect, and function serving constitutional purpose beyond the cliché of checks and balances. Following are a few instances of déjà vu applications from old to new that highlight a few of the thoughts gathered from a reading of the flow of cases.

31. It is this boundless set of issues that makes the focus of rights and governance critical to intellectual futures and basic human rights. The following studies represent a search, without answers, for a sustainable perspective on intellectual rights and wrongs. One learns from successes in baby steps and failures as well. These citations map the ontogeny of portions of travels to this point: Robert I. Reis, *The Relationship of Technology Enablement to Regulatory Structures* (Mar. 24, 2011) (paper presented at the annual meeting of the The Law and Society, J.W. Marriott Resort, Las Vegas, NV) (on file with author); Robert I. Reis, *The Public Beneficial Interest in the Intellectual Commons: The Implications of the Public Trust Doctrine and Necessary Standing to Represent the Public Interest* (paper presented at the 6th Annual IPSC Conference, Aug. 10-11, 2006), available at <http://www.law.berkeley.edu/institutes/bclt/ipsc/papers2/Reis.pdf>; Robert I. Reis, *Exploration for Intellectual Capital—Legal, Technical and Social Issues Autism—A Mystery of Epidemic Proportions* (paper presented at the 9th Annual IPSC Conference, Depaul University, Aug. 6-7, 2009) (The hypothesis being that anything labeled epidemic by the CDC should have research and scholarship readily available for review. That was not the conclusion of the study.), available at http://www.law.depaul.edu/centers_institutes/ciplit/ipsc/paper/Robert_ReisPaper.pdf. A delightful presentation distinguishing “access” and IP rights can be found in a more recent article: Randal C. Picker, *Fair Use v. Fair Access*, 31 COLUM. J. L. & ARTS 603 (2008); Reis, *Rights and Remedies Post Ebay v. Mercexchange—Deep Waters Stirred*, supra note 26 (raising the issue of separation of powers and discretionary remedies); Reis, *The Sony Legacy: Secondary Liability Perspectives*, supra note 26 (note discussion of inference in secondary liability cases as well as technology transfer assessment protocols that permit assessment of potentials represented by innovation); Reis, supra note 21.

A. *Bilski*

The decision of the Court in *Bilski*³² was anxiously awaited. The question addressed was whether using a mathematical formula to permit investors, suppliers and end users to hedge the risks of fluctuation in market price changes and demand was a patentable process within the meaning of section 101.³³ This, in turn, depended on the statutory definition of “process”, and whether a “process” required enablement be coupled with a machine or device under the machine-or-transformation test to limit the patent right and enable the use of the basic algorithm by others for alternative uses.³⁴ The Court rejected any “categorical” analysis, one way or the other.³⁵ The *Bilski* Court indicated that the broad language of the Act would permit a “process” in and of itself to be eligible for patent protection under the proper circumstance, although they did not venture further by delineation of what that might be.³⁶ The Court attempted to clarify that the machine-or-transformation test is not the only test for patent protection under section 101.³⁷ They admonished that neither does it mean that the process at issue is or is not a recognized process for patent protection.³⁸ In the final analysis, the claims in the case of *Bilski* were found to include “the basic concept of hedging which reduced that concept to a mathematical formula” rendering the process ineligible for patent qualification as an abstract mathematical formulation or algorithm.³⁹

32. *Bilski v. Kappos*, 130 S. Ct. 3218 (2010). It is a little more than interesting that BNA Daily Tax Report reports, “Senate Finance Committee Chairman Max Baucus (D-Mont.) and Finance member Charles Grassley (R-Iowa) Jan. 20 unveiled legislation they plan to introduce that would stop the patenting of tax strategies...”. Alison Bennet, *Grassley, Baucus Unveil Legislation to Stop Patenting of Tax Strategies*, BNA Daily Tax Report, Jan. 21, 2011, ¶ 1.

33. 35 U.S.C.A. § 101.

34. *Bilski*, 130 S. Ct. at 3220.

35. *Id.* at 3236. See, e.g., Robert I. Reis, *Rights and Remedies Post Ebay v. MercExchange—Deep Waters Stirred*, *supra* note 26 (considering discretion, an inherent judicial function).

36. *Bilski*, 130 S. Ct. at 3221.

37. *Id.* at 3218.

38. *Id.*

39. One of the many Amicus briefs submitted evidenced a concern that a narrowing of the patent right would have a negative economic impact on a community dependent of the revenues of like intellectual properties and applications. Brief of the Intellectual Property Section of the Nevada State Bar as Amicus Curiae in Support of Respondent, *Bilski v. Kappos*, 130 S. Ct. 3218 (2010) (No. 08-964), 2009 U.S. S. Ct. Briefs LEXIS 1008. Consider further that abstractions and algorithms belong to all unless reduced to practice as process tied to a “machine” that limits the nature of the private right. Unless so tied, the “invention” may not be eligible for patent protection. The broad public benefit lies not only in the invention, but in not privatizing more than specific to the patent to ensure the use of these incidents for all to use in invention. The question was phrased as that of congressional intent in the drafting of the statute, but not as that of constitutional

The tenets of deference to statutory language and interpretation in this context mirror that of *Wheaton*.⁴⁰ In *Bilski*, the issue faced by the Court was how to implement the intent of Congress to broaden the meaning of “process” while, at the same time, remain fast on limiting patenting algorithms and other abstract or fundamental constructs to the detriment of future users.⁴¹ Surprisingly, the Court notes there are judicial exceptions in the interpretive process based on precedent that constitute “perceived” exceptions to section 101’s reach.⁴² The three exceptions are “laws of nature, physical phenomena and abstract ideas.”⁴³ Does this qualify as “wizardry” in the balance aspect of checks and balances? Note the attempt of the Court to justify what rarely is acknowledged by the following statement:

And, in any case, these exceptions have defined the reach of the statute as a matter of statutory *stare decisis* going back 150 years[;]” ... concepts converged by these exceptions are “part of the storehouse of knowledge of all men... free to all men and reserved exclusively to none.”⁴⁴

The Court also noted:

It is important to emphasize that the Court today is not commenting on the patentability of any particular invention, let alone holding that any of the above-mentioned technologies from the Information Age should or should not receive patent protection. This Age puts the possibility of innovation in the hands of more people and raises new difficulties for the patent law. With ever more people trying to innovate and thus seeking patent protections for their inventions, the patent law faces a great challenge in striking the balance between protecting inventors and not granting monopolies over procedures that others would discover by independent, creative application of general principles. Nothing in this opinion should be read to take a position on where that balance ought to be struck.⁴⁵

limitation. The economic preservation issue must be viewed as a balance with progress and future use of the common elements of nascent patents. These matters underlie many of these cases and reviews. The economic aspect may be the reward, but not the objective of intellectual property. Despite this observation, vested interests prevail in the shadows of many cases and contexts. See generally *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

40. See *Wheaton v. Peters*, 33 U.S. 591 (1834). See also *O’Reilly v. Morse*, 56 U.S. 62 (1853).

41. See generally *Bilski*, 130 S. Ct. at 3218.

42. *Id.* at 3228; 35 U.S.C. § 101.

43. *Bilski*, 130 S. Ct. at 3226.

44. *Id.* at 3225.

45. *Id.* at 3228.

What would be the benefit and the detriment were this not the practice and the rule? If one really needs justification for this “outrage” of judicial balance, the ultimate justification may lie in the implicit belief that if Congress objected to this interpretation for the past 150 years it would have amended the statute.⁴⁶

There are several notable cases that qualify as déjà vu and rationale for this holding such as *O’Reilly v. Morse*.⁴⁷ The *Roy v. Tatham*⁴⁸ case has been cited 372 times in total, including 73 times in courts and administrative proceedings and 17 times and two cases before the Courts as party thereto. Both *O’Reilly*⁴⁹ and *Roy*⁵⁰ raise questions concerning the force of legislation, the intent of Congress, the substance of invention, the impact of privatizing abstract principles and the coupling of the abstract principals with the tangible invention. *Morse* is particularly instructive because of the clearly articulated reduction of claimed subject matter to protect the recognized public interest and avoid the issues raised in *Bilski*.⁵¹ *Morse* involved the use of electro magnetism as an abstract principle and force of nature as a means of transmitting and printing messages over great distances powered by electric impulses sent and received by machines at either end.⁵² *Morse* conceived of his invention on a return voyage from France to New York in 1832.⁵³ The period of invention, testing, modification of invention, filing of caveats, surrender of invention and modification of claims and reissuance of final patent with limited claims took almost two decades.⁵⁴

46. 35 U.S.C. § 101.

47. See generally *O’Reilly v. Morse*, 56 U.S. 62 (1853).

48. See generally *Le Roy v. Tatham*, 55 U.S. 156 (1853), which demonstrated the use of lead for pipes not claimed, but the application was: The essential difference in the character of this pipe, which distinguishes it, as well as that contemplated by Thomas Burr, from all other heretofore known or attempted, is that it is wrought under heat, by pressure and constriction, from set metal; and that it is not a casting formed in a mould. And they declare, ‘We do not claim as our invention and improvement, any of the parts of the above-described machinery, independently of its arrangement and combination above set forth. What we do claim as our invention, and desire to secure, is, the combination of the following parts above described, to wit: the core and bridge, or guide-piece, with the cylinder, the piston, the chamber and the die, when used to form pipes of metal, under heat and pressure, in the manner set forth, or in any other manner substantially the same.’ *Id.* at 160.

49. *O’Reilly*, 56 U.S. at 62.

50. *Le Roy*, 55 U.S. at 156.

51. *Bilski*, 130 S. Ct. at 3218.

52. *O’Reilly*, 56 U.S. at 70-73.

53. *Id.* at 62.

54. *Id.* at 70-73.

The final reissue patent was granted in 1848, fully 16 years after the first conception of the invention.⁵⁵

Morse's final description of the invention claimed speaks for itself:

First. Having thus fully described my invention, I wish it to be understood that I do not claim the use of the galvanic current, or current of electricity, for the purpose of telegraphic communications, generally; but what I specially claim as my invention and improvement, is making use of the motive power of magnetism, when developed by the action of such current or currents, substantially as set forth in the foregoing description of the first principal part of my invention, as means of operating or giving motion to machinery, which may be used to imprint signals upon paper or other suitable material, or to produce sounds in any desired manner, for the purpose of telegraphic communication at any distances.⁵⁶

As does this further excerpt from the Court:

Now whether the Telegraph is regarded as an art or machine, the manner and process of making or using it must be set forth in exact terms. The act of Congress makes no difference in this respect between an art and a machine. An improvement in the art ... must be so described; and so must the art of printing by the motive power of steam [sic]. And in all of these cases it has always been held, that the patent embraces nothing more than the improvement described and claimed as new, and that anyone who afterwards discovered a method of accomplishing the same object, substantially and essentially differing from the one described, had a right to use it. Can there be any good reason why the art of printing at a distance, by means of the motive power of the electric or galvanic current, should stand on different principles? Is there any reason why the inventor's patent should cover broader ground? It would be difficult to discover anything in the act of Congress which would justify this distinction. The specification of this patentee describes his invention or discovery, and the manner and process of constructing and using it; and his patent, like inventions in the other arts above mentioned, covers nothing more.⁵⁷

The provisions of the acts of Congress in relation to patents may be summed up in a few words:

Whoever discovers that a certain useful result will be produced, in any art, machine, manufacture, or composition of matter, by the use of

55. *Id.* at 84-85.

56. *Id.* at 85 (emphasis added).

57. *Id.* at 118-19.

certain means, is entitled to a patent for it; provided he specifies the means he uses in a manner so full and exact, that any one skilled in the science to which it appertains, can, by using the means he specifies, without any addition to, or subtraction from them, produce precisely the result he describes. And if this cannot be done by the means he describes, the patent is void. And if it can be done, then the patent confers on him the exclusive right to use the means he specifies to produce the result or effect he describes, and nothing more. And it makes no difference, in this respect, whether the effect is produced by chemical agency or combination; or by the application of discoveries or principles in natural philosophy known or unknown before his invention; or by machinery acting altogether upon mechanical principles. In either case he must describe the manner and process as above mentioned, and the end it accomplishes. And any one may lawfully accomplish the same end without infringing the patent, if he uses means substantially different from those described.⁵⁸

The following excerpt from *Le Roy v. Tatham*⁵⁹ provides another perspective of *Bilski*⁶⁰ foundations:

It is admitted, that a principle is not patentable. A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right. Nor can an exclusive right exist to a new power, should one be discovered in addition to those already known. Through the agency of machinery a new steam power may be said to have been generated. But no one can appropriate this power exclusively to himself, under the patent laws. The same may be said of electricity, and of any other power in nature, which is alike open to all, and may be applied to useful purposes by the use of machinery.

In all such cases, the processes used to extract, modify, and concentrate natural agencies, constitute the invention. The elements of the power exist; the invention is not in discovering them, but in applying them to useful objects. Whether the machinery used be novel, or consist of a new combination of parts known, the right of the inventor is secured against all who use the same mechanical power or one that shall be substantially the same.

A patent is not good for an effect, or the result of a certain process, as that would prohibit all other persons from making the same thing by any means whatsoever. This, by creating monopolies, would

58. *Id.*

59. See generally *Le Roy*, 55 U.S. 156 (cited in 77 subsequent cases).

60. See generally *Bilski*, 130 S. Ct. at 3218.

discourage arts and manufactures, against the avowed policy of the patent laws.⁶¹

*Le Roy v. Tatham*⁶² is but one more example of not simply blind citation, but the repetition and application of the fundamental principles of constitutional law and the role of the court in maintaining relevance and balance through “judicious” application of the principles to each case as they may change over time. The fact that Congress enacts and that the court implements and applies is nothing but the “wizardry” of balance.

B. *KSR International*

The search for a pattern continues with a look at *KSR International Co. v. Teleflex, Inc.*⁶³ *KSR* focused on whether the proposed invention was rendered ineligible for patent protection because it was obvious to those skilled in the arts.⁶⁴ The subject matter under consideration involved the development of an adjustable pedal assembly using a sensor to send digital data to an onboard processor used to record pedal position for the purpose of fuel flow or breaking.⁶⁵ The question was whether this was new or novel.⁶⁶ Prior methods of control involved fixed pedals, rods, or pulleys and even moveable, adapted pulleys.⁶⁷ The question is whether the prior art was such that any person skilled in the art would consider sensors an obvious alternative to mechanical or other functional devices.⁶⁸ If known or obvious, it is not new or novel and not “invention” for the purposes of patent qualification under section 103.⁶⁹ The determination of what is new or novel or obvious is properly the subject of judicial interpretation. It is part and parcel of the judicial function of applying the language of the statute to achieve balance in the fundamental constitutional purpose of protecting private rights and public purpose. The Court cites and quotes from *Graham v. John Deere*

61. *Le Roy*, 55 U.S. at 174-75.

62. *Le Roy*, 55 U.S. 156.

63. See generally *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) (incredibly already cited in 509 decisions).

64. *Id.* at 398-99.

65. *Id.*

66. *Id.* at 400.

67. *Id.* at 409.

68. *Id.* at 400.

69. 35 U.S.C. § 103.

*Co. of Kansas City*⁷⁰ to demonstrate the appropriate standard for “obvious”:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.⁷¹

The district court made the determination that use of sensors as a substitute for other control mechanisms would be anticipated as obvious by one of ordinary skill in the relevant art.⁷² This does not mean one who would be looking for a specific solution, but a standard that would cover anyone who understood the wide range of applications that such control devices could be put to. The meaning of “obvious” is expansive and somewhat variable depending on context as well as the nature of the art under consideration. The notation of the Court in *KSR*, while informative, leaves much to the translation.⁷³ The *KSR* Court teaches:

The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill... a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Following these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement. Often, it will be necessary for a court to look to

70. See generally *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966) (cited in 3244 decisions).

71. *Id.* at 17-18.

72. *Graham v. John Deere Co. of Kansas City*, 216 F. Supp. 272 (W.D. Mo. 1963).

73. See generally *KSR*, 550 U.S. at 398.

interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit... (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.⁷⁴

Perhaps this is a matter where mythology cited below can shed light on reality. Long before the “common law”, there existed a person having but ordinary skill in the arts, which, for the purpose of this parable, may be of use to determine whether the invention was obvious, even though there was, for long times, an apparent reason to combine the known elements in the fashion claimed in the use of known elements to accomplish a task of great utility. Consider the example used by Justice Brennan for both context and reason in deliberating the use of water under pressure to clean a dairy farm floor as proper subject matter for a patent in *Sakraida v. Ag Pro, Inc.*⁷⁵:

Among the labors of Hercules is the following: “Heracles now set out to perform his fifth Labour, and this time his task was to cleanse the stables of Augeas in a single day. Augeas was a rich king of Elis, who had three thousand cattle. At night the cattle always stood in a great court surrounded with walls, close to the king’s palace, and as it was quite ten years since the servants had cleaned it out, there was enough refuse in the court to build up a high mountain. Heracles went to Augeas and asked if he would give him the tenth part of his flocks if he thoroughly cleansed his stables in a single day. The king looked upon this as such an absolutely impossible feat that he would not have minded promising his kingdom as a reward for it, so he laughed and said, ‘Set to work, we shall not quarrel about the wages,’ and he further promised distinctly to give Heracles what he asked, and this he did in the presence of Phyleus, his eldest son, who happened to be there. The next morning Heracles set to work, but even his strong arms

74. *Id.* at 417-18.

75. *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 275-76 (1976).

would have failed to accomplish the task if they had not been aided by his mother-wit. He compelled a mighty torrent to work for him, but you would hardly guess how he did it. First he opened great gates on two opposite sides of the court, and then he went to the stream, and when he had blocked up its regular course with great stones, he conducted it to the court that required to be cleansed, so that the water streamed in at one end and streamed out at the other, carrying away all the dirt with it. Before evening the stream had done its work and was restored to its usual course.⁷⁶

Obviousness in this case is “obvious” to “one skilled with the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed.”⁷⁷ Whether “obvious” is not so obvious in many, if not most other circumstances, is a fundamental question of statutory interpretation and judicial discretion. Some believe that *KSR* is another step in confusing whether “obvious” is a question of fact for the jury, or a matter of law for the Court.⁷⁸ Is it equally obvious that the interpretation of the statute must be accomplished in a manner that serves to protect the inventor, the purpose of reward, the value of the invention, the public benefit and prevent detriment by the expansion of the patent right beyond constitutional direction and statutory language?

III. BLIPS, PARADOXES AND PARAPHRASIES⁷⁹

A. *A Blip and Correction*

As noted in at the outset of this journey, throughout the long years and varied cases considered, there has been respect in deference to Congress, but wisdom and patience in the interpretation of statutory language. There have been a few “blips” along the way and one paradox or paraphrasies. One perspective on the recent decision in *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*,⁸⁰ is simply that it was the

76. *Id.* at 275-76 (quoting C. WITT, CLASSIC MYTHOLOGY 119-20 (1883)).

77. *Id.* at 278.

78. See generally Chris Cotropia, *KSR and the Line Between Fact and Law*, PATENTLY-O BLOG (May 6, 2007, 7:30 PM), http://www.patentlyo.com/patent/2007/05/ksr_and_the_line.html. See also Dennis Crouch, *Judge versus Jury: Who Should Decide the Question of Obviousness?*, PATENTLY-O BLOG (Aug. 19, 2009, 8:59 AM), <http://www.patentlyo.com/patent/2009/08/medela-ag-v-kinetic-concepts-inc-on-petition-for-a-writ-of-certiorari-2009-after-their-success-in-ksr-james-dabney-and.html>.

79. Paraphrasies used in a non-Freudian context. See *infra* note 84.

80. See generally *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005).

remediation of the inapposite adoption of the “Staple Article of Commerce” doctrine borrowed from patent law in *Sony Corp. of America v. Universal City Studios, Inc.*⁸¹ The Court assuaged its sense of deference to statutory language by analogizing copyrights to patent law mindful that creation of both were in the same delegation to Congress under the Constitution.⁸² This simplistic use of the practice of the Court warrants the label “blip” to be put on the case, albeit the decision itself stands as viable. *Grokster* partially righted the use of the “adopted” doctrine by placing emphasis on actual behavior and business practice of the parties, rather than inferences drawn from end user infringements.⁸³

B. *A Paradox*

The singular intellectual property case that stands out as a paradox/paraphraxies⁸⁴ in deviation from the obligation of the Court to consider the constitutionality of legislative enactment in the context of the language used both in the constitution and legislative enactment is *Eldred v. Ashcroft*.⁸⁵ *Eldred* does not, however, stand alone in the flow of cases through history before the Supreme Court that raise questions regarding the issues of the underlying paraphraxies.⁸⁶ Some light may be brought to the case by realizing the conflicts, pressures and competing interests in *Eldred* are not singularly different as “intellectual

81. See generally *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

82. See *Metro-Goldwyn*, 545 U.S. at 913.

83. See generally Reis, *The Sony Legacy: Secondary Liability Perspectives*, *supra* note 26.

84. This is used here in the non-Freudian adaptation of slip of the tongue, misstate or hidden agenda or meaning. What was the real purpose of eliminating “progress” as purpose and limitation on the delegated powers to Congress? Was it to further the protection of vested IP rights without limitation based on consideration of the impact of term extension on public beneficial use? Who represented the public beneficial use in the case and what consideration was given the multiple of amicus briefs filed that raised acknowledged legitimate issues, but were treated as either anecdotal or raised by one without standing in the case. See, for example, further action of the matter in subsequent cases: Note the language of the court in *Golan v. Ashcroft*: “...I agree with Defendant that Plaintiffs’ CTEA claim is foreclosed by the Supreme Court’s holding in *Eldred v. Ashcroft*, *supra*. In *Eldred*, the Supreme Court ruled, on the Petitioners’ claim that Congress exceeded its authority under the Copyright and Patent clause, that the CTEA did not violate the constitutional requirement that copyrights endure for ‘limited Times.’ Although the Petitioners in *Eldred* did “not challenge the ‘life-plus-70-years’ timespan itself...” *Golan v. Ashcroft*, 310 F. Supp. 2d 1215, 1218 (D. Colo. 2004) (citing *Eldred v. Ashcroft*, 537 U.S. 186, 193 (2003)). See also *Golan v. Holder*, 611 F. Supp. 2d 1165 (D. Colo. 2009).

85. *Eldred*, 537 U.S. at 188.

86. See generally *Eldred*, 537 U.S. 186.

property” than for other commons resources, public and private interests and ostensible governmental custodianship.⁸⁷

In the context of cases that have come before and the cases that will be noted hereafter, the question remains: What was the primary purpose of CTEA? Was it because the Congress and the Court believed that extending the copyright term would result in encouraging creative ventures? Was it to honor and pay homage to the efforts of Sonny Bono to secure the copyright term extension on behalf of the powerful entertainment industry? Was it the culmination and final victory for Noah Webster who fought tirelessly to expand the range of his protected rights in his dictionary?⁸⁸ Was it because empirical evidence was provided that reward produced creative ventures? Was it more simplistically to bring the copyright regimes of this country in line with that of others to secure protection for copyrights in other nation states for the benefit of authors?⁸⁹ Was it to protect the economic value of all copyrights of this country because the United States needed those values as a rapidly evolving debtor nation? Was it one of any number or combination of factors, including the power of the entertainment industry’s lobbyists and sense of special status that over the centuries has become the focus of the “intellectual property” clause of the Constitution, rather than a means, an end in itself? There is no answer that either satisfies everyone in this inquiry or “fits all.” It certainly fuels the belief that leads some to think the primary objective was the

87. See generally *The Public Domain*, 66 LAW & CONTEMP. PROBS. 1 (2003), an entire issue devoted to an expansive view of the public domain with some segue to natural resources. See also Scott M. Martin, *The Mythology of the Public Domain: Exploring the Myths Behind Attacks on the Duration of Copyright Protection*, 36 LOY. L.A. L. REV. 253 (2002).

88. There was testimony during the hearing on the copyright reform from any number of interested individuals and groups, including the Register of Copyrights Marybeth Peters. The primary focus of many of these presentations addressed the economic incentives created by the CTEA. Mary Beth Peters proffered that the term extension for copyright of existing works might “. . . provide additional income that would finance the production and distribution of new works.” House Hearings 158. “Authors would not be able to continue to create,” the Register explained, unless they earned income on their finished works. The public benefits not only from an author’s original work but also from his or her further creations. Although this truism may be illustrated in many ways, one of the best examples is Noah Webster[,] who supported his entire family from the earnings on his speller and grammar during the twenty years he took to complete his dictionary. *Eldred*, 537 U.S. at 207.

89. 17 U.S.C. § 302(a). This standard harmonizes the baseline United States copyright term with the term adopted by the European Union in 1993. See Council Directive 93/98/EEC of 29 October 1993, *Harmonizing the Term of Protection of Copyright and Certain Related Rights*, 1993 OFFICIAL J. EUR. COMS. (L290), p. 9 (EU Council Directive 93/98). For anonymous works, pseudonymous works, and works made for hire, the term is 95 years from publication or 120 years from creation, whichever expires first. 17 U.S.C. § 302(c); *Eldred*, 537 U.S. at 195-96.

reconciliation of private rights with international treaties at the expense of the public benefit. If so, why was the century long “belief” that “progress” was a stated goal of the Constitution dismissed as prefatory? If so, why, in light of the contemporary concerns of the Founders to the abuses of monopolies from whence they came, did the Court not continue the metaphor of limited times meaning “short” time before reversion to the public domain. And, why did the Court ignore the notation of *Wheaton* that unless all the requisite acts to justify the purpose of copyright for public use be fulfilled, there should be no copyright lest it should remain forever in the public domain?

The litany of the *Eldred* legacy actually begins with three discrete issues, the first being the threshold question of standing to be heard before the Court.⁹⁰ *Eldred* denied standing to those who did not have a direct economic interest in the subject matter and demeaned individual or collective representation of the public interest.⁹¹

This had been the subject of extended consideration in *Sierra Club*, with the heart of the dispute being the philosophical difference between the majority of the Court and the dissents of Justice Douglas, Justice Brennan, and Justice Blackmun.⁹² The position of the majority denying standing was set forth by Justice Stewart:

... to authorize judicial review at the behest of organizations or individuals who seek to do no more than vindicate their own value preferences through the judicial process... would have us ... do just that.⁹³

Every school boy may be familiar with Alexis de Tocqueville’s famous observation, written in the 1830’s, that ‘scarcely any political question arises in the United States that is not resolved, sooner or later, into a judicial question.’¹ *Democracy in America* 280 (1945). Less familiar, however, is De Tocqueville’s further observation that judicial review is effective largely because it is not available simply at the behest of a partisan faction, but is exercised only to remedy a particular, concrete injury. ‘It will be seen, also, that by leaving it to private interest to censure the law, any by intimately uniting the trial of the law with the trial of an individual, legislation is protected from wanton assaults and from the daily aggressions of party spirit. The

90. *Eldred*, 537 U.S. at 186.

91. See generally Reis, *The Public Beneficial Interest in the Intellectual Commons*, *supra* note 31.

92. *Sierra Club v. Morton*, 405 U.S. 727 (1972).

93. The definition of value preference is demeaning as something “less than” fundamental or recognized as important or accepted.

errors of the legislator are exposed only to meet a real want; and it is always a positive and appreciable fact that must serve as the basis of a prosecution.⁹⁴

Is this not the demeaning of those who profess to raise issues of public interest, without alleging private harm, a denial of the right of every citizen who are the inherent sovereigns in the delegation of powers to the federal government? Is this not that which the majority condoned in *Eldred* to deny the plaintiff standing in the case to raise broader issues than its narrow economic stake in the outcome or subsequent cases on remand from having their day in court?⁹⁵ Is challenging the economic interest of the public domain publishers as a “windfall” similar in import as that of labeling their interest a “value preference to denigrate public interest participation as in *Sierra Club*”?

And, in the flow of constitutional decision making, was not the next element, the excessive deference to Congress and reluctance to assume judicial responsibility for “governance,” in this particular case, distinct from the routine deference in most other cases particularly regarding intellectual property matters? Alexis de Tocqueville was correct in calling this a matter of basic governance. It is a question at the heart of our governance structure of checks and balances for the purpose of protecting the public beneficial interests. The obligations of “checks” and “balances” are not prefatory, they are mandatory. Those rights lie at the heart of the EU human rights requirements, as well as the EU concern to protect competition in pre-legislation review and judicial process.⁹⁶

The dissents of the Justices in *Eldred*, despite their harsh treatment in the majority opinion, confirm the value of the dissent in the judicial process for they highlight and call attention to that which would otherwise pass for the norm.⁹⁷ The litany of dissent concerns can be read as wide ranging, albeit only a few are highlighted here. Fundamental issues of disagreement include: separation of powers and judicial review, abdication of congressional obligation to external

94. *Sierra Club*, 405 U.S. at 739.

95. See *Eldred*, 537 U.S. 186.

96. See generally, Reis, *supra* note 21. One may wonder how this issue escalates from a simple exercise on the implications of cases heard by the Supreme Court during the past decade, but then isn't that the philosophical divide in how one perceives the meaning and intent of Article I, Section 8, Clause 8?

97. The majority opinion interjects points from the two dissents, which shed light on and clarify fundamental disagreement beyond the specific issues of the case, but reflect on the role of the judiciary under separation of powers and the inherent nature and limitations on the delegation of the copyright and patent delegations to Congress. *Sierra Club*, 405 U.S. at 741-60.

standards (the EU), the interpretation of constitutional language regarding purpose, reward, beneficiaries and benefits, the nature and intent of term limits on interests created, the purpose and impact of term limits, the validation of acts of Congress by prior incremental changes either not challenged or of less than paradoxical proportion. These are but a few of many issues singled out as evident in the case and fundamental to an appreciation of the extensive reach of *Eldred*.⁹⁸

Eldred majority:

In sum, we find that the CTEA is a rational enactment; we are not at liberty to second-guess congressional determinations and policy judgments of this order, however debatable or arguably unwise they may be. Accordingly, we cannot conclude that the CTEA—which continues the unbroken congressional practice of treating future and existing copyrights in parity for term extension purposes—is an impermissible exercise of Congress’ power under the Copyright Clause.⁹⁹

Justice Stevens, dissenting¹⁰⁰:

[I]nsofar as the 1998 Sonny Bono Copyright Term Extension Act, 112 Stat. 2827, purported to extend the life of unexpired copyrights, it is invalid. Because the majority’s contrary conclusion rests on the mistaken premise that this Court has virtually no role in reviewing congressional grants of monopoly privileges to authors, inventors, and their successors, I respectfully dissent.¹⁰¹

....

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

98. See *Eldred*, 537 U.S. at 207.

99. *Eldred*, 537 U.S. at 208. This could have been read by the dissents quite differently. “We are not at liberty” [to avoid our constitutional obligations under separation of powers to review acts of congress pursuant to constitutional delegation to ensure compliance with the language and intent thereof.]

100. *Eldred*, 537 U.S. at 222–42.

101. *Id.* at 223.

Cranch 137, 177, 2 L.Ed. 60 (1803). We should discharge that responsibility as we did in *Chadha*.¹⁰²

Justice Breyer, dissenting¹⁰³:

The Constitution's Copyright Clause grants Congress the power to "promote the Progress of Science ... by securing for limited Times to Authors ... the exclusive Right to their respective Writings." Art. I, § 8, cl. 8 (emphasis added). The statute before us, the 1998 Sonny Bono Copyright Term Extension Act, extends the term of most existing copyrights to 95 years and that of many new copyrights to 70 years after the author's death. The economic effect of this 20-year extension—the longest blanket extension since the Nation's founding—is to make the copyright term not limited, but virtually perpetual. Its primary legal effect is to grant the extended term not to authors, but to their heirs, estates, or corporate successors. And most importantly, its practical effect is not to promote, but to inhibit, the progress of "Science"—by which word the Framers meant learning or knowledge, E. Walterscheid, *The Nature of the Intellectual Property Clause: A Study in Historical Perspective* 125-126 (2002).

The majority believes these conclusions rest upon practical judgments that at most suggest the statute is unwise, not that it is unconstitutional. Legal distinctions, however, are often matters of degree. ... And in this case the failings of degree are so serious that they amount to failings of constitutional kind. Although the Copyright Clause grants broad legislative power to Congress, that grant has limits. And in my view this statute falls outside them.¹⁰⁴

The language of the holding, while innocuous and apologetic on its face, appears fully appreciated by Justices Stevens and Breyer as obfuscating the legitimacy of the prior line of term extensions cited to justify the current extension.¹⁰⁵ The impact of prior incidents of extension was relatively modest as was the impact on the total duration of the copyright interest. If there were "alarm" bells for the prior extensions, they were not noted. In this instance, however, the extension and the totality of the copyright duration still ring bells of alarm. Life likewise, the force behind extension, was not external as in this case to bring us into conformity with other nation states.

102. *Id.* at 242.

103. *Id.* at 242-69, app.

104. *Id.* at 242-43.

105. *See Eldred*, 537 U.S. at 222-69.

Rather than follow established rules of statutory and constitutional construction regarding the meaning of words and phrases in the context of where and how they were used, the Court used dictionary definitions, out of context, to emasculate the only two, if not primary, substantive limitations in the delegation under the Constitution to Congress.¹⁰⁶ The collateral damage of this is that “progress” is not considered purpose, but prefatory, and the duration of copyrights extend to life of the author plus 70 years, before reversion and unfettered use in the public domain for two, three or even four generations to come. The coincidence of public benefit and private right may be thought by some diminished to a cliché and the foundation of the new readings an example of fallacious syllogism. The reality may be the uninviting perspective of detriment to the almost uniform consistency of belief in these foundation principles from *Wheaton*¹⁰⁷ to date, rendering the objective of public user illusory.¹⁰⁸

What is the outcome of this view of the decision? Is it that there remains no objective standard to measure legislative enactments under the Constitution? There has been considerable scholarship both in anticipation of and after the *Eldred* case, which sheds light on the meaning of “progress” as “spread” and education, clearly the purpose of the amendment in light of the fact that only twenty powers were requested by the federal government,¹⁰⁹ three of which were the copyright power, the patent power and the power to create a national university—all about education and “spread” of knowledge.

In light of the years of metaphors touting a benefit to the public lying in the unfettered right of use on reversion to the public domain, the term of life of the author plus 70 years may be construed as both “rivalrous” and consumptive, posing an impediment to innovation, progress and public beneficial use.¹¹⁰ Or, perhaps it is all as succinctly noted by Justice Story in *Folsom v. Marsh*¹¹¹:

This is one of those intricate and embarrassing questions, arising in the administration of civil justice, in which it is not, from the peculiar nature and character of the controversy, easy to arrive at any satisfactory conclusion, or to lay down any general principles applicable to all cases. Patents and copyrights approach, nearer than

106. *Id.* at 248.

107. *Wheaton v. Peters*, 33 U.S. 591 (1834).

108. Reis, *supra* note 21.

109. Oliar, *supra* note 21.

110. Reis, *supra* note 21.

111. *Folsom v. Marsh*, 9 F. Cas. 342 (C.C. Mass. 1841).

any other class of cases belonging to forensic discussions, to what may be called the metaphysics of the law, where the distinctions are, or at least may be, very subtle and refined, and, sometimes, almost evanescent.¹¹²

The number of scholars that believe the CTEA legislation should have been ruled unconstitutional is growing larger, albeit already significant: "... a substantial consensus exists within the community of American intellectual property scholars that CTEA is unconstitutional."¹¹³ The perspective of this exercise, however, looks not only to the deviation from the norm in the judicial role of checks and balances, but to the meaning and implications of balance that were considered in the outcome.

IV. STRAWS IN THE WIND: A LIMITED AND LIMITING PERSPECTIVE

What might the purpose or outcome of this article be? That depends on whether there is something to be gained from the perspective of the flow of cases over the years before the Supreme Court. Not everything is lineal or of consequence limited to any of the decisions themselves. There are both intended and unintended consequences of every decision. The use of prior case decision is often the reasoning mode of choice. It is reasonably secure, safe and often with known consequences. This use of precedent, however, often clouds issues, allows miniscule changes in purpose or consequences. Sometimes it is syllogistic, or supports interests that come before the Court to seek protection at the expense of interests that may be in greater need but not be represented.¹¹⁴

The composition of the Court reflects balance and the wisdom of the years. An interesting example lies in the decision of the Court in *Feist Publications, Inc. v. Rural Telephone Service*.¹¹⁵ The decision raised some "eyebrows" and was noted critically for its repetitive references to the Constitution and ensuing constitutional analysis despite, what some believed, "adequate" statutory authority to resolve the matter at hand. There is more than a scintilla of irony to this

112. *Id.* at 344.

113. Samuelson, *supra* note 28.

114. See generally Reis, *The Public Beneficial Interest in the Intellectual Commons*, *supra* note 31. See also Reis, *supra* note 21, to appreciate the process of settlement on individual rights. Consider as well the underlying issues in *N.Y. Times Co. v. Tasini*, 533 U.S. 483 (2001), and *Reed Elsevier, Inc. v. Muchnick*, 130 S.Ct. 1237 (2009) (regarding settlement agreements and representation).

115. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345, 359 (1991).

perception taken in context. The decision was authored by Justice O'Connor, a Justice "of balance" who often bridged the ideologies of the individual Justices, in this case, to speak for a unanimous Court.¹¹⁶ This criticism, however, doesn't address the question of why the Court felt this necessary. Could it be that the Court believed it necessary to assume the role of informing, reminding of bright lines and limitation, of constitutional purpose and of achieving some measure of balance in subject matter, private rights and public user? Or, could it be that lest this citation and discourse some believed, we would otherwise be without standard(s) to understand constitutional purpose, but simply become the metaphysics of Justice Story?¹¹⁷

This never-ending search for standards has historically been the role of the dissenter on the Court, such as Justice Douglas. As one goes through the cases of these past two centuries, there have always been one or more Justices that have performed this role, not to encapsulate the moment, but to bring reason to the judicial role of constitutional balance in interpretation and application.¹¹⁸ Those that have performed this role in the dissent were pronounced "gladiators" by Justice Cardozo who noted "those who disagree with the majority, writing... the dissenter is 'the gladiator making a last stand against the lions.'"¹¹⁹ Some legal analysts believe that dissents are an important part of the system of checks and balances. Justice Charles E. Hughes, Chief Justice from 1930 to 1941, wrote, "A dissent ... is an appeal to the brooding spirit of the law, to the intelligence of a future day, when a later decision may possibly correct the error into which the dissenting judge believes the court to have been betrayed."¹²⁰ And, they have performed this role in concurrence.¹²¹

How many different ways can one, or the collective, come to the same observations before they find their way into the halls of Congress or the chambers of the court? While positioned to supposedly represent the public interest, both Congress and the courts deal with advocates and

116. *Id.*

117. *See supra* note 29.

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

119. FREE ONLINE LAW DICTIONARY, Legal Definition of Dissent, <http://legal-dictionary.thefreedictionary.com/dissent> (last visited Mar. 28, 2011).

120. LAWBRAIN.COM, Dissent, <http://lawbrain.com/wiki/Dissent> (last visited Mar. 28, 2011).

121. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 395-96 (2006) (Stevens, J., Kennedy, J., Souter, J., and Souter, J., concurring). See also Reis, *Rights and Remedies Post Ebay v. MercExchange—Deep Waters Stirred*, *supra* note 26, for an interesting exercise of separation of powers. The Stirring consisted of attacking the use of precedent and practice in injunctions for over 150 years by noting that things right at one point in time may not be in later times and changed circumstance.

the resolution of conflicts. These resolutions themselves bring about changes in balance. There cannot be an absolute constitutional or congressional purpose. Time and balance most certainly changes almost everything. But there cannot be a time when things are so far out of balance that the future itself is threatened. The question is how to measure, observe, determine and ensure sustainable futures. If this view of the Court in the near term and the long term sheds light on anything, it is that the Court's sense of balance remains intact. While Justice Douglas reminds us in *Mazer* “[a]t times the Court has on its own initiative considered and decided constitutional issues not raised, argued, or briefed by the parties,”¹²² the fact is that there has not been one patent or copyright case ruled unconstitutional. *Eldred* does not stand alone. The issue to be taken with *Eldred* is the impact on the future by minimization of the historic perceptions of the pillars of the Constitution—“limited times” and “progress.”¹²³ There are always the constant reminders in dissent of checks, as well as balance in the exercise of discretion by the court that serves to ensure reasoned protections for public rights, constitutional purpose and the intellectual property rights created. There is an ever growing tension, however, between private rights and public purpose. They are not necessarily coincident; they are rivals for intellectual and economic value.

The “spate” of cases that occasioned this exercise evidenced the role of the Court in seeking balance by protecting the future in limiting private rights. In *KSR*¹²⁴ and *Bilski*,¹²⁵ the Court limited patent monopolies to the narrow range of invention proper by application of long held practice in claims construction and general principals “invent”, “discover”, “new”, “novel” and not “obvious.” In *MedImmune*,¹²⁶ the Court found that the licensee does not give up the right to challenge the validity of the patent, a holding respecting the integrity of the patent process and the public interest. In *Quanta Computer, Inc.*,¹²⁷ the first-sale doctrine was in issue and the Court found the doctrine of patent exhaustion limited patent rights that survived the initial sale of the patented subject. In *Tsaini*,¹²⁸ the Court protected the copyright of the author and determined that the provisions of §201(c) of the Copyright

122. *Mazer v. Stein*, 347 U.S. 201, 220 (1954).

123. See *Eldred*, 537 U.S. 186.

124. See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

125. See *Bilski v. Kappos*, 130 U.S. 3218 (2010).

126. *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118 (2007).

127. *Quanta Computer, Inc. v. LG Electronics, Inc.*, 553 U.S. 617 (2008).

128. *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 488 (2001).

Act prohibit publishers from reproducing the author's works in hard copy or electronically without authorization.¹²⁹ The fact that it was properly published in a collection does not carry forward to the individual reproduction. The holding of the Court will likely lead to altered contractual arrangements between free-lance writers and publishers, such as the New York Times.¹³⁰ This was followed by the suit in *Muchnick*,¹³¹ providing that copyright registration was not jurisdictional and a bar to the filing of a copyright infringement action. Likewise, in the administration of justice, balance has been recast to fundamental principles of discretionary remedies of the court. In *eBay*,¹³² the use of injunctive relief when there is "detriment to the public" and in preventing "extortion" in the market place through the legal process by use of remedies.¹³³

The wisdom of balance and understanding the limitations and miscues of intellectual property interests can also be gleaned in cases not listed in the spate precipitating this review. These cases of concern are based on earlier holdings of the Court, and lower court actions that followed.¹³⁴ If one follows the sequence and flow of *Feist*¹³⁵ and *Mazer*¹³⁶ into the context of two more recent lower court cases, one may detect an imbalance in the misuse¹³⁷ of the copyright interest to prevent competition relative to "accidental" art in *Pivot Point*¹³⁸ and art of questionable origin in *Boisson*.¹³⁹ While the court found infringement in *Boisson*, it restored balance by exercising discretion in allowing only proven damages to a single copyright interest of the copyright holder

129. 35 U.S.C. § 201(c).

130. *N.Y. Times*, 533 U.S. at 488.

131. *Reed Elsevier, Inc. v. Muchnick*, 130 U.S. 1237 (2009).

132. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006) (including majority and second concurring opinion).

133. See generally Reis, *Rights and Remedies Post Ebay v. MercExchange—Deep Waters Stirred*, *supra* note 26.

134. Some of the notable ones include *Mazer v. Stein*, 347 U.S. 201 (1954), *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004), *Boisson v. Banian, Ltd.*, 273 F.3d 262 (2d Cir. 2001) (copyright infringement), and *Boisson v. Banian, Ltd.*, 280 F. Supp. 2d 10 (E.D.N.Y. 2003) (damages). The latter two cases likely validate Justice Douglas' instinct that competition, not expression, would rule the rulings of the Court, which one might have thought was forestalled by constitutional reference in *Feist*.

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

136. *Mazer v. Stein*, 347 U.S. 201 (1954).

137. See generally WILLIAM PATRY, *MORAL PANICS AND THE COPYRIGHT WARS* (2010).

138. *Pivot Point*, 372 F.3d 913.

139. See generally *Boisson v. Banian Ltd.*, 273 F.3d 262 (2d Cir. 2001) (finding copyright infringement).

and no attorney fees for either side.¹⁴⁰ Both of the *Boisson* decisions are extensive and revealing of judicial balance. These three decisions taken together may to some validate Justice Douglas' instinct that competition, not expression, would rule the rulings of the court.¹⁴¹

V. IT IS "WIZARDRY" OF BALANCE

Even where there is a questionable congressional or judicial exercise (or non-exercise)¹⁴² of power that causes ripples to the foundations of constitutional interests, there is the ever present possibility of political action or the discretion of the courts seeking balance and rebalance. There is always the thought of relief in Congress for interests in the public commons interests, as there was with environmental issues in the middle of the 20th Century. A review of proposed and enacted legislation might indicate that hasn't happened yet.¹⁴³ There is a distinct difference in perception when reading the entire flow of cases of the past two centuries which may not be appreciated by reading of isolated cases or the published works of some scholars. The difference is one of appreciating the "wizardry" of balance that comes into focus when reading the string of cases from the inception to the present. This exercise spotlights the genius of checks and balances.¹⁴⁴

140. See generally *Boisson v. Banian Ltd.*, 280 F. Supp. 2d 10 (E.D.N.Y. 2003) (ameliorating by damages).

141. Thereby justifying and making one wonder about that which might have thought forestalled by his extended constitutional references in *Feist*.

142. Approaching the decade after *Eldred*, there is a tranquility or peace that prevails no check, but the decisions reflect adaptation to the now "infamous" prefatory language and vast expansion in duration of copyright interests by "balance" which maintains most cases close to the two centuries of interpretation and administration of constitutional interests.

143. Most legislation appears to be directed at increasing private rights, increasing protection of private rights, increasing penalties and the appointment of intellectual property tsars.

144. The first of two significant tests of copyright is likely to come in *Viacom Int'l Inc. v. YouTube, Inc.*, 718 F. Supp. 2d 514 (S.D.N.Y. 2010). This is reflected in the current appeal from the decision of the lower court, specifically focusing on questions concerning the intent and impact of safe harbor provided ISPs under the DMCA. Another imminent challenge regards the role and capacity of the court to resolve conflicts involving the use of new technologies in the intellectual property arena. These issues lie at the heart of the rejection of the Google Book Settlement Agreement by the district court. *The Authors Guild v. Google, Inc.*, No. 05 Civ. 8136 (DC), 2011 WL 986049 (S.D.N.Y. Mar. 22, 2011). The court indicates that the resolution of these issues is a matter for congressional action because of the prospective nature of matters included within the settlement agreement. While the court might well have been able to craft a remedy limited to the parties before it, deferring to Congress to resolve this case may raise issues of the retroactive exercise of the legislative function. The fundamentals and reach of any decision in the case presents a mountain of a quandary. The case requires a resolution of the issues before the court, yet guidance and thus deference to Congress in addressing issues of technologies, private rights and constitutional purpose for the future—assuredly matters of delicate balance.