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THE CONSTITUTIONALITY OF PROPOSED FEDERAL DATABASE PROTECTION LEGISLATION

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I. INTRODUCTION

It has always been clear that individual facts are not copyrightable. An author's literary description (or an artist's depiction) of facts may be the subject of copyright, but the facts themselves are not the "writings" of "authors" for which federal copyright protection is designed.[1] For most of the history of United States copyright law, however, under the so-called "sweat of the brow" doctrine, collections of uncopyrightable facts—often referred to today as "databases"—could seek federal statutory copyright protection. Under that doctrine, one who "expended labor" in the "industrious collection" of facts was considered to be the author of the collection for federal statutory copyright purposes, even though the collection exhibited no "literary skill or originality."[2]

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[1] The Constitution gives 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." U.S. Const. art. I, § 8, cl. 8.

[2] *Jeweler's Circular Publg. Co. v. Keystone Publg. Co.*, 281 F. 83, 88 (2d Cir. 1922). Regarding the early credentials of the "sweat of the brow" theory, *see* George Ticknor Curtis, *Treatise on the Law of Copyright in Books, Dramatic and Musical Compositions, Letters and other Manuscripts, Engravings and Sculpture, as Enacted and Administered in England and America: With Some Notices of the History of Literary Property* 174 (C.C. Little and J. Brown 1847); Eaton S. Drone, *A Treatise on the Law of Property in Intellectual Productions in Great Britain and the United States* 386 (Rothman Reprints 1972). For a summary of the numerous "sweat of the brow" cases decided before the Supreme Court's 1991 decision in *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340 (1991), *see* H.R. Subcomm. and Comm. of Cts. & Intell. Prop. of the Jud. Comm., *Collections of Information Antipiracy Act, Hearings of H.R. 2652*, 105th Cong. [¶ 5] (Oct. 28, 1997) (statement of Professor Jane Ginsburg) (stating that "[t]hroughout the nineteenth and well into the twentieth centuries, U.S. courts consistently recognized copyright protection for labor-intensive works of information, despite these works' low (if any) quotient of creativity"); U.S. Copyright Office, *Report on Legal Protection of Databases* 3-7 (U.S. Govt. Printing Off. Aug. 1997). An influential early case in the United States was *Emerson v. Davies*, 8 F. Cas. 615 (D. Mass. 1845). Justice Story's opinion observed that, under established law:

> [a] man has a right to the copy-right of a map of a state or country, which he has surveyed or caused to be compiled from existing materials, at his own expense, or skill, or labor, or money. Another man may publish another map of the same state or country, by using the like means or materials, and the like skill, labor and expense. But then he has no right to publish a map taken substantially and designedly from the map of the other person, without any such exercise of skill, or labor, or expense.

Id. at 619.

In *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, the Supreme Court rejected the "sweat of the brow" theory as inconsistent with "basic copyright principles."[3] Since facts are not copyrightable, "[c]ommon sense tells us that 100 uncopyrightable facts do not magically change their status when gathered together in one place."[4] Collections of facts, the Court reasoned, could be the subject of copyright only if the collection "possesses at least some minimal degree of creativity."[5] In accord with general copyright principles, the required degree of originality "is extremely low; even a slight amount will suffice,"[6] but the standard of originality nevertheless "does exist"[7]—there must be some creativity involved in the "choices as to selection and arrangement"[8] of factual data for federal statutory copyright to exist in a database.

The *Feist* Court recognized that, in view of the minimal character of the creativity requirement, many factual collections would likely be able to cross the protection threshold.[9] Even more important than the Court's rejection of the "sweat of the brow" theory, therefore, was *Feist*'s accompanying and related holding that, even when the copyright standard of originality is met, the resulting copyright protection for a database is necessarily "thin."[10] A valid database copyright does not protect the uncopyrightable collected data itself, but only the original elements of selection and arrangement that justify the copyright in the first place. Thus,

> [n]otwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement. . . . "No matter

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[3] 499 U.S. at 354.

[4] *Id.* at 345.

[5] *Id.*

[6] *Id.*

[7] *Id.* at 362.

[8] *Id.* at 348.

[9] The plaintiff's collection in *Feist* itself, however, did not. Rural Telephone had published a "garden-variety" white pages telephone directory, containing an alphabetical list of Rural's subscribers and their telephone numbers. This list—the only thing appropriated by Feist Publications—was "devoid of even the slightest trace of creativity." *Id.* at 362. Alphabetizing names was:

> an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course. . . . It is not only unoriginal, it is practically inevitable. This time-honored tradition does not possess the minimal creative spark required by the Copyright Act and the Constitution.

Id. at 363.

[10] *Id.* at 349.

> how much original authorship the work displays, the facts and ideas it exposes are free for the taking."[11]

To make the Court's rejection of "sweat of the brow" jurisprudence even more significant, moreover, the twin holdings of *Feist*—that collections of facts are federally copyrightable only when some originality inheres in their selection or arrangement and that, even when such originality exists, the federal copyright covers only the original selection and arrangement, and not the collection of facts itself—are, said the Court, a "constitutional requirement."[12] This was true because "originality is a constitutionally mandated prerequisite for copyright protection."[13] Thus, not only did *Feist* make "sweat of the brow" an invalid basis for protection under the current Copyright Act, it made it an unavailable basis for protection under any statute that might be enacted pursuant to the Constitution's Copyright Clause.

Justice O'Connor's opinion for a unanimous Court in *Feist*[14] recognized that "[i]t may seem unfair that much of the fruit of the compiler's labor may be used by others without compensation."[15] This apparent unfairness, as well as the damage that *Feist* may do to the continued existence of commercial incentives to produce and publish useful databases, has prompted proposals, in the wake of *Feist*, for new federal legislation. Such legislation would afford protection to producers and publishers of databases against misappropriation of their work product in ways that cause them significant economic harm. Under *Feist*, such legislation cannot be based on Congress's copyright power. The most likely alternative source of legislative power would be Congress's broad authority under Article I of the Constitution to regulate interstate and foreign commerce. This article addresses two constitutional questions that have been raised in connection with such legislative proposals: (1) Does the Court's holding in *Feist* preclude Congress from using its commerce, rather than its copyright, power to provide protection against the unauthorized

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[11] *Id.* at 349 (quoting Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 Colum. L. Rev. 1865, 1868 (1990)).

[12] *Feist*, 499 U.S. at 347.

[13] *Id.* at 351. *Feist* could have been decided solely on the ground that the current federal Copyright Act, which affords copyright protection to "original works of authorship," does not protect purely "sweat of the brow" materials. 17 U.S.C. § 102 (2001). The Court's statements about the limits of congressional power under the Copyright Clause were unnecessary to its decision, as well as inconsistent with the Court's traditional practice of addressing constitutional issues only when it is necessary to do so.

[14] Justice Blackmun concurred in the result.

[15] *Feist*, 499 U.S. at 349.

and commercially unfair appropriation of databases? (2) Even if the Commerce Clause *is* a potential source of affirmative federal power, does the First Amendment prohibit such federal database protection?

II. DOES *FEIST* PRECLUDE CONGRESS FROM USING ITS COMMERCE POWER TO ENACT FEDERAL DATABASE PROTECTION LEGISLATION

The *Feist* opinion states that the Constitution's Copyright Clause cannot be the source of congressional authority to protect the non-original factual elements in databases from being appropriated and reproduced without the authorization of the compiler or publisher.[16] The fact that Congress cannot enact legislation on a certain subject pursuant to one of the several powers delegated to it in the Constitution, however, does not ordinarily mean that it is not able to enact the legislation by exercising a different delegated power more appropriate to the subject at hand. Article I, section 8 is a list of affirmative powers given to Congress in order to enable it to serve a number of different governmental purposes. If a power given to Congress in order to serve a particular constitutional purpose does not authorize certain federal legislation, there is ordinarily no reason why a different power, designed to serve a different purpose, may not authorize the legislation instead.

Perhaps the most well known twentieth century illustration of this basic structural constitutional principle concerns Congress's efforts to prevent racial discrimination in privately owned places of public accommodation, such as railroads, hotels, and restaurants. In the *Civil Rights Cases*,[17] the Supreme Court held that Congress could not prohibit such racial discrimination through its delegated affirmative legislative power to enforce the provisions of the Fourteenth Amendment because that Amendment prohibits only governmental discriminatory action, not discrimination by the owners of private businesses. In 1964, however, the Court held, without overruling the *Civil Rights Cases*, that Congress can prohibit racial discrimination in the very same privately owned places of public accommodation pursuant to its power to regulate interstate commerce (so long as the discrimination significantly affects commerce).[18] The state-action limitation on the subjects that Congress can regulate under its delegated Fourteenth Amendment enforcement power does not limit

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[16] *Id.* at 346.

[17] 109 U.S. 3, 24-25 (1883).

[18] *See Heart of Atlanta Motel, Inc. v. U.S.*, 379 U.S. 241, 277-79 (1964); *Katzenbach v. McClung*, 379 U.S. 294, 304-05 (1964).

Congress when it has a basis for exercising its separately delegated commerce power.

As the civil-rights example shows, each of Congress's delegated legislative powers stands on its own. The several powers are cumulative and often overlapping. The limits that the Constitution places on the subjects that may be treated under one power do not ordinarily apply to limit the subjects that may be treated under another power designed for a different purpose.[19] The Supreme Court has, moreover, repeatedly emphasized the breadth and plenary nature of the federal regulatory authority to deal with commercial matters under the commerce power.[20] Under ordinary principles, therefore, the commerce power would clearly seem to authorize federal protection of factual databases that move in or otherwise substantially affect interstate or foreign commerce, even though such databases are not the original writings of authors protectable under the copyright power.

Opponents of federal database protection legislation have at times invoked the Supreme Court's decision in *Railway Labor Executives' Association v. Gibbons*[21] as contradicting this general structural principle and indicating that limits imposed on the subjects that may be regulated under one congressional power *do* apply to legislation sought to be based upon a different power. In *Gibbons*, the Court held a federal bankruptcy law unconstitutional because it violated the requirement in the Constitution's Article I Bankruptcy Clause that federal bankruptcy laws be uniform throughout the United States.[22] The Court's opinion included the following statement:

> We do not understand either appellant or the United States to argue that Congress may enact bankruptcy laws pursuant to its power under the Commerce Clause. Unlike the Commerce Clause, the Bankruptcy Clause itself contains an affirmative limitation or restriction upon Congress'[s] power: bankruptcy laws must be uniform throughout the United States. Such uniformity in the applicability of legislation is not required by the Commerce Clause. . . . Thus, if we were to hold that Congress had the power

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[19] For examples of congressional action under an alternate power, review *supra* notes 17-18 and the accompanying text.

[20] *See e.g. Civil Rights Cases*, 109 U.S. 3 (1882); *Currin v. Wallace*, 306 U.S. 1 (1939); *Gibbons v. Ogden*, 22 U.S. 1 (1824); *Prudential Ins. Co. v. Benjamin*, 328 U.S. 408 (1946).

[21] 455 U.S. 457 (1982).

[22] *Id.* at 468-69. Article I, section 8, clause 4 of the United States Constitution, the so-called Bankruptcy Clause, provides that "Congress shall have Power . . . To establish . . . uniform Laws on the subject of Bankruptcies throughout the United States."

> to enact nonuniform bankruptcy laws pursuant to the Commerce Clause, we would eradicate from the Constitution a limitation on the power of Congress to enact bankruptcy laws.[23]

Opponents of database protection legislation have relied on this statement to argue that, if Congress cannot use its commerce power to enact nonuniform bankruptcy legislation that could not be enacted under the Bankruptcy Clause, it similarly cannot use its commerce power to enact database protections that, after *Feist*, cannot be enacted under the Copyright Clause.[24] This argument misunderstands the *Gibbons* opinion. The basis for *Gibbons* was the Supreme Court's express holding that the legislation challenged in that case *was*, in fact, federal bankruptcy legislation.[25] As bankruptcy legislation, the Constitution required that it be uniform. This principle is fully applicable to the Copyright Clause, which contains the limitation that federal copyright legislation offer protection for only a limited time. That application, however, does not cast doubt on the use of the Commerce Clause to enact database protections. Under *Gibbons*, Congress cannot use its commerce power to give copyright protection for an unlimited time, just as it cannot use the commerce power to enact bankruptcy legislation that is not uniform. *Feist*, however, holds that the data in databases are not, and never have been, the proper subjects of copyright. Database protection legislation, *i.e.*, legislation that protects non-copyrightable data against unfair and destructive commercial practices, is, therefore, *not* copyright legislation. *Gibbons*, which rests its decision on the Court's express holding that the legislation in that case was bankruptcy legislation (and therefore had to be treated as bankruptcy legislation for constitutional purposes), simply does not apply. Database protection legislation is not copyright legislation and it need not be treated as if it were.

The inapplicability of *Gibbons* to the database situation is also shown, I think, if we ask whether the limits on the subjects that Congress can regulate under the Commerce Clause should apply to its uses of its copyright powers. The Commerce Clause does not authorize Congress to regulate matters that have no connection to interstate or foreign commerce. That plainly does not mean, however, that Congress cannot use its copyright powers to regulate materials that have no connection to interstate or foreign commerce. Congress certainly can use those powers, even where

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[23] 455 U.S. at 468-69.

[24] *See e.g.* Yochai Benkler, *Constitutional Bounds of Database Protection: The Role of Judicial Review in the Creation and Definition of Private Rights Information*, 15 Berkeley Tech. L.J. 535, 546 (2000).

[25] 455 U.S. at 468.

commerce may not be affected. The limitations on the subjects that Congress can regulate under the Commerce Clause plainly do not limit the subjects that Congress can regulate under other Article I powers that authorize Congress to act whether or not commerce is affected. Presumably, the analysis applies in the opposite direction as well: the fact that unoriginal factual compilations do not fall under the copyright power does not mean that they cannot be protected through the commerce power, when the conditions for the exercising of that power are present.[26]

In considering whether *Feist* limits Congress in exercising its commerce power, it is also relevant to consider several important pre-*Feist* decisions of the Supreme Court that relate quite directly to the issue. Most directly on point are the *Trade-Mark Cases*,[27] where the Supreme Court held that Congress had no constitutional authority under the Copyright Clause to enact an 1870 federal trademark law. The Court's decision (like the Court's decision in *Feist*) was based on its holding that trademarks were not sufficiently "original" to qualify as copyrightable writings.[28] The Court went on to say, however, that Congress *might* enact a valid trademark law under the Commerce Clause, so long as the legislation was limited to protecting trademarks used in interstate or foreign commerce.[29] Congress eventually did enact a series of Commerce Clause-based trademark laws, and no one—including those who oppose federal database protection legislation on constitutional grounds—has seriously questioned Congress's authority to do so.

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[26] Viewed in the context of the breadth of the Commerce Clause power, as interpreted today, one may perhaps be tempted to give the Copyright Clause the unprecedented function of limiting Congress in the exercise of its other powers because the Copyright Clause may otherwise seem to serve no useful purpose. Almost all inventions and writings today have some relationship to interstate commerce. It is likely, therefore, that, under today's broad commerce power jurisprudence, Congress could enact broad patent and copyright legislation, even if the Constitution included no Copyright or Patent Clause. The Copyright Clause, one might therefore think, must be intended to serve some limiting purpose, for it is largely or completely unnecessary as an affirmative source of power.

The problem with this line of thinking is that the relationship of writings and inventions to interstate and foreign commerce was not as close or as comprehensive in 1789 as it is today, nor did the Constitution's Framers necessarily anticipate the broad uses of the federal commerce power that the Supreme Court has permitted since the Constitution's ratification. In 1789, the Framers likely believed, therefore, that the Copyright Clause might well be needed to permit Congress to provide meaningful copyright and patent protection for many materials with a limited (if any) direct connection with interstate or foreign commerce, as then defined. The Copyright Clause clearly served an important affirmative purpose when it was written. Its possible redundancy today is not a reason for attributing to it a limiting effect that was not part of its original function.

[27] 100 U.S. 82 (1879).

[28] *Id.* at 94.

[29] *Id.* at 97.

In 1918, the Supreme Court decided another very well known case that also seems flatly inconsistent with the idea that the post-*Feist* Copyright Clause prevents Congress from using its commerce power to protect non-copyrightable databases from misappropriation. In *International News Service v. Associated Press*,[30] the Supreme Court affirmed a lower federal court injunction against the International News Service ("INS"), prohibiting it from appropriating facts taken from news bulletins issued by the Associated Press ("AP") or its members, and selling that news to INS's clients.[31] The Court expressly assumed, as *Feist* later held, that the facts of the news were not copyrightable. The Court nevertheless held that protecting AP against INS's copying was proper as a matter of "unfair competition in business."[32]

The *INS* case was decided as a matter of judge-made law during the regime of federal common law. Although the issue of Congress's power to provide protection for noncopyrightable factual material was therefore not before the Court in that case, it seems inconceivable that the Court would have found Congress to be constitutionally precluded from providing protection in circumstances where a federal equity court was not. Indeed, although Justices Holmes and Brandeis dissented in *INS*, they specifically stated that they did so, not because of any negative emanations of the Copyright Clause, but because they did not believe that existing common-law principles justified a court in giving relief to AP in the absence of legislation.[33] So far as one can tell, the whole Court in *INS* would clearly have approved the constitutionality of federal legislation preventing INS from unfairly appropriating AP's noncopyrightable work product.

Supreme Court cases dealing with federal preemption of state misappropriation laws also indicate that the Copyright Clause does not limit Congress's ability to use the commerce power to protect noncopyrightable materials. In *Kewanee Oil Company v. Bicron Corporation*,[34] for example, the Court upheld the right of states to offer protection to noncopyrightable and nonpatentable trade secrets. The Court said that, "[t]he only limitation on the States is that in regulating the area of patents and copy-rights [sic] they do not conflict with the operation of the laws in this area passed by Congress . . . ."[35] If it is thus up to Congress to decide whether or not to allow state protection for noncopyrightable trade

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[30] 248 U.S. 215 (1918) ("*INS*").

[31] *Id.* at 241.

[32] *Id.* at 240.

[33] *Id.* at 248, 253-54.

[34] 416 U.S. 470 (1974).

[35] *Id.* at 479.

secrets, Congress certainly would not seem to be precluded from offering the same protection itself to businesses affecting interstate commerce—an area in which Congress has plenary legislative power.[36] The same conclusions ought to apply to noncopyrightable facts.[37]

In her opinion for the Supreme Court in *Feist*, Justice O'Connor included some statements that seem on their face to be at odds with the foregoing conclusions. In addition to the statement, quoted above, that much of the fruit of a compiler's labor "may be used by others without compensation," the *Feist* opinion also states that facts "may not be copyrighted and are part of the public domain."[38] Opponents of database protection legislation sometimes interpret these dicta as indicating the Court's view that Congress has no power to use its Commerce Clause authority to protect databases from commercially unfair misappropriation. Such an interpretation, however, would make *Feist*'s dicta flatly inconsistent with the Supreme Court's decision in *INS*, since that case did exactly that—it protected noncopyrightable facts from unfairly competitive unauthorized copying. The *Feist* opinion, moreover, cites *INS* with approval.[39] The dicta would also be inconsistent with the *Feist* opinion's approving quotation of a passage from *Nimmer on Copyright*, stating that "[p]rotection for the fruits of [factual] research . . . may in certain circumstances be available under a theory of unfair competition."[40] A broad interpretation of *Feist*'s statements would also conflict with the *Trade-Mark Cases* and with the Supreme Court's decision in *Kewanee Oil*. It would, in addition, be inconsistent with the Court's decisions in *Zacchini v. Scripps-Howard Broadcasting Co.*,[41] which upheld state protection for an uncopyrightable "human cannonball" act,[42] and *San Francisco Arts &*

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[36] *See U.S. v. Moghadam*, 175 F.3d 1269, 1282 (11th Cir. 1999) (upholding federal "bootleg" record legislation, 18 U.S.C. § 2319A (1994), protecting noncopyrightable live (nontangibly-fixed) musical performances from unauthorized reproduction).

[37] It is important to distinguish between protections that Congress has, through its statutory preemption power, forbidden states to provide, and protection that Congress may or may not decide to provide itself on a nationwide basis. The fact that Congress may have decided to preclude state protection of a certain kind does not mean that Congress is precluded from offering that protection itself through federal legislation. Limits that cases like *Natl. Basketball Assn. v. Motorola*, 105 F.3d 841 (2d Cir. 1997), have placed on state protection of factual materials as a matter of federal statutory preemption do not apply to limit Congress, should it choose to enact its own federal protection of such materials.

[38] 499 U.S. at 348-49 (citing *Miller v. Universal Studios*, 650 F.2d 1365, 1369 (5th Cir. 1981)).

[39] 499 U.S. at 353.

[40] *Id.* at 354 (quoting Melville Nimmer & David Nimmer, *Nimmer on Copyright* § 3.04 (1978)).

[41] 433 U.S. 562 (1977).

[42] *Id.* at 570.

Athletics, Inc. v. United States Olympic Committee,[43] which upheld a federal statute granting exclusive use of the uncopyrightable word "Olympic" to the U.S. Olympic Committee.[44] It seems unlikely that the Court's *Feist* dicta, in a case that directly involved only the protection offered by the Copyright Act, meant summarily to jettison all of this precedent.

A more plausible reading of the *Feist* statements is suggested by the Court's recognition that protection might be available to facts under a theory of unfair competition. The Court in *Feist* meant to say, I think, that it is only as a matter of *copyright law* that facts are in the public domain and may be copied at will. The *Feist* statements should probably be taken to mean that *copyright* is not available for unoriginal collections of facts because the protection of such material does not fall within the limited purpose of the Copyright Clause, which is to encourage and reward artistic originality. The fact that the *copyright* power has this limited purpose, however, does not mean that Congress may not use a different legislative power for a different legislative purpose—that of preventing unfair and harmful business practices that adversely affect interstate commerce. *Feist* thus accepts the decision in *INS*, and approves of Nimmer's reference to a theory of unfair competition, because protection against misappropriation in cases like *INS* and in the circumstances referred to by Nimmer was not meant to reward or encourage originality or creativity, but was meant to prevent unfair business practices—protection that does not turn on the presence of copyrightability.

III. DOES THE FIRST AMENDMENT PROHIBIT CONGRESS FROM ENACTING FEDERAL DATABASE PROTECTION LEGISLATION

Whether or not federal database protection legislation would violate the First Amendment depends in very large part upon the scope of the prohibitions contained in that legislation. Some uses of published databases are undoubtedly strongly protected by free expression principles, so that any statutory prohibition on those uses would be of dubious constitutionality. It would almost certainly be unconstitutional, for example, if Congress were to attempt to prohibit scholars or news reporters from doing research in published databases, or from extracting and using individual facts from those collections in their own writings and publications. A database statute that limited its protection to prohibiting entities in commerce from duplicating competitors' entire databases and

[43] 483 U.S. 522 (1987).

[44] *Id.* at 539.

selling them in competition with the original database compilers, on the other hand, might well meet a different fate in most of its applications. It is doubtful whether such unauthorized wholesale mechanical piracy of another's work product qualifies for First Amendment protection at all. Even if it does, free expression rights are not absolute and the government's interest in preventing destructive or otherwise unfair methods of business competition in commerce might well be a constitutionally permissible justification for a statutory prohibition.

Without the enactment of a specific piece of federal database protection legislation, it is difficult to reach any firm First Amendment conclusions. In what follows, I first describe what seem to me to be the governing First Amendment principles that would likely be applied to federal database protection legislation, should Congress enact such legislation, and then apply those principles to the main elements of a specific proposed federal statute that, although not yet enacted, was favorably reported on by the House of Representatives Judiciary Committee in 1999.

In deciding free expression issues, the Supreme Court has in recent years clearly distinguished between legislation that seeks to suppress certain viewpoints or the discussion of certain topics, which will be sustained only in the presence of an extremely high level of governmental justification, and other legislation that is not enacted for the purpose of suppressing expression, that is content and viewpoint neutral, that does not favor or disfavor any point of view or any topic, and that does not completely foreclose the use of any medium of expression. Restrictive legislation of the latter sort is currently subjected to what is often described as an "intermediate" level of constitutional scrutiny, a level that requires that the legislation further a "substantial governmental interest" in a way that is "narrowly" drawn to further that interest.[45]

Application of the intermediate-scrutiny standard may explain the long recognized constitutional validity of content neutral copyright laws.[46] It may also explain the constitutionality of other content neutral anti-misappropriation restrictions, such as the protection that has been given by

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[45] *See e.g. S.F. Arts & Athletics, Inc.*, 483 U.S. at 535-37; *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 450 (2d Cir. 2001). At the time *San Francisco Arts* was decided, intermediate scrutiny required that the restriction be "no greater than is essential" to further the government's interest. The Supreme Court changed the "intermediate" scrutiny test two years later to require reasonably "narrow tailoring," rather than legislative use of the "least restrictive" alternative. *Ward v. Rock Against Racism*, 491 U.S. 781, 797-98 (1989); *see Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622, 662 (1994).

[46] As suggested above, laws, like copyright laws, insofar as they prohibit the wholesale mechanical piracy of *someone else's* expression may, in fact, call for no First Amendment scrutiny at all.

statute and common law to trademarks and trade secrets, the statutory and common-law protection for uncopyrightable (because unfixed in tangible form) performances, and the protection given by *INS* against competitive appropriation of uncopyrightable facts. All of these are content neutral misappropriation restrictions that can be seen as being narrowly tailored to serve substantial governmental interests.

The constitutional inquiry does not always end, however, with the conclusion that a statutory or common-law restriction is constitutional on its face. Some expression may be found to be so valuable in particular circumstances that even a facially valid restriction may not be able to be applied in some contexts. One such situation may have been present in the Supreme Court's decision in the well-known Pentagon Papers case, *New York Times Co. v. United States*,[47] which gave constitutional protection to the publication of material obtained in violation of presumably constitutional national-security restrictions.[48] The Supreme Court's more recent decision in *Bartnicki v. Vopper*[49] may also illustrate this point. *Bartnicki* involved a radio commentator's violation of a federal statute prohibiting the disclosure of the contents of an illegally intercepted electronic communication.[50] Even though the disclosure violated the federal statute, and even though the Court recognized the general validity of that statute, the Court held that the strong public importance of the contents of the wiretap required a holding that the commentator's particular broadcast was protected by the First Amendment.[51] A facially valid database protection statute might similarly warrant an "as applied" First Amendment challenge in circumstances in which the public's need for information is particularly strong and in which application of a database protection statute would frustrate that interest.

Federal database protection legislation might be drafted in a number of different ways. Among the most important variables are the decision about which databases to protect, the description of the conduct that will be deemed to constitute a misappropriation of protected databases, and the exceptions to statutory protection that may be included in order to avoid unnecessary interference with free-expression values. The application of the First Amendment to a particular piece of database legislation will depend to a very large extent on the choices that the legislation makes on these subjects. To best understand the First Amendment issues, it is useful

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[47] 403 U.S. 713 (1971).

[48] *Id.* at 714.

[49] 532 U.S. 514 (2001).

[50] *Id.* at 519-20.

[51] *Id.* at 535.

to focus upon a particular database protection proposal. The following analyzes the main provisions of H.R. 354, the Collections of Information Antipiracy Act,[52] a bill that was reported on favorably by the House Judiciary Committee in May, 1999, but not enacted.[53]

H.R. 354 sought to protect the investment of businesses in commercially valuable databases from unauthorized use of the databases that might unfairly damage or destroy that investment. Thus, only databases gathered, organized, or maintained "through the investment of substantial monetary or other resources" would have been protected, and this protection would have applied only against unauthorized use of all or a substantial part of the investor's product in a way that caused "material harm" to the investor's market.[54] The apparent rationale for providing protection was the fact that databases, though often enormously expensive to produce, may be relatively easy and inexpensive to copy. If wholesale appropriation is permitted, that reproduction, made without the cost and effort necessary to produce the original database, will often be able to capture or divert a significant part of the market for the original collection. If those who create databases thus become unable to obtain a financial return on their investments of effort and resources, much of the incentive to produce those potentially valuable products will be removed.

If enacted, H.R. 354 would thus have served the federal governmental interest in encouraging the creation of useful databases by protecting the

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[52] H.R. 354, 106th Cong. (1999).

[53] *See* H.R. Rpt. 106-349, at pt. 1 (Sept. 30, 1999). Also introduced in, but not enacted by, the 106th Congress was H.R. 1858, 106th Cong. (1999), approved by the House Committee on Energy and Commerce in 1999. Unlike H.R. 354, which was designed broadly to protect investment in databases against unauthorized uses that cause material market harm, H.R. 1858 would have provided protection only against unauthorized commercial uses that were "in competition" with the protected database. H.R. 1858, 106th Cong. at § 102. H.R. 1858 also would have protected only against *duplication* of another's database, *id.*, as contrasted with H.R. 354's prohibition of unauthorized use of "all or a substantial part" of a protected database. H.R. 354, 106th Cong. at § 1402. Like H.R. 354, H.R. 1858 would not have protected individual facts, would not have interfered with the independent collection of protected data, and contained exceptions for news reporting use and for scientific, educational, and research uses. H.R. 354, 106th Cong. at § 1403; H.R. 1858, 106th Cong. at § 103. H.R. 1858, however, would not have protected legal materials (court opinions, statutes, and regulations) unless those materials were permanently available, without charge, in electronic form. H.R. 1858, 106th Cong. at § 104. Also, unlike H.R. 354, H.R. 1858 contained no general exception for unauthorized "fair uses," nor did it contain a limited term of protection. H.R. 354, 106th Cong. at §§ 1403, 1409.

The lack of a general fair use provision and limited term might make H.R. 1858 more vulnerable than H.R. 354 to a facial First Amendment challenge, although the relatively narrow scope of H.R. 1858's protection might counteract these omissions. In addition to H.R. 354 and H.R. 1858, there are various other formulations of database protection that could meet constitutional standards. A choice by Congress among these proposals should focus on factors such as the scope and adequacy of the protection and the appropriateness of the statutory exclusions.

[54] H.R. 354, 106th Cong. at § 1402.

investment of their compilers. This apparently substantial governmental interest is both content and viewpoint neutral, and related to a desire to encourage, rather than inhibit, the expansion of knowledge. The remaining constitutional question under "intermediate" scrutiny is whether the legislation's restrictions are narrowly tailored to its legitimate objectives, so as not to interfere unnecessarily with the use of database information. Two features of H.R. 354 seem particularly relevant in this regard. First, H.R. 354 would have conferred no informational monopoly on the first person or entity to compile and publish information on a particular subject—others would have remained completely free to collect and publish the same or similar information so long as they acted independently.[55] Second, when databases would have been protected from unauthorized reproduction by H.R. 354, that protection would not have extended to "individual item[s] of information, or other insubstantial part[s] of a collection of information, in itself."[56] Protection would have applied only to unauthorized appropriation of all or a substantial part of the database, and that appropriation would also have had to be shown to interfere with the original compiler's commercial market. These limits would have minimized—and in most situations would have completely removed—the possibility that the legislation, if enacted, would have interfered significantly with scientific research, or with public discussion of political and social issues. H.R. 354 would also have limited its protection to a 15-year term.[57]

H.R. 354 contained a number of additional explicit exceptions apparently designed to serve the same free-expression-protective purpose. These included a general "reasonable-use" exception for unauthorized uses such as criticism, research, and analysis (available to for-profit and non-profit entities alike), an exception for nonprofit educational, scientific, and research uses that do not harm the investor's primary market, and an exception for uses for the purpose of verifying independently-gathered information.[58] Perhaps most importantly, the bill expressly permitted use of information from protected databases "for the sole purpose of news reporting on any subject (including news gathering, dissemination, comment, and feature or general interest reporting)" unless the information

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[55] *Id.* at § 1403(d). As discussed below, in those limited instances where the information could not be obtained independently, an "as applied" attack would be potentially available to protect First Amendment interests.

[56] *Id.* at § 1403(c).

[57] *Id.* at § 1409(c).

[58] *Id.* at § 1403.

was (as it was in *INS*) time sensitive and used as part of a consistent pattern of direct competition with the party seeking protection.[59]

Had H.R. 354 been enacted, these limitations and exceptions would likely have conformed the legislation to the constitutional requirement that statutory protection be narrowly tailored to serve a content neutral governmental purpose. First Amendment values would seemingly have been implicated only in the situation where a database would have contained information of public concern, where the relevant information constituted all or a substantial part of the database, where the information was not available from any other source, and where an unauthorized use of the information would have materially damaged the market value of the database. Such a situation would be likely to arise rarely, if ever. If it did, a challenge to the statute as applied to the facts of the particular case might well succeed, as it did in the Supreme Court's decision in *Bartnicki*.[60] If so, the defendant would be insulated from liability, but the overall validity of the legislation would not be affected.

IV. CONCLUSION

Neither the Copyright Clause nor the First Amendment stand as a barrier to Congress, should it wish to use its Commerce Clause authority to enact legislation protecting the investment in informational databases by prohibiting their wholesale unauthorized duplication in ways that unfairly cause commercial harm to the initial compiler.[61]

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[59] *Id.* at § 1403(f).

[60] 532 U.S. 514; *see supra* nn. 49-51 (discussing *Bartnicki*).

[61] Authorities on copyright law have reached a similar conclusion in the wake of the Supreme Court's decision in *Feist*. *See* Nimmer, *supra* n. 40, at § 1.01 [B][2][b] (stating that "[i]f Congress wished to pass a law protecting industrious compilations of facts, the experience of the twentieth century would lead one to doubt the efficacy of a constitutional challenge"); Paul Goldstein, *Copyright and Legislation: The Kastenmeier Years*, 55 L. & Contemp. Probs. 79, 88 (1992) (arguing that "the Supreme Court in *Feist* was [not] saying that the great and socially valuable investments made in databases not rising to the announced originality standard must go unprotected *by intellectual property law*"(emphasis added)); Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information after Feist v. Rural Telephone*, 92 Colum. L. Rev. 338, 387-88 (1992).