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My thanks to Timothy Shin, Kevin Waterson, and Brisette Gantt for research assistance. Over the years, my understanding of the issues surrounding extra-copyright protection of databases has profited from discussions with Yale Braunstein, Jane Ginsburg, Marci Hamilton, Peter Jaszi, Brian Kahin, Christopher Kelly, Michael Keplinger, Bruce Lehman, Anthony Miles, Marc Pearl, J.H. Reichman, Pamela Samuelson, Alain Strowel, and Paul Uhlir. I have learned much from them; the remaining errors are the exclusive intellectual property of the author.

HOW EXTRA-COPYRIGHT PROTECTION OF DATABASES CAN BE CONSTITUTIONAL

Justin Hughes[*]

I. INTRODUCTION

When a law professor gives an analysis of what the law is, especially with Constitutional law, quite often the professor is telling us what he or she *wants* the law to be. This melding of descriptive and normative is inherent in what we do because the law is a persuasive endeavor. Pronouncements of what the law *is*, coated in objective-sounding language, may succeed in affecting what the law *will be*. Werner Heisenberg demonstrated that one cannot take measurements on the spin or trajectory of a subatomic particle without affecting the spin or trajectory of that particle. The same connection between observer and observed exists with social phenomena. Every observation and report on the social institution of law affects, in ways large and small, the trajectory of the law.

When it comes to legal protection of databases beyond the limited protection copyright law offers, several scholars have argued forcefully that many forms of such extra-copyright database protection would be unconstitutional.[1] This conclusion is always well reasoned from existing precedent, but is also usually tied to the commentator's personal beliefs as to the proper arrangement of law and civic society. Indeed, there has been a dependable convergence of policy views and constitutional opinions

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[1] *See e.g.* Yochai Benkler, *Constitutional Bounds of Database Protection: The Role of Judicial Review in the Creation and Definition of Private Rights in Information*, 15 Berkeley Tech. L.J. 535, 575 (2000); William Patry, *The Enumerated Powers Doctrine and Intellectual Property*, 67 Geo. Wash. L. Rev. 359, 360 (1999); Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment*, 17 Cardozo Arts & Ent. L.J. 47, 90 (1999). Professor Pollack happily (and refreshingly) recognizes that she is a "dedicated low protectionist" and that her "hopeful reading of dicta is no more authoritative than a high protectionist's opposite jump into the unknown." *Id.* at 77. For more balanced analyses, *see* Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Restraint on Congress*, 2000 Ill. L. Rev. 1119, 1197 (2000); Memorandum from William Michael Treanor, Deputy Assistant Attorney General, Office of Legal Counsel, Department of Justice, to William P. Marshall, Assoc. White House Counsel, *Constitutional Concerns Raised by the Collections of Information Antipiracy Act, H.R. 2652* <http://www.acm.org/USACM/copyright/doj-hr2652-memo.html> (last updated July 28, 1998) ("OLC Memorandum").

through the discussions in the last few years. Those who believed that database protection in the original form of the 1998 and 1999 bills was needed as a policy matter had little question that the proposals were constitutional. Those most opposed to the bill on policy grounds were also convinced that such legislation could not pass constitutional muster. Occasionally, a commentator not directly involved in the debates would peer in and deem the constitutional questions to be "a fair issue for future debate."[2]

Like that commentator, I am agnostic on this topic. (I also admit that, rhetorically speaking, it would be to my benefit to *claim* to be agnostic.) Given the Supreme Court's pronouncements to date, I believe that there are substantial arguments to support the constitutionality of many forms of extra-copyright protection of databases and that there are substantial arguments against the constitutionality of many forms of such protection. Part II outlines the most important of those Supreme Court pronouncements—1991 *Feist Publications v. Rural Telephone Service* case[3]—and the subsequent decade of political gyrations to establish post-*Feist* legal protection of large, comprehensive databases.

Part III describes how extra-copyright protection of databases at the federal level must navigate the conflicting gravitational forces of Congress' broad ability to control interstate commerce under the Commerce Clause and Congress' limited ability to establish intellectual property at the federal level through the specifically enumerated power of Article I, section 8, clause 8. A rational actor trying to enact database legislation that the Supreme Court would uphold would want to pay close attention to the misappropriation doctrine as enunciated in the Court's 1918 decision in *International News Service v. Associated Press*.[4]

A second hurdle for extra-copyright protection of databases (federal or state) is the First Amendment. Some writers have posited that extra-copyright protection of databases would be unconstitutional because of our need to protect a broad information commons, rights of autonomy, or a *right to know* grounded in the First Amendment. Such theories are bold and broadly painted—probably too broadly to gain traction with the present Court. Part IV explores two mistakes that have appeared in such First Amendment critiques of database protection—one mistake as to what is being protected and one mistake as to the nature of information. Part III describes how there *are* First Amendment concerns about extra-copyright

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[2] Jon O. Newman, *New Lyrics for an Old Melody: The Idea/Expression Dichotomy in the Computer Age*, 17 Cardozo Arts & Ent. L.J. 691, 703 (1999).

[3] 499 U.S. 340 (1991).

[4] 248 U.S. 215 (1918).

database protection, but they are real, not epic; substantial, not insurmountable.

Part V addresses the question of a database law at the state level. The analysis here is largely derivative on the discussion in Parts III and IV. Once state law is judged against the requirements of the First Amendment—the same as with a federal law—the analysis focuses on the problem of preemption. Preemption of a state law creating extra-copyright protection of databases is a two-step process. First, there is analysis under section 301 of the Copyright Act, which describes the kinds of state laws Congress expressly intended federal copyright law to preempt. Second, there is a more general preemption to ensure that the state law is not impinging upon the operation of federal laws or policies, an analysis that dovetails with Part III. This comes with an important caveat: the same Constitutional strictures that constrain what Congress can do in this area may not similarly constrain the states.

Part VI sketches the elements of a database law that would likely pass constitutional muster. Such a law might be constitutional while protecting more–somewhat more–than jurists and commentators have reckoned.

This article attempts to use neutral and complete language, at least as much as the reader can be expected to bear and at least until a concept is thoroughly introduced and shorthand phrasing can be used without conceptual compromise. For example, the problem has been described so far as one of *extra-copyright protection* of databases; an initial or too casual description of the issue as one of *database protection* makes it sound like databases otherwise have no intellectual property protection.

Similarly, Article I, section 8, clause 8 has been called many things, principally variations on *Copyright and Patent Clause* or *Intellectual Property Clause*. Neither of these two names is descriptively perfect and either name can serve certain rhetorical ends. I will use *Copyright and Patent Clause* (or "C/P Clause") because it seems more accurate as a matter of the clause's history[5] and its scope.[6] Perhaps the most accurate name

[5] As many have noted, the whole notion of "intellectual property" is a post-18th century construct. While the clause uses neither the word *copyright* nor *patent*, there is no doubt those are the policy instruments the Founders had in mind. In fact, preliminary proposals and versions of the clause did use *copyright* and *patent*. *See* Karl Fenning, *The Origin of the Patent and Copyright Clause in the Constitution*, 17 Geo. L.J. 109 (1929). In *Graham v. John Deere*, the Court described the patent "provision appears in the Constitution spliced together with the copyright provision." 383 U.S. 1, 5, n. 1 (1966); *see* Jane C. Ginsburg, *"No Sweat"? Copyright and Other Protection of Works of Information After Feist*, 92 Colum. L. Rev. 338 (1992) (calling it "Patent and Copyright Clause").

[6] For example, if one believes that trademarks and trade secrets are intellectual property—as the entire American legal community seems to treat them—the idea that Article I, section 8, clause 8 is the exclusive basis for Congress to pass *intellectual property* legislation seems demonstrably false.

would be the Supreme Court's occasional reference to Article I, section 8, clause 8 as "the Patent and Copyright Clauses,"[7] a kind of dual aspectualism—two aspects of a unified whole—that is familiar, at least, to readers of Spinoza and/or eastern philosophy. Because most lawyers and legal commentators are neither, I will use the singular Copyright and Patent Clause.

Finally, I should acknowledge agnosticism at another level: namely, on the question whether the Court's analysis of copyright law in *Feist* was correct. This is not the place for a full dissection of *Feist*; it should suffice to say the kind of extra-copyright database protection that seems likely to pass constitutional muster is not too distant from the protection that would have been available under a *sweat of the brow* copyright law. That is because copyright law would carry with it important limitations on any rights in databases: the fair use doctrine, the idea/expression dichotomy, and (very importantly, but generally unrecognized) the copyright's *merger* doctrine.

Such protection of database—intra or extra copyright—would not put the Republic at risk. On the other hand, if we never see such protection the Information Age is not going to grind to a halt. That itself may be reason enough to leave the status quo be.[8]

II. NON-CREATIVE DATABASES AND COPYRIGHT LAW

The knotty problem of database protection, both domestically and internationally, began in the early 1990s with court decisions on both sides of the Atlantic that cut back substantially on the intellectual property protection that databases were *perceived* to enjoy.

Advocates of extra-copyright protection of databases like to say that prior to 1991, there *was* copyright protection of databases in the United States. Opponents like to say that there was a split among the circuits with the most copyright-savvy courts denying such protection. The truth may have a more interesting texture. Prior to 1991, ambiguity about protection of comprehensive databases was woven deeply into the doctrinal fabric of American copyright law. There was a split among courts—and arguably within some courts—between competing visions of the foundation of

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[7] *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 152 (1989).

[8] Elsewhere I have written that while there is a good theoretical case to protect database producers from commercial misappropriation, there is not a good empirical case for legislation more robust database protection. *See* Justin Hughes, *Political Economies of Harmonization: Databases Protection and Information Patents*, Social Sciences Research Network <http://ssrn.com/abstract_id=318486> (last updated Aug. 30, 2002).

copyright law. Many courts held to a *sweat of the brow* theory: only *industrious collection* was needed for copyright protection.[9] These courts interpreted the originality requirement as being that the work *was not copied from others*. These decisions included an influential early 20th century decision from the Second Circuit, the *Jeweler's Circular Publishing* case, which nicely summarized the justification for *sweat of the brow* protection:

> The right to copyright a book upon which one has expended labor in its preparation does not depend upon whether the materials which he has collected consist or not of matters which are *publici juris*, or whether such materials show literary skill or originality, either in thought or in language, or anything more than industrious collection. The man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and their street number, acquires material of which he is the author.[10]

Such reasoning typically occurred in *directory* cases—collections of information that were presented in tabular or database format.

Yet when the informational results of research were presented in narrative or expository form, American courts tended to reach an opposite result, finding that the assembled facts could *not* be protected.[11] In other words, when the *work* was expressive narration, American courts tended to conclude copyright protected only the *prose* of the author and that the *facts* could be freely copied. These cases emphasized that copyright law protected only the creative or original aspects of the work, pushing purely factual information outside the range of protection.

The cases could be explained as being motivated by a sense of unfair competition or just desserts, in that the plaintiff must have created at least *some* protectable and worthwhile *res*. In cases involving a historical or

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[9] *Jeweler's Circular Publg. Co. v. Keystone Pub. Co.*, 281 F. 83, 87-88 (2d Cir. 1922); *Leon v. P. Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937); *Adventures in Good Eating, Inc. v. Best Places to Eat, Inc.*, 131 F.2d 809 (7th Cir. 1942); *Gelles-Widmer Co. v. Milton-Bradley Co.*, 313 F.2d 143, 146 (7th Cir. 1963); *Schroeder v. William Morrow*, 566 F.2d. 3 (7th Cir. 1977). *See generally*, Justin Hughes, *The Philosophy of Intellectual Property*, 77 Geo. L.J. 287, 300-14 (1988) (discussing role of *labor* as possible justification for copyright protection).

[10] *Jeweler's Circular Publg. Co.*, 281 F. at 88.

[11] *Rosemont Enters., Inc. v. Random H., Inc.*, 366 F.2d 303, 309 (2d Cir. 1966); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980); *Miller v. Universal City Studios*, 650 F.2d 1365, 1372 (5th Cir. 1981) (criticizing *sweat of the brow* courts because "ensur[ing] that later writers obtain the facts independently . . . is precisely the scope of protection given . . . copyrighted matter, and the law is clear that facts are not entitled to such protection").

biographical book, the narrative text could be recognized as the protected *res*—the rewarded result of hard work—allowing the court to leave the facts unprotected. But when there was no narrative and the expression of facts was reduced to the barebones necessities of symbolic representation (like tabular numbers), a court searching for a protectable *res* often moved toward copyright over the barebones symbolic representations.[12]

The Supreme Court resolved this tension in American copyright law in the 1991 *Feist Publications v. Rural Telephone Service* case.[13] *Feist* is now familiar to practically everyone who studies intellectual property. The defendant, Feist Publications, had sought to create a regional telephone directory for northwest Kansas, encompassing telephone numbers from smaller areas served by 11 different local telephone companies.[14] Rural Telephone was the lone holdout, refusing to license its telephone directory information for inclusion in Feist's larger work.

Feist proceeded to copy Rural Telephone's entries—over 1,300 verbatim and an additional 3,600 in part. As typically happens in such cases, copying was proven by the defendant's work replicating errors and false entries that the plaintiff had intentionally inserted in its work.[15] Rural Telephone sued and the case eventually arrived at the Supreme Court, where the Court modestly noted, "[t]his case requires us to clarify the extent of copyright protection available to telephone directory white pages."[16]

The resulting unanimous decision was unusual in several respects. A copyright case reaching our Supreme Court is itself fairly rare; only 20 such cases have reached the Court from 1945 through 2000. Of those, only half

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[12] *See e.g. Worth v. Selchow & Righter*, 827 F.2d 569 (9th Cir. 1987) (finding no *sweat of the brow* copyright in trivia compilations). Note too that this difference between works with and without narration also reconciles [in the explanatory sense], decisions like *CBS v. Nash*, 899 F.2d 1537 (7th Cir. 1990) and *Hoehling*, 618 F.2d at 972, which have held that there was no copyright in *theory* of historical events, with newer cases like *CCC Info. Serv. v. Maclean Hunter*, 44 F.3d 61 (2d Cir. 1994) and *CDN v. Kapes*, 197 F.3d 1256 (9th Cir. 1999) (finding copyright protection in used car and collector coin valuations—which are really just *theories* about what the listed cars and coins are worth).

[13] 499 U.S. 340.

[14] *Id.* at 343 ("[t]he Feist directory that is the subject of this litigation covers 11 different telephone service areas in 15 counties and contains 46,878 white pages listings—compared to Rural's approximately 7,700 listings").

[15] *Id.* at 344 ("1,309 of the 46,878 listings in Feist's 1983 directory were identical to listings in Rural's 1982-1983 white pages. App. 54 (¶ 15-16), 57. Four of these were fictitious listings that Rural had inserted into its directory to detect copying."); *see Skinder-Strauss, Assoc. v. Mass. CLE*, 914 F. Supp. 665, 675 (D. Mass. 1995) (plaintiff *seeded* directory of attorneys with false entries); *EPM Commun., Inc. v. Notara*, 2000 U.S. Dist. LEXIS 11533 *7-8 (S.D.N.Y., 2000) ("[D]efendant copied into its database a deliberately false entry (or "seed") from the 1999 Sourcebook. The appearance of such material in the . . . database shows copying, but, of course, not necessarily infringement").

[16] *Feist*, 499 U.S. at 342.

were decided unanimously.[17] But what makes *Feist* particularly unusual is the Court's basis for its decision.

Despite the extensive copying, Feist Publication's final telephone book shared neither the same selection nor the same arrangement as Rural Telephone's listings. Rural's copyright claim rested solely on extensive copying of the entries themselves. Notice I say *entries themselves*, not *facts themselves,* which is the usual way to describe them. The entries are expressions of facts, *not* facts themselves—at least not on most metaphysical and common sense accounts of facts. (We will return to this point in Part IV.) The Court held that copyright did not protect the telephone book entries—whether considered individually or *en masse*—because they were not within the meaning of the Copyright Act's *original works*.[18]

Copyright could still protect a database of factual entries, but only if the creativity in its selection and/or arrangement rendered it an *original work*; and even then, the legal protection would only extend to copying of that selection and arrangement. The Rural telephone book lacked such a *modicum of creativity* because the arrangement was obvious—alphabetical—and the company's service area controlled the selection. In short, with Rural's telephone book, there was nothing for copyright to attach to—not the factual entries, not the selection of those entries, and not the arrangement of those entries.[19]

If the *Feist* decision had been limited to a statutory interpretation of *original works* under the Copyright Act, Congress could have amended the Act to extend copyright protection to non-creative, *sweat-of-the-brow* works. Instead, the Court's analysis was both statutory and constitutional, such that what was judged to be the standard for an *original work* in the statute was also judged to be the outward limit for copyrightability as a *writing* by an *author* under Article I, section 8, clause 8.[20] In the next Part, we will explore how the *Feist* decision *further* established that there are limits to Congress' power to create property rights under the Copyright and Patent Clause.

Following *Feist*, courts in the United States have consistently found that copyright law does not prevent copying of all or a very large percentage of a database, absent a claim that creative selection and

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[17] *See* Marci A. Hamilton, *Copyright at the Supreme Court: A Jurisprudence of Deference*, 47 J. Copy. Socy. 317, 321 (2000).

[18] *Feist*, 499 U.S. at 340.

[19] *Id.*

[20] *Id.*

arrangement was copied. The result has been several cases where the defendant engaged in *free riding* on the plaintiff's investment, but liability was either not found[21] or was found on non-copyright grounds.[22]

In Europe, the early 1990s also produced some important court decisions concluding that copyright law did not protect large, comprehensive databases.[23] The most important of these was the 1991 decision from the Dutch Supreme Court in the *Van Dale Lexicografie B.V., v. Romme* case.[24] This serendipitous convergence of copyright norms[25] allowed for this copyright standard to be integrated into the TRIPS Agreement in 1994. Article 10(2) of TRIPS provides that members of the World Trade Organization ("WTO") must provide copyright protection to databases, domestic and from other WTO countries, "which by reason of the selection or arrangement of their contents constitute intellectual creations."[26]

But the potential of, and problem inherent in, new information technologies had not been understood when the TRIPS provisions were negotiated. In its analysis of Europe's shortcomings vis-à-vis United States information industries, the European Commission concluded in the mid-1990s that additional legal protection would create a positive incentive for further commercial database production and distribution. The result was the 1996 establishment of a *sui generis* intellectual property right protecting

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[21] *Warren Publg. v. Microdos Data Inc.*, 115 F.3d 1509 (11th Cir. 1997) (*en banc*), *cert. denied*, 522 U.S. 963 (1997); *EPM Commun.*, 2000 U.S. Dist. LEXIS 11533; *Skinder-Strauss*, 914 F. Supp. at 675 (bare fact that defendant copied information from plaintiff's directory did not establish copyright violation).

[22] *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447 (7th Cir. 1996).

[23] Throughout the discussion, I will use *comprehensive databases* to refer to databases that are organized on obvious principles and lack creativity in their selection (such a database covers all the candidate entries in a particular area/field and, hence, is *comprehensive*). Such databases are usually large datasets, but need not be. An alphabetical telephone directory of a 500-person company or school would be a *comprehensive database*.

[24] Supreme Court of the Netherlands (Hoge Raad), 1993 European Intell. Prop. Rev. D-260 (January 4, 1991) (reprinted in English in *Protecting Works of Fact* 93 (Egbert J. Dommering & P. Bernt Hugenholtz eds., Deventer 1991)). Although Dutch law had been considered the most friendly of continental legal systems to the protection of labor and investment in a comprehensive database, the Court considered a 230,000 entry Dutch language dictionary and concluded that "such a collection is in itself no more than a number of factual data which do not in themselves qualify for copyright protection." *Id.* at 95. Beginning in 1989, French courts also delivered a series of decisions denying copyright protection to factual compilations on the grounds that they did not reach "au rang de création intellectuelle" or constitute an "apport créatif et intellectuel." *See* André Lucas, *Droit d'auteur et numérique*, 40, n. 79 (Litec, 1998).

[25] Similar economic conditions could easily have brought such cases to the fore; *i.e.*, the increasing value of such databases.

[26] *See General Agreement on Tariffs and Trade—Multilateral Trade Negotiations (The Uruguay Round); Agreement on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods*, 33 I.L.M. 81, pt. II, § 1, art. 10.2 (1994).

investment in databases.[27] Several commentators have written about the origins and mechanisms of the European Union ("EU") Database Directive.[28] Many of these commentators have roundly criticized it as unnecessary and damaging to research, science, and education.[29]

The EU Database Directive prompted database protection to become a subject of discussions running up to the December 1996 diplomatic conference convened by the World Intellectual Property Organization (WIPO) to consider changes in international copyright law in response to digitization and the new Internet environment. In early 1996, it appeared the United States might follow the Europeans, both with domestic legislation on databases and by agreeing to international treaty provisions on the protection of non-creative databases.

But opposition from the research and library communities quickly complicated the U.S. position. At the same time, the basic copyright issues took much more time at the December diplomatic conference proceedings than had been anticipated. In the end, the conference members reached agreement only on the *core* copyright issues.[30] Database protection fell into the same general pot of unresolved issues as protection of audiovisual performers and broadcasters.

With the international pressure off and an EU-style *sui generis* right politically impractical at home, the House Judiciary Committee took a new approach in 1998, taking inspiration from traditional *misappropriation* doctrine. Although this bill, described below and then called H.R. 2652, passed the House of Representatives twice in 1998, it was stalled in the Senate in the fall of 1998. There, opponents, Senator Hatch's staff, and the

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[27] Council Directive No. 96/9, O.J. L 77/20 (1996) (available on Europa, *Council Directive 96/9/EC on the Legal Protection of Databases* <http://europa.eu.int/smartapi/cgi/sga_doc?smartapi!celexapi!prod!CELEXnumdoc&lg=EN&numdoc=31996L0009&model=guichett> (accessed Jan. 12, 2003)).

[28] *See e.g.* Hughes, *supra* n. 8, at 18-27 (elaborating on development of directive and its provisions); Mark Powell, *The European Union's Database Directive: An International Antidote to the Side Effects of Feist?*, 20 Fordham Intl. L.J. 1215 (1997); George Koumantos, *Les Bases de Données dans la Directive Communautaire*, 171 Revue Internationale du Droit D'Auteur 79, 104-05 (Jan. 1997).

[29] *See e.g.* J.H. Reichman & Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 Vand. L. Rev. 51 (1997); Hughes, *supra* n. 8; H.R. Subcomm. on Intell. Prop. & Cts. of the Jud. Comm., *Collections of Information Antipiracy Act-Hearings of H.R. 2652*, 105th Cong. 15-16 (Oct. 23, 1997) (statement of J.H. Reichman) (available at U.S. House of Representatives, *Committee on the Judiciary* <http://www.house.gov/judiciary/41121.htm> (accessed Jan. 12, 2003)).

[30] For more information on the related rights of musical performers and phonogram producers, *see* WIPO, *WIPO Copyright Treaty ("WCT")* < http://www.wipo.int/treaties/ip/wct/index.html>) (accessed Jan. 12, 2003); WIPO, *WIPO Performances and Phonograms Treaty ("WPPT")* <http://www.wipo.int/treaties/ip/wppt/index.html> (accessed Jan. 12, 2003). The Diplomatic Conference on Certain Copyright and Neighboring Rights Questions in Geneva adopted both treaties on Dec. 20, 1996.

Administration proposed amendments that substantially watered down the law and made the *proponents* seek to have the bill withdrawn from what became the Digital Millennium Copyright Act.

With the support of the database producers' coalition, the House Judiciary Committee reintroduced the same bill in 1999, now called H.R. 354, the "Collections of Information Antipiracy Act."[31] The opponents changed tactics, introducing their own "minimalist" bill through House Commerce Committee Chairman Tom Bliley: H.R. 1858, the Consumer and Investor Access to Information Act.[32] Ever since, the two lobbying sides have been in political equipoise, with a number of different scenarios for the deadlock being broken soon—or possibly never.[33]

It is helpful, at this juncture, to talk about how people envision extra-copyright database protection law working. Every proposal for such a law has what we might call a *basic prohibition* provision. The strength or weakness of the law will depend on the combined chemistry of the basic prohibition with the law's (a) definitions; (b) limitations and exceptions; and (c) term of protection. With that in mind, let us consider some of the basic prohibitions concepts. The basic prohibition in H.R. 354 as introduced early in 1999 was as follows:

> [a]ny person who extracts, [or uses in commerce], all or a substantial part, [measured either qualitatively or quantitatively], of a collection of information gathered, organized, or maintained by another person through the investment of substantial monetary or other resources, so as to cause material harm to the [actual or potential] primary market of that other person . . . .[34]

The bill's supporters argued that this was not a property right *per se* because of the inclusion of a "harm" requirement as an element of the cause of action. In 1999, the Administration made it clear that for this to be a meaningful addition, the standard should be raised to a *substantial* harm test[35]—something the backers of H.R. 354 informally agreed to do late in 1999.

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[31] H.R. 354, 106th Cong. (1999) (reproduced in Sen. Orrin Hatch's January 1999 floor statement, *see Database Antipiracy Legislation*, 145 Cong. Rec. S31 (1999)).

[32] H.R. 1858, 106th Cong. (1999) (this bill and others are available on GPO, *Catalog of Congressional Bills* <http://www.access.gpo.gov/congress/billsindex.html> (accessed Jan. 12, 2003)).

[33] For a full exposition of these events, *see* Hughes, *supra* note 8, at 31-41.

[34] H.R. 354, 106th Cong. at § 1402.

[35] H.R. Subcomm. on Cts. and Intell. Prop. of the Jud. Comm., *Collections of Information Antipiracy Act of H.R. 354*, 106th Cong. pt. IV A. (Mar. 18, 1999) (Statement of Andrew J. Pincus, Gen. Counsel, U.S. Dept. of Comm.) [hereinafter *1999 Administration Statement on H.R. 354*] (available on USPTO, *Administrator for Legislative/International Affairs* <http://www.uspto.gov/web/offices/dcom/olia/hr354.html> (accessed Jan. 13, 2003); Association of Research Librarians,

At heart, the cause of action in the original H.R. 354 was the same as the EU Database Directive with the addition of this substantial harm test. The EU Database Directive requires member states to provide database producers with the following right:

> [A] right for the maker of the database which shows that there has been [either] qualitatively and/or quantitatively a substantial investment in either the obtaining, verification, or presentation of the contents to prevent extraction and/or re-utilization of the whole or of a substantial part, evaluated qualitatively and/or quantitatively, of the contents of that database.[36]

The original H.R. 354 aimed generally at *use in commerce* just as the Directive takes aim at *reutilization*, both troubling ambiguous notions. Both are written to prohibit an unauthorized, substantial *taking* from the database, measured either qualitatively or quantitatively. Both establish a term of protection of 15 years.

In contrast, the *minimalist* House Commerce Committee proposal, H.R. 1858, provides as follows:

> It is unlawful for any person . . . , by any means or instrumentality of interstate or foreign commerce or communications, to sell or distribute to the public a database that—(1) is a duplicate of another database that was collected and organized by another person . . . ; and (2) is sold or distributed in commerce in competition with that other database.[37]

H.R. 1858 is envisioned as a *low protectionist* response that focuses *only* on competitive "free-riding," although it is not as *low protection* as may first appear.

Two elements of H.R. 1858 put special bite into the protection it provides. First, when a larger database has discrete subcomponents, section 101(1) of H.R. 1858 provides that a discrete section of a database may be treated as a *database*. In other words, if a restaurant guide to New England has a discrete section for restaurants in Hartford, copying that specific section, although only a small part of the entire database, would count as copying a *database* under H.R. 1858.[38] Second, H.R. 1858 stays true to the

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Letters, Testimony, & Statements <http://www.arl.org/info/letters/pincstate.html> (last updated June 24, 2001)).

[36] *Council Directive No. 96/9*, *supra* n. 27, at ch. III, art. 7.1.

[37] H.R. 1858, 106th Cong. § 102.

[38] In 1999, the Administration criticized this approach: "the coverage provided by section 101(1) appears likely to be more subject to technological vicissitudes and manipulation by private parties than a

common law concept of *misappropriation* and has no term of protection—thus the protection against commercial *free-riding* is permanent.[39]

The basic proposition of these bills is that some types of unauthorized copying of factual entries should be made the subject of civil and/or criminal liability because this is the best way to avoid a public goods/free-rider problem with comprehensive and valuable databases.

III. COPYRIGHT AND PATENT CLAUSE VERSUS COMMERCE CLAUSE

The constitutionality of federal database protection rests on the interaction of three bodies of law, each of which, like a heavenly body, has considerable gravitational pull within our constitutional system. The first is the subject of this Part: the direct competition between Congress' general power to regulate interstate commerce under the Commerce Clause against limitations on Congress' expressly enumerated power to grant proprietary rights under the Copyright and Patent Clause. The question is whether database legislation would be pulled into the gravitational *dead zone* of what the Copyright and Patent Clause *forbids* or into the zone of what the Commerce Clause *permits*.

It is axiomatic that when Congress enacts legislation, it must be a valid exercise of Congress' Article I powers under the Constitution. Most of Congress' intervention in the national economy occurs pursuant to its very broad power "*[t]o regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes.*"[40] On our present understanding of the Commerce Clause power,[41] Congress could have established national intellectual property law in roughly the form we have without the enumerated power in the Copyright and Patent Clause.

The argument that the Copyright and Patent Clause changes all this can be constructed as five steps:

'substantial' taking measure." H.R. Subcomm. on Telecomm., Trade, and Consumer Protection of the Commerce Comm., *Consumer and Investor Access to Information Act of 1999: Hearings on H.R. 1858*, 106th Cong. pt. IV A. (June 15, 1999) (Statement of Andrew J. Pincus, General Counsel, U.S. Department of Commerce) [hereinafter *1999 Administration Statement on H.R. 1858*] (available on USPTO, *Administrator for Legislative/International Affairs* <http://www.uspto.gov/web/offices/dcom/olia/hr1858.htm> (accessed Jan. 12, 2003)).

[39] The Administration also opposed this. *See 1999 Administration Statement on H.R. 1858*, *supra* n. 38, at pt. IV B. ("We do not support the basic premise of H.R. 1858—that a codification of misappropriation principles should provide an open-ended term of protection because common law misappropriation principles do not impose any fixed duration to such claims.").

[40] U.S. Const. art. I, § 3.

[41] The Supreme Court finally drew limits on the general power of the Commerce Clause in *Lopez v. U.S.*, 514 U.S. 549 (1995) (holding that criminalizing the carrying of a gun near a school is beyond Congress' Commerce Clause power, but such limits would not affect intellectual property laws).

1. The enumerated power in the C/P Clause, like each enumerated power, has both a grant of positive power and limitations on ways in which that enumerated power may be exercised;

2. The enumerated power in the C/P Clause, like each enumerated power, applies to a particular, discrete area of possible legislative activity;

3. If legislation falls within the *particular, discrete area of possible legislative activity covered by an enumerated power* and the legislation is outside the *limitations on ways in which that enumerated power may not be exercised*, the legislation is unconstitutional;

4. Extra-copyright protection of databases does/does not fall within the particular, discrete legislative area of the C/P Clause;

5. Therefore, extra-copyright protection of databases is/is not constitutional.

This is only an expanded version of the analysis of many—perhaps all commentators—who have considered the problem.[42]

A. Limitations on the Enumerated Power of the Copyright and Patent Clause

The Founders gave us remarkably little guidance as to the meaning of the 27 words in Article I, section 8, clause 8:

> The Congress shall have Power . . . [8] To promote the Progress of Science and useful Arts, by securing for limited Times to Authors

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[42] Different commentators formulate the problem in slightly varied forms. *See e.g.* Pollack, *supra* n. 1, at 62 (stating the "current question is whether Congress is allowed to conclude that market failure has been shown sufficiently to entitle Congress to use the Commerce Clause to bypass the textual limits of the Intellectual Property Clause"); Heald & Sherry, *supra* n. 1, at 1121 (stating the "conundrum[] . . . [is] how to determine when limiting language found in one part of the Constitution affects the scope of powers emanating from different clauses"); Marci Hamilton, *A Response to Professor Benkler,* 15 Berkeley Tech. L.J. 605, 619-25 (2000) (stating the "more the legislation resembles copyright protection, the more likely courts will find it to be an inappropriate enactment pursuant to the Copyright Clause"); OLC Memorandum, *supra* n. 1, at 2 (framing the question as whether database legislation "constitutes a valid exercise of Congress's [sic] power under the Commerce Clause, or whether the Intellectual Property Clause precludes such Commerce Clause legislation").

> and Inventors the exclusive Right to their respective Writings and Discoveries.[43]

The jurisprudence of this clause could give any originalist a migraine. Congress and the courts—including the Supreme Court—have had no problem concluding that photos, motion pictures, and sound recordings are *writings* eligible for protection under the clause. Small sculptural shapes—including representational art in useful items—are also *writings*; a result that should be more disturbing than any of the modern technologies above because arts and crafts were well established in the United States as of the late 18th century.[44] (For example, Paul Revere and Myer Myers[45] were among America's master silversmiths at the time.) Some of the 27 words are examined quite seriously—like *authors*—while others are politely avoided—like *science* and *useful arts*.[46] Are soap operas and game shows part of *science* (or the *useful arts*) as that term would have been understood by our Founders?[47] In short, the language of the clause has turned out to be less fixed than we would hope most copyrighted works to be.

But that does not mean that the C/P Clause is without content. In recent years, there has been an outpouring of legal scholarship on limitations of the power granted under the Copyright and Patent Clause.[48] Much of the recent scholarship has been in reaction to Congress' 1998 retroactive 20-

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[43] U.S. Const. art. I, § 8.

[44] *Mazer v. Stein*, 347 U.S. 201 (1954). In a concurring opinion, Justice Douglas observed, "[t]he Copyright Office has supplied us with a long list of such articles which have been copyrighted—statuettes, book ends, . . . candlesticks, inkstands, chandeliers, . . . salt and pepper shakers . . . . Perhaps these are all 'writings' in the constitutional sense. But to me, at least, they are not obviously so. It is time that we came to the problem full face." *Id.* at 220-21.

[45] *See e.g.* Skirball Cultural Center, *Myer Myers: Jewish Silversmith in Colonial New York* <http://www.skirball.com/press/archives/myer2.html> (accessed Nov. 6, 2002) (providing extensive background on early American silversmithing). Our present understanding of *Writings* would provide copyright protection to their ornamental silver work, although this seems far from anything the Founders intended.

[46] There is relatively little scholarly or court discussion of these phrases, although suggestions have ranged from the constrained to the very modern. *Compare* Pamela Samuelson, *Benson Revisited: The Case Against Patent Protection for Algorithms*, 39 Emory L.J. 1025, 1033 n. 109 (1990) ("'Useful arts' is understood to be the realm of technological and industrial improvements") *with* Margaret Chon, *Postmodern Progress: Reconsidering the Copyright and Patent Power*, 43 DePaul L. Rev. 97, 114 (1993) ("[f]rom the modernist perspective, 'Science and useful Arts' can be reduced to the single term 'knowledge'").

[47] In their defense, it might be noted that one proposal, from an influential member of the Constitutional Convention, was for Congress "to secure to authors the exclusive rights to their performances and discoveries." *See* Fenning, *supra* n. 5, at 110. James Madison proposed "to secure to literary authors exclusive rights for a certain time." *Id.* at 112. Of course, the presence of these proposals—and the differing final language—could be argued both ways.

[48] For an interesting analysis of "securing" rights in the provision, *see generally* Edward C. Walterscheid, *Inherent or Created Rights: Early Views on the Intellectual Property Clause*, 19 Hamline L. Rev. 81 (1995).

year extension of the copyright term and whether this comports with the language of the clause that Congress shall grant intellectual property rights for "limited times." If Congress attempted to grant eternal copyright or eternal patents (as some countries did in the 20th century), no one doubts that such legislation would be beyond a very *express* limitation of the clause.

More nuanced issues arise with limitations that may arise from other language in the clause. For example, what limitation, if any, arises from the prefatory language that the grant of power is "[t]o promote the Progress"? The U.S. Government has, on occasion, argued that the prefatory language is a mere *preamble,* which does not condition the grant of power.[49] That argument comports with the precatory status of some similar *limiting* but general language in the Constitution.[50] Yet the Court made it clear in the 1966 *Graham v. John Deere* case[51] that the "[t]o promote the Progress" language does have a limiting effect, at least in the case of patents.[52]

The *Graham* Court was dealing with the new statutory requirement of "non-obviousness" in the 1952 Patent Act. In its discussion of Congress' power to establish a patent system, the Court noted that the C/P Clause "is both a grant of power and a limitation."[53] The C/P Clause established a "qualified authority" with Congress that, unlike monopolies granted under the English crown patent of the 16th and 17th centuries, "is limited to the promotion of advances in the 'useful arts.'" Promotion of progress is, for the patent system, a "*standard* expressed in the Constitution and it may not be ignored."[54] Despite the Solicitor General's argument in *Eldred v. Ashcroft*, there is no reason to understand the language any differently in the case of copyrights.

In *Feist,* the Court could have reached its result on statutory grounds—that factual entries, whether individually or *en masse*, do not by themselves qualify as *original works of authorship* under section 102 of the Copyright Act. But the Court used the telephone books before it to further rule that

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[49] Br. of the U.S. in the S. Ct. of the U.S., *Eldred v. Ashcroft*, 18-19 (Aug. 5, 2002).

[50] I am thinking of whether Congress' power to "lay and collect Taxes" has any meaningful limit in the language that such power is to "provide for the . . . general welfare of the United States." U.S. Const., art. I, § 8, cl. 1. The Court has on occasion treated this language as an *expansion* instead of a limitation on Congress' taxation power. *See Buckley v. Valeo*, 424 U.S. 1, 90 (1976) (stating that appellants "erroneously treat[] the General Welfare Clause as a limitation upon congressional power. It is rather a grant of power, the scope of which is quite expansive . . .").

[51] 383 U.S. 1, 5 (1966).

[52] *Id.*

[53] *Id.*

[54] *Id.* at 6. *See generally*, Lawrence B. Solum, *Congress' Power to Promote the Progress of Science*, 36 Loy. L.A. L. Rev. 1 (2002) (stating that the preamble interpretation was untenable).

copyright law could not protect factual entries as a *constitutional* matter. The Court reasoned that the requirement of *originality* arose not just from the statute's limitation to *original works*, but also from the Copyright and Patent Clause's requirement that its enumerated power be exercised to give *Authors* rights over their *Writings*. Getting an originality requirement from *Authors* and *Writings* is not as clear a derivation as getting an originality requirement from *original works*, but no one questions that some requirement of this kind is needed to make the copyright system workable and that the requirement has a long pedigree.[55]

As I said in the introduction, this is not the place for a detailed exegesis on *Feist*. But some background is appropriate. The important step in *Feist* was equating originality with some small threshold of creativity (*i.e.*, originality equals creativity). The Court was certainly correct that this seemed to be the teaching of *Burrow-Giles v. Sarony*[56] and *Bleistein v. Donaldson Lithographing Co.*[57] Yet, there is something about the result as a whole that, particularly for comparative law scholars, may not be completely satisfying.

The Court was interpreting words in our Constitution, but the Founders used concepts from the Anglo-Saxon legal tradition. If the words in the Constitution mean only what the Founders could have known them to mean, then *Feist* loses some of its luster. Recent decisions from high courts in Australia and Canada have said, in effect, that *Feist* is not a good analysis of Anglo-Saxon legal concepts of authors, writings, or originality.[58] Indian jurists believe that comprehensive databases are still protected under their English-based law.[59] The English *BBC v. Magill* case

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[55] *Feist*, 499 U.S. at 346 (stating "[o]riginality is a constitutional requirement. The source of Congress' power to enact copyright laws is Article I, § 8, cl. 8, of the Constitution, which authorizes Congress to 'secure for limited Times to Authors . . . the exclusive Right to their respective Writings.' In two decisions from the late 19th century—*The Trade-Mark Cases*, 100 U.S. 82 (1879); and *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884)—this Court defined the crucial terms 'authors' and 'writings.' In so doing, the Court made it unmistakably clear that these terms presuppose a degree of originality.").

[56] 111 U.S. 53, 60 (1884) (finding that a photograph of Oscar Wilde was an original work of art).

[57] 188 U.S. 239, 250 (1903) (finding that circus advertisements were copyrightable, as the "personal reaction of an individual upon nature").

[58] *Desktop Mktg. Sys. v. Telstra Corp.*, [2002] F.C.A.F.C. 112 (Fed. Ct. Australia May 15, 2002) (available at Federal Court of Australia, *Full Court Decisions* <http://www.austlii.edu.au/au/cases/cth/FCAFC/2002/112.html> (last updated Aug. 2, 2002)); *see* Justin Hughes, *The Personality Interest of Authors and Inventors in Intellectual Property*, 16 Cardozo Arts & Ent. L.J. 81, 99-106 (1998) (discussing the melding of the concepts of originality and creativity).

[59] *Desktop Mktg. Sys.*, [2002] F.C.A.F.C 112.

made it clear that pre-Directive English copyright law also afforded substantial copyright protection to comprehensive databases.[60]

The 1790 Copyright Act expressly mentioned only maps, charts, and books—a vision of copyright coverage that seems to focus on fact-based functional works, not creativity.[61] Because of the substantial overlap between members of the Constitutional Convention and members of the first Congress, the legislative actions of the first Congress has been recognized as "'contemporaneous and weighty evidence' of the Constitution's meaning."[62]

For strong advocates of the creativity requirement, the 1790 Act is a source of heartburn, if not an indigestible fact. For example, referring to the 1790 statutory list and recognizing that maps are *archetypical* sweat-of-the-brow works,[63] Malla Pollack commented that "[t]he creativity requirement for authorship [found in *Feist*], was also obscured by statutory lists of protectable works."[64] Could it be that the creativity requirement as formulated in 1991 was not "obscured," but actually did not exist in the minds of the Founders two centuries earlier? Although *Burrow-Giles* and *Bleistein* are supportive of a creativity requirement, the *Trade-Mark Cases*[65] and *Higgins v. Kueffe*[66] both have language suggesting *intellectual labor* is enough. It is no surprise that until *Feist* a number of commentators either held out the prospect that *sweat-of-the-brow* was a good foundational explanation of American copyright law and/or that such a foundation was needed to provide incentives for valuable fact-based works.[67]

The result—clear then and clearer now—is that American copyright law was placed somewhere between traditional Anglo-Saxon law's

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[60] [1990] I.L.R.M. 534 (finding copyright protection for BBC's weekly television program schedules).

[61] In this way, the 1790 Copyright Act also makes some sense of *Science*.

[62] *Printz v. U.S.*, 521 U.S. 898, 905 (1997).

[63] Pollack, *supra* n. 1, at 51 ("Maps are archetypical 'sweat of the brow works' requiring labor and accuracy, but not necessarily creativity").

[64] *Id.*

[65] 100 U.S. at 94 (noting that "[t]he writings which are to be protected are the fruits of intellectual labor," and a trademark is not copyrightable because "[i]t requires no fancy or imagination, no genius, no laborious thought").

[66] 140 U.S. 428, 431 (1891) (finding that the Clause "has reference only to such writings and discoveries as are the result of intellectual labor" and citing the *Trade-Mark Cases*, 100 U.S. 82).

[67] Robert C. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 Colum. L. Rev. 516 (1981) (advocating protection with wide fair use limits); Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 Colum. L. Rev. 1865 (1990) (advocating proper protection while acknowledging inconsistencies in case law).

extremely low threshold of *originality* and the higher *mark of personality* threshold of continental legal systems. Yet *Feist* was not a conscious effort by the Supreme Court to move American copyright law closer to *droit d'auteur*. Indeed, the *Feist* decision was driven not by a vision of what copyright law should be, but by a vision of what free expression and free discourse must be in American society.

The concern I raised in the preceding few paragraphs is based on the notion that the 27 words in the C/P Clause mean what the Founders could have known them to mean in the late 18th century. But just as our common law of defamation has diverged from the rest of Anglo-Saxon law because of our particular structure of free expression jurisprudence, perhaps these Anglo-Saxon copyright concepts have also been refocused—and need to be refocused—through the prism of our constitutional scheme. In that spirit, one can view the driving force of the unanimous *Feist* decision as being a concern that American copyright law had inadvertently developed in such a way that it seems to threaten increasingly free expression in American society. Let me explain this.

There is no question that by the end of the 18th century, the Anglo-Saxon law understanding of *original*, *writing*, and *author* covered functional works like almanacs, maps, and the like. At the same time, there was not much material like this for copyright to cover; there was very little in any country in the way of large statistical compendia. It appears that during this period, measured against per capita GDP, the United States produced more large, statistical, database-like publications than the United Kingdom.[68] Each of us can guess whether the copyright law protected these against slavish copying; my guess is that it would have.

But protection against slavish copying—that is, verbatim reproduction—was all that American copyright gave. Eighteenth century and early 19th century American copyright did not offer copyright owners solid rights over derivative works. For example, there was no liability for unauthorized translations of copyrighted works;[69] there was scant, if any, liability for unauthorized abridgements of copyrighted works.[70] In other

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[68] The young American republic so took to heart the idea of gathering data as part of the science of republican government that by the time Englishman Thomas Malthus was preparing the second edition of his *Essay on the Principle of Population*, a large amount of his data came from American sources, including Seybert's *Statistical Annals of the United States*. *See* Mary Poovey, *A History of Modern Fact*, 290 (The U. Chi. Press 1998). In comparison, the British did not conduct their first national census until 1801. *Id.* at 291.

[69] *Stowe v. Thomas*, 23 Fed. Cas. 201 (E.D. Pa. 1853) (holding that a German translation of Uncle Tom's Cabin did not infringe the original).

[70] Early copyright cases in the U.S. acknowledged that a "real, substantial condensation" of a work was "not a piracy" provided that "intellectual labor and judgment [was] bestowed thereon." *Folsom v. Marsh*, 9 Fed. Cas. 342, 345 (C.C. Mass. 1841); *Wheaton v. Peters*, 33 U.S. 591, 651 (1834) (plaintiff

words, *if* there had been comprehensive databases and *if* people manipulated data in the ways they do now to produce "downstream" works, there would have been no liability under 19th century American copyright law. But as American copyright doctrine expanded to include rights over *derivative works*, this situation changed. Even then, the effect on downstream manipulation of data would not have been noticeable because only digitization and computerization offer to make massive manipulation and rearrangement of data a common process.

To a legal realist, the *Feist* case was not the best fact pattern on which to base a decision about the nature of copyright protection for factual works. The problem, as Malla Pollack has noted, is that the plaintiff "had not really sweated."[71] The plaintiff in *Feist* did not need any economic incentive from copyright law to collect the facts—Rural Telephone generated the phone numbers and the databases as a function of being an operating telephone company.[72] Nor did Rural Telephone need an incentive from copyright law to publish the resulting database—state regulation mandated the publication of the phone book by whoever had the (lucratively profitable) local telephone service.[73] In other words, the fact pattern in *Feist* made it easy for the Court to say that industrious collection of facts garnered no copyright protection. It would have been much more interesting and contentious if a fact pattern like the subsequent *Warren Publishing* or *ProCD* cases had been before the Court.

It is doubtful that anyone at the U.S. Supreme Court in 1991 understood the potential of the Internet, but it is likely that the judges saw how the strong derivative work right—developed in the 20th century quite sensibly in relation to fictional works—casts a disturbing shadow when applied to factual works. All kinds of reuses of data would be susceptible to copyright

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recognized that "[a]n abridgement fairly done, is itself authorship, requires mind; and is not an infringement, no more than another work on the same subject," but argued that the defendant's "[c]ondensed Reports have none of the features of an abridgement, and the work is made up of the same cases, and no more than is contained in Wheaton's Reports"). In Britain, the right of fair abridgement was endorsed by the Court of King's Bench in *Millar v. Taylor*, 98 Eng. Rep. 201 (K.B. 1769). *See* Alfred C. Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 Ohio St. L.J. 517, 534, n. 119 (1990) (noting that 18th and early 19th century courts "adopted a very limited view of infringement").

[71] Pollack, *supra* n. 1, at 52.

[72] *Feist*, 499 U.S. at 343 ("As the sole provider of telephone service in its service area, Rural obtains subscriber information quite easily. Persons desiring telephone service must apply to Rural and provide their names and addresses; Rural then assigns them a telephone number.").

[73] *Id.* at 342 ("Rural Telephone Service Company, Inc., is a certified public utility that provides telephone service to several communities in northwest Kansas. It is subject to a state regulation that requires all telephone companies operating in Kansas to issue annually an updated telephone directory. Accordingly, as a condition of its monopoly franchise, Rural publishes a typical telephone directory. . . .").

infringement claims if the derivative work right has as large a penumbra over factual databases as it does over a short story, a comic book character, or a song.

The simplest resolution of the problem was to clarify that copyright could protect the selection and arrangement of a database, but did not extend to the basic expression of discovered facts, no matter how many and no matter how much industry had gone into the collection/expression of those facts. This *freed* the data, so to speak; equalized the protection of facts in a database and a narrative; and, in the Court's mind, still offered reasonable protection to many commercial databases.[74]

It is on this last point that the Court probably did not grasp the full effect of digitization and the networked computer environment. That environment has largely eliminated traditional *arrangement* of a database. As everyone knows, electronic databases are accessed via software that usually allows any number of possible arrangements; the literal *arrangement* on a hard drive is irrelevant.[75] While the digital, networked environment has not technologically eliminated *selection* the same way it has eliminated *arrangement*, the environment has removed cost and efficiency pressures that placed a premium on editorial *selection*. The economics of the digital, networked environment has tended to move the emphasis from valuable selection to valued *comprehensiveness* and completeness.

It is possible to argue that the constitutional pronouncements in *Feist* are dicta,[76] but that seems silly—to my unlearned eyes such strong language by a unanimous Court seems a surer guide to future decisions than a 5-4 holding. *Feist* teaches us in plain language that an author of a work may only be rewarded with exclusive rights pursuant to the Copyright and Patent Clause when the work manifests a modicum of creativity.

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[74] *Id.* at 345 (citing the Nimmer treatise and noting that for copyright protection, "the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be."). *See* 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright*, §§ 2.01[A], [B] (1990).

[75] *See Notara*, 2000 U.S. Dist. Lexis 11533 at *15 (concluding that there was no infringement of the plaintiff's arrangement because "the Notara database is a random collection of factual information—not arranged by industry category—which can only be retrieved using a search engine"); *see* Jane C. Ginsburg, *supra* n. 5, at 345 (computer databases "may lack any 'arrangement' for they are designed to permit the user to impose her own search criteria on the mass of information"); Hughes, *Created Facts*, *supra* n. 58, at 135-36.

[76] OLC Memorandum, *supra* n. 1, at 12-13 (citing *U. S. v. Lopez*, 514 U.S. 549 (1995)).

B. *When Legislation is Outside the Limits of Enumerated Power and Falls Within the Particular, Discrete Area of that Enumerated Power*

In 1998, the House of Representatives passed the "Collections of Information Antipiracy Act," the earliest version of the House Judiciary Committee's attempt at database protection that is not a *sui generis* right. The House Report accompanying the bill asserted that "the committee finds the authority for this legislation in Article I, section 8, clause 3 of the Constitution."[77] Even the Department of Justice's Office of Legal Counsel, which was very critical of the initial 1998 bill, agreed that "[a]bsent some external constitutional limitation, the bill would appear to constitute a valid exercise of the commerce power . . . ."[78]

The key "external constitutional limitation"[79] we must consider is the Copyright and Patent Clause itself. We need to explore what happens when Congress legislates in the particular area of an enumerated power, but legislates outside the limits of the enumerated power. May the general Commerce Clause provide cover? Some members of Congress would like to believe the answer is *yes*. The most important precedent in this area is the 1982 *Railway Labor Executives Association v. Gibbons* case[80] and its answer is *no*.

In *Railway Labor*, the Court held that the requirement of Article I, section 8, clause 4 that gives Congress "power to enact bankruptcy laws that are uniform throughout the United States"[81] preempted Congress from legislating under the more general power of the Commerce Clause to provide specific protection for the employees of a particular bankrupt railroad. The Chicago, Rock Island, and Pacific Railway Co. ("Rock Island") had been operating under protection of the bankruptcy laws when a labor strike depleted its cash reserves and the reorganization ordered the total abandonment of the railway system and the dissolution of the company.[82]

Congress responded to this by enacting legislation that required the bankruptcy trustee for Rock Island to provide up to $75 million in benefits to Rock Island employees not hired by the entities taking over the Rock

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[77] H.R. Rpt. 106-349 at 16 (Sept. 30, 1999).

[78] OLC Memorandum, *supra* n. 1, at 12-13 (citing *Lopez*, 514 U.S. 549).

[79] *Id.*

[80] *Ry. Lab. Execs. Assn. v. Gibbons*, 455 U.S. 457 (1982).

[81] *Id.* at 469.

[82] *Id.* at 460.

Island trackage.[83] The legislation provided that the benefits paid to the former employees would be counted as "administrative expenses" of the estate, so as to give the benefits certain priority among claims to the Rock Island assets in liquidation.[84] The trial court concluded that "Congress . . . legislate[d] a $75 million labor protection burden on the assets of the Rock Island" railroad and found that the legislation violated the Just Compensation Clause of the Constitution.[85]

The Supreme Court took a different approach. First, the Court concluded that the legislation was actually a kind of bankruptcy law. The Court acknowledged that "the subject of bankruptcies is incapable of final definition," but noted that the core concept was a law governing "relations between an insolvent or nonpaying or fraudulent debtor and his creditors, extending to his and their relief."[86] On that criterion, the majority concluded that the legislation was a bankruptcy law because "Congress did nothing less than to prescribe the manner in which the property of the Rock Island estate [was] to be distributed among its creditors."[87] Because the legislation was specific to Rock Island, the conclusion that it was a bankruptcy law led inexorably to the conclusion that the law was constitutionally infirm:

> We do not understand . . . 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' power: bankruptcy laws must be uniform throughout the United States. The Commerce Clause does not require such uniformity in the applicability of legislation. Thus, if we were to hold that Congress had the power to enact nonuniform bankruptcy laws pursuant to the Commerce Clause, we would eradicate from the Constitution a limitation on the power of Congress to enact bankruptcy laws.[88]

The Rock Island legislation violated the most basic meaning to *uniform* laws because it was, in effect, a private bill.[89] The majority opinion identified how the Founders had called for *uniform* bankruptcy laws "throughout the United States" precisely because of the rampant (and

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[83] *Id.* at 461-62.

[84] *Id.* at 463.

[85] *Id.*

[86] *Id.* at 466 (citing *Wright v. Union C. Life Ins. Co.*, 304 U.S. 502, 513-14 (1938)).

[87] *Id.* at 467.

[88] *Id.* at 468-69.

[89] *Id.* at 470. The Court made clear that the *uniform* law requirement would not straitjacket Congress from drawing distinctions among different types of debtors or from creating differences to compensate for differences in state commercial laws.

presumably corrupt) practice in state legislatures "of passing private Acts to relieve individual debtors."[90] The Court concluded that "the Bankruptcy Clause's uniformity requirement was drafted in order to prohibit Congress from enacting private bankruptcy laws,"[91] precisely what it had done for Rock Island.

The combined chemistry of *Feist* and *Railway Labor* lead to the conclusion that Congress cannot create copyrightesque, extra-copyright protection for non-creative databases. Application of the *Railway Labor* reasoning to hold the database law unconstitutional requires only a few steps: (a) that databases are *writings* and that database producers are *authors* constitutionally; (b) that the Copyright Clause permits Congress to protect *only* writings with some creativity, and therefore; (c) that Congress cannot protect any *writing* without creativity, including a database.

To make this argument, we need the *Feist* decision to say not just what Congress may not do under the Copyright and Patent Clause, but that the Clause establishes what Congress may not do at all. Nothing in *Feist* expressly states that the Copyright and Patent Clause limits the scope of Congress' power under other provisions of the Constitution. On the other hand, if the limitation is limited to *that* enumerated power, it is no limit at all—a result that makes no sense.[92] Moreover, there is considerable language in *Feist* to suggest that the C/P Clause actually prohibits copyright-like protection to the non-original parts of *writings*.

For example, the Court tells us that factual entries "may not be copyrighted and are part of the public domain available to every person."[93] The latter clearly suggesting a positive obligation stemming from the C/P

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[90] *Id.* at 472.

[91] *Id.*

[92] That is, a result that has made no sense to any number of commentators. *See e.g.* Rochelle C. Dreyfuss, *A Wiseguy's Approach to Information Products: Muscling Copyright and Patent into a Unitary Theory of Intellectual Property*, 1992 S. Ct. Rev. 195, 230 (stating that "[r]estrictions on constitutional grants of legislative power, such as the Copyright Clause, would be meaningless if Congress could evade them simply by announcing that it was acting under some broader authority"); Patry, *supra* n. 1, at 361; Theodore H. Davis, Jr., *Copying in the Shadow of the Constitution: The Rational Limits of Trade Dress*, 90 Minn. L. Rev. 595, 640 (1996) ("Congress cannot override constitutional limitations on its own authority merely by invoking the Commerce Clause"); David L. Lange, *The Intellectual Property Clause in Contemporary Trademark Law*, 59 L. & Contemp. Probs. 213 (1996) (noting that it is widely accepted that the clause "functions . . . to constrain Congress in enacting such legislation, through exhortation as well as limitation"); John J. Flynn, *The Orphan Drug Act: An Unconstitutional Exercise of the Patent Power*, 1992 Utah L. Rev. 389, 414, n. 81 (noting that the Copyright and Patent Clause establishes "an implicit policy of precluding the federal government from granting private parties . . . exclusive monopolies . . . other than that authorized by the Patent Clause"); Pollack, *supra* n. 1, at 60.

[93] *Feist*, 499 U.S. at 348 (quoting *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1369 (1981)).

Clause. Later, the Court states that "the facts and ideas [a work] exposes are free for the taking."[94] The strongest evidence that the *Feist* Court envisions a scheme in which factual entries must remain free for the taking is Justice O'Connor's statement that:

> It may seem unfair that much of the fruit of the compiler's labor may be used by others without compensation. As Justice Brennan has correctly observed, however, this is not "some unforeseen byproduct of a statutory scheme." *Harper & Row*, 471 U.S. at 589 (dissenting opinion). It is, rather, "the essence of copyright," *ibid.*, and a constitutional requirement.[95]

Feist expressly tells us that a system in which "raw facts may be copied at will" is "neither unfair nor unfortunate. It is the very means by which copyright advances the progress of science and art."[96]

The *Feist* opinion follows the spirit of several Supreme Court cases with pronouncements suggesting limitations on congressional power designed to ensure that there will be a public domain of information and ideas that are robust (but hardly unlimited). For example, in *Graham*, the Court made it clear that "Congress may not authorize the issuance of patents whose effect are to remove existent knowledge from the public domain, or to restrict free access to materials already available."[97] Two years earlier, in the *Compco Corporation v. Day-Brite Lighting* case, the Court had already put states on notice that they could not create their own intellectual property schemes, which "would interfere with the federal policy, found in [Article] I, [section] 8, [clause] 8 of the Constitution . . . of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain." [98] In *Bonito Boats*, decided three years before *Feist*, Justice O'Connor made it clear that Congress could not create a patent law whose effect would be "to remove existent knowledge from the public domain, or to restrict free access to materials already available."[99]

These pronouncements over the years have reasonably led many commentators to conclude that the C/P Clause establishes a public domain

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[94] *Feist*, 499 U.S. at 349 (quoting Jane C. Ginsberg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 Colum. L. Rev. 1865, 1868, n. 12 (1990)).

[95] *Id.*

[96] *Id.* at 350.

[97] 383 U.S. at 5-6.

[98] 376 U.S. 234, 237 (1964).

[99] 489 U.S. at 146 (Brennan, J., concurring) (quoting *Graham*, 383 U.S. at 6, and stating, "[a]s we have noted in the past, the [Patent and Copyright] Clause contains both a grant of power and certain limitations . . . of that power"). *Bonito Boats* will be discussed at length in pt. V below.

that trumps all possible federal or state intellectual property law.[100] On this reading, the internal limits of the C/P Clause function as a nascent First Amendment against private control of some communications. Congress cannot trample on that freedom the C/P Clause implicitly secured by empowering private actors with rights over non-copyrightable *writings*.

But no one knows the contours of this public domain, what things are/must be in it all the time, what things must be in it *some* of the time, and what things must be in it under some circumstances. Scholars who opine eloquently that the C/P Clause demands that all databases remain unprotected are expressing heartfelt wishes, not cautious judicial thinking.[101]

And that leads us to just one additional step needed to show that this *Feist/Railway Labor* formula carries the day: that the database legislation falls within the particular, discrete area of legislative activity that the C/P Clause covers. This is because, prior to *Feist*, the Court had recognized a variety of (what can be called) intellectual property interests that were not grounded in the C/P Clause. Some of these came before the Court as state law, some as federal law. But as a constellation of cases, they make it clear that the legal system can impose certain limits on reproduction and dissemination of information materials when Congress might lack the power to impose such limits through the C/P Clause.[102]

First, the Court has sanctioned trade secrecy law and concluded that such laws can be compatible with the federal scheme of the C/P Clause.[103] There is nothing in the Court's pronouncements to suggest that trade secrecy law passed by Congress would be constitutionally infirm; indeed,

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[100] *See e.g.* Davis, *supra* n. 92, at 595; Newman, *supra* n. 2, at 713 (reasoning that the Copyright Clause can be read as an "implied grant to the public to copy what is not copyrightable"). David Lange reasons, interestingly, that this public domain is a "natural rights antecedent to the rights of those intellectual property proprietors whom the Clause envisions." Lange, *supra* n. 92, at 227. I am a little discomforted by this notion of mixed natural rights and positive rights regimes, but, it definitely conveys the strength of conviction about the public domain.

[101] Or, as Malla Pollack properly noted, "[w]e have too little [background and] documentation regarding the background and purposes of the Intellectual Property Clause to count on swaying originalists on the Court to read this Clause robustly." Pollack, *supra* n. 1, at 65.

[102] This argument, of course, goes with the rhetoric of calling Article I, sec. 8, cl. 8 the "Intellectual Property Clause," suggesting that the absence of the words "copyright" and "patent" means the clause has a broader scope. As early as 1929, Karl Fenning made this suggestion in a positive way—that the power granted to Congress is not "limited to the particular forms of conditional exclusive rights which were at that time known as copyrights and patents." Fenning, *supra* n. 5, at 116. Nowadays, the argument usually goes to the scope of what the clause forbids.

[103] *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974) (upholding Ohio's trade secrecy law as consistent with, and not preempted by, federal patent law).

federal courts may enforce trade secrets protected by state law[104] and the federal government may extract its own enforceable promises from employees that they will not divulge the government's classified information.[105] Second, the Court has countenanced state law preventing the reproduction and distribution of certain materials in order to protect the right of publicity.[106] In *Zacchini v. Scripps-Howard Broadcasting Co.*,[107] the Court upheld an Ohio law that made it illegal for a television news station to air a film of a human cannonball performance where the performance was public, but the performer had authorized neither the filming nor the broadcast. The *Zacchini* Court was quite clear that it was protecting the defendant against broadcasts that posed a threat to the economic value of his performance and that it was "focusing on the right of the individual to reap the reward of his endeavors."[108]

Both of these types of laws can be distinguished from how database legislation would be likely to work. In *Zacchini*, the Court expressly noted that any state law right of publicity could not prevent reporting the *facts* of the performance.[109] The prohibition on displaying the actual performance was analogized to copyright protection of an *original recording*.[110]

Third, and much more importantly, the Court has recognized that Congress may restrict the flow of information and communicative symbols when such restrictions are necessary to prevent unfair competitive practices.[111] We may argue about what constitutes *unfair competition*, both categorically and case-by-case, but this is the general teaching of both the 1879 *Trade-Mark Cases* and the 1918 Court decision of *International News Service v. Associated Press* case ("*INS*").[112]

In the 1879 *Trade-Mark Cases*,[113] the Court concluded that the words, names, and slogans protected by Congress' attempt at a national trademark law were not *writing* under the C/P Clause because they required "no fancy

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[104] *Seattle Times Co. v. Rhinehart*, 467 U.S. 20 (1984) (federal court may impose protective order to restrict party from revealing trade secrets that it obtained in litigation discovery process).

[105] *Carpenter v. U.S.*, 484 U.S. 19, 25-28 (1987) (holding that federal government can, as a condition of employment, require enforceable promise from employee that he will not reveal classified information).

[106] *See e.g. Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 563 (1977).

[107] *Id.*

[108] *Id.* at 573.

[109] *Id.* at 574. *Cf. id.* at 569 (stating that a case involving *description* of the cannonball act would be "a very different case") (emphasis added).

[110] *Id.* at 577, n. 13 (citing *Goldstein v. Cal.*, 412 U.S. 546, 571 (1973)).

[111] *See e.g. Trade-Mark Cases*, 100 U.S. 82.

[112] *Trade-Mark Cases*, 100 U.S. 82; *Intl. News Serv. v. Assoc. Press*, 248 U.S. 215, 234-35 (1918).

[113] 100 U.S. 82.

or imagination, no genius, no laborious thought."[114] Indeed, as the Court pointed out, one way a name or symbol functions as a trademark is that it is *old* and *well-known*, just the opposite of new and previously unknown.[115] The Court also concluded that the trademark legislation was not within the scope of Congress' Commerce Clause power because the legislation also protected trademarks used only in *intrastate* commerce.[116] As Professor Heald and Sherry conclude, "[t]he case therefore implicitly holds that Congress *may* use its commerce power to protect some things that it could not protect under the Intellectual Property Clause."[117]

In *INS*, the Court not only accepted federal protection against misappropriation of *hot news*, it also *created* such protection, recognizing a *quasi-property* right under then federal common law.[118] During World War I, the British and French barred International News Service ("INS"), part of the Hearst media entities, from the western front. In order to compete with the Associated Press ("AP"), INS systematically reviewed east coast AP-published newspapers, rewrote the facts into news stories, and used the stories in west coast INS newspapers.[119] The Court held that even if the AP did not have any claims on the reported facts vis-à-vis members of the public, it had a *quasi-property* right against its competitor INS.[120] The Court's majority was motivated by—and has since caused to be enshrined in American property jurisprudence—the just desserts sentiment that a defendant should not "reap where it has not sown."[121]

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[114] *Id.* at 94.

[115] *Id.*

[116] *Id.* at 96-97.

[117] Heald and Sherry, *supra* n. 1, at 1156 (emphasis in the original).

[118] 248 U.S. at 234-35 (1918). The dispute was a diversity jurisdiction case prior to *Erie R.R. v. Tompkins*, 304 U.S. 64 (1938), allowing the Court to fashion appropriate *federal common law* under the doctrine of the time.

[119] *See* Richard A. Epstein, *Intl. News Serv. v. Associated Press: Custom and Law as Sources of Property Rights in News*, 78 Va. L. Rev. 85, 91 (1992).

[120] *Intl. News Serv.*, 248 U.S. at 236 (noting that INS was "seeking to make profits at the same time and in the same field").

[121] *Id.* at 239. In *S.F. Arts and Athletics v. U.S. Olympic Comm.*, 483 U.S. 522 (1987) ("Gay Olympics"), the Court upheld a Congressional law granting exclusive commercial control of the Olympics to the U.S. Olympic Committee ("USOC"), even in circumstances where there was no consumer confusion. Part of the Court's willingness to embrace the law was its unfair competition-esque conclusion that much of the value of the Olympics was a result of the USOC's efforts. Sure enough, the Court cites *INS*'s formula about planting and harvests. *S.F. Arts and Athletics*, 483 U.S. at 54. *See* Lange, *supra* n. 92, at 221 (noting that the rhetoric of *free riding* or "reaping where . . . [one] . . . has not sown" is a central concern of current trademark law). *INS* appears regularly in property course casebooks. *See e.g.* Haar & Leibman, *Property and Law* 1017 (3d ed., Little, Brown, and Co. 1977); Jesse Dukeminier & James E. Krier, *Property* 60 (5th ed., Aspen Publg. 2002); Grant S. Nelson, William B. Stoebuch & Dale A. Whitman, *Contemporary Property* 1247 (2d ed., West 2002).

Without copyright infringement as the hook, *INS* marked an express acceptance of certain federal liability for the copying of publicly available information outside the context of the C/P Clause.[122] To put it in terms now popular among intellectual property scholars, the *INS* decision sanctions some limited *enclosure* of material otherwise in the public domain via federal power outside the C/P Clause. The question becomes how much and what kind of enclosure can occur outside the C/P Clause's limitations.[123]

The Court in *Feist* expressly noted that in *INS*, the "Court ultimately rendered judgment for Associated Press on non-copyright grounds that are not relevant here."[124] This cryptic comment seems reasonably taken as recognition that Congress might have some power outside the C/P Clause to regulate unfair competitive practices in information products. That reading of the passage is consistent with the Court's further statement that:

> Protection for the fruits of such research . . . may in certain circumstances be available under a theory of unfair competition. But to accord copyright protection on this basis alone distorts basic copyright principles in that it creates a monopoly in public domain materials without the necessary justification of protecting and encouraging the creation of "writings" by "authors."[125]

While the second part of this passage just repeats the Court's conclusion about originality, the first part—"[p]rotection of the fruits of such research . . . may in certain circumstances be available under a theory of unfair competition. But to accord copyright protection on this basis alone distorts basic copyright principles"—suggests an acknowledgement that an unfair competition law restricting the flow of publicly disclosed information can be built on Commerce Clause power.[126]

The question then becomes—is this database legislation in the gravitational field of *Feist/Railway Labor* or can it be pulled away from those cases and into the orbit of *Trade-Mark Cases/INS*? It is clear that if Congress tried to create *copyright* protection for non-creative databases under the Commerce Clause, we would be in the forbidden zone of the C/P Clause. It is also clear that any transparent ruse by Congress—for example, creating a *database right of reproduction and distribution* with provisions parallel to the copyright provisions in Title 17—would also fall in the

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[122] 248 U.S. at 233.

[123] Hamilton, *supra* n. 42, at 620 (considering *INS* and concluding that "[l]imited enclosure, though, under another congressional power is a viable [option]. The key question is what limits are appropriate and feasible.").

[124] 499 U.S. at 354, n. *.

[125] *Id.* at 354 (quoting M. Nimmer & D. Nimmer, *Copyright* § 3.04, 3-23 (1990)).

[126] *Id.*

forbidden zone of the C/P Clause. To put it in the *equivalency* language,[127] when would database protection legislation be *equivalent* to copyright protection? When would it be *similar, but sufficiently different*?

It is anyone's guess how much space there is for a Commerce Clause-based federal unfair competition law restricting the flow of publicly disclosed information. A few years earlier, Justice O'Connor expressed a very limited view of unfair competition in *Bonito Boats*:

> The law of unfair competition has its roots in the common-law tort of deceit: its general concern is with protecting *consumers* from confusion as to source. While that concern may result in the creation of "quasi-property rights" in communicative symbols, the focus is on the protection of consumers, *not the protection of producers as an incentive to product innovation.*[128]

It is hard to reconcile this very limited view of 'unfair competition' with the language of the *INS* case, which did not focus on west coast newspaper consumers being deceived as to the source of the news. In 1935, Chief Justice Hughes recognized that unfair competition had, even by then, broadened in focus:

> "Unfair competition," as known to the common law, is a limited concept. Primarily, and strictly, it relates to the palming off of one's goods as those of a rival trader. In recent years, its scope has been extended. It has been held to apply to misappropriation as well as misrepresentation, to the selling of another's goods as one's own,— to misappropriation of what equitably belongs to a competitor.[129]

Justice Hughes' 1938 comment is in keeping with both the express conclusion the *INS* majority reached[130] and numerous state court opinions, including the 1950 case of *Metropolitan Opera Association, Inc. v.*

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[127] Lange, *supra* n. 92, at 225 (discussing Malla Pollack's work).

[128] *Bonito Boats*, 489 U.S. at 157 (emphasis added).

[129] *Schechter Poultry Corp. v. U.S.*, 295 U.S. 495, 531-32 (1935) (internal citations omitted). *See Restatement (Third) of Unfair Competition* § 1(3) (1995) (stating that actionable unfair competition includes harm resulting from "acts or practices . . . relating to . . . appropriation of intangible trade values including trade secrets and the right of publicity . . . or from other acts or practices . . . determined to be actionable as an unfair method of competition"). *But see* Lange, *supra* n. 92, at 221, n. 33 (noting that "the Restatement now tries to cut back on misappropriation-based theories").

[130] 248 U.S. at 241-42 (stating, "[i]t is said that the elements of unfair competition are lacking because there is no attempt by defendant to palm off its goods as those of the complainant, characteristic of the most familiar, if not the most typical, cases of unfair competition. But we cannot concede that the right to equitable relief is confined to that class of cases" (internal citations omitted)).

Wagner-Nichols Recorder Corp.[131] In *Metropolitan Opera,* the court faced a misappropriation claim where a record company was marketing recordings of the Metropolitan Opera's performances in the days before sound recordings enjoyed copyright protection.[132] The defendant argued that the elements of unfair competition were "lacking because there is no attempt by defendant to palm off its goods as those of the complainant."[133] But the court would not "concede that the right to equitable relief is confined to that class of cases."[134] Instead, the court reasoned:

> With the passage of those simple and halcyon days when the chief business malpractice was "palming off" and with the development of more complex business relationships and, unfortunately, malpractices, many courts, including the courts of this state, extended the doctrine of unfair competition beyond the cases of "palming off." The extension resulted in the granting of relief in cases where there was no fraud on the public, but only a misappropriation for the commercial advantage of one person of a benefit or "property right" belonging to another.[135]

Without knowing more about what went into Justice O'Connor's statement in *Bonito Boats*, I will bet on a broader understanding of 'unfair competition' that can incorporate a law which protects producers of comprehensive databases from competitive free-riding.

Professors Paul Heald and Suzanna Sherry have offered a very detailed analysis of when and how the Court finds implied limits on Congress' power to legislate. In cases where such arguments are made, Heald and Sherry conclude that the Court has looked to six kinds of historical sources.[136] Unfortunately, none of these six areas provides a rich evidentiary vein for any negative penumbra cast by the C/P Clause over factual compilations.

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[131] 101 N.Y.S.2d 483, 491 (N.Y. App. Div. 1950).

[132] *Id.*

[133] *Id.* at 491.

[134] *Id.*

[135] *Id.* at 489.

[136] My own recitation of their categories is as follows: (a) American historical experience before the Constitution; (b) direct evidence of the views of the Constitution's drafters; (c) evidence of the views of those who ratified the Constitution; (d) early Congressional acts; (e) early court interpretations; and (f) contemporary, popular reactions of "e." *See* Heald & Sherry, *supra* n. 1, at 1129. Heald and Sherry's direct analysis of the historical evidence on which the Court has typically relied is inconclusive as to what Congressional activity the Copyright and Patent Clause might curtail, but they go on to distill a series of 'principles' to judge what the Copyright and Patent Clause might limit. *Id.* at 1159-68. Giving greater focus to the copyright term extension legislation, their application of the 'principles' to database legislation is quite limited. They find the main concern to be a principle of the 'public domain,' not a principle of originality/creativity. *Id.* at 1178.

Of course, one of the six primary evidentiary areas is the legislative activity of early Congresses. The first Congress passed a copyright statute that named "maps" and "charts" as two of the three types of things protected.[137] Would that first Congress have recognized that Benjamin Franklin's almanacs should be copyrightable? How about the tables in Franklin's almanacs? If the answer is yes, it throws the analysis of *Feist* into question. Absent more evidence, the safest bet is legislation that sticks close to *INS* misappropriation.

IV. CONGRESS' COMMERCE CLAUSE POWER VERSUS THE FIRST AMENDMENT

Much has been written about how database legislation is incompatible with the First Amendment. Scholars have ambitiously posited that such legislation would violate a "right to know"[138] or would impinge on constitutionally protected interests in democracy or autonomy.[139] Tempting as such ideas might be, I would start more cautiously.

We have long understood that all "private law doctrines that create proprietary interests in forms of expression must be analyzed carefully [against] . . . constitutional guarantees of free speech and free press."[140] But we also must start from the proposition that the Court will, if possible, adopt a narrow construction of any database protection law *in order to avoid* constitutional questions.[141] Even with statutes that implicate First Amendment interests, we have been told that courts should "construe the statute to avoid constitutional problems, if the statute is subject to such a limiting construction."[142] Second, on the critical question of what level of scrutiny the Court would apply, there are good, but not overwhelming,

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[137] Cong. Ch. 1-15, §1, 1 Stat. 124 (1790).

[138] Pollack, *supra* n. 1, at 72, *et seq.* ("posit[ing] a right to know in the form of a duty by the government not to block access to information"). The more general idea of a *right to know* is found frequently in writings about free expression, democracy, and civil society. *E.g.* William H. Marnell, *The Right to Know: Media and the Common Good* (Seabury Press 1973). There is also an ample *right to copy* literature, but much of that makes narrower claims. *See e.g.* Davis, *supra* n. 92, at 653.

[139] Benkler, *supra* n. 1, at 587.

[140] Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 Cal. L. Rev. 283, 288 (1979).

[141] As the Court noted in *Schneider v. Smith*, "[i]t is part of the stream of authority which admonishes courts to construe statutes narrowly so as to avoid constitutional questions." 390 U.S. 17, 26 (1968) (interpreting statute granting investigatory powers to preclude broad authorization to probe the reading habits of citizens); *see INS v. St. Cyr*, 533 U.S. 289, 300 (2001) (holding statutory interpretation should attempt to avoid constitutional problems).

[142] *N.Y. v. Ferber*, 458 U.S. 747, 769, n. 24 (1982).

reasons to think that the Court would apply intermediate scrutiny. But before turning to that analysis, it is useful to address two common mistakes that are made in many First Amendment analyses of database protection.

A. Facts and Representations of Facts

Analysis of database legislation usually refers to protection of *facts*. For example, an otherwise careful analysis of 1998 database legislation by an office at the Justice Department said, "The legislation would . . . provide protection to ordinary facts, which are not now subject to copyright protection. . . ."[143] The *Feist* opinion itself repeatedly describes the issue as protection of 'facts.'

But *ordinary facts* are in the real world, not fixed on paper. If every copy of every Manhattan phone book were shredded or burned, that might eliminate all *expressions* of the fact of my apartment address on East 12th Street, but it would not eliminate the fact of my apartment address on east 12th Street. We are discussing *expressions* or *representations* of *facts*. A periodic table has *representations* of the facts of atomic elements; the facts themselves are *in* the atoms, so to speak.

Both sides overlook this point—or, more properly, trample upon it. Database protection opponents speak of locking up *facts* and its proponents point out that nothing in these proposals prevents a person from independently gathering the *same* facts. Both sides are correct—some of the time—and precisely because of the difference between facts and *expressions of facts*.

The proponents are correct that the proposed bills do not prevent *de novo* gathering and collection of the same facts. Indeed, replicating statistical results is part of the scientific enterprise, which is why one of the best known parodies in the scientific community is *The Journal of Irreproducible Results*.[144] And the right to recreate a "fenced off" *res* independently has been key in at least one case testing intellectual property laws against the First Amendment.[145] For example, California had a law

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[143] OLC Memorandum *supra* n. 1, at 5. To be fair, the memorandum later offers a better construction of whether Congress could "provide copyright protection to either the listings themselves, or the facts contained in the listings." *Id.* at 9-10.

[144] Society for Irreproducible Research, *The Journal of Irreproducible Results* <http://www.jir.com> (accessed Jan. 12, 2003). To be accurate, scientists seek to recreate results, not facts. The *facts* of one epidemiological study are with the subject persons of that study; confirmation or recreation of the results involves new statistics that are, for the particular purposes at issue, equal in their probative value.

[145] *Goldstein*, 412 U.S. at 546.

prohibiting misappropriation of sound recordings prior to their protection under federal copyright law.[146] In validating that law, the Supreme Court repeatedly noted, "petitioners and other individuals remain free to record the same compositions in precisely the same manner and with the same personnel as appeared on the original recording."[147]

On the other hand, many datasets cannot be reproduced. Some, like historical data on solar flare or seismic tremor activity, may be unique and absolutely irreproducible. Where the raw archival material has been lost through mishap or entropy, the one database built from the now-lost material may be the only access to those facts. Other data sets are simply too expensive to reproduce or only one entity has a genuine ability to gather the data, such as a database on annual U.S. mail deliveries by zip code. In those cases, control over the one *expression* of the data can quickly become control over any *expression* of the data. When the dataset is available from only one entity, we have what has come to be called the *sole source* problem.

The sole source problem is very real for many databases, but not all. For example, there is real competition among legal databases, with Westlaw, Lexis, and LoisLaw competing, not to mention more and more courts putting their cases online. Any data service built upon data from the U.S. Government—like weather data or GPS data—is, by definition, not a sole source information purveyor. When a database is truly a sole source database, then *expression of fact* and *fact* are, *de facto*, one and the same. That means special rules might be needed.

Having said that, there is an important distinction between *facts* and *expressions of facts*. Let me make three additional observations: first, a descriptive explanation of why the two are conflated; and then, two normative explanations of why we may want to conflate them.

First, why are *facts* and *expressions of facts* commonly conflated when it comes to databases, but we have no problem distinguishing *ideas* from *expressions of ideas* in novels, plays, etc.? Because there is often one way—or a very limited number of ways—to express a fact such as to

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[146] *See id.* at 548, n. 1.

[147] *Id.* at 550, 571. Similarly, in defense of the federal law prohibiting disclosure of information obtained by electronic surveillance, the U.S. Justice Department noted that "[a] person who is prohibited from disclosing or otherwise using information obtained through illegal electronic surveillance by Title III is perfectly free to use the identical information as long as it has been obtained by other means." Br. of U.S. at 12, *Bartnicki v. Vopper*, 200 F.3d 109 (3d Cir. 1999); *see* Br. of U.S., *Boehner v. McDermott*, 191 F.3d 463 (D.C. Cir 1999). Critics will rightly point out that a six-member majority of the Court eventually found the statute constitutionally infirm on First Amendment grounds. *See Bartnicki*, 532 U.S. 514 (2001). To me, this just points out how difficult the question is.

include the expression in a tabular or compilation work. Sure, I could write out September 6, 1938 in Spanish words, but that is not a real substitute. The substitutes are pretty limited: 9/6/1938, 9/6/38 (which will soon enough be wrong), and perhaps 6 September 1938. That makes it easy to treat the *expression of fact* as the *fact itself.*

This, in turn, leads to two normative or doctrinal points, both showing how copyright law might be unworkable—but from different directions. First, because of the very limited number of ways available to express many facts, even if party B has independently gathered her set of facts, it may easily appear that party B copied the entries from party A's database. In copyright-speak, even if B independently created her database, there is a good likelihood that B's entries will look *substantially similar* to A's entries. That means that if we tried to protect factual entries under copyright law, we might trigger lots of unfounded litigation because of the substantial similarity of independently gathered databases. In short, high transaction costs for a system creating limited incentives.

But, second, in circumstances where there is only one or a limited number of ways to express an idea, copyright law deploys its *merger doctrine* to deny any copyright protection to the expression.[148] It is not clear to me why the *Feist* case could not have been decided on these grounds: there was no other sensible way to express the information contained in the entries in Rural's telephone book, so even if Rural technically had a copyright over those entries, Feist should have been able to reproduce them. Many, perhaps most, database producers could lose copyright actions on summary judgment simply on the grounds that there is no other way to express the facts represented in the plaintiff's database. (Of course, this would leave most database producers in the same boat—unprotected by their lights.)

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[148] *See e.g. Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967) (holding that limited number of ways to express sweepstake rules meant plaintiff's expression should be denied protection under the *merger doctrine*); *Concrete Machinery Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606 (1st Cir. 1988) ("[w]hen there is essentially only one way to express an idea, the idea and its expression are inseparable and copyright is no bar to copying that expression"); *Computer Assn. Intl. v. Altai, Inc.*, 982 F.2d 693, 709 (2d Cir. 1992) (applying the *merger doctrine* as an "effective way to eliminate non-protectable expression contained in computer programs" where those elements are uniquely efficient ways to achieve the program's purpose); *Digital Commun. Assoc. v. Softklone Distribg. Corp.*, 659 F. Supp. 449, 457 (N.D. Ga. 1987) ("ideas, as such, are not copyrightable and, as a corollary, necessary expressions incident to an idea 'merge' with that idea and also are not copyrightable").

B. *The First Amendment and Information*

We know that the First Amendment is intended to "secure 'the widest possible dissemination of information from diverse and antagonistic sources.'"[149] Despite this goal, the Court has been careful never to state categorically that publication of lawfully obtained truthful information "is automatically constitutionally protected."[150]

Too often commentators show a tendency toward indiscriminate assertions that legal restrictions on *information* or any diminution of the *public domain* will jeopardize democracy and civil society. But not all categories of information are created equal—at least not for purposes of the republican democracy and civil society the Constitution envisioned. Broad-stroked images of autonomy and democratic society are, in the words of one of my colleagues, "too expansive . . . to assist reliably with drawing the constitutional line between information that should be accessible to the people and information that is less constitutionally significant."[151]

A database of details of soap opera episodes is not as important to democratic society as a database of details of legislators' votes. While we may not know what information will be important for policies on public education or global climate change, we can be sure that a database on horse racing or movie star addresses is less important than a database of judicial opinions or gene sequences. A rough hierarchy can be drawn, even if it can never be complete and always will be imperfect.[152] Thus, the fact that the Court has repeatedly barred sanctions for republishing truthful, lawfully acquired information relating to crimes[153] does not lead inextricably to the

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[149] *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 266 (1964) (quoting *Associated Press v. U. S.*, 326 U.S. 1, 20 (1945)).

[150] *The Fla. Star v. B.J.F.*, 491 U.S. 524, 541 (1989).

[151] Hamilton, *supra* n. 42, at 606. In addition to conversations with Marci Hamilton, I have also profited from discussions of the First Amendment issues with James Weinstein, whose article is also in this symposium volume.

[152] Admittedly, one can always construct an argument that a database of *X* is necessary and vital to discuss the public policy issues surrounding *X*, whether *X* is high school test scores or horse races or lipstick shades. It is just that public policy about high schools is generally more important than public policy about horse racing, which in turn, is generally more important than any public policy issues concerning lipstick colors. Yes, the lipsticks might be poisoned with higher fatality rates among fashion victims, but this does not disprove a general hierarchy that can be guessed *ex ante*.

[153] *The Fla. Star*, 491 U.S. at 524 (state law could not forbid a newspaper from publishing the name of a rape victim that had inadvertently been put on a [publicly-available] police blotter); *Smith v. Daily Mail*, 443 U.S. 97 (1979) (vacating an indictment of two newspapers for publishing name of juvenile offender learned from legal monitoring of police radio band); *Okla. Publg Co. v. Okla. County*, 430 U.S. 308 (1977) (refusing to enjoin publication of name obtained at a public juvenile proceeding);

conclusion that the Court would bar a general database law on the same basis (particularly where the law arguably encourages private production and distribution of more data).

In any discussion of the republican democracy's need for information, we must recognize that the federal government already provides massive amounts of information freely—far, far more than is necessary to fulfill the Constitution's express provisions for government disclosure of information. From federal budget information to weather data to the results of billions of dollars in research grants, the government pours vast stockpiles of information into the public domain as part of a conscious program to fuel both the economy and civil society.[154]

The federal government disavows any copyright in such works—even to the point that when government material is integrated into an otherwise copyrightable work of a private party, the private party has an obligation to identify the unprotected (government) portions. The federal government has a general policy, even in the post 9/11 environment, that when information is made publicly available, it should be available at no or marginal cost. Taken as a whole, this information-dissemination strategy is in sharp contrast to the practices of many other industrialized democracies.

These policies would not justify federal database protection, *i.e.*, it would not be an acceptable argument to say that Congress has gratuitously filled the public domain and may now substantially drain it. But to the degree that database protection legislation includes safeguards to ensure public access to information *necessary and/or valuable to representative democratic government and civil society* (versus public access to any and all information), then the legislation already substantially addresses First Amendment concerns.

First, both H.R. 354 and H.R. 1858 included express provisions barring any database rights over information the federal government has generated.[155] In 1998, the Administration issued *six principles* for any extra-

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Cox Broad. Corp. v. Cohn, 430 U.S. 469 (1975) (vacating civil award against station that published rape victim's name obtained from public courthouse records).

[154] *See* Office of Management and Budget, *Circular No. A-130 Management of Federal Information Resources* <http://www.whitehouse.gov/omb/circulars/a130/a130trans4.html> § 7.b (accessed Jan. 13, 2003) ("Government information is a valuable national resource. It provides the public with knowledge of the government, society, and economy—past, present, and future. It is a means to ensure the accountability of government, to manage the government's operations, to maintain the healthy performance of the economy, and is itself a commodity in the marketplace.").

[155] H.R. 354, 106th Cong. at § 1401 (Oct. 8, 1999), as initially introduced provided:

> Protection under this chapter shall not extend to collections of information gathered, organized, or maintained by or for a government entity, whether Federal, State, or local, including by any employee or agent of such government entity, or any person substantially funded by, exclusively licensed by, or working under contract to such government to achieve a government purpose or fulfill a government obligation as established by law or regulation,

copyright protection of databases, including the third principle that "[c]onsistent with Administration policies expressed in relevant Office of Management and Budget circulars and federal regulations, databases generated with Government funding generally should not be placed under exclusive control, *de jure* or *de facto*, of private parties."[156] In keeping with that view, the Administration urged that the prohibition on protection of government-generated information be broadened in both H.R. 354 and H.R. 1858 to include all information generated by government contracts and government grants.[157]

If the Administration was correct that the U.S. Government creates, collects, and distributes "possibly more [information] than any other entity in the world,"[158] then a strong statutory provision barring propertization of this raw data certainly *serves* the public domain. Such a provision would not prevent a private entity from taking the raw data, adding value, and claiming exclusionary rights over the value-added product. That is exactly what we want entrepreneurs to do with such data because, even while they may charge for the improved information product, its introduction into the marketplace of ideas enriches that marketplace. Moreover, even in such circumstances, it would be possible to provide statutory mechanisms to make citizens aware of free public sources of raw data.[159] The point is that there are many ways that a database protection law could protect the public domain and even a few ways in which it might enrich it.

C. *The Level of Scrutiny*

A critical question is what kind of scrutiny would the Court use to evaluate extra-copyright protection of databases.

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if such collections of information are gathered, organized or maintained within the scope of the employment, agency, license, grant, contract, or funding. Nothing in this subsection shall preclude protection under this chapter for information gathered, organized, or maintained by such a person that is not within the scope of such employment, agency, license, grant, contract, or funding, or by a Federal or State educational institution in the course of engaging in education or scholarship.

Id.

[156] *1999 Administration Statement on H.R. 354*, *supra* n. 35.

[157] *Id.*; *see 1999 Administration Statement on H.R. 1858*, *supra* n. 38.

[158] *Id.*

[159] *Id.* (stating that "we believe that any database protection law along the lines of H.R. 354 should require any private database producer whose database includes a substantial amount of government-generated data to note that fact with reasonably sufficient details about the government source of the data").

The courts have used different devices to judge the appropriate degree of First Amendment scrutiny for laws that regulate speech, but the distinction between whether a statute is *content-based* or *content-neutral* is "a (if not the) crucial determination in evaluating a particular regulation of speech."[160] The government's purpose in imposing the speech restriction "is the controlling consideration" in categorizing the restriction as content-based or content-neutral.[161] A statute is *content-based*, and therefore subject to "the most exacting scrutiny," if it seeks to "suppress, disadvantage, or impose differential burdens upon speech because of its content."[162] The court is to ask whether the government has adopted the restriction "because of disagreement with the message [the speech] conveys."[163] In contrast, a statute is *content-neutral* if it is "justified without reference to the content of the regulated speech."[164]

We are familiar with the rationale for the content neutrality doctrine: when a restriction on speech is not the product of government disapproval of the message (or that particular kind of message), there is less risk that particular ideas and views will be excluded from public debate. "[R]egulations that are unrelated to the content of speech" are subject to intermediate scrutiny, because they ordinarily "pose a less substantial risk of excising certain ideas or viewpoints from the public dialogue."[165] A statute satisfies intermediate scrutiny if it furthers an important or substantial governmental interest; if the governmental interest is unrelated to the restrictive effects on expression; and if the restrictive effects on speech are not unnecessarily great.[166]

It seems to me that by the lights of precedent a database protection law would be both viewpoint and content-neutral.[167] The proposals to date are unquestionably viewpoint neutral. They would affect the data compilations of everyone—liberals and conservatives; Mormons and atheists; and anarchists and monarchists. But Professor Marci Hamilton has raised the question of whether these bills are actually content-neutral because they are

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[160] *Rappa v. New Castle County*, 18 F.3d 1043, 1053 (3d Cir. 1994).

[161] *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989).

[162] *Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622, 642 (1994).

[163] *Ward*, 491 U.S. at 791.

[164] *Clark v. Community for Creative Non-Violence*, 468 U.S. 288, 293 (1984).

[165] *Turner*, 512 U.S. at 642; *Rappa*, 18 F.3d at 1053.

[166] In contrast, content-based speech restrictions are ordinarily subject to strict scrutiny, meaning that the government must "show that the 'regulation is necessary to serve a compelling state interest and that it is narrowly drawn to achieve that end.'" *Rappa*, 18 F.3d at 1053 (quoting *Boos v. Barry*, 485 U.S. 312, 321 (1988) (internal quotation marks omitted)).

[167] OLC Memorandum, *supra* n. 1, at 22. In contrast to content-specific laws, "H.R. 2652 would not target any particular types of messages for suppression. It would instead prescribe the means by which collections of information that had been compiled may be used by others." *Id.*

"aimed at a particular type of content: facts and information."[168] This is an interesting point.

Part of the answer is that the proposals for database legislation are, on their face, more content neutral than copyright law. While copyright law discriminates in some important ways between true facts and fiction, the database proposals do not.[169] All versions of database protection floating about Washington for the past five years would apply equally to a tabular chronology of events in the Civil War (fact) and a tabular chronology of the history of Yoknapatwapha County (fiction). On the other hand, the database protection proposals arguably do discriminate as to the form in which information is presented—if database protection would not protect a narrative account of the Civil War, but would protect a timeline chronology, there is discrimination as to *form.* Although the problem is not absolutely resolved, I do not think this would be *content* discrimination as the Court has elaborated it.

Congress' intent with any extra-copyright protection of databases—to promulgate economic regulation in an *information economy*—reinforces the above conclusion. We may question whether the economic regulation is wise; we may believe that it gives unjustified monopoly rents to a few upstream data collectors; but it is very hard to detect any motivation beyond economics. In other words, we have a situation similar to the speech-dampening effects of the section 1201(a)(2) and 1201(b)(1) of the Digital Millennium Copyright Act.[170]

If this is correct, then extra-copyright database protection would be subject to intermediate scrutiny, and we might apply the analysis used in

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[168] Hamilton, *supra* n. 42, at 625.

[169] *See* Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 Duke L.J. 147, 186 (1998) (suggesting, without elaboration, that copyright law, while view-point neutral, is not content-neutral).

[170] *Universal City Studios v. Reimerdes*, 111 F. Supp. 2d 294, 329 (S.D.N.Y. 2000) (upholding section 1201(a)(2) against a First Amendment attack on the grounds that Congress intended to promulgate an economic regulation; *i.e.*, "[t]he reason that Congress enacted the anti-trafficking provision of the DMCA had nothing to do with suppressing particular ideas of computer programmers and everything to do with functionality—with preventing people from circumventing technological access control measures"). In affirming, the Second Circuit concluded that section 1201(a)(2) is "a content-neutral regulation with an incidental effect on a speech component" backed up by a substantial interest in economic regulation. *Universal City Studios v. Corley*, 273 F.3d 429, 454 (2d Cir. 2001) ("The Government's interest in preventing unauthorized access to encrypted copyrighted material is unquestionably substantial, and the regulation of DeCSS by the posting prohibition plainly serves that interest.").

United States v. O'Brien.[171] Would the database law comport with the requirement of "narrow tailoring," if it were applied? Certainly those testing the law's constitutionality would point to other possible means of protecting the investment in database products, but the Supreme Court has been careful not to allow the narrow tailoring test to become one that places courts in the shoes of legislators.

In its loosest form, the narrow tailoring requirement is satisfied "so long as the . . . regulation promotes a substantial government interest that would be achieved less effectively absent the regulation."[172] In *Ward v. Rock Against Racism*, the Supreme Court was clear:

> So long as the means chosen are not substantially broader than necessary to achieve the government's interest . . . the regulation will not be invalid simply because a court concludes that the government's interest could be adequately served by some less-speech-restrictive alternative.[173]

Least-restrictive-alternative analysis is "wholly out of place."[174] Thus, in order to invalidate the database law, a court will have to have more than a disagreement with Congress about how best to create reasonable incentives in this area of the economy.

The question then turns on whether the mechanism of the basic prohibition operating with the many exceptions built into the law is a reasonably tailored effort to protect private financial investment in databases while leaving unaffected the free dissemination of information obtained through means that do not implicate that financial interest.

D. Facial Challenge or Case-by-Case Assessment?

An initial question in a First Amendment critique of any law is whether the law could be subject to a constitutional attack on its face. If not, the law's constitutionality must be tested on a case-by-case basis—a far less appealing approach, because the law is generally left intact as to those fact patterns not yet brought before the courts. The First Amendment doctrines of overbreadth and vagueness provide the principal basis for a facial challenge to any extra-copyright protection of databases.

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[171] 391 U.S. 367, 385 (1968); *see* Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. Rev. 354, 372, n. 83, 413, n. 230 (1999).

[172] *Ward*, 491 U.S. at 799; *U.S. v. Albertini*, 472 U.S. 675, 689 (1985).

[173] 491 U.S. at 799.

[174] *Id.* at n. 6.

The void-for-vagueness doctrine requires that a statute define an offense "with sufficient definiteness that ordinary people can understand what conduct is prohibited and in a manner that does not encourage arbitrary and discriminatory enforcement."[175] Although this due process doctrine has its roots—and principal application—in criminal law, the Supreme Court has made it clear that it also applies, albeit in less rigorous form, in civil cases. Where only civil penalties are at issue, a statute's prohibitions may still be void-for-vagueness where the statutory standards are "so vague and indefinite as really to be no rule or standard at all."[176]

Because of the new terminology employed in these proposals—"collection of information,"[177] "duplicate of a database,"[178] and "information"—void-for-vagueness is an appealing banner under which to march onto the First Amendment field. Curiously, the advocates of database protection have failed to recognize that if they insist on the statute having criminal penalties, they may be increasing the likelihood that these untested concepts will make the statute constitutionally infirm. The Court has invalidated a number of statutes on the grounds that ill-defined gray zones of potential liability chill too much speech.[179] If a database protection law has both civil and criminal liability, it is likely to attract the same void-for-vagueness scrutiny. Even if limited only to civil liability, the vagueness problem is real and one that could be partially addressed, for example, by narrowing key definitions.

While the vagueness doctrine is an application of due process principles, the overbreadth doctrine is a standing tool to permit prompt

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[175] *Kolender v. Lawson*, 461 U.S. 352, 357 (1983).

[176] *Boutilier v. INS*, 387 U.S. 118, 123 (1967) (civil statute void for vagueness only if it is "so vague and indefinite as really to be no rule or standard at all") (citing *Small Co. v. Am. Sugar Ref. Co.*, 267 U.S. 233, 239 (1925)); *see* Tim Searchinger, *Note: The Procedural Due Process Approach to Administrative Discretion: The Courts' Inverted Analysis*, 95 Yale L.J. 1017, 1026 (1986) ("Although courts apply void-for-vagueness chiefly to criminal and quasi-criminal laws, its rationales apply also to the adjudication of government benefits.").

[177] For example, "collection of information" was defined in H.R. 354, 106th Cong. § 1401 as "information that has been collected and has been organized for the purpose of bringing together discrete items of information together in one place or through one source so that users may access them." That definition could easily apply to, for example, a biography of a political figure or an information kiosk in an airport, although these are far beyond what the proponents of H.R. 354 intended.

[178] In H.R. 1858, 106th Cong. § 101, a "duplicate of a database" is defined as a database that is "substantially the same as [the first] database, and was made by extracting information from such other database." In other words, it is not an exact duplicate, but judged on a substantial sameness test. That test is likely to be copyright's substantial similarity test, but we do not know.

[179] *Kolender*, 461 U.S. 352 (1983) (invalidating a California loitering statute for vagueness); *Smith v. Goguen*, 415 U.S. 566 (1974) (invalidating a Massachusetts flag desecration statute on vagueness grounds); *Gooding v. Wilson*, 405 U.S. 518 (1972) (voiding a Georgia "abusive words" statute on vagueness grounds).

challenge of statutes that are potentially speech-inhibiting.[180] The overbreadth doctrine "prohibits the Government from banning unprotected speech if a substantial amount of protected speech is prohibited or chilled in the process."[181] But analyzing a database protection law under the overbreadth doctrine is not as easy as the parallel analysis of an anti-pornography law. While I believe that a database protection law could have constitutional applications against data misappropriation by commercial competitors, ambiguous definitions and inadequate exceptions could provide fertile ground for a successful overbreadth challenge. Consider a defendant who (a) copied an extensive amount of data from a commercial database; (b) reintroduced the data into public discourse in the context of a political dispute; (c) had no for-profit motive; and (d) did this under circumstances where the data was the "sole source," *i.e.*, there was no other viable resource from which the data[182] could be obtained. For concerns of both vagueness and overbreadth, proponents of database protection need to think much more seriously about these kinds of situations.

E. How Database Protection Could Be Upheld

Some First Amendment critiques of database legislation fail to take full account of the "speech ledger"; *i.e.*, how much does the database legislation *cause* new speech to be introduced into the marketplace of ideas versus how much restriction it imposes on speech already in the marketplace. This is the same kind of balancing that occurs with copyright.[183] As the Court said in *Turner Broadcasting*, "assuring that the public has access to a multiplicity of information sources is a governmental purpose of the highest order, for it promotes values central to the First Amendment."[184] The creation of property or quasi-property rights over expression X does not

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[180] *Clark v. City of Lakewood*, 259 F.3d 996, 1010 (9th Cir. 2001) ("Under the overbreadth doctrine . . . prudential considerations have weighed in favor of allowing litigants to bring First Amendment challenges on behalf of those whose expression might be impermissibly chilled, so long as the plaintiff also suffers an injury in fact.").

[181] *Ashcroft v. Free Speech Coalition*, 535 U.S. 234 (2002).

[182] Perhaps the data is a published report on student performances in various public schools from an extensive study, and the immediate political dispute is replacement of the school superintendent.

[183] *See* OLC Memorandum, *supra* n. 1, at 24 ("it arguably could be defended as a legitimate attempt to recognize individual rights in intellectual property in order to ensure an overall increase in the amount of available, valuable factual information (because of the heightened incentives to compile facts)"); Ginsburg, *supra* n. 5, at 386.

[184] *Turner*, 512 U.S. at 663.

mean that expression X disappears from the public discourse; it just determines from which information sources expression X will come.[185]

If the database law provides members of the public with the assurance that they can disseminate existing databases to the public without the risk of immediately losing much of the financial investment in those databases, it can fall within this genre of federal law that serves the interests of the First Amendment. If it provides incentives for the creation and distribution of databases that do not yet exist, then it also fulfills that model.

As yet, there is no empirical evidence that extra-copyright protection of database would have such effects. Early data from the European Union do not show any increase in commercial database production following implementation of their 1996 Database Directive, but in fairness to the Europeans, it is much too early to expect such results. A positive effect on net information production and dissemination remains a real possibility—and might be a genuine justification for passing such legislation, particularly a narrow misappropriation bill.

That is why, if such legislation was signed into law, opponents would want to pick the fact patterns for their first challenges very carefully. In a situation in which someone laboriously researched *X*, the defendant took all the data and reintroduced it into the marketplace, was sued, and raised a First Amendment defense, one could well imagine the Court repeating its words in *San Francisco Arts and Athletics v. U.S. Olympic Comm.* ("*Gay Olympics*"): "The mere fact that [petitioner] claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to 'appropriat[e] to itself the harvest of those who have sown.'"[186]

A database law also *might* prompt database producers to make their products available in more and less restrictive ways. This returns us to one of the larger issues in the database debates. The debates over database protection were perceived by many as part of a larger shift in favor of intellectual property owners. This shift is often seen as having three components: (1) technological developments; (2) intellectual property laws; and (3) contract law—all evolving in ways favorable to control by content producers. Critics are concerned that the wrong combination of developments in these three areas could substantially alter the existing balance between content owners and content users.

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[185] *Zacchini*, 433 U.S. at 572-73 (noting that the real question in a right of publicity case is not whether information will be publicly unavailable, but rather which party will make it publicly available).

[186] 483 U.S. at 541 (quoting *INS*, 248 U.S. at 215).

But it is possible that promulgation of a database protection law will actually retard the rise of legal and technological self-help. It is *possible*, for example, that a database producer protected by the database law will be willing to distribute her database on CD-ROM as well as password-controlled Internet access. It is *possible* that a database producer protected by the new law will skip the plastic shrink-wrap license on the print version of his database, although the behavior of copyrighted software makers admittedly does not bode well for this development.

This leads to a key point already mentioned in the limited context of putting government-generated information outside the protection regime: the exceptions and exemptions from a database protection law could prove more important than the protection itself—and favor the First Amendment interests over what would exist without the law. A properly crafted law could provide courts with the grounds to say that certain contractual provisions will not be enforced or the breach of certain technological measures will not incur liability because the content owner-imposed restrictions violate the balance created by the new intellectual property law. Brave and principled courts might conclude that the balance struck by copyright and database protection cannot be completely undone by contracts because enforcing such contracts would, in effect, result in state law preempting a balanced federal scheme. "Database protection misuse" could take its place next to patent misuse and copyright misuse as a doctrine to curb overreaching and over-enclosing contract provisions.

V. THE FRAMEWORK OF CONSTITUTIONALITY FOR A STATE LAW

There was a scare a couple years ago in Washington, D.C. intellectual property circles when it was learned that a Georgia state legislator had introduced a bill in the statehouse in Atlanta to create database protection. Was this a nefarious plot by database proponents to route around the blockage in Washington? Without knowing the details, I am doubtful. After all, Washington D.C. lobbyists would likely lose business if the legislative battle turned to statehouses—so they would be unlikely to recommend such a strategy. In any case, the Georgia bill died quietly and the prospect of a state legislating on this issue seems dim.

But if the dim became reality, would a state statute creating extra-copyright protection of databases be constitutional? As I said in the introduction, the analysis here is derivative of Parts III and IV. In the case of the First Amendment, the analysis is the same. If the First Amendment dictates that Congress lacks the power to pass a database law of *X* contours, then the states lack that power as well.

The state law analysis in relation to the C/P Clause is different. The vehicle for the analysis is the preemption doctrine, not the interaction at the federal Constitution level between general and enumerated powers. Preemption analysis is traditionally understood as having three main prongs: (1) when the federal law expressly preempts the state law; (2) when the necessary operation of the federal statute requires that the state law be set aside; or, (3) more ambiguously, when the public policy underlying the federal statute will be frustrated by enforcement of the state law, so the state law is set aside.

But in addition to these factors, we need to consider the possibility of preemption by the constitutional scheme itself, *i.e.*, can a state's law, whether legislation or common law, be preempted by the Constitution's grant of power to Congress *even though Congress has not exercised that power*? Obviously, the Dormant Commerce Clause is the best-known example of the Constitution itself, without congressional action, establishing a zone of impermissible legislative activity by the state governments. So understood, the taxonomy of *possible* preemption looks like this:

	1. Congress has legislated	2. Congress has not
Preemption by	a. express statute provision	a. C/P Clause.
	b. necessary operation of federal law	
	c. public policy of federal law	

It is worthwhile to lay out the preemption scheme in this manner because (1.c) and (2.a) may, for most situations, be indistinguishable. Yet there may be situations in which Congress had not established statutory law and a state law arguably contravenes the public policy embedded in the C/P Clause, even though Congress has been silent on the issue. And, as Jane Ginsburg has noted, the Court sometimes seems "to waver between a preemption analysis based solely on the relationship between state law and the federal statute, and a broader preemption analysis derived from the Patent-Copyright Clause."[187]

Let us consider preemption situations, moving from the familiar to the untested. Copyright law easily generates examples of express preemption (1.a). Section 301 of the Copyright Act provides that federal copyright law expressly preempts "all legal or equitable rights that are equivalent to any

[187] Ginsburg, *supra* n. 5, at 363.

of the exclusive rights within the general scope of copyright."[188] This preemption of rights applies to "works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103" of the Copyright Act.[189]

In the face of this provision, what would happen if the State of Ohio passed a *petit copyright* law that added 20 years of protection in Ohio to works enjoying federal copyright protection, the 20 years beginning at the end of the federal copyright term? Section 301 would preempt this.

Now, what if Ohio gave a 20-year term of protection to works that are *non-copyrightable* under federal law (such as unfixed works or non-original databases or the ideas in the novels of Ohio authors)? The Ohio Attorney General may argue that the state law survives preemption *because* it does not apply to "works of authorship that . . . come within the subject matter of copyright as specified by sections 102 and 103" of the federal law.[190] But this argument would fail.

Courts and commentators generally agree that the *subject matter* for purposes of *preemption* is not the same as subject matter for purposes of *protection*, and that "the former is in fact broader than the latter."[191] Another way to state this is that works of authorship not meeting the originality threshold standard are within the *subject matter* of federal copyright, but fail to meet its *requirements*.[192] As one circuit court has noted, if the law were otherwise, "states would be free to expand the perimeters of copyright protection . . . on the theory that preemption would be no bar to state protection of material not meeting federal statutory standards."[193]

In this case, the Ohio *petit copyright* would be preempted, but would it be preempted because it expressly conflicts with the statute (1.a), because it frustrates the operation of federal copyright law (1.b), or because it undermines the public policy of federal copyright law (1.c)? I think people could sensibly differ on this, particularly between (1.b) and (1.c). The *Bonito Boats* case could similarly fall in both categories vis-à-vis patent law. The state statute at issue in *Bonito Boats* provided property rights to

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[188] 17 U.S.C. § 301(a) (2002).

[189] *Id.*

[190] *Id.*

[191] *Katz Dochtermann & Epstein, Inc. v. Home Box Off.*, 50 U.S.P.Q.2d 1957, 1959 (S.D. Ill. 1999) (holding that *ideas* in copyrightable ad campaign that were not copyrightable could not be protected by state law of misappropriation of ideas); *U.S. ex. rel. Berge v. Bd. of Trustees*, 104 F.3d 1453, 1463 (4th Cir. 1997); *Markogianis v. Burger King Corp.*, 42 U.S.P.Q.2d 1862 (S.D.N.Y. 1997); *see* Mark Lemley, *Beyond Preemption: The Law and Policy of Intellectual Property Licensing*, 87 Cal. L. Rev. 111, 140, n. 124 (1999).

[192] *Id.*

[193] *Harper & Row*, 723 F.2d at 200.

low-level innovation, which patent law had clearly put outside the intellectual property scheme. The Court invalidated the legislation because "[w]here it is clear how the patent laws strike [the] balance in a particular circumstance, that is not a judgment the States may second-guess."[194] So, by disturbing the federal scheme's line between protected and unprotected works, the Ohio law would certainly compromise the public policy of federal copyright law.

The preemption argument against a state law then connects to our discussion about the field of control exercised by the C/P Clause. The question(s) is: if Congress could not legislate database law of *X* contours because such legislation is outside the limits of the enumerated power in the C/P Clause, does the Clause so constrain a state legislature? Conversely, if Congress *can* legislate a database law of *X* contours under its Commerce Clause authority but does not do so, does the Constitution still restrain the states from acting?

In the 1963 *Compco* case,[195] discussed briefly above, the Court seemed to take a strong line that state law cannot tamper with the balanced scheme of control of and access to information established by Congress' patent and copyright laws. The *Compco* analysis seemed to be (2.a) preemption in my taxonomy, that is "preemption worked directly via the Intellectual Property Clause."[196] But 10 years later, in *Goldstein v. California*, the Court upheld a California law protecting sound recordings at a time when federal copyright law did not. The Court reasoned that:

> [T]he clause of the Constitution granting to Congress the power to issue copyrights does not provide that such power shall vest exclusively in the Federal Government. Nor does the Constitution expressly provide that the States shall not exercise such power.[197]

The Court firmly reiterated this approach in the 1989 *Bonito Boats* decision observing that "[o]ur decisions since *Sears* and *Compco* have made it clear that the Patent and Copyright Clauses do not, by their own force or by negative implication, deprive the States of the power to adopt rules for the promotion of intellectual creation within their own jurisdictions."[198] Thus, a

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[194] *Bonito Boats*, 489 U.S. at 152.

[195] *Compco Corp. v. Day-Brite Lighting*, 376 U.S. 234 (1963) (application of state law preempted by federal patent law).

[196] Lange, *supra* n. 92, at 228.

[197] *Goldstein*, 412 U.S. at 553; *see Kewanee Oil Corp. v. Bicron Corp.*, 416 U.S. 470 (1974) (reaffirming the point in upholding state trade secrecy law); *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257 (1979).

[198] *Bonito Boats*, 489 U.S. at 165.

limit on Congress through the checks and balances at the federal level does not mean that the states would be constrained in the same ways.

Yet when it comes to the states we are still left with an open question. If the C/P Clause establishes a public domain that Congress may not tamper with, nothing in *Goldstein* or *Bonito Boats* says that states *may* tamper with that public domain. If the C/P Clause circumscribes a protected public domain, the protection may be against action by the states as well as against action by Congress. If the public domain-creating force of the C/P Clause does not hobble states as well as Congress, then the public domain created is fairly fragile.

To see what the states and Congress might do, let us consider the one place courts and states seem to have quietly developed unfair competition law concerning information products.

Almost everyone agrees that a constitutional law could be crafted along the lines of Judge Winter's 1997 decision in *National Basketball Association v. Motorola.*[199] In *Motorola*, the NBA claimed that Motorola's sports score reporting service, "SportsTrax"—available through its pagers—misappropriated valuable commercial information from the NBA.[200] Motorola obtained the scores by having data gatherers/inputers watch NBA games on broadcast television, so there was no claim that Motorola agents were disseminating information from NBA games in violation of some contractual provision attached to ticket sales.[201] The NBA brought a misappropriation claim under New York common law.[202]

Judge Winter was faced with: (a) the *INS* analysis (which had been *federal* common law); (b) a wide state law misappropriation doctrine crafted by New York courts in *Metropolitan Opera* and its progeny; (c) the 1976 Copyright Act's explicit preemption provision; (d) the relatively recent *Feist* decision; and (e) no attempt by New York courts to address the misappropriation doctrine since (c) and (d). The court concluded that only a narrow New York cause of action for misappropriation had survived the developments since *Metropolitan Opera* and that the elements of such a cause of action largely tracked *INS*.[203]

> (i) the plaintiff generates or collects information at some cost or expense; (ii) the value of the information is highly time-sensitive; (iii) the defendant's use of the information constitutes free-riding on the plaintiff's costly efforts to generate or collect it; (iv) the

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[199] 105 F.3d 841 (2d Cir. 1997).
[200] *Id.*
[201] *Id.*
[202] *Id.*
[203] *Id.*

> defendant's use of the information is in direct competition with a product or service offered by the plaintiff; [and] (v) the ability of other parties to free-ride on the efforts of the plaintiff would so reduce the incentive to produce the product or service that its existence or quality would be substantially threatened [if the free-riding continued].[204]

Not only did the court conclude that there was no direct competition between any of the NBA's products and Motorola's SportsTrax service, the court's rationale would effectively deny the NBA relief even if it had a competing sports score service. This is because Motorola's use of the information in no way *reduced the incentive* to produce the scores. That is, the use did not reduce the incentive to put on games themselves.

The *Motorola* court placed great emphasis on how the expansion of the Copyright Act in 1976 and preemption doctrine narrowed the possible range of any *INS*-style misappropriation doctrine. Following the statutory prescription in the Copyright Act that a state law claim would only survive preemption if it had an *extra element* not found in a copyright infringement cause of action, Judge Winter favored an approach "that the 'extra element' test should not be applied so as to allow state claims to survive preemption easily."[205] The court did *not* say the First Amendment compelled the limits it drew.

At least one New York state court has used the *Motorola* formula, but no New York state court has embraced it in situations where its requirements would deny relief to a party that might be entitled to press claims under the more liberal *Metropolitan Opera* doctrine.[206]

Opponents of database legislation point to the *Motorola* analysis as being the *limits* of what is constitutionally possible for a state law navigating *INS*, *Feist*, and Section 301. I am not as sure, particularly to requirements (ii), (iv), and (v). As to requirement (iv), federal courts in New Jersey and Delaware have been of the same mind as Judge Winter, finding that direct competition is a requirement for a misappropriation

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[204] *Id.* at 852 (internal citation omitted).

[205] *Id.*

[206] In *Lynch, Jones, & Ryan v. Standard & Poor's*, 47 U.S.P.Q.2d 1759 (N.Y. Sup. Ct. 1998), the state court concluded that Standard and Poor's dissemination of economic data from Lynch Jones' *Redbook* during a 35 minute *embargo period* when the Redbook information was available to subscribing investors but not yet released to the general public constituted misappropriation of *hot news*. The court noted that the "plaintiff here [had] met all of the criteria necessary to bring such a [*Motorola*] cause of action." *Id.*

cause of action under the laws of those states.[207] But several other states—California, Tennessee, and Illinois—have construed their misappropriation causes of action more broadly and permitted claims to go forward against indirect competitors.[208]

While *INS* did concern highly *time-sensitive* news and the Court noted that "novelty and freshness form so important an element in the success of the business" at issue,[209] the Supreme Court characterized the Court of Appeals as directing an injunction in favor of the Associated Press against "any bodily taking of the words or substance of complainant's news until its commercial value as news had passed away."[210] The Court's general discussion of what it finds objectionable in *INS*'s practices do not focus on the extreme short-term value of the news.[211]

Finally, while conditions (i)-(iv) could be found in the *INS* case itself, the high barrier of requirement (v)—that the free-riding by the defendant threaten the plaintiff's data collection activity—was not present in *INS*. The Associated Press did not claim it was at risk of going under—or pulling its reporters from the western front because of INS's activities. Indeed, the Court said that it was enjoining INS "only to the extent necessary to prevent that competitor from reaping the fruits of complainant's efforts and expenditure," but *not* to the extent of preventing the plaintiff from being able to gather the news.[212]

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[207] *U.S. Golf Assn. v. St. Andrews Sys.*, 749 F.2d 1028 (3d Cir. 1984) (interpreting N.J. law and requiring direct competition); *Natl. Football League v. Gov. of the St. of Del.*, 435 F. Supp. 1372 (D. Del. 1977); *see generally Restatement (Third) of Unfair Competition*, § 38 cmt. c. (1993):

> In most of the small number of cases in which the misappropriation doctrine has been determinative, the defendant's appropriation, like that in *INS*, resulted in direct competition in the plaintiff's primary market. . . . Appeals to the misappropriation doctrine are almost always rejected when the appropriation does not intrude upon the plaintiff's primary market.

[208] *See e.g. U. S. Golf Assn. v. Arroyo Software Corp.*, 49 U.S.P.Q.2d 1979 (Cal. Ct. App. 1999) (finding golf handicap formulae misappropriated by software maker under Cal. law); *Bd. of Trade v. Dow Jones & Co.*, 439 N.E.2d 536 (1982), *aff'd*, 456 N.E.2d 84 (1983).

[209] 248 U.S. at 238.

[210] *Id.* at 232.

[211] *See id.* at 239-40.

> In doing this defendant, by its very act, admits that it is taking material that has been acquired by complainant as the result of organization and the expenditure of labor, skill, and money, and which is salable by complainant for money, and that defendant in appropriating it and selling it as its own is endeavoring to reap where it has not sown, and by disposing of it to newspapers that are competitors of complainant's members is appropriating to itself the harvest of those who have sown. Stripped of all disguises, the process amounts to an unauthorized interference with the normal operation of complainant's legitimate business precisely at the point where the profit is to be reaped.

Id.

[212] *Id.* at 241.

VI. HOW TO WRITE A CONSTITUTIONAL DATABASE PROTECTION LAW

So, having laid out all of these issues, how can extra-copyright protection of databases be constitutional? Being at just that level of risk adversity that makes Rawls' *Theory of Justice* ring true in my head, I do not have any strong inclination to gamble. But if I were to bet on a database protection law passing constitutional muster with the Court, I would want it to have the following elements.

A. Focus on the Activities of "Competitors," Including Those Bent on Destroying a Market for "Kicks"

The (visible) bottom line is simple: the more a law seems to trigger liability on "the mere fact of copying itself," the more the law will have to withstand scrutiny from—and exist within the environment of—the C/P Clause.[213] The more a database protection law impinges upon activities among commercial competitors, the more it will appear to be a reasonable regulation of business practices in the spirit of *INS*. In *INS*, the Court emphasized that the issue the two news services had brought was "not so much the rights of either party as against the public but their rights as between themselves."[214]

Both proposals in the House have allowed regulation of databases "in commerce," but we need to pay more attention to the varied ways in which American jurisprudence now relies upon a commercial/non-commercial distinction and the notion of *commercial* activities. Despite what dictionaries and common sense tell us, *use in commerce* and *commercial use* are not always the same thing. In trademark law, itself a subspecies of unfair competition, actionable *use in commerce* unquestionably includes activities of non-profit and charitable organizations.[215] In copyright law, we have seen a shift from *commercial use* being understood as for-profit activities toward an understanding of *commercial use* as equivalent to mass distribution and/or market-substituting distributions.

I mention this because it may be necessary to clarify our notion of *commercial activity* or *commercial use* in order to catch an ample range of

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[213] Lange, *supra* n. 92, at 244.

[214] 248 U.S. at 236.

[215] *See e.g. U.S. Jaycees v. S.F. Junior Chamber of Comm.*, 354 F. Supp. 61, 64-65 (N.D. Cal. 1972), *aff'd*, 513 F.2d. 1226 (9th Cir. 1975); J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §§ 9.5, 9-12 (4th ed., West Group 1996).

market-substituting activities without making *every* recycling of factual entries into *commercial activity* just because a database producer could charge for the reuse. That kind of circular reasoning can be seen in a few copyright cases and has been rightly criticized for its circularity. Not every reintroduction of information is done by a *competitor* and not every unauthorized user is a *pirate*. In short, we may need to make some normative decisions about what will count as actionable and stop hiding behind notions like *commercial activity*.

B. Ensure "Fair Use" Co-Extensive with Copyright Law

Beyond properly focusing on the basic prohibition of such a statute, I think nothing is more important to its constitutionality than ensuring that it embodies *fair use* at least as broad as provided in copyright law.[216] Indeed, while I recommend that the statute be moved away from the copyright law, this is one place where exact replication of the copyright criteria has enormous value in avoiding First Amendment concerns.[217]

C. Create Mechanisms to Avoid "Sole Source" Problems

The discussion above criticized most courts and commentators for failing to distinguish between *facts,* which do not occur in *tangible medium* and *expressions of facts*, which are what is really at issue in database protection cases. There are times when controlling a particular set of *expressions of fact* does not get you much because anyone else can collect the same facts. For example, if I offer you a list of airlines that serve O'Hare Airport in Chicago for X dollars, you'll rightly judge the X price against an afternoon visiting the terminals at O'Hare to make your own list of airlines. There are other times when controlling a particular set of expressions of facts gets you a great deal—because it is either impossible or impractical to recollect the facts and no one else has a competing set of their expression.

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[216] The Administration has consistently espoused this. *See 1999 Administration Statement on H.R. 354*, *supra* n. 35, at 5 (stating "[a]ny database misappropriation regime should provide exceptions analogous to 'fair use' principles of copyright law; in particular, any effects on non-commercial research should be *de minimis*").

[217] Commenting on then H.R. 354, the Administration noted, "[p]roviding the safeguard of familiar fair use criteria can help minimize any unintended consequences of the untested basic operating provisions of section 1402. We believe that this would give courts the tools they need to do justice in particular situations." *1999 Administration Statement on H.R. 354*, *supra* n. 35, at § E.

In these latter situations, any form of database protection carries with it the possibility that it could further insulate a *sole source* database provider against potential competition and, thereby, be the foundation for unwarranted monopoly rents. Vigorous antitrust laws and vigorous intellectual property *misuse* doctrines are a partial safeguard, but may not be enough. My own view—which was reflected in Administration positions in 1998 and 1999—is that tools like copyright's *merger* doctrine and antitrust's *essential facility* doctrine might provide the right kind of safety valves.

D. Ensure Database Rights Really Expire

If the incentive structure of the database law works properly, there is an increased dissemination of information, and the exceptions provided in the law ensure that much of the value of this information accrues to the society, not the database producer. In other words, utility accrues to the community at large even while the term of protection is in effect. But once the term of protection is over, the information becomes part of—and enriches—the public domain. This could be another "positive" in any First Amendment analysis of the database law.

One of the most disturbing things about the EU Database Directive is that the rights never seem to expire: nothing ever need enter the public domain. As long as the database producer invests in refreshing, updating, or even re-verifying the database, a new term of protection is generated over the entire database. The problem becomes acute with any constantly updated, on-line database that has antecedents more than 15 years old. If a paper copy of the 15-year-old antecedent were available, the user could take freely from that copy of the old database. If the database is only on-line, however, the user will have to guess which entries are new investments. The effect is that free uses of unprotected data entries would be chilled. The political impracticality of solving this problem with a vast, national repository of public domain databases seen as equaled only by the technical impracticality of *tagging* data entries with protection expiration dates[218] (but one should never say never with technical impracticality).

For this reason, in the spring of 1999, the Administration proposed a private sector oriented solution: any database producer seeking to avail

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[218] *See* Jane C. Ginsburg, *U.S. Initiatives to Protect Works of Low Authorship* (paper submitted to N.Y.U. Conf. on Intell. Products: Novel Claims to Protection and Their Boundaries, Engelberg Center on Innovation L. and Policy (La Pietra, Italy) (June 25-28, 1998) (arguing that publishers should identify the expired components of protected compilations)).

themselves of database protection for a product with 15-year-plus antecedents would have to ensure that the unprotected antecedents were reasonably available to the public *or* risk being unable to enforce their rights.[219] If this were part of a database protection law, consider how much the law would actually enrich the public domain over the long term.

E. Move the Statute to Title 15

Everyone acknowledges that a database protection law should not appear to be a congressional end-run around the C/P Clause—and that a perception of congressional subterfuge would not sit well with the Court.[220] But commentators and lobbyists have generally been unwilling to go where this reasoning actually leads. The database protection bill should *not* be part of Title 17, which is predominantly the copyright statute (and treated by everyone as *wholly* the copyright statute). Instead, we should consider whether database protection legislation should be re-conceptualized as part the Lanham Act—that is, as truly part of the law of unfair competition.[221]

F. Abandon the "Measured Qualitatively" Formula

The idea that a quantitatively small taking can still be substantial because it takes the heart of a work was enshrined in copyright law in *Harper & Row v. Nation*.[222] In that case, the Court concluded that the copying of a mere 300 words from former President Gerald Ford's 450-page biography constituted actionable copying.

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[219] *See 1999 Administration Statement on H.R. 354*, *supra* n. 35, at § F ("Where the database that is the subject of a litigation is the descendant of a now unprotected database and has substantial elements in common with that unprotected database, the defendant should be able to raise, as a defense, that the most recent unprotected iteration of the database is not reasonably publicly available.").

[220] *See e.g. Ry. Lab. Execs. Assn.*, 455 U.S. at 467-68, 471 ("The events surrounding the passage of [the statute], as well as its legislative history, indicate that Congress was exercising its powers under the Bankruptcy Clause. In [the statute], Congress was responding to the crisis resulting from the Rock Island [Railroad] as an operating entity. The Act was passed almost five years after the Rock Island had initiated reorganization proceedings under § 77 of the Bankruptcy Act, and approximately 10 months after a strike had rendered the Rock Island unable to pay its operating expenses.").

[221] *See e.g.* U.S. Copyright Office, *Report on Legal Protection of Databases* <http://www.copyright.gov/reports/db4.pdf> 109-110 (1997) (noting that the Court's reasoning in *Railway Labor* was a problem for database legislation, but arguing that the situation could be distinguished). Obviously, the Copyright Office has an interest in seeing the legislation put in Title 17, its area of expertise.

[222] 471 U.S. 539 (1985).

While the *Harper & Row* reasoning is certainly defensible, it makes less sense with large, comprehensive databases. Yes, there will be some databases that have *some* entries that are more rare and harder to obtain than other entries (similar to an extremely rare collector's stamp from the 19th century versus 20th century stamp issues). But in general, the *qualitatively* substantial measure could create real prospects of vexatious litigation. The added incentive it produces—compared to a database protection law that protected against only *quantitatively* substantial takings—is minimal at best. Little or no added incentive plus the prospect of high transaction costs results in a provision of the proposed law that should be jettisoned.

G. Limit Liability to Civil Liability

There is no question in my mind that database producers would be well advised to settle for a civil liability statute, instead of insisting on a statute backed by criminal sanctions. Quite reasonably, the courts have cast a more critical eye on criminal liability statutes that affect First Amendment activities.[223] If the legislation is properly focused on the activities of commercial competitors, money damages will serve in most cases as a proper disincentive. While there may be a need to threaten hackers and information anarchists with jail time, that need does not outweigh the increased risk of constitutional infirmity that comes with criminal provisions.

H. Establish a Genuine Legislative Record

What would be very desirable here—and in other places where Congress seeks to intervene in the national economy—is to have a legislative record of the market failure that is being addressed. There need not be the sort of fact-finding that the Court has recently insisted upon in Eleventh Amendment cases,[224] but it should be the kind of committee report that assuages concerns that extra-copyright database legislation is just

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[223] *See Kolender*, 461 U.S. at 357 (stating that "the void-for-vagueness doctrine requires that a penal statute define the criminal offense with sufficient definiteness that ordinary people can understand what conduct is prohibited and in a manner that does not encourage arbitrary and discriminatory enforcement").

[224] *See Kimel v. Fla. Bd. of Regents*, 528 U.S. 62, 91 (2000) (criticizing "Congress' failure to uncover any significant pattern of unconstitutional discrimination"); *Fla. Prepaid Postsecondary Educ. Expense Bd. v. College Sav. Bank*, 527 U.S. 627, 645 (1999) (claiming that there is no legislative record to establish that Congress was responding to "widespread and persisting deprivation" of rights).

another monopoly rent purchased by special interests for a modest amount of campaign contributions, receptions, and lobbying.[225]

VII. CONCLUSION

Among those who believe that the database protection law is unconstitutional, there are almost certainly some who believe that *INS* was wrongly decided. For these scholars and advocates, Justice Brandeis stated it best in his *INS* dissent:

> The general rule of law is, that the noblest of human productions—knowledge, truths ascertained, conceptions, and ideas—become, after voluntary communication to others, free as the air to common use.[226]

The problem, as the Supreme Court noted half a century later, is that "there is no fixed, immutable line to tell us which 'human productions' are private property and which are so general as to become 'free as the air.'"[227]

Instead, we are left to draw lines that put *some* human information products under *some* limited control of *some* particular humans. A purist may believe that this entire process is bankrupt and that information really does 'want to be free.' I am not that purist. I don't think information *wants* anything and even if it did, that would not decide the matter. Generally speaking, animals want to run free—that does not mean it is wise to let them do so in all circumstances.

With the right combination of incentive, limitations, and exceptions, database protection could increase the amount of information in the public domain. With the wrong combination of the same, it could weaken the public domain, give a few people monopoly rents, and do little or no good for public discourse. In the end, each person who has studied the matter will have his or her own intuition about what legislation in this area will do as a policy matter. And—in the end—what it does as policy will determine whether it is constitutional.

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[225] *See* Hamilton, *supra* n. 42, at 623 (noting with 1999 bills that the absence of fact-finding regarding the database industry was "striking").

[226] *Intl. News Serv.*, 248 U.S. at 250 (Brandeis, J., dissenting).

[227] *Goldstein*, 412 U.S. at 570.