

CONGRESS CAN'T TRADE AMERICA'S "AIR": COPYRIGHT, THE "KINDRED SUBJECT OF PATENT"¹

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INTRODUCTION

When Congress passed the Uruguay Round Agreements Act ("URAA") in 1994,² it allowed foreign companies, for the first time,³ to copyright work from the public domain.⁴ In doing so, Congress undeniably restrained the air that Justice Brandeis proclaimed free when he declared, "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."⁵ By passing the URAA, just over 200 years after the United States declared independence from

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1. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59 (1884).

2. Uruguay Round Agreements Act, Pub. L. No. 103-465, sec. 514, § 104A, 108 Stat. 4809, 4976-81 (1994) (codified at 17 U.S.C. § 104A).

3. Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. ILL. L. REV. 1119, 1179 (2000).

4. First Amended Complaint at 3, *Golan v. Gonzales*, 310 F. Supp. 2d 1215 (D. Colo. 2004) (No. 01-B-1854) ("Section 514 of the URAA mandates a 'wholesale removal of vast amounts of existing works—thousands of books, paintings, drawings, music, films, photographs, and other artistic works—from the public domain.'"). The URAA and its advocates describe this as "restoring" copyright. Uruguay Round Agreements Act, sec. 514, § 104A, 108 Stat. at 4976-81. *See also* S. REP. NO. 103-412, at 10 (1994) ("The copyright subtitle . . . restores copyright protection to works already in the public domain in the United States but still under protection in a WTO Member that is the source of the work."). However, as every affected work has a U.S. copyright for the first time through passage of the URAA, this appears to be a mere semantic avoidance of the more accurate description that the URAA "secures" copyright in these works. *See* U.S. CONST. art. I, § 8, cl. 8.

5. *Int'l News Serv. v. Associated Press*, 248 U.S. 215, 250 (1918) (Brandeis, J., dissenting).

England, Congress has taken an unprecedented step toward bringing U.S. copyright law back into line with the laws of England, mainland Europe, and the rest of the international community.⁶ Congress passed the Act in order to meet international trade obligations⁷ with its supporters proclaiming, “The Uruguay round is the most comprehensive trade agreement in history” and an “unprecedented opportunity to benefit the United States, create new high-paying jobs, and strengthen our economy.”⁸

The general problem with trying to force international law onto our constitutional system is particularly apparent in the copyright context, because this is an area in which the disparity between the prevailing view of the world community and the American view is especially large.⁹ For example, whereas the American perspective is that copyright is a means of providing an inducement for authors to create new works in order to achieve a greater purpose,¹⁰ the majority of the world views copyright as an end in its own right, based on granting authors “moral rights” to exert control over their work.¹¹

In *The End of Copyright*, David Nimmer describes the passage of the URAA as representing “the first tremors of certain tectonic shifts in United States sovereignty” that call into question “the identity of the master in the copyright sphere.”¹² Professor Nimmer suggests that, in passing the URAA, Congress created a dramatic clash

6. See *infra* Part I. For a general discussion of the increasing trend toward internationalization of copyright, see Richard B. Graves III, *Globalization, Treaty Powers, and the Limits of the Intellectual Property Clause*, 50 J. COPYRIGHT SOC’Y U.S.A. 199 (2003).

7. The URAA is entitled, “An Act to approve and implement the trade agreements concluded in the Uruguay Round of multilateral trade negotiations.” Uruguay Round Agreements Act, sec. 514, § 104A, 108 Stat. at 4976–81. See also Doris E. Long, *Copyright and the Uruguay Round Agreements: A New Era of Protection or an Illusory Promise?*, 22 AIPLA Q.J. 531, 565 (1995).

8. 140 CONG. REC. S15271-03, at S15278 (Dec. 1, 1994) (statement of Sen. Cochran).

9. See Long, *supra* note 7, at 533 (referring to some of the disagreements regarding copyright policy as entailing “diametrically opposed views”).

10. E.g., *Harper & Row, Publishers, Inc., v. Nation Enters.*, 471 U.S. 539, 580 (1985) (Brennan, J., dissenting) (quoting H.R. REP. NO. 60-2222, at 7 (1909) (“The enactment of copyright legislation by Congress under the terms of the Constitution is not based upon any natural right that the author has in his writings . . . but upon the ground that the welfare of the public will be served and progress of science and useful arts will be promoted by securing to authors for limited periods the exclusive rights to their writings.”)).

11. Doris Long notes that, during debate on the General Agreement on Tariffs and Trade, “[a]mong the developed countries that submitted drafts, the United States was the only one which sought to exclude moral rights.” Long, *supra* note 7, at 552.

12. David Nimmer, *The End of Copyright*, 48 VAND. L. REV. 1385, 1385–86 (1995).

between international trade law and the United States Constitution,¹³ a fray into which courts have only begun to tread.¹⁴ To meet our international obligations, Congress ignored the Constitution, specifically the Patent and Copyright Clause.¹⁵ Professor Nimmer fears that trade law will win this clash, as "all legal doctrines are collapsing into the gigantic crunch of trade law."¹⁶

In this Essay, I describe how the Patent and Copyright Clause¹⁷ insists that Congress cannot so readily trade America's "air." In Part I of this Essay, I briefly discuss section 514 of the URAA, in which Congress granted foreign authors copyright to works in the public domain, and I review two recent challenges to this section under the Patent and Copyright Clause. In Part II, I analyze why the URAA must be subject to the limitations of the Patent and Copyright Clause. In Part III, I describe two reasons why this Clause dictates that section 514 is unconstitutional. First, I briefly explore how section 514 unconstitutionally grants copyrights to entities other than "authors."¹⁸ Then, I explain why the rule from *Graham v. John Deere Co.*,¹⁹ which states that patents may not be secured for works in the public domain, applies with equal force to copyright.²⁰

I. SECTION 514 OF THE URAA AND CHALLENGES TO ITS CONSTITUTIONALITY

Congress enacted the URAA in order to comply with the United States' obligations as a member of the World Trade Organization.²¹

13. *Id.* at 1386.

14. *See infra* Part I.

15. U.S. CONST. art. I, § 8, cl. 8.

16. Nimmer, *supra* note 12, at 1387.

17. Commentators usually describe Article I, Section 8, Clause 8 in its entirety as "the Intellectual Property Clause," see, e.g., Ray Patterson, *Understanding the Copyright Clause*, 47 J. COPYRIGHT SOC'Y U.S.A. 365, 367 (2000), although "the Patent and Copyright Clause" or the "Progress Clause" are also common, see, e.g., Dotan Oliar, *Making Sense of the Intellectual Property Clause: Promotion of Progress as a Limitation on Congress's Intellectual Property Power*, 94 GEO. L.J. 1771, 1772–73 n.1 (2006). The words of the Clause relevant to patents are often described as "the Patent Clause" and those relevant to copyright as "the Copyright Clause." *Id.* For the sake of convenience, I will refer throughout this essay to the Clause as "the Patent and Copyright Clause."

18. U.S. CONST. art. I, § 8, cl. 8. *See infra* Part III.A.

19. 383 U.S. 1, 6 (1966).

20. *See infra* Part III.B.2.

21. *See, e.g.*, David E. Shipley, *What Do Flexible Road Signs, Children's Clothes and the Allied Campaign in Europe During WWII Have in Common? The Public Domain and the Supreme Court's Intellectual Property Jurisprudence*, 13 U. BALT. INTELL. PROP. L.J. 57, 98–99 (2005).

The United States became a member of the Berne Convention for the Protection of Literary and Artistic Works²² in 1988.²³ Article 18 of the Convention “requires that the terms of the Convention apply to all works that have fallen into the public domain for reasons other than expiration of their term of copyright.”²⁴ The Berne Convention is not self-executing, however, and the United States never passed legislation implementing Article 18.²⁵ During 1993 and 1994, following over seven years of world trade talks, 111 countries drafted and signed the Uruguay Round of the Multilateral Trade Negotiations on the General Agreement on Tariffs and Trade (“GATT”).²⁶ The United States is a signatory member of GATT, including the associated Agreement on Trade Related Aspects of Intellectual Property Rights (“TRIPS”).²⁷ Congress passed the URAA in 1994 to implement these agreements into U.S. law.²⁸

Section 514 of the URAA automatically grants copyright protection to foreign copyright holders whose works are protected in their own country, but which are in the public domain in the United States, for three separate reasons.²⁹ First, the URAA grants copyright to works if the foreign copyright owner failed to comply with U.S. copyright formalities.³⁰ Second, a copyright is granted if the subject matter was not previously, but now is, copyrightable in the United States, such as sound recordings recorded before 1972.³¹ Finally, a foreign work is granted a U.S. copyright if the United States had previously failed to recognize copyrights from the owner’s home country.³²

21. See Long, *supra* note 7, at 572–73.

22. Berne Convention for the Protection of Literary and Artistic Works, July 24, 1974, 828 U.N.T.S. 221, 275, 277.

23. Edward C. Walterscheid, *Understanding the Copyright Act of 1790: The Issue of Common Law Copyright in America and the Modern Interpretation of the Copyright Power*, 53 J. COPYRIGHT SOC’Y U.S.A. 313, 353 n.46 (2006).

24. Long, *supra* note 7, at 571.

25. S. REP. NO. 103-412, at 225 (1994); *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77, 83 (2d Cir. 1995). See also *Quality King Distribs., Inc. v. L’anza Research Int’l, Inc.*, 523 U.S. 135, 153 (1998) (“Equally irrelevant is the fact that the Executive Branch of the Government has entered into at least five international trade agreements . . . none has been ratified by the Senate.”).

26. Long, *supra* note 7, at 533.

27. *Id.*

28. Shipley, *supra* note 21, at 98–99.

29. Uruguay Round Agreements Act, Pub. L. No. 103-465, sec. 514, § 104A(h)(6), 108 Stat. 4809, 4980–81 (1994); S. REP. NO. 103-412, at 225–26 (1994).

30. Uruguay Round Agreements Act, sec. 514, § 104A(h)(6), 108 Stat. at 4980–81.

31. See Long, *supra* note 7, at 572–73.

32. Uruguay Round Agreements Act, sec. 514, § 104A(h)(6), 108 Stat. at 4980–81.

Since the URAA was first passed, critics have raised serious questions about the constitutionality of section 514.³³ Two cases challenging this section as unconstitutional under the Patent and Copyright Clause have thus far reached the federal circuit courts of appeals, *Luck's Music Library, Inc. v. Ashcroft*³⁴ and *Golan v. Gonzales*.³⁵

In *Luck's Music Library*, a "family-owned, corporation that repackage[d] and [sold] works already in the public domain," joined Moviecraft, a business that preserved films that were already in the public domain, to argue that the Patent and Copyright Clause of the Constitution "requires the public to have free access to copy and use works once they have fallen into the public domain."³⁶ In *Golan v. Gonzales*, another group of "artists or purveyors of art material" also challenged the constitutionality of section 514. They proposed that once a work goes into the public domain the Patent and Copyright Clause prohibits Congress from removing it from free use.³⁷

In both cases, the district courts that first considered these issues rejected the notion that Congress lacks authority to pass section 514

33. This Essay only explores the constitutionality of section 514 under the Patent and Copyright Clause, but section 514 has also been challenged as violating the First Amendment in the same cases discussed within this section. *E.g.*, *Golan v. Ashcroft*, 310 F. Supp. 2d 1215, 1220 (D. Colo. 2004), *aff'd in part, remanded in part sub nom.* *Golan v. Gonzales*, 501 F.3d 1179 (10th Cir. 2007). With respect to whether it violates the Takings Clause, Due Process, and Equal Protection, see generally Thomas Gordon Kennedy, *GATT-out of the Public Domain: Constitutional Dimensions of Foreign Copyright Restoration*, 11 ST. JOHN'S J. LEGAL COMMENT. 545 (1996). Section 514 is not the only part of the URAA to face constitutional challenges. In addition, sections 512 (17 U.S.C. § 1101) and 513 (18 U.S.C. § 2319A), anti-bootlegging statutes that establish civil and criminal penalties, respectively, for recording and trafficking copies of live musical performances, have been challenged as unconstitutional under both the Patent and Copyright Clause and the First Amendment. *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999) (Patent and Copyright Clause); *United States v. Martignon*, 346 F. Supp. 2d 413 (S.D.N.Y. 2004), *vacated*, 492 F.3d 140 (2d Cir. 2007) (Patent and Copyright Clause and the First Amendment). See also Joseph C. Merschman, *Anchoring Copyright Laws in the Copyright Clause: Halting the Commerce Clause End Run Around Limits on Congress's Copyright Power*, 34 CONN. L. REV. 661 (2002).

34. 407 F.3d 1262 (D.C. Cir. 2005).

35. 501 F.3d 1179.

36. *Luck's Music Library v. Ashcroft*, 321 F. Supp. 2d 107, 110, 112 (D.D.C. 2004), *aff'd*, 407 F.3d 1262 (D.C. Cir. 2005). See also Amanda Roach, Case Summary, *Luck's Music Library v. Ashcroft* 321 F. Supp. 2d 107 (2004), 15 DEPAUL-LCA J. ART & ENT. L. & POL'Y 421 (2005).

37. Plaintiffs combined this challenge with an argument that the Copyright Term Extension Act was unconstitutional, which the District Court held was foreclosed by the Supreme Court's decision in *Eldred v. Gonzales*, 537 U.S. 186 (2003), *Golan v. Ashcroft*, 310 F. Supp. 2d at 1216-18.

under the Patent and Copyright Clause.³⁸ When considering Luck's challenge, the District Court for the District of Columbia relied on the Supreme Court's direction that "[t]o comprehend the scope of Congress' power under the IP clause, 'a page of history is worth a volume of logic.'" ³⁹ The Court reviewed the history of copyright law⁴⁰ and concluded that "Congress' past actions show a clear history of allowing retroactive copyrights, lending significant weight" to the argument that section 514 is constitutional.⁴¹ In *Golan*, the District Court for Colorado also considered Congress' historical treatment of copyright.⁴² Finding that "[o]n the whole, Congress has historically demonstrated little compunction about removing copyrightable materials from the public domain," the court held that Congress acted within its authority under the Patent and Copyright Clause.⁴³

In their respective reviews of the historical treatment of copyright, both district courts relied on an understanding that the very first Copyright Act, passed in 1790, demonstrates that "[t]he First Congress evidently determined that [removing works from the public domain] was constitutionally permissible."⁴⁴ In an essay critical of the reasoning in both of these cases, Edward Walterscheid notes that these two courts maintained a flawed understanding of copyright's history in reliance on the Supreme Court's interpretation of the Copyright Act of 1790 in *Wheaton v. Peters*.⁴⁵ Disapproving of the courts' reliance on a judicial opinion concerning that statute rather than on the original copyright statute itself, Walterscheid opines, "Reliance on judicial legerdemain in interpreting the 1790 Copyright Act is a frail reed on which to predicate the copyright power of Congress."⁴⁶ After reviewing the historical treatment of copyright, he concludes that "a basic premise used by courts in the past several years to justify the constitutionality of . . . Section 514 of the URAA is suspect at best."⁴⁷

38. *Luck's Music Library*, 321 F. Supp. 2d at 112; *Golan v. Gonzales*, No. Civ.01-B-1854(BNB), 2005 WL 914754, at *14 (D. Colo. Apr. 20, 2005), *aff'd in part, remanded in part*, 501 F.3d 1179 (10th Cir. 2007).

39. *Luck's Music Library*, 321 F. Supp. 2d at 113 (quoting *Eldred*, 537 U.S. at 200) (internal brackets omitted).

40. *Id.* at 113–16.

41. *Id.* at 116.

42. *Golan v. Gonzales*, 2005 WL 914754, at *5–14.

43. *Id.* at *14.

44. *Id.* at *11. See also *Luck's Music Library*, 321 F. Supp. 2d at 113.

45. Walterscheid, *supra* note 23, at 353 (citing *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834)).

46. *Id.* at 353 (footnote omitted).

47. *Id.*

I will not attempt to resolve whether this historical understanding is flawed, except to recall the fact that “no one acquires a vested or protected right in violation of the Constitution by long use, even when that span of time covers our entire national existence.”⁴⁸ Thus, regardless of whether Congress historically believed that it could remove work from the public domain, this issue is not determinative of the larger question: whether such an action is prohibited by the Constitution.

With respect to congressional authority to pass section 514, the district court in *Golan* reasoned, “[T]hat the public domain is indeed public does not mandate that the threshold across which works pass into it cannot be traversed in both directions.”⁴⁹ The district court in *Golan* was also particularly forthright in its opinion regarding the applicability of patent doctrine to copyright. According to that court’s view,

Removal of existent knowledge from the public domain is a persistent danger in the expansion of patent monopolies and, for that reason, informs courts’ understanding of Congress’ patent power to a considerable degree. That danger, however, is not lurking within the retroactive expansion of copyrights It is unlikely that the public has a greater interest in copyrightable works than it does in patentable ones.⁵⁰

The district court in *Luck’s Music Library* agreed that a constitutional prohibition on Congress with respect to patents is “inapplicable” to copyright.⁵¹ In *Golan*, the district court built upon this basic attempt to distinguish copyrights from patents to further assert, “[E]xpansion of the copyright does not impede the progress of science and the useful arts to the extent that expansion of the patent might.”⁵²

When the plaintiffs in *Luck’s Music Library* appealed their case to the D.C. Circuit, they fared no better than they had at the district level.⁵³ After hearing the appeal, the D.C. Circuit affirmed the district court’s view that the Patent and Copyright Clause does not prohibit

48. *Walz v. Tax Comm’n*, 397 U.S. 664, 678 (1970).

49. *Golan v. Gonzales*, No. Civ.01-B-1854(BNB), 2005 WL 914754, at *3 (D. Colo. Apr. 20, 2005), *aff’d in part, remanded in part*, 501 F.3d 1179 (10th Cir. 2007).

50. *Id.* at *5 (citation omitted).

51. *Luck’s Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107, 116–17 (D.D.C. 2004) *aff’d sub nom. Luck’s Music Library, Inc. v. Gonzales*, 407 F.3d 1262 (D.C. Cir. 2005). This prohibition is discussed *infra* Part III.B.1.

52. *Golan v. Gonzales*, 2005 WL 914754, at *12.

53. *Luck’s Music Library*, 407 F.3d at 1262.

Congress from removing works from the public domain.⁵⁴ Relying on an understanding of *Eldred v. Ashcroft*⁵⁵ as holding that Congress need have only a rational basis in order to pass copyright legislation, the D.C. Circuit stressed the trade implications of the URAA, quoting a U.S. Senate report that stated that “[section 514] helped secure better foreign protection for U.S. intellectual property and was ‘a significant opportunity to reduce the impact of copyright piracy on our world trade position.’”⁵⁶ Relying on a substantially similar understanding of the history of copyright as that expressed by the district courts,⁵⁷ the D.C. Circuit also disposed of the argument that patent law’s prohibition applies to copyright, noting, “[T]he case dealt with patents rather than copyright, and ideas applicable to one don’t automatically apply to the other.”⁵⁸ The court further distinguished patent from copyright because, unlike inventors of patents, an “author is eager to disclose her work.”⁵⁹

In support of the government’s position in Golan’s appeal to the Tenth Circuit, amici crafted an argument distinct from that relied upon by the government or the lower court.⁶⁰ Amici proposed that any discussion of whether the Patent and Copyright Clause would authorize Congress to pass section 514 is irrelevant to a consideration of whether section 514 is constitutional, as Congress can, in the alternative, pass the statute under the Commerce Clause or the Treaty Power.⁶¹

Before addressing this paper’s thesis that both district courts and the D.C. Circuit erred by refusing to apply patent doctrine to copyright, I first respond to amici’s argument. I describe why limitations of the Patent and Copyright Clause must apply to congressional acts, regardless of the power under which they are invoked.

54. *Id.* at 1263.

55. 537 U.S. 186 (2003).

56. *Luck’s Music Library*, 407 F.3d at 1264 (quoting S. REP. NO. 100-352, at 2 (1988)).

57. *Id.* at 1265–66.

58. *Id.* at 1266.

59. *Id.*

60. Brief for The International Coalition for Copyright Protection as Amici Curiae Supporting Respondents, *Golan v. Gonzales*, 501 F.3d 1179 (10th Cir. 2007).

61. *Id.* at 1182–84.

II. CONGRESS MAY NOT SIDESTEP THE PATENT AND COPYRIGHT CLAUSE BY INVOKING ANOTHER ARTICLE I POWER

The Patent and Copyright Clause is “both a grant of power and a limitation.”⁶² While it is clear that, under this Clause, Congress has “broad” power,⁶³ and that Congress may “implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim,”⁶⁴ it is equally apparent that this power is not unlimited. As the Supreme Court has cautioned, “The clause thus describes both the objective which Congress may seek and the means to achieve it.”⁶⁵ In *Sony Corp. of America v. Universal City Studios, Inc.*, the Court referred with approval to Congress’ own declaration of a check upon its copyright power: “In enacting a copyright law Congress must consider . . . how much will the monopoly granted be detrimental to the public?”⁶⁶ Some commentators have suggested that the patent and copyright “power of Congress was enumerated in the Constitution *for the purpose of expressing its limitations.*”⁶⁷ Still, to say that the Patent and Copyright Clause provides an important limitation on the power of Congress does not specifically delineate the boundaries of those limits. Nonetheless, over the years the Court has made clear that the outer limit of Congress’ discretion is bounded in a number of ways, including by the meanings of “limited times,”⁶⁸ “author,”⁶⁹ and “inventor.”⁷⁰ Commentators have also described additional limitations “of constitutional weight” derived from the Patent and Copyright Clause as a whole.⁷¹

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

63. *Goldstein v. California*, 412 U.S. 546, 561–62 (1973) (“[T]he area in which Congress may act is broad . . .”).

64. *Graham*, 383 U.S. at 6.

65. *Goldstein*, 412 U.S. at 555.

66. 464 U.S. 417, 429 n.10 (1984) (quoting H.R. REP. NO. 60-2222, at 7 (1909)).

67. Heald & Sherry, *supra* note 3, at 1153 (quoting 1 WILLIAM W. CROSSKEY, POLITICS AND THE CONSTITUTION IN THE HISTORY OF THE UNITED STATES 486 (Univ. of Chicago Press 1953)). See also Graves III, *supra* note 6, at 204.

68. *Eldred v. Ashcroft*, 537 U.S. 186, 199–200 (2003).

69. See *infra* Part III.A.

70. See *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 400 (1926) (“[O]ne really must be the first inventor in order to be entitled to a patent.”). Many commentators have also explained that a “fixation” requirement is inherent in the meaning of the term “Writings.” See *infra* note 90.

71. Heald & Sherry, *supra* note 3, at 1167 (describing four such limitations). The existence of limitations in the Patent and Copyright Clause does not, of course, suggest that all congressional acts should be subject to review relating to the limits of the Patent and Copyright Clause. As they explained, the limits of the Clause must be applied only to “legislation that

To bypass these limitations, some courts and commentators have proposed that any inherent limitations on congressional authority found within the Patent and Copyright Clause do not apply to statutes passed under another constitutional authority.⁷² However, recent scholarship has begun to point to flaws in the logic behind this notion.⁷³ I join these commentators in arguing that the limitations of the Patent and Copyright Clause prohibit the removal of work from the public domain, as the Court explicitly maintained in *Graham v. John Deere Co.*,⁷⁴ notwithstanding any other constitutional authority.

It is well established that “the constitutionality of action taken by Congress does not depend on recitals of the power which it undertakes to exercise.”⁷⁵ In addition, the Supreme Court has explicitly stated that a grant of power by one constitutional clause does not shield congressional action under that clause from the requirement that it meet with other express limitations of the

imposes monopoly-like costs on the public through the granting of exclusive rights.” *Id.* at 1160 (emphasis omitted).

72. In *United States v. Moghadam*, the Eleventh Circuit considered the constitutionality of section 513 of the URAA, 18 U.S.C. § 2319A. 175 F.3d 1269 (11th Cir. 1999). While explicitly declining to decide whether this section violates the “Limited Times” limitation, *id.* at 1281, the court held that it does not violate a “fixation” requirement, *id.* at 1282, derived from the term “Writings” in the Patent and Copyright Clause, *id.* at 1280, and suggested that Congress could pass the provision under the Commerce Clause despite this limitation, *id.* at 1277–80. *See also* Jane C. Ginsburg, *No “Sweat”? Copyright and Other Protection of Works of Information after Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 369 (1992); Paul Goldstein, *Copyright and Legislation: The Kastenmeier Years*, 55 LAW & CONTEMP. PROBS. 79 (1992); Dennis S. Karjala, *Copyright and Misappropriation*, 17 U. DAYTON L. REV. 885, 897 n.48 (1992) (“Assuming that publication places a work in commerce, Congress has this power unless the patent and copyright clause implies a limitation on the Commerce Clause [I]t seems unlikely that an original intent reading of the Constitution would require such an interpretation.”). Congress also appears to have subscribed to this view. *See* Heald & Sherry, *supra* note 3, at 1120 (“Despite the limiting language of the Intellectual Property Clause, Congress has recently enacted, or is seriously contemplating enacting, more than a dozen laws that seem to ignore or purport to avoid it.”). *See also* Peter A. Jaszi, *Goodbye to All That—A Reluctant (and Perhaps Premature) Adieu to a Constitutionally-Grounded Discourse of Public Interest in Copyright Law*, 29 VAND. J. TRANSNAT’L L. 595, 596 (1996) (“Sooner or later, and more likely sooner than later, one will see legislation introduced in the U.S. Congress to restore protection for domestic works now in the public domain . . .”).

73. Merschman, *supra* note 33, at 683–92; Adam R. Tarosky, *The Constitutionality of WIPO’s Broadcasting Treaty: The Originality and Limited Times Requirements of the Copyright Clause*, 2006 DUKE L. & TECH. REV. 16 (2006).

74. 383 U.S. 1, 6 (1966).

75. *EEOC v. Wyoming*, 460 U.S. 226, 243 n.18 (1983) (quoting *Woods v. Miller*, 333 U.S. 138, 144 (1948)).

Constitution.⁷⁶ The most prominent example of this principle is seen in *Railway Labor Executives' Ass'n v. Gibbons*.⁷⁷ In that case, the Court struck down a congressional act passed under the Commerce Clause because the act violated a limitation of the Bankruptcy Clause that laws be "uniform" throughout the states.⁷⁸ As the Court explained, "[I]f 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."⁷⁹ As recently as 1999, the Court reiterated this principle:

Article I of the Constitution grants Congress broad power to legislate in certain areas. Those legislative powers are, however, limited not only by the scope of the Framers' affirmative delegation, but also by the principle that they may not be exercised in a way that violates other specific provisions of the Constitution.⁸⁰

Despite the implication of these lessons to copyright, various courts and commentators have contended that the Commerce Clause may be used to bypass the Patent and Copyright Clause,⁸¹ largely in reliance on a misreading of the *Trade-Mark Cases*.⁸² Though the Supreme Court's explicit holding in that case was only that Congress could not implement federal trademark legislation under authority of the Patent and Copyright Clause,⁸³ the case has also been read as granting Congress tacit approval to pass such legislation under the Commerce Clause. Such a reading is found in *United States v. Moghadam*, in which the Eleventh Circuit noted, "[T]he *Trade-Mark Cases* stands for the proposition that legislation which would not be permitted under the Copyright Clause *could* nonetheless be permitted under the Commerce Clause, provided that the

76. *Buckley v. Valeo*, 424 U.S. 1, 132 (1976) ("Congress has plenary authority in all areas in which it has substantive legislative jurisdiction, so long as the exercise of that authority does not offend some other constitutional restriction.") (internal citation omitted).

77. 455 U.S. 457 (1982).

78. *Id.* at 473.

79. *Id.* at 468–69.

80. *Saenz v. Roe*, 526 U.S. 489, 508 (1999) (internal quotation omitted).

81. *See supra* note 72. *See generally* Nimmer, *supra* note 12 (pointing out that expanded use by Congress of the Commerce Clause, in particular, has gone beyond the limitations of the Copyright Clause).

82. 100 U.S. 82 (1879).

83. *Id.* at 94.

independent requirements of the latter are met.”⁸⁴ However, to say that Congress may look to their other enumerated powers to enact legislation not *permitted* by one Clause is not to say that Congress may do the same when an act is *prohibited* by another Clause.

This distinction became expressly clear when the Court again had the opportunity to consider federal trademark legislation in *Dastar Corp. v. Twentieth Century Fox Film Corp.*⁸⁵ In *Dastar*, the Court considered an aspect of the federal trademark statute, the Lanham Act, which, under one reading, would impermissibly violate the Patent and Copyright Clause.⁸⁶ In construing the Lanham Act so that it would not conflict with the Patent and Copyright Clause, the Court noted that “[t]o hold otherwise would be akin to finding that § 43(a) [of the Lanham Act] created a species of perpetual patent and copyright, which Congress may not do.”⁸⁷ Thus, the Court made clear that even with respect to trademark legislation expressly passed under the Commerce Clause, Congress cannot violate the limitations of the Patent and Copyright Clause.

In *Moghadam*, the Eleventh Circuit implicitly recognized this distinction when it documented a line of cases in which the Supreme Court prohibited the Commerce Clause from being used to circumvent limitations of other clauses.⁸⁸ Describing *Railway Labor Executives Ass’n v. Gibbons* as representing “the Framers’ judgment that Congress should be affirmatively prohibited from passing certain types of legislation, no matter under which provision,”⁸⁹ the *Moghadam* court ruled that Congress could bypass the Patent and Copyright Clause because “the Copyright Clause does not envision that Congress is positively forbidden from extending copyright-like protection under other constitutional clauses, such as the Commerce Clause, to works of authorship that may not meet the fixation requirement inherent in the term ‘Writings.’”⁹⁰ With respect to a limitation of the Patent and Copyright Clause, however, the court

84. 175 F.3d 1269, 1278 (11th Cir. 1999).

85. 539 U.S. 23 (2003).

86. *Id.*

87. *Id.* at 37.

88. *United States v. Moghadam*, 175 F.3d 1269, 1279–81 (11th Cir. 1999).

89. *Id.* at 1279.

90. *Id.* at 1280. Some commentators disagree with the *Moghadam* court’s view that fixation is not a requirement of the Patent and Copyright Clause. *E.g.*, Merschman, *supra* note 33, at 678–83. *See also* Goldstein v. California, 412 U.S. 546, 561 (1973) (“[W]ritings’ . . . may be interpreted to include any *physical rendering* of the fruits of creative intellectual or aesthetic labor.”) (emphasis added). I do not here attempt to fully explore or resolve this debate.

stated, “[w]e assume *arguendo*, without deciding, that the Commerce Clause could not be used to avoid a limitation in the Copyright Clause if the particular use of the Commerce Clause . . . were fundamentally inconsistent with the particular limitation in the Copyright Clause”⁹¹ Thus, even under the Eleventh Circuit’s reading, when the Patent and Copyright Clause “positively forbids” legislation, Congress may not bypass this limitation under the Commerce Clause.⁹² The Eleventh Circuit also clearly recognized that other limitations from the Patent and Copyright Clause do reach this same level of an absolute prohibition on Congress.⁹³

Commentators have similarly suggested that the treaty power independently grants Congress special authority, which may be used to bypass any limitations of the Patent and Copyright Clause.⁹⁴ These arguments rely on the Supreme Court’s dicta in the *Trade-Mark Cases*, stating that “we wish to be understood as leaving untouched the whole question of the treaty-making power over trade-marks, and of the duty of Congress to pass any laws necessary to carry treaties into effect.”⁹⁵ The arguments also rely on *Missouri v. Holland*, which stands for the proposition that Congress has broad authority under its treaty power beyond the enumerated powers of Article I, Section 8.⁹⁶ However, *Holland* also recognized that “a treaty cannot be valid if it infringes the Constitution, that there are limits, therefore, to the treaty-making power . . . ,” and the court only found the treaty at issue to be within Congress’ powers after finding that “[t]he treaty in question does not contravene any prohibitory words to be found in the Constitution.”⁹⁷ Moreover, the URAA is not a treaty, of course,

91. *Moghadam*, 175 F.3d at 1280 n.12.

92. *Id.* at 1280.

93. *See id.* at 1281 (leaving undecided the question of whether the “Limited Times” requirement would render section 513 of the URAA unconstitutional). In *United States v. Martignon*, the U.S. District Court of the Southern District of New York held that section 513 is an unconstitutional application of the copyright power, both because it violates the “Limited Times” requirement and because it violates a “fixation” requirement. 346 F. Supp. 2d 413, 424 (S.D.N.Y. 2004). That court recognized that a holding that this section of the URAA is unconstitutional need not be in conflict with the *Moghadam* court’s ruling, if the challenged feature of a copyright statute is “fundamentally inconsistent” with the “limitations imposed by the Copyright Clause.” *Id.* at 428.

94. *See, e.g.,* Jaszi, *supra* note 72; Caroline T. Nguyen, *Expansive Copyright Protection for All Time? Avoiding Article I Horizontal Limitations Through the Treaty Power*, 106 COLUM. L. REV. 1079 (2006).

95. 100 U.S. 82, 99 (1879).

96. 252 U.S. 416 (1920).

97. *Id.* at 432, 433.

but rather a statute implemented like any other.⁹⁸ The commentators who propose using the Treaty Power to bypass the Patent and Copyright Clause's limitations generally also recognize that "the Treaty Power may . . . not be used to violate affirmative prohibitions."⁹⁹ Just as under authority of the Commerce Clause, the Treaty Power is limited by certain absolute prohibitions on congressional power.¹⁰⁰ Thus, even among those commentators most inclined to view congressional authority broadly, there is general agreement that a true prohibition found in one part of the Constitution applies to any congressional action. The next section describes two such limitations.

III. THE URAA IS UNCONSTITUTIONAL UNDER THE PATENT AND COPYRIGHT CLAUSE

A. *Congress may not Grant Copyright to Entities Other than "Authors"*

In addition to the more commonly discussed limitations of the Patent and Copyright Clause,¹⁰¹ the Clause also contains a specific limitation that Congress may secure copyrights only in "Authors." The Supreme Court has defined an "author" as "he to whom anything owes its origin [sic]."¹⁰² As the Court recently explained, "The Framers guarded against the future accumulation of monopoly power in booksellers and publishers by authorizing Congress to vest copyrights

98. See Merschman, *supra* note 33, at 688 n.146; Nimmer, *supra* note 12, at 1397–98.

99. Nguyen, *supra* note 94, at 1079.

100. Joseph C. Merschman has previously detailed why Congress may not bypass the Patent and Copyright Clause by invoking either the Commerce Clause or Trade Power authority. Merschman, *supra* note 33, at 683–92. See also William Patry, *The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision*, 67 GEO. WASH. L. REV. 359, 361 (1999) ("When a specific clause of the Constitution, such as Clause 8 of Article I, Section 8, has been construed as containing general limitations on Congress's power, Congress may not avoid those limitations by legislating under another clause."); 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, 60 (1999) ("Congress may not do an end run around a limitation in one clause of the Constitution by invoking a more general clause . . ."). After conducting a review of many of the reasons previously advanced for why the Supreme Court should not allow Congress to bypass the Patent and Copyright Clause's limitations, Richard Graves concludes that the ideological makeup of the current Court is unlikely to permit such a bypass. See generally Graves III, *supra* note 6.

101. See *supra* notes 65–71 and accompanying text.

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

only in 'Authors.'"¹⁰³ Nonetheless, section 514 allows entities that hold foreign copyrights to obtain a U.S. copyright regardless of whether or not they are actually authors. A recent case in the Fifth Circuit Court of Appeals, *Alameda Films SA de CV v. Authors Rights Restoration Corp.*, illustrates the application of the URAA in practice.¹⁰⁴

In *Alameda Films*, twenty-four Mexican film production companies brought suit against companies that were distributing various Mexican films in the United States that were originally produced between the late-1930s and the mid-1950s.¹⁰⁵ The Mexican film companies argued that, though these works had previously fallen into the public domain in the United States, the URAA granted them copyrights in the work. They also argued that copyright "vests initially in the author or initial rightholder of the work as determined by the law of the source country of the work."¹⁰⁶ As the Fifth Circuit explained, "[T]he Plaintiffs can claim restored copyrights in their films under the URAA only if the Plaintiffs are considered 'authors' under Mexican copyright law—the law of the source country of the work."¹⁰⁷ The question of whether the Mexican film companies could be granted copyrights in their work under the URAA then depended not on whether they qualified as "Authors," as envisioned by the Constitution, but rather on whether they qualified as "authors," under Mexican law.¹⁰⁸ Clearly, the question of what is required to be an author in any sovereign nation need have no relationship to the standard of "Author" required by the U.S. Constitution. Therefore, whenever a foreign entity which would not meet the Constitution's standard attempts to secure copyright under the URAA, a challenge to the constitutionality of section 514 should be brought and should be successful.

103. *Eldred v. Ashcroft*, 537 U.S. 186, 201 n.5 (2003). Because of this limitation, some commentators have argued that the work-for-hire doctrine of copyright is unconstitutional. *E.g.*, Rochelle Cooper Dreyfuss, *The Creative Employee and the Copyright Act of 1976*, 54 U. CHI. L. REV. 590, 600 (1987). Others, however, disagree with this conclusion. *E.g.*, Heald & Sherry, *supra* note 3, at 1190–91.

104. 331 F.3d 472 (5th Cir. 2003).

105. *Id.* at 475.

106. *Id.* at 476 n.5 (quoting 17 U.S.C. § 104A(2)(b) (2007)).

107. *Alameda Films*, 331 F.3d at 477.

108. *See id.* at 477–78.

B. Congress may not Remove Works from the Public Domain

1. The *Graham* Rule—Congress May Not Grant Patents To Works In The Public Domain—One additional, specific limitation that the Supreme Court has recognized is that Congress may not remove work from the public domain.¹⁰⁹ In *Graham v. John Deere Co.*, the Supreme Court explicitly pronounced that “Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available.”¹¹⁰ While this statement is often derided as “a dictum,”¹¹¹ lower courts are “bound by Supreme Court dicta almost as firmly as by the Court’s outright holdings.”¹¹² Furthermore, the conclusion that Congress may not remove works from the public domain was built upon a substantial foundation of cases, which held that individual authors and the states are similarly precluded, and has been reaffirmed.

In *Pfaff v. Wells Electronics, Inc.*, Justice Stevens, writing for a unanimous Court, explained that the Court’s previous holdings, which prohibited an inventor from removing works from the public domain, were based on the Constitution.¹¹³ After discussing patent’s role, “as contemplated by the Constitution,”¹¹⁴ he noted that “the Patent Act serves as a limiting provision, . . . excluding ideas that are in the public domain from patent protection.”¹¹⁵ He further explained, “The patent laws . . . seek . . . to protect the public’s *right* to retain knowledge

109. By “public domain” I am referring to a concept akin to a definition offered by Yochai Benkler: “The public domain is the range of uses of information that any person is privileged to make absent individualized facts that make a particular use by a particular person unprivileged.” 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, 362 (1999). Heald & Sherry describe this limitation as the “public domain principle.” Heald & Sherry, *supra* note 3, at 1165–66.

110. 383 U.S. 1, 6 (1966).

111. *E.g.*, *Luck’s Music Library, Inc. v. Gonzales*, 407 F.3d 1262, 1266 (D.C. Cir. 2005).

112. *United States v. Nelson*, 383 F.3d 1227, 1232 (10th Cir. 2004) (citation omitted).

113. 525 U.S. 55, 64–65 (1998). Justice Stevens specifically discussed only the holding in *Pennock v. Dialogue*, 27 U.S. (2 Pet.) 1 (1829), but his analysis applies equally to additional patent cases including, for example, *Kendall v. Winsor*, 62 U.S. (21 How.) 322, 328 (1858) (“Moreover, that which is once given to or is invested in the public, cannot be recalled nor taken from them.”), and *Shaw v. Cooper*, 32 U.S. (7 Pet.) 292, 323 (1833) (“Whatever may be the intention of the inventor, if he suffers his invention to go into public use, through any means whatsoever, without an immediate assertion of his right, he is not entitled to a patent.”).

114. *Pfaff*, 525 U.S. at 64 (quoting *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516, 533–34 (1870)).

115. *Id.*

already in the public domain.”¹¹⁶ The Federal Circuit has further recognized that one of the purposes of patent’s public-use bar to patentability is “discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.”¹¹⁷ Thus, undoubtedly the Constitution prohibits individuals from removing works from the public domain through patents.

The Supreme Court has made clear that the states are similarly prohibited from removing work from the public domain, and the Court has affirmed that this limitation derives from the Patent and Copyright Clause. In *Compco Corp. v. Day-Brite Lighting, Inc.*, the Court noted that “[t]o forbid copying would interfere with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution . . . of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain.”¹¹⁸ The Court based this assertion on its holding in *Sears, Roebuck & Co. v. Stiffel Co.*, which recognized only that states may not enact measures inconsistent with federal patent laws.¹¹⁹ Thus, one interpretation is that the Clause is intended only to describe a limitation, rooted in the Supremacy Clause, that the *states* cannot grant patents and copyrights beyond those established by Congress.¹²⁰ This explanation would mean that the Court’s recognition that the “policy of the patent law: that which is in the public domain cannot be removed therefrom by action of the States”¹²¹ must be based exclusively on the Supremacy Clause.

However, this reading would ignore *Compco*’s explicit reference to the Patent and Copyright Clause as establishing a policy of leaving the public domain untouched, as well as the fact that *Compco* never even mentioned the Supremacy Clause.¹²² Since *Compco*’s admonition that works in the public domain must remain there was explicitly based on the Patent and Copyright Clause, it necessarily applies to Congressional actions. In *Goldstein v. California*, the Court explicitly made this very point, noting that “Section 8 enumerates

116. *Id.* at 65 (emphasis added).

117. *Baxter Int’l, Inc. v. Cobe Labs., Inc.* 88 F.3d 1054, 1058 (Fed. Cir. 1996).

118. 376 U.S. 234, 237 (1964).

119. 376 U.S. 225, 232–33 (1964).

120. In fact, the Court has clearly stated that *Sears* itself was rooted in the Supremacy Clause. *Eldred v. Ashcroft*, 537 U.S. 186, 204 n.8. (2003).

121. *See Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 481 (1974).

122. *See Theodore H. Davis Jr., Copying In The Shadow Of The Constitution: The Rational Limits Of Trade Dress Protection*, 80 MINN. L. REV. 595, 610–13 (1996); Shipley, *supra* note 21, at 59–65.

those powers which have been granted to Congress; Whatever limitations have been appended to such powers can only be understood as a limit on congressional . . . action.”¹²³ In *Kewanee Oil Co. v. Bicron Corp.*, the Court referred to “[t]he policy that matter once in the public domain must remain in the public domain,”¹²⁴ and in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, the Court reaffirmed this rule.”¹²⁵ The inevitable conclusion from these cases is that the Court meant what it said in *Graham*, and that the prohibition on issuing patents to work in the public domain applies to Congress as well as the states. As the Court put it, “[W]e have consistently reiterated the teaching of *Sears* and *Compco* that ideas once placed before the public without the protection of a valid patent are subject to appropriation without significant restraint.”¹²⁶

By passing section 514 of the URAA, Congress exceeded the boundaries established by *Graham*, but it has done so in the copyright rather than the patent context. The district court in *Golan v. Gonzales* wrote that “[i]t is unlikely that the public has a greater interest in copyrightable works than it does in patentable ones,” thus refusing to rely on patent cases and concluding that Congress is not precluded from taking copyrighted works from the public domain.¹²⁷ This notion of the public’s alleged “greater interest” in patent is reminiscent of judicial notions that elicited Justice Holmes’ famous reminder that “[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”¹²⁸ A blanket conclusion that the works protected by patent are more important to the public than those of copyright is just as unwarranted as a proclamation that a single work is more worthy than another within the field of copyright. Who can say that the next Shakespeare or Monet is any less important for society, or worthy of protection, than the next patent issued for a computer or better mousetrap? A blanket statement in favor of patents over copyrights seems

123. 412 U.S. 546, 560 (1973).

124. 416 U.S. 470, 484 (1974).

125. 489 U.S. 141, 152 (1989) (quoting *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896) (clarifying that when an invention enters the public domain “the right to make the thing formerly covered by the patent becomes public property”)).

126. *Bonito Boats*, 489 U.S. at 156.

127. No. Civ.01-B-1854(BNB), 2005 WL 914754, at *5 (D. Colo. Apr. 20, 2005), *aff’d in part, remanded in part*, 501 F.3d 1179 (10th Cir. 2007).

128. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

particularly questionable when one considers design patents, which may issue for works that are often also copyrightable,¹²⁹ and serve much the same purpose.¹³⁰

Previous courts and commentators have had the opportunity to explore the application of the *Graham* rule to Congress' authority with respect to copyrights. Paul J. Heald and Suzanna Sherry, in an interesting analysis, considered the application of this limitation, as well as others implied by the Patent and Copyright Clause, to two federal copyright statutes, the Copyright Term Extension Act ("CTEA")¹³¹ and the URAA.¹³² While they suggested that the URAA "may be subject to challenge under either the Public Domain Principle or the Quid Pro Quo Principle," they ultimately concluded that "only the Quid Pro Quo Principle presents serious problems."¹³³ Although recognizing that the URAA "takes some works out of the public domain," Heald and Sherry concluded that this was permissible based on their description of this taking as only an "administrative technicalit[y]."¹³⁴ On the other hand, they concluded that application of the Quid Pro Quo principle rendered both the CTEA and URAA unconstitutional.¹³⁵

These ideas were tested by the D.C. Circuit Court of Appeals in *Eldred v. Reno*, when that court considered the constitutionality of the CTEA.¹³⁶ Although the D.C. Circuit rejected Heald and Sherry's conclusion that the CTEA is unconstitutional, the court also explained, in dicta, that the directive from the Supreme Court's *Graham* decision dealing with patents would "preclude the Congress from authorizing under [the Patent and Copyright] Clause a copyright to a work already in the public domain."¹³⁷ During oral argument

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

130. See *Gorham Mfg. Co. v. White*, 81 U.S. (14 Wall.) 511, 524 (1871) ("The acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance . . .").

131. Heald & Sherry, *supra* note 3, at 1168–76 (discussing the Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998)).

132. *Id.* at 1179–81 (discussing the Uruguay Round Agreements Act, Pub. L. No. 103-465, sec. 514, § 104A(h)(6), 108 Stat. 4809, 4980–81 (1994)).

133. *Id.* at 1180. This latter assertion was rejected in *Eldred v. Ashcroft*, 537 U.S. 186, 217 (2003).

134. Heald & Sherry, *supra* note 3, at 1180.

135. *Id.* at 1169, 1180.

136. *Eldred v. Reno*, 239 F.3d 372 (D.C. Cir. 2001), *aff'd sub nom.* *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

137. *Id.* at 377.

before the Supreme Court, the government conceded as much, noting that there is a “bright line” between those works with existing copyrights, which were extended by the CTEA, and other works already in the public domain.¹³⁸ When the Supreme Court considered *Eldred*, Justice Stevens, in his dissent, disregarded any argument that works could be removed from the public domain, noting that “no one seriously contends that the Copyright/Patent Clause would authorize the grant of monopoly privileges for works already in the public domain.”¹³⁹ Still, *Eldred* did not depend upon a determination of this issue, and when the D.C. Circuit later directly faced this question, it concluded that the URAA’s granting of copyrights to works already in the public domain does not violate the Patent and Copyright Clause.¹⁴⁰ Relying on *Eldred*, that court took the fact that Congress could extend existing copyrights to mean that Congress would be able to do the opposite and remove work already within the public domain.¹⁴¹

When the Fifth Circuit Court of Appeals examined the application of the URAA, that court similarly refused to rely on the patent cases, noting that “[p]atents . . . are not copyrights, and thus patent cases are inapposite to copyright cases.”¹⁴² However, a review of the history of the Supreme Court’s overlapping treatment of patents and copyrights clearly illustrates that it is unreasonable for lower courts to conclude that the limitation on removing works from the public domain is “inapposite” to copyright.

2. The *Graham* Rule Applies Equally to Copyrights—The constitutional copyright provision is found in the same clause as the constitutional patent provision: “The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”¹⁴³ Since the very first case interpreting the Patent and Copyright Clause, the Supreme Court has relied on a presumption of parallelism between the “Discoveries” of

138. Transcript of Oral Argument at 44, *Eldred v. Ashcroft*, 537 U.S. 186 (October 9, 2002) (No. 01-618).

139. *Eldred v. Ashcroft*, 537 U.S. at 240 (Stevens, J., dissenting).

140. See *Luck’s Music Library, Inc. v. Gonzales*, 407 F.3d 1262, 1263 (D.C. Cir. 2005).

141. *Id.* at 1263–65.

142. *Alameda Films SA de CV v. Authors Rights Restoration Corp. Inc.*, 331 F.3d 472, 483 n.33 (5th Cir. 2003).

143. U.S. CONST. art. I, § 8, cl. 8.

"Inventors" and the "Writings" of "Authors."¹⁴⁴ In *Wheaton v. Peters*, the Court faced the question of the correct interpretation of the word "securing" within the Patent and Copyright Clause.¹⁴⁵ Although the case only pertained to copyrights, the Court reasoned that the word's placement within the clause dictated that it "refers to inventors, as well as authors."¹⁴⁶ The Court then interpreted the word in light of its dual application to both copyrights and patents.¹⁴⁷ In subsequent interpretations of the Patent and Copyright Clause, the Court has maintained the general rule that patents and copyrights are to be treated the same. For example, in *Fox Film Corp. v. Doyal*, the Court explicitly stated, "[W]hat we have said as to the purposes of the government in relation to copyrights applies as well, mutatis mutandis, to patents which are granted under the same constitutional authority to promote the progress of science and useful arts."¹⁴⁸ Reflecting on over 100 years of precedent in interpreting the Clause, Justice Douglas once pointed out that "[n]o distinction is made in the constitutional language between copyrights and patents and I would not create one by judicial gloss."¹⁴⁹

This is not to say that there are no differences between patents and copyrights. Even when analogizing between them, the Court has remained mindful that "[t]he two areas of the law, naturally, are not identical twins, and we exercise the caution which we have expressed in the past in applying doctrine formulated in one area to the other."¹⁵⁰ As evidence of that caution, the Court has pointed to its

144. This parallel structure apparently does not extend to the terms "Science" and "useful Arts" in the preamble to the Patent and Copyright Clause, as these terms apply to both patent and copyright. Compare *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 961 (2005) ("The Constitution itself stresses the vital role that copyright plays in advancing the 'useful Arts.'") (Breyer, J., concurring) with the title of the first Patent Act, "An Act to promote the progress of useful Arts." Act of April 10, 1790, 1 Stat. 109.

145. 33 U.S. (8 Pet.) 591 (1834).

146. *Id.* at 592.

147. *Id.*

148. 286 U.S. 123, 131 (1932). See also *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964) ("Today we have held in *Sears, Roebuck & Co. v. Stiffel Co.* that when an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article.") (citation omitted); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 228, 231 n.7 (1964); *Goldstein v. California*, 412 U.S. 546, 578 n.3 (1973) (Marshall, J., dissenting) (recognizing that, in previous cases, "the Court repeatedly referred to the patent and copyright statutes as if the same rules of interpretation applied to both").

149. *Lee v. Runge*, 404 U.S. 887, 890 (1971) (Douglas, J., dissenting from denial of certiorari).

150. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 439 n.19 (1984).

early decisions in *Mazer v. Stein* and *Bobbs-Merrill v. Straus*.¹⁵¹ In the seminal *Stein* case, the Court refused to apply patent's "exclusive right to the art" to copyright.¹⁵² As it explained, "The copyright protects originality rather than novelty or invention."¹⁵³ Similarly, in *Bobbs-Merrill*, without pointing to any particular difference, the Court noted only "that there are differences between the patent and copyright statutes in the extent of the protection granted by them."¹⁵⁴ In *Eldred v. Ashcroft*, the Court again exercised this caution, finding that "one cannot extract from language in our patent decisions . . . genuine support for petitioners' bold view . . . that a *quid pro quo* requirement stops Congress from expanding copyright's term in a manner that puts existing and future copyrights in parity."¹⁵⁵

Importantly, the fact that the Court has described differences between patents and copyrights does not detract from the general rule that doctrines based in the Constitution apply equally to both. Instead, the differences between patent and copyright suggest only that they be treated differently, when necessary, to reflect inherent differences about what constitutes a patent or a copyright. Where the Court has found constitutional differences between patent and copyright, these differences are due only to the difference between the terms "author," "writings," "inventor," and "discoveries."¹⁵⁶ Thus, the Court's definitions of an "author" as "he to whom anything owes its origin [sic]; originator; maker; one who completes a work of science or literature,"¹⁵⁷ and of "writings" as "the literary productions of those authors, . . . to include all forms . . . by which the ideas in the mind of the author are given visible expression,"¹⁵⁸ dictate the originality requirement of copyright.¹⁵⁹ Judge Learned Hand summarized

151. *Id.*

152. *Mazer v. Stein*, 347 U.S. 201, 217 (1954).

153. *Id.* at 218.

154. *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 345 (1908).

155. 537 U.S. 186, 217 (2003).

156. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903) (citing with approval a district court's observation, in *Henderson v. Tompkins*, 60 F. 758, 764 (C.C.D. Mass. 1894), that "[t]here is a very broad distinction between what is implied in the word 'author,' found in the constitution, and the word 'inventor.'").

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

158. *Id.* See also *Trade-Mark Cases*, 100 U.S. 82, 94 (1879) ("[T]he word *writings* . . . include[s] . . . only such as are *original*, and are founded in the creative powers of the mind. . . . *the fruits of intellectual labor.*").

159. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 346 (1991) ("Originality is a constitutional requirement. . . . [T]he crucial terms 'authors' and 'writings' . . . presuppose a degree of originality.").

copyright's originality requirement when he famously declared that "if by some magic a man who had never known it were to compose anew Keats's Ode on a Grecian Urn, he would be an 'author,' and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's."¹⁶⁰ Similarly, the Court's understanding of the meaning of "Inventor" and "Discovery" dictate the novelty requirement of patents.¹⁶¹ The reduced originality versus novelty standard¹⁶² explains why patents inherently create a monopoly on ideas,¹⁶³ whereas copyright grants a more limited right only to prevent direct copying.¹⁶⁴

Similarly, the inherent difference between the writings of authors and discoveries of inventors explains why it is "much more important that when the supposed author sues for a violation of his copyright, the existence of those facts of originality, of intellectual production, of thought, and conception of the part of the author should be proved than in the case of a patent right."¹⁶⁵ Likewise, these inherent differences explain why "patent's *quid pro quo* is more exacting than copyright's."¹⁶⁶ As the Court explained in *Eldred*, "For the author seeking copyright protection . . . disclosure is the desired objective, not something exacted from the author in exchange for the copyright."¹⁶⁷ This consideration is inherent in an author's writing and is not dictated by differential application of the Patent and Copyright Clause's limitations to the two types of works. In fact, the Court has given no guidance to suggest that any word or phrase of the Patent and Copyright Clause should have a different meaning depending upon whether it is applied to patents or copyrights. In Justice

160. *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936).

161. See *Pfaff v. Wells Elecs., Inc.* 525 U.S. 55, 60 (1998) ("The primary meaning of the word 'invention' in the Patent Act unquestionably refers to the inventor's conception rather than to a physical embodiment of that idea."). See also *Alexander Milburn Co. v. Davis Bournonville Co.* 270 U.S. 390, 400 (1926) ("[O]ne really must be the first inventor in order to be entitled to a patent.").

162. *Mazer v. Stein*, 347 U.S. 201, 218 (1954) (recognizing that unlike a patent "[t]he copyright protects originality rather than novelty or invention").

163. *Eldred v. Ashcroft*, 537 U.S. 186, 217 n.22 (2003) (recognizing that patent grants prevent full use of an inventor's knowledge whereas a copyright "gives the holder no monopoly on any knowledge").

164. *Sheldon*, 81 F.2d at 54.

165. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59–60 (1884).

166. *Eldred*, 537 U.S. at 217 n.22.

167. *Id.* at 216.

Douglas' words, the Court has not distinguished between patents and copyrights "by judicial gloss."¹⁶⁸

Indeed, the Court has repeatedly—including in a series of recent cases—referred to holdings pertaining only to patents or to copyrights to inform its inquiry regarding the other. In *Sony Corp. of America v. Universal City Studios, Inc.*, the Court applied the patent doctrine of contributory infringement to copyright.¹⁶⁹ Then, in *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, the Court decided that "[f]or the same reasons that *Sony* took the staple-article doctrine of patent law as a model for its copyright safe-harbor rule, the inducement rule, too, is a sensible one for copyright."¹⁷⁰ Most recently, in *eBay Inc. v. MercExchange, L.L.C.*, the Court adopted copyright doctrine and applied it to patents, this time with respect to when an injunction should be granted in an infringement case.¹⁷¹ In fact, in *Eldred v. Ashcroft*, the very case relied upon by those courts which refused to apply patent doctrine to copyright when they considered the URAA, the Court noted, "Because the Clause empowering Congress to confer copyrights also authorizes patents, congressional practice with respect to patents informs our inquiry."¹⁷² The lower courts have similarly applied doctrines from patent law to copyright.¹⁷³

Specifically with respect to the removal of works from the public domain, the parallelism between patent and copyright has already been applied to the powers of authors and the states. It is clear that authors, like inventors, cannot remove work from the public domain.¹⁷⁴ Similarly, the limitation preventing the states from granting patents to works in the public domain is equally applicable to copyright, as evidenced by the Court's reference to both in the

168. *Lee v. Runge*, 404 U.S. 887, 890 (1971) (Douglas, J., dissenting from denial of certiorari).

169. 464 U.S. 417, 439 (1984) ("The closest analogy is provided by the patent law cases to which it is appropriate to refer because of the historic kinship between patent law and copyright law.").

170. 545 U.S. 913, 936 (2005).

171. 126 S. Ct. 1837, 1840 (2006).

172. 537 U.S. 186, 201 (2003).

173. *E.g.*, *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 973 (4th Cir. 1990) ("We are persuaded, however, that a misuse of copyright defense is inherent in the law of copyright just as a misuse of patent defense is inherent in patent law.").

174. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33–34 (2003) ("[O]nce the patent or copyright monopoly has expired, the public may use the invention or work at will and without attribution."); *Steward v. Abend*, 495 U.S. 207, 223 (1990) (noting that a work can be infringed only "[s]o long as the pre-existing work remains out of the public domain"); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896).

Compro decision.¹⁷⁵ That Congress would similarly be precluded is reasonable in light of the parallel structure in the Patent and Copyright Clause and the Court's continued application of each word in the Clause to both forms of intellectual property in like manner. In contrast to the suggestion that copyright in public domain work should be available where patents clearly are not, a former member of the Court suggested that if there are differences between patents and copyright, "a copyright may have to meet greater constitutional standards for validity than a patent."¹⁷⁶

Finally, it is important to note that, in addition to the application of the patent cases to copyright, including *Graham's* proclamation, the Supreme Court had already concluded that Congress may not use the Patent and Copyright Clause to remove works from the public domain nearly a century before *Graham*.¹⁷⁷ When the Court first considered the constitutionality of trademarks in the *Trade-Mark Cases*, it had the opportunity to consider the application of the Patent and Copyright Clause to that form of intellectual property.¹⁷⁸ While the case is primarily remembered for the notion that Congress could not grant trademark protection under the Patent and Copyright Clause,¹⁷⁹ often overlooked is that the Court's conclusion that trademarks could not be justified under the Patent and Copyright Clause also relied on the fact that trademarks were "the adoption of something already in existence."¹⁸⁰ Importantly, unlike in *Graham*, this is a direct reference both to copyright as well as to patent.¹⁸¹ As the Court did not distinguish between the two in terms of what they require in this regard, the holding necessarily represents a limitation of both the Patent and the Copyright Clauses; a limitation that has neither been contravened nor overruled.

175. *Compro Corp. v. Day-Brite Lighting, Inc.* 376 U.S. 234, 237 (1964).

176. *Lee v. Runge*, 404 U.S. 887, 890 (1971) (Douglas, J., dissenting from denial of certiorari).

177. *See Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

178. *Id.*

179. *Heald & Sherry, supra* note 3, at 1156 ("Congress had no power under the Intellectual Property Clause to protect trademarks, because they are not 'a sudden invention' and require 'no fancy or imagination, no genius, no laborious thought.'") (*quoting Trade-Mark Cases*, 100 U.S. at 94).

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

181. The Court explained, for example, "[i]f we should endeavor to classify it under the head of writings of authors, the objections are equally strong. In this, as in regard to inventions, originality is required." *Id.* at 94. The Court concluded that "we are unable to see any such power in the constitutional provision concerning authors and inventors, and their writings and discoveries." *Id.* at 95.

CONCLUSION

Section 514 of the Uruguay Round Agreements Act¹⁸² is an unconstitutional application of the copyright power granted to Congress. In the name of international trade, Congress has granted foreign entities American copyrights, circumventing the Constitution's mandate that copyrights be granted solely to "Authors." Courts asked to review this statute should also pay close attention to the Supreme Court's long history of analogous treatment of patents and copyrights. Absent contrary indication from the Supreme Court, courts should apply the general rule that doctrine grounded in either of the two halves of the Patent and Copyright Clause applies equally to the other half. With respect to the URAA, this doctrine mandates that Congress may not remove works from the public domain, as they have done under section 514.

Today, the promotion of international trade has become a dominant force in domestic policy debates, and the URAA is just one development, albeit an important one, in this movement.¹⁸³ The policy considerations being discussed during passage of the U.S. Constitution, were very different, however, even opposite.¹⁸⁴ Just a few years ago, Professor Graeme Austin asked whether the Patent and Copyright Clause mandated isolationism.¹⁸⁵ In *Eldred v. Ashcroft*, the Court answered the question, in part and in the negative, by deferring to the international concerns prompting Congress to enact the CTEA.¹⁸⁶ However, this should not be taken as granting Congress a blank check to rely on international trade concerns without limit. Congress' ability to bring the United States into line with international norms is nonetheless constrained by a Constitution, which does in fact mandate some degree of isolationism. As Professor Austin recognized, while international law issues were not necessarily raised under the CTEA, some international questions are inherent in

182. Uruguay Round Agreements Act, Pub. L. No. 103-465, sec. 514, § 104A, 108 Stat. 4809, 4976-81 (1994) (codified at 17 U.S.C. § 104A).

183. See, e.g., Trade Agreements Work for America, Office of the United States Trade Representative, available at http://www.ustr.gov/assets/Document_Library/Fact_Sheets/2006/asset_upload_file920_9647.pdf.

184. See generally THE FEDERALIST NO. 43 (James Madison).

185. Graeme W. Austin, *Does the Copyright Clause Mandate Isolationism?* 26 COLUM. J.L. & ARTS 17, 59 (2002) (cautioning against "an isolationist reading of the Copyright Clause that is in tension with . . . America's international copyright relations over the last hundred or so years").

186. *Eldred v. Ashcroft*, 537 U.S. 186, 205-06 (2003).

the URAA.¹⁸⁷ It does not conflict with Professor Austin's broad conclusion that "emerging international intellectual property norms might be allowed at least to influence thinking about doctrinal positions as well as fundamental principles in U.S. copyright jurisprudence,"¹⁸⁸ to recognize that in some respects, the Constitution is unyielding. As the Court has described, the Constitution "sets forth, and rests upon, innovative principles original to the American experience."¹⁸⁹ Though some of the Constitution's limitations may appear to be outdated today, they must nonetheless be respected. The challenge for Congress today is to find a way to meet our international obligations without trading American "air."

187. Austin, *supra* note 185, at 20.

188. *Id.* at 58–59.

189. *Roper v. Simmons*, 543 U.S. 551, 578 (2005).